

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

IPR2022-00464
Patent 10,193,600 B2

Before NATHAN A. ENGELS, SHARON FENICK, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

ENGELS, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Apple Inc. filed a Petition requesting an *inter partes* review of claims 1–28 of U.S. Patent No. 10,193,600 B2 (Ex. 1001, “the ’600 patent”). Paper 1 (“Pet.”), 1. Patent Owner filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Petitioner submitted the Declaration of Dr. Apostolos K. Kakaes. (Ex. 1003) in support of the Petition, and Patent Owner submitted the Declaration of Dr. Muriel Médard (Ex. 2001) in support of the Preliminary Response.

An *inter partes* review may not be instituted unless it is determined that “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 (2018). For the reasons provided below and based on the record currently before us, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims. Patent Owner has not persuaded us that we should exercise our discretion to deny institution of trial. Accordingly, we institute an *inter partes* review on all grounds set forth in the Petition.

B. Real Parties in Interest

Petitioner states that Apple Inc. is the real party in interest. Pet. 65. Patent Owner states that Telefonaktiebolaget LM Ericsson and Ericsson Inc. are the real parties in interest. Paper 5, 1.

C. Related Proceedings

Petitioner states that it “is not aware of any related matters that may affect, or may be affected by, decisions in this proceeding.” Pet. 65. Patent Owner states that the ’600 patent was challenged in *Samsung Electronics Co. v. Telefonaktiebolaget LM Ericsson*, IPR2021-00730, which was filed March 26, 2021 and is now terminated. Paper 5, 2. Patent Owner also states that the ’600 patent is the subject of *Ericsson Inc. v. Samsung Electronics Co.*, Case No. 2:20-cv-00380 (E.D. Tex.), filed December 11, 2020. Paper 5, 2.

D. The ’600 Patent (Ex. 1001)

The ’600 patent describes systems and methods for wireless communications in which nodes in a wireless network (eNodeB) signals a codebook subset restriction (“CSR”) to a user’s wireless device (“user equipment” or “UE”). Ex. 1001, 6:20–25. The ’600 patent states that the UE then sends a channel state information (“CSI”) report back to the network suggesting a subset of possible precoders available for communication with the UE, with the subset being restricted by the signaled CSR configuration. Ex. 1001, 6:25–32.

Codebook subset restriction can be configured based on the rank of a channel, which is the number of spatial streams that can be sent to a particular UE. Ex. 1003 ¶ 40. The challenged claims relate to rank-agnostic CSR signaling that jointly restricts the precoders in a group without regard to the precoders’ transmission rank. Ex. 1001, 3:12–15.

E. Illustrative Claims

Claims 1, 8, 15, and 22 are independent claims. Claim 1 is illustrative and is reproduced below with bracketed labels added to reflect those references by Petitioner.

1. [preamble] A method implemented by a network node for signaling to a wireless communication device which precoders in a codebook are restricted from being used, the method characterized by:

[1.1] generating codebook subset restriction signaling that, for each of one or more groups of precoders, jointly restricts the precoders in the group

[1.2] by restricting a certain component that the precoders in the group have in common, wherein the codebook subset restriction signaling is rank-agnostic signaling that jointly restricts the precoders in a group without regard to the precoders' transmission rank; and

[1.3] sending the generated signaling from the network node to the wireless communication device.

F. Asserted Challenges to Patentability

Petitioner challenges the patentability of claims 1–28 of the '600 patent as follows (Pet. 2):

Claim(s) Challenged	35 U.S.C. §	References/Basis
1–28	103 ¹	Novlan ²
1–28	103	Novlan, 36.213 ³

¹ The '600 patent's earliest priority date falls after the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112–29, 125 Stat. 284 (2011), took effect. Thus, we apply the AIA version of § 103.

² US Publication No. 2014/0016549 A1; publ. Jan. 16, 2014. Ex. 1005.

³ "Evolved Universal Terrestrial Radio Access (E-UTRA); Physical Layer Procedures," 3GPP TS 36.213, Version 12.3.0 (Release 12). Ex. 1006.

II. DISCUSSION

A. *Discretionary Denial*

Patent Owner asks the Board to exercise its discretion to deny institution under 35 U.S.C. § 325(d). Prelim. Resp. 23–30 (citing *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 8 (PTAB Feb. 13, 2020) (precedential); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17-18 (PTAB Dec. 15, 2017) (precedential)).

Section 325(d) provides that the Director has discretion to reject a petition if “the same or substantially the same prior art or arguments previously were presented to the Office.” The Board analyzes this issue under a two-part framework:

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
- (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, Paper 6, 8.

1. *Whether the Same or Substantially the Same Art or Arguments Were Previously Presented to the Office*

There is no dispute that Novlan was cited during prosecution of the '600 patent. Pet. 61–62; Prelim. Resp. 23, 25–27. Petitioner contends 36.213 was not before the Office during prosecution, but Patent Owner argues 36.213 is cumulative of art that was before the Examiner, namely an earlier version of the same specification—36.212 v.10.1.0 (Ex. 1007). Prelim. Resp. 27–30.

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