

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION, ZTE (USA), AMAZON.COM, INC.,
PANTECH CO., LTD., PANTECH WIRELESS, INC., DELL INC.,
LG ELECTRONICS, INC., and LG ELECTRONICS U.S.A., INC.,
Petitioners,

v.

CELLULAR COMMUNICATIONS EQUIPMENT LLC,
Patent Owner.

Case IPR2014-01135
Patent 6,377,804

Before JENNIFER S. BISK, GREGG I. ANDERSON and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

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

INTRODUCTION

A. *Background*

NEC Corporation of America, NEC Mobile Communications, Ltd.,¹ HTC Corporation, Amazon.com, Inc., ZTE (USA), Inc., Pantech Co., Ltd., Pantech Wireless, Inc., Dell Inc., LG Electronics, Inc., and LG Electronics U.S.A., Inc. (collectively, “Petitioner”), filed a Corrected Petition (Paper 4, “Pet.”) requesting an *inter partes* review of claims 1–12 of U.S. Patent No. 6,377,804 (Ex. 1001, “the ’804 patent”). Patent Owner, Cellular Communications Equipment LLC, filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). On January 20, 2015, we instituted a review (Paper 11, “Institution Decision” or “Inst. Dec.”) based upon Petitioner’s assertion that (1) claims 1, 3, and 5–9 are anticipated by Sasuta,² and (2) claims 1, 3, 4, 6, and 7 are anticipated by Lawrence.³

This is a Final Written Decision under 35 U.S.C. § 318(a). For the reasons set forth below, Petitioner has not shown by a preponderance of the evidence that claims 1 and 3–9 of the ’804 patent (“the challenged claims”) are unpatentable.

B. *Related Proceedings*

The parties indicate that the ’804 patent is the subject of several proceedings in the United States District Court for the Eastern District of Texas. Pet. 1–2; Paper 6, 2–3.

¹ NEC Mobile Communications, Ltd. was formerly known as NEC CASIO Mobile Communications, Ltd. Paper 8, 2. NEC Corporation of America and NEC Mobile Communications, Ltd. were dismissed on February 12, 2015. Paper 20, 2–3.

² U.S. Patent No. 5,862,490 (“Sasuta”).

³ U.S. Patent No. 5,819,173 (“Lawrence”).

C. *The '804 Patent*

The '804 patent relates to mobile communication systems. Ex. 1001, Title. Specifically, the '804 patent discusses the coexistence of a variety of mobile telephone standards, including new generation standards that are implemented with the expectation that they will eventually supersede older standards. *Id.* at 1:14–27. The '804 patent explicitly discusses GSM, TDMA, and the Universal Mobile Telecommunication System (“UMTS”) communication standards. *Id.* at 1:15–27. Networks using these communication standards may coexist and frequently differ in both geographical coverage and scope of services provided. *Id.* at 2:11–20. This results in certain geographical areas being covered by more than one network, each using a different communication standard and providing differing services. *Id.* The '804 patent describes taking advantage of this overlap by transferring from a network operating on one standard to a second network operating on a different standard when a mobile communication device requests a service provided by the second network, but not the first network. *Id.* at 1:65–2:10.

As an example, the '804 patent describes the situation in Europe in which the more recently implemented UMTS networks likely have only limited geographical coverage, at least for an initial period of time. *Id.* at 3:17–20. Figure 1 of the '804 patent is reproduced below.

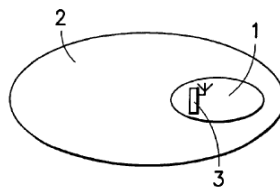


FIG. 1

Figure 1 shows schematically the geographical coverage of two networks. *Id.* at 3:3–5. Area 1, which falls wholly within area 2, illustrates the coverage provided by the UMTS network. *Id.* at 20–22. Area 2 represents a pre-existing GSM network. *Id.* Figure 2 of the '804 patent is reproduced below.

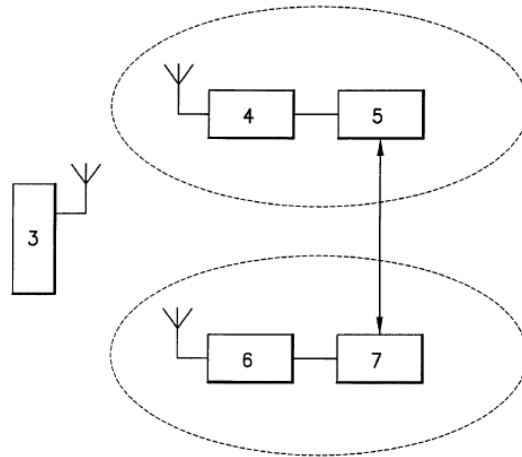


FIG.2

Figure 2 shows a diagram of the architectures of the networks shown in Figure 1. *Id.* at 3:6–7. Mobile station 3 communicates with either UMTS base station subsystem 4 or GSM base station subsystem 6. *Id.* at 3:46–49. To provide seamless operation when mobile station 3 moves between network coverage areas, the two core networks, 5 and 7, cooperate according to a roaming agreement. *Id.* at 3:49–51. In the situation where mobile station 3 is registered with the GSM network of area 2 as its home public land mobile network (HPLMN), and requires the use of a service provided by a UMTS network, but not the GSM network, mobile station 3 must “roam” for that service. *Id.* at 3:52–59. This activity is referred to as “roaming for service” and differs from traditional “roaming for coverage” defined in the GSM specification. *Id.* at 3:56–61, 3:66–4:4. Roaming for

service, unlike roaming for coverage, does not require location updates or location registration because the mobile station can remain registered with its home network, which knows the location of the mobile station. *Id.* at 2:66–4:3. Figure 3 of the '804 patent is reproduced below.

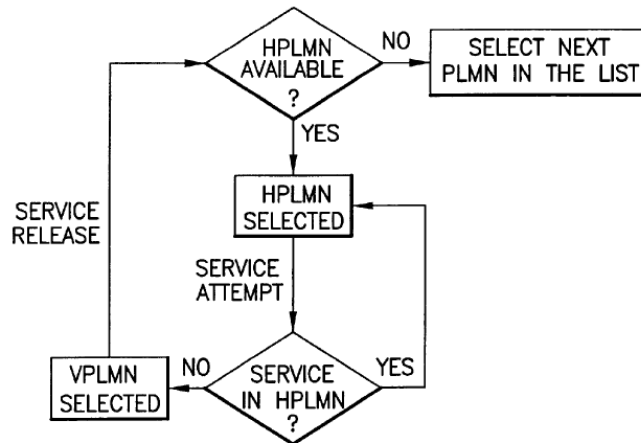


FIG.3

Figure 3 is a flow chart of mobile station 3 operating in the coverage area of the networks shown in Figure 1. *Id.* at 3:8–9. Figure 3 illustrates that mobile station 3 will select the HPLMN “so long as that network is available and the selected service is provided by the HPLMN.” *Id.* at 3:61–65.

D. Illustrative Claim

Of the challenged claims in the '804 patent, claim 1⁴ is independent. Claims 3–9 depend, either directly or indirectly, from claim 1. Claim 1 is reproduced below.

⁴ Subsequent to the filing of the Petition, a Certificate of Correction was issued changing the language of claim 1. Ex. 2001, 12. This decision will refer exclusively to this corrected version of claim 1 (discussed in the Petition as “claim 1 as allowed but not issued”).

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