

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE (USA) INC.,

Petitioner

v.

FUNDAMENTAL INNOVATION SYSTEMS INTERNATIONAL LLC,

Patent Owner

REQUEST FOR REHEARING ON ORDER DENYING INSTITUTION

Case No. IPR2018-00274
Patent 7,834,586 B2

Before BRYAN F. MOORE, JON B. TORNQUIST, AND
ARTHUR M. PESLAK, *Administrative Patent Judges*

I. Introduction

Petitioner ZTE (USA) Inc. (“Petitioner”) respectfully requests rehearing on the Board’s decision denying institution of an *inter partes* review of claims 8, 9, 11, and 13 of U.S. Patent No. 7,834,586 (Ex. 1001, “the ’586 patent”). *See* Paper 20 (“Denial Order”) at 19. The Board declined to institute review based solely on a determination “that Petitioner fail[ed] to adequately explain . . . why one of ordinary skill in the art . . . would not simply use a standard USB controller chip” and therefore determined that Petitioner’s arguments rely on improper hindsight. Denial Order at 17-18. In arriving at this erroneous conclusion, the Board misapprehended Petitioner’s actual combination and faulted Petitioner for failing to explain a combination that it never presented, thus imposing a legally improper burden on Petitioner. Under a correct understanding of Petitioner’s combination, the Petition presented a sufficient rationale, and the combination was not the result of hindsight. For the reasons that follow, Petitioner respectfully requests rehearing and that the Board institute review.

II. Argument

Respectfully, the Board misunderstood Petitioner's two-reference obviousness combination and erroneously expected Petitioner to provide reasons for making a combination that Petitioner never asserted. The Petition identified U.S. Patent No. 5,925,942 (Ex. 1005, "Theobald") as the primary reference and explained how it would have been obvious to make minor modifications to Theobald in view of teachings in U.S. Patent No. 6,625,738 (Ex. 1006, "Shiga"). Petitioner explained why it would have been obvious to replace Theobald's J3-style connector with the well-known USB-style connector, as was explicitly taught in Shiga. The Board faulted Petitioner for failing to explain why a physical connector would be replaced with a USB connector *without also* replacing the software signaling protocols from the USB 2.0 Specification, typically implemented in a standard USB controller chip. Denial Order at 17-18. But this explanation was unnecessary because using a USB-style hardware connector does not dictate what software signaling interface must be used, and Petitioner never argued as much. Indeed, the hardware requirements of a USB connector (dimensions, number of pins, etc) are independent from the software requirements (*i.e.*, the signaling protocols). As Petitioner explained, Theobald itself provides a motivation for replacing its physical connector with other known connector styles,

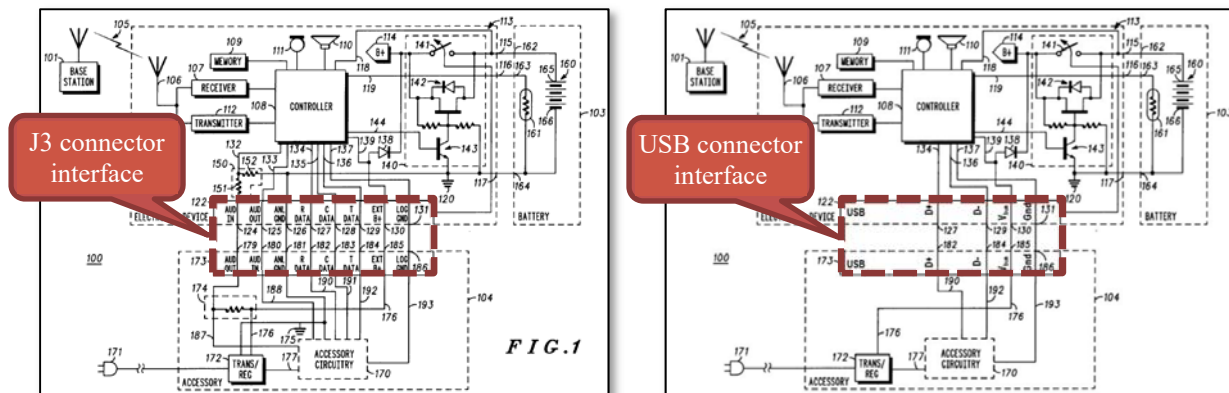
and the USB-connector style was an obvious choice because of its broad industrial application.

A. The Board Misapprehended Which Combination of Prior Art Teachings Were Presented in the Petition

The Board appears to have misunderstood Petitioner's combination of Theobald and Shiga by assuming that Petitioner intended to wholesale replace Theobald's system with the entire USB specification. This was not Petitioner's combination. The Petition combined Theobald with two teachings from Shiga: (1) the physical USB connector and (2) Shiga's "fourth mode" signaling protocol, which itself departed from the USB specification. Pet. at 33. The Petition explained it would have been obvious for a POSITA to modify Theobald with Shiga's teachings by: (1) replacing the physical J3-style connector with a USB-style connector and (2) replacing the "predefined identification information" with Shiga's "forth mode" signaling protocol. The combination's "remaining structural elements and their connections are identical to those in Theobald's controller embodiment." Pet. at 35.

Nothing in the Petition indicates the combination intended to incorporate into Theobald anything more from the then-existing USB 2.0 specification than a

physical USB connector.¹ The Petition is clear that one of skill in the art would have been motivated to replace the J3 connector of Theobald with the USB connector taught in Shiga, and that this substitution was a modification to the connector taught in Shiga, and that this substitution was a modification to the physical style of the connector, nothing more. As shown in Petitioner's illustration of the Theobald/Shiga combination, only the USB-style connector was swapped in for the J3-style connector, and Theobald's logic circuitry remains:



Theobald, Fig. 1

Theobald/Shiga Combination, Pet. at 34

¹ The USB 2.0 standard describes both the shape/style of the physical connector and the logical signaling requirements (Pet. at 11-21), but the Petition only combines USB's physical connector, not all of its signaling requirements. The Petition uses the term "connector" and "interface" to describe the physical connections between the electrical device 102 and accessory 104. Pet. at 33-43. Had the Petition intended to refer to incorporating *all* of the logical signaling requirements from the USB specification, it would have used the term "USB standard" or "USB specification," as it did elsewhere. *See, e.g.*, Pet. at 11-21 (describing the history of the USB standards).

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