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Paper 8
Date: November 29, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD., and
SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

EVOLVED WIRELESS LLC,
Patent Owner.

IPR2021-00949
Patent RE46,679 E

Before PATRICK M. BOUCHER, TERRENCE W. McMILLIN, and JASON M. REPKO, *Administrative Patent Judges*.

BOUCHER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively, "Petitioner") filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–3 and 6–8 of U.S. Patent No. RE46,679 E (Ex. 1001, "the '679 patent"). Paper 2 ("Pet.").

Evolved Wireless LLC ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

We have authority under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. For the reasons set forth below, we exercise our discretion under 35 U.S.C. § 314(a) and decline to institute an *inter partes* review.[1]

I. BACKGROUND

A. The '679 Patent

1. Overview

The '679 patent relates "to a method of transmitting and receiving radio connection information that allows a terminal to access a target base station . . . in a faster and more efficient manner while performing a handover for the terminal to a cell of the target base station." Ex. 1001, 1:29–35. In particular, the '679 patent describes a sequence of transmissions among a mobile terminal (such as a cellular telephone, designated "UE"), a source base station (designated "Source eNB"), and a target base station (designated "Target eNB") that avoids inefficient "collisions" that may occur when two mobile terminals simultaneously attempt to use the same random access channel to effect handovers. *Id.* at 5:12–21.

[1] Petitioner did not request authorization to file a Reply to address Patent Owner's discretionary-denial arguments.

Figure 9 of the ’679 patent is reproduced below.

Fig 9

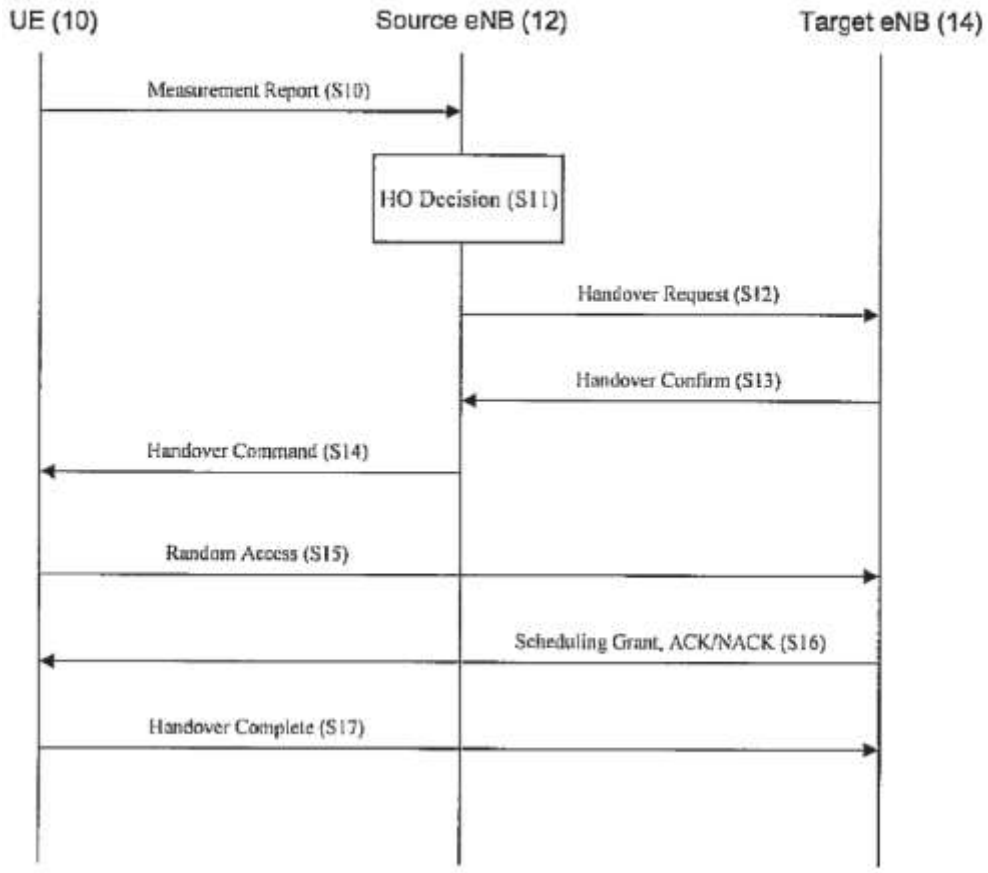

Figure 9 illustrates communications used in effecting the handover of mobile terminal UE from a cell of source base station eNB 12 to a cell of target base station eNB 14. *Id.* at 6:20–22. Mobile terminal 10 transmits measurement report S10 to source base station eNB 12, which determines at S11 whether to perform a handover for the mobile terminal to a different cell. *Id.* at 6:23–38. If a handover is to be performed, source base station eNB 12 transmits handover request S12 to target base station eNB 14 and receives handover confirmation S13. *Id.* at 6:54–57. The confirmation may include information “necessary in the course of connecting” the mobile terminal to

the target cell, such as information used in a random access channel ("RACH") for performing a radio-access procedure, which may include "a preamble which is selected from signatures contained in" the mobile terminal. *Id.* at 6:49–57.

Handover command S14 is accordingly transmitted from source base station eNB 12 to mobile terminal 10, and "may include necessary information which comes from the target eNB" as well as "information of the signature and the preamble which is to be used in the access procedure to the target eNB." *Id.* at 7:14–22. Mobile terminal 10 uses the RACH to establish radio communication with target base station eNB 14 with signal S15. *Id.* at 7:23–44.

Because target eNB 14 already allocates a signature used in the preamble to mobile terminal 10, the mobile terminal can be identified by the preamble, and target base station eNB 14 may allocate uplink radio resources to the mobile terminal as indicated by scheduling grant S16. *Id.* at 7:45–51. That is, to avoid channel collision with other mobile terminals, mobile terminal 10 "should not transmit a preamble that is selected from the signatures used in the RACH during the handover; but rather, the [mobile terminal] may transmit a preamble of a previously defined signature through the handover confirm message from the target [base station]." *Id.* at 6:65–7:2. Completion of the handover from source base station eNB 14 to target base station eNB 16 based on the scheduling grant is confirmed with handover-complete message S17. *Id*. at 7:57–8:2.

2. Prosecution History

The '679 patent is a reissue of U.S. Patent No. 8,219,097 B2 ("the '097 patent"). Ex. 1001, code (64). The claims were ultimately amended (1) to remove a duplicate word from claim 1; and (2) to replace the word "non-contention" with "collision avoidance" in claims 2 and 7, to overcome a rejection under 35 U.S.C. § 112, ¶ 1. *See id.*, 10:14–11:27; Ex. 1027. In allowing the reissued claims, the Examiner made the following statement of reasons for allowance:

> No art could be found such that suggests that transmitting of preamble information via dedicated signaling in downlink that is used for performing a RACH procedure, where the preamble is also transmitted from the terminal to the network and such that uplink data is transmitted to the network using an uplink grant in a random access response.

Ex. 1030, 4.

3. Illustrative Claim

Independent claim 6 is illustrative of the challenged claims and is reproduced below, omitting notations that identify text removed on reissue.

> 6. A mobile terminal for transmitting uplink data in a wireless communication system, the mobile terminal comprising:
>
> a transceiver configured to transmit or receive the uplink data;
>
> a memory configured to store the uplink data transmitted or received via the transceiver or from an external source; and
>
> a processor cooperating with the transceiver and the memory, the processor configured to:
>
> receive, from a network, preamble information generated by the network, wherein the preamble information is received via dedicated signaling in downlink, wherein the preamble information is used for performing a random access channel

(RACH) procedure, wherein the received preamble information is either a dedicated preamble or an index of the dedicated preamble, and wherein the dedicated preamble is used for a specific terminal;

transmit, to the network, the dedicated preamble on a random access channel (RACH) in uplink;

receive a random access response in response to the transmitted dedicated preamble, wherein the random access response includes at least one of time information for a handover operation, an uplink grant for the handover operation, time information for a downlink data arrival, or a random access preamble identifier; and

transmit the uplink data to the network using the uplink grant included in the random access response.

Ex. 1001, 10:52–11:14.

B. Evidence

Petitioner relies on the following references. Pet. 3.

(1) *Intra-LTE Handover Operation*, 3GPP draft R2-061135 (Ex. 1003; "Nokia")[2]; and

(2) Chinese Patent Publication CN 159602A, published March 16, 2005 (Ex. 1004, "Hu")[3].

In addition, Petitioner relies on a Declaration by Paul S. Min, Ph.D. Ex. 1037.

[2] Petitioner contends that Nokia was published on or before May 3, 2006. Pet. 3, 25–26.

[3] Hu includes an English translation, with a certification by the translator that it is "accurate and complete." *See* Ex. 1004, 14.

C. Asserted Ground of Unpatentability

Petitioner challenges claims 1–3 and 6–8 on the following ground. Pet. 3.

Claim(s) Challenged	35 U.S.C. §[4]	References
1–3, 6–8	103	Nokia, Hu

D. Real Parties in Interest

The parties identify only themselves as real parties in interest. Pet. 1; Paper 5, 2.

E. Related Matters

Both parties identify the following matters as involving the '679 patent: (1) *Evolved Wireless, LLC v. Samsung Electronics Co. Ltd.*, No. 2:21-cv-00033 (E.D. Tex.) ("the related Texas litigation"); and (2) *In the Matter of Certain LTE-Compliant Cellular Communication Devices*, Inv. No. 337-TA-1253 (ITC) ("the related ITC Investigation"). Pet. 1; Paper 5, 2.

In addition, Petitioner identifies *Evolved Wireless, LLC v. Samsung Electronics Co. Ltd.*, No. 15-cv-545 (D. Del.), and Patent Owner identifies

[4] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended various provisions of 35 U.S.C. Because the '679 patent is a reissue of the '097 patent, which was filed before March 16, 2013 (the effective date of the relevant amendment), the pre-AIA versions of those provisions apply. *See* MPEP 1440.II. ("The claims in a reissue application are treated as if they were presented in the patent being reissued for purposes of evaluating patentability over prior art, i.e., as if they had the same effective filing date as the original patent.")

Evolved Wireless, LLC v. Motorola Mobility LLC, No. 1:21-cv-00567 (N.D. Ill.) as involving patents with related subject matter. Pet. 1–2; Paper 5, 2.

Related matters before the Board include IPR2016-01185, IPR2016-01347, IPR2021-00943, and IPR2021-00950. *See* Pet. 2; Paper 5, 2.

II. DENIAL UNDER 35 U.S.C. § 314(a)

A. Background

As noted above, the '679 patent is the subject of two parallel proceedings, namely the related Texas litigation and the related ITC Investigation. *Supra* § I.F. Patent Owner asks that we exercise our discretion to deny the Petition based on the state of the related ITC Investigation, but does not make a similar request based on the related Texas litigation. Prelim. Resp. 2–3. In particular, Patent Owner maintains that "[t]he ITC will benefit in its decision-making process from a trial with live witnesses and extensive briefing on the issues overlapping with [Petitioner]'s Petition, all of which will occur more than a month before [] Patent Owner['s] Response is due." *Id.* at 2. It is undisputed that, about ten months ago, on February 1, 2021, Patent Owner filed its complaint before the ITC against Petitioner (and Motorola), asserting infringement of the '679 patent. *See id.* at 4; Ex. 1036.

B. Analysis

Institution of an *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (2018) (stating "[t]he Director *may not* authorize an inter partes review to be instituted unless the Director determines that the information

presented in the petition . . . 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") (emphasis added); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is permitted, but never compelled, to institute an IPR proceeding."). The advanced state of either a parallel district court action or a parallel ITC investigation may warrant exercising discretion on behalf of the Director to deny a petition for *inter partes* review. *See NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential) ("*NHK*"); *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 at 5–6, 8 (PTAB March 20, 2020) (precedential) ("*Fintiv*"); Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 58 & n.2, *available at* https://www.uspto.gov/TrialPracticeGuideConsolidated ("Trial Practice Guide").

In evaluating whether to do so, we consider the following factors in assessing "whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding":

> 1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
>
> 2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
>
> 3. investment in the parallel proceeding by the court and the parties;
>
> 4. overlap between issues raised in the petition and in the parallel proceeding;
>
> 5. whether the petitioner and the defendant in the parallel proceeding are the same party; and

> 6. other circumstances that impact the Board's exercise of discretion, including the merits.

Fintiv at 5–6. In evaluating these factors, we "take[] a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Id.* at 6.

Relevant to our consideration of these factors is a scheduling order entered by the ITC on April 2, 2021, that sets forth the following deadlines: (1) "Fact discovery cut-off and completion," October 12, 2021; (2) "Expert discovery cutoff and completion," December 3, 2021; (3) "Hearing," January 31 – February 4, 2022; (4) "Initial Determination," May 6, 2022; (5) "Target date for completion of investigation," September 8, 2022. Ex. 2002. In light of this schedule, the Presidential Review period of the related ITC Investigation is expected to expire on November 7, 2022. 19 U.S.C. § 1337(j) (2018); *see* Pet. 63 (Petitioner agreeing with such date); Prelim. Resp. 4 (Patent Owner agreeing with such date).

1. Possibility of Stay

A stay of a related proceeding pending resolution of the PTAB trial "allays concerns about inefficiency and duplication of efforts." *Fintiv* at 6. Although the related Texas litigation has been stayed, Petitioner concedes that "[w]ith respect to the [related ITC Investigation], as of this time, no stay pending IPR has been requested." Pet. 60–61. Petitioner represents that it "intends to file a motion to stay pending IPR if the Petition is instituted," and Patent Owner represents that it "will not request a stay itself." *Id.* at 61; Prelim. Resp. 7. Patent Owner supports its position that a stay of the related ITC Investigation is unlikely by citing a number of cases to show that "the ITC routinely denies such requests" and by noting that, at the estimated time

of this Decision, the related ITC Investigation will be at such an advanced state that "the Parties will have filed motions for summary determination, will be exchanging pretrial materials, and will be preparing for trial in the Investigation." Prelim. Resp. 7–8.

Petitioner nevertheless contends that "this factor is at least neutral," and points to "the lack of preclusive effect of an ITC determination" in other forums. Pet. 61–62. That is, Petitioner "respectfully submits that the [related ITC Investigation] should not be viewed as *per se* weighing in favor of exercising § 314(a) discretion because the ITC lacks the authority to issue a binding ruling on invalidity." *Id.* at 61. Although Petitioner cites two routine Board cases that considered this, *id.*, Patent Owner correctly observes that both "were decided before the precedential *Fintiv* decisions" that bind us. Prelim. Resp. 8. Indeed, *Fintiv* expressly addressed this issue by emphasizing that "even though the Office and the district court would not be bound by the ITC's decision, an earlier ITC trial date may favor exercising authority to deny institution under *NHK* if the ITC is going to decide the same or substantially similar issues to those presented in the petition." *Fintiv* at 8.

In light of these considerations, we determine that this factor weighs in favor of a denial of the Petition.

2. Schedules

According to *Fintiv*, "[i]f the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution." *Fintiv* at 9. In addressing this factor, Patent Owner compares the September 8, 2022, anticipated date

for the ITC's Final Determination with the statutory deadline for a final written decision in this proceeding. Prelim. Resp. 9 (citing Ex. 1035); *see also* Pet. 63 (citing same and agreeing with the anticipated date for the ITC's Final Determination). In contrast, Petitioner appears to compare the date for the ITC's Initial Determination with the date of our Institution Decision in this proceeding. *See* Pet. 63 ("Notably, the Board has declined to exercise its § 314(a) discretion even where the Board's institution decision was due nearly two months *after* the ITC's [Initial Determination] in a parallel ITC investigation" (citation omitted)).

We agree with Patent Owner that Petitioner's measure for assessing this factor is inappropriate. Prelim. Resp. 10 ("Samsung then *changes* the relevant variables in the conversation, focusing *not* on (a) the trial date and (b) the statutory deadline for Final Written Decision, but *instead* on (i) the ITC's Initial Determination date and completion of Investigation and (ii) the Institution Decision date."); *see, e.g., Philip Morris Prods., S.A. v. RAI Strategic Holdings, Inc.*, IPR2020-00919, Paper 9 at 9 (PTAB Nov. 16, 2020) (*Fintiv* factor 2 weighs in favor of exercising discretion to deny institution where "the ITC is likely to reach a final determination ahead of the date of our final written decision"); *Canadian Solar Inc. v. The Solaria Corp.*, IPR2021-00095, Paper 12 at 9–10 (PTAB May 26, 2021) (evaluating *Fintiv* factor 2 by comparing anticipated date of ITC final determination with anticipated date of Board's final written decision).

Petitioner cites four cases to support its position that the Board should not exercise its discretion under § 314(a) despite the relative schedules of the two proceedings. Pet. 63–64 (citing *Wirtgen Am., Inc. v. Caterpillar Paving Prods. Inc.*, IPR2018-01201, Paper 13 at 10–12 (PTAB Jan. 8, 2019); *Intel*

Corp. v. Tela Innovations, Inc., IPR2019-01636, Paper 16 at 21–24 (PTAB Mar. 31, 2020); *Renesas Elecs. Corp. v. Broadcom Corp.*, IPR2019-01040, Paper 9 at 7–8 (PTAB Nov. 13, 2019); *MED-EL Elektromedizinische Geräte GmbH v. Sonova AG*, IPR2020-00176, Paper 13 at 15 (PTAB June 3, 2020)). We also agree with Patent Owner that Petitioner's citation of these cases is inapposite because "[t]hree of these cases—*Wirtgen*, *Intel*, and *Renesas*—were decided before the precedential *Fintiv v. Apple* decisions that set forth the proper inquiry under § 314(a)" and "[t]he fourth—*MED-EL*—involved District Court litigation, not an ITC Investigation." *See* Prelim. Resp. 11–12 (citing Pet. 63–64).

The projected target date for the Final Determination in the related ITC Investigation is about two or three months ahead of the statutory deadline for a final written decision in this proceeding.[5] We accordingly determine that this factor weighs in favor of exercising discretion to deny institution of an *inter partes* review.

3. Investment in Parallel Proceeding

"[I]f, at the time of the institution decision, the district court has issued substantive orders related to the patent at issue in the petition, this fact favors denial" of the Petition. *Fintiv* at 9–10. The Petition's assertion that, in the related ITC Investigation, "fact discovery is just beginning, no depositions have taken place, [and] the Markman hearing is not scheduled

[5] A final written decision would be due one year after institution of an *inter partes* review. 35 U.S.C. § 316(a)(11). Patent Owner's last-possible-day estimate of "December 7, 2022," Prelim. Resp. 10, proves to be more accurate than Petitioner's optimistic estimate of "October 2022," Pet. 63.

until September 1, 2021," was made about half a year ago, when the Petition was filed on May 16, 2021. *See* Pet. 64–65 (citing Ex. 1034). Since then, according to Patent Owner's more recent statement, a "significant investment in time and money [] has taken place and [] will take place in the ITC by the time an Institution Decision is due." Prelim. Resp. 13. Patent Owner specifically represents that, as of the September 7, 2021, date of its Preliminary Response, "the Parties have exchanged and/or answered 138 Interrogatories, 171 Requests for Production, 79 Requests for Admission, served 30(b)(6) Deposition Notices comprising 64 topics, and exchanged over 1.3 million pages of documents (not counting source code)." *Id.* at 5 (footnote omitted). Still further investment in the related ITC Investigation has undoubtedly taken place since that time, particularly in light of the deadlines for fact and expert discovery set forth in the ITC scheduling order, discussed above. *See* Ex. 2002.

The investment in the related ITC Investigation by the parties is thus clearly substantial. We accordingly determine that this factor weighs in favor of exercising discretion to deny institution of an *inter partes* review.

4. Overlap of Issues

"[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial." *Fintiv* at 12. Petitioner makes two points with respect to this factor. First, "Petitioner stipulates that, if this IPR is instituted, Petitioner will not assert in the ITC case any grounds of invalidity based in any way upon the primary reference relied upon herein, Nokia (including, but not limited to, any and all grounds advanced in this

petition)." Pet. 65. Second, Petitioner observes that, in addition to claims 6 and 8, which are asserted at the ITC, the Petition challenges claims 1–3 and 7, which are not asserted at the ITC. *Id.* at 66.

With respect to Petitioner's first point, Patent Owner counters that the stipulation is "illusory." Prelim. Resp. 14. This is so, Patent Owner contends, because the related ITC Investigation also involves another respondent, Motorola, who would not be subject to Petitioner's stipulation. *Id.* "In fact, Motorola and [Petitioner] jointly served their invalidity contentions in the [related ITC] Investigation, identifying *Nokia* as an alleged anticipation and obviousness reference." *Id.* (citing Ex. 2003, 5; Ex. 2004). Patent Owner observes that, if Petitioner withdrew its reliance on the Nokia reference in the related ITC Investigation, Petitioner "would still benefit from any findings made in Motorola's favor related to that reference." *Id.* at 14–15. Although we recognize Patent Owner's point, we credit Petitioner's proffered stipulation, which is somewhat broader than the stipulation credited in the Board's informative decision in *Sand Revolution II, LLC v. Continental Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 11–12 (June 16, 2020) (informative) (petitioner stipulating not to "pursue the same grounds in the district court litigation").

With respect to Petitioner's second point, although there are differences in the claims at issue in this proceeding and the related ITC Investigation, the overlap is nonetheless significant. Independent claim 1 of the '679 patent is a method claim that substantially recites what is implemented by the "processor" of independent claim 6. *Compare* Ex. 1001, 10:14–38 *with id.* at 10:52–11:14. And, but for its dependence from independent claim 1 instead of independent claim 6, claim 3 recites the

same limitation as claim 8, which is directly at issue in the related ITC Investigation. *Compare id.* at 10:43–45 *with id.* at 11:19–21. The only issue that is not presented in any form in the related ITC Investigation is thus the "collision avoidance random access preamble" recited in claims 2 and 7. *See id.* at 10:39–42; 11:15–18. Although we recognize that the overlap of issues is imperfect, *Fintiv* acknowledges that "weighing the degree of overlap is highly fact dependent" and that "it may still be inefficient to proceed because the [other tribunal] may resolve validity of enough overlapping claims to resolve key issues in the petition." *Fintiv* at 13.

Considering these two points, we determine that this factor weighs somewhat against exercising discretion to deny institution of an *inter partes* review.

5. Overlap of Parties

All parties to this proceeding are included in the related ITC Investigation. The Board determined in *Sand Revolution* that "[a]lthough it is far from an unusual circumstance that a petitioner in *inter partes* review and a defendant in a parallel district court proceeding are the same, or where a district court is scheduled to go to trial before the Board's final decision would be due in a related *inter partes* review, this factor weighs in favor of discretionary denial." *Sand Revolution*, Paper 24 at 12–13; *see also Fintiv* at 13–14. In denying institution in the *Fintiv* proceeding, the Board determined that "[b]ecause the petitioner and the defendant in the parallel proceeding are

the same party, this factor weighs in favor of discretionary denial." *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 15 at 15 (PTAB May 13, 2020).[6]

Accordingly, this factor weighs in favor of exercising our discretion to deny institution.

6. Other Circumstances

The final factor takes into account any other relevant circumstances, including the merits. "For example, if the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution." *Fintiv* at 14–15. This is not such a case. Rather, our assessment of the merits indicates that this case instead presents "a closer call, [which] has favored denying institution when other factors favoring denial are present." *Id.* at 15.

For its sole challenge, Petitioner relies on Nokia (which Petitioner concedes was cited to the Office during prosecution, Pet. 26) for "nearly all the limitations of the '679 patent claims." Pet. 33. Figure 1 of Nokia is reproduced below.

[6] We acknowledge Petitioner's observation that one APJ has questioned the interpretation of this factor. Pet. 66 (citing *Cisco Systems, Inc. v. Ramot at Tel Aviv University Ltd.*, IPR2020-00122, Paper 15 at 10 (PTAB May 15, 2020) (Crumbley, APJ, dissenting)). Even were we to determine that this factor is neutral under the alternative interpretation of this factor, we would still reach the same ultimate conclusion to exercise discretion to deny the Petition.

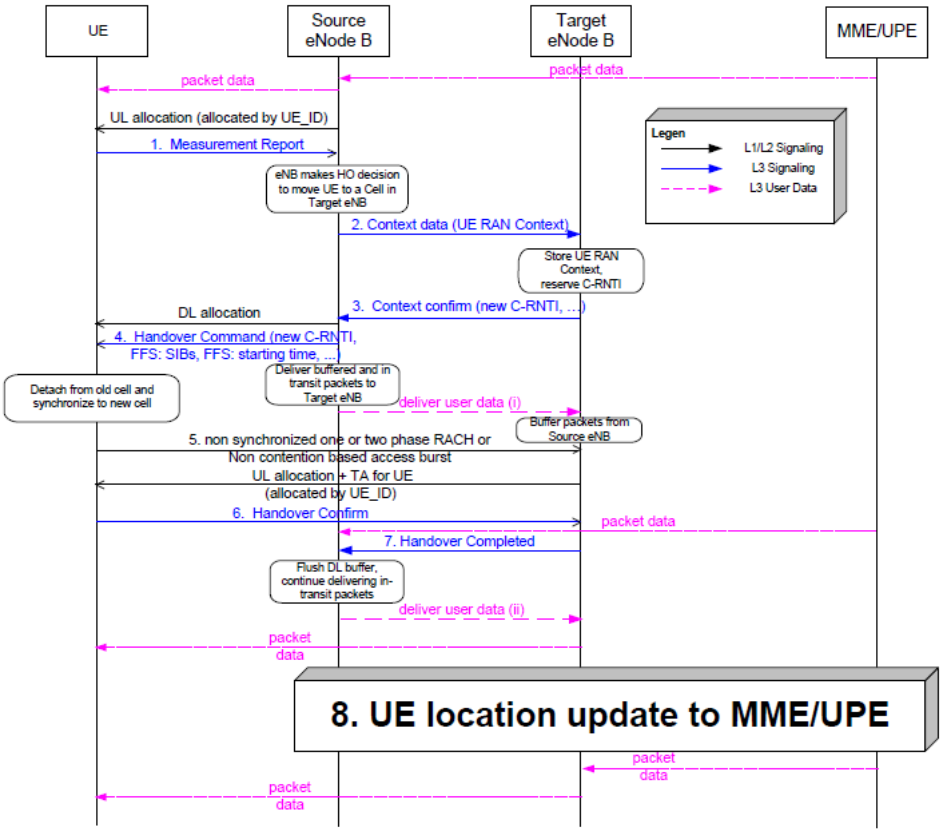

Figure 1: Proactive intra-MME/UPE HO

Figure 1 presents a "basic handover scenario." Ex. 1003, 1. At step 1, the UE is triggered to send a measurement report. *Id.* at 2. The source eNB makes a decision based on the measurement report at step 2 and passes relevant information to the target eNB at step 2. *Id.* The target eNB responds by providing the source eNB with updated information and other parameters at step 3. *Id.* At step 4, the UE receives a handover command with necessary parameters. *Id.* The UE synchronizes with the target eNB at step 5 and acquires a timing advance either (1) by a "normal one or two phase RACH procedure" or (2) "by sending access burst in a non-contention based manner." *Id.* The network responds with a UL allocation and timing advance that the UE uses at step 6 to send a handover confirmation to the

target eNB. *Id.* at 3. The target eNB informs the source eNB at step 7 that the handover was successful, with the UE location information being updated at step 8. *Id.*

Petitioner contends that Nokia discloses, "in the context of the disclosed handover operations, performing a *contention free* . . . RACH procedure (step 5 [of Nokia's Figure 1]), wherein the identifier information necessary for the UE to communicate with the target base station during the RACH procedure was previously transmitted in a message from the source base station to the UE (*e.g.*, Handover Command, Step 4)." Pet. 33–34 (citing Ex. 1037 ¶ 92). Petitioner motivates its reasoning for effecting a combination of Nokia with Hu by contending that a person of skill in the art "would recognize that the specific implementation of such a conventional, contention free RACH procedure as referenced in Nokia could be implemented using" a variety of known methods. *Id.* at 35. Such a person "would also have recognized," Petitioner further contends, "that using conventional RACH procedures wherein each UE is assigned and uses its own different preamble would make the handover process quicker and more efficient by reducing contention between the mobile station and the other mobile stations on the RACH." *Id.* Petitioner relies on such features to argue that "Hu discloses the full implementation level details of how such a conventional, contention free RACH procedure using allocated resources in the form of a dedicated code resource (*i.e.*, a dedicated preamble) is performed." *Id.* at 35–36.

Patent Owner disputes Petitioner's reading of Nokia, particularly that it discloses a contention-free RACH procedure. *See* Prelim. Resp. 36–43. Patent Owner correctly observes that the timing alignment in step 5 of

Nokia's Figure 1 "involves one of two *different* procedures: a 'one or two step RACH procedure' **OR** a 'Non contention based access burst.'" *Id.* at 37. Patent Owner elaborates that, although Nokia teaches that the "UE receives allocation(s)" that can be used in an access burst in the second of these procedures, Nokia "does not even teach what an 'access burst' is or how it would be used in a non-contention-based manner—and certainly does not teach or suggest that the non-contention-based manner would involve a RACH procedure." *Id.* at 38. Patent Owner further supports its position with "[o]ther contemporaneous submissions by Nokia [that] confirm this and explain what Nokia meant by a contention-free access burst procedure," as well as LTE standards documents. *Id.* at 38–43 (citing Ex. 2009, 1–2; Ex. 2010 § 10.1; Ex. 2011 § 10.1.2.1; Ex. 2012 § 10.1.2.1). We have reviewed this evidence, and find on this record that it provides some support for Patent Owner's position.

The merits of this case thus present the "closer call" that favors exercising discretion to deny institution of an *inter partes* review under *Fintiv*.

7. Conclusion

As noted in *Fintiv*, we consider the above factors as part of "a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review." *Fintiv* at 6. In this instance, most of the factors we consider weigh in favor of exercising discretion to deny institution of an *inter partes* review, with *Fintiv* factor 4 weighing only somewhat against. We accordingly exercise that discretion and deny the Petition.

III. ORDER

In consideration of the foregoing, it is

ORDERED that the Petition is *denied* and no trial is instituted.

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