

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

COMMWORKS SOLUTIONS, LLC,
Patent Owner.

IPR2021-01297
Patent 8,923,846 B2

Before JENNIFER MEYER CHAGNON, KEVIN C. TROCK, and
JOHN R. KENNY, *Administrative Patent Judges*.

CHAGNON, *Administrative Patent Judge*.

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

I. INTRODUCTION

Unified Patents, LLC (“Petitioner”)¹ filed a Petition requesting *inter partes* review of claims 1–6, 9–13, and 16–20 (“the challenged claims”) of U.S. Patent No. 8,923,846 B2 (Ex. 1001, “the ’846 patent”). Paper 1 (“Pet.”). CommWorks Solutions, LLC (“Patent Owner”)² filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314, which provides that an *inter partes* review may be instituted only upon a showing 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). Moreover, if the Board institutes a trial, the Board will institute on all challenges raised in the petition. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1355–56 (2018) (“*SAS*”) (holding that a decision to institute under 35 U.S.C. § 314 may not institute review on fewer than all claims challenged in the petition); *see also* Patent Trial and Appeal Board Consolidated Trial Practice Guide 64 (Nov. 2019), <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf> (“CTPG”) (“The Board will not institute on fewer than all claims or all challenges in a petition.”).

Applying those standards, and upon consideration of the information presented in the Petition and the Preliminary Response, as well as the evidence of record, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in showing the unpatentability of at least

¹ Petitioner states that Unified Patents, LLC is the real party-in-interest in this proceeding. Pet. 62.

² Patent Owner also identifies Brainbox Innovations, LLC as a real party-in-interest to this proceeding. Paper 4, 1.

one of the challenged claims. Accordingly, we institute an *inter partes* review of all challenged claims of the '846 patent, based on all grounds identified in the Petition.

The following findings of fact and conclusions of law are not final, but are made for the sole purpose of determining whether Petitioner meets the threshold for initiating review. Any final decision shall be based on the full trial record, including any response timely filed by Patent Owner. Any arguments not raised by Patent Owner in a timely-filed response may be deemed waived, even if they were presented in the Preliminary Response.

A. Related Proceeding

The parties identify *CommWorks Solutions, LLC v. Comcast Cable Communications, LLC*, Case No. 6:21-cv-00366-ADA (W.D. Tex.) as a related matter involving the '846 patent. Pet. 62; Paper 4, 1.

B. The '846 Patent

The '846 patent, titled "Recovery Techniques in Mobile Networks," was filed on October 21, 2013,³ and issued on December 30, 2014. Ex. 1001, codes (22), (45), (54). Embodiments of the '846 patent relate to "technique[s] for recovering location information of a subscriber in a mobile network." *Id.* at 1:54–2:16; *see also id.* at code (57) ("A technique for

³ The '846 patent claims priority, through a series of continuation applications and a divisional application, to application No. 09/802,861, filed on March 12, 2001. Ex. 1001, code (60). The specific priority date of the challenged claims is not at issue in this proceeding, and we need not make any determination in this regard for purposes of this Decision.

protecting location information of a subscriber in a mobile network is disclosed.”).

The '846 patent explains that “Mobile IPv6^[4] allows a subscriber to move from one link to another without changing its IP address.” *Id.* at 3:11–12. “While a subscriber is attached to some foreign link away from home, it is also addressable by one of more care-of-addresses, in addition to its home address.” *Id.* at 3:30–32. The '846 patent describes that a “care-of address is an IP address associated with a mobile node while the subscriber is visiting a particular foreign link.” *Id.* at 3:30–34. For this to work, “a mobile subscriber registers one of its care-of addresses with a router on its home link, requesting this router to function as the ‘home agent.’” *Id.* at 3:49–51. The home agent then “intercept[s] any IPv6 packets addressed to the subscribers’ home address (or home addresses) on the home link and tunnels each intercepted packet to the subscribers’ primary care-of address.” *Id.* at 3:59–62.

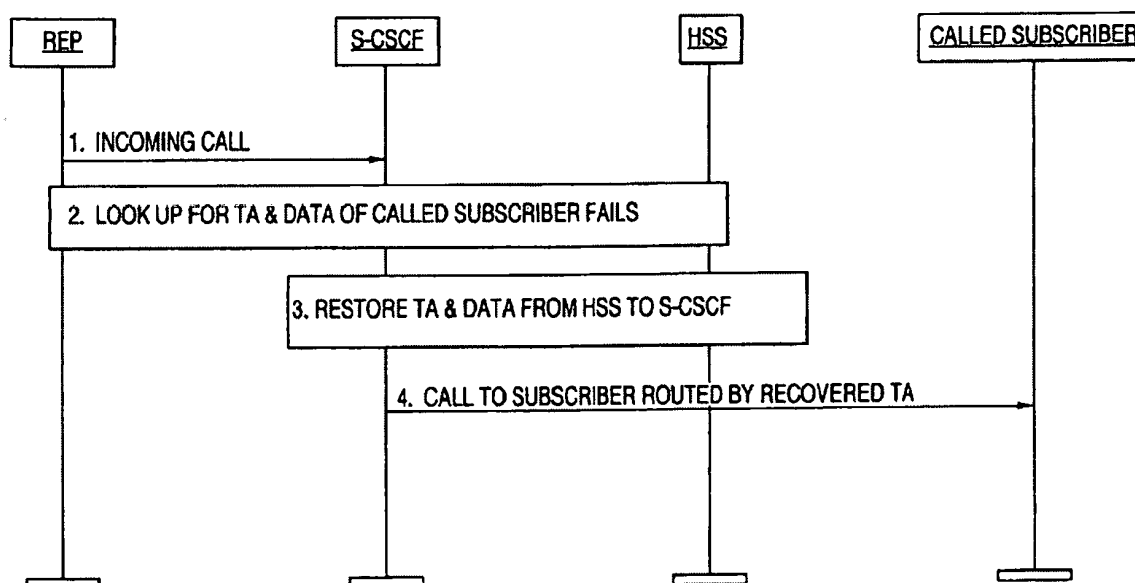
The '846 patent “relates to protecting the Transport Address (TA) which is a current Care of Address of a mobile subscriber is reachable from loss and after Call State Control Function (CSCF) crashes and after reset situations of a network element realizing CSCF functionality.” *Id.* at 1:22–27. The '846 patent describes embodiments in the context of a 3G All-IP mobile network. *See id.* at 6:22–26. In a 3G All-IP network, the “S-CSCF [servicing-CSCF] that the subscriber is currently registered to and the TA of the roaming subscriber . . . must be known to and maintained by the network.” *Id.* at 2:63–67. Specifically, “[k]eeping the address of the S-CSCF ensures that a call to a subscriber can be routed to the destination

⁴ Internet Protocol Version 6. *See* Ex. 1001, 4:30–31.

node,” and “[k]eeping the current TA of the subscriber ensures that a call made to the subscriber which arrives at the S-CSCF can finally reach the subscriber.” *Id.* at 3:66–4:3. But, “the information of the current S-CSCF (stored in the HSS [Home Subscriber Service]) is insufficient to reach the subscriber upon the loss of the subscriber TA.” *Id.* at 4:15–17. The ’846 patent proposes several options to remedy this problem, including that “[t]he TA of the subscriber should be forwarded to the HSS at registration and downloaded from the HSS to the S-CSCF during recovery.” *Id.* at 4:27–29.

Figure 4A of the ’846 patent, reproduced below, illustrates an embodiment for “sending subscriber TA to S-CSCF and then forwarding it to HSS at registration” (*id.* at 2:39–40):

FIG. 4A



In the embodiment shown in Figure 4A above, “a safe copy” of the subscriber’s TA is forwarded to the HSS for storage and protection” so that “[t]he TA and other data can then be restored to the S-CSCF upon the earlier loss of data by the S-CSCF.” *Id.* at 4:37–42. In particular, in step 1, “[a]n

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