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Paper 8
Entered: October 8, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

KONINKLIJKE KPN N.V.,
Patent Owner.

IPR2022-00557
Patent 9,667,669 B2

Before KEVIN F. TURNER, ROBERT J. WEINSCHENK, and RUSSELL E. CASS, *Administrative Patent Judges*.

TURNER, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Ericsson Inc. and Telefonaktiebolaget LM Ericsson ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting institution of *inter partes* review of claims 1–3, 6, 8, 10–12, 21, 22, 24, and 25 of U.S. Patent No. 9,667,669 B2 (Ex. 1001, "the '669 Patent"). Koninklijke KPN N.V. ("Patent Owner") filed a Preliminary Response (Paper 5, "Prelim. Resp."). We additionally authorized the filing of a Reply by Petitioner to Patent Owner's Preliminary Response (Paper 6, "Pet. Prelim. Reply") and a Sur-reply by Patent Owner (Paper 7, "PO Prelim. Sur-reply") to further consider the arguments of the parties with respect to the application of our discretion under 35 U.S.C. § 325(d).

An *inter partes* review may be instituted only if "the information presented in the petition . . . and any [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." 35 U.S.C. § 314(a) (2018). For the reasons given below, Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims of the '669 Patent. Accordingly, we institute an *inter partes* review of claims 1–3, 6, 8, 10–12, 21, 22, 24, and 25 of the '669 Patent on the ground of unpatentability raised in the Petition.

B. Related Proceedings

Both parties identify the following judicial or administrative matter that would affect, or be affected by, a decision in this proceeding: *Versata Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson*, Case No. 2:21-cv-113 (E.D. Tex.). Pet. 2; Paper 4, 2.

C. The '669 Patent

The '669 Patent is titled "Managing Associated Sessions in a Network," and is asserted to provide "a method and a system for managing associated multimedia sessions in a network," including the provision of a composition session identifier. Ex. 1001, code (54), Abs. With the growth of IP Multi-Media Subsystem (IMS) architecture, IMS-enabled services are offered that combine sessions (also referred to as streams) from various sources such as audio, video, and other media. *Id.* at 1:23–37. According to the '669 Patent, IMS-enabled services permit an end user to be an active participant in a multimedia session having multiple underlying media sessions instead of a passive viewer. *Id.* at 1:38–40.

The '669 Patent also details that in prior art systems, the network element is unaware of the association between the various underlying media sessions that are combined to make up these multimedia services, such that the network element may not treat each underlying media session uniformly or in a manner conducive to the multimedia services, which could impact quality of service. Ex. 1001, 2:10–15. The '669 Patent discloses the use of a composition session to associate multiple underlying media sessions and manages the associated sessions through one or more composition sessions. *Id.* at 3:25–43, 4:54–55.

In one embodiment, associated sessions are managed in an IMS-based Internet Protocol Television (IPTV) system, which uses Session Initiation Protocol (SIP) to setup and control media sessions between user equipment (UE) and a network element, such as a Service Control Function (SCF) or a Media Function (MF), with exemplary protocol flow illustrated in Figure 2, reproduced below. Ex. 1001, 7:39–42, 7:22–26, 7:29–30, 7:9–10.

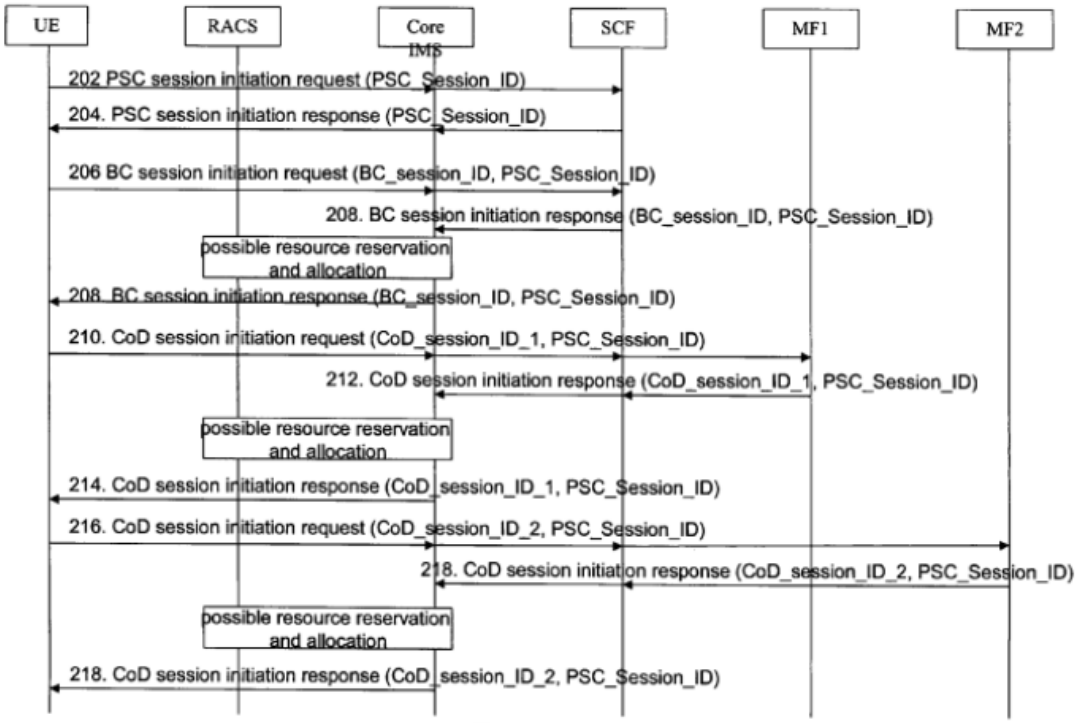

Figure 2

Figure 2 of the ’669 Patent illustrating a flow diagram

In Figure 2, the composition session is a personalized stream or service composition (PSC) session, and the composition session identifier is referred to as PSC_Session_ID. The composition session identifier may be generated or created by the UE or the network element, or provided by a third party, such as an application server or an Electronic Programming Guide. Ex. 1001, 8:1–5. The method associates underlying media sessions by exchanging the composition session identifier between the UE and the network element (for example, network elements SCF or MF1/MF2), to initiate the composition session and to initiate the associated media sessions.

D. Challenged Claims

Claims 1 and 21 are the sole independent claims challenged in this proceeding, with each of challenged claims 2, 3, 6, 8, 10–12, 22, 24, and 25

dependent on one of those claims, directly or indirectly. Independent claim 1 is considered to be representative and is reproduced below:

> 1. [1p] A method for managing associated sessions in a network, the network having a network element configured for managing associated sessions between the network and at least one user equipment, the method comprising:
>
> [1a] providing a composition session identifier for associating sessions in the network;
>
> [1b] after providing the composition session identifier, exchanging the composition session identifier between a user equipment and the network element a first time;
>
> [1c] associating two or more sessions with the composition session identifier by exchanging the composition session identifier at least a second time, wherein exchanging the composition session identifier at least a second time comprises the network element exchanging the composition session identifier with the user equipment;
>
> [1d] initiating establishment of a composition session, the composition session being a signaling session for facilitating management of the two or more sessions and exchanging the composition session identifier between the user equipment and the network element as part of said establishment, the composition session being different from the two or more sessions; and
>
> [1e] modifying the composition session, wherein modifying the composition session comprises using signaling in the composition session to terminate all of the two or more sessions.

Ex. 1001, 12:30–50 (with annotations provided by Petitioner, Pet. 25–50).

E. Asserted Ground of Unpatentability

Petitioner asserts the following ground of unpatentability (Pet. 6, 21–72), supported by the declaration of Mr. Anthony Wechselberger (Ex. 1003):

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–3, 6, 8, 10–12, 21, 22, 24, 25	103(a)[1]	Foti,[2] RFC 3261,[3] RFC 4566,[4] RFC 2326,[5] Wright,[6] Lloyd[7]

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Petitioner, supported by Mr. Wechselberger's testimony, proposes that a person of ordinary skill in the art at the time of the invention "would be a person with a B.S. degree in electrical engineering, computer engineering, or equivalent training or job experience, with two years of experience in computer networking technology, or a Master's degree in electrical engineering, computer engineering, or other equivalent degree." Pet. 13 (citing Ex. 1003 ¶ 47). Patent Owner indicates that it does not challenge the

[1] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent claims priority to an application filed before March 16, 2013, we refer to the pre-AIA version of § 103.
[2] U.S. Patent Publication 2008/0151918 A1, filed Dec. 22, 2006, published Jun. 26, 2008 (Ex. 1006, "Foti").
[3] J. Rosenberg et al., SIP: Session Initiated Protocol, RFC 3261, June 2002 (Ex. 1007, "RFC 3261").
[4] M. Handley et al., SDP: Session Description Protocol, RFC 4566, Jul. 2006 (Ex. 1008, "RFC 4566").
[5] H. Schulzrinne et al., Real Time Streaming Protocol (RTSP), RFC 2326, Apr. 1998 (Ex. 1009, "RFC 2326").
[6] U.S. Patent Publication 2006/0039367 A1, filed Dec. 30, 2004, published Feb. 23, 2006 (Ex. 1010, "Wright").
[7] European Patent Application 1777969 A1, filed Oct. 10, 2005, published Apr. 25, 2007 (Ex. 1011, "Lloyd").

qualifications proposed by Petitioner for a person of ordinary skill in the art. Prelim. Resp. 26.

At this stage of the proceeding, we find Petitioner's proposal consistent with the level of ordinary skill in the art reflected by the prior art of record, *see Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978), and, therefore, we adopt Petitioner's unopposed position as to the level of ordinary skill in the art for purposes of this decision.

B. Claim Construction

In this *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b) (2020). The claim construction standard includes construing claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art at the time of the invention. *See id.*; *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005) (en banc). In construing claims in accordance with their ordinary and customary meaning, we take into account the specification and prosecution history. *Phillips*, 415 F.3d at 1315–17.

Petitioner asserts that one claim term, "composition session," requires explicit construction (Pet. 20–21), whereas Patent Owner asserts that the same claim term, plus one additional claim element, namely "associated sessions," should be construed expressly. Prelim. Resp. 26–29.

We consider the parties' proposed, express constructions below, along with an additional claim element we determine to require explicit construction.

1. "associated sessions"

With respect to the limitation "associated sessions," Patent Owner asserts that the '669 Patent defines those sessions as those that "should not be managed independent from each another." Prelim. Resp. 26 (quoting Ex. 1001, 7:37–38). Based on the recitations of the Specification, we construe "associated sessions" as "sessions that should not be managed independent from each other," as proffered by Patent Owner.

2. "composition session"

With respect to the limitation "composition session," Petitioner asserts that it should be construed as "a separate signaling session for managing the associated sessions that is initiated using a different signaling session than the associated sessions," which Petitioner asserts to be consistent with the definition in the Specification and the applicant's statements made during prosecution. Pet. 20 (citing Ex. 1001, 3:61–4:1). Petitioner asserts that the patent applicant stressed during prosecution that the composition session is a session for management that is initiated separately and is different than the associated sessions, which differs from Patent Owner's asserted construction of the term in the litigation as a "signaling session separate from the associated sessions." *Id*. at 20–21 (citing Ex. 1002, 49–50, 52; Ex. 1017, ex. A, 32; Ex. 1020, 25–27).

Patent Owner asserts that the United States District Court for the Eastern District of Texas rejected Petitioner's proposed construction in the District Court Case, and following briefing and oral argument in that

proceeding, the District Court concluded that "composition session" means "a signaling session that is separate from the associated sessions and that is for facilitating management of the associated sessions." Prelim. Resp. 28 (citing Ex. 2002, 84–90). Having reviewed the District Court's determinations, we adopt its construction of "composition session" in the analysis below.

3. "exchange"

Claim 1 recites, in part, "exchanging the composition session identifier." In its arguments countering the ground of unpatentability laid out in the Petition, Patent Owner asserts that the "Petition's assertion that one-way transmission of one and only one SIP message is an 'exchange' as recited in Claim 1," is contrary to the disclosures of Foti and RFC 3261. Prelim. Resp. 48–52 (quoting *id*. at 50). Patent Owner argues that Foti teaches that the SIP INVITE message and the OK message back, taken together, constitute an exchange, and that RFC 3261 discloses a two-phase exchange of SDP messages. *Id*. at 50–51 (citing Ex. 1006 ¶¶ 7, 25, claims 12, 24; Ex. 1007, 15, 16, 79). This argument, however, excludes consideration of the Specification of the '669 Patent, which discloses that "[t]he sending of such composition session identifier in either direction may be referred to as an 'exchange.'" Ex. 1001, 3:18–20. As such, the plain and ordinary meaning of "exchanging the composition session identifier," in the context of the Specification, is "sending the composition session identifier in either direction." We apply that construction in the analysis below.

4. Other terms

We determine that it is not necessary to provide an express interpretation of any other claim terms. *See Nidec Motor Corp. v.*

Zhongshan Broad Ocean Motor Co. Matal, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) ("[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.").

C. Legal Standards – Obviousness

The U.S. Supreme Court sets forth the framework for applying the statutory language of 35 U.S.C. § 103 in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966):

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

As explained by the Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*,

> Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.")).

"Whether an ordinarily skilled artisan would have been motivated to modify the teachings of a reference is a question of fact." *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1327 (Fed. Cir. 2016) (citations omitted). "[W]here a party argues a skilled artisan would have been motivated to combine references, it must show the artisan 'would have had a reasonable expectation of success from doing so.'" *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1360–61 (Fed. Cir. 2017) (quoting *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litig.*, 676 F.3d 1063, 1068–69 (Fed. Cir. 2012)).

D. Obviousness over Foti in view of RFC 3261, RFC 4566, RFC 2326, Wright, and Lloyd

Petitioner asserts that the combination of Foti, RFC 3261, RFC 4566, RFC 2326, Wright, and Lloyd would have rendered the subject matter of claims 1–3, 6, 8, 10–12, 21, 22, 24, and 25 obvious to one of ordinary skill in the art at the time of the invention. Pet. 21–72. Patent Owner argues that the Petition has failed to establish the requisite motivation to combine the cited references, that the Petition fails to identify with particularity the argument and evidence against the challenged claims, and the cited references do not teach or suggest at least limitations [1p], [1c], and [1d] of claim 1. Prelim. Resp. 38–66. We begin with brief discussions of the cited references, and then consider Petitioner's arguments with respect to the references' teachings applied to the instant claims as well as Patent Owner's arguments asserting deficiencies in this ground of unpatentability.

1. Foti

Foti describes a method for managing media sessions by associating a media session to a SIP signaling session. Ex. 1006, code (54), Abs. Foti

details that in prior art systems, the SIP signaling session is not linked to the RTSP media session that it creates, such that reliable identification and authentication of the user is difficult and prohibits the correlation of accounting information with the user for billing purposes. *Id*. ¶ 4. Foti teaches that linking the RTSP session to the SIP session facilitates management of the RTSP sessions, such that network operators can more accurately identify users to be charged for media transactions, reconcile accounting records, and detect fraud. *Id*. ¶ 5. Foti's methods for establishing multimedia streaming sessions are embodied in an IPTV system that uses standard IMS and IETF protocols such as SIP, SDP, and RTSP. *Id*. ¶¶ 2, 3, 5.

When a user desires to watch content on UT 20, the "user issues an RTSP command from a remote control such as 'PLAY,' to start watching a movie." Ex. 1006 ¶ 30. UT 20 next issues a SIP INVITE 64 message to AS 40, which contains an identification of the user, a SIP session ID, and a Uniform Resource Locator (URL) that identifies a particular MCS 30 and/or media program being requested. *Id*. UT 20 initiates a media session by sending a SIP INVITE message to AS 40. *Id*. ¶ 25. The signaling flow to complete this process is shown in Figure 4, as reproduced below:

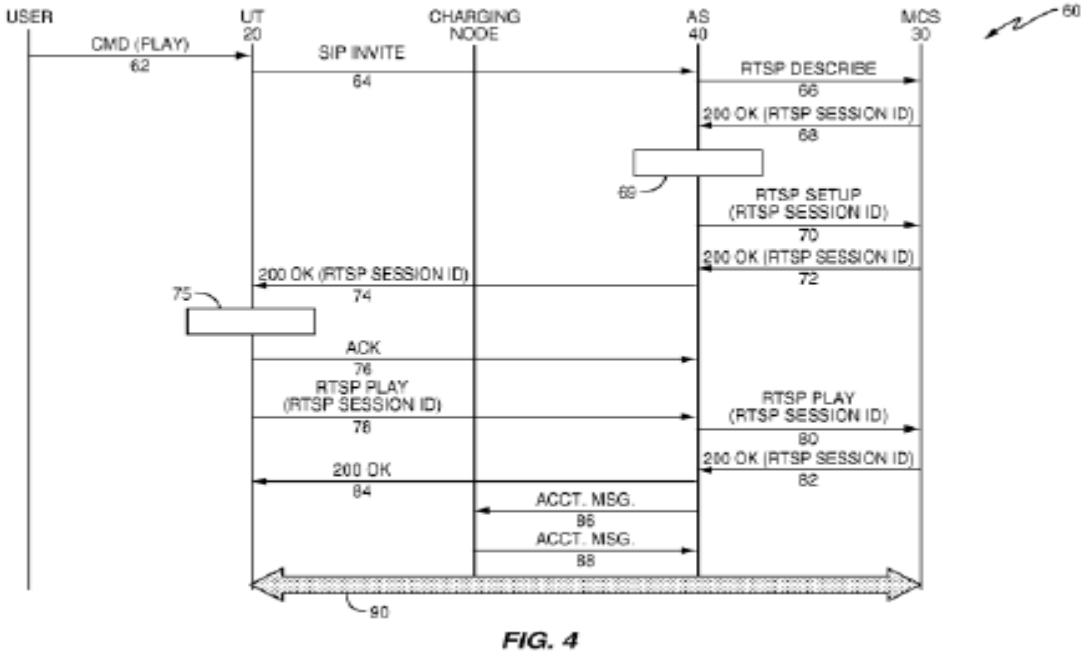

FIG. 4

Figure 4 of Foti illustrates the call flow according to one embodiment

Foti is directed to managing media sessions generally, and in certain embodiments, more than one RTSP session, through its RTSP session ID, may be linked to the same SIP session, through its SIP session ID. Ex. 1006 ¶ 28. Figure 3 illustrates that table 52 provides that RTSP2 and RTSP4, both RTSP session IDs, can be made to correspond to SIP2, a single SIP session ID. *Id*. ¶ 28, Fig. 3. Table 52 may also store the user ID and the URL associated with the RTSP media session. *Id*. ¶ 28.

2. RFC 3261, RFC 4566, and RFC 2326

RFC 3261 is an IETF standard document describing the Session Initiated Protocol (SIP), which is a signaling protocol for creating, modifying, and terminating sessions. Ex. 1007, Abs. SIP is a component that can be used with other IETF protocols to build a multimedia architecture. *Id*. at 9–10.

RFC 4566 is an IETF standard document describing the Session Description Protocol (SDP), which is a protocol for describing media sessions for purposes of session initiation. Ex. 1008, Abs.

RFC 2326 is an IETF standard document describing the Real Time Streaming Protocol (RTSP). Ex. 1009, Abs. RTSP provides for the setup and teardown of real-time streaming media sessions, as well as providing mechanisms for real-time control of the streaming media such as PLAY and PAUSE. *Id.* at Abs., 33–37.

3. Wright, and Lloyd

Wright describes methods for establishing media streams in IPTV systems using SIP messages. Ex. 1010 ¶ 8. Wright further discloses methods for terminating the media streams using SIP messages, whereby the termination includes the user equipment sending a SIP BYE message (as taught by RFC 3261), and the network responding to that message by terminating the media stream. *Id.* ¶¶ 8, 38, Fig. 6.

Lloyd is concerned with the transmission of video signals via a network, and describes methods for establishing media streams in video systems using SIP messaging and SDP to communication information and parameters that describe the media stream. Ex. 1011 ¶ 11. The SDP signaling can be used to reset the parameters of a video conferencing session and send them to the receiving end, including analyzing of network conditions, with periodic adjustments to the video frame rate being communicated to receivers via a "SDP message with new frame rate." *Id.* ¶ 12, Fig. 3.

4. Patent Owner's Arguments Regarding Mapping of Elements from the Prior Art to the Claims in the Petition

Patent Owner asserts that the Petition does not identify the specific teachings of each of these references against the challenged claims, much less provide sufficient explanation as to how the multiple alternative mappings interact in its ground of unpatentability. Prelim. Resp. 42. Patent Owner further asserts that this failure to identify with particularity the alleged teachings of the challenged claims in the prior art supports denial of the Petition. *Id*. (citing *Juniper Networks, Inc. v. Core Optical Techs., LLC*, IPR2020-01664, Paper 9, 11–12, 16 (PTAB Apr. 16, 2021); *PayPal, Inc. v. IOENGINE, LLC*, IPR2019-00931, Paper 16, 28–32 (PTAB Oct. 29, 2019); *Elk Eng'g Sdn. Bhd. v. Wilco Marsh Buggies & Draglines, Inc.*, IPR2020-00344, Paper 7, 14–15 (PTAB June 23, 2020)). Patent Owner also asserts that the Petition's multiple alternative mappings of Foti and the IETF RFC standards "are ambiguous and leave the Patent Owner and the Board to guess what the combination actually is for Claim 1." *Id*. at 42–43. Patent Owner points to specific incidences of these alleged ambiguities with respect to the Petition's analyses of claims 1 and 21. *Id*. at 43–47.

We determine, overall, that the intent of the single ground of unpatentability is clear with respect to the challenged claims. Taking Patent Owner's example, i.e., limitation [1c] (Prelim. Resp. 43–44), the RFC references detail additional aspects of certain protocols, such as SIP, SDP, and RTSP, as discussed above. Foti discusses each of these protocols, also as discussed above. *See* Ex. 1006 ¶¶ 2, 3, 5. One of ordinary skill in the art evaluating Foti would have had an understanding of the disclosed protocols, and would have looked to the RFCs to determine certain particular aspects, such as, for example, what elements make up a certain message in the

particular protocol, if those elements were not immediately recollected. The Petition's assertion that "Foti, alone and in view of RFCs 4566, 3261, and 3388" (Pet. 33) is understood as asserting that Foti teaches or suggests the functionality of element [1c] alone, with reference to the also-cited RFCs being necessary if particular aspects of the disclosed RFCs are needed to understand what one of ordinary skill in the art would have understood the protocols to cover. Similarly, with respect to elements [1p] and [1e], as well as claim 21, we can follow the logic of the Petition and understand how they are being applied to the claim elements.

5. Proffered Motivation to Combine Foti, RFC 3261, RFC 4566, RFC 2326,Wright, and Lloyd

Petitioner asserts that persons of ordinary skill in the art would have been motivated to combine Foti with RFC 3261, RFC 4566, RFC 2326, Wright, and Lloyd to arrive at the claimed invention. Pet. 21 (citing Ex. 1003 ¶¶ 79–85). Petitioner asserts that such skilled artisans would have been motivated to refer to these RFCs to implement the express teachings of Foti to manage RTSP sessions using a SIP session, SDP, and SIP session identifier, and would have had a reasonable expectation of success. *Id*. at 21–22. Additionally, Petitioner asserts that it would have been obvious to combine the teachings of Foti with those of Wright, since both Foti and Wright discuss establishing media sessions using SIP and RTSP protocols, and Wright discloses additional techniques for admission control whereby the network decides whether the session can be established based on the amount of available bandwidth. *Id*. at 23 (citing Ex. 1010¶¶ 5–7, 23, 36; Ex. 1003 ¶ 83). Petitioner also asserts that Wright also teaches how to terminate the media session using a user-initiated SIP BYE message and that Foti

discloses methods for continuing a media session in the event that the SIP session times out and the user desires to continue watching the media session. *Id*. (citing Ex. 1010 ¶ 38, Fig. 6; Ex. 1006 ¶¶ 37–39). Petitioner asserts that skilled artisans would have been motivated to include Wright's ability to terminate unwanted media sessions using a SIP BYE message in Foti's system to complement Foti's discloses processes, and as this would have been an expected functionality of an IPTV service. *Id*. at 23–24 (citing Ex. 1003 ¶ 84). Lastly, Petitioner asserts that person of ordinary skill in the art would have been motivated to follow the teachings of Lloyd to modify Foti to support the known technique of adaptive video frame rate media streams to achieve better perceived quality of service from AS 40 and to be able to accommodate changes in network transmission capacity and to meet "the challenge of consistent provision of QoS." *Id*. at 24–25 (citing Ex. 1011 ¶ 3; Ex. 1003 ¶ 85).

Patent Owner responds that neither the Petition nor Petitioner's expert identifies how or why a person of ordinary skill in the art would have combined all six references in the manner recited in any of the challenged claims as a whole. Prelim. Resp. 40. Patent Owner takes issue that the Petition identifies separate motivations to combine the supporting references with Foti, but does not discuss a motivation to combine all six references. *Id*. at 40–41. We are not persuaded by Patent Owner's argument to deny institution, as discussed below.

At this stage of the proceeding, on the present record, we determine that Petitioner has sufficiently established that an ordinarily skilled artisan would have had a rationale to combine the teachings of Foti with RFC 3261, RFC 4566, RFC 2326, Wright, and Lloyd, and would have had a reasonable

expectation of success from that combination. As discussed above, we are persuaded that one of ordinary skill in the art would have consulted and utilized disclosures in the RFC references to understand and implement the protocols disclosed by Foti. We are further persuaded by Petitioner's arguments that such skilled artisans would have had a rationale to combine the teachings of Wright and Lloyd with those of Foti for the reasons provided.

We are not persuaded by Patent Owner's argument. Petitioner has asserted that each of the supporting references would have been used by persons of ordinary skill in the art to modify or enhance the system described in Foti for the benefits described for the proposed changes. Absent reasons the references should not be combined, which Patent Owner has not pointed out, but accepting that Patent Owner has no burden of persuasion, we determine that the motivation proffered by the Petition is sufficient for institution.

6. Proffered Evidence of Objective Indicia of Nonobviousness

With respect to the sole ground of unpatentability supplied in the Petition, we must also consider any objective evidence of nonobviousness put forward by the parties. Petitioner acknowledges, and Patent Owner emphasizes, that Patent Owner submitted an European Telecommunications Standards Institute (ETSI) Telecommunications and Internet Converged Services and Protocols for Advanced Networking (TISPAN) Change Request related to the embodiments recited in the '669 Patent. Ex. 2008, 5; Prelim. Resp. 1–2. Patent Owner further asserts that the standards agency adopted it and that adoption is industry praise and supports the nonobviousness of the challenged claims. Prelim. Resp. 6–7, 65 (citing

WBIP, LLC v. Kohler Co., 829 F.3d 1317, 1334 (Fed. Cir. 2016)). Patent Owner also asserts that Petitioner's expert in the District Court Case, Dr. Jeffay, admitted that the Change Request was "related to the invention claimed in the '669 Patent," and thus has nexus to the challenged claims, being reasonably commensurate with the scope of the challenged claims. *Id*. at 65 (quoting Ex. 2008, 5).

On this record, however, we cannot verify the nexus to the challenged claims merely through the testimony of Petitioner's expert in the District Court Case. That expert testified: "I also *understand* that KPN and TNO submitted an ETSI TISPAN Change Request related to the invention claimed in the '669 Patent in January 2009." Ex. 2008, 5 (emphasis added). Although the expert's testimony is evidence, it is only weak evidence, as it is not supported by any underlying documentation, such as the Change Request itself or a comparison of that Change Request and the issued claims of the '669 Patent. As such, we remain open to further consideration of this evidence of nonobviousness through industry praise, but determine it to be insufficient to overcome the case for obviousness of the challenged claims provided in the Petition at this stage of the proceeding.

7. Claim 1

a. Element [1p]: Preamble

With respect to the preamble of claim 1, Petitioner asserts that Foti discloses a network which "includes a network element (AS 40) that manages media sessions between the network and at least one user equipment (user terminal (UT) 20)." Pet. 25 (citing Ex. 1006 ¶¶ 19–20, Fig. 1). Petitioner also asserts that Foti discloses associating the RTSP sessions and SIP session using AS40 to "link the RTSP session to the SIP signaling

session used to setup the RTSP media session," and that AS40 "correlates the RTSP session ID to the SIP session using, for example, information included within the SIP INVITE message previously received from the UT 20." *Id*. at 26 (citing Ex. 1006 ¶¶ 26–27). Petitioner further asserts that Foti's disclosure of linking and correlating the RTSP sessions to the SIP session discloses that the managed sessions are "associated" as claimed, and that Foti's AS 40 performs specific management functions, such as identifying the user or its information. *Id*. at 26–27 (citing Ex. 1006 ¶¶ 18, 20; Ex. 1003 ¶ 88). Petitioner also asserts that persons of ordinary skill in the art would have understood that Foti's system could be used to manage the associated RTSP sessions by setting up, modifying, or terminating the associated sessions, where those function would have been understood as management functions. *Id*. at 26–27 (citing Ex. 1003 ¶ 89).

Patent Owner argues that the Petition asserts that "Foti in light of the well-known IETF protocols introduced above discloses or renders obvious" limitation [1p], but never identifies which "IETF protocols introduced above" along with Foti disclose or render obvious limitation [1p]. Prelim. Resp. 62. Patent Owner also argues that the Petition only cites the abstract of RFC 3261 for limitation [1p], but that abstract does not teach or suggest "associated sessions" as recited in claim 1. *Id*. at 63. We are not persuaded by the deficiencies argued by Patent Owner because we are persuaded that the elements of the preamble are taught or suggested by Foti alone.

We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that Foti meets the limitations of the preamble of claim 1 for the reasons explained by Petitioner.

b. Element [1a]: "providing a composition session identifier"

With respect to the method step of providing a composition session identifier for associating sessions in the network, Petitioner asserts that Foti discloses that UT 20 provides a composition session identifier for associating RTSP sessions in the network, by generating a SIP session ID, and that one of ordinary skill in the art would have understood that for UT 20 to send the SIP INVITE containing the SIP session ID to AS 40, UT 20 first would have generated or provided the SIP session ID. Pet. 28 (citing Ex. 1006 ¶¶ 25–27, 30; Ex. 1003 ¶ 90). Petitioner notes that "[t]his is also consistent with the disclosure of the '669 Patent, which states "the PSC ID may be implemented as a SIP Call ID (as defined in RFC 3261)." *Id*. at 31 (quoting Ex. 1001, 9:44–45).

Patent Owner does not offer counter arguments with respect to this element of claim 1 in the Preliminary Response. We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that Foti meets this limitation of claim 1 for the reasons explained by Petitioner.

c. Element [1b]: "exchanging the composition session identifier"

Claim 1 recites, in part, exchanging the composition session identifier between a user equipment and the network element a first time. Petitioner asserts that Foti discloses that after the UT 20 generates the SIP INVITE, including the composition session identifier, i.e., the SIP session ID, UT 20 sends the SIP INVITE to AS 40. Pet. 31–32 (citing Ex. 1006 ¶ 30, Fig. 4).

Patent Owner does not offer counter arguments with respect to this element of claim 1 in the Preliminary Response. We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that Foti meets this limitation of claim 1 for the reasons explained by Petitioner.

d. Element [1c]: "associating two or more sessions"

Claim 1 recites, in part, associating two or more sessions with the composition session identifier by exchanging the composition session identifier at least a second time, wherein exchanging the composition session identifier at least a second time comprises the network element exchanging the composition session identifier with the user equipment. Petitioner asserts that Foti, alone or in combination with RFCs 4566, 3261, and 3388, discloses associating two or more RTSP sessions using the composition session identifier (i.e., SIP session ID). Pet. 33. Petitioner asserts that Figure 3 of Foti illustrates that two RTSP sessions are associated with a single SIP session identifier, and that Foti states that "[m]ore than one RTSP session ID may be linked to the same SIP session ID." *Id*. at 35–36 (citing Ex. 1006 ¶ 27, Fig. 3).

Petitioner also asserts that Foti discloses that the 200 OK message to the UT 20 may contain the correlation information determined by AS40, which completes the association the two or more sessions by AS 40 and allows the UT 20 to also associate the two or more sessions. Pet. 36–38 (citing Ex. 1006 ¶¶ 31–33, Fig. 4).

Patent Owner argues that Petitioner's assertion that Foti discloses exchanging the composition session identifier at least a second time is unsupported by Foti and contrary to an IETF RFC standard asserted in the Petition. Prelim. Resp. 48. Patent Owner argues that the Petition misuses the term "exchange," which would have been understood as "the actual exchange of messages—not one-way transmission of a single message from one component to another component." *Id*. at 50 (citing Ex. 1006 ¶¶ 7, 24, claims 12, 24). Patent Owner also argues that "the Petition's assertion that

one-way transmission of one and only one SIP message is an 'exchange' as recited in Claim 1 is contrary to RFC 3261 asserted in the Petition." *Id*. at 50–51 (citing Ex. 1007, 15, 16, 79). We do not find Patent Owner's arguments to be persuasive.

As discussed above, the plain and ordinary meaning of "exchanging the composition session identifier," in the context of the Specification, is "sending the composition session identifier in either direction." Given the description supplied in the Specification of the '669 Patent, we are not persuaded that it is error for the Petition to refer to one-way transmission of a single message as an "exchange." Also, under the plain and ordinary meaning, the 200 OK message to the UT 20, would have been an exchange and would involve the exchange of the SIP session ID a second time in the timing diagram, i.e., Figure 4, of Foti.

Patent Owner also argues that Foti does not support the Petition's assertion that the linking of more than one RTSP session ID with the same SIP session ID is equivalent to associating two or more sessions with the composition session identifier. Prelim. Resp. 52. Patent Owner also argues that in each disclosure in Foti that recites the linking, it follows from a message exchange for establishing just one single media session, and underscores that Foti does not establish "two or more media sessions." *Id*. Patent Owner also argues that Foti emphasizes how one RTSP session is linked to a SIP session ID and does not disclose how more than one RTSP session ID may be linked to the same SIP session ID. *Id*. at 53–54. We do not find Patent Owner's arguments to be persuasive.

As asserted by the Petition (Pet. 33–36), Foti clearly discusses table 52, illustrated in Figure 3, as having "the media sessions identified by

RTSP2 and RTSP4 [] both linked to the signaling session identified by SIP2." Ex. 1006 ¶ 28. Although Patent Owner argues that this is the sole disclosure in all of Foti, that does not diminish what the disclosure provides. We have no argument or evidence that would distinguish "linking" of identifiers, identifying sessions, from the claimed recitation of "associating two or more sessions with the composition session identifier." Although Patent Owner is correct that the bulk of Foti considers the linking of one RTSP ID with one SIP ID, that does not negate its actual disclosure. We agree with Petitioner that the linking of the multiple RTSP IDs with a single SIP ID, via the exchanged "correlation information," would allow for facilitation of management of the two or more RTSP sessions, such that if the SIP session should terminate the AS would reject RTSP commands as invalid. Pet. 42 (citing Ex. 1006 ¶¶ 36–37).

We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that Foti meets this limitation of claim 1 for the reasons explained by Petitioner.

e. Element [1d]: "initiating establishment of a composition session"

Claim 1 recites, in part, initiating establishment of a composition session, the composition session being a signaling session for facilitating management of the two or more sessions and exchanging the composition session identifier between the user equipment and the network element as part of said establishment, the composition session being different from the two or more sessions. Petitioner asserts that a user interacts with UT 20 via a TV set to initiate the composition session (SIP signaling session) by sending a SIP INVITE to AS 40. Pet. 39 (citing Ex. 1006 ¶ 24). Petitioner

also asserts that Foti discloses that the SIP signaling session is a composition session because the SIP signaling session is a separate session initiated by UT 20 using a SIP INVITE (64), while the RTSP session is a separate RTSP session set up by AS 40 and MCS 30 using different RTSP messages. *Id*. at 40 (citing Ex. 1006, Fig. 4). Petitioner further asserts that Foti's signaling session facilitates management of the two or more (RTSP) sessions, such that if the SIP session should terminate the AS would reject RTSP commands as invalid. *Id*. at 42 (citing Ex. 1006 ¶¶ 36–37). Petitioner also asserts that the composition session identifier is exchanged between the user equipment and the network as part of said establishment, as discussed above, and that Foti's SIP signaling session is different than the two or more (RTSP) sessions because the latter are initiated using different messages than the SIP signaling session, are set up using a different IETF protocol that is not SIP, and allow UT 20 to control the media stream using different messages. *Id*. at 45.

Patent Owner argues that the Petition asserts that "Foti discloses" limitation [1d], but also cites RFC 2326 in the mapping of the limitation. Prelim. Resp. 63 (citing Pet. 39, 41). Patent Owner also argues that the cited portion of RFC 2326 does not teach or suggest "the composition session being a signaling session for facilitating management of the two or more sessions" as recited in claim 1. *Id*. We are not persuaded by the deficiencies argued by Patent Owner because we are persuaded that element [1d] is taught or suggested by Foti alone.

We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that Foti meets this limitation of claim 1 for the reasons explained by Petitioner.

f. Element [1e]: "modifying the composition session"

Claim 1 recites, in part, modifying the composition session, wherein modifying the composition session comprises using signaling in the composition session to terminate all of the two or more sessions. Petitioner asserts that it would have been obvious to modify Foti's system in light of the media stream teardown procedure taught by Wright. Pet. 45. Petitioner asserts that a person of ordinary skill in the art would have understood that Foti discloses a network-initiated procedure for tearing down the RTSP sessions when the SIP session times out or for other policy reason. *Id*. at 46 (citing Ex. 1003 ¶ 113). Petitioner further asserts that a user may desire to end the SIP session and associated RTSP sessions by pushing a button on a remote control, as taught by Wright, through a desire to stop watching the on demand video or to turn off the UT. *Id*. at 46–47 (citing Ex. 1010 ¶ 38, Fig. 6; Ex. 1003 ¶ 114). Petitioner reiterates that such procedures would have been known to ordinarily skilled artisans, would have had a reasonable expectation of success, and would have resulted in the natural and predictable result of having the user's desires be manifested. *Id*. at 49–50 (citing Ex. 1003 ¶¶ 116–117).

Patent Owner does not offer counter arguments with respect to this element of claim 1 in the Preliminary Response. We find that at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that the teachings of Foti and Wright meet this limitation of claim 1 for the reasons explained by Petitioner.

g. Conclusion

We have reviewed the arguments and evidence and find that at this stage of the proceeding, on the present record, Petitioner sufficiently

establishes that the combination of Foti, RFC 3261, RFC 4566, RFC 2326, Wright, and Lloyd teaches or suggests all of the limitations of independent claim 1 for the reasons explained by Petitioner.

8. Independent Claim 21; Dependent Claims 2, 3, 6, 8, 10–12, 22, 24, and 25

With respect to independent claim 21, Petitioner largely relies on its analysis provided for claim 1. *See* Pet. 64–66. With respect to the last limitation in claim 21, modifying, using signaling in the composition session, all of the two or more sessions, Petitioner argues that it has shown that Foti and Wright teach or suggest terminating the SIP session. *Id*. at 65. Petitioner asserts that persons of ordinary skill in the art would have understood that terminating the two or more sessions is a form of modifying the sessions. *Id*. (citing Ex. 1003 ¶ 145). We concur with Petitioner's analysis, including how the '669 Patent describes terminating one or more sessions as being a type of modification of the composition session. *Id*. at 66 (citing Ex. 1001, 5:44–50). As such, we determine that Petitioner as sufficiently shown, for purposes of institution, that Foti, RFC 3261, RFC 4566, RFC 2326, Wright, and Lloyd teaches or suggests all of the limitations of independent claim 21.

We have also reviewed the Petition's discussion of dependent claims 2, 3, 6, 8, 10–12, 22, 24, and 25 with respect to the single ground of unpatentability (Pet. 51–63, 66–72) and we determine at this stage of the proceeding, on the present record, Petitioner sufficiently establishes that the combined teachings of Foti, RFC 3261, RFC 4566, RFC 2326, Wright, and Lloyd meet the limitations of those dependent claims for the reasons explained by Petitioner.

E. Discretion under 35 U.S.C. § 325(d)

Institution of *inter partes* review is discretionary. *See Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("[T]he PTO is permitted, but never compelled, to institute an IPR proceeding."); 35 U.S.C. § 314(a). Pursuant to 35 U.S.C. § 325(d), in determining whether to institute an *inter partes* review, "the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." In evaluating arguments under § 325(d), we use

> [a] two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential); *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) (listing factors (a)–(f) to consider in evaluating the applicability of § 325(d)).

Patent Owner contends that we should deny the Petition under § 325(d) because Petitioner relies on "the IETF RFC standards asserted in the Petition—RFC 3261, RFC 2326, and RFC 4566—[which] are substantially the same as the ETSI TISPAN TSs and the OMA Service Guide ["the Presented Art"] considered by the USPTO." Prelim. Resp. 30. Patent Owner asserts that the "Petition does not even attempt to explain how

the asserted IETF RFC standards are different from [the Presented Art] considered by the USPTO, much less show that the USPTO erred in evaluating the prior art." *Id*. Patent Owner continues that the cited RFCs discussed in the Petition are cumulative to the Presented Art considered during the original prosecution of the application that issued as the '669 Patent, citing exemplary points of overlap. *Id.* at 31–37.

Petitioner responds that "[a]ll references in Petitioner's combination are new references that were neither cited nor considered during prosecution." Pet. Prelim. Reply 1. Petitioner also responds that the examiner did not rely on the Presented Art, which were merely cited by the applicant, and also disputes Patent Owner's arguments that the Presented Art describes indispensable references of which persons of ordinary skill in the art would have been aware. *Id*. at 2–3. Petitioner also asserts that the references relied upon in the Petition are not cumulative to the Presented Art, and that Patent Owner's comparisons fail to consider the totality of the actual disclosures of the Presented Art. *Id*. at 3–5. Lastly, Petitioner asserts that even though we need not reach step two of *Advanced Bionics*, the Patent Office materially erred "because those claims are unpatentable for the reasons set forth in the Petition." *Id.* at 5.

Patent Owner responds that the Presented Art is substantially the same as the RFCs cited and applied in the Petition, again relying on its analysis provided in the Preliminary Response. PO Prelim. Sur-reply 2 (citing Prelim. Resp. 31–37). Patent Owner also argues that "Petitioner's response to these examples highlights the little to no material differences between the specific teachings." *Id.* at 4 (citing Pet. Prelim. Reply 4–5). Additionally, Patent Owner argues that Petitioner has failed to show the Examiner

materially erred in evaluating the Presented Art considered during prosecution. *Id.* at 5.

Under *Advanced Bionics*, *Becton Dickinson* factors (a), (b), and (d) are considered in the evaluation of whether the same or substantially the same art or arguments were previously presented to the Office. *Advanced Bionics*, Paper 6 at 10. *Becton, Dickinson* identifies these three factors as (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; and (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art. *Becton, Dickinson*, Paper 8 at 17–18.

Before we consider the initial factors, we address Patent Owner's implicit arguments, namely that "[i]f one considers the [Presented Art], they also take into account the IETF RFCs," and what one of ordinary skill in the art "would have been aware of" in considering the Presented Art. PO Prelim. Sur-reply 2. What an examiner may have been aware of, unless recorded in the prosecution history, cannot be easily discerned and cannot form a basis for determining if references considered during prosecution are materially the same or are cumulative over reference cited in a petition. An examiner's knowledge can be vast in his or her areas of expertise, and it would not be efficient to consider every reference an examiner considered but did not cite in our inquiry. In the instant case, we have no direct evidence that the examiner in the prosecution of the application that resulted the '669 Patent applied the Presented Art or any other networking standard. Impugning known to an examiner widens the scope of any inquiry too

broadly, where actual references to the prosecution history are finite and definite.

Turning to factor (a), we agree that there are similarities between the Presented Art and the RFC cited in the Petition. However, the analysis would be incomplete without consideration of Foti, Wright, and Lloyd. Patent Owner has not pointed out references considered during prosecution that are cumulative of those additional references. As such, the similarities between the total asserted art in the Petition and the prior art (the Presented Art) involved during examination are not as great had merely the RFC references been the only references applied in the Petition. Similarly, with respect to factor (b), even if the Presented Art and the cited RFCs were completely cumulative, which we do not necessarily find, the Presented Art when compared to the RFCs plus Foti, Wright, and Lloyd is not cumulative. With respect to factor (d), the arguments are different, given that there has been no assertion of equivalent references for Foti and Wright, which make up the bulk of the arguments made in the Petition.

Accordingly, we do not find that any of *Becton Dickinson* factors (a), (b), and (d) are met for Petitioner's challenge based on the combination of Foti, RFC 3261, RFC 4566, RFC 2326, Wright, and Lloyd, and we find that the ground of unpatentability does not rely upon the same or substantially the same prior art or arguments considered during examination of the '669 Patent. *Oticon Medical AB v. Cochlear Ltd.*, IPR2019-00975, Paper 15 at 20 (PTAB Oct. 16, 2019) (precedential) (declining to exercise discretion when new, noncumulative prior art was asserted in the Petition). Having failed the first prong under *Advanced Bionics*, we need not determine whether Petitioner has demonstrated that the Office erred in a manner material to the

patentability of challenged claims. We conclude that the circumstances presented here do not warrant our exercise of discretion to deny institution based on § 325(d).

III. CONCLUSION

For the foregoing reasons, Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that at least one claim of the '699 Patent is unpatentable.

IV. ORDER

Accordingly, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 1–3, 6, 8, 10–12, 21, 22, 24, and 25 of the '669 Patent on the following asserted grounds:

Claims 1–3, 6, 8, 10–12, 21, 22, 24, and 25 under 35 U.S.C. § 103(a) as unpatentable over Foti in view of RFC 3261, RFC 4566, RFC 2326, Wright, and Lloyd; and

FURTHER ORDERED that 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, the trial commencing on the entry date of this Decision.

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