

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDIATEK INC. and
MEDIATEK USA, INC.,

Petitioners,

v.

NIPPON TELEGRAPH AND TELEPHONE CORPORATION,
Patent Owner.

Case IPR2020-01404
Patent 7,280,551

PATENT OWNER'S PRELIMINARY SURREPLY

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I. INTRODUCTION

Petitioner's argument that a "mandatory channel" can be the only channel between two stations largely relies on pointing out that the method claims *can* be performed using a single channel. Paper No. 11 ("Reply"), *passim*. There is a significant gap in this logic:¹ A "mandatory channel" may be **used** by itself in a given instance, but it is only "mandatory" in relation to other channels that have been **provided**. The claim language, and specification, require the "mandatory channel" to be one of multiple channels.

II. PETITIONER'S INTERPRETATION IS INCORRECT

A. **Being Able to Use One of Multiple Channels Is Not the Same as Being Provided Only One Channel**

As in the Petition, the Petitioner places undue reliance on the word "or" in the preamble to argue that the claimed steps can be performed with a single channel. But Patent Owner never disputed the meaning of the word "or." Paper No. 8 ("Response") at 19. It is true that the claimed steps could sometimes be performed using a single channel, *but* the claims require that this single channel include the "mandatory channel," as opposed to merely any channel. *E.g.*, '551 Patent at cl. 1. One need not look to the preamble to arrive at this conclusion, because the claims themselves indicate that transmission may use "a wireless

¹ This is essentially the same argument as the three-page discussion of the word "or" presented the Petition (*compare* Paper No. 2 ("Petition") at 27-30), that was addressed in Patent Owner's Preliminary Response (Paper No. 8, "Response" at 15-18).

channel/wireless channels that includes/include the mandatory channel.” *See id.*

Thus, depending on the number of packets in the queue or whether the other channels are busy, only the “mandatory channel” may need to be used at any given time and still be within the scope of the claims.

Indeed, despite Petitioner’s protestations, it *still* cannot point to anything in the specification indicating an embodiment where only a single channel is ***provided*** between two stations. *See* Reply at 4-6. For example, Petitioner argues that stating transmission cannot occur “even if there is another channel” indicates that a “mandatory channel” can “exist” without another channel, but placed in context, this sentence is actually saying that no transmission occurs “even if” another channel could be ***used***. Petitioner also cites to column 11, lines 57-59 as indicating support for the “mandatory channel” “existing” without other channels, but this states that the claims are not limited to the described embodiments. Petitioner also points to various other parts of the specification stating that “transmission **can occur using** ‘a [singular] wireless channel or wireless channels that includes/include the mandatory channel’” (Reply at 4-5, emphasis added), but this, once again, conflates the idea that a single channel may be **used** with the idea that only a single channel is **provided**. The argument concerning a single channel that permits transmission using MIMO technology likewise fails to fill the gap in Petitioner’s logic. Reply at 3-4. Using MIMO techniques would not in itself make

a channel “mandatory,” if there were no other channels to differentiate. Rather, every embodiment incorporating MIMO makes clear that MIMO is *added* to an existing multichannel architecture, wherein one of the multiple channels is set as “mandatory.” *E.g.*, ’551 Patent at 7:44-45. There is no support for the proposition that a “mandatory channel” can **exist** in the absence of other channels.

B. Recourse to the Specification is Proper

The Petitioner argues that the Board need not look to the specification because “mandatory channel” is simply a “channel” that is “mandatory.” Reply at 2. This is not correct.

First, as pointed out in the Response, “mandatory channel” is a coined term that is created for the ’551 Patent. Response at 16. Petitioner does not argue that this phrase has any usage outside the ’551 Patent. Moreover, just because the words “mandatory” and “channel” are individually found in a dictionary does not mean that “mandatory channel” is no more than the sum of its parts. Indeed, a “hotdog” is not simply a “dog” that is “hot.”

Second, Petitioner is incorrect that the specification does not explain what a “mandatory channel” is. As pointed out in Patent Owner’s Response, the specification teaches that a “mandatory channel can be regarded as a wireless channel having the highest priority **among wireless channels** that have a plurality of priorities.” Response at 17, ’551 Patent at 3:57-60 (emphasis added). The

specification further teaches that this means that “wireless packets are always transmitted via wireless channels including the mandatory channel, and when the mandatory channel is busy, **transmission is not performed even if there is another wireless channel.**” *Id.* at 7, 17; ’551 Patent at 3:54-57 (emphasis added). This description is what NTT relies on for its construction.

Petitioner’s reliance on the *Altiris* case is inapposite. In *Altiris*, the ordinary meaning of “flag,” which is “a signal or marker **to identify** a status, a condition, or an event,” already indicates that additional context is required to specify what that “status, condition, or event” is. *See Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373 (Fed. Cir. 2003) (emphasis added). Thus, the term “boot selection flag” is simply a flag that is used “to identify” selection of boot cycle, because the words “boot selection” fill in the gap specified by the ordinary meaning of “flag.” *See id.* Indeed, neither side in *Altiris* disputed this. *Id.* Unlike *Altiris*, the ordinary meaning of “channel” does not indicate what modifying it with “mandatory” would mean, and the word “mandatory” by itself does not explain what it is about a “mandatory channel” that is “mandatory.” Recourse to the specification is proper.

C. The Claim Language Requires the Presence of Multiple Channels

Even if one were to accept, for the sake of argument, Petitioner’s assertion that the claims should be interpreted without the context of the specification

(which would be improper under *Phillips*), here the claim language clearly indicates that the “mandatory channel” is one of multiple channels provided.

As stated in the Response, there is nothing “mandatory” about a channel if it is merely the only channel provided. Response at 21-22. The use of the qualifier “mandatory” necessarily indicates the presence of a “non-mandatory” channel, just as requiring that the “mandatory channel” “always” be used indicates that, absent this language, another channel might be used. *Id.* Petitioner’s tortured reading renders all this language superfluous—if only a single channel were provided at the outset, there would be no need to “set” a “mandatory channel,” nor require that transmission occur “only when the mandatory channel is idle.” *See* ’551 Patent at cl. 1; Response at 21-23. This is plainly improper. *See, e.g., Digital-Vending Servs. Int’l, LLC v. Univ. of Phoenix, Inc.*, 672 F.3d 1270, 1275 (Fed. Cir. 2012) (“claims are interpreted with an eye toward giving effect to all terms in the claim”).

D. The File History Indicates that Multiple Channels are Provided

Contrary to Petitioner’s suggestion, the file history contains no indication that the applicant regarded the “mandatory channel” as being the sole channel provided. Rather, the file history demonstrates that both the applicant and examiner regarded the ’551 patent as pertaining to multi-channel systems.

In fact, the examiner made only one substantive rejection, and only cited references that disclosed multichannel systems: Mouldsley, for instance, disclosed

transmitting packets “using **multiple** wireless channels,” but “does not disclose determination of an idle channel...and setting a mandatory channel.” EX1002 at 306 (emphasis added). Sonetaka disclosed assigning a “service channel” out of multiple channels provided, to carry traffic of a predetermined traffic rank. *Id.* Thus, in responding to the examiner’s rejection, the applicant clarified that the Sonetaka’s “service channel” cannot be a “mandatory channel” because it is not “regularly used” for transmission. *Id.* at 306-307. The issue of whether a “mandatory channel” can be the sole channel provided never came up—rather, the file history shows that both applicant and examiner accepted as a given that in the patent, the “mandatory channel” must be one of multiple provided channels.

Petitioner points to a statement by the applicant suggesting that a “mandatory channel” is “indispensable” as indication that “mandatory channel” has an ordinary meaning that encompasses being the sole channel provided. Reply at 6. However, this statement demonstrates quite the opposite—if a channel can be qualified as “indispensable,” this necessarily indicates the possibility of channels that are “dispensable.” Thus, this qualifier, like “mandatory,” itself indicates the presence of other channels against which an “indispensable channel” is compared.

III. CONCLUSION

NTT respectfully requests that the Board deny institution.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.8 and 42.6(e), the undersigned hereby certifies that the foregoing **Patent Owner's Preliminary Surreply** was served electronically via e-mail to:

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