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September 5, 2014

***By ECF***

The Honorable Richard G. Andrews  
The District Court for the District of Delaware  
844 N. King Street  
Wilmington, Delaware 19801

**Re: *InterDigital Comm., Inc. et al. v. Nokia et al.*  
C.A. No. 13-010-RGA**

Dear Judge Andrews:

Plaintiffs InterDigital Communications, Inc., InterDigital Technology Corporation, IPR Licensing, Inc. and InterDigital Holdings, Inc. (“InterDigital”) hereby respond to Defendants Nokia Corp., Nokia Inc. and Microsoft Mobile Oy’s (“Defendants”) September 4, 2014 letter (“Letter”) regarding the USPTO’s decision denying institution of an *inter partes* review of the ‘151 patent (‘151 IPR Denial). InterDigital is responding to several misstatements of law and fact, as well as new issues raised by Defendants’ in their Letter.

**A. The ‘151 IPR Denial is A Decision on the Merits**

Defendants state that the ‘151 IPR Denial is not a decision on the merits. Defendants are wrong. There is no effective difference between the “reasonable likelihood of success” standard for institution of an IPR and the patentability standard. An IPR is instituted upon a showing that “there is a ***reasonable likelihood*** that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. §314(a)(emphasis added). If the petition fails to meet this low threshold, this means the Patent Office reviewed the evidence and argument presented in the petition and determined there is not even a reasonable likelihood that the petitioner could prevail on its assertion that the challenged patent claims are not patentable. *See* 35 U.S.C. §318(a)(The Patent Trial and Appeals Board (“PTAB”) issues “a final written decision with respect to the patentability of any patent claim challenged by the petitioner.”). Therefore, a decision whether to institute a petition necessarily involves a decision regarding the patentability of the challenged claims.

Contrary to Defendants’ Letter, the ‘151 IPR Denial did in fact address the obviousness of the claims of the ‘151 patent in view of Siemens 004

**Microsoft Corporation**  
**Exhibit 1036-00001**

combined with other prior art. Specifically, the '151 IPR Denial states that "[h]aving considered Petitioner's arguments concerning the combination of Siemens 004 with each of the APA [Admitted Prior Art], 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." Ex. 1, Decision Denying Institution of *Inter Partes* Review at 18. The PTAB could not have been clearer that it considered, and rejected, the arguments that the claims of the '151 patent were obvious in light of Siemens 004 in combination with other prior art.<sup>1</sup>

Defendants also incorrectly assert that the '151 IPR Denial is not a decision on the merits because "the PTAB's decision was based on a construction of 'shared channel' that was *explicitly rejected by the Court*." Defendants are wrong. The term "shared channel" was neither argued in front of the Court, nor addressed in the claim construction opinion and order. Memorandum Opinion on Claim Construction (D.I. 253, April 22, 2014); Claim Construction Order (D.I. 224, April 29, 2014). Instead, the parties *agreed* to a construction of "shared channel," notifying the Court of the same in a May 2, 2014 letter. More importantly, the issues in the '151 IPR Denial focused on whether the uplink channel in Siemens 004 was "shared." Under either the agreed construction or that used by the PTAB, the word "shared" as used in the phrase "shared channel" has exactly the same meaning. Compare, "channel that can convey information to or from a plurality of WTRUs" (May 2, 2014 Letter (D.I. 261) at 1) and "a radio resource that can convey information to or from a plurality of WTRUs" (Ex. 1, Decision Denying Institution of *Inter Partes* Review at 10). Nokia did not argue prejudice arising from any differences in the two constructions because there is none. Any differences are insubstantial and irrelevant just as much here as they were in the '151 IPR Denial.

## **B. The '151 IPR Denial is Part of the Prosecution History**

Defendants' Letter ignores that the USPTO considers the '151 IPR Denial as 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). The PTAB's comments in *ScentAir Techs. Inc. v. Prolitec, Inc.* that an IPR is not examination are not to the contrary. Examination is not the only part of the intrinsic record of the prosecution history, as recognized by courts. *Intellectual Ventures I LLC v. PNC*

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<sup>1</sup> Defendants' allegation that the PTAB did not address obviousness is wrong. Without informing the Court, Defendants quoted from a portion of the IPR Denial where the Patent Office refused to consider obviousness based on Siemens 004 *alone* because Petitioner had failed to advance any arguments of obviousness based on Siemens 004 *alone*. See Ex. 1, Decision Denying Institution of *Inter Partes* Review at 10, n. 5. The Petitioner, however, did offer evidence and arguments of obviousness based on Siemens 004 in combination with other prior art, and that evidence and those arguments were expressly considered and found wanting by the Patent Office.. *Id.* at 18-19.

*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 case law cited by Defendants is inapposite. In quoting from footnote 31 in *Sigram*, Defendants neglected to include the next sentence, which states that “[a]s the [interim] rejections on reexamination **are not binding**, they are generally not relevant to the issues to be tried.” *Sigram Schindler Beteiligungsgesellschaft mbH v. Cisco Sys., Inc.* Nos. 09-72-SLR, 09-232-SLR, 2010 WL 2977552, at \*416, n.31 (D. Del. July 26, 2010)(emphasis added). In *SRI Int’l Inc. v. Internet Sec. Sys. Inc.*, the court noted that “[a]bsent unusual circumstances, none of which were presented here, **non-final** decisions made during reexamination are not binding”, where non-binding decisions were those “not vetted by the Federal Circuit.” 647 F. Supp. 2d 323, 356, n. 39 (D. Del. 2009). Thus, both deal with reexamination proceedings that **were not yet final**. This is not the case with the ‘151 IPR Denial, as it is a final decision that is non-appealable.

Further, in noting that it “typically does not admit evidence of reexamination proceedings at trial,” the court in *Boston Scientific Corp. v. Johnson & Johnson Inc.* requested that the parties “be prepared to address, at the pre-trial hearing, the admissibility of [a witness’] statements (cited by BSC) made during the co-pending reexamination for impeachment purposes.” 679 F.Supp. 2d 539, 548, n.12 (D. Del. 2010). There is no indication about the status of the reexamination proceeding or whether these statements were precluded or not by that court.

**C. The ‘151 IPR Denial is relevant and Probative to Defendants’ Defenses**

Defendants’ arguments that the USPTO did not fully consider Siemens 004 are wrong. The 20 page decision of the ‘151 IPR Denial demonstrates that the USPTO expressly considered the Siemens 004 reference, both alone and in combination with other prior art. Defendants’ arguments that anticipation is not obviousness are irrelevant. As noted *supra*, the ‘151 IPR Denial expressly addresses whether the challenged claims of the ‘151 patent were obvious in light of Siemens 004 and other prior art. Ex. 1, Decision Denying Institution of *Inter Partes* Review at 18-19. Defendants’ assertions to the contrary are wrong. Because Siemens 004 was considered, both alone and in combination with other prior art, the ‘151 IPR Denial is relevant to show that the USPTO has considered the Siemens 004 reference.

**D. Admission of the ‘151 IPR Denial Would Not Expand the Scope of the Case**

Defendants’ assertion that InterDigital withheld key evidence from the

PTAB is wrong. Despite being aware of the ‘151 IPR Denial, as well as InterDigital’s intention to refer to the ‘151 IPR Denial, since at least July 21, 2014, Defendants only now raise these allegations and demand discovery. These allegations are not pleaded in Defendants’ answer, nor set forth in any contentions at any point in this case. Thus, Defendants have waived raising this issue at this late stage in the litigation.

Even if it is appropriate to raise the issue at this late date, Defendants inaccurately characterize the law governing *inter partes* review proceedings. Section 1.56 of 37 C.F.R., which is the regulatory basis for inequitable conduct claims, specifically does not apply to post grant proceedings. 77 Fed. Reg. 48638 (“[IPR] Proceedings, not being applications for patents, are not subject to §1.56.”)(Response to Comment 105). Further, 37 C.F.R. § 42.51 relates to discovery obligations, which are generally effective only upon institution of an *inter partes* review. See, e.g., 77 Fed. Reg. 48637 (“Scheduling Order [issued after institution] will authorize the patent owner to begin taking routine discovery” but “additional discovery may be authorized [by the PTAB] prior to institution.”)(Response to Comment 102). No discovery was exchanged or authorized by the PTAB during the pendency of the petition that resulted in the ‘151 IPR Denial.

Finally, 37 C.F.R. § 42.11 does require a duty of candor and good faith in proceedings before the Office. However, the scope of this duty is “comparable to the obligations toward the tribunal imposed by Rule 11 of the Federal Rules of Civil Procedure.” 77 Fed. Reg. 48630 (Response to Comment 43). Even assuming that a pending petition qualifies as a proceeding under this regulation, nowhere do Defendants set forth facts demonstrating that InterDigital has violated Rule 11 in its conduct. This is because InterDigital has not. InterDigital’s arguments and filings before the PTAB were not for an improper purpose. Further, they were warranted by existing law and based on evidentiary support. Therefore, Defendants’ allegations have no factual or legal basis and should not prevent admission of the ‘151 IPR Denial.

Respectfully,

/s/ Neal C. Belgam

Neal C. Belgam (No. 2721)

cc: Clerk of Court  
Counsel of Record

# **Exhibit 1**

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

INTERDIGITAL TECHNOLOGY CORPORATION,  
Patent Owner.

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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).<sup>1</sup> 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,

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<sup>1</sup> 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.

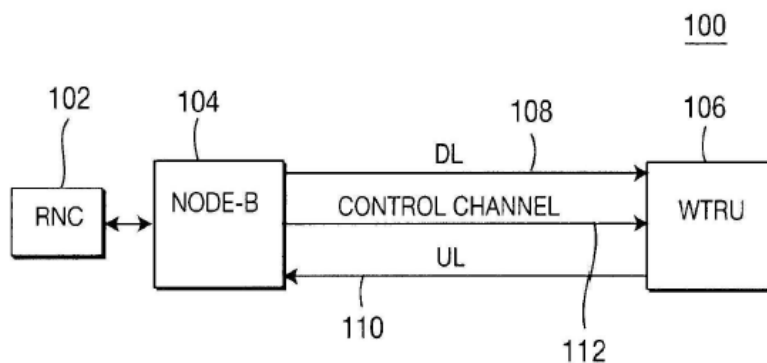
#### B. The '151 Patent (Ex. 1001)

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.

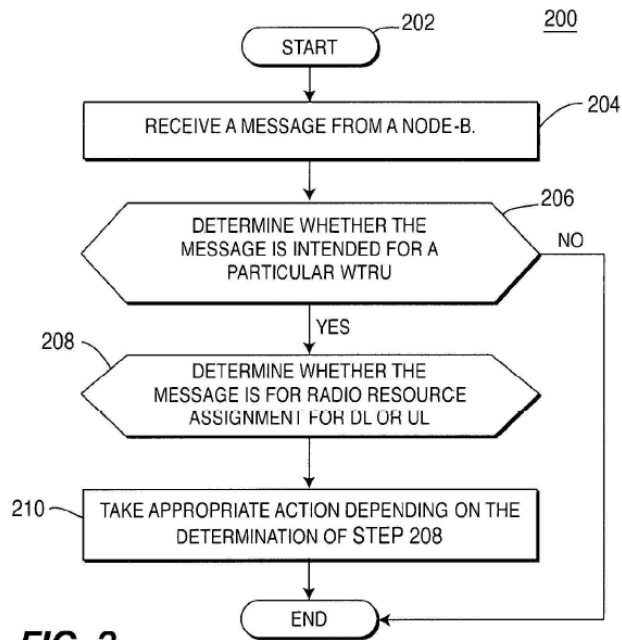
**FIG. 3**

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. Madiseti (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, 3 <sup>rd</sup> 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.”<sup>2</sup> 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

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<sup>2</sup> 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.<sup>3</sup> 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.<sup>4</sup>

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.<sup>5</sup> Pet. 15-33. In support thereof, Petitioner provides claim charts that identify the disclosure in Siemens 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

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<sup>3</sup> 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).

<sup>4</sup> We note that our construction conforms to the definition of “shared channel” from the 3GPP Dictionary. *See* Ex. 2008, 25.

<sup>5</sup> 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

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