

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

IPR2022-00459
Patent 8,798,658 B2

Before SHARON FENICK, STEVEN M. AMUNDSON, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

A. *Background and Summary*

Apple Inc. (“Petitioner”) filed a petition for *inter partes* review challenging claims 1–5, 12–16, 22–24, 26–28, and 30 (“challenged claims”) of U.S. Patent 8,798,658 B2 (Ex. 1001 (“’658 patent”)). Paper 1 (“Pet.” or “Petition”). Telefonaktiebolaget LM Ericsson (“Patent Owner”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

The Board has authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the Petition and the Preliminary 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.” For the reasons that follow, we institute an *inter partes* review as to the challenged claims of the ’658 patent on all grounds of unpatentability presented.

B. *Real Parties in Interest*

Petitioner identifies only itself as the real party in interest. Pet. 77.

Patent Owner identifies Telefonaktiebolaget LM Ericsson and Ericsson Inc. as the real parties in interest. Paper 5 (Patent Owner’s Mandatory Notices), 2.

C. *Related Matters*

Petitioner and Patent Owner each indicate the ’658 patent was previously challenged in IPR2021-00537. Pet. 77; Paper 5, 2. Petitioner notes that this IPR was terminated pursuant to a settlement prior to a preliminary response. Pet. 75.

D. The '658 Patent

The '658 patent is titled “Minimizing Drive Test Logged Data Reporting” and generally relates to “network based control of report messages comprising logged measurements in a wireless communications network.” Ex. 1001, codes (54), (57), 1:14–19. The '658 patent describes situations in which a user equipment (UE) has stored logged data for reporting that is bigger than the size of a report message, and the UE “sends only a portion of the logged measurements that fits into a single report message” in each report message to a network node and multiple partial report messages are sent. *Id.* at code (57), 3:22–32. A partial report message may also contain an indication that more logged measurements exist at the UE. *Id.* at code (57), 3:27–32.

The '658 patent describes, as background, that according to 3GPP radio access technology, UE's may take measurements called Minimizing Drive Tests (MDT) measurements, maintain a log of MDT measurements, and report the logged measurements to a network node upon request of the network node. *Id.* at 2:4–36. A UE may include a UE buffer for storing logged measurements. *Id.* at 5:32–35. The '658 patent discloses that, in the MDT implementation then current, “logging of measurements . . . may only be done when the UE is in ‘idle’ state and the sending of logged measurements (MDT logs) in report messages may only be done when the UE is in the ‘connected’ state.” *Id.* at 9:47–51; *see id.* at 2:41–42.

According to one exemplary embodiment, a network node's communications interface sends a request to UE 30 to start transmitting logged measurements in report messages and receives the report messages comprising the logged measurements. *Id.* at 5:49–53.

One embodiment, focused on the network node's actions and determinations, is depicted in Figure 3, reproduced immediately below. *Id.* at 7:58–59.

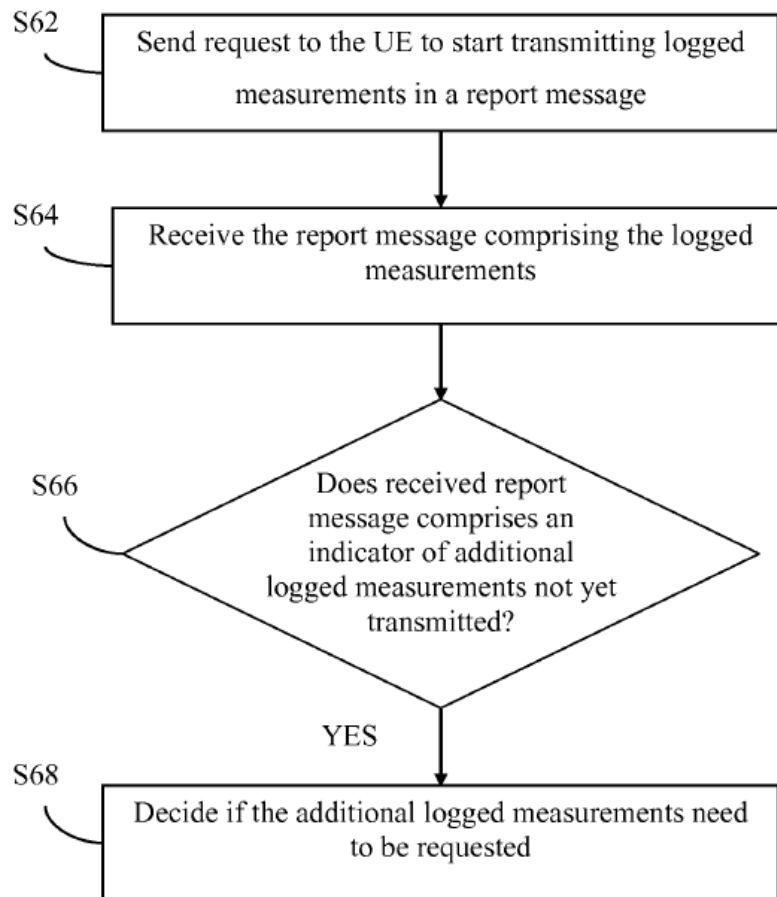


Fig. 3

Figure 3 depicts a flow chart including actions and a decision by the network node. *Id.* The network node decides to send a request to the UE to start reporting, and receives a report message as a response. *Id.* at 7:66–67, Fig. 3 (step S62). The network node receives a report message comprising the logged measurements. *Id.* at 7:67–8:1, Fig. 3 (step S64). The network

determines whether the received report message comprises an indicator of additional logged measurements not yet transmitted. *Id.* at 8:1–3, Fig. 3 (step S66). If so, the network node decides if the additional logged measurements need to be requested. *Id.* at 8:3–5, Fig. 3 (step S68). In another embodiment, these steps are preceded by the network node receiving from the UE, in existing signaling, an indication of the existence¹ and availability of logged measurements. *Id.* at 5:61–67; 8:9–15, Fig. 4.

One embodiment, focused on the UE’s actions and determinations, is depicted in Figure 6, reproduced immediately below. *Id.* at 8:50–53.

¹ The claims and specification of the ’658 patent use the word “existents” in an apparent typographical error for the word “existence.” Ex. 1001, 4:21–24, 5:61–64, 6:61–65, 8:9–13, Fig. 4 (element S71), 12:40–42 (claim 2), 13:24–27 (claim 12), 14:45–49 (claim 26); *see* Pet. 7–8. A certificate of correction was requested and issued, but does not address this issue. Ex. 1002, 317–325. As we hereby institute, the parties may address this issue in the briefing if they choose.

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