

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 IPR2014-00919
Patent 7,848,353 B2

Before JOSIAH C. COCKS, WILLIAM A. CAPP, and
DAVID C. McKONE, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

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

Ericsson Inc. and Telefonaktiebolaget LM Ericsson, (collectively “Ericsson”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 9–20 and 29–34 of U.S. Patent No. 7,848,353 B2 (Ex. 1001, the “’353 patent”). We issued a Decision to Institute an *inter partes* review of claims 9–20 and 29–34 of the ’353 patent. Paper 8 (“DI”). After institution of trial, Patent Owner Intellectual Ventures II LLC (“Intellectual Ventures”) filed a Patent Owner’s Response (Paper 17, “PO Resp.”) and Ericsson filed a Petitioner’s Reply (Paper 21, “Reply”). We have jurisdiction under 35 U.S.C. § 318(a).

The instant case came before the Board for a regularly scheduled oral hearing on the merits on August 25, 2015, the transcript of which is entered as Paper 36 (“Tr.”). Also before the Board are the following matters:

Patent Owner’s Objection to Evidence (Paper 24); and

Patent Owner’s Motion to Exclude Evidence (Papers 27 and 31).

After considering the evidence and arguments of counsel and for the reasons set forth below, we determine that Ericsson has met its burden of showing, by a preponderance of the evidence, that claims 9–20 and 29–34 of the ’353 patent are unpatentable.

Related Proceedings

The ’353 patent issued from non-provisional application number 12/033,824 and is the subject of two IPR proceedings. The first such proceeding is the instant proceeding in which Petitioner Ericsson challenges claims 9–20 and 29–34 of the ’353 Patent. The second such IPR Proceeding is *Google Inc. v. Intellectual Ventures II LLC*, Case IPR2014-01031 (PTAB) in which the Petitioner Google challenges claims 1–8 and 21–27 of the ’353 Patent.

IPR2014-00919
Patent 7,848,353 B2

The '353 patent is the parent of a continuation application, non-provisional application number 12/960,774, which lead to issuance of US Patent 8,396,079 B2 (the "'079 patent"). The '079 Patent is the subject of an IPR proceeding captioned *Ericsson, Inc. v. Intellectual Ventures II LLC*, IPR2014-00915 (PTAB).

The '353 patent and/or the '079 patent are patents-in-suit in one or more of the following United States District Court patent infringement actions:

Intellectual Ventures I LLC v. AT&T Mobility LLC, 1-13-cv-01668 (D. Del. 2013).

Intellectual Ventures I LLC v. Leap Wireless Int'l, 1-13-cv-01669 (D. Del. 2013).

Intellectual Ventures I LLC v. Nextel Operations, 1-13-cv-01670 (D. Del. 2013).

Intellectual Ventures I LLC v. T-Mobile USA Inc., 1-13-cv-01671 (D. Del. 2013).

Intellectual Ventures I LLC v. United States Cellular, 1-13-cv-01672 (D. Del. 2013).

Intellectual Ventures I LLC v. Motorola Mobility LLC, 0-13-cv-61358 (S.D. Fla. 2013).

I. BACKGROUND

A. *The '353 Patent (Ex. 1001)*

The '353 patent, titled "Communication Units Operating With Various Bandwidths," relates to digital communication systems such as wireless cellular communication systems. Ex. 1001, 1:13–18. The communication system disclosed in the '353 patent is capable of operating at a plurality of bandwidths. *Id.*, Abstract. The system transmits a signal comprised of a first signal portion and a further signal portion. *Id.* The first

signal portion is transmitted over a first bandwidth. *Id.* The first signal portion contains an indication of an operating bandwidth selected from a plurality of bandwidths for use in transmitting and receiving the further signal portion. *Id.*

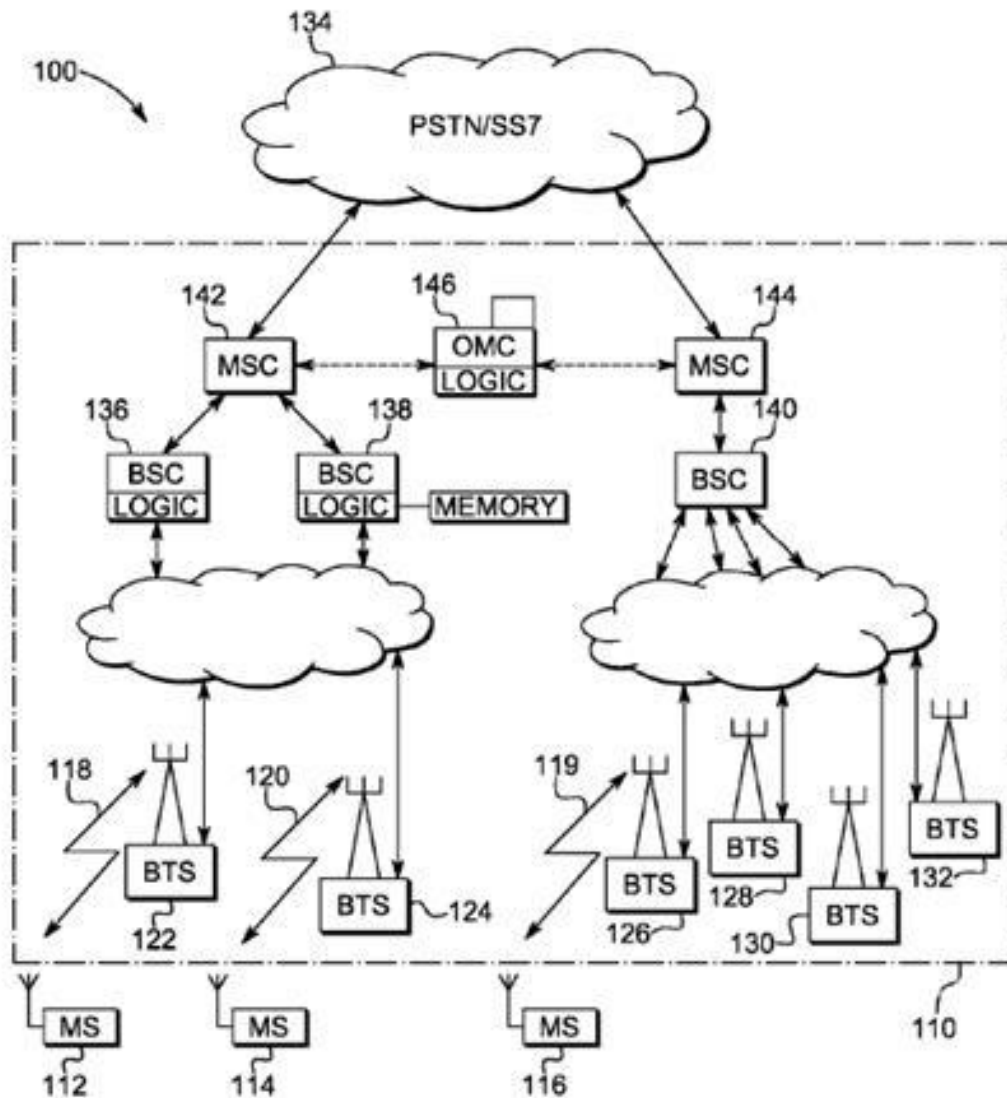


Figure 1 of the '353 patent is shown above. Figure 1 is a block diagram of a wireless communication system. Ex. 1001, 3:8–10. A plurality of subscriber terminals (*e.g.*, cell phones) 112, 114, 116 communicate wirelessly over radio links 118, 119, 120 with a plurality of base transceiver

stations 122, 124, 126, 128, 130, 132, also known as “Node-Bs.” *Id.* at 3:34–38. The cell phones and Node-Bs transmit and receive multi-rate signals. *Id.* at 4:39–44.

A first portion of the multi-rate signal has a predetermined bandwidth and contains an indication of an operating bandwidth for a further portion of the signal. *Id.* at claim 9. Following transmission, both the indication from the first signal portion and the information in the further signal portion are recoverable. *Id.* The information in the further signal portion is recoverable at the operating bandwidth indicated in the first signal portion. *Id.*

B. The Challenged Claims

Ericsson challenges claims 9–20 and 29–34. Claims 9, 14, and 29 are independent claims. Claim 9 is a method claim and claims 14 and 29 are apparatus claims. Claim 14 is illustrative of the subject matter of the challenged claims and is reproduced below:

14. A multi-bandwidth communication system comprising:
 - a transmitter having logic for transmitting a signal having a first signal portion at a first, predetermined bandwidth and containing an indication of an operating bandwidth selected from a plurality of bandwidths used for a further signal portion;
 - a receiver having logic for receiving the transmitted signal;
 - logic for recovering the indication from the first signal portion at the first, predetermined bandwidth; and
 - logic for recovering information in the further signal portion at the operating bandwidth indicated by the indication.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.