

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

IPR LICENSING, INC.,
Patent Owner.

Case IPR2014-00525
Patent 8,380,244 B2

Before SALLY C. MEDLEY, MIRIAM L. QUINN, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

DECISION ON REMAND

35 U.S.C. § 144 and 37 C.F.R. § 42.5(a)

I. INTRODUCTION

A. Background

ZTE Corporation and ZTE (USA) Inc. (collectively, “Petitioner”) filed a corrected Petition requesting inter partes review of claims 1–8, 14–16, 19–29, 36–38, and 41–44 of U.S. Patent No. 8,380,244 B2 (Ex. 1001, “the ’244 patent”). Paper 9 (“Pet.”).¹ IPR Licensing, Inc. (“Patent Owner”) filed a Patent Owner Preliminary Response (Paper 12 (“Prelim. Resp.”)). Pursuant to 35 U.S.C. § 324, the Board instituted trial on one ground of unpatentability, Claims 1–8, 14–16, 19–29, 36–38, and 41–44 under 35 U.S.C. § 103 as obvious over Jawanda, the GPRS Standards, and the IEEE 802.11 Standard. Paper 19, 22. After institution of trial, Patent Owner filed a Patent Owner Response (Paper 25 (“PO Resp.”)) and Petitioner filed a Reply (Paper 38 (“Pet. Reply”)). Oral hearing was held on May 21, 2015, and a transcript of the hearing is in the record. Paper 47 (“Tr.”). On September 14, 2014, we issued a Final Written Decision holding that Petitioner had demonstrated by a preponderance of the evidence that claims 1–8, 14–16, 19–29, 36–38, and 41–44 of the ’244 patent were unpatentable as obvious based on the instituted ground. Paper 48 (“Final Dec.”).

Patent Owner appealed to the United States Court of Appeals for the Federal Circuit. Paper 49. On April 20, 2017, the Federal Circuit issued a decision affirming our conclusion that the asserted prior art references rendered claims 1–7, 14–16, 19–29, 36–38, and 41–44 obvious, and vacated

¹ We granted the Motion for Joinder filed by Microsoft Corporation, joining Case IPR2015-00074 with this proceeding. Paper 31. Subsequently, Petitioner Microsoft Corporation filed a motion to terminate its participation in this proceeding on May 17, 2017, which we granted May 23, 2017. Paper 53.

and remanded to the Board to consider again our finding of obviousness of claim 8, which depends from claim 1. *IPR Licensing, Inc. v. ZTE Corp., ZTE (USA) Inc., Microsoft Corp.*, 685 F. App'x 933 (Fed. Cir. 2017) (unpublished). In particular, the Federal Circuit agreed with our claim construction for the claim 1 phrase “maintain[ing] a communication session,” but held that “substantial evidence does not support the Board’s articulated motivation to combine the asserted references to arrive at the invention defined in claim 8.” *Id.* at 935, 939. The Federal Circuit’s mandate issued on June 19, 2017.

The Board has reviewed the record in light of the Federal Circuit’s decision. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claim 8 of the ’244 patent is unpatentable.

B. Conference Call after Remand

The Board held a conference call on July 18, 2017, with the parties to discuss potential actions to be taken in view of the remand by the Federal Circuit. A court reporter was present on the call, and a transcript of the call was filed by Patent Owner. Ex. 2026. Both parties agreed that additional briefing beyond the arguments and evidence presently in the record was unnecessary, and that the narrow issue to be addressed was the motivation to combine the PDP Context feature of the GPRS Standards that enables the subscriber unit to “maintain a communication session” with a CDMA network as required by claim 8. Paper 54, 2–3. We authorized Petitioner to file a paper containing a numeric listing of citations to the existing record

indicating where the evidence pertaining to this issue was originally introduced or argued in the Petition (*id.* at 3).

C. Related Proceedings

The parties represent that the '244 patent is the subject of the following judicial proceedings: (1) *InterDigital Commc'ns Inc. v. ZTE Corp.*, Case No. 13-cv-00009-RGA (D. Del.), filed January 2, 2013; (2) *InterDigital Commc'ns Inc. v. Nokia Corp.*, Case No. 13-cv-00010-RGA (D. Del.), filed January 2, 2013; and (3) *InterDigital Commc'ns Inc. v. Samsung Elec. Co. Ltd.*, Case No. 13-cv-00011-RGA (D. Del.), filed January 2, 2013. Pet. 2; Paper 6, 2.

D. The '244 Patent (Ex. 1001)

The '244 patent is directed to a system and method of short-range, high-speed, and long-range, lower-speed, data communications using a dual-mode unit. Ex. 1001, Abstract. The wireless communication path is selected based on a request to establish a communication session between first and second sites, by first determining whether the first wireless digital communication path is available. *Id.* at 3:19–22. The first wireless communication path is a wireless LAN connection, and the second wireless communication path is a cellular connection. *Id.* at 3:23–28. The '244 patent describes several embodiments for indicating availability of the first wireless communication mode. *Id.* at 3:44–54. For example, if the first wireless communication path is unavailable, the communication session is established using the second wireless communication path, and “the local wireless transceiver is controlled to make it appear to the second wireless

digital communication path as though the bandwidth were continuously available during the communication session, irrespective of any actual need to transport data communication signals between said first and second sites.” *Id.* at 3:60–4:1.

In another example, the second wireless digital communication path “is provided by establishing a logical connection using a higher layer protocol, such as a network layer protocol” from a subscriber unit to an intended peer node. *Id.* at 4:5–11. The network layer logical connection “is made through a wireless channel that provides a physical layer connection between the portable computer node, through a base station, and the intended peer node.” *Id.* at 4:11–14. The physical layer channel is released, “while maintaining the appearance of a network layer connection to the higher level protocols.” *Id.* at 4:16–18. The ’244 patent contemplates that the physical links “are preferably known wireless communication air interfaces using digital modulation techniques such as [the] Code Division Multiple Access (CDMA) standard [O]ther wireless communication protocols and other types of links 30 may also be used to advantage with the invention.” *Id.* at 5:31–37.

This embodiment is illustrated in Figure 6, reproduced below:

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