

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. AND
TELEFONAKTIEBOLAGET LM ERICSSON,
Petitioner,

v.

INTELLECTUAL VENTURES II LLC,
Patent Owner.

Case IPR2018-01694
Patent 8,897,828 B2

Before KRISTEN L. DROESCH, MICHAEL W. KIM, and
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner, Ericsson Inc. and Telefonaktiebolaget LM Ericsson, filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1, 2, 5, 6, 8, 9, 12, 13, 15, 16, 19, 20, 22, 23, 26, 27, 29, 30, 33, 34, 36, 37, 40, and 41 of U.S. Patent No. 8,897,828 B2 (Ex. 1001, “the ’828 patent”). Patent Owner, Intellectual Ventures II LLC, timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), we have authority to determine whether to institute review.

An *inter partes* review may not be instituted unless “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). For the reasons set forth below, we conclude that Petitioner has shown a reasonable likelihood it will prevail in establishing the unpatentability of at least one challenged claim. We, therefore, institute *inter partes* review of the challenged claims of the ’828 patent in this proceeding.

A. RELATED MATTERS

As required by 37 C.F.R. § 42.8(b)(2), each party identifies various judicial or administrative matters that would affect or be affected by a decision in this proceeding. Pet. 1–2; Paper 5 (Patent Owner’s Mandatory Notices).

B. THE ’828 PATENT

The ’828 patent is titled “Power Control in a Wireless Communication System” and describes power-control systems that can operate in multiple modes. Ex. 1001, (54), (57). In particular, the ’828 patent describes open-

loop power control, in which a user equipment (UE) can measure path loss and use it to determine the transmit power level. *Id.* at 2:5–16. The ’828 patent also describes closed-loop power control, in which the network measures the “signal to noise-plus-interference ratio (SNIR)” and uses it to issue transmit power control (TPC) commands to the UE. *Id.* at 1:50–56, 2:17–32. The ’828 patent discloses that a UE receiving TPC commands may accumulate the commands to determine the transmit power level. *Id.* at 6:39–46, 7:16–19. The UE may include both open- and closed-loop functionality so that it may respond to either TPC commands or to a change in the path loss. *Id.* at 8:5–7.

C. CHALLENGED CLAIMS

Challenged claims 1, 8, 15, 22, 29, and 36 are independent. Claim 15 is illustrative of the claimed subject matter and is reproduced below:

15[pre]. A method performed by a wireless network, the method comprising:

- [a] sending, by the wireless network, an indication of whether accumulation of transmit power control (TPC) commands is enabled;
- [b] determining, by a user equipment (UE), a path loss of a downlink channel;
- [c] receiving, on a single physical channel by the UE if accumulation is enabled, an allocation of a scheduled uplink resource and a TPC command, wherein the TPC command is accumulated with other received TPC commands;
- [d] calculating, by the UE if accumulation is enabled, transmit power in association with an uplink communication based on both the path loss and the accumulated TPC commands; and

[e] receiving, on the single physical channel by the UE if accumulation is not enabled, an allocation of a scheduled uplink resource to transmit data to the wireless network at a power level calculated by the UE based on the path loss.

Ex. 1001, 14:41–61¹

D. PROPOSED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability, each based on 35 U.S.C. § 103:

| References | Claims |
|---|---|
| Zeira, ² Chen, ³ and Cheng ⁴ | 1, 5, 8, 12, 15, 19, 22, 26, 29, 33, 36, and 40 |
| Zeira, Chen, Cheng, and Tong ⁵ | 2, 9, 16, 23, 30, and 37 |
| Zeira, Chen, Cheng, and Shiu ⁶ | 6, 13, 20, 27, 34, and 41 |

Pet. 1. Petitioner also relies on the Declaration of Dr. Wayne Stark (Ex. 1003). *See generally* Pet. 11–73.

¹ We add square-bracketed annotations to separate claim limitations as identified by the parties. *See* Pet. 25–49.

² U.S. Patent No. 6,728,292 B2 (filed June 11, 2003; iss. Apr. 27, 2004) (Ex. 1004).

³ U.S. Patent No. 7,532,572 B2 (filed May 14, 2004; iss. May 12, 2009) (Ex. 1006).

⁴ U.S. Patent No. 6,411,817 B1 (filed Jan. 21, 2000; iss. June 25, 2002) (Ex. 1005).

⁵ U.S. Patent No. 6,529,741 B1 (filed Apr. 16, 1999; iss. Mar. 4, 2003) (Ex. 1009).

⁶ U.S. Patent. No. 6,983,166 B2 (filed Aug. 20, 2001; iss. Jan. 3, 2006) (Ex. 1008).

II. DISCUSSION

A. 35 U.S.C. § 325(D)

Patent Owner argues that we should deny institution because the Petition relies on Zeira and Chen, which were “heavily considered during prosecution,” and because “the Petition’s arguments directly overlap with those considered during prosecution.” Prelim. Resp. 15–19.

We consider multiple factors when determining whether to exercise our discretion not to institute under 35 U.S.C. § 325(d), potentially including:

(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, Case IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (Paper 8) (informative). As Patent Owner points out, Zeira was applied a number of times during prosecution. Prelim. Resp. 15–17. After the Board affirmed the Examiner’s rejection over

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