

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

WSOU INVESTMENTS, LLC
d/b/a BRAZOS LICENSING AND DEVELOPMENT,
Patent Owner.

IPR2021-00960
Patent 8,665,733 B2

Before THU A. DANG, ROBERT J. WEINSCHENK, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. *Background and Summary*

Cisco Systems, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–20 (“the challenged claims”) of U.S. Patent No. 8,665,733 B2 (Ex. 1001, “the ’733 patent”). WSOU Investments, LLC d/b/a Brazos Licensing and Development (“Patent Owner”) did not file a preliminary response to the Petition. We instituted an *inter partes* review of the challenged claims on December 6, 2021. Paper 6 (“Dec. on Inst.”), 10. After institution, Patent Owner filed a Response (Paper 9, “PO Resp.”) to the Petition, Petitioner filed a Reply (Paper 11, “Pet. Reply”) to the Response, and Patent Owner filed a Sur-reply (Paper 12, “PO Sur-reply”) to the Reply. We held an oral hearing on September 7, 2022, and a transcript of the hearing is included in the record. Paper 24 (“Tr.”).

For the reasons set forth below, Petitioner has shown by a preponderance of the evidence that claims 1–20 of the ’733 patent are unpatentable.

B. *Real Parties in Interest*

The parties identify themselves as the only real parties in interest. Pet. 75; Paper 3, 1.

C. *Related Matters*

The parties indicate that the ’733 patent is the subject of the following district court case: *WSOU Investments, LLC v. Cisco Systems, Inc.*, No. 6:21-cv-00128 (W.D. Tex.). Pet. 75; Paper 3, 2.

D. The '733 Patent

The '733 patent relates “generally to key performance indicators in communication networks and is particularly related to network element delay apportionment in round trip delay monitoring.” Ex. 1001, 1:8–11. The '733 patent states that “all wireless network operators track the network performance indicators and demand from the infrastructure and mobile vendors that certain performance criteria are met to satisfy a level of quality of the end user experience.” *Id.* at 1:19–23. According to the '733 patent, “[e]ven though it is feasible to measure the total data path latency for any given user and for any given service, it is in current practice prohibitively expensive to measure the apportionment of this total delay.” *Id.* at 1:37–42. But “[w]hen the measured end-to-end latency is higher than the expected value, it is a matter of urgency to know which of the network elements are the causes of this extra delay.” *Id.* at 1:45–48.

To address this alleged problem, the '733 patent describes “a method or apparatus capable of measuring round trip delay and apportioning latency among network elements contributing to the round trip delay without the drawbacks of present methods.” *Id.* at 2:1–4. Specifically, each network element is configured to receive a packet and determine if the packet includes a probe session indicator. *Id.* at 5:10–22. If the packet includes a probe session indicator, each network element records a timestamp “at reception of the packet and sending of the packet.” *Id.* at 10:24–28. The network elements then forward the recorded timestamps to a network management system that “calculates signaling plane delays across each network element.” *Id.* at 9:55–59.

E. Illustrative Claim

Of the challenged claims, claims 1, 7, and 14 are independent.
Claim 1 is reproduced below.

1. A method for apportioning delays of a plurality of network elements on a round trip path in a network, said method comprising the steps of:

Transmitting, at a user element, a loopback packet having a probe session indicator along said round trip path,

wherein said roundtrip path reaches a core network element, and

wherein the loopback packet is received at said user element after completing said roundtrip path;

determining at each of said plurality of network elements on said round trip path the presence of said probe session indicator, and

responsive to the presence of said probe session indicator, logging a first timestamp corresponding to the time of receipt of said loopback message, and a second timestamp corresponding to the time of retransmission of said loopback message; and

transmitting at each of said plurality of network elements said first and second timestamps to a network management system.

Ex. 1001, 12:6–25.

F. Evidence

Petitioner submits the following evidence:

Evidence	Exhibit No.
Declaration of Nader F. Mir, Ph.D. (“Mir Declaration”)	1003
Mateski, US 8,189,487 B1, issued May 29, 2012 (“Mateski”)	1005
Abdo, US 2006/0159025 A1, published July 20, 2006 (“Abdo”)	1006

Evidence	Exhibit No.
Buckley, US 2009/0131022 A1, published May 21, 2009 (“Buckley”)	1008

G. Asserted Grounds

Petitioner asserts that the challenged claims are unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 4, 5, 7–10, 12, 14–17, 19	103(a) ¹	Mateski
6, 13, 20	103(a)	Mateski, Abdo
3, 11, 18	103(a)	Mateski, Buckley

II. ANALYSIS

A. Legal Standards

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 the 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 ordinary skill in the art; and 4) any objective indicia of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the ’733 patent was filed before the effective date of the relevant amendment, the pre-AIA version of § 103 applies.

B. Level of Ordinary Skill in the Art

Petitioner argues that a person of ordinary skill in the art would have had “a bachelor’s degree in electrical engineering, computer engineering, or equivalent, and two years of professional experience relating to communication networks,” as well as “a working knowledge of the communication network art that is pertinent to the ’733 patent.” Pet. 11 (citing Ex. 1003 ¶ 20). Petitioner’s description of the level of ordinary skill in the art is supported by the testimony of Petitioner’s declarant, Dr. Nader Mir. Ex. 1003 ¶ 20. Patent Owner does not propose a description of the level of ordinary skill in the art or dispute Petitioner’s description. PO Resp. 6. We adopt Petitioner’s description for purposes of this Decision.

C. Claim Construction

In an *inter partes* review proceeding, a patent claim is construed using the same standard used in federal district court in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of the claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b) (2020). The parties’ disputes about the asserted grounds of unpatentability raise issues regarding the meaning of the term “probe session indicator” in claims 1, 7, and 14.

1. Probe session indicator

Patent Owner contends that the term “session” in “probe session indicator” includes “setting up any of a variety of different services including a call.” PO Resp. 12; Tr. 10:25–11:4. Patent Owner argues that the written description of the ’733 patent supports its interpretation. PO Resp. 12 (citing Ex. 1001, 4:35–39); PO Sur-reply 6–7 (citing Ex. 1001,

4:12–13, 6:31–34, 9:4–7); Tr. 11:6–12:6 (citing Ex. 1001, 3:63, 5:10–13, 6:31–34, 9:4–7). In particular, Patent Owner argues that “when the ’733 patent states that a ‘session can include setting up a variety of different services,’ what is being conveyed is that a session has the capability of setting up a variety of different services where one of the services can be a call.” PO Sur-reply 6–7 (citing Ex. 1001, 4:12–13, 6:31–34, 9:4–7).

We disagree with Patent Owner’s interpretation. The ’733 patent states that “a session is set up using the probe session identifier,” and “[t]he session *can include* setting up any of a variety of different services including a call.” Ex. 1001, 5:10–13 (emphasis added). The ’733 patent’s use of the phrase “can include” indicates that the described features of a session are optional, not requirements. *Id.*; see *Absolute Software, Inc. v. Stealth Signal, Inc.*, 659 F.3d 1121, 1137 (Fed. Cir. 2011). This is consistent with the other portions of the ’733 patent cited by Patent Owner, which similarly indicate that setting up a service or call are examples of a session, not requirements. Ex. 1001, 6:31–34 (“UE 508 sends signaling messages, *such as* for setting up a call or establishing a service”) (emphasis added); *id.* at 9:4–7 (“related to a session *such as* a call or a service”) (emphasis added).

Because Patent Owner’s interpretation is not consistent with the written description, we decline to adopt it. Nonetheless, as discussed below, even if we were to assume that the term “session” means “setting up any of a variety of different services including a call,” the asserted prior art teaches the disputed claim limitation. See Section II.D.2.

D. Obviousness of Claims 1, 2, 4, 5, 7–10, 12, 14–17, and 19 over Mateski

Petitioner argues that claims 1, 2, 4, 5, 7–10, 12, 14–17, and 19 would have been obvious over Mateski. Pet. 16–57. For the reasons discussed

below, Petitioner has shown by a preponderance of the evidence that claims 1, 2, 4, 5, 7–10, 12, 14–17, and 19 would have been obvious over Mateski.

1. Overview of Mateski

Mateski teaches a communication system including a transmitter, a receiver, network nodes, and a test server. Ex. 1005, 2:46–50, 6:66–7:3. The transmitter transmits a test packet including a test code to a network node. *Id.* at 2:59–61, 7:59–60. The network node reads the header of the test packet to determine if the test code is present. *Id.* at 3:2–5, 7:60–61. If the test code is present, the network node timestamps the header of the test packet with the arrival and departure times of the test packet at the network node. *Id.* at 3:5–10, 7:62–67. The network node also may transfer the timestamps to the test server. *Id.* at 3:15–19, 8:5–8.

2. Claim 1

Claim 1 recites “[a] method for apportioning delays of a plurality of network elements on a round trip path in a network.”² Ex. 1001, 12:6–8. Mateski teaches a test server that can “determine latency between each node, determine latency between each application in each node, and determine round-trip latency.” Pet. 19–20 (emphasis omitted); Ex. 1005, 5:4–10. Mateski also teaches a round trip path from a transmitter in a user device, through a plurality of network nodes, to a receiver in the same user device. Pet. 20–25; Ex. 1005, 3:30–31, 7:33–37, 10:35–47. Patent Owner does not dispute that Mateski teaches the preamble of claim 1.

² Because Petitioner presents evidence that the prior art teaches the recitations in the preamble of each independent claim, we need not decide whether the preamble in the independent claims is limiting.

Claim 1 recites “[t]ransmitting, at a user element, a loopback packet having a probe session indicator along said round trip path.” Ex. 1001, 12:9–10. Mateski teaches that the transmitter in the user device transmits a test packet having a test code along the round trip path. Pet. 25–27; Ex. 1005, 2:59–63, 3:30–31, 5:24–55, 7:43–46, 7:59–60. Patent Owner does not dispute that Mateski teaches this limitation of claim 1.

Claim 1 recites “wherein said roundtrip path reaches a core network element.” Ex. 1001, 12:11–12. Mateski teaches that a network node is in the round trip path. Pet. 27–29; Ex. 1005, 5:56–62. Patent Owner does not dispute that Mateski teaches this limitation of claim 1.

Claim 1 recites “wherein the loopback packet is received at said user element after completing said roundtrip path.” Ex. 1001, 12:13–14. Mateski teaches that the receiver in the user device receives the test packet after completing the round trip path. Pet. 29–31; Ex. 1005, 3:25–31, 7:25–27. Patent Owner does not dispute that Mateski teaches this limitation of claim 1.

Claim 1 recites “determining at each of said plurality of network elements on said round trip path the presence of said probe session indicator.” Ex. 1001, 12:15–17. Mateski teaches that the network nodes read the header of the test packet to determine if the test code is present. Pet. 31–34; Ex. 1005, 2:66–3:5, 7:60–61.

Patent Owner responds that Mateski does not teach a probe session indicator. PO Resp. 11–13; PO Sur-reply 5–7. Specifically, Patent Owner argues that “the ’733 patent discloses a probe session for determining latency where the session can include setting up any of a variety of different services including a call.” PO Resp. 12. But, according to Patent Owner,

Mateski “fails to mention a session that includes setting up any of a variety of different services including a call for which a network node is responsive.” *Id.*; PO Sur-reply 5.

Patent Owner’s argument is unavailing. As discussed above, we decline to adopt Patent Owner’s interpretation of the term “session” that requires setting up any of a variety of different services including a call. *See* Section II.C.1. Nonetheless, Mateski teaches setting up a variety of different services including a call. Pet. 16 (citing Ex. 1005, 5:58–62); *id.* at 22–23 (citing Ex. 1003 ¶ 72; Ex. 1005, 5:56–62, 6:22–27). Specifically, Mateski teaches that

[c]ommunication network 110 may comprise any network that *provides a communication service* for transmitter 101 to send a packet and receiver 102 to receive a packet. Communication network 110 could comprise wireless communication nodes, *telephony switches*, Internet routers, network gateways, computer systems, communication links, or some other type of communication equipment—including combinations thereof.

Ex. 1005, 6:20–27 (emphases added). In other words, Mateski’s network is capable of setting up a communication service. *Id.*; Ex. 1003 ¶ 72. And because Mateski’s network comprises telephony switches, that communication service can be a call. Ex. 1003 ¶ 72; Ex. 1005, 6:20–27.

Patent Owner also responds that Mateski does not teach determining the presence of the probe session indicator. PO Resp. 9–11; PO Sur-reply 2–5. Specifically, Patent Owner argues that Petitioner and its declarant, Dr. Mir, assert that a person of ordinary skill in the art would have understood that Mateski teaches determining the presence of the test code in the test packet. PO Resp. 9–11 (citing Pet. 32; Ex. 1003 ¶¶ 103–104). But, according to Patent Owner, “Dr. Mir does not state *why* a POSITA would

have this understanding” and does not “point to any support for his assertion in the intrinsic record or contemporaneous evidence at the time of the invention.” *Id.* at 11.

Patent Owner’s argument is unavailing. Petitioner and Dr. Mir each identifies specific portions of Mateski that teach determining the presence of the test code in the test packet. Pet. 32 (citing Ex. 1005, 2:66–3:5, 7:60–61); Ex. 1003 ¶¶ 101, 103 (citing Ex. 1005, 2:66–3:5, 7:60–61). For example, Mateski states that “network node 120 could read the header of the first packet *to determine if the first test code is present* by checking if a single bit representing the first test code is set to one.” Ex. 1005, 3:2–5 (emphasis added); *see also id.* at 7:60–61 (“Node 320 reads the packet header to determine whether it contains a test code.”). Patent Owner does not address the specific portions of Mateski cited by Petitioner and Dr. Mir. *See* PO Resp. 9–11; PO Sur-reply 2–5.

Patent Owner argued at the oral hearing that Petitioner relies on Mateski’s test code and unique tracking number together as teaching the probe session indicator. Tr. 14:10–16:6. And, according to Patent Owner, Petitioner does not show that Mateski teaches determining the presence of *both* the test code *and* the unique tracking number in the test packet. *Id.* Patent Owner’s argument is not timely because it was presented for the first time at the oral hearing. *See* Tr. 16:2–14; PO Resp. 9–13; PO Sur-reply 2–7; Consolidated Trial Practice Guide, 85–86 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf> (“TPG”) (“During an oral hearing, a party . . . may only present arguments relied upon in the papers previously submitted.”).

Moreover, Patent Owner’s argument is not persuasive. Petitioner asserts in the Petition that “Mateski’s test code *separately* and taken together with the assigned unique tracking number corresponds to ‘a probe session indicator.’” Pet. 26 (emphasis added); *see also id.* at 31–32 (“a packet with a loop-back test session indicator (e.g., test code separately and together with an assigned unique tracking number), which corresponds to the claimed ‘probe session indicator.’”). In other words, Petitioner relies on Mateski’s test code by itself as teaching the claimed probe session indicator. *Id.* at 26, 31–32. And, as discussed above, Mateski expressly teaches “determin[ing]” if the test code is “present” in the test packet. Ex. 1005, 3:2–5, 7:60–61.

Further, Petitioner shows that Mateski also teaches determining the presence of the unique tracking number in the test packet. Specifically, Mateski teaches that the network nodes read the unique tracking number from the header of the test packet. Pet. 32; Ex. 1005, 7:54–58 (“the test packet could be used to store the . . . unique tracking number . . . to be read by the nodes 320 and 330.”). And the evidence of record indicates that a person of ordinary skill in the art would have known that because the network nodes read the unique tracking number from the test packet, the network nodes determine that the unique tracking number is present. Pet. 32; Ex. 1003 ¶ 104. Patent Owner asserts that Mateski’s “act of reading” the test code does not “in and of itself constitute[] a determination” of its presence in the test packet, but Patent Owner does not identify specific evidence to support that assertion. PO Sur-reply 4. For the foregoing reasons, Petitioner has shown that Mateski teaches determining the presence of the probe session indicator.

Claim 1 recites “responsive to the presence of said probe session indicator, logging a first timestamp corresponding to the time of receipt of said loopback message, and a second timestamp corresponding to the time of retransmission of said loopback message.” Ex. 1001, 12:18–22. Mateski teaches that in response to the test code, the network nodes log a first timestamp corresponding to the packet arrival time and a second timestamp corresponding to the packet departure time. Pet. 34–36; Ex. 1005, 2:66–3:15. Other than the arguments discussed above, Patent Owner does not dispute that Mateski teaches this limitation of claim 1.

Claim 1 recites “transmitting at each of said plurality of network elements said first and second timestamps to a network management system.” Ex. 1001, 12:23–25. Mateski teaches that the network nodes transmit the first and second timestamps to the test server. Pet. 36–40; Ex. 1005, 3:15–18, 9:16–26. Patent Owner does not dispute that Mateski teaches this limitation of claim 1.

3. Claims 7 and 14

Claims 7 and 14 recite limitations similar to those discussed above for claim 1. Ex. 1001, 12:46–64, 13:14–14:6. Petitioner relies on evidence similar to that discussed above for claim 1, which shows that Mateski teaches the limitations of claims 7 and 14. Pet. 43–48, 52–56. Patent Owner’s arguments regarding claims 7 and 14 are unavailing for the same reasons discussed above for claim 1. *See* PO Resp. 13; Section II.D.2.

4. Claims 2, 10, and 17

Claim 2 depends from claim 1, and recites “wherein said determining the presence of said probe session indicator is determined in an application layer of said network element.” Ex. 1001, 12:26–29. Claims 10 and 17

depend from claims 7 and 14, and recite similar limitations. *Id.* at 13:3–5, 14:13–16. Mateski teaches that an application in the network node reads the header of the test packet to determine if the test code is present. Pet. 40–41; Ex. 1005, 2:66–3:5, 3:60–4:3, 6:12–19. The evidence of record indicates that a person of ordinary skill in the art would have known that Mateski’s application operates at the application layer of the network node. Pet. 41; Ex. 1003 ¶ 130. Patent Owner does not dispute that Mateski teaches the limitations of claims 2, 10, and 17. *See* PO Resp. 13.

5. *Claim 4, 12, and 19*

Claim 4 depends from claim 2, and recites “wherein said probe session indicator comprises a probe bit identifying a probe session.” Ex. 1001, 12:33–35. Claims 12 and 19 depend from claims 7 and 14, and recite similar limitations. *Id.* at 13:9–10, 14:20–22. Mateski teaches that the test code comprises a single bit that identifies the test packets that are part of a loop back test. Pet. 42; Ex. 1005, 2:63–65, 3:30–31. Patent Owner does not dispute that Mateski teaches the limitations of claims 4, 12, and 19. *See* PO Resp. 13.

6. *Claim 5*

Claim 5 depends from claim 4, and recites “wherein said probe bit comprises a bit in a message header of said loopback message.” Ex. 1001, 12:36–39. Mateski teaches that the test code comprises a single bit written to the header of the test packet. Pet. 43; Ex. 1005, 2:61–65, 3:46–51. Patent Owner does not dispute that Mateski teaches the limitation of claim 5. *See* PO Resp. 13.

7. Claims 8 and 15

Claim 8 depends from claim 7, and recites “wherein said loopback message traverses the same intermediate nodes on the uplink path and downlink path.” Ex. 1001, 12:65–67. Claim 15 depends from claim 14, and recites a similar limitation. *Id.* at 14:8–10. Mateski teaches that the uplink and downlink paths utilize the same communication link. Pet. 49; Ex. 1005, 10:35–47. Patent Owner does not dispute that Mateski teaches the limitations of claims 8 and 15. *See* PO Resp. 13.

8. Claims 9 and 16

Claim 9 depends from claim 7, and recites “wherein the first device is a network management system.” Ex. 1001, 13:1–2. Claim 16 depends from claim 14, and recites a similar limitation. *Id.* at 14:11–12. Mateski teaches transmitting the first and second timestamps to the test server (i.e., a network management system). Pet. 37, 51; Ex. 1005, 3:15–18, 9:16–26. Patent Owner does not dispute that Mateski teaches the limitations of claims 9 and 16. *See* PO Resp. 13.

9. Summary

For the foregoing reasons, Petitioner has shown by a preponderance of the evidence that claims 1, 2, 4, 5, 7–10, 12, 14–17, and 19 would have been obvious over Mateski.

E. Obviousness of Claims 6, 13, and 20 over Mateski and Abdo

Petitioner argues that claims 6, 13, and 20 would have been obvious over Mateski and Abdo. Pet. 57–65. Claim 6 depends from claim 1, and recites “wherein said loopback message comprises a modified Internet Control Message Protocol (ICMP) PING message, and wherein said loopback message has identical uplink and downlink paths.” Ex. 1001,

12:40–45. Claims 13 and 20 depend from claims 7 and 14, and recite similar limitations. *Id.* at 12:11–13, 14:23–25. Mateski teaches transmitting the test packet having the test code along uplink and downlink paths that utilize the same communication link. Pet. 49, 65; Ex. 1005, 10:35–47. Abdo teaches a modified ICMP message for enhanced ping functionality. Pet. 63–65; Ex. 1006 ¶¶ 11, 15, 26, 29.

Petitioner presents evidence that a person of ordinary skill in the art would have had reason to combine the cited teachings of Mateski and Abdo. Pet. 58–62 (citing Ex. 1003 ¶¶ 188–200). We agree with Petitioner’s rationale. Specifically, it would have been obvious to a person of ordinary skill in the art to combine the cited teachings of Mateski and Abdo so that Mateski’s test packet is implemented using Abdo’s modified ICMP PING message. Pet. 59–60; Ex. 1003 ¶¶ 191, 194. Doing so would have been obvious because implementing Mateski’s test packet using Abdo’s modified ICMP PING message “means that there is no need to send any separate loop-back test packet to perform Mateski’s loopback test, thereby reducing network traffic and processing power utilization.” Pet. 60; Ex. 1003 ¶ 194. Further, because “ICMP ping messaging was well-known,” a person of ordinary skill in the art would have had a reasonable expectation of success in implementing Mateski’s test packet using Abdo’s modified ICMP PING message. Pet. 62; Ex. 1003 ¶ 198.

Patent Owner responds that the combination of Mateski and Abdo does not teach a loopback message comprising a modified ICMP PING message. PO Resp. 14–15; PO Sur-reply 7–10. Patent Owner argues that “the Petition fails to reconcile that the ‘modified Internet Control Message Protocol (ICMP) PING message’ of claim 6 is dependent on claim 1, which

claims in element [1.4] ‘transmitting at each of said plurality of network elements said first and second timestamps to a network management system.’” PO Resp. 14. Thus, according to Patent Owner, “the ‘modified Internet Control Message Protocol (ICMP) PING message’ must comprise information to instruct the ICMP receiving/responding device to separately transmit the timestamps to a network management system.” *Id.* Patent Owner contends that Petitioner “makes no . . . showing” that Abdo teaches a message comprising that instruction.³ *Id.* at 14–15; PO Sur-reply 8–9.

Patent Owner’s argument is unavailing because it addresses Abdo individually, not the combination of Mateski and Abdo. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981) (“[O]ne cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references.”). Specifically, Mateski teaches that its test packet instructs the network nodes to transmit the timestamps to the test server. Pet. 35, 37; Ex. 1005, 9:16–23. And, as discussed above, Petitioner proposes implementing Mateski’s test packet using Abdo’s modified ICMP PING message. Pet. 59–60; Ex. 1003 ¶¶ 191, 194. Thus, in the proposed combination, Abdo’s modified ICMP PING message would similarly instruct the network nodes to transmit the timestamps to the test server. Pet. 62; Ex. 1003 ¶ 198 (“[T]he combined teachings would not adversely impact Mateski’s system, which would be understood to support ICMP messaging.”).

³ Because Petitioner presents evidence that the prior art teaches a modified ICMP PING message that instructs the network nodes to transmit the timestamps to the test server, we need not decide whether the disputed claim limitations require such an instruction.

For the foregoing reasons, Petitioner has shown by a preponderance of the evidence that claims 6, 13, and 20 would have been obvious over Mateski and Abdo.

F. Obviousness of Claims 3, 11, and 18 over Mateski and Buckley

Petitioner argues that claims 3, 11, and 18 would have been obvious over Mateski and Buckley. Pet. 65–69. Claim 3 depends from claim 2, and recites “wherein said indicator comprises an International Mobile Subscriber Identity (IMSI) identifying a probe session.” Ex. 1001, 12:30–32. Claims 11 and 18 depend from claims 7 and 14, and recite similar limitations. *Id.* at 13:6–8, 14:17–19. Mateski teaches that the test packet includes the test code and the unique tracking number. Pet. 26–27; Ex. 1005, 2:66–3:5, 7:43–46. Buckley teaches using an IMSI to identify a session. Pet. 68–69; Ex. 1008 ¶¶ 51, 58.

Petitioner presents evidence that a person of ordinary skill in the art would have had reason to combine the cited teachings of Mateski and Buckley. Pet. 66–68 (citing Ex. 1003 ¶¶ 215–224). We agree with Petitioner’s rationale. Specifically, it would have been obvious to a person of ordinary skill in the art to combine the cited teachings of Mateski and Buckley so that Mateski’s unique tracking number is implemented using Buckley’s IMSI session identifier. Pet. 66–67; Ex. 1003 ¶ 220. Doing so would have been obvious because “Mateski does not provide details regarding the type of format for the unique tracking number,” and Buckley teaches that “IMSI’s were known to be used to identify a session.” Pet. 67; Ex. 1003 ¶ 222. Further, because “IMSI’s were well-known,” a person of ordinary skill in the art would have had a reasonable expectation of success in implementing Mateski’s unique tracking number using Buckley’s IMSI

session identifier. Pet. 67–68; Ex. 1003 ¶ 223. Patent Owner does not dispute that the Mateski and Buckley combination teaches the limitations of claims 3, 11, and 18, or that it would have been obvious to combine the cited teachings of Mateski and Buckley.

For the foregoing reasons, Petitioner has shown by a preponderance of the evidence that claims 3, 11, and 18 would have been obvious over Mateski and Buckley.

III. CONCLUSION⁴

Petitioner has shown by a preponderance of the evidence that claims 1–20 of the ’733 patent are unpatentable.

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1, 2, 4, 5, 7–10, 12, 14–17, 19	103(a)	Mateski	1, 2, 4, 5, 7– 10, 12, 14–17, 19	
6, 13, 20	103(a)	Mateski, Abdo	6, 13, 20	
3, 11, 18	103(a)	Mateski, Buckley	3, 11, 18	
Overall Outcome			1–20	

⁴ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

IV. ORDER

It is hereby

ORDERED that claims 1–20 of the '733 patent are shown unpatentable; 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.

IPR2021-00960
Patent 8,665,733 B2

PETITIONER:

Theodore M. Foster
David L. McCombs
Gregory P. Huh
Eugene Goryunov
Jolene Robin-McCaskill
HAYNES AND BOONE, LLP
ipr.theo.foster@haynesboone.com
david.mccombs.ipr@haynesboone.com
gregory.huh.ipr@haynesboone.com
eugene.goryunov.ipr@haynesboone.com
jolene.robinmccaskill.ipr@haynesboone.com

PATENT OWNER:

Sean Burdick
BURDICK PATENTS
sean@burdickpatents.com

Ryan Loveless
ETHERIDGE LAW GROUP
IPTeam@etheridgelaw.com
ryan@etheridgelaw.com