

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. and TELEFONAKTIEBOLAGET LM ERICSSON,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2014-01330
Patent 8,310,993 B2

Before BRIAN J. McNAMARA, DAVID C. McKONE, and
JASON J. CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Procedural Background

Ericsson Inc. and Telefonaktiebolaget LM Ericsson (collectively “Petitioner”) filed a Petition (“Pet.”) for *inter partes* review of claims 1–12 of U.S. Patent No. 8,310,993 (“the ’993 patent”) (Ex. 1001) pursuant to 35 U.S.C. §§ 311–319. Paper 2. Intellectual Ventures II LLC (“Patent Owner”) filed a Preliminary Response (“Prelim. Resp.”). Paper 6. On February 23, 2015, we instituted review as to claims 1–12 of the ’993 patent and instituted trial on two grounds of unpatentability as set forth below. Paper 8 (“Dec. on Inst.”).

Claims	Grounds	Reference
1, 2, 4–8, and 10–12	§ 103(a)	Kakani ¹ , Sipola ² , and AAPA ³
3 and 9	§ 103(a)	Kakani, Sipola, AAPA, and Rinne ⁴

Patent Owner filed a Patent Owner’s Response (Paper 14, “PO Resp.”), and Petitioner filed a Reply (Paper 20, “Reply”). We heard Oral Argument on November 18, 2015. Paper 28, “Tr.”

¹ U.S. Patent Publication No. 2005/0054347 published Mar. 10, 2005 (Ex. 1008, “Kakani”).

² U.S. Patent No. 7,260,073 filed Dec. 2, 2002 (Ex. 1007, “Sipola”).

³ Petitioner cites to column 1, line 21, through column 4, line 4, in the Background of the Invention section of the ’993 patent as an admission of prior art (Applicant Admitted Prior Art, or “AAPA”). We agree that this section is an admission of the scope and content of the prior art and refer to AAPA to inform the knowledge of a person of ordinary skill in the art at the time of the invention. *Cf. Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015).

⁴ U.S. Patent No. 8,572,250 B2 filed Feb. 24, 2006 (Ex. 1011, “Rinne”).

B. Related Matters

Petitioner and Patent Owner identify five related district court proceedings. Pet. 1; Paper 5, 1.

C. Summary of Conclusions

In this Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, 4–8, and 10–12 are unpatentable.

II. THE '993 PATENT (Ex. 1001)

The '993 patent relates generally to packet data transmission in a wireless communication system. Ex. 1001, 1:15–19. According to the '993 patent, what the patent refers to as “transfer communication protocol” or “TCP” data segments are buffered in downlink (“DL”) TCP transmissions. *Id.* at 4:55–60. The buffered TCP data segments are transmitted from the buffer to the user equipment (“UE”). *Id.* at 4:60–63, Fig. 5. As the TCP segments are transmitted from the buffer, a counting logic counts a number of transmitted TCP segments that are transmitted to the UE. *Id.* at 5:4–7. The counting logic ensures that when a second segment is sent, uplink (“UL”) resources are allocated. *Id.* at 5:8–12; Fig. 5. After the UL resources are allocated and the DL message is processed, a stand-alone acknowledgement (“ACK”) message is transmitted in the UL. *Id.* at 5:36–39, Fig. 5.

Independent claim 1, reproduced below, is illustrative.

1. A wireless network comprising:
 - a circuit located in the wireless network, wherein the circuit buffers segments of transfer communication protocol (TCP) data for downlink (DL) transmission;
 - a transmitter arranged to transmit the buffered segments of TCP data to a user equipment (UE);
 - the circuit is further configured to count a number of transmitted segments of TCP data;
 - wherein the circuit is further configured, in response to the count exceeding a predetermined number, to transmit a message that indicates an allocation of uplink resources to transfer an uplink segment and the allocation of uplink resources is sufficient to have information indicating acknowledgment; and
 - wherein the circuit is further configured to receive, in response to the uplink resources, the uplink segment which includes the information indicating acknowledgment of receipt of the transmitted segments of TCP data.

III. CLAIM CONSTRUCTION

As a step in our analysis for determining whether to institute a review, we determine the meaning of the claims. In an *inter partes* review, a claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears. *See* 37 C.F.R. § 42.100(b). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We construe the terms below in accordance with these principles.

Claim 1 recites a “circuit is further configured *to count* a number of transmitted segments of TCP data” and taking action “in response to *the count* exceeding a predetermined number.” Similarly, claim 7 recites “*counting*, by the network, a number of transmitted segments of TCP data” and taking action “in response to *the count* exceeding a predetermined number.” Patent Owner contends that Webster’s New World Dictionary of Computer Terms defines “count” as “the successive increase or decrease of a cumulative total of the number of times an event occurs.” PO Resp. 11–12; Ex. 2003. Petitioner, in response, contends the prosecution history indicates that “the count is of a number of sent segments of TCP data in the downlink.” Reply 4–6 (citing Ex. 1004, 14:2, 14:16–17).

We note that claim 1 recites “count” twice. Ex. 10:26–29. Claim 1 first recites “to count,” which is a verb.⁵ *Id.* at 10:26–27. Next, claim 1 recites “the count,” which is a noun. *Id.* at 28–29. Claim 7, similarly, first recites “counting” as a verb, then recites “the count,” a noun. *Id.* at 61–64. We address the verb and noun definitions of “count” in turn.

We agree with Patent Owner’s argument that “to count,” as recited in claim 1 (and “counting” as recited in claim 7) means “the successive increase or decrease of a cumulative total of the number of times an event occurs.” This is consistent with the verb form of “count,” as evidenced by

⁵ The expression “to count” actually is an infinitive, which is defined as “a verb form normally identical in English with the first person singular that performs some functions of a noun and at the same time displays some characteristics of a verb and that is used with *to* (as in “I asked him to go”) except with auxiliary and various other verb (as in “no one saw him *leave*).” Webster’s New Collegiate Dictionary at 591 (published by G. & C. Merriam Co. 1977).

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