

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS, LLC,
Petitioner,

v.

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

IPR2021-01191
Patent 7,333,770 B2

Before BRIAN J. McNAMARA, ROBERT J. WEINSCHENK, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

Petitioner, Unified Patents, LLC (“Petitioner”), filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 2, 4–6, and 16–18 (“the challenged claims”) of U.S. Patent No. 7,333,770 B2 (Ex. 1001, “the ’770 patent”). Petitioner filed a Declaration of Jon B. Weissman, Ph.D. (Ex. 1002) with its Petition. Patent Owner, WSOU Investments, LLC d/b/a Brazos Licensing and Development (“Patent Owner”), filed a Preliminary

Response (Paper 7, “Prelim. Resp.”). With our authorization (Paper 8), Petitioner filed a Reply (Paper 9, “Pet. Reply”) and Patent Owner filed a Sur-reply (Paper 10, “PO Sur-reply”) directed to the issue of discretionary denial under 35 U.S.C. § 314(a).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we institute an *inter partes* review as to claims 1, 2, 4–6, and 16–18 of the ’770 patent on all grounds of unpatentability presented.

I. BACKGROUND

A. *Real Parties-in-Interest*

Petitioner identifies Unified Patents, LLC, as the real party-in-interest. Pet. 60. Patent Owner identifies WSOU Investments, LLC d/b/a Brazos Licensing and Development as the real party-in-interest. Paper 3, 1.

B. *Related Proceeding*

The parties identify the following proceeding related to the ’770 patent (Pet. 60; Paper 3, 2):

WSOU Invs., LLC v. TP-Link Tech. Co., No. 6:20-cv-01019 (W.D. Tex. filed Oct. 31, 2021) (“the TP-Link litigation”).

C. The '770 patent

The '770 patent is directed to a device for optimum broadcasting of information in a telecommunication system. Ex. 1001, 1:7–8. According to the '770 patent, techniques for sending information over a telecommunication network at the time of the invention conformed to, *inter alia*, the “pull” technique. *Id.* at 1:17–19. With the “pull” technique, a content provider makes information that it wishes to transmit available in a database and customers access the information after finding out the address of the database. *Id.* at 1:19–22. But this technique is not suitable for broadcasting, so the '770 patent aims to solve the problem of providing a device for broadcasting information that enables advertisers to direct information to the most receptive population segment. *Id.* at 2:3–6.

Figure 1 of the '770 patent is reproduced below.

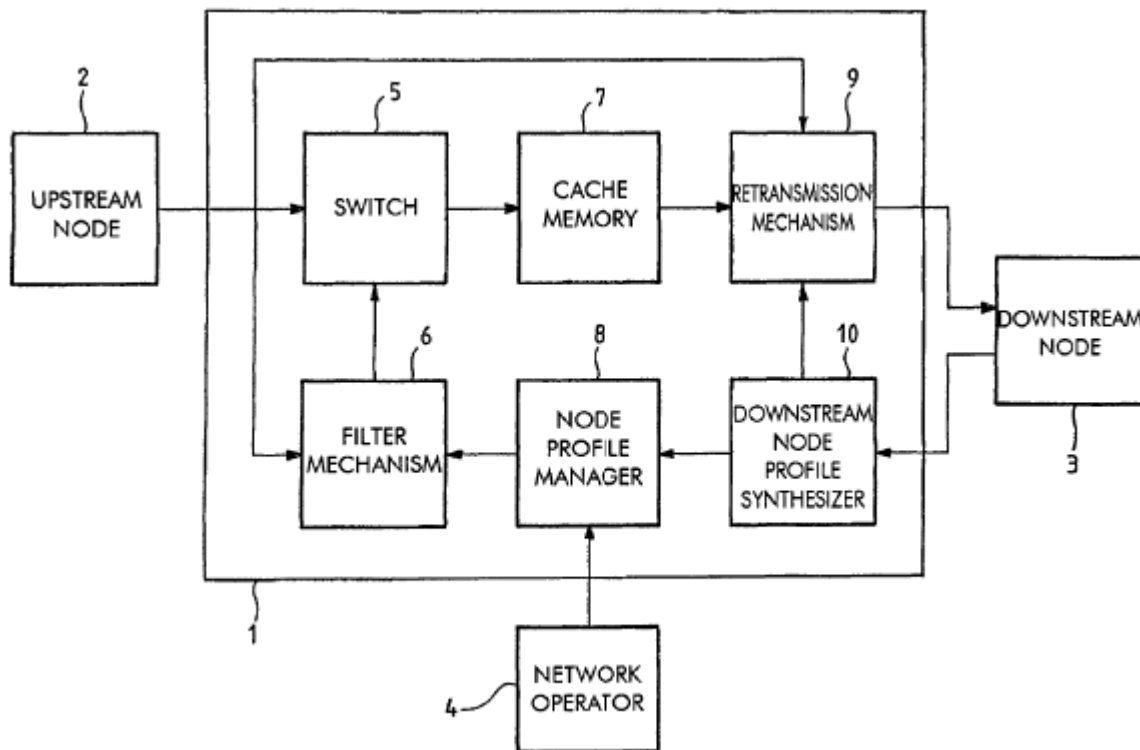


Figure 1 depicts “the installation of a device according to the invention in an access network node which can be an input node, an output node, or an intermediate node of an access network.” *Id.* at 3:9–12. Node 1 of the network is connected to another network node 2 on its upstream side and to one or more further network nodes 3 on its downstream side. *Id.* at 3:20–24. Node 1 receives as input streams of information coming from upstream node 2. *Id.* at 3:27–28. Mechanism 10 synthesizes profiles of the downstream nodes and supplies its results to node profile management circuit 8 for managing the node profiles. *Id.* at 3:39–42. Node 1 includes filter mechanism 6, which receives as input a node profile established by node profile management circuit 8 and broadcasting criteria and routing constraints associated with the information items in the streams of information. *Id.* at 3:42–47. Filter mechanism 6 controls switch 5 for storing information items in cache memory 7. *Id.* at 3:48–49. Retransmission mechanism 9 retransmits stored information items to downstream node 3. *Id.* at 3:49–51.

The ’770 patent issued from a PCT application filed on January 3, 2002, and claims priority to a French patent application filed on January 4, 2001. Ex. 1001, codes (22), (30). As discussed below, Petitioner applies the January 3, 2002, PCT application filing date for qualifying the asserted references as prior art. *See* Pet. 2–3, 11, 13–14.

D. Illustrative Claim

Of the challenged claims of the ’770 patent, claims 1 and 16 are independent. Claims 2 and 4–6 depend from claim 1, and claims 17 and 18

depend from claim 16. Claim 1 is illustrative of the challenged claims and recites:

1. A device for broadcasting information in an access network comprising a plurality of interconnected nodes configured for conveying streams of information items between information content providers and receiver terminals, characterized in that said device is installed in one or more network nodes and comprises a node profile management circuit configured by an operator of the network or an operator of the node as a function of objective or subjective criteria and a mechanism configured for filtering broadcast information items that controls a switch to filter said information items.

Ex. 1001, 6:30–40.

E. Prior Art

Petitioner relies on the following prior art:

U.S. Patent No. 6,047,327, filed Feb. 16, 1996, issued Apr. 4, 2000 (Ex. 1005, “Tso”);

Patent Cooperation Treaty (PCT) Patent Application Publication No. WO 97/41654, published Nov. 6, 1997 (Ex. 1006, “Ericsson”); and

U.S. Patent No. 5,896,379, filed Aug. 26, 1996, issued Apr. 20, 1999 (Ex. 1007, “Haber”).

F. The Asserted Grounds

Petitioner challenges claims 1, 2, 4–6, and 16–18 of the ’770 patent on the following grounds (Pet. 15):

Claims Challenged	35 U.S.C. §	References
1, 2, 4–6, 16–18	103(a) ¹	Tso, Haber

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102, 103, and 112.

Claims Challenged	35 U.S.C. §	References
1, 2, 4–6, 16–18	103(a)	Tso, Ericsson, Haber

II. ANALYSIS

We now consider Petitioner’s asserted grounds and Patent Owner’s arguments in the Preliminary Response to determine whether Petitioner has met the “reasonable likelihood” standard for institution under 35 U.S.C. § 314(a).

A. *Legal Standards*

A claim is unpatentable 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. *See 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) where in evidence, so-called secondary considerations.² *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). We also recognize that prior art references must be “considered together with the knowledge of one of ordinary skill in the pertinent art.” *In re*

Because the ’770 patent was filed before March 16, 2013 (the effective date of the relevant amendments), the pre-AIA versions of §§ 102, 103, and 112 apply.

² The present record does not include any evidence of secondary considerations of nonobviousness.

Paulsen, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (citing *In re Samour*, 571 F.2d 559, 562 (CCPA 1978)).

B. Level of Ordinary Skill in the Art

Citing testimony from Dr. Weissman, Petitioner contends a person of ordinary skill in the art “would have had a bachelor’s degree in electrical engineering, computer engineering, computer science, or a similar field and approximately two years of experience in telecommunications, computer networking, or computer programming for network-based applications.” Pet. 4–5 (citing Ex. 1002 ¶¶ 26–28). Patent Owner does not dispute Petitioner’s definition of the level of ordinary skill at this time. *See* Prelim. Resp. 9.

For purposes of this Decision, we adopt Petitioner’s definition of the level of ordinary skill in the art. On the present record, we are satisfied that this definition comports with the level of skill necessary to understand and implement the teachings of the ’770 patent and the asserted prior art.

C. Claim Interpretation

In an *inter partes* review, we construe each claim “in accordance with the ordinary and customary meaning of such 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). Accordingly, our claim construction standard is the same as that of a district court. *See id.* Under the standard applied by district courts, claim terms are generally given their plain and ordinary meaning as would have been understood by a person of ordinary skill in the art at the time of the invention and in the context of the entire patent

disclosure. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc). “There are only two exceptions to this general rule: 1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012).

Construing a claim term under 35 U.S.C. § 112 ¶ 6 involves two steps: identifying the claimed function and then determining what structure, if any, disclosed in the specification corresponds to the claimed function.

Williamson v. Citrix Online, LLC, 792 F.3d 1339, 1351 (Fed. Cir. 2015). To determine whether § 112 ¶ 6 applies to a claim limitation, the essential inquiry is “whether the words of the claim are understood by persons of ordinary skill in the art to have a sufficiently definite meaning as the name for structure.” *Id.* at 1348. If the limitation uses the word “means,” “there is a rebuttable presumption that § 112, para. 6 applies; if not, there is a rebuttable presumption that the provision does not apply.” *Diebold Nixdorf, Inc. v. Int’l Trade Comm’n*, 899 F.3d 1291, 1298 (Fed. Cir. 2018).

1. Whether the Preamble of Claim 1 is Limiting

Neither party takes a position as to whether the preamble of claim 1³ is limiting, but Petitioner does provide contentions related to the entirety of

³ Petitioner appears to contend that the preamble of claim 1 is “[a] device for broadcasting information in an access network.” Pet. 16 (quoting Ex. 1001, 6:30–31). Although we need not decide whether this is correct for purposes of this Decision, we note that the preamble might also include the further language “comprising a plurality of interconnected nodes configured for conveying streams of information items between information content providers and receiver terminals.” Ex. 1001, 6:31–34. At trial, the parties

claim 1. *See* Pet. 16–44. “[A] preamble may be limiting if: it recites essential structure or steps; claims depend on a particular disputed preamble phrase for antecedent basis; [or] the preamble is essential to understand limitations or terms in the claim body.” *Georgetown Rail Equip. Co. v. Holland L.P.*, 867 F.3d 1229, 1236 (Fed. Cir. 2017). For claim 1, the initial recitation in the preamble is “[a] device for broadcasting information.” Ex. 1001, 6:30. The body of the claim recites that “said device” is “installed in one or more network nodes” and comprises “a node profile management circuit” and “a mechanism configured for filtering broadcast information items.” *Id.* at 6:34–40. As such, we find that the recited “device for broadcasting information” in the preamble provides antecedent basis for limitations in the body of the claim about where the device is disposed and what it comprises. *Id.* The recited “device” in the preamble also is essential to understand these limitations in the body of the claim. Thus, for purposes of this Decision, we find that the preamble of claim 1—and by extension the entirety of claim 1—is limiting.

2. “Access Network”

At this stage, neither party disputes that “an access network” in the context of the challenged claims relates to a cellular network, e.g., a GSM network. *See* Pet. 16–17; Prelim. Resp. 11. Yet both parties present claim construction arguments about how various elements should be arranged in the recitations “[a] device for broadcasting information in an access network comprising a plurality of interconnected nodes . . . characterized in that said

should address the scope of the preamble if they believe it is relevant to the disposition of this case.

device is installed in one or more network nodes.” Ex. 1001, 6:30–35.

Petitioner contends claim 1 “does not require the *device for broadcasting to be in an access network* as opposed to *broadcasting information in an access network*.” Pet. 17. Patent Owner argues that ““said device is installed in one or more network nodes’ refers back to the ‘access network comprising a plurality of interconnected nodes,’ and plainly requires that the device be installed in one or more of those network nodes.” Prelim. Resp. 15. We now consider what it means to be “in an access network” in the context of the ’770 patent.

As noted by Petitioner, the language of claim 1 suggests two different readings of how the recited “device” relates to the “access network”:

(1) that the device must be disposed in an access network node; or (2) that the device can be disposed in a network node that merely broadcasts into the access network. Claim 1 states that the “access network compris[es] a plurality of interconnected nodes,” and the recited device is “installed in one or more network nodes.” Ex. 1001, 6:30–35. The Specification of the ’770 patent states the following about access networks:

An access network comprises a plurality of branches each consisting of a plurality of interconnected nodes. Thus the device can be installed in a plurality of branches of the access network and in a plurality of interconnected nodes of a branch of the access network. It is therefore considered that a device according to the invention is installed at one or more access network nodes.

Id. at 3:13–19. Thus, the Specification supports a somewhat broader notion of an access network where *branches* of the network are part of the “access network.” We further note that the lone drawing figure of the ’770 patent focuses only on one node rather than the overall topology of the network in

question. *See id.* at Fig. 1. And the description of that drawing figure mentions installation of the claimed “device” in an input node of the access network: “FIG. 1 shows the installation of a device according to the invention in an access network node which can be *an input node*, an output node, or an intermediate node of an access network.” *Id.* at 3:9–12 (emphasis added). Thus, for purposes of this Decision, we construe “access network comprising a plurality of interconnected nodes” as including all nodes connected to an access network, including input and output nodes.

We additionally consider the relationship between the recited “device” of claim 1 and the “access network” insofar as it is “installed in one or more network nodes.” In light of our construction of “access network” directly above, we determine for purposes of this Decision that the device of claim 1 may be disposed in an input node of the access network.

During the course of trial, we expect the parties to further develop the record with respect to these preliminary claim constructions.

3. *Whether the Recited “Mechanisms” of Claims 1 and 16 Should Be Construed Under 35 U.S.C. § 112 ¶ 6*

Claim 1 recites “a mechanism configured for filtering broadcast information items that controls a switch to filter said information items” and claim 16 recites “a filter mechanism configured to receive said managed profile information from said circuit and broadcasting information and routing information associated with said input information streams.”

Ex. 1001, 6:38–40, 8:15–19. Petitioner puts forth obviousness contentions for these limitations both under their plain and ordinary meaning and under 35 U.S.C. § 112 ¶ 6. *See* Pet. 31–35, 51–53 (incorporating analysis from claim 1). Neither party takes a position as to whether § 112 ¶ 6 should

apply, however. We note that these limitations do not include the word “means,” so we apply the rebuttable presumption that § 112 ¶ 6 does not apply. *Diebold*, 899 F.3d at 1298. Thus, for purposes of this Decision, we apply the plain and ordinary meaning to these limitations.

4. *Other Limitations*

We determine that no other aspects of the challenged claims require explicit construction. *See, e.g., Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. *Patent Owner’s Arguments Regarding Discretionary Denial*

Patent Owner contends we should exercise our discretion to deny institution under 35 U.S.C. § 314(a) “because institution would be an inefficient duplication of pending litigation.” Prelim. Resp. 3–9; *see also* PO Sur-reply 1–3. Petitioner disagrees. Pet. Reply 1–5.

Institution of *inter partes* review is discretionary. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he [Office] is permitted, but never compelled, to institute an [*inter partes* review] proceeding.”).

In *Fintiv*, the Board discussed potential applications of *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”), as well as a number of other cases dealing with discretionary denial under § 314(a). *Fintiv* identifies a non-exclusive list of factors parties may consider addressing, particularly where there is a related, parallel district court action and whether such action provides any basis for discretionary denial. *Fintiv*, Paper 11 at 5–16. Those factors include:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Id. at 5–6.

We now consider these factors to determine whether we should use our discretion to deny institution under 35 U.S.C. § 314(a). In evaluating the factors, we take a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review. *Fintiv*, Paper 11 at 6.

1. Stay in the Underlying Litigation

Under the first *Fintiv* factor, we consider “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Id.* at 6. Patent Owner notes that the defendant in the TP-Link litigation has not moved for a stay. PO Sur-reply 1. Patent Owner also argues that the presiding judge in the TP-Link litigation “generally does not stay trial for a pending IPR, even if instituted.” Prelim. Resp. 5–6 (citing another case by the presiding judge); PO Sur-reply 1. As such, Patent Owner argues that this factor favors denial. *Id.*

Petitioner argues that Patent Owner “presents no argument or evidence regarding whether or not *the specific parallel litigation* will be stayed” and that Patent Owner is merely assuming that a stay would not be sought and granted. Pet. Reply 1. Thus, Petitioner contends this factor is neutral based on “the absence of evidence for or against a stay being granted.” *Id.*

We agree with Petitioner and determine that the first *Fintiv* factor is neutral. We decline to infer how the district court would rule on any potential motion to stay in the TP-Link litigation based on decisions in other cases. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative).

2. The Trial Date in the Underlying Litigation

Under the second *Fintiv* factor, we consider the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.” *Fintiv*, Paper 11 at 6. Patent Owner contends that the parties in the TP-Link litigation have jointly proposed a trial date of

October 31, 2022, and have been adhering to the proposed schedule. Prelim. Resp. 6 (citing Ex. 2001, 5 for the “group 1” trial date).

Petitioner contends that it is probable that the trial in the TP-Link litigation will occur after a Final Written Decision is issued here. Pet. Reply 1–2. Petitioner argues that Patent Owner has not provided any evidence linking the challenged patent in this case to the “group 1” trial date listed in the scheduling order and that the trial dates listed for certain other “groups” occur after the anticipated date of a Final Written Decision in this case. *Id.* at 2 (citing Ex. 2001, 5). Petitioner further argues that the court and the parties in the TP-Link litigation have not been adhering to the scheduling order. *Id.* at 2–3 (citing, *inter alia*, Ex. 1019). Thus, Petitioner argues that this factor “favors institution or, at the very least, is neutral.” *Id.* at 1.

In its Sur-reply, Patent Owner seemingly modifies its position. Specifically, Patent Owner states that

by the time of an institution decision in this case, the district court will have held a *Markman* hearing and ordered a trial date for this case that will *likely* predate an anticipated final written decision date were trial to be instituted in this IPR, as proposed by the parties in the agreed scheduling order.

PO Sur-reply 1 (emphasis added).

The proposed schedule from the TP-Link litigation cited by Patent Owner lists four different trial dates for four different “groups,” which apparently refers to groups of patents among the 11 different cases listed in the caption of the scheduling order. Ex. 2001, 1, 5. Patent Owner bases its analysis on the earliest of these four trial dates (i.e., “group 1”), but does not present any evidence showing that the challenged patent from the instant case is in “group 1.” Thus, even if we were to assume that the scheduling

order will be adopted by the court, we have no record evidence of which “group” will include the challenged patent, so the trial might occur before or after an anticipated Final Written Decision. *See* Ex. 2001, 5 (listing one date before, one date contemporaneous with, and two dates after the anticipated date of a Final Written Decision in this case). Patent Owner’s argument from the Sur-reply reflects this uncertainty insofar as Patent Owner states that it is merely “likely” that the trial could occur first. PO Sur-reply 1. Petitioner also puts forth some evidence showing that the court and the parties have not been adhering to the proposed schedule. *See* Pet. Reply 2–3 (noting that the parties have not filed a Joint Claim Construction Statement and the court has not held a claim construction hearing in accordance with the proposed schedule). Given the lack of a firm trial date for the TP-Link litigation, we find that this factor does not weigh for or against denying institution in this case.

3. *Investment by the Court and the Parties in the Underlying Litigation*

Under the third *Fintiv* factor, we consider the “investment in the parallel proceeding by the court and the parties.” *Fintiv*, Paper 11 at 6. Patent Owner argues that, by the time of the institution decision, the parties will have completed claim construction briefing and the court will have held a claim construction hearing and issued a claim construction order. Prelim. Resp. 6–7 (citing Ex. 2001, 3); PO Sur-reply 2. Thus, Patent Owner contends this factor weighs in favor of discretionary denial.

Petitioner argues that the claim construction hearing has been delayed. Pet. Reply 2–3. Petitioner also argues that none of the claim construction effort mentioned by Patent Owner relates to the validity. Pet. Reply 3–4.

Thus, Petitioner contends “this factor favors institution, or at the very least, is neutral.” *Id.* at 4.

We determine that this factor weighs against discretionary denial of institution. Although the parties have briefed claim construction issues, the claim construction hearing has been postponed and the record does not indicate when it will go forward. *See* Ex. 1019. Furthermore, the record does not indicate that this relatively meager investment by the parties is tethered to the merits of the parties’ validity positions in the TP-Link litigation and, by extension, their patentability positions here. *See Sand Revolution II, LLC v. Continental Intermodal Group–Trucking LLC*, IPR2019-01393, Paper 24 at 10–11 (June 16, 2020) (informative).

4. *Overlap of the Issues*

Under the fourth *Fintiv* factor, we consider the “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv*, Paper 11 at 6. Patent Owner argues that the defendant in the TP-Link litigation is asserting the same references that Petitioner is asserting here, i.e., Tso, Ericsson, and Haber.⁴ Prelim. Resp. 7 (citing Ex. 2002, 21); PO Sur-reply 2. Patent Owner also notes that the defendant in the TP-Link litigation has not stipulated to stop asserting these references if we were to institute an *inter partes* review in this case. Prelim. Resp. 7–8; PO Sur-reply 2.

Petitioner argues that Patent Owner has not shown that the defendant in the TP-Link litigation “is relying on the references at issue in this

⁴ Patent Owner mistakenly states that that Petitioner is asserting these references in the TP-Link litigation. Prelim. Resp. 7. As discussed below, Petitioner is not a party to the TP-Link litigation. *See infra* § II.D.5.

proceeding in the same way that [they are] presented in this proceeding.” Pet. Reply 4. Petitioner also notes the allegation of the defendant in the TP-Link litigation that Patent Owner has not properly asserted claims 10, 12, and 15 in the TP-Link litigation. *Id.* (citing Ex. 2002, 12). Petitioner also references Patent Owner’s acknowledgement that Patent Owner is not asserting claim 6 in the TP-Link litigation. *Id.* (citing Prelim. Resp. 8). As such, Petitioner argues that four asserted claims here are not asserted in the TP-Link litigation. Therefore, Petitioner contends this factor “favor[s] institution.” *Id.*

Patent Owner has established that the same references asserted here are also at issue in the TP-Link litigation. *See* Ex. 2002, 21. Nevertheless, this is tempered by the fact that at least one—and perhaps as many as four—of the eight challenged claims here will not be before the district court in the TP-Link litigation. *See* Prelim. Resp. 8; Ex. 2002, 12. Moreover, it is unclear from the preliminary invalidity contentions in the record whether the defendant in the TP-Link litigation will be making the same obviousness challenges and/or arguments that Petitioner is making here. *See* Ex. 2002, 21 (merely listing Tso, Ericsson, and Haber). Accordingly, we find on the present record that this factor weighs only slightly in favor of exercising our discretion to deny institution.

5. *Whether Petitioner is Unrelated to the Defendant in the Underlying Litigation*

Under the fifth *Fintiv* factor, we consider “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11 at 6. Patent Owner acknowledges that Petitioner is different from the defendant in the TP-Link litigation. Prelim. Resp. 8. Notwithstanding,

Patent Owner argues that Petitioner “appear[s] to have a significant relationship” with the defendant. Prelim. Resp. 8. We give no weight to Patent Owner’s speculation, however, because it is contradicted by the uncontested testimony of Petitioner’s CEO that no such relationship exists. *See* Pet. Reply 5 (citing Ex. 1024 ¶ 2). We likewise give no weight to Patent Owner’s additional speculation that Petitioner might have filed the Petition “on behalf of any entity other than [the defendant]” or “to demonstrate to [the defendant] the benefits of membership,” which is not based on any record evidence. PO Sur-reply 3. We determine that the fifth *Fintiv* factor weighs against exercising our discretion to deny institution because Petitioner is different from the defendant in the TP-Link litigation.

6. *Other Considerations*

Under the sixth *Fintiv* factor, we consider “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv*, Paper 11 at 6. Petitioner argues about potential jurisdictional flaws in the TP-Link litigation related to contested service of process. Pet. Reply 5. Patent Owner contends these arguments are too speculative. PO Sur-reply 3. We agree with Patent Owner and do not consider Petitioner’s arguments as part of this factor.

Petitioner also argues that the merits of its challenges are strong, whereas Patent Owner argues that the Petition is deficient. Pet. Reply 5; Prelim. Resp. 9. Based on the merits of Petitioner’s challenges, we determine that the sixth *Fintiv* factor weighs against discretionary denial of institution. As discussed below, on this record and at this stage of the proceeding, Petitioner presents a strong case that claims 1, 2, 4–6, and 16–18

are unpatentable. *See Fintiv*, Paper 11 at 14–15 (“[I]f the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution.”). In particular, Tso teaches InfoCast servers that receive InfoCasts from content providers and then send out “InfoBites” to client terminals, which may be disposed in a cellular network, based on user profile information. *See infra* § II.E.3. Patent Owner’s arguments do not undermine Petitioner’s persuasive showing for claims 1, 2, 4–6, and 16–18.

7. *Conclusion*

The only *Fintiv* factor favoring discretionary denial relates to overlap of the issues, and we give it only slight weight. This showing is outweighed by the minimal investment by the court and parties in the TP-Link litigation and the lack of a firm trial date, which weigh against discretionary denial. Thus, based on our holistic view of the *Fintiv* factors, we decline to exercise our discretion under § 314(a) to deny the Petition.

E. *Obviousness Ground Based on Tso and Haber*

Petitioner contends the subject matter of claims 1, 2, 4–6, and 16–18 would have been obvious over the combination of Tso and Haber. Pet. 15–59. Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 11–17.

1. *Tso*

Tso is a U.S. patent directed to the automatic distribution of information to different users based on a set of selected criteria. Ex. 1005,

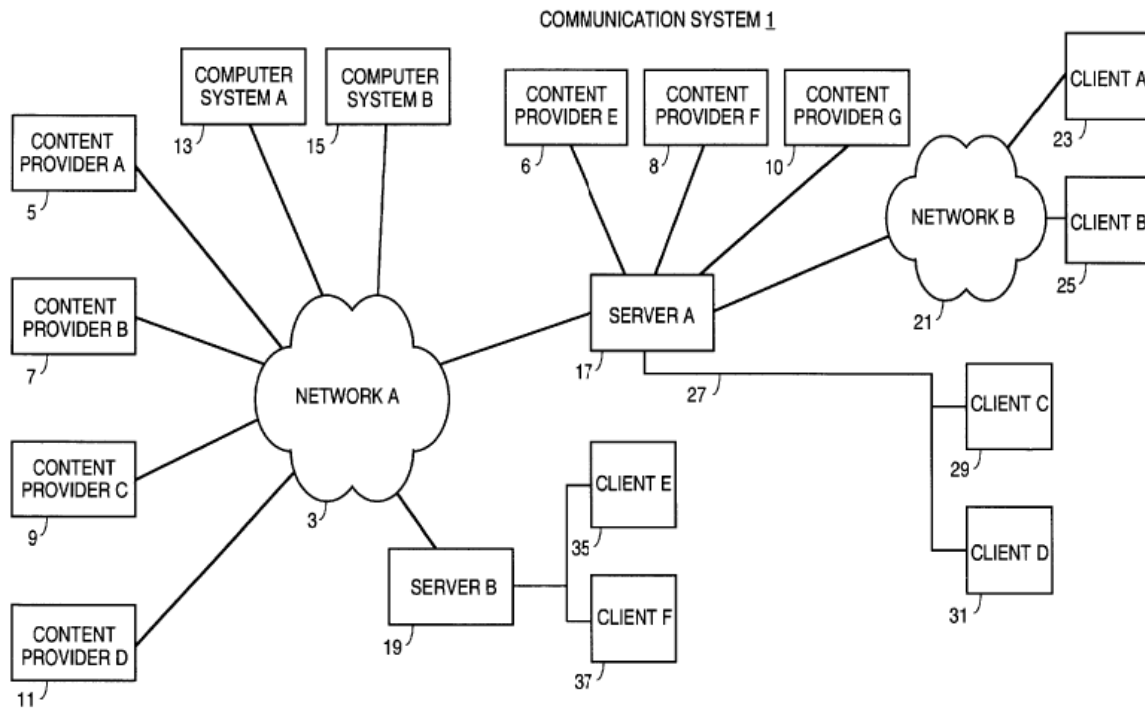


FIG. 1

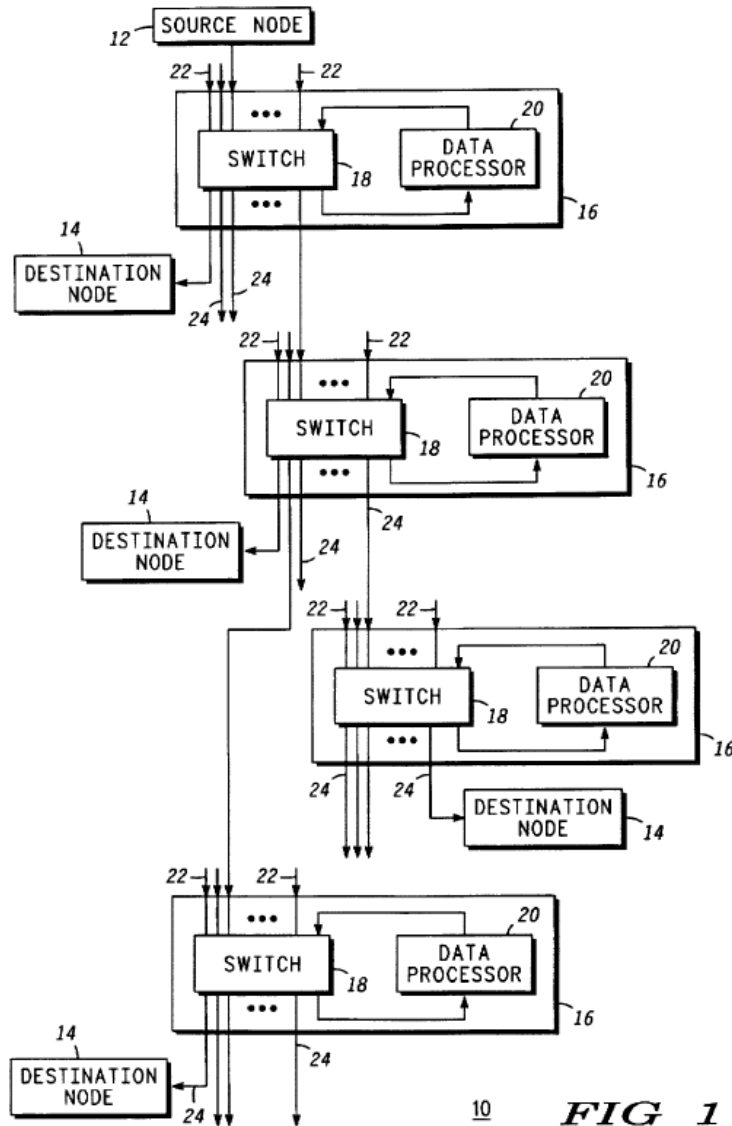
Figure 1 depicts communication system 1 for automatically distributing electronic information to a targeted group of users. *Id.* at 2:40–42, 2:54–55. Communication system 1 includes network A 3, which is a wide area network such as the Internet, and network B 21, which is a cellular communication system. *Id.* at 2:55–58, 2:64–66. Network A 3 is connected to content providers A 5, B 7, C 9, and D 11; computer systems A 13 and B 15; and servers A 17 and B 19. *Id.* at 2:58–63. Server B 19 is connected to clients E 35 and F 37 through local area network 33. *Id.* at 3:5–7. Server A 17 is connected to network B 21 and content providers E 6, F 8, and G 10. *Id.* at 2:66–3:2. Server A 17 is further connected to clients A 23 and B 25 through network B 21; and to clients C 29 and D 31 through local area network 27. *Id.* at 3:2–5.

Servers A 17 and B 19 are known as InfoCast servers. *Id.* at 2:64, 3:5–6. Content providers send information, known as “InfoCasts,” to the InfoCast servers. *Id.* at 7:17–19. An InfoCast can consist of either a data file containing one or more separate articles or a video/audio feed. *Id.* at 7:19–21. For each item in an InfoCast, an InfoFeed interface (not shown) within the InfoCast servers creates an “InfoBite,” which can be sent to a user in lieu of the full item. *Id.* at 7:30–32. Each InfoBite includes, *inter alia*, summary information for the associated item in the InfoCast and data necessary for a user to obtain the associated item. *Id.* at 7:32–39. A schedule/resource controller (not shown) within the InfoCast servers filters the InfoBites that are sent to a user based on the user’s profile. *Id.* at 10:41–46.

Petitioner contends Tso qualifies as prior art under, *inter alia*, 35 U.S.C. § 102(b) based on its issue date. Pet. 11. Patent Owner does not contest the prior art status of Tso. For purposes of this Decision, we determine that Tso qualifies as prior art under 35 U.S.C. § 102(b) because Tso’s issue date of February 16, 1996, is more than one year before the PCT filing date of application that led to the challenged claims, which is January 3, 2002. Ex. 1001, code (22); Ex. 1005, code (45).

2. *Haber*

Haber is a U.S. patent directed to network packet switching nodes that selectively perform data processing functions on data conveyed in packets. Ex. 1007, 1:7–10. Figure 1 of Haber is reproduced below.



10 **FIG 1**

Figure 1 is a layout diagram of packet switching communication network 10. *Id.* at 2:45–46. Network 10 includes any number of user nodes, such as source nodes 12 and destination nodes 14, and any number of intermediate switching nodes 16. *Id.* at 2:46–49. Each Switching node 16 includes switch 18 and data processor 20. *Id.* at 2:66–3:1. Switches 18 perform a switching or routing function for network 10. *Id.* at 3:14–15. Data processor 20 performs a non-switching network processing function, such as a broadcast data network processing function, which applies to user data

conveyed by packets. *Id.* at 3:21–23, 3:34–35. Haber also discloses a “broadcast data processor process” for routing selected data packets to defined groups by manipulating switches 18, among other things. *See id.* at 6:58–7:53, Fig. 6.

Petitioner contends Haber qualifies as prior art under, *inter alia*, 35 U.S.C. § 102(b) based on its issue date. Pet. 14. Patent Owner does not contest the prior art status of Haber. For purposes of this Decision, we determine that Haber qualifies as prior art under 35 U.S.C. § 102(b) because Haber’s issue date of April 20, 1999, is more than one year before the PCT filing date of the application that led to the challenged claims, which is January 3, 2002. Ex. 1001, code (22); Ex. 1007, code (45).

3. *Claim 1*

Claim 1 recites “[a] device for broadcasting information in an access network comprising a plurality of interconnected nodes configured for conveying streams of information items between information content providers and receiver terminals.” Ex. 1001, 6:30–34. Regarding the recited “device for broadcasting information,” Petitioner cites Tso’s InfoCast servers (e.g., server A 17) and contends that they receive an “InfoCast broadcast” from a content provider and then send out “InfoBites,” which are based on the InfoCasts, to client terminals via short message service (SMS). Pet. 16 (citing Ex. 1005, Abstr., 2:23–24, 7:30–32, 7:41–44, 12:26–28). For the “access network,” Petitioner cites Tso’s teaching of broadcasting data using SMS in a GSM access network (e.g., network B 21) via a base station.

Id. at 17 (citing Ex. 1005, 3:65–4:3, 11:23–26, 12:26–28, Fig. 2).⁵ For the recited “plurality of interconnected nodes configured for conveying streams of information items between information content providers and receiver terminals,” Petitioner cites content provider nodes A–G, InfoCast servers A and B, and clients A–F in Tso’s Figure 1. Pet. 19 (citing Ex. 1002 ¶ 98; Ex. 1005, 2:1–3, 2:54–3:7, Fig. 1). Petitioner contends that these nodes carry InfoCasts from content providers to InfoCast servers then on to clients as InfoBites. *Id.* at 20–21 (citing Ex. 1005, 7:17–21, 7:30–32, 7:41–44, 10:53–61, Fig. 5).

Patent Owner argues that “Petitioner’s identification of the alleged nodes does not correspond to what Petitioner identified as the access network.” Prelim. Resp. 11. In particular, Patent Owner argues that Petitioner has failed to show how the interconnected nodes cited by Petitioner, i.e., Tso’s content provider nodes A–G, InfoCast servers A and B, and clients A–F, form an access network, which Petitioner maps to Tso’s network B 21. *Id.* at 11–12.

⁵ Although our preliminary claim construction does not require it (*see supra* § II.C.2), Petitioner puts forth an alternative position to the extent claim 1 requires the recited “device for broadcasting information” to be disposed in the “access network.” Specifically, Petitioner contends that it would have been obvious to place the InfoCast server in a GSM network because the InfoCast server’s functionality (i.e., serving InfoBites to clients connected to the cellular network) would not have materially changed if placed within the cellular access network itself. Pet. 17 (citing Ex. 1002 ¶¶ 95–96). Patent Owner argues that this theory has not been carried forward consistently in Petitioner’s analysis of later limitations in claim 1. *See* Prelim. Resp. 15. We need not consider these arguments based on our preliminary claim construction, but we note that they might be relevant (and potentially dispositive) if we ultimately decide to construe the “access network” of claim 1 differently.

We do not agree with Patent Owner’s arguments. Petitioner cites the written description for Tso’s Figure 1, which states that “[s]erver A 17, which is termed an InfoCast server, is connected to a network B 21, which, in the preferred embodiment, is a cellular communication system.” Pet. 19; Ex. 1005, 2:64–66. As discussed above (*see supra* § II.C.2), we determine that an input node of an access network is part of the “plurality of interconnected nodes” that make up the access network. Thus, we find that Petitioner’s cited teachings from Tso teach the access network limitation because the InfoCast server (server A 17) is an input node to the cellular communication system (network B 21). In addition, Petitioner establishes that Tso’s InfoCast server broadcasts information using SMS in a GSM access network via a base station. Pet. 16–17 (citing, *inter alia*, Ex. 1005, 3:65–4:3, 12:26–28). Petitioner also cites Tso’s teaching that its disclosed system “supports the transfer of information over the nodes of many types of communication networks such as cellular data networks.” Pet. 19 (quoting Ex. 1005, 2:1–3). All of this supports Petitioner’s contention that Tso’s InfoCast server A 17 is a connected node of access network B 21. Petitioner’s showing is sufficient for institution.

In addition, we are persuaded that Tso’s InfoCast server A 17 is a “device for broadcasting information in an access network” because it broadcasts InfoBites via SMS. *See, e.g.*, Ex. 1005, 3:65–4:3, 12:26–28. We additionally are persuaded that the nodes in Tso’s Figure 1 are configured to convey InfoCasts from content providers A–G through InfoCast servers A 17 and B 19 and onto clients A–F as InfoBites. *See, e.g.*, Ex. 1005, 7:17–21, 7:30–32, 7:41–44, 10:53–61, Fig. 5. Thus, based on the present record, we are persuaded that Tso teaches “[a] device for broadcasting information

in an access network comprising a plurality of interconnected nodes configured for conveying streams of information items between information content providers and receiver terminals.”

Claim 1 further recites that the “device is installed in one or more network nodes.” Ex. 1001, 6:34–35. For this limitation, Petitioner contends Tso’s “InfoCast servers—such as servers A and B—are located in network nodes defining connection points between various networks (*e.g.*, server A is in a node between network A and network B, and between content providers E-G and clients A-D).” Pet. 21 (citing Ex. 1002 ¶ 105; Ex. 1005, Fig. 1). Petitioner further contends that an ordinarily skilled artisan “would have understood that Tso’s InfoCast functionality was implemented in computer code for execution on hardware at the network node.” *Id.* at 22 (citing Ex. 1002 ¶ 106).

Patent Owner argues that Petitioner fails to allege that Tso’s InfoCast servers are “‘installed in one or more network nodes’ that form the earlier-recited access network, which the Petition identifies only as Tso’s network B.” Prelim. Resp. 14–15. We disagree. Based on our construction of “access network” above (*see supra* § II.C.2), and for reasons similar to those discussed above, Tso’s InfoCast server A 17 is an input node of—and thus a part of—access network B 21. *See* Ex. 1005, Fig. 1. On the present record, Petitioner’s mapping of the recited “device” to InfoCast server A 17 within the topology of Tso’s Figure 1 is sufficient to teach that the device is “installed in one or more network nodes.”

Claim 1 further recites that the device comprises “a node profile management circuit configured by an operator of the network or an operator of the node as a function of objective or subjective criteria.” Ex. 1001,

6:34–38. For this limitation, Petitioner cites Tso’s subscriber database (supported by associated hardware) and schedule/resource controller 61 within InfoCast server A 17. Pet. 22–24 (citing Ex. 1002 ¶¶ 110–115; Ex. 1005, 4:65–5:1, 5:18–30, 15:41–44, Fig. 3). Petitioner contends these elements “maintain[] and manage[] user profiles for all users served by the InfoCast server.” *Id.* Petitioner contends that the node profile management circuit is “configured by the operator” based on Tso’s teaching of a subscriber database and an open database connectivity (ODBC) application programming interface (API). Pet. 26–30. In particular, Petitioner contends an ordinarily skilled artisan would have “would have understood that the database including the user’s record with their interests and other information would have been defined by the database administrator, because that is the entity that defines the schema for the database.” *Id.* at 26–27 (citing, *inter alia*, Ex. 1002 ¶¶ 117–118; Ex. 1005, 4:34–41, 21:33–37) (internal quotations omitted). Petitioner further contends that an ordinarily skilled artisan considering the API “would have known that writing applications for reading into a database required a known schema and would have required the application to be coded to read and write into the known database using appropriate indices.” *Id.* at 27–30 (quoting Ex. 1002 ¶ 121) (citing, *inter alia*, Ex. 1005, 4:43–49, 6:41–43). Petitioner additionally contends the node profile management circuit is configured “as a function of objective or subjective criteria” based on Tso’s teaching of using “positional information [i.e., *objective criteria*] of all users located in the domains served by server A 17” and information regarding interests (i.e., subjective criteria) in the subscriber database. Pet. 30–31 (quoting Ex. 1005, 4:34–36) (citing *id.* at 4:36–41) (alteration by Petitioner).

Patent Owner does not dispute Petitioner’s analysis of the “node profile management circuit” at this juncture. On the present record, we are persuaded that Tso’s subscriber database includes “the records of all users . . . who are currently in the territory serviced by server A 17.” Ex. 1005, 4:65–5:1. This includes information regarding “interests,” i.e., “subjective criteria,” which an ordinarily skilled artisan would have known to include data compiled by a database administrator (i.e., “configured by an operator of the network”). *See, e.g.*, Ex. 1002 ¶¶ 117–118; Ex. 1005, 4:36–41, 21:33–37. Moreover, Tso’s schedule/resource controller 61 filters information sent to subscribers based on user profiles in the subscriber database. *See, e.g.*, Ex. 1005, 13:28–31. Thus, we are persuaded that Tso teaches the recited “node profile management circuit.”

Claim 1 further recites that the device comprises “a mechanism configured for filtering broadcast information items that controls a switch to filter said information items.”⁶ Ex. 1001, 6:34–40. For this limitation, Petitioner cites Tso’s teaching of a filter in schedule/resource controller 61 that filters InfoBites and information transmitted to users. Pet. 31 (citing Ex. 1005, 7:30–55, 10:53–61). Petitioner concedes, however, that “Tso does not explicitly describe the filter as controlling a switch to filter information items.” *Id.* at 34. Thus, Petitioner relies on Haber for teaching switching nodes 16 that include switch 18. *Id.* (citing Ex. 1007, Abstr.). Petitioner further contends data processor 20 in Haber’s switching nodes 16 may be “configured to perform a broadcast data network processing function.” *Id.* (quoting Ex. 1007, 3:34–35) (citing *id.* at 2:40–42, 6:58–60).

⁶ As stated above, we apply the plain and ordinary meaning of this limitation. *See supra* § II.C.3.

Petitioner notes that improved network efficiency can be gained by placing Haber's data processing function in switching nodes because it avoids transporting redundant user information in the network. Pet. 35 (citing Ex. 1007, 8:20–31). Thus, according to Petitioner, an ordinarily skilled artisan “would have found it obvious to employ the combined teachings of Tso and Haber such that Tso's InfoCast server logic and system was implemented in a data processor within a switching node to route data in a packet-switched data network, such as that disclosed by Haber.” *Id.* at 35–36 (citing Ex. 1002 ¶¶ 134–135). Petitioner contends that “[b]y implementing Tso's InfoCast server functionality in processors within switching nodes as expressly suggested by Haber, the overall traffic flowing over a packet-switched network can be reduced by applying Tso's filtering, thereby improving network efficiency.” *Id.* at 38–39 (citing Ex. 1002 ¶ 140; Ex. 1005, 13:27–34, 13:59–64; Ex. 1007, 7:22–24). Petitioner further contends that “[i]mplementing Tso so as to have the filter control a switch for filtering information items would have merely applied Haber's technique in a Tso packet switching network to yield predictable results—namely the ability to control a switch based on filtered data to be routed to downstream nodes.” *Id.* at 40 (citing Ex. 1002 ¶¶ 141, 143, 145).

Patent Owner argues that Petitioner fails to show how “Tso's InfoCast server could accomplish the needed filtering or provide the alleged benefits argued by Petitioner if it were implemented in a single switching node of Haber.” Prelim. Resp. 16. Patent Owner also argues that Petitioner fails to show “why one of ordinary skill in the art would expend cost and resources in implementing Tso's server in every switching node in Haber in view of

Tso’s teachings of accomplishing the function with a single server located outside the network.” *Id.*

We do not agree with Patent Owner’s arguments. First, we do not read Petitioner’s proposed combination as being implemented in “a single switching node of Haber.” Rather, Petitioner proposes “implementing Tso’s InfoCast server functionality in processors within switching *nodes* as expressly suggested by Haber.” Pet. 38 (emphasis added). Thus, Petitioner expressly contemplates the combination in multiple nodes. Second, we do not agree with Patent Owner’s characterization (Prelim. Resp. 16) that the combination “implement[s] Tso’s server in every switching node in Haber in view of Tso’s teachings of accomplishing the function with a single server located outside the network.” Petitioner proposes implementing the InfoCast server *functionality* in the data processors of Haber’s switching nodes. Pet. 35–36, 38. As noted by Petitioner (Pet. 36), Tso expressly states that its disclosed system “supports the transfer of information over the nodes of many types of communication networks such as cellular data networks, local area networks, and wide area networks.” Ex. 1005, 2:1–4. And Dr. Weissman’s uncontested testimony supports this combination insofar as an ordinarily skilled artisan “would have understood that Tso’s network included packet-switched networks.” Ex. 1002 ¶ 132; *see also id.* ¶ 136; Ex. 1005, 11:26–35, 12:63–67, 18:25–26 (Tso discussing TCP/IP applications). Thus, we view the combination as being implemented in existing packet-switched elements within the combined Tso–Haber network topology rather than relying on a multiplicity of new servers, as Patent Owner seems to imply.

At this juncture, we are persuaded that Tso's schedule/resource controller 61 filters InfoBites and information transmitted to users. *See, e.g.*, Ex. 1005, 7:30–55, 10:53–61. We are further persuaded that Haber teaches switching nodes 16 with switches 18 along with data processor 20 having a “broadcast data processor process” that controls switches 18. *See, e.g.*, Ex. 1007, Abstr., 3:34–35, 6:58–60. Petitioner also provides a persuasive reason for combining Haber with Tso: to obtain the efficiencies of Tso's InfoCast server functionality in the data processor of Haber's switching nodes, which can reduce the transport of redundant information in the network. *See, e.g.*, Ex. 1002 ¶¶ 133, 143; Ex. 1007, 8:20–31. Thus, we are persuaded that the combination of Tso and Haber teaches the filtering mechanism limitation of claim 1.

Based on the present record, we are satisfied that the combination of Tso and Haber teaches all of the limitations of claim 1. We also are persuaded that an ordinarily skilled artisan would have had reasons to combine Tso and Haber. Thus, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that the subject matter of claim 1 would have been obvious over the combination of Tso and Haber.

4. Claims 2 and 4–6

We have reviewed Petitioner's obviousness analysis for claims 2 and 4–6, which depend from claim 1. Pet. 44–49. Patent Owner relies on the same arguments discussed above with respect to claim 1. Prelim. Resp. 17. Based on the present record, we are satisfied that the combination of Tso and Haber teaches all of the limitations of claims 2 and 4–6. Thus, we determine

that Petitioner has established a reasonable likelihood that it would prevail in showing that the subject matter of claims 2 and 4–6 would have been obvious over the combination of Tso and Haber.

5. *Claim 16*

Independent claim 16 recites “[a] broadcast network having a plurality of nodes” (Ex. 1001, 8:8–9) and Petitioner relies on an analysis similar to that of claim 1. *See* Pet. 49–55. Patent Owner relies on arguments similar to those discussed above with respect to claim 1. Prelim. Resp. 17. Based on the present record, we are satisfied that the combination of Tso and Haber teaches all of the limitations of claim 16. Thus, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that the subject matter of claim 16 would have been obvious over the combination of Tso and Haber.

6. *Claims 17 and 18*

We have reviewed Petitioner’s obviousness analysis for claims 17 and 18, which depend from claim 16. Pet. 55–59. Patent Owner relies on arguments similar to those discussed above with respect to claim 1. Prelim. Resp. 17. Based on the present record, we are satisfied that the combination of Tso and Haber teaches all of the limitations of claims 17 and 18. Thus, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that the subject matter of claims 17 and 18 would have been obvious over the combination of Tso and Haber.

F. Obviousness Ground Based on Tso, Ericsson, and Haber

Petitioner contends the subject matter of claims 1, 2, 4–6, and 16–18 would have been obvious over the combination of Tso, Ericsson, and Haber. Pet. 15–59. Patent Owner disputes Petitioner’s contentions. Prelim. Resp. 11–17.

1. Ericsson

Ericsson is a PCT patent application publication directed to telecommunications information broadcast services and the dissemination of information to subscribers of a mobile telecommunications network. Ex. 1006, 1:2–4. Figure 2 of Ericsson is reproduced below.

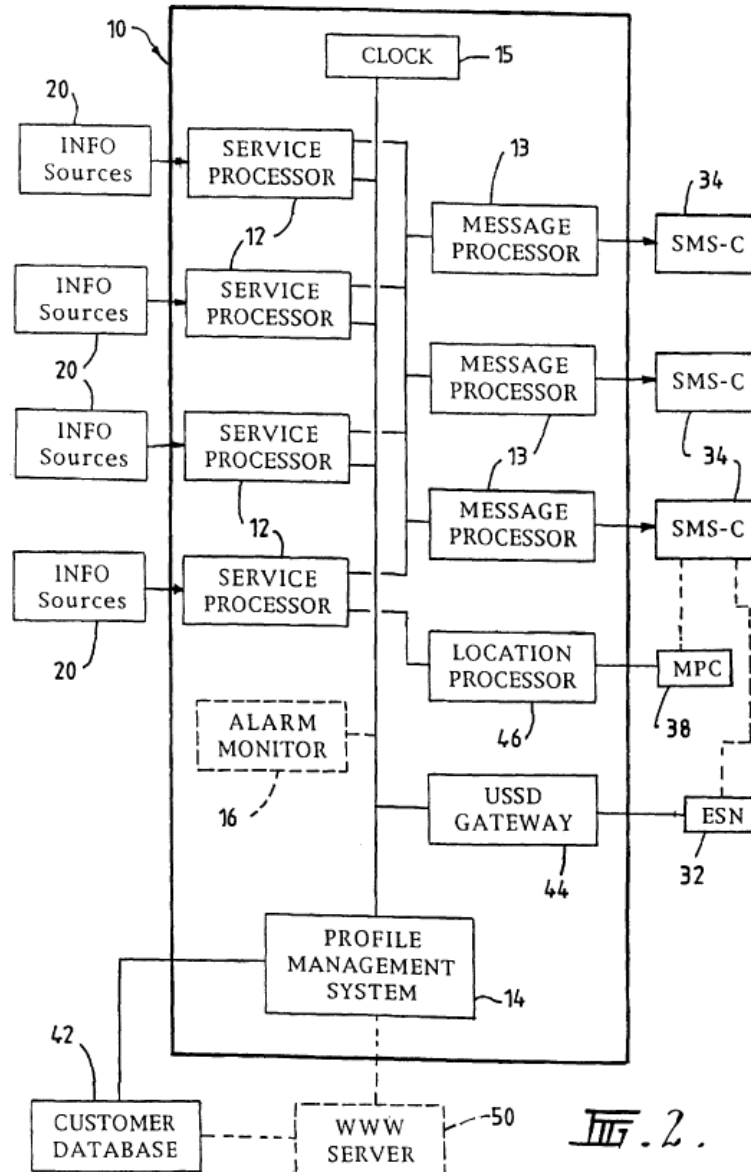


Figure 2 is a block diagram of message distribution center 10, which receives and processes data from information sources to generate location-dependent messages for particular subscribers in accordance with the location those subscribers. *Id.* at 5:16–20, 10:6. Message distribution center 10 includes service processors 12 connected to information sources 20, message processors 13 connected to short message service centers (SMS-C) 34, and profile management system 14 connected to customer database 42. *Id.* at 10:6–13. Each service processor 12 accesses

customer database 42 via profile management system 14 and processes data from information sources 20 to produce information messages for individual subscribers in accordance with customer profiles for each subscriber from customer database 42. *Id.* at 10:14–18. Service processors 12 pass information messages to message processors 13, which process the messages into SMS form for handling by SMS-C 34. *Id.* at 10:18–22. SMS-C 34 then transmits an SMS information message to subscriber’s mobile terminal 32. *Id.* at 10:24–27.

Petitioner contends Ericsson qualifies as prior art under, *inter alia*, 35 U.S.C. § 102(b) based on its publication date. Pet. 13. Patent Owner does not contest the prior art status of Ericsson. For purposes of this Decision, we determine that Ericsson qualifies as prior art under 35 U.S.C. § 102(b) because Ericsson’s publication date of November 6, 1997, is more than one year before the PCT filing date of the application that led to the challenged claims, which is January 3, 2002. Ex. 1001, code (22); Ex. 1006, code (43).

2. *Claim 1*

Petitioner’s obviousness analysis for claim 1 in this ground builds upon its obviousness analysis for the Tso–Haber ground discussed above. Petitioner further cites Ericsson’s profile management system 14 for teaching the recited “node profile management circuit.” Pet. 25 (citing Ex. 1006, 10:6–14, Fig. 2). Petitioner notes that Ericsson’s profile management system 14 includes or is connected to a customer database with customer profiles. *Id.* (citing Ex. 1006, 5:2–4, 10:14–15). As such, Petitioner contends it would have been obvious to implement Ericsson’s

profile management system 14 as a circuit for managing Tso’s subscriber database 53. *Id.* at 41 (citing Ex. 1002 ¶¶ 184–189). In particular, Petitioner contends an ordinarily skilled artisan would have found it obvious to integrate the functionality of Ericsson’s profile management system with Tso’s schedule/resource controller “as a tool for managing the user’s profiles maintained by a particular InfoCast server.” *Id.* at 42 (citing Ex. 1002 ¶ 186). Petitioner contends an ordinarily skilled artisan would have expected success in making the combination “because doing so would have implemented existing and known electronic hardware (Ericsson’s ‘profile management system’) in another known environment (Tso’s InfoCast server) using known, and indeed standardized programming techniques like the use of ODBC and SQL [Structured Query Language] techniques.” *Id.* at 43 (citing Ex. 1002 ¶ 189).

Patent Owner relies on the same arguments discussed above with respect to claim 1 of the Tso–Haber ground. Prelim. Resp. 17. Based on the present record, we are persuaded that Ericsson’s profile management system 14 is a “node profile management circuit.” *See, e.g.*, Ex. 1006, 10:6–14, Fig. 2. We also are persuaded that an ordinarily skilled artisan would have implemented Ericsson’s profile management system 14 in Tso’s schedule/resource controller to perform database management and access operations for Tso’s subscriber database. *See, e.g.*, Ex. 1002 ¶ 188. Thus, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that the subject matter of claim 1 would have been obvious over the combination of Tso, Ericsson, and Haber.

3. *Claims 2, 4–6, and 16–18*

Petitioner’s obviousness analysis for claims 2, 4–6, and 16–18 is the same as for the Tso–Haber ground with the exception of the modification discussed above with respect to claim 1. *See supra* § II.F.2. Patent Owner relies on the same arguments discussed above with respect to claim 1 of the Tso–Haber ground. Prelim. Resp. 17. Based on the present record, we are satisfied that the combination of Tso, Ericsson, and Haber teaches the limitations of claims 2, 4–6, and 16–18 and that an ordinarily skilled artisan would have had reasons to combine Tso, Ericsson, and Haber. Thus, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that the subject matter of claims 2, 4–6, and 16–18 would have been obvious over the combination of Tso, Ericsson, and Haber.

III. CONCLUSION

After considering the evidence and arguments presented in the Petition and the Preliminary Response, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the Petition. Accordingly, we institute an *inter partes* review on all of the challenged claims and all grounds presented in the Petition. At this stage of the proceeding, we have not made a final determination as to the patentability of the challenged claim.

IV. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314, *inter partes* review is instituted as to claims 1, 2, 4–6, and 16–18 of the '770 patent with respect to all grounds of unpatentability presented in the Petition; and

FURTHER ORDERED that *inter partes* review is commenced on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

IPR2021-01191
Patent 7,333,770 B2

PETITIONER:

Andrew R. Sommer
GREENBERG TRAURIG, LLP
sommer@gtlaw.com

Ashraf Fawzy
Alyssa Holtslander
UNIFIED PATENTS, LLC
afawzy@unifiedpatents.com
alyssa@unifiedpatents.com

PATENT OWNER:

Ryan Loveless
Jeffrey A. Stephens
Brett Mangrum
James Etheridge
Brian Koide
Jeffrey Huang
ETHERIDGE LAW GROUP
ryan@etheridgelaw.com
jstephens@etheridgelaw.com
brett@etheridgelaw.com
IPTeam@etheridgelaw.com
brian@etheridgelaw.com
jeff@etheridgelaw.com