

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTOROLA MOBILITY LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2020-00038
Patent 6,868,079 B1

Before SALLY C. MEDLEY, JEFFREY S. SMITH, and GARTH D. BAER,
Administrative Patent Judges.

MEDLEY, *Administrative Patent Judge.*

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

I. INTRODUCTION

Motorola Mobility LLC (“Petitioner”) filed a Petition for *inter partes* review of claim 17 of U.S. Patent No. 6,868,079 B1 (Ex. 1001, “the ’079 patent”). Paper 2 (“Pet.”).¹ Uniloc 2017 LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . 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) (2012). Upon consideration of the Petition and Preliminary Response, we conclude the information presented shows that there is a reasonable likelihood that Petitioner would prevail in showing the unpatentability of the challenged claim.

A. Related Matters

Petitioner and Patent Owner indicate that the ’079 patent is the subject of several court proceedings, as well as *inter partes* review proceeding IPR2019-00510 (“IPR510”). Pet. 2–3; Prelim. Resp. 6–7. The ’079 patent also is the subject of IPR2020-00420, for which a decision whether to institute *inter partes* review has not yet been rendered.²

B. The ’079 Patent

The ’079 patent describes “a method of operating a radio communication system,” where the radio communication system is “required to be able to exchange [signaling] messages between a Mobile Station (MS)

¹ Petitioner identifies Motorola Mobility LLC, Motorola Mobility Holding LLC, and Lenovo Group Limited as real parties-in-interest. Pet. 2.

² Neither party notified the Board of the IPR2020-00420 proceeding. The parties are reminded that within 21 days of a change of information listed in mandatory notices, they must update such information. 37 C.F.R. § 42.8.

and a Base Station (BS).” Ex. 1001, 1:7–8, 1:18–20. The ’079 patent further describes that an object of the invention “is to improve the efficiency of the method by which a MS requests resources from a BS.” *Id.* at 1:56–58. The ’079 patent describes a secondary station (*i.e.*, MS) transmitting a request for resources to a primary station (*i.e.*, BS) in a time slot allocated to the secondary station, where the secondary station re-transmits the request in at least a majority of its allocated time slots until an acknowledgment is received from the primary station. *Id.* at 1:60–67. Because there is no possibility of requests from different secondary stations colliding, a secondary station can retransmit requests in each allocated time slot. *Id.* at 2:3–5. Further, the primary station can improve the accuracy with which it determines whether a request was sent by a particular secondary station if the received signal strength is close to the detection threshold by examining the received signals in multiple time slots allocated to the secondary station in question. *Id.* at 2:9–14.

An example of a radio communication system is illustrated in Figure 1, reproduced below.

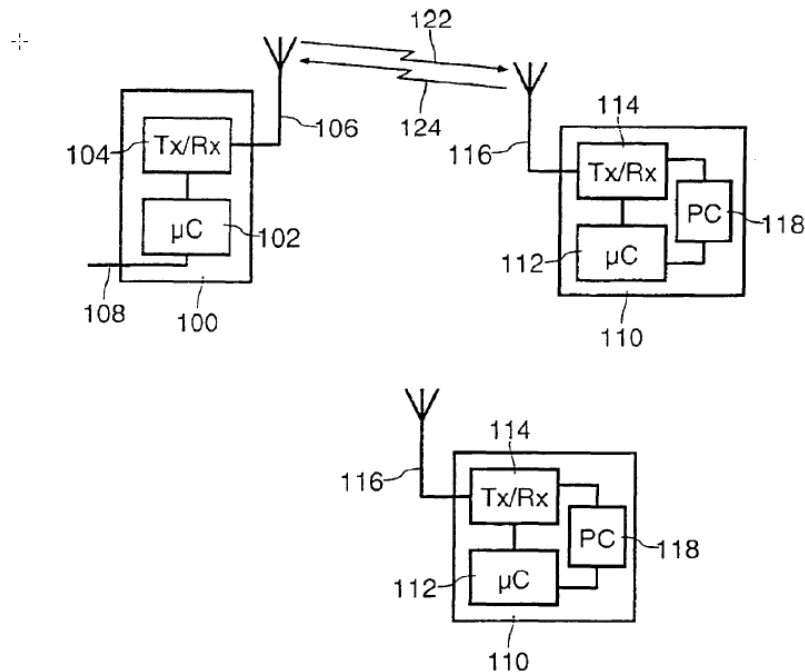


FIG. 1

Figure 1 is a block diagram of a radio communication system comprising a primary station (BS) 100 and a plurality of secondary stations (MS 110). *Id.* at 3:10–12. Communication from BS 100 to MS 110 takes place on a downlink channel 122, while communication from MS 110 to BS 100 takes place on an uplink channel 124. *Id.* at 3:19–21.

C. Illustrative Claim

Petitioner challenges independent claim 17 of the '079 patent. Claim 17 is reproduced below.

17. A method of operating a radio communication system, comprising:

allocating respective time slots in an uplink channel to a plurality of respective secondary stations; and

transmitting a respective request for services to establish required services from at least one of the plurality of respective secondary stations to a primary station in the respective time slots;

wherein the at least one of the plurality of respective secondary stations re-transmits the same respective request in consecutive allocated time slots without waiting for an acknowledgement until said acknowledgement is received from the primary station,

wherein the primary station determines whether a request for services has been transmitted by the at least one of the plurality of respective secondary stations by determining whether a signal strength of the respective transmitted request of the at least one of the plurality of respective secondary stations exceeds a threshold value.

Ex. 1001, 8:12–33.

D. Asserted Grounds of Unpatentability

Petitioner asserts that claim 17 would have been unpatentable on the following grounds:

| Claim Challenged | 35 U.S.C. § | References |
|------------------|---------------------|---|
| 17 | 103(a) ³ | Merakos ⁴ (via incorporation-by-reference of Kay ⁵), Alamouti ⁶ |
| 17 | 103(a) | Merakos (via incorporation-by-reference of Kay), Borth ⁷ |

³ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103. Because the ’079 patent has an effective filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of 35 U.S.C. §§ 102 and 103.

⁴ US 5,521,925, issued May 28, 1996 (Ex. 1003, “Merakos”).

⁵ US 5,299,198, issued Mar. 29, 1994 (Ex. 1004, “Kay”).

⁶ US 5,933,421, issued Aug. 3, 1999 (Ex. 1006, “Alamouti”).

⁷ US 4,829,543, issued May 9, 1989 (Ex. 1005, “Borth”).

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