UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC., MICROSOFT CORPORATION, MICROSOFT MOBILE OY, AND MICROSOFT MOBILE INC. (F/K/A/ NOKIA INC.),

Petitioner

v.

EVOLVED WIRELESS LLC,
Patent Owner.

Case IPR2016-01229
Patent 7,881,236

PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR REHEARING

I. Introduction

Patent Owner's Request for Rehearing (Paper 28, hereinafter the "Request") should be denied because neither of the two bases for rehearing identified by the Request is sustainable

First, contrary to Patent Owner's allegations, the Board did not overlook Patent Owner's hypothetical modification of Kitazoe's disclosure, or that hypothetical's introduction of an additional UL grant. Rather, the Decision directly addressed the hypothetical, noting expressly that the hypothetical's addition of a UL grant contradicted disclosure from Kitazoe. *See* Decision, pp. 33-35.

Second, while Patent Owner attempts to demonstrate that the Board misapprehended its flawed argument that Kitazoe "does not create the conditions that test the *only when* behavior" of the '236 patent claims, the record also belies this argument. The Decision shows how the Board sagely embraced Kitazoe's express definition of "message 3" (which the Request and, notably, the Patent Owner Response fails to even mention) as teaching the "only when behavior." *See* Decision, pp. 33-35. In doing so, the Board demonstrated its understanding of the argument; it just simply, and correctly, found the argument uncompelling.

The Request fails to show that the Decision overlooked or misapprehended any argument. Accordingly, the Board should deny Patent Owner's Request for Rehearing in full.

II. In arguing that the Board overlooked and misapprehended arguments about Kitazoe, Patent Owner conveniently ignores the Decision's acknowledgement of Kitazoe's express definition of "message 3"

Without equivocation, the Decision expressly credits Kitazoe as defining, for the purposes of its disclosure, the term message 3 as a message that is "sent *only when* the random access response is received." Decision, p. 33(emphasis added) (citing Kitazoe, 8:32-35 ("the term 'message 3' refers to the scheduled transmission sent by the access terminal to [the] base station [] *as granted by the random access response message* from [the] base station.") (emphasis added) (cited at Petition, p. 40; Wells, ¶ 128). The Request for Rehearing simply ignores the Decision's reliance on Kitazoe's definition of "message 3" or the Decision's discussion of the clear inconsistency between Kitazoe's disclosure and Patent Owner's hypothetical. As described below, these aspects of the decision make clear that the Board addressed both arguments identified in the Request and rightly found each wanting; it did not misapprehend or overlook anything about Kitazoe, as Patent Owner contends.

III. The Board did not overlook Patent Owner's argument that its hypothetical example of an additional PDCCH UL Grant is grounded in the '236 patent's specification

Patent Owner argues that the "the Board overlooked the Patent Owner's argument that the additional PDCCH UL Grant was 'the very grant that was contemplated by the inventors of the '236 [patent].'" Request, p. 10. The Board did not overlook this argument. To the contrary, the Decision plainly demonstrates that the Board clearly considered the argument in correctly holding Patent Owner's hypothetical to be inconsistent with Kitazoe's disclosure, and therefore contrived. *See* Decision, p. 35.

The Decision addresses Patent Owner's hypothetical modification of Kitazoe. In particular, the Decision acknowledges two specific contentions by Patent Owner: (1) that "Kitazoe takes a narrow view of what can occur during a random access procedure" and (2) that Kitazoe "'does not consider the more complex case' in which a 'UL Grant is not in a random access response message but is instead contained in a PDCCH communication.'" *Id.* (emphasis added) (quoting POR, pp. 41-42). As to the second contention, the Decision remarks, "[i]n such a 'more complex case,' Patent Owner argues, 'the Msg3 buffer data is sent responsive to a [different message], an UL Grant *not* in a random access response.'" Decision, p. 35 (emphasis added). Yet, Patent Owner contends that the Board overlooked inserting a "UL Grant… in a PDCCH communication" to

yield an "additional PDCCH UL Grant." *See* Request, p. 10. This position is unsupportable.

The Board correctly found that Patent Owner's hypothetical directly contradicts Kitazoe's express definition of a "message 3" (discussed above). Decision, pp. 32, 34. Indeed, as the Board recognized in the Decision, sending Kitazoe's message 3 using "an UL Grant not in a random access response," as proposed in Patent Owner's hypothetical, is contrary to the Kitazoe's definition of "message 3," as Kitazoe is clear that it sends its message 3 data only "*as granted by the random access response message*." Decision, p. 33 (citing Petition, p. 40; Kitazoe, 8:32-35; Wells, ¶ 128). Thus, it is *not* sent using UL grants from other received messages. *Id.*

The Decision also found that Patent Owner "hypothesize[d] a system that is more complex than Kitazoe." Decision, p. 35. To this point, the Decision disapproved of Patent Owner's conjuring of a hypothetical that mended together features of Kitazoe with those of a purported background system—rather than the claims—of the '236 patent. Decision, p. 35 (citing to Patent Owner Response at pp. 40-41, which compare Fig. 7 of Kitazoe with the background system of Fig.8 of the '236 Patent). The Decision noted that this contrived hypothetical was both contrary to Kitazoe's express disclosure and ineffective at demonstrating Kitazoe's lack of satisfaction of the claims of the '236 patent. Decision, p. 35. To this later

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