UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

HUAWEI TECHNOLOGIES CO. LTD,
Patent Owner.

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Case IPR2017-00658
Patent 8,537,779 B2

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Before TREVOR M. JEFFERSON, MICHELLE N. WORMMEESTER, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

Nokia Solutions and Networks US LLC and Nokia Solutions and Networks Oy ("Petitioner") filed a Petition seeking to institute an *inter partes* review of claims 1, 4, and 9–11 ("the challenged claims") of U.S. Patent No. 8,537,779 B2 (Ex. 1001, "the '779 patent") pursuant to 35 U.S.C. §§ 311–319. Paper 2 ("Pet."). Huawei Technologies Co. Ltd. ("Patent Owner") filed a Preliminary Response. Paper 9 ("Prelim. Resp."). We have statutory authority under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

Upon consideration of the Petition, Patent Owner's Preliminary Response, and the associated evidence, we conclude Petitioner has not established a reasonable likelihood it would prevail in showing the unpatentability of at least one challenged claim. Therefore, we deny the Petition for an *inter partes* review.

B. Additional Proceedings

According to the parties, Patent Owner has asserted the '779 patent in *Huawei Technologies Co., v. T-Mobile US, Inc.*, Case No. 2:16-cv-0056 (E.D. Tex). Pet. 1; Paper 6, 2. Furthermore, Petitioner alleges that it filed a successful motion to intervene in the district court proceeding, and joined the proceeding on June 14, 2016. Pet. 1.

C. The '779 Patent

The '779 patent generally relates to a handover procedure for when a User Equipment ("UE"), such as a cell phone, is handed over from a non-3rd

Generation Partnership Project ("non-3GPP") network to a 3rd Generation Partnership Project ("3GPP") network. Ex. 1001, 1:23–31. The '779 patent's specification ("Specification") does not define the terms 3GPP network and non-3GPP network, but Petitioner's expert, Mark Lanning, explains that 3GPP is a standards-setting organization that "began in 1988 as a joint partnership between several telecommunications companies to develop and standardize various aspects of 2G, 3G, and 4G mobile network operator systems." Ex. 1003 ¶ 42.

According to the Specification, in the context of 3GPP networks, there are two different types of Attach processes whereby a UE is attached to a network—a normal Attach process, and a handover Attach process in which a UE is being handed over from one network to another. Ex. 1001, 1:32–35. In a normal Attach process, the network deletes all bearers (e.g., connections), between the UE and the network's Packet Data Network Gateway ("PDN GW"). *Id.* at 1:35–37. In a handover Attach process, however, the network needs to re-create all bearers in the network associated with the UE prior to handover. *Id.* at 1:40–42. The Specification, therefore, describes reporting an Attach type, i.e., normal or handover, to a Mobility Management Entity ("MME") before initiating registration into (attaching to) the 3GPP network. *Id.* at 6:31–49. In one embodiment, an information element ("IE") called an Attach Type IE is included in an Attach Request message sent from the UE to the MME, wherein assigning the value "0" to the IE indicates the Attach type is normal and assigning a value of "1" indicates the Attach type is handover. *Id.*

D. Challenged Claims of the '779 Patent

Of the challenged claims noted above, claims 1 and 11 are independent, and claims 4, 9, and 10 depend from claim 1. Claim 1, reproduced below, is illustrative:

> 1. A handover processing method, comprising:
>
> receiving, by a Mobility Management Entity (MME), an attach request message sent by a User Equipment (UE) during a handover from a non *3rd* Generation Partnership Project (non-3GPP) network to a 3rd Generation Partnership Project (3GPP) network, wherein the attach request message comprises an information element (IE) indicating handover;
>
> identifying, by the MME, a Packet Data Network Gateway (PDN GW) whose address is used by the UE in the non-3GPP network by communicating with a Home Subscriber Server (HSS); and
>
> requesting, by the MME, the PDN GW to initiate a bearer creation procedure.

E. The Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1, 4, and 9–11 of the

'779 patent based on the following grounds (Pet. 2–3):

Challenged Claims	Basis	References
1, 4, 9–11	§ 103(a)	APA[1] and Soderbacka[2]
1, 4, 9–11	§ 103(a)	APA and Nokia[3]
1, 4, 9–11	§ 103(a)	Motorola[4] and Nokia
1, 4, 9–11	§ 103(a)	Motorola and Soderbacka

II. ANALYSIS

A. *Motion to Seal*

Concurrently with the Petition, Petitioner filed a Motion to Seal under

37 C.F.R. §§ 42.14 and 42.55. Paper 3 ("Motion to Seal"). Petitioner's

motion seeks to seal Exhibit 1022, which purports to be Patent Owner's

preliminary infringement contentions in a district court proceeding.[5] Motion

to Seal 2–3. Petitioner seeks to seal the infringement contentions because

they were marked "CONFIDENTIAL" by Patent Owner, and are subject to a

protective order, in the district court proceeding. *Id.* at 3.

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[1] Portions identified by Petitioner of the translation of the Chinese priority application leading to the '779 patent contained in the File History of U.S. Patent No. 8,537,779 (Appl. No. 12/581,575) (Ex. 1002) ("APA").

[2] U.S. Publication No. 2003/0114158 A1 (Ex. 1007) ("Soderbacka").

[3] GPRS functionality for IMS emergency services support, 3GPP TSG-SA2 Meeting #57, S2-072255 (Apr. 23–27, 2007) (Ex. 1008) ("Nokia").

[4] Handover from non-3GPP Access to E-UTRAN (TS 23.402), 3GPP TSG SA WG2 Architecture—S2#57 (Apr. 23–27, 2007) (Ex. 1009) ("Motorola").

[5] *Huawei Technologies Co. v. T-Mobile USA, Inc.*, Case No.2:16-cv-00056.

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