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Paper 41
Entered: December 7, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2014-01031
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

Google Inc. ("Google") filed a corrected Petition (Paper 6, "Pet.") requesting *inter partes* review of claims 1–8 and 21–27 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 1–8 and 21–27 of the '353 patent. Paper 10 ("DI"). After institution of trial, Intellectual Ventures II LLC ("Intellectual Ventures") filed a Patent Owner's Response (Paper 17, "PO Resp.") and Google filed a Petitioner's Reply (Paper 22, "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 40 ("Tr."). Also before the Board are the following matters:

Patent Owner's Objection to Evidence (Paper 25); and

Patent Owner's Motion to Exclude Evidence (Papers 30 and 34).

After considering the evidence and arguments of counsel and for the reasons set forth below, we determine that Google has met its burden of showing, by a preponderance of the evidence, that claims 1–8 and 21–27 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 Google challenges claims 1–8 and 21–27 of the '353 Patent. The second such IPR Proceeding is *Ericsson Inc. et al v. Intellectual Ventures II LLC*, IPR 2014-00919 (PTAB) in which the Petitioner Ericsson challenges claims 9–20 and 29–34 of the '353 Patent.

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*, IPR 2014-00915 (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).

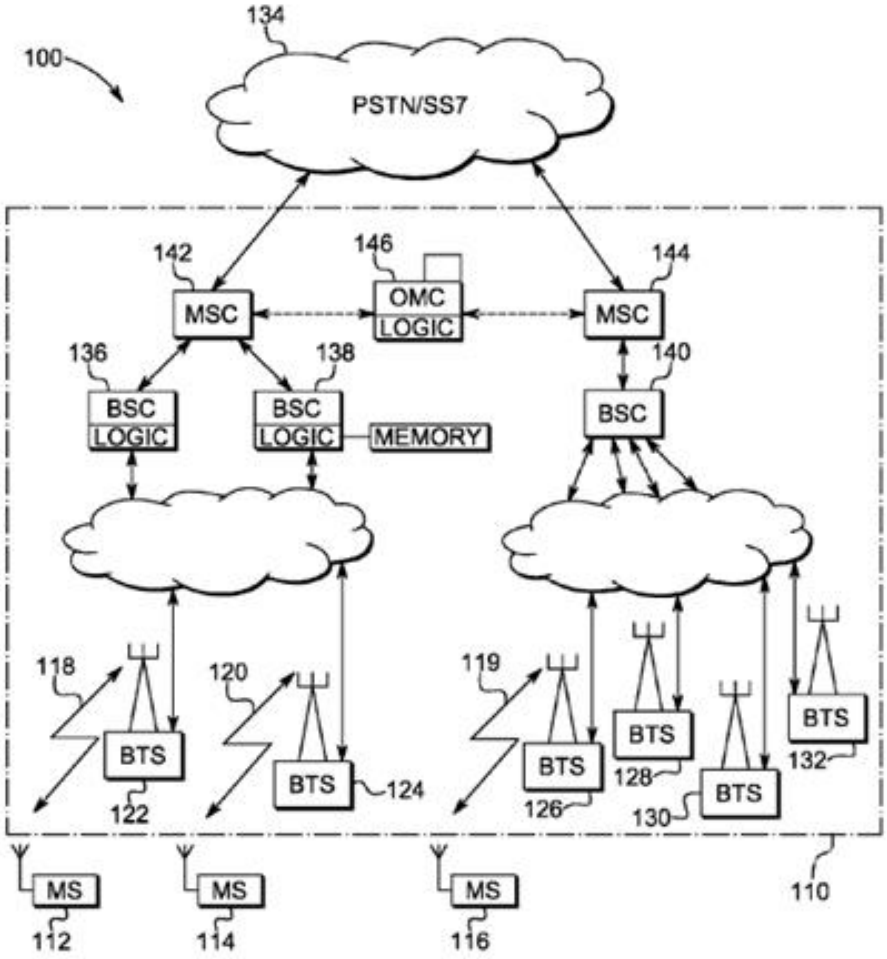
Intellectual Ventures I LLC v. Motorola Mobility LLC, 0-13-cv-61358 (S.D. Fla. 2013).

I. BACKGROUND

A. The ’353 Patent (Ex. 1001)

The ’353 patent, titled “Method, Communication System And Communication Unit For Synchronization For Multi-Rate Communication,” 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 below.



As shown in Figure 1, 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." Ex. 1001, 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*., 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

Google challenges claims 1–8 and 21–27. Claims 1 and 21 are independent claims. Claim 1 is a method claim and claim 21 is an apparatus claim. Claims 1 and 21 are illustrative of the subject matter of the challenged claims and are reproduced below:

> 1. A method for operating bandwidth determination in a multi-bandwidth communication system, the method comprising:
>
> at a remote unit:
>
> receiving a signal having a first signal portion at a first, predetermined bandwidth, containing an indication of an operating bandwidth selected from a plurality of bandwidths used for a further signal portion;
>
> recovering the indication from the first signal portion at the first, predetermined bandwidth; and
>
> recovering information in the further signal portion at the operating bandwidth indicated by the indication.
>
> 21. A communication unit for use in a multi-bandwidth communication system, the communication unit comprising:
>
> logic for receiving a signal having a first signal portion at a first, predetermined bandwidth, containing an indication of an operating bandwidth selected from a plurality of bandwidths used for a further signal portion;
>
> logic for recovering the indication from the first signal portion at the first, predetermined bandwidth; and
>
> logic for recovering information from the further signal portion at the operating bandwidth indicated by the indication.

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