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Paper 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION and HTC AMERICA, INC.,
Petitioner,

v.

INVT SPE LLC,
Patent Owner.

Case IPR2018-01557
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)

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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).

HTC Corporation and HTC America, 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 10) to which Patent Owner filed a Sur-Reply (Paper 12).

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.

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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. 1–2; Paper 4 (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. 2 n.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. 2 n.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).

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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.

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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:

> 3. A communication terminal apparatus comprising:
>
> a measurer that measures a downlink channel quality and outputs information that is generated in association with said downlink channel quality and composed of a plurality of digits including an upper digit and an lower digit;
>
> a coder that encodes the information such that the upper digit is assigned a larger number of bits than the lower digit; and
>
> a transmitter that transmits the encoded information to a base station apparatus.

D. The Asserted Grounds of Unpatentability

Petitioner challenges under 35 U.S.C. § 103[1] the patentability of claims 3, 4, 7, and 8 in the ’590 patent.

References	Claims
Padovani[2] and Gils[3]	3, 4
Padovani, Gils, and Olofsson[4]	7, 8

[1] The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of § 103.

[2] PCT Publication No. WO 99/23844, published May 14, 1999 (Ex. 1009, “Padovani”).

[3] W. van Gils, “Design of error-control coding schemes for three problems of noisy information transmission, storage and processing,” dissertation, Eindhoven Univ. of Technology, Eindhoven, the Netherlands, 1988 (Ex. 1010, “Gils”); *see* Pet. vii (Exhibit List).

[4] U.S. Patent No. 6,167,031, issued Dec. 26, 2000 (Ex. 1053, “Olofsson”).

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