

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CLEARWIRE CORPORATION and CLEAR WIRELESS LLC
Petitioners

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC
Patent Owner

Case IPR2013-00306
Patent 5,590,403

Before HOWARD B. BLANKENSHIP, JONI Y. CHANG,
MIRIAM L. QUINN, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Clearwire Corporation and Clear Wireless LLC (“Clearwire” or “Petitioners”) filed a Petition to institute *inter partes* review of claims 1, 10, and 11 of Patent 5,590,403 (the “’403 patent”) pursuant to 35 U.S.C. § 311 *et seq.* Paper 1 (“Pet.”). Mobile Telecommunications Technologies, LLC (“MTEL” or “Patent Owner”) timely filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides as follows:

THRESHOLD – The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.

Petitioners contend that claims 1, 10, and 11 (“the challenged claims”) are unpatentable under 35 U.S.C. §§ 102 and/or 103 based on the following specific grounds (Pet. 3-7, 15-57):

| Reference[s] | Basis | Claims challenged |
|-----------------------------|-------|-------------------|
| AMPS ¹ | § 102 | 1, 10, and 11 |
| Gilhousen ’472 ² | § 102 | 1, 10, and 11 |

¹ Z.C. Fluhr and P.T. Porter, *Advanced Mobile Phone Service: Control Architecture*, 58 BELL SYS. TECHNICAL J. 43-69 (1979) (Exhibit 1005) (“AMPS”).

² U.S. Patent No. 5,280,472 (Exhibit 1006) (“Gilhousen ’472”).

| Reference[s] | Basis | Claims challenged |
|-------------------------------------|-------|-------------------|
| Gilhousen '390 ³ | § 102 | 1, 10, and 11 |
| Gilhousen '501 ⁴ | § 102 | 1, 10, and 11 |
| Paulraj ⁵ | § 102 | 1 and 10 |
| Linguist ⁶ | § 102 | 1, 10, and 11 |
| Bollinger ⁷ | § 102 | 1 and 10 |
| Linguist and Uddenfelt ⁸ | § 103 | 1, 10 and 11 |
| Linguist and Gilhousen '501 | § 103 | 1, 10, and 11 |
| Linguist and Winters ⁹ | § 103 | 1, 10, and 11 |
| Linguist and Anderson ¹⁰ | § 103 | 1, 10, and 11 |
| Paulraj and Uddenfelt | § 103 | 1, 10, and 11 |
| Paulraj and Gilhousen '390 | § 103 | 1, 10, and 11 |
| Paulraj and Linguist | § 103 | 1, 10, and 11 |

³ U.S. Patent No. 5,109,390 (Exhibit 1007) (“Gilhousen '390”).

⁴ U.S. Patent No. 5,101,501 (Exhibit 1008) (“Gilhousen '501”).

⁵ U.S. Patent No. 5,345,599 (Exhibit 1009) (“Paulraj”).

⁶ U.S. Patent No. 5,423,056 (Exhibit 1010) (“Linguist”).

⁷ U.S. Patent No. 5,195,090 (Exhibit 1011) (“Bollinger”).

⁸ U.S. Patent No. 5,109,528 (Exhibit 1012) (“Uddenfelt”).

⁹ Jack H. Winters, Jack Salz, and Richard D. Gitlin, *The Impact of Antenna Diversity on the Capacity of Wireless Communication Systems*, 42 IEEE TRANSACTIONS ON COMM. 1740-1751 (1994) (Exhibit 1013) (“Winters”).

¹⁰ Sören Anderson, Mille Millnert, Mats Viberg, and Bo Wahlberg, *An Adaptive Array for Mobile Communication Systems*, 40 IEEE TRANSACTIONS ON VEHICULAR TECH. 230-236 (1991) (Exhibit 1014) (“Anderson”).

| Reference[s] | Basis | Claims challenged |
|--|--------------|--------------------------|
| Paulraj and Winters | § 103 | 1 and 10 |
| Paulraj and Anderson | § 103 | 1, 10, and 11 |
| Gilhousen '501 and Uddenfelt | § 103 | 1, 10, and 11 |
| Gilhousen '501 and Paulraj | § 103 | 1, 10, and 11 |
| Gilhousen '501 and Winters | § 103 | 1, 10, and 11 |
| Gilhousen '501 and Anderson | § 103 | 1, 10, and 11 |
| Gilhousen'472 and Uddenfelt | § 103 | 1, 10, and 11 |
| Gilhousen '472 and Paulraj | § 103 | 1, 10, and 11 |
| Gilhousen '472 and Winters | § 103 | 1, 10, and 11 |
| Gilhousen '472 and Anderson | § 103 | 1, 10, and 11 |
| Gilhousen '472 and Gilhousen '390 and Gilhousen '501 | § 103 | 1, 10, and 11 |
| Gilhousen '390 and Uddenfelt | § 103 | 1, 10, and 11 |
| Gilhousen '390 and Winters | § 103 | 1, 10, and 11 |
| Gilhousen '390 and Anderson | § 103 | 1, 10, and 11 |
| Bollinger and Uddenfelt | § 103 | 1, 10, and 11 |
| Bollinger and Gilhousen '501 | § 103 | 1, 10, and 11 |
| Bollinger and Paulraj | § 103 | 1, 10, and 11 |
| Bollinger and Winters | § 103 | 1 and 10 |
| Bollinger and Anderson | § 103 | 1, 10, and 11 |

For the reasons described below, we determine that the present record demonstrates a reasonable likelihood that Petitioners will prevail in establishing the unpatentability of all the challenged claims. Accordingly, we GRANT the petition for *inter partes* review of the '403 patent as to claims 1, 10 and 11 based on the authorized grounds, as discussed below.

II. PRELIMINARY MATTERS

Before delving into the analysis of the '403 patent and the authorized grounds, we address Patent Owner's contentions regarding the current state of the litigation in which the '403 patent is involved.

First, the '403 patent is the subject matter of the following co-pending district court litigations: *MTEL v. Clearwire*, Case No. 2:12-cv-308 (E.D.Tex.); *MTEL v. Sprint Nextel Corp.*, Case No. 2:12-cv-832 (E.D. Tex.); and *MTEL v. Apple, Inc.*, Case No. 2:13-cv-258 (E.D.Tex.). Pet. 1-2; Prelim. Resp. 10.

Second, Patent Owner contends that, considering the status of the pending litigation identified above and the date of expiration of the '403 patent, the Board must deny the Petition in the interests of justice. Prelim. Resp. 9-10. Specifically, Patent Owner argues that the district court case against Petitioners is scheduled for a trial on the merits on February 3, 2014, and that the other pending district court cases also involve patents not at issue in this proceeding. *Id.* According to Patent Owner, instituting *inter partes* review would not promote settlement of the pending district court cases. *Id.* The argument of Patent Owner involves speculation as to the timing and impact of the district court action and this proceeding. The Board recognizes the various interests of the parties involved in this

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