

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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 B2

**PATENT OWNER'S RESPONSE TO PETITIONERS' PETITION FOR
INTER PARTES REVIEW OF UNITED STATES PATENT NO. 7,881,236**

TABLE OF CONTENTS

I.	Introduction.....	1
II.	The State of the art.....	2
III.	The problem the inventors solved	5
IV.	The claims.....	7
	A. Independent claim 1	7
	B. Independent claim 7	9
V.	Claim Construction.....	10
	A. Introduction	10
	B. A person of ordinary skill would read the claims as transmitting Msg3 data “only if” the condition in 1(e) is satisfied	15
	C. Petitioners’ proposed construction is inoperative	18
	D. The principle of <i>expressio unius</i> supports Patent Owner’s “only if” construction	21
	E. The USPTO’s examination of a child patent of the ’236 patent confirms that the proper construction is the “only if” one.....	25
	F. Petitioners’ various claim construction arguments fail.....	28
	G. Claim 7 must be construed consistent with claim 1	30
VI.	Niu is not analogous prior art, and even if it were it does not teach the “determining whether there is data stored in a message 3 buffer” limitation.....	32
	A. Niu is not analogous art.....	33
	B. Petitioners misquote Niu, obscuring their failure to show that Niu meets the “determining” limitation	36
	C. There is no motivation to combine Niu’s wired system with the ’236 Patent’s wired system	38
VII.	The Kitazoe reference is unavailing under the correct claim construction because Petitioners extract teachings from Kitazoe that it does not contain	39
VIII.	Ground 2 fails because it depends on the incorrect analysis found in Ground 1	45

IX. Conclusion45

Patent Owner Evolved Wireless, LLC submits this Response to the above-captioned Petition for *Inter Partes* Review of U.S. Patent No. 7,811,236 (“Pet.,” Paper 2).

I. Introduction

The challenged claims of the ’236 patent are valid. Regardless of the claim construction the Board adopts, the Petition’s Niu reference, Exhibit 1012, is not analogous prior art. This reference underlies both Grounds, and therefore all Grounds fail.

Moreover, the Board instituted trial in this matter using a claim construction at odds with the understanding a person of ordinary skill (“POSA”). Expert testimony confirms that the claims at issue are drafted in what a POSA would call a “if condition then action1 else action2” formulation. The testimony further establishes that the construction for such language forbids carrying out action2 when the stated condition calls for action1 to be occur. The Board’s initial construction, therefore, is too broad. Further underscoring POSA’s proper reading of the claims is the *expressio unius* principle, which, as discussed in more detail below, was recently confirmed, post-Institution, by the Office’s grant of a continuation patent of the ’236 patent.

In view of the proper “only if”/ “only when” construction, Petitioner has reached unfounded conclusions regarding the disclosure of Petitioners’ primary reference (Kitazoe reference, Exhibit 1005). While Kitazoe’s teachings are not inconsistent with Petitioners’ argument, an analysis of the problem the ’236 patent

inventors addressed demonstrates that Petitioners' conclusions about Kitazoe are unsupported.

Accordingly, pursuant to the proper claim construction, the Petition should be rejected and no challenged claims should be cancelled.

II. The State of the art

The '236 patent is titled, "Data Transmission Method and User Equipment for the Same" and generally describes a method "for efficiently transmitting data stored in a message 3 (Msg3) buffer and a user equipment" in a mobile communication system such as a Long Term Evolution ("LTE") system developed and standardized in the 3rd Generation Partnership Project ("3GPP"). Ex. 1001, Abstract, (54), 1:17-32.

Figure 1 below is an annotated version of the '236 patent's Fig. 5. Fig. 5 illustrates communication between a UE (*e.g.*, a mobile telephone) and a base station (*e.g.*, a cell phone tower). Cooklev at ¶ 35-37.¹ In particular, Fig. 5 illustrates a "random access procedure" between a UE and a base station used, for example, to enable the UE to obtain initial access to the base station. Ex. 1001 at 3:45-49. Fig. 5 (the basis for the annotated in Figures 1-3 herein) illustrates a contention-based random access procedure. *Id.* at 6:53-55. In Figures 1-3 below, time increases along the downwards direction.

¹ "Cooklev" refers to the Declaration of Dr. Todor Cooklev, Ex. 2011.

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