

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RUCKUS WIRELESS, INC., BELKIN INTERNATIONAL, INC.,
NETGEAR, INC., and ROKU, INC.,
Petitioner,

v.

HERA WIRELESS S.A.,
Patent Owner.

IPR2018-01421
Patent 8,934,851 B2

Before MICHAEL R. ZECHER, THOMAS L. GIANNETTI, and
ROBERT L. KINDER, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Granting Patent Owner's Motion to Amend to Cancel Claims 1–3 and 7–9
Denying Patent Owner's Motion to Amend to Substitute Claims 10 and 12
35 U.S.C. § 318(a)

I. INTRODUCTION

Ruckus Wireless, Inc., Belkin International, Inc., Amazon.com, Inc.,¹ Netgear, Inc., and Roku, Inc. (collectively, “Petitioner” or “Ruckus”) filed a Petition requesting an *inter partes* review of claims 1–3 and 7–9 of U.S. Patent No. 8,934,851 B2 (Ex. 1001, “the ’851 patent”). Paper 1 (“Pet.”). Patent Owner, Hera Wireless S.A., filed a Preliminary Response. Paper 8. After considering the arguments presented in Patent Owner’s Preliminary Response, we determined that the information presented in the Petition established that there was a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim. Pursuant to 35 U.S.C. § 314, we instituted this *inter partes* review as to all of the challenged claims and all grounds raised in the Petition. Paper 14 (“Institution Dec.”).

Following institution, Patent Owner did not file a Patent Owner Response. Instead, Patent Owner filed a Motion to Amend. Paper 25 (“Motion”). The Motion to Amend requests the Board “to cancel original claims 1–3 and 7–9 of [the ’851 patent] and substitute therefor new claims 10 and 12.” *Id.* at 1; *see also id.* at 2 (“[Patent Owner] respectfully requests that the Board grant this motion to amend and cancel claims 1–3 and 7–9 and substitute claim 10 and 12.”). Subsequently, Petitioner filed an Opposition to the Motion to Amend (Paper 27, “Opp.”), Patent Owner filed a Reply (Paper 31, “Reply.”), and Petitioner filed a Sur-reply (Paper 37, “Sur-reply”).

¹ A joint motion to terminate the proceeding only as to Amazon.com was granted. Paper 13.

A consolidated oral hearing with related cases IPR2018-01371, IPR2018-01372, and IPR2018-01373, filed by Intel Corporation, along with cases IPR2018-01418, IPR2018-01419, and IPR2018-01420, filed by Ruckus, was held on November 6, 2019, and a transcript of the hearing is included in the record. Paper 43 (“Hearing Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision under 35 U.S.C. § 318(a). For the reasons we identify below, we grant Patent Owner’s Motion to Amend with respect to its request to cancel challenged claims 1–3 and 7–9 of the ’851 patent. We, however, deny Patent Owner’s Motion to Amend with respect to its request to substitute proposed claims 10 and 12 for cancelled independent claims 1 and 7, respectively.

A. Related Matters

The parties indicate that the ’851 patent is the subject of numerous district court cases including: (1) *Hera Wireless S.A. v. Amazon.com, Inc.*, 1:17-cv-00947 (D. Del.); (2) *Hera Wireless S.A. v. ARRIS Group, Inc.*, 1:17-cv-00948 (D. Del.); (3) *Hera Wireless S.A. v. Belkin Int’l, Inc.*, 1:17-cv-00949 (D. Del.); (5) *Hera Wireless S.A. v. Netgear, Inc.*, 1:17-cv-00951 (D. Del.); (6) *Hera Wireless S.A. v. Roku, Inc.*, 1:17-cv-00952 (D. Del.); (7) *Hera Wireless S.A. v. Lenovo Holding Co., Inc.*, 1:17-cv-01088 (D. Del.), Pet. 2–3; Papers 5, 9.

Petitioner has filed a second petition seeking inter partes review of the ’851 patent, challenging different claims from those challenged here. IPR2018-01420. The Board instituted *inter partes* review in IPR2018-01420, and concurrently with this Decision, the Board is entering a Final Written Decision in that proceeding. Petitioner has also filed petitions

seeking *inter partes* review of patents related to the '851 patent, including: IPR2018-01418 (challenging U.S. Patent No. 7,962,103) and IPR2018-01419 (challenging U.S. Patent No. 8,412,115).

The '851 patent is also the subject of a petition for *inter partes* review filed by Intel Corporation: IPR2018-01373. In addition, Intel has filed petitions requesting *inter partes* review of patents related to the '851 patent, including the following cases: (1) IPR2018-01371 (challenging U.S. Patent No. 7,962,103); and (2) IPR2018-01372 (challenging U.S. Patent No. 8,412,115). Pet. 3.

B. The '851 Patent

The '851 patent is titled “Radio Apparatus, and Method and Program for Controlling Spatial Path.” Ex. 1001, (54). The '851 patent generally relates to a radio apparatus capable of establishing multiplex communication between a radio terminal and a radio base station via a plurality of paths formed by space division, as well as to a method and a program for controlling a spatial path. *Id.* at 1:19–25. The '851 patent describes a modification to a Japanese wireless communication system known as PHS (“Personal Handy phone System”). *Id.* at 1:66–2:19.

According to the '851 patent, one alleged problem with prior art multi-path communications systems was that, once established, the paths could not be modified, even if a failure occurred in one of the designated paths. *Id.* at 4:14–17. The '851 patent, therefore, proposes a solution by providing:

a radio apparatus capable of adaptive modification in connection of a plurality of paths between a terminal and a base station in accordance with a communication condition in a mobile communication system where communication is established with

a multiple-paths-for-one-user scheme such as the MIMO scheme, as well as a method and a program for controlling a spatial path.

Id. at 4:23–30.

The '851 patent describes use in PHS of PDMA (“Path Division Multiple Access”) to improve efficiency. *Id.* at 2:20–26. In PDMA, to achieve efficiency in using a given frequency of a radio wave, mobile radio terminal units of a plurality of users establish spatial multiple connections to a radio base station through a plurality of paths formed by spatially dividing an identical time slot of an identical frequency. *Id.* at 2:22–26. This allows multiple users to communicate with the base station on the same carrier frequency and time slot. Ex. 1008, 3.

The '851 patent proposes a MIMO (“Multi Input-Multi Output”) scheme in which multiplex communication is established between one terminal having a plurality of antennas and a PDMA base station via a plurality of spatial paths of an identical frequency and an identical time slot. Ex. 1001, 3:24–28. This is illustrated by Figure 2 of the '851 patent, reproduced below.

FIG.2

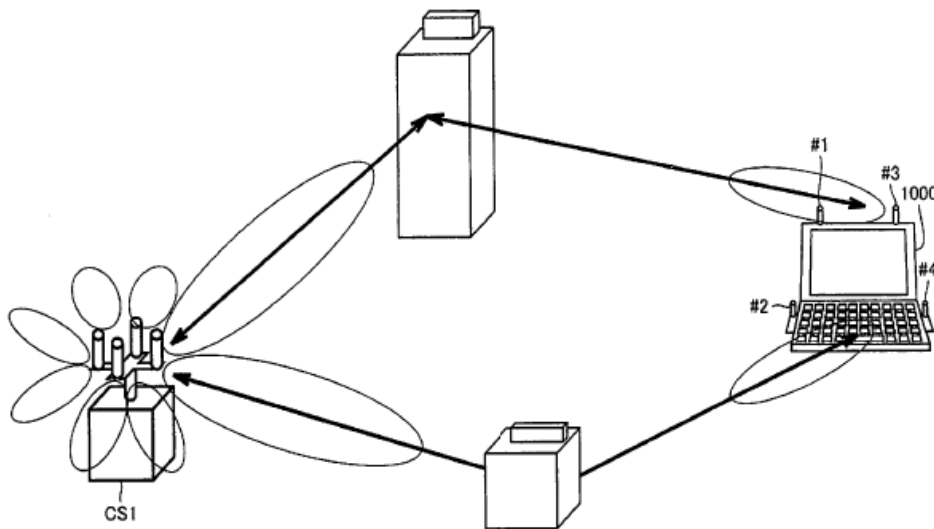


Figure 2 illustrates communication between PDMA terminal 1000 and an array antenna of base station CS1 using multiple spatial paths, where terminal antennas 1 and 3 are used for a first path and terminal antennas 2 and 4 are used for a second path. Ex. 1001, 7:27–30, 9:26–34.

In the embodiment of Figures 2 and 3 (identified as “First Embodiment”), a memory within terminal 1000 stores “antenna number information.” *Id.* at 9:45–46. Terminal 1000 transmits the antenna number information to base station CS1 at a prescribed timing. *Id.* at 9:46–48. Base station CS1 issues an instruction for the number of paths to be set to base station 1000 “based on the antenna number information from terminal 1000.” *Id.* at 9:48–51. “Terminal 1000 sets the number of paths to be formed in accordance with the instruction from base station CS1.” *Id.* at 9:51–52.

The ’851 patent further explains, with relation to Figure 3, that antenna number information is transmitted to the base station from terminal 1000 as control information in requesting establishment of a link channel

(LCH allocation request). *Id.* at 9:61–64. Base station CS1 gives an instruction for the number of paths stating that “the number of paths to be set should be equal to or smaller than the number of antennas, as the control information for link channel allocation instruction, for example, based on the antenna number information from the terminal.” *Id.* at 9:65–10:3.

II. MOTION TO AMEND

A. Background

We instituted *inter partes* review of the ’851 patent on two separate grounds: (1) obviousness of claims 1–3 and 7–9 over Paulraj² “in view of the knowledge, skill, and creativity of a [person of ordinary skill in the art],” and (2) obviousness of claims 1–3 and 7–8 over Reudink³ “in view of the knowledge, skill, and creativity of a [person of ordinary skill in the art].” Institution Dec. 6, 22.

As discussed *infra*, Patent Owner now requests cancellation of original claims 1–3 and 7–9 and substitution of new claims 10 and 12 for the cancelled claims. Motion 1. The Motion to Amend is not contingent on our determination as to whether a preponderance of the evidence establishes that challenged claims 1–3 and 7–9 of the ’851 patent are unpatentable. We, therefore, *grant* Patent Owner’s request to cancel those claims. *Id.* Thus, the only remaining issue before us is whether to grant the Motion to Amend as to proposed substitute claims 10 and 12.

In addition to its Motion and Reply, Patent Owner relies on two declarations from its expert, Dr. Jacob Sharony, to support its proposed

² U.S. Patent No. 6,351,499 B1. Ex. 1010.

³ U.S. Patent No. 7,039,441 B1. Ex. 1009.

amendment. A first declaration of Dr. Sharony was filed with the Motion to Amend. Ex. 2004 (“Sharony I Decl.”). The second was filed with Patent Owner’s Reply. Ex. 2013 (“Sharony II Decl.”). In addition, a transcript of Dr. Sharony’s October 10, 2019, deposition was filed as Exhibit 1020 (“Sharony Dep.”).

With its Opposition to the Motion to Amend, Petitioner submitted a declaration by its expert, Dr. Kevin Negus. Ex. 1015 (“Negus Decl.”).⁴

B. Proposed Substitute Claims

As noted, Patent Owner moves to substitute independent claims 10 and 12 for the cancelled claims, specifically, replacing independent claims 1 and 7, respectively. Motion 1, Claims App’x. Claim 10 recites the following (with underlining indicating language added to and brackets indicating language removed from independent claim 1):

10. A radio apparatus capable of communicating with another radio apparatus, comprising:
a communication unit configured to communicate using an antenna; and
a reception unit configured to receive, from said another radio apparatus, a value indicating [possible multiplicity associated with] the maximum number of spatial paths that can be formed by said another radio apparatus for multiplex communication[, at a predetermined timing] in a request to establish a link channel.

Motion, Claims App’x. Claim 12 recites the following (with underlining indicating language added to and brackets indicating language removed from independent claim 7):

⁴ An earlier declaration by Dr. Negus was submitted with the Petition. Ex. 1002.

12. A radio apparatus capable of communicating with another radio apparatus, comprising:
 - a communication unit configured to communicate using a plurality of antennas; and
 - a reception unit configured to receive, from said another radio apparatus, a value indicating [possible multiplicity associated with] the maximum number of spatial paths that can be formed by said another radio apparatus for multiplex communication, [at a predetermined timing] in a request to establish a link channel.

Id.

C. Statutory and Regulatory Requirements

In this proceeding, we first determine whether the motion to amend meets the statutory and regulatory requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. *See Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 and IPR2018-01130, Paper 14 (PTAB Feb. 25, 2019) (precedential) (“*Lectrosonics*”).

1. A Reasonable Number of Substitute Claims

A motion to amend may, “[f]or each challenged claim, propose a reasonable number of substitute claims.” 35 U.S.C. § 316(d)(1)(B) (2012). “The presumption is that only one substitute claim would be needed to replace each challenged claim, and it may be rebutted by a demonstration of need.” 37 C.F.R. § 42.121(a)(3) (2018).

Patent Owner cancels six claims and proposes two replacements—claims 10 and 12. We determine that the number of proposed substitute claims is reasonable under 35 U.S.C. § 316(d)(1)(B) and 37 C.F.R. §§ 42.121(a)(3).

2. Responding to a Ground of Unpatentability

“A motion to amend may be denied where . . . [t]he amendment does not respond to a ground of unpatentability involved in the trial.” 37 C.F.R. § 42.121(a)(2)(i). In its proposed substitute claims, Patent Owner adds limitations to independent claims 1 and 7 being replaced and explains how the proposed substitute claims are patentable over Paulraj and Reudink, the prior art references that served as the basis of the grounds of unpatentability involved in the trial. Motion 10–16. Specifically, Patent Owner has added three categories of allegedly narrowing limitations not present in original claims 1 and 7:

(1) the term “beforehand” is replaced by the more-specific clause “prior to any request to establish a link channel from the another radio apparatus for multiplex communication”; (2) the clause “value indicating possible multiplicity associated with the number of spatial paths that can be formed by said another radio apparatus” is replaced by the more specific clause “value indicating the maximum number of spatial paths that can be formed by said another radio apparatus for multiplex communication”; and (3) the clause “at a predetermined timing” is replaced by the more specific clause “in a request to establish a link channel.”

Motion 10–11. Patent Owner contends “[n]one of Petitioner’s references teaches or suggests systems having this new combination of limitations.”

Motion 11.⁵ We determine that the amended language in the proposed substitute claims, which will be discussed in more detail *infra*, is responsive

⁵ In addition to Paulraj and Reudink, Patent Owner also addresses prior art cited in related cases, e.g., “Wallace,” U.S. Patent Application Pub. No. 2002/0193146 A1 (Ex. 1019). Motion 17–21.

to the grounds of unpatentability involved in this trial under 37 C.F.R. § 42.121(a)(2)(i).

3. Scope of the Proposed Substitute Claims

A motion to amend “may not enlarge the scope of the claims of the patent.” 35 U.S.C. § 316(d)(3); *see* 37 C.F.R. § 42.121(a)(2)(ii). Patent Owner contends that the substitute claims are “narrower than the original, now-cancelled claims and introduce no new matter.” Motion 3. We have reviewed the limitations added in the proposed substitute claims (*see supra*) and determine that they do not enlarge the scope of the original cancelled claims.

4. New Matter/Written Description

A motion to amend “may not . . . introduce new matter.” 35 U.S.C. § 316(d)(3); *see* 37 C.F.R. § 42.121(a)(2)(ii). “New matter is any addition to the claims without support in the original disclosure.” *Lectrosonics*, Paper 15 at 7 (citing *TurboCare Div. of Demag Delaval Turbomachinery Corp. v. Gen. Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001)).

In order to show that an amendment does not introduce new subject matter, a motion to amend must set forth “[t]he support in the original disclosure of the patent for each claim that is added or amended” and “[t]he support in an earlier-filed disclosure for each claim for which benefit of the filing date of the earlier filed disclosure is sought.” 37 C.F.R. § 42.121(b)(1) and (2). Patent Owner provides citations for each respective limitation of the claim, showing that proposed substitute claims 10 and 12 are supported by U.S. Patent Application No. 13/786,888 (Ex. 2006, “the ’888 application”), which issued as the ’851 patent. Motion 5–9. Patent Owner also provides citations for each respective limitation of the claims, showing

that proposed substitute claims 10 and 12 are also supported by earlier-filed disclosures for which benefit of the filing date is sought—namely, U.S. Patent Application No. 10/508,655 (Ex. 2007, “the ’655 application”), filed on March 11, 2003, and Exhibit 2009, an English translation of Japanese Patent Application No. JP-2002-081375 (Ex. 2008, “the ’375 application”), filed on March 22, 2002. Motion 5–7.

For reasons that will be discussed *infra*, of particular relevance to this discussion is whether the original disclosure of the ’888 application, and the earlier-filed disclosures of the ’655 application and the ’375 application, provide sufficient written description support for the added claim limitation “value indicating the maximum number of spatial paths that can be formed” “in a request to establish a link channel,” as recited in each of proposed substitute claims 10 and 12. See discussion of claims 10 and 12 *supra*. Specifically, in responding to Petitioner’s prior art challenge to claims 10 and 12, Patent Owner argues that the “value indicating the maximum number of spatial paths that can be formed” is not met by sending the number of antennas. See, e.g., Hearing Tr. 108:4–8 (“If the mobile station is saying I am going to count up the number of antennas . . . it is not sending the number of spatial paths. It is sending the number of antennas.”).

As discussed *supra*, in describing the First Embodiment of Figures 2 and 3 of the ’851 patent, the ’888 application explains: “First, the antenna number information is transmitted to the base station from terminal 1000 as control information in requesting establishment of a link channel (LCH allocation request).” Ex. 2006, 16:10–12. Patent Owner relies on this disclosure of transmitting antenna number information, and quotes this discussion in support of its proposed amendment. Motion 7, 8–9 (quoting

Ex. 2006, 16:10–12). In the very next sentence, the '888 application explains further that in this embodiment, “[b]ase station CS1 gives an instruction for the number of paths stating that *the number of paths to be set should be equal to or smaller than the number of antennas*, as the control information for link channel allocation instruction, for example, based on the antenna number information from the terminal.” Ex. 2006, 16:13–16 (emphasis added). Thus, the antenna number information is described as an upper limit for the number of paths formed. Patent Owner cites this and similar discussions from the '655 application and the '375 application. Motion 7 (citing Exs. 2006 & 2007, 16:10–12; Ex. 2009 ¶ 75).

Patent Owner relies also on Figure 7 of the '888 application as written description support for this limitation. Motion 7 (citing “Figs. 7(S100) and 8(S200)”). That figure (designated “Second Embodiment”) is a flowchart that shows “flow in adaptive control of the number of paths set” in that embodiment. Ex. 2006, 20:7–8. The first step in the process, designated S100, has two variations. See discussion *infra*. In the first variation, the terminal notifies the base station of “the number of antenna elements in the terminal.” *Id.* at 20:15–16.

Petitioner’s opposition challenges Patent Owner’s showing of written description support for this proposed amendment. Opp. 7. Petitioner contends that, “to the extent that Hera is arguing that the claimed ‘value indicating a maximum number of spatial paths’ that is transmitted/received in a ‘request to establish a link channel’ is something other than the terminal’s number of antennas, it fails to show § 112(a) written description support for the claim limitation.” Opp. 7. At the oral hearing, however, Petitioner’s counsel stated that, if we were to agree with Petitioner’s position

that the proposed claims are unpatentable over Wallace, “it becomes unnecessary to address the written description point.” Hearing Tr. 70:9–11.

Based on the disclosures in the ’888 application, the ’655 application, and the ’375 application, we find that there is at least one embodiment where a terminal transmits antenna number information in a link channel request. Specifically, in the First Embodiment discussed *supra* in relation to Figure 3, the antenna number information is transmitted to the base station from terminal 1000 as control information in requesting establishment of a link channel (LCH allocation request). Ex. 1001, 9:61–64. We further find that this amounts to transmitting a “value indicating the maximum number of spatial paths that can be formed” in “a request to establish a link channel,” as recited in proposed substitute claims 10 and 12. So, too, does the description of the first variation of the Figure 7 Second Embodiment described *supra*. This showing discharges Patent Owner’s burden on this issue.

However, because we also conclude, *infra*, that proposed substitute claims 10 and 12 would have been obvious in light of Wallace, and in view of Petitioner’s concession at the oral hearing, we do not find it necessary to further address Petitioner’s specific written description arguments. See Hearing Tr. 70:9–11 (“[I]f you agree with us on Wallace, it becomes unnecessary to address the written description point”).

D. Patentability of Proposed Substitute Claims 10 and 12

1. Introduction

Petitioner challenges proposed substitute claims 10 and 12 as obvious over Wallace (*see supra*) in view of the knowledge of a person of ordinary skill in the art. Opp. 7. Patent Owner “does not bear the burden of

persuasion to demonstrate the patentability of [the proposed] substitute claims.” *Lectrosonics*, Paper 15 at 4 (citing *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017); *Bosch Auto. Serv. Sols. LLC v. Iancu*, 878 F.3d 1027 (Fed. Cir. 2017)). “Rather, as a result of the current state of the law and [Office] rules and guidance, the burden of persuasion will ordinarily lie with the petitioner to show that any proposed substitute claims are unpatentable by a preponderance of the evidence.” *Id.*

We begin our analysis with the principles of law and other related matters that generally apply to an obviousness ground, followed by a brief overview of Wallace.

2. Principles of Law

A claim is unpatentable as obvious under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations).⁶ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). We analyze Petitioner’s proposed grounds based on obviousness with the principles identified above in mind.

⁶ Patent Owner did not present arguments or evidence regarding secondary considerations during the course of trial.

3. Person of Ordinary Skill

Relying on the testimony of Dr. Sharony, Patent Owner contends that a person of ordinary skill in the art at the time of the invention of the '851 patent would have possessed “working knowledge of multi-input multi-output (MIMO) wireless communications. The person would have gained this knowledge through a Bachelor of Science degree in Electrical Engineering or an equivalent degree, and three to five years of experience working in the field of wireless communications. Additional education or experience may serve as a substitute for these requirements.” Motion 4 (citing Sharony I Decl. ¶ 31).

Petitioner's Opposition does not dispute Dr. Sharony's assessment of the level of skill in the art in opposing the motion. The Petition, however, provides the following description:

As of March 2002, the education level and work experience of a person having ordinary skill in the art . . . relevant to the '851 Patent was a Bachelor of Science in Electrical Engineering, or an equivalent field, as well as three to four years of experience in the field of wireless communications, or a Master's degree in Electrical Engineering, or an equivalent field, as well as two years of experience in the field of wireless communications.

Pet. 21–22 (citing Ex. 1002 ¶ 29). The two formulations differ mainly in the amount of experience in wireless communications for a Bachelor's degree level engineer: three to four years (Petitioner) or three to five years (Patent Owner).

We regard any differences in the two formulations as insignificant. For the purpose of this Final Written Decision, we adopt Patent Owner's proposal as consistent with the prior art before us. However, we would reach the same result with regard to this decision under either formulation.

4. Claim Construction

In this *inter partes* review proceeding, filed before November 13, 2018, we interpret claim terms according to the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b).⁷ Under that standard, and absent any special definitions, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art, at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Referring to the terms in the original claims that are carried over from claims 1 and 7, Patent Owner asserts it “does not rely on those or any other specific claim constructions to demonstrate patentability of the proposed substitute claim over the prior art. Rather, Patent Owner demonstrates patentability based on the new limitations of the proposed substitute claims.” Motion 9. Thus, Patent Owner contends that “[t]he meanings of any new limitations (e.g., ‘maximum number of spatial paths’ or ‘request to establish a link channel’)—taken as a whole—are discernable from their context and would be readily understood by those of ordinary skill in the art.” *Id.*

Petitioner does not advance an explicit construction to determine whether proposed substitute claims 10 and 12 would have been obvious in light of the prior art of record. In the course of our discussion of the merits

⁷ See Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51340 (Oct. 11, 2018) (“This rule is effective on November 13, 2018 and applies to all . . . petitions filed *on or after the effective date.*” (emphasis added)).

of Petitioner's opposition, however, we do address the scope of claims 10 and 12 in applying them to Wallace.

5. *Wallace Overview*

Wallace is titled "Method and Apparatus for Antenna Diversity in a Wireless Communication System." Ex. 1019, (54). Wallace discloses a "[m]ethod and apparatus for negotiating a transmission scenario in a mixed mode spectrum wireless communication system." *Id.* at (57); *see also id.* ¶ 74 (disclosing a "mixed mode operation for one embodiment" where "the base station negotiates with user terminals to determine antenna diversity status of the terminal").

Of particular relevance to this case, Wallace discloses the use of wireless MIMO technology, as well as receiving signals and performing adaptive array processing. *Id.* ¶ 31 ("Using Multiple Input-Multiple Output, MIMO, the transmitter can send multiple independent data streams on the same carrier frequency to a user."), ¶ 95 ("[T]he receiver performs a complementary processing (e.g., spatial matched filter) of the linear transmit processing based on the channel characterization to compute the NC spatial matched filter coefficients needed for each transmission channel (i.e., each eigenmode).").

Figure 12 of Wallace is reproduced below.

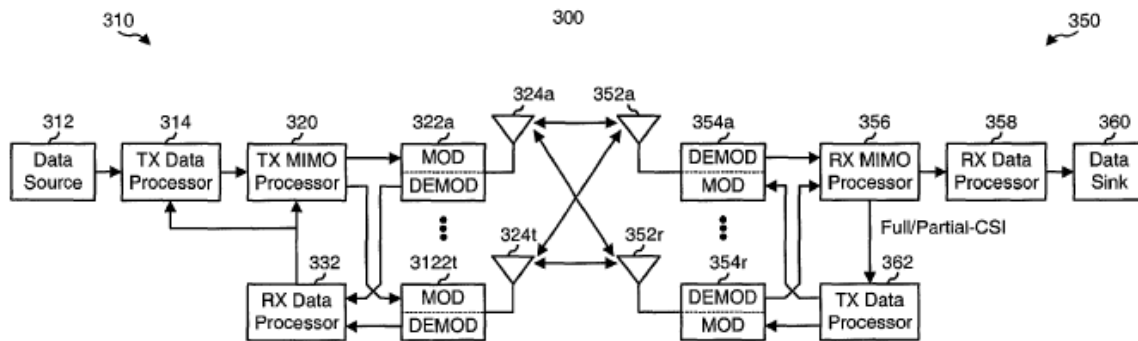


FIG. 12

Figure 12 depicts a “wireless communication system capable of MIMO and diversity transmissions.” Ex. 1019 ¶ 22. Wallace explains that “[s]ystem 300 may be operated to transmit data via a number of transmission channels.” *Id.* ¶ 93. Wallace relates the number of transmission channels (NC) to the number of transmit (NT) and receive (NR) antennas: “A MIMO channel may be decomposed into NC independent channels, with $NC \leq \min \{NT, NR\}$.” *Id.* Wallace explains further that “[e]ach of the NC independent channels is also referred to as a spatial subchannel of the MIMO channel. For a MIMO system, there may be only one frequency subchannel and each spatial subchannel may be referred to as a ‘transmission channel.’” *Id.*

Wallace explains also that a MIMO system, such as that shown in Figure 12, “can provide improved performance if the additional dimensionalities created by the multiple transmit and receive antennas are utilized.” *Id.* ¶ 94.

The base station of Wallace is illustrated in Figure 18, reproduced below.

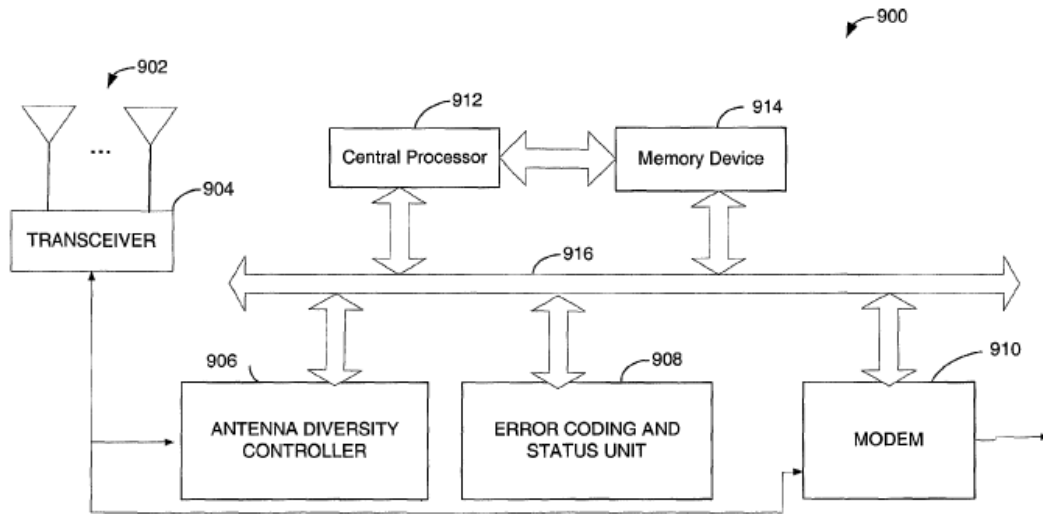


FIG. 18

Figure 18 illustrates base station 900 that includes, among other things, transceiver 904 coupled to multiple antennas 902 (including multiple transmit and receive antennas), central processor 912, and memory device 914. Ex. 1019 ¶ 122.

The mobile station of Wallace is illustrated in Figure 20, reproduced below.

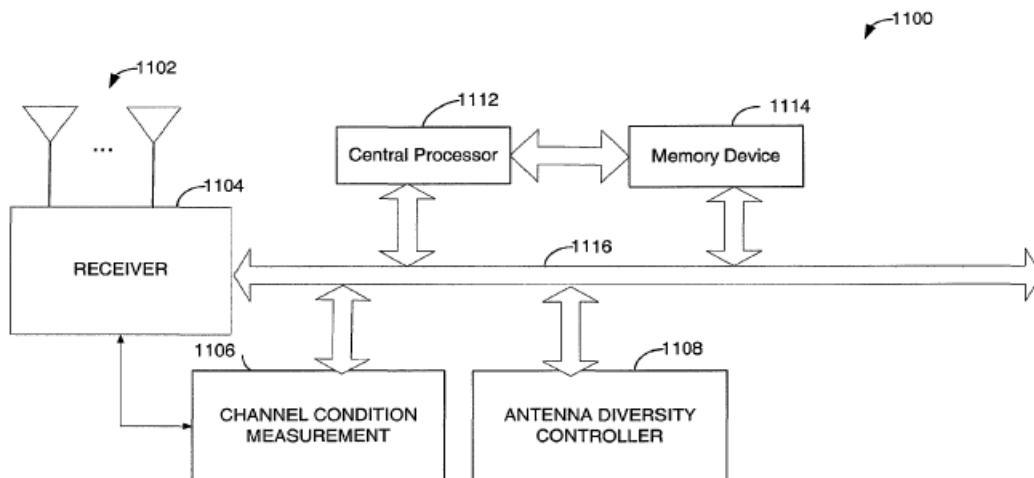


FIG. 20

Figure 20 illustrates mobile station 1100, which includes, among other things, receive antenna array 1102 coupled to receiver 1104 (which may be a transceiver), memory device 1114, and central processor 1112. Ex. 1019 ¶ 139.

Wallace explains that the process of negotiating a forward link between a mobile user and a base station “starts with a query to the mobile user to determine diversity capability information,” including, for example, information regarding the “number of receive antennas used at the mobile station.” Ex. 1019 ¶ 104. The base station may also request additional information concerning, for example, the “channel quality of [a] given link.” *Id.* In response to this information, the base station determines the appropriate configuration for the forward link. *Id.*

Wallace further discloses that, “[t]ypically, antenna diversity negotiations are performed at initiation of a communication, however, alternate embodiments may allow adjustment during a communication, wherein the quality of the communication link channel degrades over time and environmental condition.” Ex. 1019 ¶ 127. In addition, Wallace discloses that its approach can be used in time division multiple access (“TDMA”) systems. *Id.* ¶¶ 33–35, 69.

6. Analysis of Proposed Substitute Claim 10

Petitioner presents arguments and evidence that proposed substitute claim 10 would have been obvious over the teachings of Wallace. Opp. 7–25. Petitioner provides an element-by-element analysis of Wallace in relation to claim 10. *Id.* at 11–25. We credit Petitioner’s analysis and find Petitioner has demonstrated by a preponderance of the evidence that each element of claim 10 is either taught by Wallace or suggested by Wallace to a

person of ordinary skill, and that the claim as a whole would have been obvious to a person of ordinary skill based on Wallace. Our reasoning follows.

a. “A radio apparatus capable of communicating with another radio apparatus, comprising”

Petitioner contends that, to the extent this preamble of proposed substitute claim 10 is limiting, Wallace discloses the preamble. Opp. 11–12. We find that Wallace discloses the preamble of proposed substitute claim 10 because it describes a wireless communication system with a base station and “terminals.” Ex. 1019 ¶¶ 43–44. The base station communicates with the terminals. *Id.* ¶ 71. Thus, the base station of Wallace is “a radio apparatus,” and the terminal is “another radio apparatus.” Opp. 11; Negus Decl. ¶ 88–89.

Patent Owner does not challenge this assertion by Petitioner.

b. “a communication unit configured to communicate using an antenna”

Petitioner contends that Wallace discloses the “communication unit” of proposed substitute claim 10. Opp. 12–14. We find that Wallace meets this limitation. Wallace discloses MIMO communication system 300, shown in Figure 12 (reproduced *supra*), where data source 312 provides data to transmit data processor 314 and transmit MIMO processor 320. Ex. 1019, Fig. 12; ¶¶ 97–98, 100.

System 300 also has a number of receive antennas 352 and demodulators 354 that receive transmitted signals and provide demodulated signals to receive MIMO processor 356. *Id.* ¶ 102. Thus, we find that a person of ordinary skill would have understood that this combination of transmit and receive data processors, transmit and receive MIMO

processors, multiple modulators and demodulators, and multiple transmit and receive antennas is a communication unit that is configured to communicate using an antenna. Negus Decl. ¶ 106.

Patent Owner does not challenge this assertion by Petitioner.

c. “a reception unit configured to receive, from said another radio apparatus, a value indicating the maximum number of spatial paths that can be formed by said another radio apparatus for multiplex communication in a request to establish a link channel”

This limitation of proposed substitute claim 10 lies at the core of Petitioner’s opposition to the Motion to Amend and Patent Owner’s response.

i. “a reception unit . . . “

Petitioner contends that this element of claim 10 is met in Wallace: “A [person of ordinary skill] would understand that both Wallace’s disclosure of circuitry for a base station that includes multiple receive antennas, a modem, and a transceiver, and Wallace’s disclosure of elements for a receiver within a base station with multiple receive antennas coupled to demodulators and receive MIMO processor both constitute a ‘reception unit’ within claim 10.” Opp. 19–20 (*citing* Negus Decl. ¶ 137).

We find that a person of ordinary skill would have understood this reception unit element is taught by Wallace. Referring to Figure 12, reproduced *supra*, Wallace describes a MIMO communication system with a number of receive antennas 352 that receive transmitted signals and provide the received signals to demodulators 354. Ex. 1019 ¶ 102. The demodulators provide demodulated symbols to a receive MIMO processor 356, which, in turn, processes them and sends them to a receive data

processor that generates decoded bits and sends them to data sink 360. *Id.*
In light of the foregoing, we find that this limitation is disclosed in Wallace.

ii. “a value indicating the maximum number of spatial paths that can be formed by another radio apparatus”

Petitioner contends that Wallace meets this limitation. Opp. 15–17.
Petitioner asserts that a person of ordinary skill would have understood that the maximum number of spatial paths that can be formed by a terminal for multiplex communication “can equate to the ‘number of antennas’ available to the terminal for a communication link.” *Id.* at 16.

Petitioner contends that Wallace’s disclosure of the number of receive antennas and/or the number of transmit antennas for a mobile station is “a value indicating the maximum number of spatial paths that can be formed by said another radio apparatus for multiplex communication.” *Id.* at 17 (citing Negus Decl. ¶ 130). We agree with Petitioner for the reasons that follow.

As discussed *supra*, Wallace explains that the process of negotiating a forward link between a mobile user and a base station “starts with a query to the mobile user to determine diversity capability information,” including, for example, information regarding the “number of receive antennas used at the mobile station.” Ex. 1019 ¶ 104. The base station may also request additional information concerning, for example, the “channel quality of [a] given link.” *Id.* In response to this information, the base station determines the appropriate configuration for the forward link. *Id.*

Patent Owner contends that this information on number of antennas does not meet the claim limitation. Reply 5–7. Patent Owner argues: “Wallace does not contain any teaching of the use of subarrays. The presence of subarrays will necessarily result in the maximum number of

spatial paths formable by a particular unit being less than the total number of antennas, as the antennas within each subarray function as a single antenna for purposes of establishing spatial paths.” *Id.* at 5 (citations omitted).

According to Patent Owner: “While Wallace does disclose the possibility of transmitting the number of antennas as part of diversity negotiations, the number of spatial paths is a different parameter that *does not have to be, and usually is not*, the same as the number of antennas.” *Id.* (emphasis added).

At the oral hearing, this argument was presented another way:

THE BOARD: So would it be fair to characterize patent owner’s position as that antenna number information is *necessary, but not sufficient* to define the number of spatial paths formable?

PATENT OWNER’S COUNSEL: Yes, I think that is fair, Your Honor.

Hearing Tr. 112:18–23 (emphasis added).

We are not persuaded that this argument is sufficient to rebut Petitioner’s showing that the antenna number information in Wallace is “a value indicating the maximum number of spatial paths formable.” We are more persuaded by the fact that, as Petitioner points out, the proposed substitute claims 10 and 12 do not “recite or require” subarrays. Sur-reply 8; *see also In re Self*, 671 F.2d 1344, 1348 (CCPA 1982) (explaining that limitations not appearing in the claims cannot be relied upon for patentability). Patent Owner could have added such a limitation as part of its amendment, but chose not to do so. Instead, all the proposed substitute claims call for is “a value indicating the maximum number of spatial paths formable.” Motion, Claims App’x. While it is true that the antennas in a communication system may be grouped in sub-arrays, we are not aware of any assertion that this is a requirement for communications to take place.

Thus, at least in such situations where there are no sub-arrays, the number of antennas would be indicative of the maximum number of paths and would meet the claim limitation. Sur-reply 10; Sharony II Decl. ¶ 48 (“The two numbers coincide only when each subarray contains exactly one antenna and all antennas are working and used for multiplex communication.”). Patent Owner’s expert Dr. Sharony testified to this effect at his deposition. When addressing proposed claim 7 of U.S. Patent No. 7,962,103 (“the ’103 patent”), which, similar to claims 10 and 12 here, calls for “a value indicating the maximum number of spatial paths formable,” Dr. Sharony testified:⁸

Q. If I sell an 802.11 access point that has a plurality of antennas, but those antennas are not arranged in sub-arrays, can I still meet the limitation of claim 7 of the '103 patent?

...

A. You do because each antenna, again, it's a special case, could be the sub-array.”

Ex, 1020, 35:21–36:4. Thus, we are not persuaded by Patent Owner’s argument distinguishing Wallace based on “antenna arrays,” as it is not supported by the language of the proposed substitute claims. Instead, the proposed claims call for “a value indicating the maximum number of spatial paths that can be formed.” Motion, Claims App’x.

At the oral hearing, Patent Owner shifted the focus of its argument against Wallace to one based on the Figure 7 Second Embodiment of the ’851 patent. *See, e.g.*, Hearing Tr. 109:6–110:2. Thus, to support its argument that the scope of proposed substitute claims 10 and 12 excludes Wallace’s transmitting the number of antennas as part of diversity

⁸ See IPR2018-01371, Paper 29 (Claims App’x).

negotiations, Patent Owner relies on the Figure 7 second variation, discussed briefly *supra*, involving P_MAX. Hearing Tr. 109:23–110:2. Figure 7 of the '851 patent is reproduced below.

FIG.7

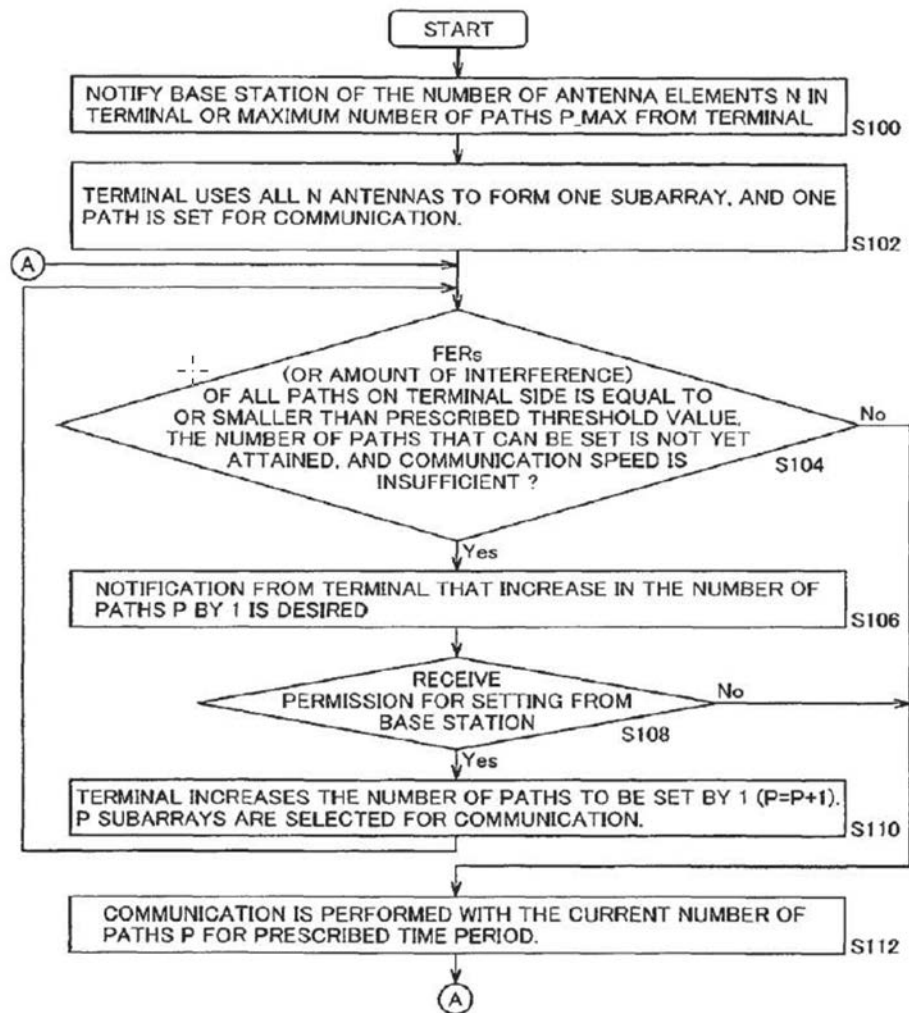


Figure 7 is a flowchart showing the steps in the adaptive control of the number of paths set in PDMA terminal. As noted previously in our written description analysis, Figure 7 is described in the '851 patent as a “Second Embodiment.” Ex. 1001, 12:16–21. As discussed, in the initial step (S100) of Figure 7, there are two alternatives: a first terminal either notifies base

station CS1 of the “number of antenna elements N in the terminal *or* the maximum number of paths P_MAX.” Ex. 1001, 12:27–29 (emphasis added). Patent Owner relies on the second (P_MAX) variation in its argument against Wallace. According to Patent Owner at the oral hearing:

Figure 7 allows for two alternatives. . . . One alternative is to send the number of antennas. Another alternative, *which is the one that we are now claiming*, is the one where you send the maximum number of paths P_MAX formable.

Hearing Tr. 109:24–110:2 (emphasis added). Thus, Patent Owner argues that proposed substitute claims 10 and 12 should be limited to the variation of Figure 7 where the base station is given “the maximum number of paths P_MAX.” *Id.* at 109:23–110:2, 111:20–23, 115:19–116:2.

For several reasons, we are not persuaded by this argument. We first look at the claim language itself. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc). The claim language imposes no requirement that the value be the actual number of paths, only that it be “a value indicating the maximum number of spatial paths *that can be formed* by said communication unit.” Motion, Claims App’x (emphasis added). There is no dispute that it is “well known” in MIMO spatial multiplexing that the number of antennas may set the upper limit for the number of paths, *e.g.*, when there are no antenna arrays. *See, e.g.*, Hearing Tr. 137:26–138:5 (“[W]e don’t dispute that the maximum number of spatial paths formable in any instance is going to be no more than the number of antennas.”). There is also no dispute that the number of antennas is “a relevant factor.” *Id.* at 119:9–10.

Nor does the ’851 patent specification support this argument by Patent Owner. Patent Owner’s argument ignores description of the First

Embodiment of the '851 patent, discussed *supra* in relation to Figures 2 and 3. Ex. 1001, 8:28 et seq. As explained *supra*, in that embodiment, the antenna number information is transmitted to the base station from terminal 1000 as control information in requesting establishment of a link channel (LCH allocation request). *Id.* at 9:61–64. Base station CS1 gives an instruction for the number of paths, the '851 patent stating that “the number of paths to be set should be equal to or smaller than the number of antennas, as the control information for link channel allocation instruction, for example, based on the antenna number information from the terminal.” *Id.* at 9:65–10:3. And in addition, the Second Embodiment illustrated in Figure 7 discloses the alternative initial step of notifying the base station of the number of antennas. *See* Ex. 1001, Fig. 7, *supra*.

Patent Owner's attempt to limit its claim by relying on the Figure 7 “P_MAX” variation is unconvincing. While claims must be read in view of the specification, “limitations from the specification are not to be read into the claims.” *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1326 (Fed. Cir. 2002) (citations omitted). “[T]he claims of the patent will not be read restrictively, unless the patentee has demonstrated a clear intention to limit the claim scope using words or expressions of manifest exclusion or restriction.” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004) (citing *Teleflex*, 299 F.3d at 1327). As noted *supra*, the '851 patent discloses sending antenna number information to the base station as an upper bound for the number of paths. Moreover, as discussed *supra*, Patent Owner relies on that very disclosure as providing written description support for proposed substitute claims 10 and 12. *See* Motion 7, 9.

In light of the foregoing, we credit Petitioner's evidence on this limitation, supported by the testimony of Dr. Negus, and find that the limitation is met by Wallace. Negus Decl. ¶¶ 204–208.

Petitioner's response to the P_MAX argument further asserts that P_MAX is a value that is derived after communication is established. Thus, according to Petitioner, in the '851 patent, a frame error rate counter (FER) calculates how many frames reach their destination terminal without an error. Hearing Tr. 72:6–13; Ex. 1001, 11:12–16. Petitioner explains that this stored information, in turn, is used to determine the value P_MAX. Hearing Tr. 72:14–73:3; Ex. 1001, 11:35–40. Thus, Petitioner argues that in order to establish communication, the first step would be to transmit the antenna number information, and not P_MAX. Hearing Tr. 74:8–23.

While we see merit in Petitioner's argument, we do not find it necessary to determine whether or not P_MAX is transmitted initially or derived after communication has started. We find (and Patent Owner does not dispute) that in one variation of this Second Embodiment, communication is initiated by transmitting the number of antennas to the base station. Hearing Tr. 109:17–110:2. For reasons discussed *supra*, we are not persuaded by Patent Owner's attempt to limit its claim to exclude that variation of the Second Embodiment, or the description in the '851 patent of the First Embodiment.

iii. “. . . for multiplex communication”

Petitioner contends that Wallace meets this limitation. Opp. 15–16; Negus Decl. ¶¶ 143, 158. Petitioner contends a person of ordinary skill would have understood “‘multiplex communication’ to mean at least a MIMO scheme where a terminal communicates with a base station using ‘a

plurality of spatial paths.’” Opp. 15 (citing Negus Decl. ¶ 110). Petitioner further contends a person of ordinary skill also would have understood the term “spatial path” to convey “at least the concepts of multiple ‘spatially multiplexed streams’ or ‘multiple distinct data streams.’” *Id.* (citing Negus Decl. ¶ 111).

We are persuaded by Petitioner’s argument and find that a person of ordinary skill would have understood the term “spatial path” in Wallace to convey “at least the concepts of multiple ‘spatially multiplexed streams’ or ‘multiple distinct data streams.’” Negus Decl. ¶ 111.

d. “receive . . . in a request to establish a link channel”

Petitioner contends that Wallace meets this limitation by disclosing “that the terminal/mobile station sends its number of transmit antennas, number of receive antennas as a message to the base station at the initiation of a communication at least in the form of a request for a communication from a mobile user that may be provided when the receiver registers with the base station.” Opp. 22 (internal quotation marks omitted) (citing Negus Decl. ¶¶ 152–154).

Patent Owner takes issue with this analysis. Reply 10–11. According to Patent Owner, “Wallace discloses that the actual number of antennas is transmitted from the terminal to a base station during registration, whereas the ’851 patent teaches that the maximum number of spatial paths that can be formed is transmitted in a request to establish a link channel.” *Id.* at 10 (emphasis omitted). To support its argument, Patent Owner relies on the PHS standard (Ex. 1016), which it claims establishes that the value indicating the number of spatial paths in PHS is not transmitted in a request to establish a link channel, as the claim requires, but comes after. *Id.*

We are not persuaded by this argument. Instead, we find that Wallace teaches transmitting the maximum number of spatial paths in the initial request of the mobile station to the base station. Negus Decl. ¶¶ 150–157. Wallace describes “[t]ypically” performing “antenna status negotiations” “at initiation of a communication.” Ex. 1019 ¶ 127. According to Wallace, “[i]nitiation refers to the start of a communication, including . . . a request for a communication from a mobile user.” *Id.* ¶ 123. Furthermore, in Wallace, a mobile station transmits antenna diversity status information, including the number of transmit and receive antennas, when it registers with the base station. *Id.* ¶ 141. The base station in Wallace “selects a transmission scenario based on the resources of the base station and the receiver.” *Id.* We find that a person of ordinary skill would have understood that this mobile station’s initial request to the base station is analogous to the request for a link channel in the ’851 patent. See Opp. 21–22 (citing Negus Decl. ¶ 149); Negus Decl. ¶¶ 154–158.

7. Analysis of Claim 12

Proposed substitute claim 12 is similar to proposed substitute claim 10, with one exception: the recited communication unit uses “a plurality of antennas” instead of “an antenna.” Motion, Claims App’x. Petitioner contends Wallace discloses embodiments that meet this additional limitation. Opp. 25. We find that at least Figures 12 and 18 of Wallace (reproduced *supra*) and the accompanying description in the text describe communications units that use “a plurality of antennas.” Ex. 1019 ¶¶ 102, 122; Negus Decl. ¶ 255.

8. Patent Owner's Additional Arguments

Patent Owner contends the “primary distinctions” are “Wallace does not teach: (a) transmitting the maximum number of spatial paths formable for multiplex communication; and (b) doing so in the initial request to establish a link channel.” Reply 1. These arguments are addressed *supra*.

Patent Owner presents additional arguments against Wallace. *Id.* at 5–11. We do not find these additional arguments persuasive.

For example, Patent Owner suggests that Wallace is “inherently different” from the ’851 patent because Wallace focuses “on selecting a transmission scenario for spatial diversity communication rather than on management of multiple spatial paths for spatial multiplexing communication.” Reply 11 n.3. We do not agree. For reasons discussed *supra*, we find that Wallace is from the same field of endeavor as the ’851 patent (wireless communication systems) and is at least “reasonably pertinent” to the claimed invention. Sur-reply 7 (citing *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004)).

Patent Owner contends Wallace teaches that the antenna number information transmitted from the remote terminal to the base station “is used only to determine a transmission scenario, i.e., the ‘type of configuration’ . . . for a communication link.” Reply 6. In addition, Patent Owner argues “Wallace does not contain any teaching of the relationship between the specific number of antennas and the maximum number of spatial paths. In fact, Wallace does not contain any teaching of spatial paths at all.” *Id.* We do not find these arguments convincing. We find that Wallace teaches MIMO communication links where the number of antennas is used to determine the maximum number of independent channels (i.e., the

maximum number of spatial paths) that can be formed by the terminal for multiplex communication. Ex. 1019 ¶ 93; Negus Decl. ¶¶ 43–45, 126–130. Thus, we find that to a person of ordinary skill Wallace teaches a relationship between antennas and spatial paths: the maximum number of spatial paths that can be formed by a terminal depends on the number of antennas at the terminal. *Id.* Further, we find that a person of ordinary skill would have understood Wallace uses this information to determine “the maximum number of spatial paths that can be formed.” *Id.*

Patent Owner further argues that Wallace receives “a *fixed* value of the terminal’s actual number of antennas in order to select a transmission scenario for spatial diversity communications. This fixed number of the actual number of antennas in the terminal does *not* represent the maximum number of spatial paths that can be formed for multiplex communication at any given time.” Reply 8. We do not find this argument convincing as it is contrary to the language of proposed substitute claims 10 and 12. Those claims do not call for a “dynamically changing parameter” or transmitting the actual number of paths formed, only “a value indicating the maximum number of spatial paths *that can be formed*.” Patent Owner does not dispute that the number of paths cannot exceed the number of antennas. *See supra*.

Patent Owner also raises the issue of the transmission in Wallace of antenna number information by the terminal during location registration. Reply 10. Patent Owner contends that the timing of this transmission does not correspond to sending a request to establish a link channel because those times “are usually different.” *Id.* We address this issue in our discussion of proposed substitute claim 10, *supra*. We find, furthermore, that Wallace meets this limitation because Wallace explicitly teaches to a person of

ordinary skill providing antenna number information at the “initiation of a communication”, e.g., when the “when the receiver registers with the base station.” Sur-reply 11–12 (citing Ex. 1019 ¶¶ 127, 141); Negus Decl. ¶¶ 150–158.

9. *Summary*

In summary, based on the full record developed during trial, we conclude that Petitioner has demonstrated by a preponderance of the evidence that the subject matter of proposed substitute claims 10 and 12 would have been obvious over Wallace.

III. CONCLUSIONS

Patent Owner’s request to cancel challenged claims 1–3 and 7–9 of the ’851 patent is *granted*. Patent Owner has demonstrated that proposed substitute claims 10 and 12 meet all the statutory and regulatory requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121. However, based on the arguments and evidence presented during trial, Petitioner has demonstrated by a preponderance of the evidence that proposed substitute claims 10 and 12 are unpatentable under 35 U.S.C. § 103(a). Patent Owner’s Motion to Amend as to substitute claims 10 and 12 is, therefore, *denied*.

A summary of our conclusions is set forth in the table reproduced below.

Motion to Amend Outcome	Claims
Original Claims Cancelled by Amendment	1–3, 7–9
Substitute Claims Proposed in the Motion to Amend	10, 12
Substitute Claims: Motion to Amend Denied	10, 12

IV. ORDER

In consideration of the foregoing, it is
ORDERED that claims 1–3 and 7–9 of the '851 patent are *cancelled*;
FURTHER ORDERED that, because Petitioner has demonstrated that
proposed substitute claims 10 and 12 are unpatentable, Patent Owner's
Motion to Amend as to claims 10 and 12 is *denied*;

FURTHER ORDERED that, because this is a Final Written Decision,
parties to this proceeding seeking judicial review of our decision must
comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2018-01421
Patent 8,934,851 B2

For PETITIONER:

Christopher Tyson
Matthew Yungwirth
DUANE MORRIS LLP
cjtyson@duanemorris.com
msyungwirth@duanemorris.com

Carol Ansley
ARRIS INTERNATIONAL
carol.ansley@arris.com

Bryan Clark
THE WEBB LAW FIRM
bclark@webblaw.com

For PATENT OWNER:

Henrik D. Parker
Timothy Devlin
Leonard Monfredo
Srikant Cheruvu
DEVLIN LAW FIRM LLC
hparker@devlinlawfirm.com
TD-PTAB@devlinlawfirm.com
lmonfredo@devlinlawfirm.com
scheruvu@devlinlawfirm.com