

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HONEYWELL INTERNATIONAL, INC., SIERRA WIRELESS, INC.,
and TELIT CINTERION DEUTSCHLAND GMBH,
Petitioner,

v.

3G LICENSING S.A.,
Patent Owner.

IPR2021-00906
Patent 7,580,388 B2

Before JAMESON LEE, AARON W. MOORE, and RUSSELL E. CASS,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

JUDGMENT

Final Written Decision on Remand
Determining Proposed Substitute Claims 69, 70, 77, and 78 Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

This Final Written Decision is entered pursuant to 35 U.S.C. § 318 and pursuant to a remand from the United States Court of Appeals for the Federal Circuit in *Telit Cinteron Deutschland GmbH, et al. v. 3G Licensing, S.A.*, 2025 WL 401647 (Fed. Cir. Feb. 3, 2025).¹ For the reasons explained below, we determine, in view of the Federal Circuit’s decision and the record, that 3G Licensing S.A. (“Patent Owner”) has not shown that its proposed substitute claims 69, 70, 77, and 78 have written description support in Application 11/065,872 as filed (“’872 Application”), which issued as the ’388 patent. Accordingly, that portion of Patent Owner’s Revised Motion to Amend which seeks entry of proposed substitute claims 69, 70, 77, and 78 is *denied*.

II. BACKGROUND

Petitioner² filed a Petition requesting *inter partes* review of claims 1–4, 6, 8, 9, 12, 33–36, 38, 40, 41, 44, 56, 57, 62, and 63 of the ’388 patent. Paper 8 (“Pet.”). We instituted *inter partes* review on December 9, 2021. Paper 18. Patent Owner filed a Motion to Amend and Request for Preliminary Guidance. Paper 29. The Board issued a Preliminary Guidance. Paper 42. Thereafter, Patent Owner filed a Revised Motion to Amend, proposing to add substitute claims 66–85. Paper 46. Petitioner filed an Opposition to the Revised Motion to Amend. Paper 48. Patent Owner filed a Reply to Petitioner’s Opposition to Patent Owner’s Revised Motion to

¹ The Federal Circuit’s slip opinion is entered in the record as Paper 80.

² Some petitioner entities have settled and the current petitioner entities are Honeywell International, Inc., Sierra Wireless, Inc., and Telit Cinteron Deutschland GmbH.

Amend. Paper 56. Petitioner filed a Sur-reply to Patent Owner's Reply to Petitioner's Opposition to the Revised Motion to Amend. Paper 64.

A Final Written Decision was issued on December 6, 2022. Paper 74. In that Final Written Decision, we determined that Petitioner proved by a preponderance of the evidence that claims 1–4, 6, 8, 9, 12, 33–36, 38, 40, 41, 44, 56, 57, 62, and 63 of the '388 patent are unpatentable, but had not proved by a preponderance of the evidence that any of Patent Owner's proposed substitute claims 66–85 in the Revised Motion to Amend were unpatentable over prior art. In the Final Written Decision, we also determined that Patent Owner proved that proposed substitute claims 66–85 meet the statutory and regulatory requirements. Accordingly, in the Final Written Decision, we *granted* Patent Owner's Revised Motion to Amend seeking to add proposed substitute claims 66–85. Paper 74.

Petitioner appealed our Final Written decision to the Court of Appeals for the Federal Circuit. Papers 75–78. On February 3, 2025, the Federal Circuit issued a decision in which it stated: “We vacate and remand the Board's decision with regard to claims 69 and 77, and their dependent claims, but otherwise affirm.” Paper 80.³ The formal mandate from the Federal Circuit was issued on March 12, 2025. Paper 79.

On April 10, 2025, a conference call was held between the Board panel and respective counsel for the parties, to discuss what issues remain for the Board to determine on remand and whether either party requests additional briefing. Paper 89. All parties agreed that additional briefing is not necessary, and no party requested additional briefing. Paper 10, 2. The

³ Proposed substitute claim 70 depends from proposed substitute claim 69. Proposed substitute claim 78 depends from proposed substitute claim 77.

parties also agreed that the Board need only address the written description support issue for proposed substitute claims 69, 70, 77, and 78, and nothing else. *Id.*

III. PROPOSED SUBSTITUTE CLAIMS 69, 70, 77, AND 78

A listing of Patent Owner's proposed substitute claims appears in Appendix A of the Revised MTA. Paper 46.

Proposed substitute claim 69 depends from proposed substitute claim 68 which depends from proposed substitute claim 66. Each of claims 66, 68, and 69 is reproduced below, with strike-through indicating deletion and underlining indicating insertion and certain changes bolded as Patent Owner presents in the Revised Motion to Amend Claims:

~~1-66~~ A method of transmitting control information from a mobile terminal in a network, the method comprising:
receiving a first message in the mobile terminal, the first message including information indicating at least ne available configuration for transmitting a second message, the second message including at least a portion of the control information;
selecting one of the at least one available configuration in the mobile terminal; and
transmitting the second message from the mobile terminal utilizing the selected information,
wherein the at least one available configuration is physical random access channel (PRACH) information related to a common control channel (CCCH) logical channel, the information including additional transport format information for the CCCH comprising ~~at least one of a RLC (Radio Link Control) size, an~~ **additional** transport block size, ~~or number of transport blocks.~~

Paper 46, 6–7.

~~3-68~~. The method of claim ~~166~~, wherein the at least one available configuration comprises a predefined configuration mode and a predefined configuration identity.

Id. at 7.

4-69. The method of claim **368**, wherein the predefined configuration mode comprises ~~at least one of utilizing an additional channel, utilizing an increased message block size for an existing channel, utilizing a new channel mapping information, or~~ utilizing a new message format;
wherein the new message format adapts a message format by omitting data;
wherein another message is transmitted using the adapted message format; and
wherein omitting data includes omitting START values transmitted in a message preceding the another message.

Id. at 8.

As shown above, claim 69 includes four distinct messages, a “first message,” a “second message,” “another message,” and a “message preceding the another message.”

Proposed substitute claim 77 depends from proposed substitute claim 76 which depends from proposed substitute claim 74. Each of claims 74, 76, and 77 is reproduced below, with strike-through indicating deletion and underlining indicating insertion and certain changes bolded as Patent Owner presents in the Revised Motion to Amend Claims:

33-74. A mobile communication device for transmitting control information to a network, the mobile communication device comprising:

an RF module configured to receive a first message from the network and to transmit a second message to the network, the first message including information indicating at least one available configuration for transmitting the second message and the second message including at least a portion of the control information;

an antenna configured to receive the first message from the network and to transmit the second message to the network;

a keypad configured to input information from a user;

a storage unit configured to store information associated with the at least one available configuration for transmitting the second message;

a display configured to convey information to the user;
and

a processing unit configured to process the first message, select one of the at least one available configuration and transmit the second message utilizing the selected configuration,

wherein the at least one available configuration is physical random access channel (PRACH) information related to a common control channel (CCCH) logical channel, the information including additional transport format information for the CCCH comprising ~~at least one of a RLC (Radio Control Link) size, an~~ **additional** transport block size, ~~or number of transport blocks.~~

Paper 46, 9–11.

~~35.76.~~ The mobile communication device of claim ~~3374~~, wherein the at least one available configuration comprises a predefined configuration mode and a predefined configuration identity.

Id. at 12.

~~36.77.~~ The mobile communication device of claim ~~3576~~, wherein the predefined configuration mode comprises ~~at least one of utilizing an additional channel, utilizing an increased message block size for an existing channel, utilizing a new channel mapping configuration, or utilizing a new message format;~~

wherein the new message format adapts a message format by omitting data;

wherein another message is transmitted using the adapted message format; and

wherein omitting data includes omitting START values transmitted in a message preceding the another message.

Id. at 12–13.

As shown above, like claim 69, claim 77 also includes four distinct messages: a “first message,” a “second message,” “another message,” and a “message preceding the another message.” The Federal Circuit instructed: “The claims thus require at least message A [first message] to precede messages C [another message] and D [message preceding the another message].” Paper 80, 7. In other words, the Federal Circuit determined that the “first message” must come before both “a message preceding the another message” and “another message.” *Id.*

With respect to proposed substitute claims 69, 70, 77, and 78, Patent Owner’s accounting for written description support in the specification of the ’872 application as filed appears on pages 8, 12–13, and 18–19 of the Revised Motion to Amend. Paper 46, 8, 12–13, 18–19. Patent Owner relies on that specification’s fourth embodiment and Figure 15. *Id.* at 19. Figure 15 is reproduced below:

FIG. 15

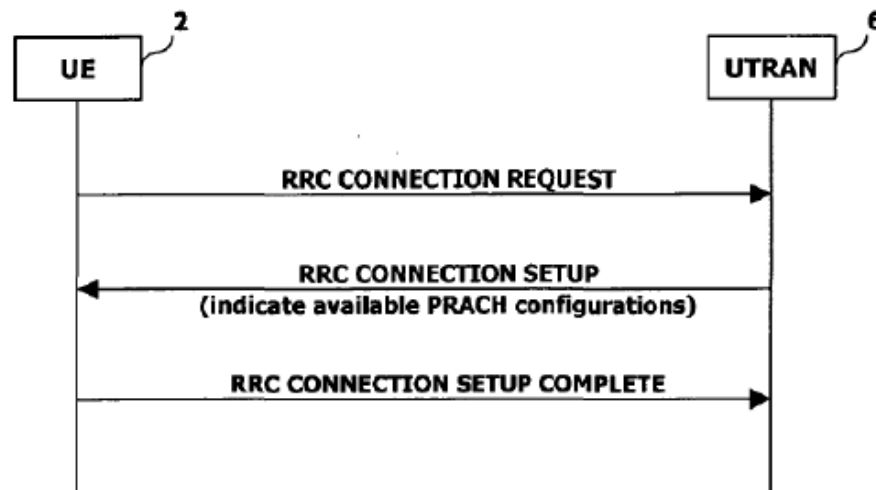


Figure 15 illustrates a method for transmitting an indication of available PRACH configurations to a mobile terminal. Ex. 1001, 12:15–18.

As explained by Patent Owner, the RRC Connection Setup message is the “first message”; the RRC Connection Setup Complete message is the second message; the RRC Connection Request message is the “another message”; and the Initial Direct transfer message (not shown in Figure 15) preceding the RRC Connection Request message is the “message preceding the another message.” *See* Paper 46, 8, 12–13, 18–19.

Per the Federal Circuit’s instruction, the “first message” must come before the “another message” and “message preceding the another message.” However, the “first message” identified by Patent Owner, i.e., the RRC Connection Setup message, occurs after what Patent Owner identifies as the “another message,” i.e., the RRC Connection Request message. That mismatching sequence is evident from Figure 15 reproduced above.

Further, the deficiency is also evident from the following text in the specification of the ’872 application, which describes that the RRC Connection Setup message, if any, is subsequent to the RRC Connection Request message:

As illustrated in FIG. 15, the information indicating the available PRACH configurations is transmitted to a specific new UE 2 that supports the new configurations when a connection between a UTRAN 6 and the UE is established. The existing RRC connection setup message is utilized to indicate the available PRACH configurations.

The UE 2 requests an RRC connection by transmitting an RRC connection request message to the UTRAN 6. If the RRC connection can be accomplished, the UTRAN 6 transmits an RRC connection setup message to the UE 2.

Ex. 1002 ¶¶ 144–45 (emphasis added).

Because the “first message” that Patent Owner identifies does not come before the “another message” that Patent Owner identifies, Patent Owner has not shown that proposed substitute claims 69 and 77 have written

description support in the specification of the '872 application as filed. Also, because claim 70 depends from claim 69 and claim 78 depends from claim 77, for the same reasons Patent Owner has not shown that proposed substitute claims 70 and 78 have written description support in the specification of the '872 application as filed.

IV. CONCLUSION

Revised Motion to Amend Outcome on Remand	Claims
Original Claims Cancelled by Amendment	
Substitute Claims Proposed in the Amendment	69, 70, 77, 78
Substitute Claims: Motion to Amend Granted	
Substitute Claims: Motion to Amend Denied	69, 70, 77, 78
Substitute Claims: Not Reached	

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the portion of Patent Owner's Revised Motion to Amend Claims, which proposes substitute claims 69, 70, 77, and 78, to replace claims 4, 6, 36, and 38 of the '388 patent, is *denied*; and

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

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