

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LG ELECTRONICS INC.,
Petitioner,

v.

CORE WIRELESS LICENSING S.A.R.L.,
Patent Owner.

Case IPR2016-00986
Patent 8,165,049 B2

Before JAMESON LEE, DAVID C. McKONE, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
Dismissing Motion for Joinder
37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

A. *Background*

On April 29, 2016, a Petition (Paper 1, “Pet.”) was filed to institute *inter partes* review of claim 15 of U.S. Patent No. 8,165,049 B2 (Ex. 1001, “the ’049 patent”). Patent Owner filed a Preliminary Response (Paper 11, “Prelim. Resp.”) on August 3, 2016. Also on April 29, 2016, Petitioner filed a Motion for Joinder (Paper 3) to seek joinder with IPR2015-01986. Patent Owner filed an Opposition (Paper 7) to the Motion for Joinder. Petitioner filed a Reply (Paper 8) to the Opposition to the Motion for Joinder. Patent Owner filed a Sur-Reply (Paper 10) to the Reply to the Opposition to the Motion for Joinder.

We exercise discretion to not institute *inter partes* review of claim 15 of the ’049 patent. The Motion for Joinder is dismissed as moot.

B. *Related Matters*

Patent Owner indicates that the ’049 patent is at issue in *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, Civ. No. 2:14-cv-00912 (E.D. Tex.). Paper 6, 2. Petitioner additionally indicates that *Core Wireless Licensing S.A.R.L. v. Apple Inc.*, Civ. No. 3:15-cv-5007 (N.D. Cal.) is a related matter. Pet. 1. U.S. Patent No. 8,792,398 claims priority to the ’049 patent and is involved in *inter partes* review IPR2015-01988. Paper 6, 2.

The ’049 patent is also involved in IPR2015-01986, for which trial was instituted on April 1, 2016, for claims 11–14, 17, and 28–31 but not claim 15.

C. The '049 Patent

The '049 patent is titled “Filtering of Electronic Information to be Transferred to a Terminal.” Ex. 1001, at [54]. The electronic information to be transferred can be any electronic content, such as short messages, picture messages, multimedia messages, and files. *Id.* at 3:44–48. The '049 patent is directed to an apparatus and a method for filtering electronic information to be transferred to a terminal through a telecommunication connection. *Id.* at Abstr. The invention involves (1) attaching a specific filtering parameter by the device transferring the electronic information to the electronic information before the electronic information is transferred to the terminal through the telecommunication connection, and (2) informing the terminal of the filtering parameter before the electronic information is transferred to the terminal through the telecommunication connection. *Id.* The terminal checks the filtering parameter and decides, based on the filtering parameter, whether to allow or prevent receiving the electronic information. *Id.*

The '049 patent describes that, preferably, the filtering parameter is transmitted to the terminal in a separate notification message before sending of the electronic information to the terminal in the event the terminal indicates that it will allow receiving of the information. *Id.* at 3:8–12. The '049 patent also describes that alternatively the filtering parameter is included in the first part of the electronic information, such as a header, which the terminal reads first, and the terminal may decide, upon reading the filtering parameter in the header, that receiving the rest of the electronic information will be prevented. *Id.* at 3:12–19.

The '049 patent describes that, in a preferred embodiment, the receiving terminal carries out the filtering automatically on the basis of pre-setting made in the terminal. *Id.* at 3:19–21. The '049 patent describes that alternatively the terminal may inform the user of the filtering parameter and then the user can decide whether to receive or not receive the electronic information. *Id.* at 3:21–26.

Claim 15 depends from claim 14. Both are reproduced below:

14. A method, comprising:

receiving by an apparatus of a recipient to whom electronic information is addressed a filtering parameter associated with electronic information that is to be received through a cellular telecommunication connection;

automatically allowing or preventing receiving of the electronic information on the basis of the filtering parameter; and

preventing the receiving of the electronic information through the cellular telecommunication connection if the filtering parameter denotes the electronic information as information whose receipt is to be prevented.

15. A method according to claim 14, wherein the filtering parameter comprises the information on at least one class of a number of classes agreed on in advance, on the basis of which the electronic information has been classified into the class, the class denoting whether the electronic information is a personal message, a commercial advertisement or information relating to a specific subject.

Id. at 17:37–55.

D. Evidence Relied Upon

Petitioner relies on U.S. Patent No. 6,301,608 B1 (Ex. 1023, “Rochkind”), U.S. Patent No. 6,732,273 B1 (Ex. 1024, “Byers”), and the following references:

MMS Specs.

Petitioner collectively identifies as “MMS Specifications” a series of draft Technical Specifications developed by 3GPP. Pet. 4. We refer to “MMS Specifications” simply as “MMS Specs.” The documents include:

3rd Generation Partnership Project (“3GPP”), TSG-SA Working Group 1 (Services), *Technical Specification Group Services and System Aspects, Service aspects; Stage 1, Multimedia Messaging Service (3G TS 22.140 version 0.1.0)*, TSG S1#4 (99)486 (July 5–9, 1999) (Ex. 1003, “MMS-1 v0.1.0”); 3GPP, *Technical Specification Group Services and System Aspects, Service Aspects; Stage 1, Multimedia Messaging Service (3G TS 22.140 version 0.2.0)* (Sept. 1999) (Ex. 1004, “MMS-1 v0.2.0”).

Nokia Proposal

Petitioner identifies a technical proposal purportedly presented by Nokia Corporation to a 3GPP working group (Pet. 6):

MMS architecture proposal, TSGT2#4(99)500 (June 14–16, 1999) (Ex. 1009, “Nokia”).

Table Summarizing References

Reference		Date	Exhibit
MMS Specs.	MMS-1 v0.1.0 MMS-1 v0.2.0	July 12, 1999 Sept. 13, 1999	Ex. 1003 Ex. 1004
Nokia	TSGT2#4(99)500	June 29, 1999	Ex. 1009
Rochkind	U.S. Patent No. 6,301,608 B1	Oct. 9, 2001 filed Aug. 14, 1996	Ex. 1023
Byers	U.S. Patent No. 6,732,273 B1	May 4, 2004 filed Oct. 21, 1998	Ex. 1024

Petitioner also relies on the Declarations of Mr. Friedhelm Rodermund and Mr. Mark R. Lanning. Exs. 1007, 1022.

E. The Asserted Grounds

References	Basis	Claim Challenged
MMS Specs., Nokia, and Byers	§ 103(a)	15
MMS Specs., Nokia, and Rochkind	§ 103(a)	15

II. ANALYSIS

A. Discretionary Non-Institution

1. Overview

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(a). There is no per se rule against a petitioner filing a second petition to address a patent claim on which the Board previously declined to institute a review. Rather, panels of this Board have considered a variety of factors in deciding whether to exercise discretion not

to institute review, including:

- (a) the finite resources of the Board;
- (b) the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review;
- (c) whether the same petitioner previously filed a petition directed to the same claims of the same patent;
- (d) whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;¹
- (e) whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;²
- (f) the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition; and
- (g) whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent.

We are concerned about the limited resources of the Board and fundamental fairness for both Petitioner and Patent Owner. Petitioner

¹ See *Conopco, Inc. v. Proctor & Gamble Co.*, Case IPR2014-00506, slip op. at 4 (PTAB Dec. 10, 2014) (Paper 25) (Informative), and slip op. at 6 (PTAB July 7, 2014) (Paper 17); *Toyota Motor Corp. v. Cellport Sys., Inc.*, Case IPR2015-01423, slip op. at 8 (PTAB Oct. 28, 2015) (Paper 7).

² See *Conopco, Inc. v. Proctor & Gamble Co.*, Case IPR2014-00628, slip op. at 11 (PTAB October 20, 2014) (Paper 21) (discouraging filing of a first petition that holds back prior art for use in later attacks against the same patent if the first petition is denied); *Toyota Motor Corp.*, slip op. at 8 (“the opportunity to read Patent Owner’s Preliminary Response in IPR2015-00634, prior to filing the Petition here, is unjust.”).

cannot expect automatic acceptance of multiple petitions for consideration, if they are against the same claims of the same patent and filed so long apart that Petitioner received the benefit of having studied Patent Owner's Preliminary Response in the first petition or the Board's decision on whether to institute review in the first petition, prior to filing the second petition. That is especially so if Petitioner, at the time of filing of the first petition was aware of or should have been aware of the prior art references applied in the second petition.

The potential for inequity resulting from a petitioner's filing of serial attacks against the same claims of the same patent, while having the opportunity to adjust litigation positions along the way based on either the patent owner's contentions responding to prior challenges or the Board's decision on prior challenges, is real and cannot be ignored. This is not to say, however, that multiple petitions against the same claims of the same patent are never permitted. Rather, each case depends on its own facts. We look to and consider, in each case, as we do here, what rationale a petitioner offers for filing multiple petitions and for the time elapsed between those filings.

2. The First Petition—Filed in IPR2015-01986

The instant Petition is the second petition filed by Petitioner challenging claim 15 of the '049 patent. The first petition was filed on September 26, 2015, in IPR2015-01986, alleging two grounds of unpatentability for claim 15:

(1) that claim 15 is unpatentable as obvious over MMS Specs., Nokia, and Sony³; and

(2) that claim 15 is unpatentable as obvious over MMS Specs., Nokia, Sony, and Shiroshita.⁴

On January 4, 2016, in IPR2015-01986, Patent Owner filed a Preliminary Response. On April 1, 2016, we instituted trial in IPR2015-01986, for claims 11–14, 17, and 28–31 of the '049 patent. We denied institution of trial for claim 15 on both alleged grounds identified above.

3. The Institution Decision in IPR2015-01986

More than 7 months passed between Petitioner's filing of the first petition in IPR2015-01986 on September 26, 2015, and Petitioner's filing of the second petition in this proceeding on April 29, 2016. During that time, Patent Owner filed a Preliminary Response in IPR2015-01986, addressing, *inter alia*, why Petitioner's challenge in the first petition against claim 15 is deficient. Also during that time, we rendered a decision in IPR2015-01986, explaining why Petitioner's challenge against claim 15 was deficient. In the meantime, Petitioner's time period for filing petitions challenging the '049 patent expired under 35 U.S.C. § 315(b).

Specifically, in denying institution of review in IPR2015-01986 for claim 15, we disagreed with Petitioner's characterization of claim 15 as

³ A technical proposal purportedly presented by Sony Corporation to a 3GPP working group—3GPP, *Technical Specification Group Services and System Aspects, Service aspects; Stage 1, Multimedia Messaging Service* (3G TS 22.140 version 0.3.1), T2M(99)008 (Nov. 9–10, 1999) (Ex. 1010 in IPR2015-01986).

⁴ Japanese Unexamined Patent Application H11-110401, published Apr. 23, 1999 (Ex. 1011 in IPR2015-01986).

simply setting forth a Markush group of a personal message, a commercial advertisement, and information relating to a specific subject, and Petitioner's corresponding allegation that claim 15 is satisfied by showing one member of the group in the prior art. *See LG Elecs., Inc. v. Core Wireless Licensing S.A.R.L.*, Case IPR2015-01986, slip op. 26–27 (PTAB April 1, 2016) (Paper 7) (“Petitioner has oversimplified claim 15 into setting forth a Markush group of restricted members such that the satisfaction of merely one meets the claim”). Instead, after considering the full context of claim 15, we concluded that “[c]laim 15 requires a plurality of classes agreed to in advance, including the specific categories of ‘personal message,’ ‘a commercial advertisement,’ and ‘information relating to a specific subject.’” *Id.* at 27. On that basis, we determined that Petitioner did not adequately account for the full extent of the limitation at issue in claim 15. *Id.*

We also determined that, for Petitioner's assertions for claim 15, Sony does not add to the disclosure of MMS Specs. *Id.* at 26. We additionally determined that, for claim 14, from which claim 15 depends, Shiroshita is not a meaningful addition to MMS Specs. *Id.* at 28. For claim 15, we determined that Shiroshita does not cure the deficiencies of MMS Specs., Nokia, and Sony. *Id.* at 30.

On April 14, 2016, Petitioner requested rehearing of the Decision in IPR2015-01986 denying institution of trial for claim 15. On May 2, 2016, we denied Petitioner's request for rehearing. IPR2015-01986, Paper 12.

4. The Second Petition

The second petition is a response to our Institution Decision in IPR2015-01986. Petitioner no longer maintains its position that claim 15 simply recites a Markush group, as it presented in the Petition filed in

IPR2015-01986. Rather, Petitioner states: “For purposes of this Petition, Petitioner has followed the constructions adopted by the Board in IPR2015-01986, set forth below. These constructions are relevant to claim 15, either directly or through its dependence on claim 14.” Pet. 12–13. Petitioner no longer relies on Sony or Shiroshita, which we described in the Institution Decision of IPR2015-01986 as not adding to the disclosure of MMS Spec. More importantly, Byers has been added to the combination of MMS Specs. and Nokia, to account for the full extent of the limitation in claim 15 that was at issue in IPR2015-01986, as we have construed it in the Institution Decision of IPR2015-01986. The same is true with respect to Rochkind. Petitioner does not indicate when or how it first became aware of Byers and Rochkind, and does not represent that either Byers or Rochkind reasonably was unavailable to Petitioner at the time of filing of its first petition.

These facts suggest this is a case of undesirable incremental-petitioning, where a petitioner relies on a Board decision in a prior proceeding involving the same parties, the same patent, and the same claim, to mount a second attack against a claim after an unsuccessful first attack, by fixing deficiencies, noted by the Board, that should not have been in the first petition.

“Allowing similar, serial challenges to the same patent, by the same petitioner, risks harassment of patent owners and frustration of Congress’s intent in enacting the Leahy-Smith America Invents Act.” *Butamax Advanced Biofuels LLC, v. Gevo, Inc.*, Case IPR2014-00581, slip op. at 13 (PTAB Oct. 14, 2014) (Paper 8) (citing H.R. Rep. No. 112-98, pt. 1, at 48 (2011)). Also, “it is more efficient for the parties and the Board to address a matter once rather than twice.” *Samsung Elec. Co. v. Rembrandt Wireless*

Techs., LP, Case IPR2015-00114, slip op. at 6 (PTAB Jan. 28, 2015) (Paper 14). The Board's resources would be more fairly expended on first petitions rather than on a follow-on petition like the Petition in this case.

The only justification Petitioner alleges for incremental-petitioning is its assertion that in the co-pending district court action between the parties involving the '049 patent, Patent Owner did not advance the construction urged in Patent Owner's Preliminary Response in IPR2015-01986, but treated claim 15 as setting forth a Markush group. Paper 3, 9. On that basis, Petitioner argues that the claim construction urged by Patent Owner in the Preliminary Response filed in IPR2015-01986 was unknown to Petitioner at the time of filing of the Petition in IPR2015-01986.⁵ *Id.* Petitioner characterizes the claim construction advanced by Patent Owner in the Patent Owner's Preliminary Response in IPR2015-01986 as constituting "a change in circumstances" that somehow justifies the filing of a second petition. Paper 8, 2. Petitioner's contentions are unpersuasive, as explained below.

First, claim construction is not an issue that Patent Owner is uniquely positioned to determine to the exclusion of Petitioner. Rather, Petitioner is required to construe the claims in the Petition. *See* 37 C.F.R.

§ 42.104(B)(3). Whatever is Patent Owner's proposed construction elsewhere, Petitioner is responsible to assert in its own petitions before the Board, such as that in IPR2015-01986, the claim construction that it desires and urges the Board to adopt. In this case, Petitioner's only attempt to construe claim 15 was to note, in passing, that "a personal message, a

⁵ The claim construction urged by Patent Owner in IPR2015-01986 is the same as that adopted by the Board in the decision instituting trial in IPR2015-01986.

commercial advertisement, or information relating to a specific subject” is a Markush group. IPR2015-01986, Paper 1, 30. Petitioner took no stated position on the remaining language of claim 15, including the language “the filtering parameter comprises the information on at least one class of a number of classes agreed on in advance, on the basis of which the electronic information has been classified into the class,” or how the cited prior art taught or suggested that language. As reiterated in our Decision on Rehearing, it was this additional language, rather than the language alleged to be a Markush group, that Petitioner failed to show in the prior art. IPR2015-01986, Paper 12, 4–5.

Petitioner’s second petition is not directed to adapting its position to a surprising claim construction advanced by Patent Owner or adopted by the Board. Rather, Petitioner seeks to fill an evidentiary gap resulting from its failure to address, in any capacity, significant language from claim 15. The second petition has been filed to fix a defect of the first petition, namely a failure to address claim language that clearly should have been addressed. Petitioner has not justified a second bite at the apple by framing this as an unanticipated issue of claim construction.

Second, on claim construction, the Board is not limited to choosing between what has been argued by Petitioner and what has been argued by Patent Owner. Rather, based on the evidence of record, we interpret claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Accordingly, Petitioner’s argument on what it had expected Patent Owner to argue with respect to claim construction, in

IPR2015-01986, is misplaced. Whether or not Patent Owner argued that claim 15 does not present a Markush group, Petitioner had to account for the possibility that the Board would disagree with its construction that claim 15 presents a Markush group. If there is substantial doubt on how to construe a claim term, a petitioner is free to include alternative constructions in its petition, and to make arguments accordingly. Moreover, it was incumbent on Petitioner to account for the full recitation of claim 15, not just the portion of that claim allegedly addressed by Patent Owner in district court. Thus, we are not persuaded by Patent Owner's characterization of a changed circumstance.

Third, we have reviewed the material identified by Petitioner to support its contention that Patent Owner had, in related district court action, construed claim 15 as setting forth a Markush group of limitations that can be met by satisfaction of any member within the group. *See* Paper 8, 1–2. That material is composed of selected portions of two sentences from Paragraph 62 within excerpts of Patent Owner's infringement report. Ex. 1040 ¶ 62. The cited material is inconclusive and incomplete. Paragraph 62 pertains only to indirect and induced infringement, not direct infringement, which is discussed in Paragraph 60. Also, Paragraph 62 refers to “advertisement of the MMS functionality in documents such as the user manuals of the Accused Device,” which is not the same as referencing a message class corresponding to messages that constitute advertisements. Furthermore, Patent Owner provides portions of claim charts (Ex. 2018) referenced in Paragraph 60, covering direct infringement of claim 15. Paper 10, 1–2. As correctly noted by Patent Owner, the cited portion of the claim charts denotes four pre-established categories of potential message types to

which a message can belong in the accused device, i.e., “Personal,” “Advertisement,” “Informational,” and “Auto.” Ex. 2018, 3. That position is consistent with the construction urged by the Patent Owner in its Preliminary Response in IPR2015-01986. Accordingly, we are not persuaded by Petitioner that Patent Owner had, in related district court action, construed claim 15 as setting forth a Markush group of limitations that can be met by satisfaction of any member within the group.

Finally, we cannot ignore the timing of the second petition. Petitioner waited until the last possible day (under Section 315(b)) to file its first petition. That petition failed to address key claim language of claim 15, which Patent Owner pointed out in its Preliminary Response. Petitioner now seeks to fill in evidentiary gaps long after the bar date through filing a serial second petition, with new evidence and argument, accompanied by a joinder motion, at a time when Patent Owner has an expectation of repose. This weighs against exercising our discretion to institute review.

5. Conclusion

For all of the reasons discussed above, and given the limited resources of the Board, we exercise our discretion not to institute review in this proceeding with respect to claim 15. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(a).

B. Petitioner’s Motion for Joinder

Because we do not institute *inter partes* review of claim 15 on any ground of unpatentability, Petitioner’s Motion for Joinder, which seeks joinder of the instant proceeding with IPR2015-01986, is moot.

III. ORDER

It is

ORDERED that the Petition is denied and no trial or *inter partes* review is instituted for claim 15 of the '049 patent on any ground; and

FURTHER ORDERED that Petitioner's Motion for Joinder is *dismissed* as moot.

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