

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA SOLUTIONS AND NETWORKS US LLC; and
NOKIA SOLUTIONS AND NETWORKS OY,
Petitioner,

v.

HUAWEI TECHNOLOGIES CO. LTD.,
Patent Owner.

Case IPR2017-00591
Patent 8,325,675 B2

Before TREVOR M. JEFFERSON, JENNIFER MEYER CHAGNON, and
MICHELLE N. WORMMEESTER, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

I. INTRODUCTION

A. *Background*

Petitioners, Nokia Solutions and Networks US LLC, and Nokia Solutions and Networks Oy (“NSN” or “Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1, 5, 6, and 10 of U.S. Patent No. 8,325,675 B2 (Ex. 1001, “the ’675 patent”) pursuant to 35 U.S.C. §§ 311–319. Patent Owner, Huawei Technologies Co. Ltd. (“Huawei” or “Patent Owner”), filed a Preliminary Response (Paper 10, “Prelim. Resp.”) to the Petition.

We have jurisdiction under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” After considering the Petition, Preliminary Response, and associated evidence, we conclude that Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of claims 1, 5, 6, and 10 of the ’675 patent.

B. *Related Proceedings*

NSN indicates that the ’675 patent is involved in *Huawei Technologies Co. v. T-Mobile US, Inc.*, Case No. 2:16-cv-0052 (E.D. Tex.), in which NSN, after a motion to intervene, joined on June 14, 2016. Pet. 1.

C. *The ’675 Patent*

The ’675 patent describes “[a] data processing method and system [that] are provided by the present invention, in order to implement data forwarding in a direct-tunnel mechanism when a handover or change

between a 2G system and a 3G system takes place.” Ex. 1001, 4:15–19,
Abstract.

The present invention provides a data processing method. The method includes: receiving, by a user plane anchor network element, data forwarded by a source data forwarding network element; and forwarding, by the user plane anchor network element, the data to a target side processing network element.

The present invention further provides a data processing method. The method includes receiving, by a user plane anchor network element, an instructive message, and sending data to at least one of a source data forwarding network element and a target side processing network element; and updating, by the user plane anchor network element, user plane routing, and sending the data to the target side processing network element as instructed in the message according to the updated user plane routing.

Id. at 4:20–34. The ’675 patent discloses that:

With the data processing methods in the direct-tunnel mechanism when a handover or change between a GERAN and a UTRAN takes place, a GGSN can buffer data forwarded by a source data forwarding network element and then send the data to a target side processing network element; alternatively, the GGSN can send the data forwarded by the source data forwarding network element directly to the target side processing network element.

Id. at 4:49–56.

D. Illustrative Claim

Claim 1, reproduced below, is illustrative of the claims at issue:

1. A data processing method in a handover procedure comprising:

exchanging messages, between a Mobility Management network element and a user plane anchor network element, to

obtain a data forwarding tunnel identifier of the user plane anchor network element;

informing, by the Mobility Management network element, the user plane anchor network element of a data forwarding tunnel identifier of a target side processing network element;

informing, by the Mobility Management network element, a source data forwarding network element of the data forwarding tunnel identifier of the user plane anchor network element;

receiving, by the user plane anchor network element, data forwarded by the source data forwarding network element using the data forwarding tunnel identifier of the user plane anchor network; and

forwarding, by the user plane anchor network element, the data to the target side processing network element.

E. The Alleged Grounds of Unpatentability

The Petition sets forth the grounds of unpatentability of claims 1, 5, 6, and 10 of the '675 patent as follows (*see* Pet. 2, 25–69):

| References | Basis | Claims Challenged |
|--|----------|-------------------|
| Vodafone, ¹ Shaheen '064, ² TS 42.129, ³ and TS 25.413 ⁴ | § 103(a) | 1, 5, 6, and 10 |

¹ 3rd Generation Partnership Project (“3GPP”), *Paging Initiation from UPE or from eNodeB?*, TSG-SA WG2 Meeting #50, Tdoc S2-060177, (Jan. 16–20, 2006) (Ex. 1005, “Vodafone”).

² U.S. Patent No. 2007/0248064 A1, published Oct. 25, 2007 (Ex. 1006, “Shaheen '064”).

³ 3GPP, *3rd Generation Partnership Project; Technical Specification Group GERAN; Packet-switched handover for GERAN A/Gb mode; Stage 2 (Release 6)*, TS 43.129 V6.8.0 (2006-06) (Ex.1007, “TS 43.129”).

⁴ 3GPP, *3rd Generation Partnership Project; Technical Specification Group Radio Access Network; UTRAN lu interface RANAP signaling (Release 7)*, TS 25.413 V7.2.0 (2006-06) (Ex.1008, “TS 25.413”).

| References | Basis | Claims Challenged |
|---|----------|-------------------|
| Nortel, ⁵ Shaheen '064, TS 42.129, and TS 25.413 | § 103(a) | 1, 5, 6, and 10 |

II. ANALYSIS

To establish Shaheen '064 as prior art pursuant to 35 U.S.C § 102(e), Petitioner relies on the provisional application filing date of Shaheen '064, because the filing date (April 16, 2007) is *after* the earliest claimed priority date of the challenged patent, the '675 patent, which is August 15, 2006. Pet. 22 (citing *In re Giacomini*, 612 F.3d. 1380, 1383 (Fed. Cir. 2010)). Specifically, Petitioner argues that “Shaheen ['064] has § 112 ¶ 1 support in—and can claim priority to—its provisional application 60/793,289 (‘Shaheen Provisional’) filed on April 19, 2006.” *Id.*

“A reference patent is only entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the *claims* in the *reference patent* in compliance with § 112, ¶ 1.” *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1381 (Fed. Cir. 2015) (emphases added). Petitioner recognizes this requirement (*see* Pet. 22), but analyzes the disclosure of the Shaheen Provisional to provide support for claim 1 of the Shaheen Provisional and does not demonstrate that it supports any of the claims of Shaheen '064. The Petition addresses the *Dynamic Drinkware* analysis, stating that:

⁵ Nortel, 3GPP, *New section for data handling during inter-access mobility*, TSG-SA WG2 Meeting #53, Tdoc S2-062190, (June 26–30, 2006) (Ex. 1009, “Nortel”).

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