

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

IPR2020-00420
Patent 6,868,079 B1

Before JAMESON LEE, SALLY C. MEDLEY, and JASON M. REPKO,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

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

I. INTRODUCTION

Ericsson Inc. (“Petitioner”) filed a Petition for *inter partes* review of claims 1–5, 7, and 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). For reasons discussed below, however, we do not reach the substantive merit of any argument based on the content of prior art. We also do not reach arguments about discretionary denial under 35 U.S.C. § 325(d). Instead, we discretionarily deny the Petition under 35 U.S.C. § 314(a).

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 proceedings IPR2019-00510 (“IPR510” (filed by Apple Inc., LG Electronics Inc., Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. and for which trial was instituted on July 25, 2019)) and IPR2020-00038 (“IPR038” (filed by Motorola Mobility LLC and for which trial was instituted on April 13, 2020)). Pet. 2–3; Prelim. Resp. 6–7.

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) and a Base Station

¹ Petitioner identifies each of Ericsson Inc. and Telefonaktiebolaget LM Ericsson as a real party-in-interest. Pet. 2.

(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.

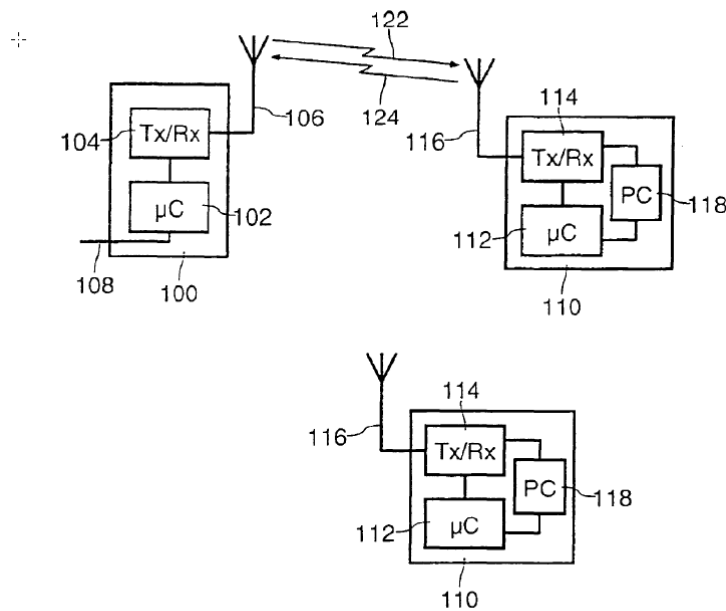


FIG. 1

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 Claims

Claims 1 and 17 are independent. Both are directed to a method for operating a radio communication system and both are reproduced below:

1. [1.pre] A method of operating a radio communication system, comprising:

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

[1.b] transmitting a respective request for services to establish required services from at least one of the respective secondary stations to a primary station in the respective time slots;

[1.c] wherein the at least one 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,

[1.d] wherein the primary station determines whether a request for services has been transmitted by the at least one respective secondary station from a combination of the received signals in a plurality of successive time slots allocated to the at least one respective secondary station.

Ex. 1001, 6:1–19.² The bracketed annotations are added to correspond to Petitioner’s annotations. Pet. 31–47.

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

² In the first wherein clause, claim 1 of the ’079 patent uses “re,transmit” where “re-transmit” appears to be intended. We regard “re,transmit” as a misspelling and read the wherein clause as reciting “re-transmit.”

- [17.a] allocating respective time slots in an uplink channel to a plurality of respective secondary stations; and
- [17.b] 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;
- [17.c] 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,
- [17.d] 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. The bracketed annotations are added to correspond to Petitioner’s annotations. Pet. 55–56.

Claim 1 reads essentially the same as claim 17, except that the second wherein clause of the two claims, i.e., limitations [1.d] and [17.d], are substantively different.³

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:⁴

³ Insignificant differences include a misspelling in claim 1 of the word “retransmit” as “re,transmit,” and claim 1’s reciting “one of the” or just “one,” instead of “one of the plurality of,” ahead of “respective secondary stations,” as does claim 17.

⁴ Petitioner also relies on the Declaration of Vijay K. Madiseti, Ph. D. Ex. 1007.

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