

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC. AND ZTE (USA) INC.,
Petitioner,

v.

INVT SPE LLC,
Patent Owner.

Case IPR2018-01478
Patent 6,760,590 B2

Before THU A. DANG, BARBARA A. BENOIT, and J. JOHN LEE,
Administrative Patent Judges.

BENOIT, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

This is a preliminary proceeding to decide whether to institute *inter partes* review of U.S. Patent No. 6,760,590 B2 (Ex. 1001, “the ’590 patent” or “the challenged patent”). *See* 35 U.S.C. § 314(a); 37 C.F.R § 42.4(a) (delegating authority to institute trial to the Board). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . 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.” 35 U.S.C. § 314(a).

Apple Inc. and ZTE (USA) Inc. (collectively, “Petitioner”) filed a petition seeking *inter partes* review of claims 1–8 of U.S. Patent No. 6,760,590 B2. Paper 1 (“Pet.”). Patent Owner, INVT SPE LLC, filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). After receiving authorization (Paper 8), Petitioner filed a Reply (Paper 9) to address Patent Owner’s argument that institution should be denied for efficiency reasons, and Patent Owner filed a Sur-Reply (Paper 10).

Although Petitioner initially sought to include claims 1, 2, 5, and 6 in its challenge, Patent Owner statutorily disclaimed those claims after the Petition was filed. *See* Ex. 2001. For the reasons discussed below, disclaimed claims 1, 2, 5, and 6 are no longer regarded as claims challenged in the Petition, leaving claims 3, 4, 7, and 8 as the only challenged claims.

Upon consideration of the Petition and the Preliminary Response, we conclude the information presented does not show a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 3, 4, 7, and 8 of the challenged patent. Accordingly, we deny institution of an *inter partes* review.

A. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), each party identified various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 34; Paper 5 (Patent Owner’s Mandatory Notices), 2–3.

B. Statutory Disclaimer of Claims 1, 2, 5, and 6

As noted above, Petitioner filed a petition challenging claims 1–8 of the ’590 patent. Pet. 3. Subsequently, Patent Owner filed a statutory disclaimer of claims 1, 2, 5, and 6. Ex. 2001; *see* Prelim. Resp. 1; *see also* 35 U.S.C. § 253 (indicating a patentee may disclaim claims). Patent Owner contends that *inter partes* review should not be instituted on the disclaimed claims in accordance with 37 C.F.R. § 42.107(e). Prelim. Resp. 1.

We agree with Patent Owner. “A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent.” *Guinn v. Kopf*, 96 F.3d 1419, 1442 (Fed. Cir. 1996) (citing *Altoona Publix Theatres, Inc. v. Am. Tri–Ergon Corp.*, 294 U.S. 477 (1935)). An *inter partes* review cannot be instituted on claims that have been disclaimed and no longer exist. *See* 37 C.F.R. § 42.107(e) (“No *inter partes* review will be instituted based on disclaimed claims.”). This conclusion is consistent with other panel decisions addressing this issue. *See, e.g., Intuitive Surgical, Inc. v. Ethicon LLC*, Case IPR2018-00935, Paper 9, 9–10 (PTAB Dec. 7, 2018); *Vestas-Am. Wind Tech. Inc. v. Gen. Elec. Co.*, Case IPR2018-01015, Paper 9, 12–14 (PTAB Nov. 14, 2018).

Accordingly, we do not institute *inter partes* review on claims 1, 2, 5, and 6.

C. The Challenged Patent

The '590 patent generally relates to transmission efficiency in mobile communications. Ex. 1001, 1:9–11, 1:15–18. The patent describes High Data Rate (“HDR”) as a known strategy to improve the transmission efficiency of a downlink from a base station to a communication terminal. *Id.* at 1:19–21 (Background Art). In HDR, a base station first transmits a pilot signal to a communication terminal. *Id.* at 1:28–31. The “communication terminal estimates the downlink channel quality using a CIR (desired carrier to interference ratio) based on the pilot signal, etc., and finds a transmission rate at which communication is possible.” *Id.* at 1:31–34. Based on the possible transmission rate, the “communication terminal selects a communication mode, which is a combination of packet length, coding method, and modulation method.” *Id.* at 1:34–39. The communication terminal then “transmits a data control rate (‘DCR’) signal indicating the communication mode to the base station.” *Id.* at 1:34–41. The base station sets a transmission rate for the communication terminal based on the DCR signal. *Id.* at 1:57–59. “Generally, DCR signals are represented by numbers from 1 to N, with a higher number indicating a proportionally better downlink channel quality.” *Id.* at 1:53–56.

The challenged patent discloses various embodiments in which the measured CIR value is encoded prior to transmission to the base station such that the CIR value is less susceptible to errors during transmission. *Id.* at 19:34–42. Figure 15 is set forth below.

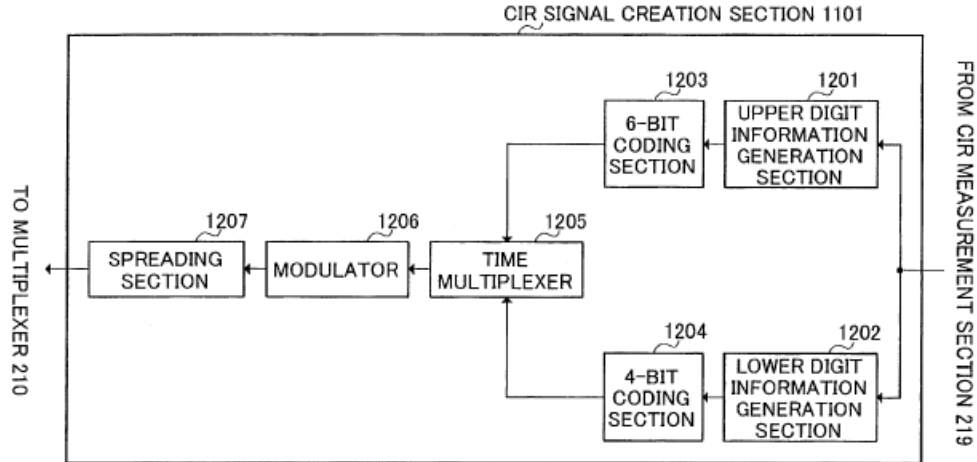


FIG.15

As shown in Figure 15, “an upper digit information generation section 1201 outputs the value of the upper digit in the CIR value output from the CIR measurement section 219 to a 6-bit coding section 1203. A lower digit information section 1202 outputs the value of the lower digit in the CIR value output from the CIR measurement section 219 to a 4-bit coding section 1204.” *Id.* at 20:33–39; Fig. 15. Using the example of an 8.7 dB CIR value output from the CIR measurement section 219, “the upper digit information generation section 1201 outputs the value of the integer part, ‘8’, to the 6-bit coding section 1203,” which converts the value to a 6-bit code word. *Id.* at 20:39–42, 20:46–48. Continuing with the 8.7 dB value example, “the lower digit information generation section 1202 outputs the value of the fractional part, ‘7’, to the 4-bit coding section 1204,” which converts the value to a 4-bit code word. *Id.* at 20:39–45, 20:49–52.

Of the claims remaining in the ’590 patent, claims 3 and 7 are independent. Claim 3, reproduced below, is illustrative of the claimed subject matter:

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Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

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