

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

KONINKLIJKE KPN N.V.,
Patent Owner.

Case IPR2023-00581
Patent 8,886,772

**PATENT OWNER'S REQUEST FOR REHEARING OF DECISION
GRANTING INSTITUTION OF *INTER PARTES* REVIEW**

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Other Authorities

37 C.F.R. § 42.71.....	1, 3, 12
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PATENT OWNER’S EXHIBIT LIST

Exhibit	Description
2001	Declaration of Mr. Regis J. (Bud) Bates, Jr. in Support of Patent Owner
2002	Curriculum Vitae of Regis J. (Bud) Bates, Jr.
2003	U.S. Patent No. 9,838,256 (“the Child ’256 Patent”)
2004	U.S. Patent No. 8,089,953 (“Angelot Patent”)
2005	First Amended Docket Control Order in <i>Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson</i> , 22-cv-00282 (E.D. Tex.) (D.I. 101)
2006	United States District Courts – National Judicial Caseload Profile, https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile0331.2023.pdf
2007	Docket Sheet for <i>Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson</i> , 22-cv-00282 (E.D. Tex.)
2008	Ericsson’s P.R. 3-3 Invalidity Contentions in <i>Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson</i> , 22-cv-00282 (E.D. Tex.)

Patent Owner Koninklijke KPN N.V. (“KPN”) requests rehearing under 37 C.F.R. § 42.71(d) of the Board’s Decision Granting Institution of *Inter Partes* Review of Claims 2-6, 11, 14, and 16 of U.S. Patent No. 8,886,772 (EX1001, “the ’772 Patent”), entered on September 7, 2023. Paper 8 (“ID”). This Request is timely filed within 14 days of the entry of the Decision Granting Institution of *Inter Partes* Review.

I. INTRODUCTION

In the Institution Decision, the Board found that “on this record, Petitioner does not show sufficiently that Angelot discloses the limitations of claim 3” and that finding also applied to Claims 4-6, which depend from Claim 3. ID, 25-26. Although the Board found that Petitioner Ericsson Inc. (“Ericsson”) had not demonstrated a reasonable likelihood that Claims 3-6 are unpatentable, the Board instituted trial based on Claim 2. *Id.* at 21-24, 26-29.

The Board found that Ericsson showed sufficiently that Angelot disclosed the limitations of disclaimed Claim 1. *Id.* at 17-21. With respect to “identify an ACS from the plurality of ACSs in accordance with the identification of manageable electronic device to provide configuration data to the manageable electronic device” recited in Claim 1—identified by the Petition as part of limitation [1g]—the Board stated that “Patent Owner does not dispute that Angelot discloses this limitation.” *Id.* at 20; Paper 1 (“Pet.”), 34.

But the Board’s statement that KPN “does not dispute that Angelot discloses” limitation [1g] is incorrect. KPN’s Preliminary Response expressly disputed that Angelot disclosed, taught, or suggested “identify an ACS from the plurality of ACSs in accordance with the identification of manageable electronic device to provide configuration data to the manageable electronic device,” supported by testimony from its expert witness Regis J. Bates. Paper 5 (“POPR”), 6, 61-63; EX2001 (“BatesDec”), ¶¶159-162. The Board misapprehended and overlooked KPN’s evidence and argument that Angelot does not disclose, teach, or suggest limitation [1g].

In the Petition, Ericsson alleged that Angelot’s disclosure of how “central server 14 processes the request to determine ... which of the plurality of service providers 18a, 18b, 18c the MAC address belongs to,” EX1006, ¶[0054], discloses “identify an ACS from the plurality of ACSs in accordance with the identification of the manageable electronic device to provide configuration data to the manageable electronic device” recited in limitation [1g]. Pet., 38.

That is wrong. As KPN argued in the Preliminary Response, identifying a service provider does not satisfy limitation [1g] under Ericsson’s mapping of Claim 1 for at least the reason that, “if a request is redirected to ‘service provider 18a,’ which of the five ‘configuration servers’ shown in FIG. 3a receives the request?” POPR, 62. To satisfy Ericsson’s mapping, there would need to be a further step to identify a configuration server, which as KPN explained in the Preliminary

Response, is “undisclosed” in Angelot. *Id.* at 63.

Because each of Claims 2-6, 11, 14, and 16 recite limitation [1g], the Petition’s failure to show that Angelot discloses, teaches, or suggests limitation [1g] is a reason to deny institution.

Both Mr. Bates’ testimony in his declaration and KPN’s argument in the Preliminary Response that Angelot does not disclose, teach, or suggest limitation [1g] support denial of institution. The Board should grant rehearing, consider Mr. Bates’ testimony and KPN’s argument regarding the lack of limitation [1g], and deny institution of *inter partes* review of Claims 2-6, 11, 14, and 16.

II. STANDARD OF REVIEW

The applicable standard for a request for rehearing provides in relevant part:

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.

37 C.F.R. § 42.71(d).

KPN argued expressly and specifically in its Preliminary Response that Angelot does not disclose, teach, or suggest “identify an ACS from the plurality of ACSs in accordance with the identification of manageable electronic device to provide

configuration data to the manageable electronic device” recited in limitation [1g]. POPR, 6, 61-63. KPN’s argument regarding the lack of limitation [1g] was supported by Mr. Bates’ testimony. BatesDec, ¶¶159-162.

The Board misapprehended and overlooked KPN’s express and specific argument that Angelot does not disclose, teach, or suggest limitation [1g]. Instead of considering Mr. Bates’ testimony and KPN’s argument regarding the lack of limitation [1g], the Board stated that “Patent Owner does not dispute that Angelot discloses this limitation of claim 1.” ID, 20.

III. THE BOARD SHOULD DENY INSTITUTION BECAUSE ANGELOT DOES NOT DISCLOSE, TEACH, OR SUGGEST LIMITATION [1G], WHICH IS RECITED IN CLAIMS 2-6, 11, 14, AND 16

In its mapping of disclaimed Claim 1, Ericsson cited Angelot’s disclosure in ¶[0054] of how its “central server 14 processes the request to determine ... which of the plurality of service providers 18a, 18b, 18c the MAC address belongs to,” EX1006, ¶[0054], as disclosing “identify an ACS from the plurality of ACSs in accordance with the identification of the manageable electronic device to provide configuration data to the manageable electronic device” recited in limitation [1g]. Pet., 38. All of Ericsson’s grounds in the Petition rely on its argument that Angelot

¶[0054] discloses limitation [1g]. Pet., 38, 51-55 (Ground 1); *id.* at 55-56 (Ground 2), *id.* at 67 (Ground 3).

KPN argued in the Preliminary Response that ¶[0054] of Angelot does not disclose, teach, or suggest limitation [1g] because—per Ericsson’s mapping of Claim 1—the service providers of Angelot are not “ACSs” recited in Claim 1; Ericsson asserted instead that Angelot’s configuration servers are the recited “ACSs.” POPR, 6, 61-63 (citing BatesDec ¶¶159-162). Further, KPN argued in the Preliminary Response that “a ‘service provider’ cannot be equated with a ‘configuration sever’ in Angelot, something made clear by Fig. 3a, which shows that a ‘service provider’ may host multiple ‘configuration servers.’” POPR, 6; *see also id.* at 61-63 (citing BatesDec ¶¶159-162).

As KPN argued in the Preliminary Response, identifying a service provider does not satisfy limitation [1g] under Ericsson’s mapping of Claim 1 because, “if a request is redirected to ‘service provider 18a,’ which of the five ‘configuration servers’ shown in FIG. 3a receives the request?” POPR, 62. To satisfy Ericsson’s mapping, there would need to be a further step to identify a configuration server,

which as KPN explained in the Preliminary Response, is “undisclosed” in Angelot. *Id.* at 63.

Because each of Claims 2-6, 11, 14, and 16 recite limitation [1g], the Petition’s failure to show that Angelot discloses, teaches, or suggests limitation [1g] is a reason to deny institution.

A. The Board Misapprehended and Overlooked that Angelot Does Not Disclose, Teach, or Suggest Limitation [1g]

In the Institution Decision, the Board found that Ericsson had not demonstrated a reasonable likelihood that Claims 3-6 are unpatentable, but the Board instituted trial based on Claim 2. *ID*, 25-26, 21-24, 26-29.

In addressing Claim 2, the Board considered whether Angelot disclosed the limitations of disclaimed Claim 1, as asserted by Ericsson. *Id.* at 17-21. With respect to limitation [1g], the Board stated that “Patent Owner does not dispute that Angelot discloses this limitation:”

Claim 1 recites ‘wherein the ACSMD is configured, responsive to receiving the request, to: . . . identify an ACS from the plurality of ACSs in accordance with the identification of the manageable electronic device to provide configuration data to the manageable electronic device.’ Ex. 1001, 10:5–8. Petitioner presents evidence that Angelot’s central server identifies a configuration server from the plurality of configuration servers in accordance with the network entity’s MAC address. Pet. 36–38 (citing Ex. 1006 ¶¶ 23, 52, 54, Fig. 3a). Patent Owner does not dispute

that Angelot discloses this limitation of claim 1. On this record, Petitioner shows sufficiently that Angelot discloses this limitation of claim 1.

Id. at 20.

But the Board’s statement that KPN “does not dispute Angelot discloses” limitation [1g] is incorrect: KPN expressly and specifically disputed that Angelot disclosed, taught, or suggested limitation [1g] with evidence and argument. POPR, 6, 61-63 (citing BatesDec ¶¶159-162). In this regard, the Board misapprehended and overlooked Mr. Bates’ testimony and KPN’s argument that Angelot does not disclose, teach, or suggest limitation [1g]. The Board stated that “Patent Owner does not dispute that Angelot discloses” limitation [1g], without considering Mr. Bates’ testimony in his declaration or KPN’s argument in the Preliminary Response that Angelot does not disclose, teach, or suggest limitation [1g]. *ID*, 20.

The Board should grant rehearing and deny institution.

B. Mr. Bates’ Testimony that Angelot Does Not Disclose, Teach, or Suggest Limitation [1g] Supports Denial of Institution

Mr. Bates’ testimony in his declaration regarding the lack of limitation [1g] that the Board misapprehended and overlooked was at ¶¶159-162 (emphases in original):

XII. ALL GROUNDS: ANGELOT DOES NOT DISCLOSE, TEACH, OR SUGGEST LIMITATION [1G], WHICH IS RECITED IN CLAIMS 2-6, 11, 14, AND 16

159. I note that each of ‘service provider[s] 18a and 18b’ are shown in FIG. 3a to include multiple ‘configuration servers.’ EX1006, Fig. 3a. Paragraph [0054] of Angelot teaches:

Upon receipt of the request, the central server 14 processes the request to determine whether the first mapping table comprises the unique MAC address associated with the request, and also determines which of the plurality of service providers 18a, 18b, 18c the MAC address belongs to. Once such a determination has been established, the central server 14 then redirects the request to an appropriate **service provider** 18a, 18b or 18c, as per first mapping table (**step 114**).

EX1006, ¶[0054] (emphasis added.)

160. In my opinion, the multiple ‘configuration servers’ shown in Figure 3a along with redirection of the request to ‘an appropriate **service provider** 18a, 18b or 18c’ disclosed in paragraph [0054] indicates that there is more to determining the ‘appropriate configuration server’ than finding the MAC address in the ‘first mapping table.’ For example, if a request is redirected to ‘service provider 18a,’ Angelot does not disclose which of the five ‘configuration servers’ shown in FIG. 3a receives the request or how that would be determined.

161. Adopting, *arguendo*, Petitioner’s interpretation of the ‘configuration server’ in Angelot as the ‘ACS’ of Claims 2-6, 11, 14, and 16 (Pet., 25), in my opinion, there is at least an ambiguity as to whether Angelot actually teaches ‘identify an ACS from the plurality of ACSs in accordance with the identification of manageable electronic device to provide configuration data to the manageable device.’

162. For example, if Angelot can be interpreted as teaching ‘identify [**a service provider**] from the plurality of [**service providers**] in accordance with the identification of manageable electronic device to provide configuration data to the manageable device,’ if the identified ‘service provider’ is ‘service provider 18a,’ then, according to FIG. 3a, an extra, undisclosed step would be required to further identify a ‘configuration server’ from among the five configuration servers in the ‘first mapping table.’

BatesDec, ¶¶159-162.

As Mr. Bates testified, Ericsson has failed to show that Angelot discloses, teaches, or suggests limitation [1g], and therefore Ericsson has failed to establish a reasonable likelihood that Claims 2-6, 11, 14, and 16 are unpatentable. Accordingly, the Board should deny the Petition and not institute trial.

C. KPN’s Argument in the Preliminary Response That Angelot Does Not Disclose, Teach, or Suggest Limitation [1g] Supports Denial of Institution

KPN’s argument regarding the lack of limitation [1g] that the Board misapprehended and overlooked was in two portions of the Preliminary Response. First, page 6 of the Preliminary Response included an introduction to KPN’s argument that Angelot does not disclose, teach, or suggest limitation [1g] (emphases in original):

Further, with respect to Claims 2-6, 11, 14, and 16 and all of Petitioner’s grounds, Angelot does not teach or suggest ‘identify an ACS from the plurality of ACSs in accordance with the identification of the manageable electronic device.’ In view of ¶[0054], Angelot might be

interpreted as teaching at most to ‘identify [***a service provider***] from the plurality of [***service providers***] in accordance with the identification of the manageable electronic device.’ But a ‘service provider’ cannot be equated with a ‘configuration server’ in Angelot, something made clear by Fig. 3a, which shows that a ‘service provider’ may host multiple ‘configuration servers.’ Thus, Petitioner’s interpretation of the ‘configuration server’ in Angelot as the ‘ACS’ of Claims 2-6, 11, 14, and 16 fails to align Angelot’s teaching with ‘identify an ACS from the plurality of ACSs in accordance with the identification of the manageable electronic device.’

POPR, 6.

Second, pages 61-63 of the Preliminary Response included KPN’s argument that Angelot does not disclose, teach, or suggest limitation [1g], with citations to ¶¶159-162 of Mr. Bates’ Declaration (emphases in original):

IX. ALL GROUNDS: ANGELOT DOES NOT DISCLOSE, TEACH, OR SUGGEST LIMITATION [1G], WHICH IS RECITED IN CLAIMS 2-6, 11, 14, AND 16

Referring again to the summary above, Angelot teaches:

Upon receipt of the request, the central server 14 processes the request to determine whether the first mapping table comprises the unique MAC address associated with the request, and also determines which of the plurality of service providers 18a, 18b, 18c the MAC address belongs to. Once such a determination has been established, the central server 14 then redirects the request to an appropriate ***service provider*** 18a, 18b or 18c, as per first mapping table (***step 114***).

EX1006, ¶[0054] (emphasis added).

‘[S]tep 114’ in FIG. 2, however, reads ‘Redirect request to appropriate **configuration server** 20a.’ *Id.* Fig. 2 (emphasis added). While this apparent interchangeable use of ‘service provider’ and ‘configuration server’ might at first seem inconsequential, consideration of FIG. 3a strongly suggests otherwise.

In particular, each of ‘service provider[s] 18a and 18b’ are shown in FIG. 3a to include multiple ‘configuration servers.’ EX1006, Fig. 3a. This fact, together with the redirection of the request to ‘an appropriate **service provider** 18a, 18b or 18c’ disclosed in ¶[0054] indicates that there is more to determining the ‘appropriate configuration server’ than finding the MAC address in the ‘first mapping table.’ BatesDec, ¶¶159-160. For example, if a request is redirected to ‘service provider 18a,’ which of the five ‘configuration servers’ shown in FIG. 3a receives the request?

Adopting, *arguendo*, Petitioner’s interpretation of the ‘configuration server’ in Angelot as the ‘ACS’ of Claims 2-6, 11, 14, and 16 (Pet., 25), there is at least an ambiguity as to whether Angelot actually teaches ‘identify an ACS from the plurality of ACSs in accordance with the identification of manageable electronic device.’ BatesDec, ¶161. That is, on the basis of ¶[0054], Angelot at most might be interpreted as teaching ‘identify [**a service provider**] from the plurality of [**service providers**] in accordance with the identification of manageable electronic device.’ If the identified ‘service provider’ happens to be ‘service provider 18a,’ then, according to FIG. 3a, an extra, undisclosed step appears to be required to further identify a ‘configuration server’ from among the five configuration servers in the ‘first mapping table.’ BatesDec, ¶162. With or without the extra, undisclosed step, this fails to teach limitation [1g]: ‘identify an ACS

from the plurality of ACSs in accordance with the identification of manageable electronic device to provide configuration data to the manageable device.’

POPR, 61-63 (citing BatesDec, ¶¶159-162).

As KPN argued in the Preliminary Response, Ericsson has failed to show that Angelot discloses, teaches, or suggests limitation [1g], and therefore Ericsson has failed to establish a reasonable likelihood that Claims 2-6, 11, 14, and 16 are unpatentable. Accordingly, the Board should deny the Petition and not institute trial.

IV. CONCLUSION

For the foregoing reasons, KPN requests rehearing under 37 C.F.R. § 42.71(d) and denial of institution of *inter partes* review of Claims 2-6, 11, 14, and 16 of the ’772 Patent.

Dated: September 21, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on September 21, 2023 the foregoing Request for Rehearing of Decision Granting Institution of *Inter Partes* Review is being served electronically by agreement of the parties, by email to the following counsel of record.

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