

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC., BROCADE COMMUNICATIONS SYS.,
INC., RUCKUS WIRELESS, INC., HEWLETT PACKARD ENTERPRISE
COMPANY, HP INC., ARUBA NETWORKS, INC., AND ARRIS
GROUP, INC.,
Petitioner,

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2017-00642
Patent 5,590,403

Before MEREDITH C. PETRAVICK, SCOTT A. DANIELS, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION
ON PETITIONER'S REQUEST FOR REHEARING
37 C.F.R. § 42.71(d)

Petitioner, as captioned above, filed a Petition to institute *inter partes* review of claims 1 and 10 of Patent No. 5,590,403 (“the ’403 patent”) pursuant to 35 U.S.C. § 311–319. Paper 1 (“Pet.”). Mobile Telecommunications Technologies, LLC. (“Patent Owner”) filed a Corrected Preliminary Response. Paper 22 (“Prelim. Resp.”).¹ We denied institution of *inter partes* review because, in part, we determined that prior art Petitioner asserted was presented previously to the Office and was considered substantively by the Examiner during examination. Thus, we exercised our discretion under 35 U.S.C. § 325(d). Paper 24 (“Decision on Institution” or “Dec.”). Petitioner requests partial rehearing of our Decision on Institution. Ex. 1023 (“Req. Reh’g”); *see* Paper 30.

For the reasons that follow, we *deny* Petitioner’s Request for Rehearing.

I. BACKGROUND

A. PROSECUTION HISTORY OF THE ’403 PATENT

The ’403 patent describes a mobile communication system “providing two-way communication capability between a central network and a mobile unit over a relatively large area” to allow for rapid communication of large messages and efficient use of system resources. Ex. 1001, 1:10–14. The ’403 patent issued from application number 07/973,918, filed on November 12, 1992. Ex. 1002, 1 (“Prosecution File”).² Claims 1 and 4 in the filed application issued as claims 1 and 10 of the ’403 patent. *Id.* at 3 (index of

¹ We refer to the Corrected Preliminary Response (Paper 22) when citing to Patent Owner’s brief.

² Cites to the Prosecution File refer to the continuous pagination Petitioner provides in the footer of Exhibit 1002.

claims showing where original claim 1 issued as final claim 1 and original claim 4 issued as final claim 10). In discussing the prosecution history, we refer to the numbering of the issued claims.

After issuing a restriction requirement grouping claims 1 and 10 together, the Office mailed a First Office Action that made two statements relevant to our discussion. First, the Examiner stated that claim 1 would be allowable if rewritten to overcome the rejection made under 35 U.S.C. § 112, second paragraph. *Id.* at 178. Second, the Examiner rejected claim 10 under 35 U.S.C. § 103 as being unpatentable over Jasinski (U.S. Patent No. 4,968,966 (Exhibit 1004)). *Id.* at 182.

The applicant argued against both rejections. With regard to claim 1, the applicant argued, in part, that a § 112 rejection is not proper given the definiteness of the claims, and that “[s]ince, as recognized by the Examiner, the prior art in this case does not affect the scope of claim 1, neither can 35 U.S.C. § 112.” *Id.* at 197–198. With regard to claim 10, the applicant argued that Jasinski did not disclose two limitations: (1) “dynamically reassigning one or more of the base transmitters in the first set of base transmitters assigned to the first zone to the second set of base transmitters assigned to the second zone as a function of the messages to be communicated in an area, thereby creating an updated first set of base transmitters and an updated second set of base transmitters”; and (2) “transmitting substantially simultaneously in simulcast a third information signal and a fourth information signal by the updated first and second sets of transmitters, respectively.” *Id.* at 201–202.

The arguments proved persuasive, because, although other pending claims were rejected anew in the next Office Action, claims 1 and 10 were

deemed allowable over the prior art of record. *Id.* at 210, 221. After further prosecution, the applicant cancelled the remaining rejected claims, and the Office issued a Notice of Allowability. *Id.* at 225–226. In that Notice, the Examiner provided an Examiner’s Statement of Reasons for Allowance as follows:

As to claim 1, the prior art of record fails to show a simulcast system for transmitting from the first and second sets of transmitters a first blocks of information over a first time period and respectively transmitting the second and third blocks of information over a second time period from the first and second sets of transmitters.

As to claim [10], the prior art of record fails to show a simulcast system for transmitting from the first and second blocks of information, dynamically reassigning one or more base transmitters and transmitting the third and fourth blocks of information to the mobile receivers.

Id. at 227. The patent issued with claims 1 and 10 after the issue fee was paid. *Id.* at 260–263.

B. ASSERTED PRIOR ART AND GROUNDS

Petitioner identified the following prior art in its challenge of unpatentability:

- 1) *Jasinski*: U.S. Patent No. 4,968,966 (Exhibit 1004); and
- 2) *Thro*: U.S. Patent No. 4,670,906 (Exhibit 1005).

The grounds of unpatentability presented in the Petition relied upon the above prior art as follows (Pet. 12):

Reference[s]	Basis	Claim challenged
Jasinski	§ 103	1
Thro	§ 103	10

Reference[s]	Basis	Claim challenged
Thro and Jasinski	§ 103	10

C. CHALLENGED CLAIMS

The challenged claims are reproduced below.

1. A method for information transmission by a plurality of transmitters to provide broad communication capability over a region of space, the information transmission occurring during at least both a first time period and a second time period and the plurality of transmitters being divided into at least a first and second set of transmitters, the method comprising the steps of:

- (a) generating a system information signal which includes a plurality of blocks of information;
- (b) transmitting the system information signal to the plurality of transmitters;
- (c) transmitting by the first and second sets of transmitters a first block of information in simulcast during the first time period;
- (d) transmitting by the first set of transmitters a second block of information during the second time period; and
- (e) transmitting by the second set of transmitters a third block of information during the second time period.

10. A method of communicating messages between a plurality of base transmitters and mobile receivers within a region of space divided into a plurality of zones with each zone having at least one base transmitter assigned thereto, the communication method comprising the steps of:

- (a) transmitting substantially simultaneously a first information signal and a second information signal to communicate messages to the mobile receivers, the first information signal being transmitted in simulcast by a first

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