

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

HUAWEI TECHNOLOGIES CO., LTD,
Patent Owner.

Case IPR2017-01474
Patent 8,639,246 B2

Before TREVOR M. JEFFERSON, MICHELLE N. WORMMEESTER, and
JOHN F. HORVATH, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Samsung Electronics Co., Ltd. (“Petitioner”)¹ filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–20 of U.S. Patent No. 8,639,246 B2 (Ex. 1001, “the ’246 patent”). Huawei Technologies Co., Ltd. (“Patent Owner”) filed a Preliminary Response (Paper 10, “Prelim. Resp.”) and we instituted an *inter partes* review of all the challenged claims. Paper 12 (“Inst. Dec.”); see 35 U.S.C. § 314(a).

Following institution, Patent Owner filed a Patent Owner Response (Paper 21, “PO Resp.”) and Petitioner filed a Reply (Paper 27, “Pet. Reply”). With our authorization, Patent Owner subsequently filed a Sur-Reply (Paper 35, “PO Sur-Reply”). Patent Owner also filed a Motion to Exclude (Paper 32), which we address below. On September 27, 2018, we conducted an oral hearing. A copy of the transcript (Paper 41, “Tr.”) is included in the record.

We have jurisdiction under 35 U.S.C. § 6(b). For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–20 of the ’246 patent are unpatentable. This final written decision is issued pursuant to 35 U.S.C. § 318(a).

B. Related Proceedings

The parties identify one related district court case: *Huawei Technologies Co. v. Samsung Electronics Co.*, Case No. 3:16-cv-02787 (N.D. Cal.). Pet. 2; Paper 5, 1. Patent Owner further identifies two related requests for *inter partes* reviews: IPR2017-01471 and IPR2017-01475.

¹ Petitioner identifies Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., and Samsung Research America as real parties in interest.

C. The '246 Patent (Ex. 1001)

The '246 Patent, titled “Method, Terminal, and System for Cell Reselection,” is directed to cell reselection. Ex. 1001, [54], [57], 1:23–25. In prior art LTE (Long Term Evolution or 4G) systems, a terminal decides what cell to camp on according to the priority. *Id.* at 1:49–53; *see* Pet. 8 (discussing cell reselection). The terminal measures a frequency/system having a higher priority, and if that measurement meets the terminal’s cell reselection criteria, it will reselect that cell. *Id.* at 1:52–60. Otherwise, the terminal will measure a cell having a lower priority. *Id.* The '245 patent states that:

If a terminal camps on a cell having a lower priority, a cell having a higher priority might be measured periodically. The priority-based cell reselection method may reduce the measurements by the terminal and save power energy. Meanwhile, a good priority setting may lead to load balance.

Ex. 1001, 1:58–63.

The '246 patent discloses having a mobile station receive from the LTE system a dedicated priority list for the particular mobile station. *Id.* at Abstract, 2:11–39, 2:56–3:9. When necessary, a mobile station performs a cell reselection according to the dedicated priority list when the terminal camps on a cell of a second non-LTE system, eliminating the need for the second system to establish the dedicated priority list when moving from an LTE system to a non-LTE system. *Id.* at Abstract, 2:11–39, 2:61–3:9.

D. Illustrative Claims

Petitioner challenges claims 1–20 of the '246 patent, with claims 1 and 11 being independent. Claims 1 and 11 are illustrative and reproduced below:

1. A method for inter-system cell reselection, comprising:

[1A] when a terminal is in a cell of a Long Term Evolution (LTE) system, receiving, by the terminal, a message including a dedicated priority list from the LTE system; and

[1B] when the terminal camps on a cell of a non-LTE system, performing, by the terminal, the inter-system cell reselection in accordance with the dedicated priority list before a valid time of the dedicated priority list expires.

11. A terminal comprising:

[11A] a receiver; and

[11B] a processor, wherein

[11C] when the terminal is in a cell of a Long Term Evolution (LTE) system, the receiver is configured to receive a message including a dedicated priority list from the LTE system; and

[11D] when the terminal camps on a cell of a non-LTE system, the processor is configured to perform inter-system cell reselection in accordance with the dedicated priority list before a valid time of the dedicated priority list expires.

Ex. 1001, 11:56–11:63, 12:27–37 (bracketed numbering added).

E. The Instituted Grounds

Trial was instituted on each of Petitioner's asserted grounds of unpatentability of claims 1–20 of the '246 (Inst. Dec. 17; *see* Pet. 4–5):

References	Basis	Claims Challenged
R2-075161 ² and R2-080338 ³	§ 103(a)	1–20
R2-075161, R2-080338, and Eerolainen ⁴	§ 103(a)	11–20

II. ANALYSIS

A. Patent Owner’s Motion to Exclude

Patent Owner moves to exclude portions of R2-075161 (Petitioner’s Exhibit 1005) and R2-080338 (Petitioner’s Exhibit 1007). Paper 32, 1–2 (“PO Mot.”). Patent Owner also moves to exclude certain declaration testimony of Petitioner’s expert Dr. Yaqub, namely, paragraphs 54 through 59 of Exhibit 1012, cited for public availability. *Id.* at 2. Petitioner opposes Patent Owner’s motion to exclude. Paper 36 (“Pet. Opp.”). In response, Patent Owner filed a reply to Petitioner’s opposition to the motion to exclude. Paper 38. Having reviewed the parties’ arguments and evidence, we deny Patent Owner’s motion to exclude.

1. Declaration of Dr. Yaqub (Exhibit 1012)

In paragraphs 54 through 59 of his declaration, Dr. Yaqub opines on the authenticity, public availability, and publication dates of R2-075161 and R2-080338. *See* Ex. 1012 ¶¶ 54–59. Dr. Yaqub bases his opinion, in part, on his ability to find these documents on the 3GPP ftp (file transfer protocol)

² NTT DoCoMo, Inc., *Inter-frequency/RAT idle mode mobility control*, 3GPP TSG RAN WG2 #60, Tdoc-R2-075161 (Nov. 2007) (Ex. 1005, “R2-075161”).

³ Nokia Corp. & Nokia Siemens Networks, *Reselection scenarios for multi-RAT terminals in Rel-8*, 3GPP TSG-RAN WG2 Meeting #60bis, R2-080338 (Jan. 2008) (Ex. 1007, “R2-080338”).

⁴ U.S. Pub. No. 2008/0176565, published July 24, 2008 (Ex. 1006, “Eerolainen”).

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