

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION AND HTC AMERICA, INC.,
Petitioner,

v.

INVT SPE LLC,
Patent Owner.

Cases IPR2018-01555 and IPR2018-01581¹
Patent 7,848,439 B2

Before THU A. DANG, KEVIN F. TURNER, and
BARBARA A. BENOIT, *Administrative Patent Judges*.

BENOIT, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ These cases have not been consolidated.

I. INTRODUCTION

We instituted *inter partes* review of U.S. Patent No. 7,848,439 B2 (Ex. 1001, “the ’439 patent” or “the challenged patent”)² in two proceedings—IPR2018-01555 (“IPR1555”) and IPR2018-01581 (“IPR1581”)—based on petitions filed by the same petitioner (HTC Corporation and HTC America, Inc., collectively “Petitioner”). (“IPR1581”). *See* IPR1555, Paper 8 (“IPR1555 Dec.”), Paper 10; IPR1581, Paper 9³ (“IPR1581 Dec.”). The challenged patent is owned by INVT SPE LLC (“Patent Owner”).

In IPR1555, we instituted review of claims 1–7 of the ’439 patent on March 7, 2019 and, in a scheduling order issued the same day, we set an oral hearing for December 17, 2019 (among other due dates). *See generally* IPR1555 Dec.; IPR1555 Paper 9 (Scheduling Order). In IPR1581, we instituted review of independent claim 8 of the ’439 patent on April 1, 2019 and, in a scheduling order issued the same day, we set an oral hearing for January 8, 2019 (among other due dates). *See generally* IPR1581 Dec.; IPR1555 Paper 10 (Scheduling Order).

² The challenged patent is Exhibit 1001 in both IPR1555 and IPR1581.

³ An error occurred during initial uploading of the Decision to Institute and Scheduling Order to the PTAB End-to-End information technology system (PTAB E2E). Papers 7 and 8 were created in PTAB E2E and then immediately expunged. The Decision to Institute and Scheduling Order then were uploaded a second time to PTAB E2E as Papers 9 and 10, respectively. As a result, the respective caption pages of the Decision to Institute and the Scheduling Order each indicate incorrect paper numbers (Papers 7 and 8), rather than the correct paper numbers (Paper 9 and 10).

II. THE CHALLENGES

The challenges brought by Petitioner in IPR1555 and IPR1581 have substantial similarities. The independent claims challenged in each proceeding have many identical limitations, as illustrated in the following chart that italicizes the limitations that are identical.

Claim 1 (Challenged in IPR1555)	Claim 8 (Challenged in IPR1581)
<p>1. <i>A communication apparatus comprising:</i> <i>a channel estimating section that carries out a channel estimation per subband;</i> <i>a parameter deciding section that decides modulation parameters and coding parameters per subband group comprised of a plurality of the subbands, based on a result of the channel estimation per subband;</i> <i>a parameter information transmission section that transmits, to a communicating party, parameter information indicating the modulation parameters and the coding parameters decided at the parameter deciding section;</i> <i>a receiving section that receives a signal containing data modulated and encoded on a per subband group basis at the communicating party using the modulation parameters and the coding parameters of the parameter information transmitted at the parameter information transmission section;</i> <i>a data obtaining section that demodulates and decodes the received signal received at the receiving section on a per subband group basis using the modulation parameters and the coding parameters decided at the parameter deciding section, and obtains the data contained in the received signal; and</i></p>	<p>8. <i>A communication apparatus comprising:</i> <i>a channel estimating section that carries out a channel estimation per subband;</i> <i>a parameter deciding section that decides modulation parameters and coding parameters per subband group comprised of a plurality of the subbands based on a result of the channel estimation per subband;</i> <i>a parameter information transmission section that transmits to a communicating party, parameter information indicating the modulation parameters and the coding parameters decided at the parameter deciding section;</i> <i>a receiving section that receives a signal containing data modulated and encoded per subband group at the communicating party, using the modulation parameters and coding parameters of the parameter information transmitted at the parameter information transmission section; and</i> <i>a data obtaining section that demodulates and decodes the received signal received at the receiving section on a per subband group basis, using the modulation parameters and the coding parameters decided at the parameter deciding section, and obtains the data contained in the received signal;</i></p>
<p>a pattern storage section that stores in advance patterns for selecting subbands constituting the subband groups wherein the parameter deciding section decides the modulation parameters and the coding parameters per subband group comprised of the subbands selected based on the patterns stored in the pattern storage section.</p>	<p>wherein the parameter deciding section decides the coding parameters in such a manner that a number of information bits obtained by assigning a weight per subband group to a sum of information bits that are able to be assigned to all of the subbands within the subband group, is assigned to the subband group.</p>

See Ex. 1001, 12:65–13:27 (claim 1), 13:65–14:26 (claim 8).

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Furthermore, Petitioner applies the following prior art⁴ in each proceeding:

U.S. Patent No. 6,904,283 B2, filed April 17, 2001, issued June 7, 2005 (Ex. 1003, “Li”);

U.S. Patent No. 7,221,680 B2, filed September 1, 2004, issued May 22, 2007 (Ex. 1004, “Vijayan”); and

U.S. Patent No. 6,721,569 B1, filed September 29, 2000, issued April 13, 2004 (Ex. 1005, “Hashem”).

In IPR1581, Petitioner also asserts the following reference:

U.S. Patent No. 5,596,604, filed August 17, 1993, issued January 21, 1997 (Ex. 1006, “Cioffi”).

More particularly, the asserted ground at issue in IPR1555 is whether claims 1–7 are unpatentable as obvious under 35 U.S.C. § 103 over Li, Vijayan, and Hashem. The asserted ground at issue in IPR1581 is whether independent claim 8 of the ’439 patent as unpatentable under 35 U.S.C. § 103 over Li, Vijayan, Hashem, and Cioffi. IPR1581 Dec. 7–8.

In IPR1581, Petitioner cites to Cioffi as teaching using weighting per subchannel in combination with the cluster groups taught by Li and subband groups taught by Vijayan as teaching or suggesting limitation the wherein limitation recited in independent claim 8 but not recited in independent claim 1: “wherein the parameter deciding section decides the coding parameters in such a manner that a number of information bits obtained by assigning a weight per subband group to a sum of information bits that are able to be assigned to all of the subbands within the subband group, is assigned to the subband group.” IPR1581 Dec. 36 (citing Pet. 30).

⁴ The same exhibit numbers are used for these references in both IPR1555 and IPR1581.

Petitioner also relies on declaration testimony by Dr. Zhi Ding (Exhibit 1007⁵) in both IPR1555 and IPR1581.

As noted in our Scheduling Order issued in IPR1581 (Paper 10), Patent Owner has the option to receive preliminary guidance from the Board on a motion to amend filed in that proceeding. *See Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 84 Fed. Reg. 9497 (Mar. 15, 2019) (“MTA Pilot Program Notice”). In that Scheduling Order, we referred the parties to the Board’s Guidance on Motions to Amend in view of *Aqua Products* (<https://go.usa.gov/xU6YV>), and *Lectrosionics, Inc. v. Zaxcom, Inc.*, Case IPR2018-01129 (Paper 15) (PTAB Feb. 25, 2019) (precedential). The MTA Pilot Program Notice does not automatically apply to IPR1555.

III. DISCUSSION

A conference call between the parties and the panel will be held on **Wednesday, April 10, 2019 commencing at 2:30 pm Eastern Time**. Prior to the call, the parties should meet and confer regarding ways in which these two *inter partes* reviews can be consolidated or otherwise conducted in light of the significant overlap of the proceedings. Such proposals by the parties should explicitly consider how Motions to Amend filed are to be handled in any consolidated proceeding. The parties should come prepared to discuss their proposals with the panel.

It is so ORDERED.

⁵ The same exhibit number is used in both IPR1555 and IPR1581.

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