Trials@uspto.gov
Tel: 571-272-7822

Paper 7
Entered: November 6, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

MPH TECHNOLOGIES OY,
Patent Owner.

Case IPR2019-00823
Patent 9,712,494 B2

Before SALLY C. MEDLEY, KAMRAN JIVANI, and JOHN D. HAMANN, *Administrative Patent Judges.*

HAMANN, *Administrative Patent Judge*.

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

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 1–11 of U.S. Patent No. 9,712,494 B2 (Ex. 1001, "the '494 patent") pursuant to 35 U.S.C. § 311. MPH Technologies Oy ("Patent Owner") filed a Patent Owner Preliminary Response (Paper 6, "Prelim. Resp.").

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). An *inter partes* review may be instituted if "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." 35 U.S.C. § 314(a). On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the Petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

Upon consideration of the Petition and the Preliminary Response, we determine that the information presented shows there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one challenged claim of the '494 patent. Accordingly, we institute *inter partes* review on all of the challenged claims based on all of the grounds identified in the Petition.

A. Related Matter

The parties identify *MPH Techs. Oy v. Apple Inc.*, Case No. 4:18-cv-05935-PJH, in the U.S. District Court for the Northern District of California, as a matter that may affect or would be affected by a decision in this proceeding. Pet. 2; Paper 4, 1. The parties also identify as related matters

the following additional *inter partes* reviews: IPR2019-00822, IPR2019-00824, IPR2019-00825, and IPR2019-00826. Pet. 2; Paper 4, 1.

B. The Challenged Patent (Ex. 1001)

The '494 patent relates to the "secure forwarding of a message from a first computer to a second computer via an intermediate computer in a telecommunication network." Ex. 1001, 6:38–41. According to the '494 patent, "[a]n essential idea of [its] invention is to use the standard [Internet Protocol ('IP') Security ('IPSec')] protocol . . . between the intermediate computer and the second computer and an 'enhanced IPSec protocol' between the first computer and the intermediate computer." *Id.* at 7:38–41, 1:54. More specifically, the '494 patent states that "[t]he advantage of [its] invention is that [a] logical IPSec connection shared by the first and the second computer can be enhanced by the first and the intermediate computer without involvement of the second computer." *Id.* at 10:38–41. The '494 patent adds: "[i]n particular[,] the so-called 'ingress filtering' performed by some routers [(e.g., the second computer)] does not pose any problems when translations of addresses are used." *Id.* at 10:41–44.

Figure 1, shown below, "illustrates an example of a telecommunication network of the invention" of the '494 patent. *Id.* at 9:55–56.

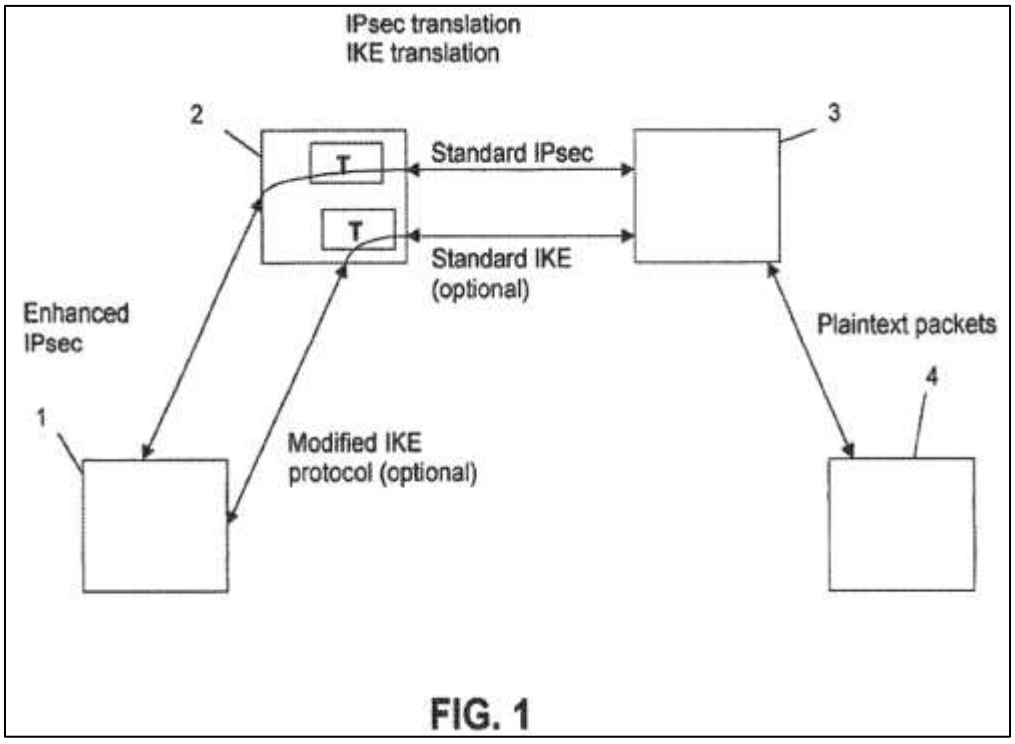

FIG. 1

Figure 1 shows an example of a telecommunication network in accordance with the invention of the '494 patent. *Id.* at 10:4–5. As illustrated, the network comprises: (i) a first computer (client computer 1) that is served by (ii) an intermediate computer (server 2), and (iii) host computer 4 that is served by (iv) a second computer (security gateway 3). *Id.* at 10:4–9. Security gateway 3 "supports the standard IPSec protocol," while client computer 1 and server 2 support an enhanced IPSec protocol. *Id.* at 10:9–12. The '494 patent discloses that the first computer (i.e., client computer 1) in Figure 1 is a mobile terminal. *Id.* at 11:5–7, 11:13–14.

"In the example of F[igure] 1, an IPSec connection is formed between . . . client computer 1 (the first computer) and . . . security gateway 3 (the second computer)." *Id.* at 10:46–48. The '494 patent discloses that "[m]essages to be sent to . . . host terminal 4 from . . . client computer 1 are first sent to . . . server 2, wherein an IPSec translation[, *inter alia*,] . . . takes place." *Id.* at 10:60–62. Put differently, "[w]hen the intermediate computer

receives the packet sent . . ., it performs an address and [Security Parameters Index ('SPI')] translation, ensuring that the security gateway (host 3 of F[igure] 1) can accept the packet." *Id.* at 12:1–4, 2:40–41. The '494 patent states that "translation[s can be] . . . performed[, for example,] by means of a translation table stored at the intermediate computer[,with t]he outer IP header address fields and/or the SPI-values [being] changed by the intermediate computer so that the message can be forwarded to the second computer." *Id.* at 7:46–50.

According to the '494 patent, "[m]ost of the packet is secured using IPSec, . . . [but] the intermediate computer . . . is able to use the outer IP addresses and the incoming SPI value to determine how to modify the outer address and the SPI to suite the second computer, which is the next destination." *Id.* at 12:1–11. "[T]he confidentiality of the packets is not compromised, . . . [because t]he intermediate computer does not know the cryptographic keys used to encrypt and/or authenticate the packets, and can thus not reveal their contents," according to the '494 patent. *Id.* at 10:26–37. After translation, "the message can be sent to . . . security gateway 3, which sends the message further in plain text to . . . host terminal 4." *Id.* at 10:60–64.

C. The Challenged Claims

Petitioner challenges claims 1–11 of the '494 patent, of which claim 1 is the sole independent claim. Claim 1 is illustrative of the challenged claims and is reproduced below:

> 1. An intermediate computer for secure forwarding of messages in a telecommunication network, comprising:
>
> an intermediate computer configured to connect to a telecommunication network;

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.