

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

TELEFONAKTIEBOLAGET LM ERICSSON,
Patent Owner.

IPR2022-00607
Patent 10,517,133 B2

Before GEORGIANNA W. BRADEN, SHARON FENICK, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

DECISION
Denying 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 1–20 (“Challenged Claims”) of U.S. Patent No. 10,517,133 B2 (Ex. 1001, “the ’133 patent”). Petitioner identifies itself as a real party in interest. Pet. 57. Telefonaktiebolaget LM Ericsson (“Patent Owner”) identifies itself and Ericsson Inc. as real parties in interest (Paper 3, 2), and timely filed a Preliminary Response to the Petition (Paper 6, “Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b) (2018); 37 C.F.R. § 42.4(a) (2022). We may not institute an *inter partes* review “unless . . . 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). The “reasonable likelihood” standard is “a higher standard than mere notice pleading” but “lower than the ‘preponderance’ standard to prevail in a final written decision.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential).

Applying those standards, and upon consideration of the information presented in the Petition and Preliminary Response, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing with respect to any of challenged claims 1–20 of the ’133 patent. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Accordingly, constrained by the record before us, we deny institution of an *inter partes* review of the ’133 patent.

II. BACKGROUND

A. Related Matters

Petitioner indicates that “[t]he ’133 patent was the subject of an IPR petition filed by Samsung Electronics Co., LTD. (“Samsung”) in IPR2021-00643,” and “Samsung’s petition was dismissed prior to institution.” Pet. 57–58 (citing *Samsung Elecs. Co. v. Telefonaktiebolaget LM Ericsson*, IPR2021-00643).

Petitioner also indicates that “[t]he ’133 patent is in the same family as pending U.S. [Patent] Application Serial No. 16/720,733” (Pet. 58), which we note is a continuation of the ’133 patent and issued as U.S. Patent No. 11,445,565 B2 on September 13, 2022 (“the ’565 patent”).

Notwithstanding the recently issued ’565 patent, Patent Owner has indicated, without update, that “[t]here are no judicial or administrative matters that would affect, or be affected by, a decision in this proceeding.” Paper 3, 2.¹

B. The ’133 Patent

The ’133 patent is titled “Methods and UE For Resuming a Connection With Full Configuration,” and issued December 24, 2019, from U.S. Patent Application No. 16/380,844, filed April 10, 2019, and claims priority through a PCT application to U.S. Provisional Patent Application No. 62/631,467, filed February 15, 2018. Ex. 1001, codes (10), (21), (22), (45), (54), (60), (63). The ’133 patent generally relates to “wireless

¹ See Consolidated Trial Practice Guide at 18 (Nov. 21, 2019) (“Administrative matters include every application and patent claiming, or which may claim, the benefit of the priority of the filing date of the party’s involved patent or application . . .”).

communications and, more particularly, to resum[ing] a connection for a wireless device.” *Id.* at 1:19–21.

The ’133 patent explains that, in Long Term Evolution (LTE) wireless communications, “during a Handover (HO) or re-establishment, the [User Equipment (UE)] context is passed from the source to the target [network node (e.g., Evolved Node B, known as ‘eNodeB’ or ‘eNB’)],” and “[i]f the target eNB does not understand any part of the UE configuration, then it triggers *full configuration*.” Ex. 1001, 6:48–54 (emphasis added), 1:27–30. The “full configuration” procedure is specified in Third Generation Partnership Project Technical Specification (3GPP TS) 36.331 section 5.3.5.8,” which is reproduced at least in part in the ’133 patent. *Id.* at 6:55–7:45. According to the ’133 patent, “[t]he full configuration procedure . . . is performed by sending an RRCConnectionReconfiguration [sic] message with the fullConfig flag set and *it is not available for other radio reconfiguration messages such as re-establishment and resume*.” *Id.* at 8:11–15 (emphasis added). The ’133 patent explains that “one of the main aims of the resume procedure is to transit the UE to connected mode as fast as possible (with as little signaling as possible), reusing the saved configuration of the UE when it got suspended, and thus an additional RRCConnectionReconfiguration [sic] is not needed.” *Id.* at 8:18–23. But, “there are scenarios where, during resuming after suspending, the target node doesn’t understand the radio configuration of the UE, and since full configuration is not supported, the only viable option for the UE to resume will be via IDLE mode . . . , which incurs further delays in the service continuity at the UE.” *Id.* at 8:25–31.

The '133 patent states that it provides solutions to such problematic scenarios, and in particular, discloses that a “*resume* procedure is enhanced to support a full configuration (or reconfiguration).” Ex. 1001, 13:59–60 (emphasis added). According to the '133 patent, this enhanced resume procedure includes:

send[ing] to a network node a request to resume a connection in a communication network; receiv[ing] a resume response message from the network node, the message comprising an indication to perform a full configuration; and apply[ing] the full configuration.

Id. at code (57). This procedure is depicted generally, for example, in Figure 7, reproduced below.

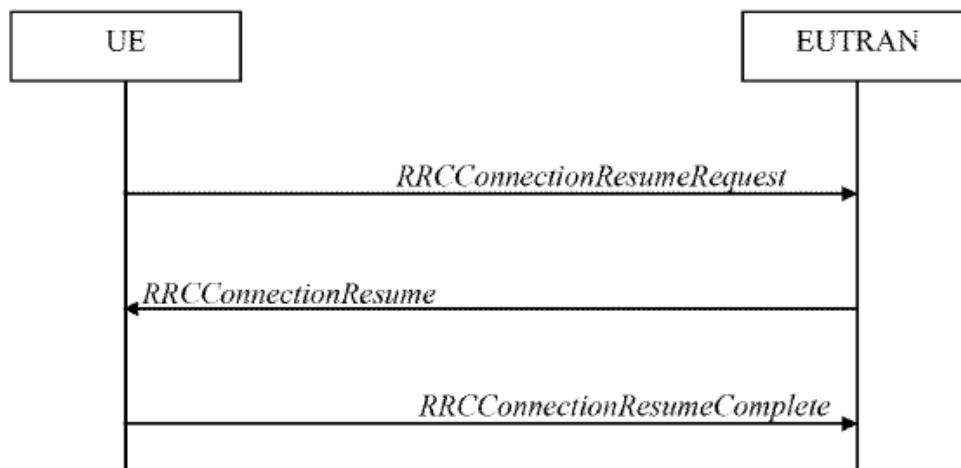


Figure 7

Figure 7 depicts a signal diagram of a successful Radio Resource Control (RRC) connection resume procedure.

Ex. 1001, 10:51–52, Fig. 7. In this case, the network node (or eNB or Evolved Universal Mobile Telecommunications System (UMTS) Terrestrial Radio Access Network (EUTRAN)), “sets a flag to the full configuration in the RRC [Connection] Resume message,” which “flag” may be referred to

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