

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TCT MOBILE (US), INC., TCT MOBILE (US) HOLDINGS, INC.,
HUIZHOU TCL MOBILE COMMUNICATION CO. LTD., and
TCL COMMUNICATION, INC.,
Petitioner,

v.

FUNDAMENTAL INNOVATION SYSTEMS INTERNATIONAL LLC,
Patent Owner.

IPR2021-00395
Patent 7,239,111 B2

Before MIRIAM L. QUINN, JO-ANNE M. KOKOSKI, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing of Decision
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

On July 6, 2021, we entered a Decision Denying Institution of *Inter Partes* Review. Paper 8 (“Decision” or “Dec.”). The basis for our Decision was Petitioner’s failure to sufficiently show that the prior art relied on by Petitioner, *i.e.*, Morita (Ex. 1017) and/or the knowledge of an ordinarily skilled artisan, “discloses or suggests the identification subsystem limitation” recited in the challenged independent claims. Dec. 26.

Petitioner timely filed a Request for Rehearing on July 20, 2021. Paper 9 (“Request” or “Req.”). Petitioner contends that we “overlooked or misapprehended its arguments that “in view of Morita and the knowledge of a POSITA, it would be obvious for Morita’s charger to send an ‘identification signal’ . . . to Morita’s mobile phone, thereby rendering obvious the ‘identification signal’ limitations.” Req. 4.

For the reasons explained below, we discern no reason to modify the Decision. Consequently, we deny the Request.

II. STANDARD OF REVIEW

Petitioner bears the burden to show that our Decision should be modified. 42 C.F.R. § 42.71(d). Our rules provide that a request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked and the place where each matter was previously addressed.” *Id.* We review a request for rehearing of the Decision “for an abuse of discretion.” 42 C.F.R. § 42.71 (c). “An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Huawei Device Co., LTD., v. Optis Cellular Tech., LLC*,

IPR2018-00816, Paper 19, 3 (PTAB Jan. 8, 2019) (precedential) (citations omitted).

III. ANALYSIS

Petitioner contends that we “overlooked or misapprehended that Petitioner’s argument was obviousness, not anticipation.” Req. 6; *see also id.* at 4–5 (arguing we overlooked argument “that it would be *obvious* to use Morita’s charger as only a charger to charge the Morita videotelephone.”). The underlying basis for this contention is that “[n]otably, Petitioner did not argue that Morita ‘discloses’ that Morita’s charger acts only as a charger.” Req. 6 (citing Pet. 42–43). This statement in the Request is absolutely false.

The Petition states “although Morita discloses that a USB host or hub . . . is *optionally* connectable to the adapter via USB port 20, it also *discloses* its device acting as a charger without the operational USB host or hub connection.” Pet. 43 (citing Ex. 1003 ¶ 118 (“Baker Decl.”); Ex. 1017 ¶ 14 (second italics added)). Patent Owner disputed that Morita discloses this mode of operation. *See* Paper 7, 30. Due to the dispute created by Petitioner’s statement, we addressed the question of whether Morita discloses such a mode of operation. *See* Dec. 22–24. In particular, we noted that neither the cited portion of Morita nor Dr. Baker’s testimony supports Petitioner’s contention that Morita discloses its device acting only as a charger. *Id.* at 23. Further, we noted that the contention flew in the face of other portions of Morita not addressed by Petitioner. *Id.* at 23–24 (discussing Ex. 1017 ¶¶ 16, 22).¹

¹ Petitioner argues “the Petition demonstrates that it would be ‘common sense’ to use Morita’s charger to simply charge Morita’s mobile device.” Req. 6 (citing *KSR Int’l Co. v. Teleflex, Inc.*, 520 U.S. 398, 420 (2007)).

Petitioner has not even attempted, let alone carried its burden to show, that our factual finding that Morita does not explicitly disclose a charging only mode is not supported by substantial evidence. *See generally* Req. Therefore, Petitioner has not shown an abuse of discretion in our resolution of this factual dispute.

We did not overlook Petitioner’s obviousness arguments or in some unstated manner apply the law of anticipation. Rather, we analyzed the arguments in the Petition and determined that Petitioner did not show how Morita or any other cited prior art was “configured to generate an identification signal wherein the identification signal is configured to indicate to the mobile device that the power socket is not a USB host or hub,” as required by claim 1 of the challenged patent. Dec. 24–26. In the Decision, we explained “Petitioner, at best, shows that Morita is *capable* of generating an SE1 signal, not that it is *configured* to generate the recited identification signal.” *Id.* at 25 (citing Pet. 46). We also found that other prior art referenced in the Petition failed to disclose an identification signal configured as recited in claim 1. *Id.* at 25–26. Petitioner does not address these findings. *See generally* Req.

Petitioner rephrases its arguments from the Petition and now contends that we should have determined “whether it would have been *obvious* to configure Morita to” generate the recited identification signal. Req. 8. We note that Petitioner does not direct us to any part of the Petition where it framed its obviousness argument in this particular way and our review of the Petition does not reveal that particular phrasing appearing in the Petition.

Petitioner did not make this argument in the Petition and, thus, we could not have overlooked or misapprehended it.

Nonetheless, the Federal Circuit directs us that the phrase “configured to” is generally equivalent to the phrases “made to” or “designed to” and, therefore, requires more than what Petitioner argues. *See In re Gianelli*, 739 F. 3d 1375, 1379 (Fed. Cir. 2014) (explaining that the phrase “‘adapted to’ is frequently used to mean ‘made to,’ ‘designed to,’ or ‘configured to’” but “can also mean ‘capable of’ or ‘suitable for.’”); *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“obviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention”). Again, showing that Morita *could* have generated an SE1 signal is not equivalent to showing that Morita would have been configured to do so. *See Dec. 25*.

In the Request, Petitioner does not argue that our finding Morita is, at best, capable of generating an SE1 signal is not supported by substantial evidence. Further, Petitioner does not argue that our determination that Morita is not “configured to” generate an SE1 signal is based on an erroneous interpretation of the law stated by the Federal Circuit in *Gianelli*. Therefore, Petitioner has not shown that we abused our discretion.

We have considered all of Petitioner’s arguments in the Request and determine that Petitioner has not met its burden to show that we overlooked or misapprehended any matter in the Petition or otherwise abused our discretion. Consequently, we deny Petitioner’s Request for Rehearing and do not modify our Decision.

IT IS HEREBY ORDERED that the Request is denied.

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