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September 2, 2014

BY ECF

The Honorable Richard G. Andrews
J. Caleb Boggs Federal Building
844 N. King Street
Unit 9
Room 6325
Wilmington, DE 19801-3555

Re: InterDigital Comm., Inc. et al. v. Nokia et al. C.A. No. 13-00010 RGA

Dear Judge Andrews:

Pursuant to footnote 5 of the Order on Motions in Limine (Docket No. 339) and as discussed at the final Pre-Trial Conference, InterDigital submits the USPTO's decision denying institution of an *inter partes* review of the '151 patent ('151 IPR Denial) and provides relevant authority establishing its admissibility as evidence in this case.

- **The '151 IPR Denial is a final decision**

The '151 IPR Denial is a final decision. A decision by the USPTO, through the Patent Trial and Appeals Board (PTAB), concerning "whether to institute an inter partes review under this section shall be final and nonappealable." 35 U.S.C. §314(d); *see also St. Jude Medical, Cardiology Division v. Volcano Corp.* 749 F.3d 1373, 1375 (Fed. Cir. 2014)(holding that §314(d) "provides no authorization to appeal a non-institution decision[.]"); *Dominion Dealer Solutions, LLC, v. Michele K. Lee*, No. 3:13CV699 (E.D. Va. Apr. 18, 2014)(dismissing action seeking review of decisions not to institute *inter partes* review.) Thus, the '151 IPR Denial is final.

- **The '151 IPR Denial was on the merits**

The '151 IPR Denial was based on the merits of the underlying petition. The '151 IPR Denial is a 20-page decision by the PTAB analyzing much of the same prior art and many of the same arguments being advanced by Nokia in this case. *See* Ex. 1, Decision Denying Institution of *Inter Partes* Review. The PTAB fully analyzed the '151 patent and interpreted the claims in the '151 IPR Denial, generally giving the claims their broadest reasonable interpretation. *Id.* at 3-10. The PTAB then closely analyzed the Siemens 004 reference – the reference that is the sole

remaining basis of Nokia's inequitable conduct defense – and affirmatively determined that Siemens 004 does not anticipate the claims of the '151 patent. *Id.* at 10-18. The PTAB further analyzed Siemens 004 reference in view of other prior art asserted in this case, and affirmatively determined that none of the combinations rendered the claims of the '151 patent obvious. *Id.* at 18-19.[1] The PTAB thus addressed the merits of the prior art when it issued the '151 IPR Denial. *See, e.g., The Proctor & Gamble Co. v. Team Tech. Inc.*, No. 12-cv-552 at 21-24 and 77 (S.D. Ohio, July 3, 2014)(Granting partial summary judgment of no invalidity based in part on PTAB's denial of petition for inter partes review).

- **The '151 IPR Denial is part of the prosecution history**

The '151 IPR Denial is unquestionably part of the prosecution history. *See* Opposition to Defendant's Motion in Limine #3, Ex. 1 (docket of the PTO prosecution file history for the '151 Patent, including the July 7, 2014 Denial of IPR Trial Request). This is consistent with the USPTO's rules requiring that a "concluded reexamination file . . . containing the request and the decision denying the request becomes part of the patent's record," even though no reexamination certificate issues. *See* Ex. 4, MPEP § 2247, at 2200-68 (ex parte); Ex. 5, MPEP § 2647, at 2600-42 (inter partes). The Federal Circuit has confirmed this and the Delaware courts have followed it. *CR Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 861, 866-69 (Fed. Cir. 2004) (considering both the "initial examination" and "reexamination" of the patent-in-suit as part of the "prosecution history" that comprises the "intrinsic record"); *St. Clair Intellectual Property Consultants, Inc. v. Matsushita Elec. Indus. Co.*, 691 F. Supp. 2d 538, 550 (D. Del. 2010) ("[S]tatements made during a reexamination" are part of intrinsic record).

A final decision on a petition for an IPR is treated no differently. *See Intellectual Ventures I LLC v. PNC Fin. Servs. Grp., Inc.*, No. 14-cv-0832, 2014 WL 3942277, at *2 (W.D. Penn. Aug. 12, 2014) (noting IPR and CBM proceedings "will become part of the intrinsic records of the patents").

- **The '151 IPR Denial is necessary to respond to Nokia's claim that Siemens 004 was never considered by the USPTO**

Nokia has indicated that it intends to argue that certain prior art, including Siemens 004, was not considered by the USPTO. Therefore, the jury is entitled to hear that the USPTO, through the PTAB, considered and rejected some of the exact same arguments regarding some of the exact same prior art, including Siemens 004, as will be proffered by Nokia at trial. *See Sciele Pharma Inc. v. Lupin Ltd.*, 684 F.3d 1253, 1260-61 (Fed. Cir. 2012)("Whether a reference was before the PTO goes to the weight of the evidence, and the parties are of course free to, and generally do, make these arguments to the fact finder.")

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[1] The Court commented on the qualifications of the Administrative Patent Judges that performed the analysis in the '151 IPR Denial, suggesting that they are not persons of ordinary skill in the art. An APJ must have both a law degree and a technical degree. *See* Ex. 2, USPTO online job positing for Administrative Patent Judge ("Key requirements: Proof of bachelor or higher technical degrees and law degrees."); Ex. 3, USPTO Recruitment Brochure at 2 ("Basic Qualifications: Degree(s)/work experience in science or engineering")

- **The full prosecution history of the ’151 patent should be considered by the jury**

The full prosecution history of the ’151 patent, including the ’151 IPR Denial, should be considered by the jury. The Federal Circuit has found reversible error for failure to “give any credence to the PTO reexamination proceeding, which upheld the validity of claims 1 and 6 despite the presence of much of the same art as was before the district court.” *Custom Accessories v. Jeffrey-Allan Indus.*, 807 F.2d 955, 961 (Fed. Cir. 1986). The ’151 IPR Denial held that there was not even a reasonable likelihood that Siemens 004, alone or in combination with other references, would invalidate the claims of the ’151 patent. This finding should be before the jury, and it would be error to exclude it.

Allowing the jury to consider the ’151 IPR Denial is consistent with the treatment of reexamination proceedings in Delaware. *Pegasus Dev. Corp. v. Directv, Inc.*, No. 00-1020-GMS, 2003 WL 21105073 (D. Del. 2003) (“Moreover, the court notes that if, after reexamination, the plaintiffs’ patents are again upheld, the plaintiffs’ rights will only be strengthened, as the challenger’s burden of proof becomes more difficult to sustain.”) (citing *Custom Accessories*) (granting stay pending reexamination); *see also E.I. du Pont de Nemours v. Polaroid Graphics*, 706 F. Supp. 1135, 1141 & n.8 (D. Del. 1989) (noting that “‘the exhaustive consideration given the prior art by the PTO during [reexamination] ***must be weighed*** in determining patentability.’”) (alteration in original and footnote omitted, emphasis added) (quoting *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1558 (Fed. Cir. 1985)).

Respectfully,

/s/ Neal C. Belgam

Neal C. Belgam (No. 2721)

NCB/jcb

Enclosures

cc: Clerk of Court (*by efile*)
All counsel of record (*by efile and email*)

EXHIBIT 1

Trials@uspto.gov
571-272-7822

Paper 11
Entered: July 7, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZTE CORPORATION and ZTE (USA) INC.,
Petitioner,

v.

INTERDIGITAL TECHNOLOGY CORPORATION,
Patent Owner.

Case IPR2014-00275
Patent 7,941,151 B2

Before SALLY C. MEDLEY, MIRIAM L. QUINN, and BEVERLY M. BUNTING, *Administrative Patent Judges.*

BUNTING, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

ZTE Corporation and ZTE (USA) INC. ("Petitioners") filed a Petition requesting an *inter partes* review of claims 1-6, 8, 9, 16-21, 23, and 24 of U.S. Patent No. 7,941,151 (Ex. 1001, "the '151 patent") pursuant to 35 U.S.C. §§ 311-319. Paper 1 ("Pet"). Patent Owner, InterDigital Technology Corp. ("Patent Owner"), filed a Preliminary Response to the Petition on April 17, 2014. Paper 9. ("Prelim. Resp.") We have jurisdiction under 35 U.S.C. § 314.

II. BACKGROUND

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides as follows:

> THRESHOLD – The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Petitioner asserts that claims 1-6, 8, 9, 16-21, 23, and 24 (i.e. "the challenged claims") are unpatentable under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).[1] Pet. 6.

Upon consideration of the Petition and Preliminary Response, we are not persuaded that there is a reasonable likelihood that Petitioner will prevail in establishing the unpatentability of the challenged claims. We,

[1] We do not consider Petitioner's allegation that "InterDigital's employees did not invent the subject matter" (Pet. 4) of the challenged claims of the '151 patent, because such matters are not within our jurisdiction under 35 U.S.C. § 311(b). Pet. 1-4.

consequently, deny the Petition and do not institute an *inter partes* review of the '151 patent based on any of the asserted grounds.

A. Related Proceedings

Petitioner asserts that the '151 patent is the subject of the following judicial or administrative matters, *Certain Wireless Devices with 3G and/or 4G Capabilities and Components Thereof*, U.S.I.T.C Inv. No. 337-TA-868; *InterDigital Commc'ns Inc. v. Huawei Techs. Co., Ltd*., Case No. 13-cv-00008-RGA (D. Del.), filed January 2, 2013; *InterDigital Commc'ns Inc. v. ZTE Corp*., Case No. 13-cv-00009-RGA (D. Del.), filed January 2, 2013; *InterDigital Commc'ns Inc. v. Nokia Corp*., Case No. 13-cv-00010-RGA (D. Del.), filed January 2, 2013; and *InterDigital Commc'ns Inc. v. Samsung Elec. Co. Ltd*., Case No. 13-cv-00011-RGA (D. Del.), filed January 2, 2013. Pet. 4.

B. The '151 Patent (Ex. 1001)

The '151 patent describes a system and method of wireless communication that provides channel assignment information used to support an uplink shared channel ("UL") and a downlink shared channel ("DL"). Ex. 1001, 1:16-20. The system includes at least one Node-B or base station that dynamically allocates radio resources for both UL and DL transmissions from and to a wireless transmit/receive unit ("WTRU") via a common control channel. *Id*. at 2:19-29. The communication of radio resource assignment information between Node-B and the WTRU includes a specific indicator of whether the radio resource assignment is for either UL or DL transmission. *Id*. at 3:40-45. The WTRU is configured to determine

whether the transmission is for assigning UL or DL radio resource assignment. *Id*. at 3:48-50. In one embodiment, the specific indicator may be contained in one or more unused bits, referred to as the impossible code combinations, in the channelization code set mapping in the current High Speed Download Packet Access (HSDPA). *Id*. at 3:51-4:3. The system may also include a radio network controller ("RNC") that controls Node-B to transmit a message to the WTRU indicating which time slots support UL channel transmission and which time slots support DL channel transmissions. *Id*. at 2:34-40.

Figure 1 of the '151 patent is reproduced below.

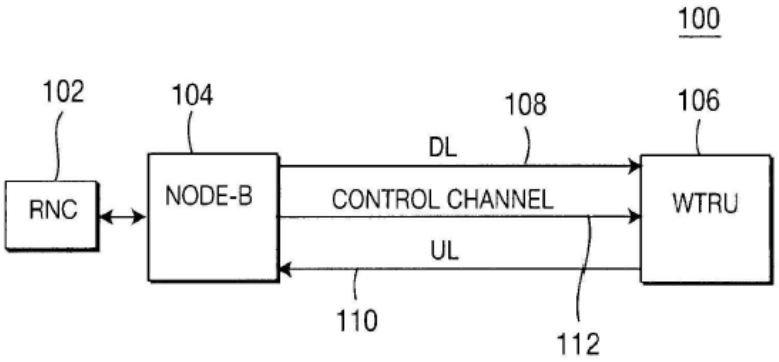

FIG. 1

Figure 1 depicts a wireless communication system showing communication between Node-B and the WTRU 106 via the control channel, DL, and UL. *Id*. at 3:24-29. The control channel transmits assignment information for both UL and DL transmissions to the WTRU from Node-B. *Id*. at 3:30-32. Downlink transmission from Node-B to the WTRU is transmitted via the DL, and uplink transmission from the WTRU to Node-B is transmitted via the UL. *Id*. at 3:26-32.

Figure 3 of the '151 patent is reproduced below.

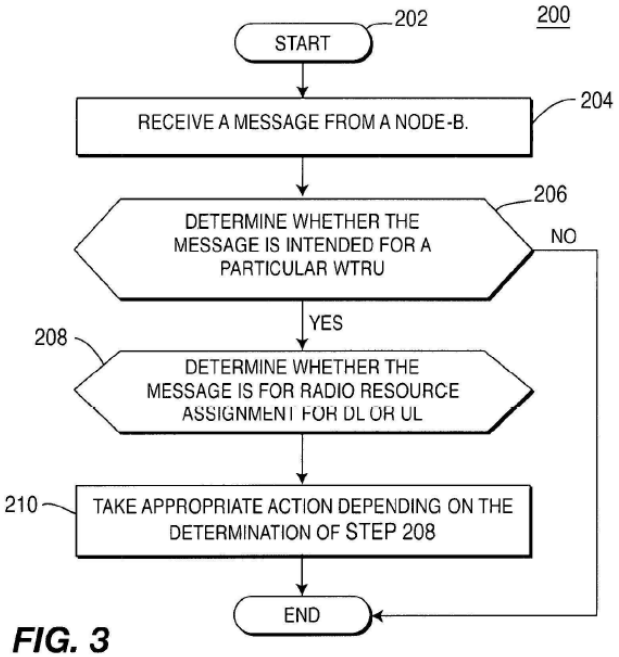

FIG. 3

Figure 3 depicts a flowchart that includes the steps of transmitting a message for radio resource assignment via the common control channel from Node-B to the WTRU, which receives and demodulates the message at step 204. *Id*. at 5:25-50. The WTRU then determines if the message is intended for the WTRU at step 206, and if the message is intended for the WTRU at step 206, another determination is made regarding whether the message is for the assignment of radio resources for DL transmission or UL transmission at step 208. *Id*. Depending on the determination made in step 208, the WTRU receives data via the DL channel or transmits data via the UL channel. *Id*.

C. Illustrative Claim

Petitioner challenges claims 1-6, 8, 9, 16-21, 23, and 24 of the '151 patent, of which claims 1 and 16 are independent. Claim 1 is illustrative of the challenged claims, and is reproduced below:

> 1. A method for utilizing channel assignment information for an uplink shared channel or a downlink shared channel, the method comprising:
>
> a wireless transmit/receive unit (WTRU) receiving downlink control information including downlink or uplink channel assignment information via a same physical downlink control channel, both downlink channel assignment information and uplink channel assignment information being received via the same physical downlink control channel;
>
> the WTRU determining whether the downlink control information is intended for the WTRU based on WTRU identity (ID)-masked cyclic redundancy check (CRC) parity bits, and if so determining whether the channel assignment information is for assigning radio resources for the uplink shared channel or the downlink shared channel; and
>
> the WTRU utilizing the radio resources for the uplink shared channel or the downlink shared channel.

D. *The Prior Art*

Petitioner relies on the following prior art references (Pet. 6) and the declaration of Dr. Vijay K. Madisetti (Ex. 1002):

References	Patents/Printed Publications	Date	Exhibit
Siemens 004	3GPP TSG RAN WG 1 #30, Tdoc R1-030004, Siemens, "Downlink Control Channel Configuration for Enhanced Uplink Dedicated Transport Channel," San Diego, USA.	January 7-10, 2003	1003

3GPP	3GPP TS 25.212 V5.2.0, 3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Multiplexing and Channel Coding (FDD) (Release 5), 2002-2009.	September, 2002	1004
InterDigital 810	TSG-RAN Working Group 1 #22, InterDigital Comm. Corp., "Implicit UE Identification for HSDPA Downlink Signaling," Torino, Italy.	August 27-31, 2001	1005
Motorola 683	ETSI SMG2 UMTS L1 Expert Group, Motorola, "Mechanisms for Managing Uplink Interferences and Bandwidth," Espoo, Finland.	December 14-18, 1998	1006
Siemens 010	3GPP TSG RAN WG1/2 Joint Meeting on HSDPA, Siemens, "Signaling Requirements for HSDPA in TDD Mode," Sophia Antipolis, France.	April 5-6, 2001	1007

E. The Asserted Grounds

Petitioner challenges claims 1-6, 8, 9, 16-21, 23, and 24 of the '151 patent based on the following statutory grounds. Pet. 6.

Reference(s)	**Basis**	**Claims Challenged**
Siemens 004	§ 102(b) or § 103(a)	1-6, 8, 9, 16-21, 23, and 24
Siemens 004 and Admitted Prior Art (APA)	§ 103(a)	1-6 and 16-21

Reference(s)	**Basis**	**Claims Challenged**
Siemens 004 and 3GPP	§ 103(a)	1-6 and 16-21
Siemens 004 and InterDigital 810	§ 103(a)	1, 2, 16, and 17
Siemens 004 and Motorola 683	§ 103(a)	8 and 23
Siemens 004 and Siemens 010	§ 103(a)	8 and 23

III. ANALYSIS

A. Claim Interpretation

In an *inter partes* review, "[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears." 37 C.F.R. § 42.100(b); *see* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,764, 48,766 (Aug. 14, 2012) (*Claim Construction*); *In re Am. Acad. of Sci. Tech. Ctr*., 367 F.3d 1359, 1364 (Fed. Cir. 2004). Under the broadest reasonable interpretation standard, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth in the specification "with reasonable clarity, deliberateness, and precision." *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner proposes using constructions from the pending district court and ITC proceedings for the following four claim terms: "same physical downlink control channel"; "channel assignment information"; "shared

channel"; and "based on WTRU identity (*ID*)-masked cyclic redundancy check (CRC) parity bits." Pet. 7-9. For three of the claim terms: "same physical downlink control channel"; "channel assignment information"; and "based on WTRU identity (ID)-masked cyclic redundancy check (CRC) parity bits;" Petitioner asserts that Patent Owner should be bound in the instant proceeding by the broad construction it has proposed in the related judicial and administrative proceedings. Pet. 7-10. However, Petitioner does not proffer specific arguments directed to the interpretation of these claim terms in the instant proceeding. Thus, for purposes of this decision, we do not construe expressly at this time the claim terms "same physical downlink control channel"; "channel assignment information"; and "based on WTRU identity (ID)-masked cyclic redundancy check (CRC) parity bits."

With respect to the claim term "shared channel," Petitioner argues that this term should be construed to mean a "channel that can convey information to or from a plurality of WTRUs."[2] Pet. 9. Taking the position that the term "shared channel" is properly construed as "a radio resource that can convey information to or from a plurality of WTRUs," Patent Owner points to intrinsic evidence from the surrounding claim language and specification in support of their construction. Prelim. Resp. 8. For example, the specification states that "the control channel 'conveys radio resource allocation information to a plurality of wireless transmit/receive units (WTRUs).'" *Id*. at 9, citing Ex. 1001, 1:33-36. Petitioner's bald assertion, that the Patent Owner's proposed construction from the district court and

[2] We note that the body of claim 1 refers specifically to an "uplink shared channel" or a "downlink shared channel," and not generally to a "shared channel".

ITC proceedings "is incorrect," and that there is no reason to define "shared channel" as "a radio resource" is not persuasive.[3] Pet. 9. For purposes of this decision, and based on the record before us, we adopt Patent Owner's proposed construction of the claim term "shared channel" to mean "a radio resource that can convey information to or from a plurality of WTRUs" as the broadest reasonable construction consistent with the specification.[4]

For purposes of this decision, we need not construe expressly any of the other terms in the challenged claims at this time.

B. Anticipation Based On Siemens 004

Petitioner challenges claims 1-6, 8, 9, 16-21, 23, and 24 as anticipated under 35 U.S.C. § 102(b) by Siemens 004, or alternatively, as rendered obvious under 35 U.S.C. § 103(a) over Siemens 004.[5] Pet. 15-33. In support thereof, Petitioner provides claim charts that identify the disclosure in Seimens 004 alleged to anticipate the subject matter in claims 1-6, 8, 9, 16-21, 23, and 24. *Id*. at 51-55. Petitioner further relies on the declaration of Dr. Madisetti to support the analysis advocated in the Petition. Ex. 1002. We have considered the arguments and evidence presented, and are not

[3] Petitioner's mere reference to claim construction arguments from another proceeding, without informing us how these arguments are relevant to the instant proceeding, are afforded minimal weight. *See* 37 C.F.R. § 42.104(b)(5).

[4] We note that our construction conforms to the definition of "shared channel" from the 3GPP Dictionary. *See* Ex. 2008, 25.

[5] While Petitioner alleges claims 1-6, 8, 9, 16-21, 23, and 24 are alternatively unpatentable under 35 U.S.C. § 103(a) over Siemens 004 (Pet. 6), Petitioner advances no separate obviousness argument in this regard. Thus, we consider Petitioner's challenge to the claims only on the basis of 35 U.S.C. § 102(b).

persuaded that Siemens teaches the "uplink shared channel," as recited in the preamble, and further in the second determining step of "whether the channel assignment information is for assigning radio resources for the uplink shared channel," as required by each of the challenged claims. A detailed analysis of our determination follows after a brief overview of Siemens 004.

1. Overview of Siemens 004 (Ex. 1003)

Siemens 004 is a feasibility study presented to the TRG-RAN Working Group 1 by Siemens, and titled "Downlink Control Channel Configuration for Enhanced Uplink Dedicated Transport Channel." Ex. 1003, 1. In particular, Siemens 004 discusses re-use of the existing High Speed Shared Control Channel (HS-SCCH) also for downlink control information of the enhanced uplink dedicated transport channel (EU-DCH). *Id.* Siemens discloses that the same shared control channel may "be used for ED-DCH and HSDPA users in time multiplex." *Id*. Siemens also describes re-use of the existing HS-SCCH part 1 coding format, and more specifically the "8 unused codewords within the channelisation code-set field . . ." for EU-DCH downlink signaling. *Id*. Siemens 004 further suggests that with re-use of the HS-SCCH channel and coding format, "detection based on the implicit UE-ID and decoding of part 1 is identical for HSDPA and EU-DCH data transmission and receiver implementation is notably simplified." *Id*. at 2.

2. Claim 1

Before delving into the specific arguments regarding the limitations

allegedly taught by Siemens, we address Patent Owner's argument that Siemens 004 does not disclose the "uplink shared channel" required by each claim, but instead discloses the opposite, an uplink *dedicated* channel. Prelim. Resp. 1, 3. The term "uplink shared channel" is initially found in the preamble of claim 1, which recites "[*a*] *method for utilizing channel assignment information for an uplink shared channel or a downlink shared channel."* Ex. 1001, 5:58-60 (emphasis added).

Petitioner relies on the definitions of "uplink channel" and "shared channel" proffered by Dr. Madisetti to support their argument that Siemens 004 discloses the preamble of claim 1, and in particular that the EU-DCH of Siemens 004 discloses the recited "uplink shared channel." Pet. 18-21; citing Ex. 1002 ¶ 157-159. According to Dr. Madisetti, the EU-DCH described in Siemens 004 "is an 'uplink channel' because it is a channel used to convey information from a handset to a base station. In addition, the EU-DCH is a 'shared channel' because it can convey information from a plurality of handsets." Ex. 1002 ¶ 159.

Pointing to the definitions of "dedicated channel" and "shared channel" from the 3GPP Dictionary in support of their position, Patent Owner counters that a dedicated channel is the opposite of a shared channel because "a dedicated channel is dedicated to a specific UE, whereas shared channels are dynamically shared between several UEs." Prelim. Resp. 16, citing Ex. 2008, 10, 25. Patent Owner maintains that Siemens 004 "consistently refers to an Enhanced Uplink *Dedicated* (emphasis omitted) Channel" and not "an uplink *shared* (emphasis omitted) channel," as described in the '151 patent, and that there is no disclosure in Siemens 004 that suggests that the EU-DCH channel is the same as the enhanced uplink

shared channel described and claimed in the '151 patent. Prelim. Resp. 17-18.

Patent Owner's argument has persuaded us that Petitioner has not identified sufficiently in Siemens 004 that the EU-DCH channel is the same as the claimed uplink shared channel, because the EU-DCH is described as a dedicated channel. Likewise, Dr. Madisetti, does not provide sufficient and persuasive evidence demonstrating that a person of ordinary skill in the art would have understood the Siemens 004 EU-DCH channel to be the same as the claimed uplink shared channel. *Id*. at 18, *see* Ex. 1002 ¶¶ 151-166. Indeed, Patent Owner has provided credible evidence showing that the EU-DCH channel described in Siemens 004 is not the same channel as the "uplink shared channel" recited in the preamble of claim 1.

We next consider use of the term "uplink shared channel" within the body of claim 1. In particular, the second determining limitation recites "*determining whether the channel assignment information is for assigning radio resources for the uplink shared channel or the downlink shared channel.*" Ex. 1001, 6:4-7 (emphasis added).

Petitioner argues that the second determining limitation is met because "the HS-DSCH described in Siemens 004 is a 'downlink shared channel,' the EU-DCH described in Siemens 004 is an 'uplink shared channel,' and the HS-SCCH transmits 'channel assignment information' for the HS-DSCH and EU-DCH." Pet. 26. Petitioner relies on the declaration of Dr. Madisetti to explain how

> a person of ordinary skill in the art reviewing Siemens 004 would have understood, if the channelization-code-set includes one of the 120 codewords used for HSDPA, then a WTRU could determine whether information in the HS-SCCH is for the HS-DSCH, which is the "downlink shared channel"; similarly,

> if the codeword is one of the 8 codewords not used for HSDPA, then the WTRU could determine whether information in the HS-SCCH is for the EU-DCH, which is the "uplink shared channel."

Ex. 1002 ¶ 197. Dr. Madisetti opines that Siemens 004 discloses the second determining limitation because both Siemens 004 and the '151 patent describe the use of the channelization-code-set field of the HS-SCCH to determine whether "the channel assignment information is for assigning radio resources to the HS-DSCH or the Enhanced Uplink channel . . ." and because Siemens 004 discloses "the same channels used in exactly the same way" as the '151 patent. *Id*. ¶¶ 200-203.

Patent Owner counters that Siemens 004 does not disclose the "second determining" limitation. Prelim. Resp. 18. Explaining further, Patent Owner reasons that because Siemens 004 does not disclose an "uplink shared channel," it follows that Siemens 004 does not disclose "channel assignment information . . . for the uplink shared channel." Prelim. Resp. 18. Moreover, Patent Owner contends that Siemens is silent regarding channel assignment information even for the "Enhanced Uplink **Dedicated** Channel that is disclosed." *Id*. While admitting that Siemens discloses usage of unused codewords for EU-DCH downlink signaling, Patent Owner submits that Siemens 004 does not disclose the use of codewords to provide channel assignment information for assigning radio resources for the uplink shared channel, nor in determining whether the channel assignment information is for "assigning radio resources for the uplink shared channel or the downlink shared channel." *Id*. at 19. Thus, Patent Owner suggests that the Siemens 004 EU-DCH downlink signaling need not be channel assignment information, and instead, could be other control information (i.e.

H-ARQ which relates to error correction). *Id*.

Aside from arguments made with respect to use of the claim term "uplink shared channel" in the preamble, Petitioner does not proffer additional arguments regarding further use of the claim term "uplink shared channel" in the second determining limitation. Because Petitioner failed to show, with sufficient evidence, that the EU-DCH channel from Siemens 004 is an "uplink shared channel," as used in the preamble of claim 1, Petitioner's further argument that the second determining limitation in the body of the claim is met because "the EU-DCH [channel] . . . is an 'uplink shared channel"' (Pet. 26) is likewise unpersuasive for the reasons discussed above. Thus, we agree with Patent Owner that Petitioner has not shown that Siemens 004 discloses the step of "determining whether the channel assignment information is for assigning radio resources for the uplink shared channel or the downlink shared channel," because Siemens 004 does not disclose an "uplink shared channel."

Based on the current record, we are not persuaded by Petitioner's argument that EU-DCH channel described in Siemens 004 is an "uplink shared channel," as recited in claim 1. Accordingly, Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to its contention that claim 1 is anticipated by Siemens 004.

3. Claims 2-6, and 9

Petitioner asserts that Siemens 004 discloses each of the limitations of dependent claims 2-6, including: the WTRU ID-masked CRC parity bits derived from sixteen-bit CRC of claim 2; the downlink control modulation and coding scheme information of claim 3; the downlink control modulation

information new data indicator of claim 4; the downlink control information redundancy version of claim 5; and the downlink control information hybrid automatic repeat request information of claim 6. Pet. 28-29. With respect to dependent claim 9, Petitioner asserts that Siemens 004 likewise discloses each limitation, including that the downlink control information indicates whether the channel assignment information is for the uplink shared channel or the downlink shared channel. Pet. 31-32.

As discussed above with respect to claim 1, our determination concerning the insufficiency of the evidence with respect to the uplink shared channel limitation of independent claim 1 applies equally to dependent claims 2-6, and 9. Accordingly, Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to its contention that claims 2-6, and 9 are anticipated by Siemens 004.

4. Claim 8

Claim 8 depends from claim 1 and further requires that the "physical downlink control channel carries both downlink and uplink channel assignment information simultaneously." Ex. 1001, 6:24-26 (emphasis added). Initially, Petitioner challenges whether the '151 patent discloses a physical downlink control channel that would carry both downlink and uplink channel assignment information simultaneously. Pet. 30 (citing Ex. 1002 ¶ 258). This argument is not persuasive, because it is inconsistent with the specification, which states that the common control channel occupies "a shared DL radio resource space, as defined by a set of SF-12R channelization codes, for both DL and UL transmissions simultaneously, and the WTRU 106 is configured to recognize whether a particular transmission

is intended for assigning radio resources for the DL or the UL transmissions." Ex. 1001, 3:45-50.

Next, Petitioner notes that Patent Owner may interpret claim 8 to mean that "downlink and uplink channel assignment information are received simultaneously but on different control channels," and proffers arguments directed to this interpretation. *Id*. at 30-31. Because Petitioner did not propose how the claim terms should be construed properly, as required by 37 C.F.R. § 42.100(b), and generally we interpret the claim terms according to their ordinary and customary meaning, Petitioner's arguments are unconvincing.

Based on the record before us, our determination concerning the insufficiency of the evidence with respect to independent claim 1 equally applies to dependent claim 8. Accordingly, Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to its contention that claim 8 is anticipated by Siemens 004.

5. Claims 16-21, 23, and 24

Petitioner argues that independent claim 16 is nearly identical to claim 1, but notwithstanding any differences, Siemens 004 discloses each and every limitation of claim 16 for the reasons provided with respect to claim 1. Pet. 32-33. Further, Petitioner argues that Siemens 004 discloses each and every limitation of claims 17-21, 23, and 24, which depend from claim 16, and recite the same limitations as claims 2-6 and 8-9 respectively. Pet. 33-34. Based on the record before us, our determination concerning the insufficiency of the evidence with respect to independent claim 1 equally applies to claims 16-21, 23, and 24. Accordingly, Petitioner has not

demonstrated a reasonable likelihood that it would prevail with respect to its contention that claims 16-21, 23, and 24 are anticipated by Siemens 004.

C. Obviousness Based On Siemens 004

1. Discussion Concerning the Grounds of Obviousness

Petitioner asserts additional grounds based, in part, on Siemens 004. *See* Section II(E) above. In response to these asserted grounds, Patent Owner argues that Petitioner fails to identify any disclosure in the APA, 3GPP, InterDigital 810, Motorola 683, and Siemens 010 respectively, directed to the "uplink shared channel" that is missing from Siemens 004. Neither does the Petition provide any motivation to modify Siemens 004 to include this missing element, according to Patent Owner. Prelim. Resp. 23-38.

Having considered Petitioner's arguments concerning the combination of Siemens 004 with each of the APA, 3GPP, Interdigital 810, Motorola 683, and Siemens 010, we are not persuaded that Petitioner has demonstrated a reasonable likelihood that it would prevail in demonstrating obviousness of the challenged claims. For the reasons provided above with regards to the anticipation analysis of Siemens 004, we determine that Petitioner has not demonstrated sufficiently that Siemens 004 discloses an "uplink shared channel." Moreover, Petitioner does not rely on any disclosure of the secondary references to solve the noted deficiency of Siemens 004.

Thus, we have reviewed Petitioner's evidence presented on the ground of unpatentability of the challenged claims and considered all of the arguments presented in Patent Owner's Preliminary Response. Based on the

foregoing analysis, we conclude that Petitioner has not demonstrated a reasonable likelihood that it would prevail as to its contention that claims 1-6, 8, 9, 16-21, 23, and 24 would have been obvious over the combinations of Siemens 004 with the APA; 3GPP; Interdigital 810; Motorola 683, and Siemens 010 respectively.

IV. CONCLUSION

For the foregoing reasons, we conclude that Petitioner has not demonstrated a reasonable likelihood that at least one challenged claim is unpatentable based on the asserted grounds. We, therefore, do not institute an *inter partes* review on any of the asserted grounds as to any of the challenged claims.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that an *inter partes* review as to claims 1-6, 8, 9, 16-21, 23, and 24 the '151 patent is *DENIED*.

Case IPR2014-00275
Patent 7,941,151

PETITIONER:

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EXHIBIT 2

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Dock

Overview Duties Qualifications & Evaluations Benefits & Other Info How to Apply

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Agency Contact Info

United States Patent and Trademark Office
An Agency of the Department of Commerce

Job Title: Administrative Patent Judge
Department: Department Of Commerce
Agency: Patent and Trademark Office
Job Announcement Number: PTAB-2014-0048

Job Announcement Number: PTAB-2014-0048

Control Number: 377185400

SALARY RANGE:	$135,842.00 to $167,000.00 / Per Year
OPEN PERIOD:	Friday, August 1, 2014 to Saturday, August 30, 2014
SERIES & GRADE:	AD-1222-00
POSITION INFORMATION:	Permanent - Full Time
DUTY LOCATIONS:	many vacancies in the following location: Detroit, MI View Map
WHO MAY APPLY:	Applications will be accepted from all United States Citizens and Nationals. This is a Non-bargaining position. More than one position may be filled.
SECURITY CLEARANCE:	Public Trust - Background Investigation
SUPERVISORY STATUS:	Yes

JOB SUMMARY:

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KEY REQUIREMENTS

- Complete application with all required documentation.
- Proof of bachelor or higher technical degrees and law degrees.
- Proof of active Bar Membership in good standing.
- Demonstrated ability to litigate or draft decisions around patentability.
- Being a U.S. Citizen or National.
- Writing Sample (answer to Vacancy Question 11 serves as the writing sample)

DUTIES: Back to top

An Administrative Patent Judge (APJ) serves as a member of the Patent Trial and Appeal Board (PTAB) of the U.S. Patent and Trademark Office (USPTO). The PTAB has authority to:

- Hear and adjudicate appeals from decisions of Primary Examiners as to Patentability in patent applications and reissue and re-examination of patents

- Conduct post-grant review proceedings, inter partes review proceedings, derivation proceedings, and Transitional Program for Covered Business Method Patent proceedings, and declare and conduct proceedings in legacy interferences.

As and APJ, you will be expected to:

- Formulate ideas and communicate them effectively to various stakeholders; and

- Draft decisions regarding patentability.

Though not required, PTAB prefers candidates with 10-15 years of patent experience, including those who have prosecuted and/or litigated patent cases and supervised professional IP teams and/or attorneys. Though not required, PTAB prefers candidates with experience prosecuting and/or litigating electrical, computer, mechanical or data processing patents and patent applications.

QUALIFICATIONS REQUIRED: Back to top

Experience must have been at a sufficiently high level of difficulty to clearly show that the candidate possesses the required professional and technical qualifications to litigate and/or prosecute issues and to draft decisions directed to patentability.

Experience refers to paid and unpaid experience, including volunteer work done through National Service programs (e.g., Peace Corps, AmeriCorps) and other organizations (e.g., professional; philanthropic; religious; spiritual; community, student, social). Volunteer work helps build critical competencies, knowledge, and skills and can provide valuable training and experience that translates directly to paid employment. You will receive credit for all qualifying experience, including volunteer experience.

You must meet the United States Office of Personnel Management's (OPM) qualification requirements by the closing date of this announcement. To qualify for this position, you must meet the following Qualifications:

Qualifications

IMPORTANT NOTE: You are expected to furnish all required documents to ultimately qualify for the position. Unofficial undergraduate, graduate and law degree transcripts and Bar certificates can be provided if official copies are unattainable before the closing date of the announcement. Official documents will be accepted after the application is submitted.

To be considered for this position, you must possess the following:

(A) Proof of successful completion of a full 4-year course of study in an accredited college or university leading to a bachelor's or higher degree in the study of engineering, chemistry, or biology.

For an engineering degree, the curriculum must:

1. Be accredited by the Accreditation Board for Engineering and Technology (ABET) as a professional engineering curriculum;

OR

2. Include differential and integral calculus and courses (more advanced than first-year physics and chemistry) in five of the following seven areas:
a) statics, dynamics

b) strength of materials (stress-strain relationships)

c) fluid mechanics, hydraulics

d) thermodynamics

e) electrical fields and circuits

f) nature and properties of materials (relating to particle and aggregate structure to properties)

g) any other comparable area of fundamental engineering science or physics, such as optics, heat transfer, soil mechanics or electronics

OR

(B) A combination of Education and Experience. This combination of college level education, training and/or technical experience must have furnished both:

• A thorough knowledge of the physical and mathematical sciences underlying professional engineering;

AND
• A good understanding, both theoretical and practical, of the engineering sciences and techniques and their application to professional engineering. This can be demonstrated by one of the following:

1. Professional registration-- Current registration as a professional engineer by any State, the District of Columbia, Guam or Puerto Rico.

2. Written test-- Evidence of passing the Engineer-in-Training (EIT) examination or the written test required for professional registration, administered by the Boards of Engineering Examiners in various States, the District of Columbia, Guam and Puerto Rico.

3. Specified academic courses-- Successful completion of at least 60 semester hours in the physical, mathematical and engineering sciences and including the courses specified in the basic requirements. The courses must be fully acceptable toward meeting the requirements of a professional engineering curriculum as described in paragraph A.

4. Related curriculum-- Successful completion of a curriculum leading to a bachelor's degree in engineering technology or in an appropriate professional field, e.g., physics, chemistry, biology, architecture, computer science, mathematics, hydrology, or geology, may be accepted in lieu of an Engineering degree, provided the applicant has had at least 1 year of professional engineering experience with professional engineering supervisión and guidance.

AND

(C) Proof of successful completion of a law degree (minimum: J.D. or equivalent).

(D) Proof of active membership of the Bar of any state, District of Columbia, Puerto Rico, or any U.S. territory, in good standing.

(E) Demonstration of recent, extensive and comprehensive experience with the following:

1. Evaluating combined Intellectual Property (IP) assets and providing legal advice.

2. Formulating ideas and communicating them effectively to various stakeholders via clear, logically-developed opinions and decisions regarding patentability.

3. Effectively working with others.

4. Conducting and managing patent prosecution, examination or administration which demonstrates

a thorough knowledge and application of patent laws and rules of practice.

HOW YOU WILL BE EVALUATED:

Your resume, supporting documentation and self-assessment answers will be evaluated for required competencies and specialized experience. The self-assessment questions cover the following competencies:

- Knowledge of legal matters associated with patent prosecution, examination, litigation, and administration.
- Knowledge of Patent Trial and Appeal Board jurisdiction, rules, and procedures.
- Ability to communicate effectively, orally and in writing
- Knowledge of evaluating, applying, and interpreting patent law
- Ability to lead people

Your application will then be evaluated and rated by a subject matter expert panel via federal government selection procedures.

Qualified applicants are assigned to one of these two categories:

- Best Qualified - Possessing recent exceptional experience with a background that demonstrates a superior level of knowledge, skills, abilities, and competencies required to perform the duties of the position

- Well Qualified - Possessing good recent experience with a background that demonstrates a satisfactory level of knowledge, skills, abilities, and competencies required to perform the duties of the position

To preview questions please click here.

BENEFITS:

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OTHER INFORMATION:

If you are a male applicant born after December 31, 1959, you must certify that you have registered with the Selective Service System. If you are exempt from registration under Selective Service Law, you must provide appropriate proof of exemption. Visit the Selective Service System website for details. This is a Non-Bargaining Unit position.

This is a Public Trust position and has a risk level designation of "high." Background Investigation - If selected for this position, you may be required to complete a Declaration for Federal Employment (OF-306) to determine your suitability for Federal employment by authorizing fingerprinting, a credit check and a background investigation.

Probationary Period - If selected, you will be required to complete a two-year probationary period.

Relocation incentives may be authorized.

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The Ethics in Government Act of 1978, as amended, requires senior officials in the executive, legislative and judicial branches to file public reports of their finances as well as other interests outside the Government. If selected for this position you will be required to file a Financial Disclosure Report (OGE Form 278). The OGE 278 is available to the public. The primary purpose of disclosure is to assist agencies in identifying potential conflicts of interest between a filer's official duties and the filer's private financial interests and affiliations.

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Physical Location:
Administrative Patent Judges will work from the Detroit office.

Opportunities for telework are available from all offices. Generally, telework will not be available during the first 6 – 9 months.

Some travel to USPTO Headquarters in Alexandria, VA for initial and subsequent training may be required.

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HOW TO APPLY:

All application materials become the property of the USPTO. You MUST apply online. If you need help or do not have access to a computer, contact the HR Specialist listed as the point of contact before the closing date of this job announcement.
If you have never registered for a USAJobs account, you must first create an account profile with your basic contact information and a resume. Sign in to your account to apply. For help, see the USAJobs Help Page. When you have gathered all of the required information and are ready to begin applying, click the "APPLY ONLINE" button. You will be directed away from USAJobs to the Department of Commerce's USPTO application site.

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To submit supporting documents during the Vacancy Open Period:
• Upload documents when you register with USAJobs, or update your application on the Department of Commerce application site accessed through USAJobs, OR
• Fax documents to 571-258-4052 using the system-generated fax coversheet.

Your application and all required documentation must be received by 11:59 p.m. EST on the closing date of this job announcement. Questions? Contact the HR Specialist listed on this announcement.

REQUIRED DOCUMENTS:

A complete application includes the following documents submitted BY THE CLOSING DATE of this announcement:

1. Cover Letter explaining, at a minimum, your interest in the position.

2. Resume including: • Citizenship • Job-related qualifications • Education • Work experience (including job titles, salary, employment dates, duties and accomplishments, and how any experience relates to the competencies listed in the job announcement.) Resumes should clearly address any relevant experience in electrical, computer, mechanical technologies, and/or with data processing matters.

3. Responses to self-assessment questions. Answers to questions not fully supported by your resume may result in rating adjustments. Also, any experience claimed in a cover letter should also be substantiated by your resume.

4. Education Documentation • Transcripts: Undergraduate, graduate and law school transcripts or a statement from the institution or equivalent documentation will be accepted. Inadequate or illegible information could result in non-qualification. Unofficial transcripts are acceptable for the initial application; however, if selected, you must furnish official transcripts two weeks before entrance on duty.

Transcripts must include: Applicant Name, Name of College/University, Type of Degree (e.g., Bachelor of Science), Discipline (e.g., Computer Engineering), GPA, Semester hours completed, Course names and grades • Foreign Education: Documentation for education completed outside the United States must demonstrate that the education is equivalent to that of an accredited U.S. educational institution.

5. Proof of active Bar Membership (Good Standing)

AGENCY CONTACT INFO:

Isis Thomas
Phone: 571-272-4363
Fax: 571-258-4052
Email: Isis.Thomas@uspto.gov

Agency Information:
PATENT AND TRADEMARK OFFICE
550 Elizabeth Lane
Alexandria, VA
22314
US
Fax: 571-258-4052

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EXHIBIT 3

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United States Patent and Trademark Office

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Patent Trial and Appeal Board

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Exhibit 1035-00033

The Patent Trial and Appeal Board (PTAB) provides a dynamic environment and a premier group of colleagues who work collaboratively to decide cases on the cutting edge of technology and patent law. The PTAB offers these high caliber work opportunities and allows judges to achieve work-life balance and high job satisfaction.

what is the PTAB?

Areas of the PTAB's jurisdiction include:

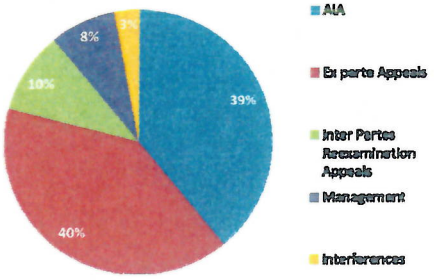
- Appeals from adverse examiner decisions in patent applications and reexamination proceedings.
- AIA trial proceedings.
- Interferences.

BASIC QUALIFICATIONS

- Many years of experience in the practice of patent law (prosecution, litigation, or both).
- Degree(s)/work experience in science or engineering.
- Preferred experience in handling of patent matters in the areas of electrical engineering, software, data processing.
- Must be able to work collaboratively (typically, in 3 judge panels).
- Must have excellent written and oral communication skills and excellent legal reasoning skills.
- Must have basic proficiency with Microsoft Office Suite, including Word and Outlook, and Adobe Acrobat.

current judge staffing

*As of April 2014



^ All judges begin with a docket of ex parte appeals. Assignments to other areas are based on need.

USPTO OFFICES NATIONWIDE

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Administrative Patent Judge Matt Clements, Silicon Valley Office

PTAB'S HIRING PROCESS

Application Review & Selection → Interviews → Recommendation to the USPTO Director → Recommendation to the Commerce Secretary → Approval by the Secretary → Notification of Selection → Preliminary Offer → Preliminary Background Check → Formal Offer (including compensation and start date) → ACCEPTANCE

Microsoft Corporation

Exhibit 1035-00034

EXHIBIT 4

requester must be filed within two weeks of the date upon which a copy of the original **37 CFR 1.181** petition was served on the third party requester to ensure consideration. It is advisable that, upon receipt and review of the served copy of such a **37 CFR 1.181** petition which the third party requester intends to oppose, the requester should immediately place a courtesy telephone call to both the CRU support staff and the CRU SPRS to notify the Office that an opposition to the **37 CFR 1.181** petition will be filed. Whenever possible, filing of the opposition should be submitted by facsimile transmission.

The filing of a **37 CFR 1.181** petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester.

III. PRIOR ART SUBMITTED AFTER THE ORDER

Any prior art citations under **37 CFR 1.501** submitted after the date of the decision on the order should be retained in a separate file by the CRU or Technology Center (TC) (usually the CRU SPRS or the TC Quality Assurance Specialist (QAS)) and stored until the reexamination proceeding is concluded, at which time the prior art citation is then entered of record on the patent file. See **MPEP § 2206**.

2247 Decision on Request for Reexamination, Request Denied [R-11.2013]

The request for reexamination will be denied if a substantial new question of patentability is not found based on patents or printed publications.

If the examiner concludes that no substantial new question of patentability has been raised, the examiner should prepare a decision denying the reexamination request. Form paragraph 22.02 should be used as the introductory paragraph in a decision denying reexamination.

¶ *22.02 No New Question of Patentability*

No substantial new question of patentability is raised by the request for reexamination and prior art cited therein for the reasons set forth below.

The decision denying the request will then indicate, for each patent and printed publication cited in the request, why the citation is:

(A) Cumulative to the teachings of the art cited in the earlier examination of the patent;

(B) Not available against the claims (e.g., the reference is not available as prior art because of its date or the reference is not a publication);

(C) Not important to a reasonable examiner in deciding whether any claim of the patent for which reexamination is requested is patentable, even though the citation is not cumulative and the citation is available against the claim; or

(D) One which was cited in the record of the patent and is barred by the guidelines set forth in **MPEP § 2242**, subsection II. A.

The examiner should also, in the decision respond to the substance of each argument raised by the requester which is based on patents or printed publications. If arguments are presented as to grounds not based on prior art patents or printed publications, such as those based on public use or on sale under **35 U.S.C. 102(b)**, or abandonment under **35 U.S.C. 102(c)** for reexamination proceedings examined under the first-to-invent prior art regime, the examiner should note that such grounds are improper for reexamination and are not considered or commented upon. See **37 CFR 1.552(c)**.

See **MPEP § 2247.01** for an example of a decision denying a request for reexamination. The example in **MPEP § 2247.01** is drafted for the case where the "request indicates that Requester considers that Claims 1-2 are unpatentable over Smith taken with Jones." There may, however, be a request **that does not indicate the claims to be unpatentable over the art**, but rather that a substantial new question of patentability is raised by the art. This may occur, for example, in a patent owner request filed to address prior art that raises a substantial new question of patentability but the claims are still patentable over the art. **In such an instance**, the decision on the request should not state that the "request indicates that Requester considers that Claims 1-2 are unpatentable over Smith taken with Jones." Rather, it should state that the "request indicates that Requester considers that a substantial new question

of patentability is raised as to Claims 1-2 based on Smith taken with Jones."

The decision denying a request for reexamination is mailed by the Central Reexamination Unit (CRU)), and the CRU will allow time for a petition seeking review of the examiner's determination refusing reexamination. If such a petition is not filed within one (1) month of the examiner's determination denying reexamination, the CRU then processes the reexamination file to provide the partial refund set forth in **37 CFR 1.26(c)** (the Office of Finance no longer processes reexamination proceedings for a refund). The reexamination proceeding is then given a 420 status. A copy of the PALM "Application Number Information" screen and the "Contents" screen is printed, the printed copy is annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy is then scanned into IFW using the miscellaneous letter document code.

The concluded reexamination file (electronic or paper) containing the request and the decision denying the request becomes part of the patent's record.

PROCESS OF PREPARING THE DECISION DENYING THE REQUEST

If the examiner's position is to deny reexamination, the examiner will prepare for and set up a panel review conference as per **MPEP § 2271.01**, to discuss the issuance of a decision denying reexamination. The examiner may prepare the decision after the conference, or may prepare the decision and revise it as needed after the conference.

The conference will be conducted. If the conference confirms the examiner's preliminary decision not to grant reexamination, the decision denying reexamination will be completed and signed by the examiner, with the two or more other conferees initialing the action (as "conferee") to indicate their presence in the conference. A transmittal form PTOL-465 with the third party requester's address will be completed, if a copy for mailing is not already available. The transmittal form PTOL-465 is used to forward the decision to the third party requester. The use of this form removes the need to retype the third party requester's address each time a mailing is required. In conjunction with the mailing, any appropriate processing (e.g., PALM work, update scanning) is carried out by the staff of the CRU.

2247.01 Examples of Decisions on Request for Reexamination [R-11.2013]

Examples of decisions on requests for *ex parte* reexamination are provided below. The first example is a grant of an *ex parte* reexamination. The second example is a denial of an *ex parte* reexamination. The examiner should leave the paper number blank since IFW files do not have a paper number.

Example (1): Decision Granting Request for Reexamination

EXHIBIT 5

1.181(a)(3) exist to vacate the order granting reexamination where, for example:

(A) the reexamination order is facially not based on prior art patents or printed publications;

(B) reexamination is prohibited under 37 CFR 1.907;

(C) all claims of the patent were held to be invalid by a final decision of a Federal Court after all appeals;

(D) reexamination was ordered for the wrong patent; or

(E) reexamination was ordered based on a duplicate copy of the request.

While a patent owner may file a petition under 37 CFR 1.181(a)(3) to vacate a reexamination order as " *ultra vires*," such a petition should be rare, and will be granted only in the extremely rare situation where the Office acted in "brazen defiance" of its statutory authority in granting the reexamination order. See *Heinl*, 143 F. Supp. 2d at 601-02. This occurs only where the Office applied the wrong standard in ordering reexamination; a petition is not to be filed to challenge the Office's application of the correct standard, since such is barred by statute. See 35 U.S.C. 312(c). (Petitions to vacate a reexamination order are delegated to the Director of Central Reexamination Unit (CRU)).

When a petition under 37 CFR 1.181 is filed to vacate a reexamination order, the third party requester may file a single submission in opposition to the petition. Because reexamination proceedings are conducted with special dispatch, 35 U.S.C. 314(c), any such opposition by the third party requester must be filed within two weeks of the date upon which a copy of the original 37 CFR 1.181 petition was served on the third party requester to ensure consideration. It is advisable that, upon receipt and review of the served copy of such a 37 CFR 1.181 petition which the third party requester intends to oppose, the requester should immediately place a courtesy telephone call to the CRU SPRS to notify the Office that an opposition to the 37 CFR 1.181 petition will be filed. Whenever possible, filing of the opposition should be submitted by facsimile transmission.

The filing of a 37 CFR 1.181 petition to vacate an *ultra vires* reexamination order is limited to a single submission, even if an opposition thereto is filed by a third party requester.

III. PRIOR ART SUBMITTED AFTER THE ORDER

Any prior art citations under 37 CFR 1.501 submitted after the date of the decision ordering *inter partes* reexamination should be retained in a separate file by the Technology Center (TC) (usually the TC Quality Assurance Specialist (QAS)) and stored until the reexamination proceeding is concluded, at which time the prior art citation is then entered in the record of the patent file. See MPEP § 2206. Note that 37 CFR 1.902 governs submissions of prior art that can be made by *patent owners* and *third party requesters* after reexamination has been ordered.

2647 Decision Denying Reexamination [R-11.2013]

The request for reexamination will be denied if a SNQ/RLP is not found based on patents or printed publications.

If the examiner concludes that no SNQ/RLP has been raised, the examiner should prepare a decision denying the reexamination request. Form paragraph 26.02 should be used as the introductory paragraph in a decision denying reexamination.

For a request filed prior to September 16, 2011, the following version was to be used:

Former ¶ 26.02 No New Question of Patentability

No substantial new question of patentability is raised by the present request for *inter partes* reexamination and the prior art cited therein for the reasons set forth below.

For a request filed beginning September 16, 2011 and ending September 15, 2012, the following version is used:

¶ *26.02 No reasonable likelihood established*

For the reasons set forth below, the present request for *inter partes* reexamination fails to establish a reasonable likelihood that requester

will prevail with respect to at least one of the challenged claims of United States Patent Number **[1]**.

The decision denying the request will then indicate, for each patent or publication cited in the request, why a SNQ/RLP has not been established by the request, for that citation.

The examiner should also, in the decision, respond to the substance of each argument raised by the third party requester which is based on patents or printed publications.

If arguments are presented as to grounds not based on prior art patents or printed publications, such as those based on public use or on sale under **35 U.S.C. 102(b)**, or abandonment under **35 U.S.C. 102(c)**, the examiner should note that such grounds are improper for reexamination and are not considered or commented upon. See **37 CFR 1.906(c)**.

See **MPEP § 2647.01** for an example of a decision denying a request for *inter partes* reexamination which was filed prior to September 16, 2011 (when the SNQ standard was applied).

The decision denying the request is mailed by the Central Reexamination Unit (CRU), and the CRU will allow time for petition seeking review of the examiner's determination refusing reexamination. If such a petition is not filed within one (1) month of the examiner's determination denying reexamination, the CRU then processes the reexamination file to provide the partial refund set forth in **37 CFR 1.26(c)** (the Office of Finance no longer processes reexamination proceedings for a refund).

The reexamination proceeding is then given a 420 status in the Office's PALM system. A copy of the PALM "Application Number Information" screen and the "Contents" screen is printed, the printed copy is annotated by adding the comment "PROCEEDING CONCLUDED," and the annotated copy is scanned into IFW using the miscellaneous letter document code.

The concluded reexamination file (electronic or paper) containing the request and the decision denying the request becomes part of the patent's record.

PROCESS OF PREPARING THE DECISION DENYING THE REQUEST

If the examiner's position is to deny reexamination, the examiner prepares for and sets up a panel review conference as per **MPEP § 2671.03**, to discuss the issuance of a decision denying reexamination. The examiner may prepare the decision after the conference, or may prepare the decision prior to the conference and revise it, as needed.

If the conference confirms the examiner's preliminary decision not to grant reexamination, the decision denying reexamination is completed and signed by the examiner, with the two or more other conferees initialing the action (as "conferee") to indicate their presence in the conference. A transmittal form PTOL-501 with the third party requester's address is completed, if a copy for mailing is not already available. The transmittal form PTOL-501 is used to forward the decision to the third party requester. The use of this form removes the need to retype the third party requester's address each time a mailing is required.

2647.01 Examples of Decisions on Requests [R-11.2013]

Examples of decisions on requests for *inter partes* reexamination for requests filed prior to September 16, 2011 (when the SNQ standard was applied), are provided below. The first example is a **grant** of an *inter partes* reexamination. The second example is a **denial** of an *inter partes* reexamination. The examiner should leave the paper number blank, since IFW files do not have a paper number.