

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. and NOKIA OF AMERICA CORP.,
Petitioners,

v.

ACTIVE WIRELESS TECHNOLOGIES LLC,
Patent Owner.

IPR2024-00886
Patent 11,019,557 B2

Before MONICA S. ULLAGADDI, DAVID COTTA, and
JASON M. REPKO, *Administrative Patent Judges*.

ULLAGADDI, *Administrative Patent Judge*.

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

I. INTRODUCTION

Ericsson Inc. and Nokia of America Corp. (collectively “Petitioner”) filed a Petition to institute an *inter partes* review (“IPR”) of claims 9–16 (the “challenged claims”) of U.S. Patent No. 11,019,557 B2 (Ex. 1001, “the ’557 patent”). Paper 1 (“Petition” or “Pet.”). Active Wireless Technologies LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). We deny the Petition on a discretionary basis as requested by Patent Owner. Thus, for reasons explained below, we do not institute *inter partes* review of claims 9–16 of the ’557 patent.

A. *Real Parties-in-Interest*

Petitioner identifies Ericsson Inc., Telefonaktiebolaget LM Ericsson, and Nokia of America Corporation as the real parties-in-interest. Pet. 64. Petitioner also identifies T-Mobile USA, Inc., and Cellco Partnership d/b/a Verizon Wireless as real parties in interest because “one or both of the Petitioners have intervened in the Related Matters identified below due to their use of Petitioners’ products being accused of infringement.” *Id.* Patent Owner identifies itself, Active Wireless Technologies LLC as the real party-in-interest. Paper 6, 2.

B. *Related Matters*

The parties identify as a related matter the following lawsuits involving the ’557 patent (and other patents): *Active Wireless Technologies LLC v. T-Mobile USA, Inc., et al.*, Case No. 2:23-cv-00261 (E.D. Tex.) (“the Related Litigation”) and *Active Wireless Technologies LLC v. Verizon*

Communications, Inc., et al., Case No. 2:23-cv-00620 (E.D. Tex.).¹ Pet. 64–65; Paper 6, 2.

C. The '557 Patent

The '557 patent is titled “Apparatus and Method for Acquisition of Periodically Broadcasted System Information in Wireless Communication.” Ex. 1001, code (54). More particularly, the '557 patent describes communication between a user equipment (UE) and a base station in a radio access network (RAN) to acquire “a first type system information block (SIB) acquisition process to receive a first type SIB,” in which “[t]he first type SIB comprises scheduling information of a second type SI message.” *Id.* at code (57). According to the '557 patent, “the second type SI message compris[es] at least one system information block (SIB)” and “an indication of broadcast status for the second type SI message, the indication indicating broadcasting.” *Id.*

Figure 3 of the '557 patent depicts a

wireless terminal acquiring, e.g., receiving, the Minimum SI [system information] that is broadcasted from the currently serving access node, e.g., access node 22 . . . The Minimum SI may contain information about the Other SI, including the delivery method, e.g., periodic broadcast/on-demand, scheduling information, validity information, etc. Based on the information, the wireless terminal in act 3-2 may determine which SI message(s) to acquire by on-demand. As act 3-3, the wireless terminal may send a request message (depicted as message 2-2 of FIG. 2) to the access node, the request message indicating the SI message(s) that the wireless terminal desires to obtain. As act

¹ Because the Docket Control Order for Case No. 2:23-cv-00620 is not of record, and because the parties assert that the earliest scheduled trial date is for Case No. 2:23-cv-00261, we focus our *Fintiv* analysis on Case No. 2:23-cv-00261.

3-4 the wireless terminal 26 may attempt to receive the requested SI message(s) which, e.g., was sent using message 2-3 of FIG. 2.

Ex. 1001, 9:7–25. According to the '557 patent,

FIG. 13A is an exemplary format of SIB 1, which is based on the format shown in FIG. 7 with an additional information element si-MaxAcqAttempts. The information element si-MaxAcqAttempts provides a termination condition for the SI reception procedure, indicating the maximum number of SI message reception opportunities (e.g. SI windows) allowed before the end of the SI reception procedure. FIG. 13B is an alternative format of SIB1, wherein the information element ue-TimersAndConstants includes a timer configuration (T#x) to be used as a termination condition for the SI reception procedure.

Id. at 14:55–65.

D. Challenged Claims

Of challenged claims 9–16 of the '557 patent, claims 9 and 13 are independent. Claim 9 is illustrative of the subject matter of the challenged claims and is reproduced below.²

9. **[preamble]** A base station apparatus of a radio access network (RAN) that communicates over a radio interface with a user equipment, the base station apparatus comprising:

[9.1] transmitting circuitry configured to transmit a first type system information block (SIB), the first type SIB comprising:

[9.2] scheduling information of a system information (SI) message, the SI message comprising at least one second type SIB, the scheduling information configuring SI windows, the SI windows comprising periodically occurring time windows in which the SI message is transmitted;

² Claim 13 is similar to claim 9, but is directed to “[a] method for a base station apparatus of a radio access network (RAN) that communicates over a radio interface with a user equipment” rather than to “[a] base station.” The parties focus their argument on claim 9. Accordingly, we do the same.

[9.3] a parameter associated with a condition for determination of a failure of an SI message acquisition process; and

[9.4] an indication of broadcast status for the SI message, the indication indicating broadcasting; and

[9.5] processor circuitry configured to cause the transmitting circuitry to broadcast the SI message; wherein:

[9.6] the first type SIB is re-acquired by the user equipment upon the user equipment failing on the SI message acquisition process in at least one of the SI windows to receive the SI message,

[9.7] the base station apparatus is a current serving access node of the user equipment.

Ex. 1001, 34:27–50 (bracketing added for reference).

E. Asserted Grounds of Unpatentability

Petitioner asserts that claims 9–16 would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. § ³	Reference(s)/Basis
9–16	103	Ingale ⁴
9–16	103	Ingale, Jung ⁵

Petitioner relies on the declaration of Dr. Mark P. Mahon (Ex. 1003) among other evidence.

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102, 103 effective March 16, 2013. The earliest date to which ’557 patent claims priority is May 20, 2018. Ex. 1001, code (60). As that date falls after the effective date of the applicable AIA amendments, we apply the AIA versions of §§ 102 and 103 here.

⁴ WO 2018/016922 A1 to Ingale et. al., published Jan. 25, 2018 (Ex. 1004, “Ingale”).

⁵ U.S. Patent Publication No. 2015/0223258 A2 to Jung et al., published Aug. 6, 2015 (Ex. 1005, “Jung”).

II. EXERCISE OF DISCRETION

Institution of an *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018).

In the Preliminary Response, Patent Owner contends that we should exercise our discretion to deny the Petition because the Related Litigation will likely to be completed several months before a Final Written Decision in this proceeding. Prelim. Resp. 15–22.

When determining whether to exercise discretion to deny institution in view of a parallel proceeding, we consider the following factors:

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.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* In evaluating these factors, we “take[] a holistic view of whether efficiency and integrity

of the system are best served by denying or instituting review.” *Id.* at 6. We consider each of these factors below.

On June 21, 2022, the Director of the United States Patent and Trademark Office issued a Memorandum setting forth an “Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation” (“Guidance Memo”).⁶ The Guidance Memo states that “to benefit the patent system and the public good, the PTAB will not rely on the *Fintiv* factors to discretionarily deny institution in view of parallel district court litigation where a petition presents compelling evidence of unpatentability.” Guidance Memo 2. “[C]ompelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” *Id.* at 4.

With these *Fintiv* factors and the Director’s guidance in mind, we consider the parties’ contentions.

In the analysis that follows, we first consider whether *Fintiv* factors 1–5 weigh in favor of exercising our discretion to deny institution. For the reasons discussed below, we conclude that *Fintiv* factors 1–5 weigh in favor of denying institution. Because *Fintiv* factors 1–5 favor denial of institution, we must also determine whether the Petition presents compelling merits. *See CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 5 (PTAB Feb. 27, 2023) (precedential) (“In circumstances where . . . the

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https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621.pdf

Board’s analysis of *Fintiv* factors 1–5 favors denial of institution, the Board shall then assess compelling merits.”).

A. Likelihood of a Stay (Factor 1)

Fintiv factor 1 recognizes that a stay of litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts, which strongly weighs against exercising the authority to deny institution. *Fintiv*, Paper 11 at 6.

Petitioner argues that this factor is neutral, asserting that “no request for stay has been filed.” Pet. 61. Patent Owner asserts that “the Court has already denied a stay pending this Petition.” Prelim. Resp. 16–17 (citing Prelim. Resp. § VII.E). Both parties paint a somewhat incomplete picture of what has transpired in the Related Litigation with respect to a stay. In fact, Judge Gilstrap denied Petitioner’s Motion to Stay without prejudice on the basis that it was premature. Ex. 3001. Judge Gilstrap’s decision expressly permits Petitioner leave to refile its Motion “within fourteen (14) days following the Board’s last institution decision.” *Id.* at 3. Accordingly, the possibility of a stay remains open.

We decline to speculate on how the court may rule on a future motion for a stay should one be filed. Accordingly, this factor is neutral. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (explaining that factor 1 generally “does not weigh for or against discretionary denial” when neither party has requested a stay).

B. Proximity of Trial Date to Projected Deadline (Factor 2)

Fintiv factor 2 looks to the “proximity of the court’s trial date to the Board’s projected statutory deadline.” *Fintiv*, Paper 11 at 9. The Board’s projected statutory deadline for reaching a final written decision in this

matter is in November of 2025. The earliest scheduled trial date in the Related Litigation is March 17, 2025. Ex. 2001, 1.⁷ Because the scheduled trial date substantially predates the expected date of our final written decision, this factor weighs in favor of denial. *See e.g., Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, 13 (PTAB May 13, 2020) (informative) (“Because the currently scheduled District Court trial is scheduled to begin two months before our deadline to reach a final decision, this factor weighs somewhat in favor of discretionary denial in this case.”); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7 at 6–13 (PTAB Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7 at 7–10 (PTAB Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude).

C. Investment in the Parallel Proceeding (Factor 3)

Fintiv factor 3 considers the “investment in the parallel proceeding by the court and parties,” including “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. For example, if, at the time of institution, the court in the parallel proceeding has issued “substantive orders related to the patent at issue in the petition” or “claim construction orders” this favors denial. *Id.* at 9–10.

⁷ Neither party introduces evidence of current median time to trial statistics for the Eastern District of Texas.

Petitioner asserts in its Petition that “the Related Litigations are in their early stages, and the investment in them has been minimal at this time.” Pet. 62. In addition, Petitioner asserts that it “diligently prepared this Petition and filed well in advance of the statutory deadline, which weighs further against denying institution.” *Id.* Thus, according to Petitioner, “[f]actor 3 heavily favors institution.” *Id.*

Patent Owner responds that “[t]he parties have already exchanged infringement contentions . . . and claim construction briefing is underway. Prelim. Resp. 20 (citing Ex. 2001). According to Patent Owner, the district court has already issued several orders, and “[d]iscovery is . . . well underway.” *Id.* Patent Owner, thus, asserts that “the parties’ and Court’s substantial investment in this proceeding weighs in favor of denial of institution.” *Id.*

We agree with Patent Owner that the existing investment by the parties and the court in the Related Litigation has been substantial. Fact discovery in the Related Litigation has closed and expert discovery will conclude soon. Ex. 2001 (Docket Control Order listing the deadline for completion of fact discovery as October 11 and the deadline for completion of expert discovery as December 4). In addition, the deadline for filing dispositive motions and *Daubert* motions is approaching. *Id.* (listing the deadline for filing such motions as December 9, 2024). Although work remains in the lead-up to trial before the district court, we find that this factor favors exercising our discretion to deny institution.

Petitioner’s argument that its diligence weighs in favor of institution is weak. Petitioner does not explain how it was diligent or even identify the time period during which it contends it was diligent. For example, Petitioner does not present argument or evidence on whether it was diligent from: 1)

the date suit was filed against its customer; 2) the date it received notice of such suit; 3) the date it moved to intervene in the suit against its customer; 4) the date it received infringement contentions; or 5) some other date. Absent argument or evidence supporting Petitioner’s diligence, we are not persuaded that filing the Petition “in advance of the statutory deadline” weighs in favor of institution.

D. Overlap of Issues (Factor 4)

Fintiv Factor 4 considers whether “the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.” *Fintiv*, Paper 11 at 12. If the issues in the Petition overlap substantially with those raised in the parallel proceeding, “this fact has favored denial.” *Id.* “Conversely, if the petition includes materially different grounds, arguments, and/or evidence . . . this fact has tended to weigh against exercising discretion to deny institution.” *Id.* at 12–13.

Here, Petitioner stipulates that it “will not pursue invalidity against the asserted claims in the district court using the specific combination of prior art references set forth in the grounds presented in this Petition for purposes of establishing obviousness.” Pet. 63 (citing *Sand Revolution II LLC v. Continental Intermodal Group-Trucking LLC*, IPR2019-01393, Paper 24 at 11–12 (PTAB June 16, 2020)).

Patent Owner asserts that the same claims are at issue in this proceeding as in the Related Litigation and that institution would “duplicate effort” and be an “inefficient use of Board, party, and judicial resources.” Prelim. Resp. 18 (citing *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (PTAB May 15, 2020)). Patent Owner also

asserts that institution would “raise[] the possibility of conflicting decisions.” *Id.* Additionally, Patent Owner asserts that an IPR, if instituted, “would only cover 2 out of at least 9 combinations of obviousness that Petitioner has raised in the District Court Litigation, and do not include Petitioner’s challenges under § 101, § 102, or § 112.” *Id.* at 21 (citing-in-part Ex. 2002, 13, 15, 20–21, 26, 28–29, 40–52, 89–90, 92).

The Board’s informative decision in *Sand Revolution II, LLC v. Continental Intermodal Group–Trucking LLC* expressed skepticism that stipulations like that at issue here achieve the goals of avoiding duplication and inconsistent decisions:

Petitioner *could have stipulated* that it would not pursue any ground raised or that *could have been reasonably raised* in an IPR, i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patents or printed publications. *A broader stipulation of that nature, not at issue here, might better address concerns regarding duplicative efforts and potentially conflicting decisions in a much more substantial way.* Likewise, such a stipulation might help ensure that an IPR functions as a true alternative to litigation in relation to grounds that could be at issue in an IPR. Further still, Petitioner could have expressly waived in the district court any overlapping patentability/invalidity defenses. Doing so might have tipped this factor more conclusively in its favor.

IPR2019-01393, Paper 24 at 12 n.5 (PTAB June 16, 2020) (informative) (emphasis added). The Board in *Sand Revolution* accorded a stipulation not containing the “could have reasonably raised” provision “marginal[]” weight. *Id.* at 12.

Petitioner’s stipulation does reduce somewhat the overlap relating to the challenge presented in the Petition, but not as fully as would a *Sotera*-type stipulation. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential) (addressing a

stipulation to not pursue in court any grounds raised or that reasonably could have been raised in the IPR); Guidance Memo, 7–8 (explaining that institution will not be discretionarily denied due to parallel litigation where a *Sotera*-type stipulation is made). If we grant institution in IPR, the Board may well end up reconsidering claims whose validity was previously tried before the district court. Thus, while Petitioner’s stipulation “mitigates to some degree the concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions” (*Sand Revolution*, Paper 24 at 12), it does not remove them. In addition, Petitioner’s stipulation does not preclude Petitioner from relying on the same prior art in different combinations. Accordingly, consistent with the decision in *Sand Revolution* we find that Petitioner’s stipulation weighs only marginally against discretionary denial. IPR2019-01393, Paper 24 at 12 (determining that stipulation similar to that here weighed “marginally” against discretionary denial).

Overall, we find that this factor weighs marginally against exercising our discretion to deny institution.

E. Identity of Parties (Factor 5)

Petitioner is an intervenor/defendant in the Related Litigation. Pet. 63. To the extent that trial in the district court may precede the deadline for a final written decision in this proceeding, this factor favors exercising our discretion to deny institution. *Huawei Tech. Co. v. WSOU Inv., LLC*, IPR2021-00225, Paper 11 at 14 (PTAB June 14, 2021) (finding that “this factor favors denial if trial precedes the Board’s Final Written Decision and favors institution if the opposite is true”) (internal quotation marks omitted); *Google LLC v. Parus Holdings, Inc.*, IPR2020-00846, Paper 9 at 21 (PTAB

Oct. 21, 2020) (“Here, . . . Petitioner is the defendant in the parallel proceeding. This fact could weigh either in favor of, or against, exercising discretion to deny institution, depending on which tribunal was likely to address the challenged patent first.”). As discussed *supra*, trial in the district court is likely to precede our final written decision. Accordingly, this factor weighs in favor of exercising our discretion to deny institution.

F. Other Circumstances Including the Merits (Factor 6)

We take “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review” when evaluating these factors. *Fintiv*, Paper 11 at 6. We have considered the circumstances and facts before us in view of *Fintiv* Factors 1–5. As discussed above, Factor 1 is neutral, Factors 2, 3, and 5 weigh in favor of discretionary denial of institution, and Factor 4 weighs marginally against discretionary denial. On balance, we conclude that the evidence of record on Factors 1–5 favors exercising our discretion to deny institution of an *inter partes* review.

Following *CommScope*, where, as here, our analysis of the first five *Fintiv* Factors favors denial of institution, we address the merits of the Petition to determine whether, on this preliminary record, the merits are compelling. *CommScope*, Paper 23 at 4–5; Guidance Memo 3–5.

III. COMPELLING MERITS ANALYSIS

A. Legal Principles

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3)).

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed invention and the prior art are such that the claimed invention would have been obvious at the time the invention was made to a person having ordinary skill in the relevant art. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective indicia of nonobviousness when presented. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Moreover, “[a]n obviousness determination requires finding both that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.” *CRFD Rsch., Inc. v. Matal*, 876 F.3d 1330, 1340 (Fed. Cir. 2017) (internal quotation marks omitted).

B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art (“POSA” or “POSITA”) would have been “familiar with wireless communications networks, equipment, and integrated circuit chips, and would have had at least a working knowledge of communication protocols used in LTE and 5G radio access networks (‘RAN’).” Pet. 9. According to Petitioner, a POSA would have “at least a Bachelor’s degree in Electrical Engineering or a related field, and at least two years of work experience in design, development, and/or testing wireless telecommunication systems” as well as “familiarity with the wireless standards and protocols related to data transmission and network management.” *Id.* Petitioner further contends that, “[t]o the extent a POSITA would have had a more advanced degree, such as

a Master’s degree in Electrical Engineering or related field, then a POSITA may have had less work experience.” *Id.* at 9–10 (citing Ex. 1003 ¶¶ 37–39).

At this stage in the proceeding, Patent Owner does not contest Petitioner’s definition of the POSA. Prelim. Resp. 6–7 (“For purposes of this Preliminary Response only, Patent Owner utilizes Petitioner’s proposed level of skill in the art.”).

Petitioner’s description of a POSITA appears consistent with the subject matter of the ’557 patent and with the prior art of record, we apply it for purposes of this Decision. *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).

C. Claim Construction

We interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2020). Under this standard, we construe the 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.” *Id.*

Petitioner proposes that, for purposes of this proceeding, “each claim term be given its plain and ordinary meaning.” Pet. 9. Petitioner asserts that “[t]he prior art herein meets each claim limitation under any reasonable construction.” *Id.* At this stage in the proceeding, Patent Owner does not identify any claim terms as needing construction. Prelim. Resp. 6 (citing Pet. 9) (“For purposes of this Preliminary Response, Patent Owner agrees with Petitioner that ‘each claim term be given its plain and ordinary meaning.’”).

Absent any apparent dispute between the parties as to how the claims should be construed, we do not find it necessary to construe the claims at

this stage of the proceeding. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 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))); *Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘to the extent necessary to resolve the controversy’”).

D. Overview of the Asserted Prior Art

1. Ingale (Ex. 1004)

Ingale concerns a method and system for system information acquisition in wireless communication system. Ex. 1004, code (54). More particularly, Ingale “disclose[s] a method for provisioning system information (SI) for a user equipment (UE) in a wireless communication system.” *Id.* ¶ 40. According to Ingale, the method includes

transmitting a broadcast channel to at least one user equipment (UE) in a wireless communication system, wherein the broadcast channel periodically transmits first system information comprising at least a first master information block (MIB) and a second master information block; providing second system information to at least one user equipment in the wireless communication system based on at least one of a periodic broadcast and an on-demand basis, wherein the on-demand delivery of at least one system information block of the second system information is based on system information request procedure triggered by at least one user equipment, and the on-demand basis to deliver the system information block of the second system information available in the camped cell is decided based on at least one of an indication and a flag included in the first system information for the system information block.

Id. ¶ 46.

Ingale further discloses that

[b]efore camping on the cell 104 of next generation RAT [Radio Access Technology], the UE 102 blindly decodes the MIB (353) which contains at least the most essential or most important parameters i.e. minimum system information (MSI): the DL system bandwidth, . . . a configuration comprising resource for requesting one or more SI blocks of OSI for on-demand basis, scheduling information related to SI windows for reception of one or more SI blocks of OSI, ePDCCH configuration, parameters for camping (i.e. cell selection/cell re-selection), random access parameters, the plurality of indicators and the plurality of system configuration indices or identifiers (SCI).

Id. ¶ 136.

According to Ingale, “[t]he MSI can be transmitted in at least one block i.e. MIB (353).” *Id.* Ingale further discloses that “[t]he plurality of indicators may include broadcast indicator/FLAG, a common value tag i.e., counter associated with version of system information or individual value tag. i.e., counter associated with version of each system information block and SIT [stored configuration] invalidity FLAG.” *Id.* Ingale further discloses that “[t]he SCI associated with each SI block represents the configuration corresponding to SI block used in the cell.” *Id.* ¶ 204. Ingale also discloses that when “[t]he SCI need to broadcast in the minimum SI (MSI) so that when UE performs cell re-selection and if UE has stored configuration of SI block corresponding to SCI, UE do not need to re-acquire or request that SI block. UE re-acquires or requests for a SI block only when it does not have the configuration of SI block corresponding to SCI of that SI block or the stored configuration (SIT) is invalid.” *Id.* Furthermore, Ingale discloses that “[i]t is logical that the plurality of SCI is broadcast in MIB#2 (i.e. SIB1) and MIB#1 because list of SCI associated with SI blocks available in cell needs to be signaled and MIB#1 has size restriction.” *Id.*

2. *Jung (Ex. 1005)*

Jung is titled an “Operating Method for Acquiring System Information in Wireless Communication System, and Apparatus for Supporting Same.” Ex. 1005, code (54). Jung discloses radio link monitoring by a “UE [that] monitors downlink quality based on a cell-specific reference signal in order to detect the quality of the downlink radio link of a [PCell].” *Id.* ¶¶ 128, 129.

Jung describes “acquiring system information by [a] terminal . . . in order to prevent non-reception of a service due to non-reception of the compulsory system information.” *Id.* ¶ 213. According to Jung, “when the terminal is a general LTE [long term evolution] terminal in an RRC [radio resource control] connection state, the above compulsory information according to the present invention may include MIB, SIB1, and SIB2” and “[w]hen the terminal is a general LTE terminal in an RRC idle state, the above compulsory information according to the present invention may include MIB 1, SIB1 to SIB8.” *Id.* ¶ 214.

E. Challenges Applying Ingale and/or Jung

Petitioner asserts that claim 9 is unpatentable as obvious over Ingale or Ingale in view of Jung. Pet. 18–51. For the reasons discussed below, we determine that Petitioner’s showing does not rise to the level of “compelling merits” according to the Office’s current guidance and Board precedents. *CommScope* at 3–4 (quoting Guidance Memo, 4) (“[W]hen determining whether there is a compelling unpatentability challenge, the Board evaluates whether the Petition presents challenges ‘in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.’”); *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper 102 at 49–50 (PTAB

Oct. 4, 2022) (precedential) (“*OpenSky*”) (explaining that “[a] challenge can only ‘plainly lead to a conclusion that one or more claims are unpatentable’ . . . if it is highly likely that the petitioner would prevail with respect to at least one challenged claim”).

1. *Petitioner’s Showing for Claim 9*

Below we provide an element-by-element analysis of Petitioner’s obviousness showing for claim 9. After considering the evidence supporting Petitioner’s obviousness showing, and Patent Owner’s arguments and evidence as to why Petitioners’ obviousness showing is deficient, we consider whether the totality of the evidence rises to the level of compelling merits.

[preamble] A base station apparatus of a radio access network (RAN) that communicates over a radio interface with a user equipment, the base station apparatus comprising:

Petitioner contends that “[t]o the extent the preamble is limiting, Ingale discloses this claim element.” Pet. 27 (citing Ex. 1003 ¶ 94) (footnote omitted). Petitioner “specifically” contends that “Ingale discloses a base station (eNB 103) (blue) of a RAN that communicates over a radio interface with a user equipment (UE 102) (red).” *Id.* at 28 (emphasis omitted).

[9.1] transmitting circuitry configured to transmit a first type system information block (SIB), the first type SIB comprising:

Petitioner contends that “[a]s shown and described with reference to FIG. 9a, the BS (eNB 103) (blue) includes transmitting circuitry (communication module 902) (green).” Pet. 29 (emphasis omitted) (citing Ex. 1004, 9a; Ex. 1003 ¶ 96). Petitioner further contends that Ingale “further discloses that the communication module 902 (*transmitting circuitry*) is

configured to transmit first type system information block (SIB) (*Minimum System Information (MSI)*), which includes a Master Information Block and SIB1.” *Id.* at 30 (emphasis omitted) (citing Ex. 1004 ¶ 13) (“Another object of the embodiments herein is to decode a broadcast channel to acquire Minimum System Information (MSI) periodically transmitted by a base station.”).

[9.2] scheduling information of a system information (SI) message, the SI message comprising at least one second type SIB, the scheduling information configuring SI windows, the SI windows comprising periodically occurring time windows in which the SI message is transmitted;

Petitioner contends that “[t]he MSI disclosed by Ingale (first type of SIB) includes scheduling information of a system information (SI message) comprising at least one second type SIB (Other System Information (OSI)) as claimed.” Pet. 32 (emphasis omitted); Ex. 1003 ¶ 100. According to Petitioner, Ingale discloses that “the UE monitors respective SI windows for the OSI indicated by the scheduling information included in the MSI to obtain one or more SI blocks of the OSI available in the camped cell after triggering the SI request for on-demand delivery.” Pet. 32 (quoting Ex. 1004 ¶ 148) (emphasis omitted); *see id.* at 32–33 (citing Ex. 1004 ¶¶ 156–157; Ex. 1003 ¶¶ 101, 102).

[9.3] a parameter associated with a condition for determination of a failure of an SI message acquisition process; and

Petitioner contends that “Ingale discloses a timer or counter that is associated with an indicator/FLAG that indicates how long the network will broadcast OSI.” Pet. 34. Petitioner quotes Ingale’s disclosure below:

Before camping on the cell 104 of next generation RAT, the UE 102 blindly decodes *the MIB (353) which contains at least the most essential or most important parameters i.e.*

minimum system information (MSI): ... scheduling information related to SI windows for reception of one or more SI blocks of OSI, ePDCCH configuration, parameters for camping (i.e. cell selection/cell re-selection), random access parameters, the plurality of indicators and the plurality of system configuration indices or identifiers (SCI) . . . The plurality of indicators may include broadcast indicator/FLAG, a common value tag i.e., counter associated with version of each system information block and SIT invalidity FLAG which indicates whether the stored SIT is valid or not. ***There can also be a timer or a counter (specified in terms of seconds or radio frame) associated with the broadcast indicator/FLAG when the FLAG is set to true to indicate how long the network will broadcast the other system information*** with reference to the beginning of system modification interval.

Id. (quoting Ex. 1004 ¶ 136) (citing Ex. 1003 ¶ 104). Petitioner contends that “[a] POSITA would have understood the timer and counter disclosed by Ingale as corresponding to the claimed parameter in light of Jung’s disclosure.” *Id.* at 36 (citing Ex. 1003 ¶ 106); *see id.* at 36–38.

[9.4] an indication of broadcast status for the SI message, the indication indicating broadcasting; and

Petitioner contends “Ingale discloses that the MSI (as discussed above, the claimed ‘first type system information block (SIB)’) includes an indication of broadcast status for ‘Other System Information’ or ‘OSI’ (as discussed above, the claimed ‘SI Message’), with the indication indicating broadcasting.” Pet. 38 (quoting Ex. 1004 ¶ 16). Petitioner’s quoted portion of Ingale discloses that

[a]nother object of the embodiments herein is to determine whether ***at least one of a SI block of Other System Information (OSI) available in the camped cell is provided based on at least one of the periodic broadcast*** and an on-demand basis, where the on-demand basis to deliver the SI block of the OSI available

in the camped cell is *decided based on at least one of an indication and a flag included in the MSI*.

Id. (quoting Ex. 1004 ¶ 16). According to Petitioner, Ingale further discloses that

[b]efore camping on the cell 104 of next generation RAT, the UE 102 blindly decodes *the MIB (353) which contains at least the most essential or most important parameters i.e. minimum system information (MSI)* . . . The plurality of indicators may include *broadcast indicator/FLAG* . . . If at step 404b, as depicted in the FIG. 4b, the UE 102 detects the *FLAG is set to TRUE (i.e. Other SI broadcast indicator) meaning that the network is periodically broadcasting the Other SI* then UE 102 is not required to initiate the SI request procedure to request

Id. at 38–39 (quoting Ex. 1004 ¶¶ 136, 173); *see id.* at 39 (citing Ex. 1003 ¶¶ 119, 120).

[9.5] processor circuitry configured to cause the transmitting circuitry to broadcast the SI message; wherein:

Pointing to Ingale’s Figure 9a, Petitioner contends that “the BS (eNB 103) (blue) includes processor circuitry (processor module 906) (orange) in addition to having transmitting circuitry (communication module 902) (green).” Pet. 39 (emphasis omitted). Petitioner contends that “Ingale further discloses that the transmitting circuitry (communication module 902) of the BS (eNB 103) is configured to broadcast the SI message (Other SI).” *Id.* at 40–41 (emphasis omitted). Petitioner quotes a portion of Ingale that discloses “*the communication module 902 is configured to broadcast* synchronization signal, the PBCH and the SBCH to plurality of UEs 102a-102c and 102x-102z” and “*the communication module 902 is configured to* transmit system information response message or *broadcast OSI during the SI windows to plurality of UEs* 102a-102c and 102x-102z.” *Id.* at 41 (citing Ex. 1004 ¶ 274; Ex. 1003 ¶ 123); *see id.* at 41–44.

[9.6] the first type SIB is re-acquired by the user equipment upon the user equipment failing on the SI message acquisition process in at least one of the SI windows to receive the SI message,

Petitioner contends that “[a] POSITA would have understood that if the UE failed to acquire one or more of Ingale’s Other SI blocks (*SI message*) prior to the expiration of the timer or before the counter is exceeded, then the UE would not have successfully received the one or more Other SI blocks.” Pet. 44 (citing Ex. 1003 ¶ 128). According to Petitioner, “Jung expressly discloses that, in such a scenario, the UE would initiate another attempt to acquire the SI.” *Id.* (citing Ex. 1005 ¶¶ 221, 240; Ex. 1003 ¶ 129). Petitioner contends that “[s]uch teachings are consistent with Ingale” because “Ingale discloses that, if a UE does not have stored a valid version of the one or more Other SI blocks, then the UE re-acquires the one or more Other SI blocks (*SI message*) after first acquiring the MSI (*first type SIB*) broadcast on the PBCH and/or SBCH” and quotes the following portions of Ingale. *Id.* at 44–45 (citing Ex. 1003 ¶ 130).

Ingale discloses that

[a]nother object of the embodiments herein is to monitor respective *SI windows indicated by scheduling information included in the MSI to acquire one or more SI blocks of the OSI* available in the camped cell.

...

The plurality of indicators broadcasted on PBCH and/or SBCH comprises at least one or more of: ... a common valutag i.e. a counter indicating at least one system information block configuration provided *in* other SI has changed or updated and one or more individual value tags i.e. counter associated with change or update of configuration of corresponding SI block provided in other SI and ***a validity flag indicating whether the already acquired and stored system information is still valid.***

...

In an embodiment, the SIT invalidity flag is broadcasted in the minimum system information on the PBCH/SBCH which if set TRUE indicates the UE 102 that already acquired and stored system information is not valid and the UE 102 ***need to clear all stored system information and acquired updated SIT.***

...

The configurations associated with SI block applicable in different parts of the network can be provided to UE upon request or broadcasted based on network implementation such that SI block provided in one cell can be also applicable and valid for other cells. The SCI associated with each SI block represents the configuration corresponding to the SI block used in the *cell*. ***The SCI need to broadcast in the minimum SI (MSI)*** so that when UE performs cell re-selection and if UE has stored configuration of SI block corresponding to SCI, UE do not need to reacquire or request that SI block. ***UE re-acquires*** or requests for ***a SI block only when it does not have the configuration of SI block corresponding to SCI of that SI block or the stored configuration (SIT) is invalid.*** It is logical that the plurality of SCI is broadcast in MIB#2 (i.e. SIB1) and MIB#1 because list of SCI associated with SI blocks available in cell needs to be signaled and MIB#1 has size restriction.

Id. at 45–46 (citing Ex. 1004 ¶¶ 19, 87, 182, 204) (citing Ex. 1003 ¶ 130).

In view of the above, Petitioner contends that

[a] POSITA would have understood from the teachings of Ingale and Jung that the UE would reacquire the MSI because the MSI includes the scheduling information identifying the SI windows for acquiring one or more SI blocks of the OSI and validity flags identifying whether any stored information is valid.

Pet. 46 (citing Ex. 1003 ¶ 131). According to Petitioner, “[a]s such, the UE would need to confirm that it has the current scheduling information so that the UE can determine how (e.g., broadcast or on demand) and when (e.g., SI windows) to acquire one or more Other SI blocks.” *Id.*; *see id.* at 47.

[9.7] the base station apparatus is a current serving access node of the user equipment.

Petitioner contends that “Ingale discloses that the BS (*eNB 103*) is a current serving access node of the UE (*UE 102*).” Pet. 47 (citing Ex. 1003 ¶ 134). Petitioner contends that “[f]or example, Ingale discloses that the UE 102 is ‘camped’ in an area served by the eNB 103 prior to attempting to acquire the Other SI (*second type SIB*) and therefore the current serving access node of the UE” and quotes the following portion of Ingale. *Id.* Ingale discloses that

[t]he on-demand basis to deliver the corresponding system information block of the second system information ***available in the camped cell*** is decided based on at least one of an indication and a flag included in the first system information for the system information block.

. . . .

At step 403a, the UE 102 camps on the cell 104 based on at least the cell access parameters, the cell selection and the PLMN selection parameters and the cell barring parameters included in the minimum system information. The minimum system information is either included in one Master information block (MIB) or distributed over two blocks i.e. MIB#1 and MIB#2/SIB1.

. . . .

Further, at step 403a, the UE 102 determines the resources to access the camped cell 104 based on the configuration parameters for sending SI request acquired from the minimum system information transmitted by the camped cell 104.

Id. at 47–48 (quoting Ex. 1004, code (57), ¶¶ 162–164); *see id.* at 48–51.

2. Patent Owner’s Arguments

Among other arguments, Patent Owner disputes Petitioner’s showing with respect to limitation 9.6 and contends that “Petitioner admits that ‘Jung

expressly discloses that . . . the UE would initiate another attempt to acquire the SI.” Prelim. Resp. 13 (citing Pet. 44 (citing Ex. 1005 ¶¶ 221, 240)).

According to Patent Owner, “this claim limitation recites that ‘the first type SIB is reacquired,’ not the SI itself, rendering Petitioner’s characterization of Jung inapposite.” *Id.* at 13–14 (citing Ex. 1001, Claim 9 (distinguishing between “the first type SIB comprising: scheduling information of a system information (SI) message” and the SI message)).

According to Patent Owner, “Petitioner admits that ‘Ingale discloses that . . . the UE reacquires the one or more Other SI blocks (*SI message*).” Prelim. Resp. 13–14 (citing Pet. 44–45 (citing Ex. 1004 ¶¶ 19, 87, 182, 204)). Patent Owner further contends that “[f]rom Ingale’s and Jung’s disclosures of re-acquisitions of OSI or SI messages, Petitioner relies on its expert for the proposition that ‘[a] POSITA would have also understood from the foregoing teachings of Ingale and Jung that the UE would re-acquire the MSI.”” *Id.* at 14 (citing Pet. 46 (citing Ex. 1003 ¶ 131)). Patent Owner further contends that

Petitioner’s expert, Dr. Mahon, merely parrots the same statements as in the Petition without any support. Contrary to Dr. Mahon’s assertion, the fact that SI messages are re-acquired does not automatically mean that “the UE would need to confirm that it has the current scheduling information” so as to re-acquire the scheduling information. *Id.* The Petition includes no attempt to establish inherency or show that re-acquiring scheduling information is “necessarily present” when merely SI messages are re-acquired. Dr. Mahon’s conclusory testimony amounts to only a possibility not disclosed by either Ingale or Jung, thus rendering the Petition deficient as to this claim limitation.

Id. (citing Ex. 1003 ¶ 131; *LBT IP I LLC*, 2023 WL 3914920, at *3).

3. *Discussion of the Petitioner's Contentions and Patent Owner's Arguments*

Patent Owner's arguments regarding Petitioner's showing for limitation 9.6 of claim 9 persuade us that Petitioner's showing is not sufficient to meet the threshold of compelling merits. Limitation 9.6 requires that **"the first type SIB is re-acquired by the user equipment upon the user equipment failing on the SI message acquisition process in at least one of the SI windows to receive the SI message."**

As discussed above, Petitioner cites Ingale's disclosure of minimum system information (MSI) as teaching the claimed "first type of system information block (SIB)" as recited in limitation 9.1 of claim 9. Pet. 30 (citing Ex. 1004 ¶ 13). Petitioner cites Ingale's disclosure of scheduling information included in the MSI as teaching "scheduling information of a system information (SI) message" as recited in limitation 9.2 of claim 9. *Id.* at 30 (citing Ex. 1004 ¶ 148). Petitioner cites Ingale's disclosure of "one or more SI blocks of the OSI" as teaching "the SI message comprising at least one second type SIB" as recited in limitation 9.2 of claim 9. *Id.* Petitioner cites both Ingale's timer or counter and/or Jung's timer or counter to teach the claimed "parameter" as recited in limitation 9.3 of claim 9. *See e.g., id.* at 34 (citing-in-part Ex. 1004 ¶ 136), 37 (citing-in-part Ex. 1005 ¶¶ 219, 221–223, 239, 240–248). With respect to limitation 9.6 of claim 9, Petitioner cites Ingale's teaching of "monitor[ing] respective SI windows indicated by scheduling information included in the MSI to acquire one or more SI blocks of the OSI available in the camped cell" and also cites Jung's teaching of a "UE initiat[ing] another attempt to acquire the SI." *Id.* at 45 (citing-in-part Ex. 1004 ¶ 19), 44 (citing-in-part Ex. 1005 ¶¶ 221, 240),

Thus, we would expect Petitioner to show, as part of its proof with respect to limitation 9.6, that Ingale alone or in combination with Jung discloses or suggests that the *MSI* is re-acquired by the UE upon determining that the SI message failed to be acquired.

Petitioner contends that if Jung’s “UE failed to acquire one or more of Ingale’s Other SI Blocks,” it would “initiate another attempt to acquire the SI” and that Jung’s teachings are consistent with Ingale’s disclosure that, “if a UE does not have stored a valid version of the one or more Other SI blocks, then the UE re-acquires the one or more Other SI blocks (SI message) ***after first acquiring the MSI (first type SIB) broadcast on the PBCH and/or SBCH.***” Pet. 44–45 (citing Ex. 1005 ¶¶ 221, 240; Ex. 1003 ¶¶ 129, 130) (emphasis added). In support, Petitioner cites paragraphs 19, 87, 182, 204 of Ingale and paragraphs 129 and 130 of Dr. Mahon’s Declaration. Petitioner also cites paragraphs 221 and 240 of Jung along with paragraphs 128 and 129 of Dr. Mahon’s Declaration. We discuss Petitioner’s cited evidence below.

Paragraph 19 of Ingale refers to “SI windows indicated by scheduling information included in the MSI to acquire one or more SI blocks of the OSI available in the camped cell” during the initial acquisition process, not a re-acquisition process. Ex. 1004 ¶ 19. Nothing in this paragraph appears to address the *re-acquisition* of *MSI*, which Petitioner pointed to as teaching the claimed “first type of system information block (SIB).”

Paragraph 87 of Ingale describes which “indicators [are] broadcasted on PBCH and/or SBCH comprises,” including “a common value tag i.e. a counter indicating at least one system information block configuration provided in other SI has changed or updated and one or more individual value tags i.e. counter associated with change or update of configuration of

corresponding SI block provided in other SI and a validity flag.” Ex. 1004 ¶ 87. Nothing in this paragraph appears to address the re-acquisition of *MSI*, which Petitioner pointed to as teaching the claimed “first type of system information block (SIB).”

Paragraph 182 of Ingale describes “the SIT invalidity flag is broadcasted in the minimum system information on the PBCH/SBCH which if set TRUE indicates the UE 102 that already acquired and stored system information is not valid and the UE 102 need to clear all stored system information and acquired updated [stored configuration] SIT.” Ex. 1004 ¶ 182. As with paragraph 87, nothing in this paragraph appears to address the *re-acquisition* of *MSI*, which, as noted above, Petitioner pointed to as teaching the claimed “first type of system information block (SIB).” The cited portion teaches that “the UE 102 . . . acquire[s] updated SIT,” but it is not clear what Petitioner aspect of claim 9 Petitioner contends SIT meets, or, indeed, if Petitioner intends to cite SIT to cite any claim element of claim 9 at all.

Finally, paragraph 204 of Ingale discloses that

[t]he SCI need to broadcast in the minimum SI (MSI) so that when UE performs cell re-selection and if UE has stored configuration of SI block corresponding to SCI, UE do not need to reacquire or request that SI block. UE re-acquires or requests for a SI block only when it does not have the configuration of SI block corresponding to SCI of that SI block or the stored configuration (SIT) is *invalid*. It is logical that the plurality of SCI is broadcast in MIB#2 (i.e. SIB1) and MIB#1 because list of SCI associated with SI blocks available in cell needs to be signaled and MIB#1 has size restriction.

Ex. 1004 ¶ 204.

It is not clear from either the cited portion of Ingale. or Dr. Mahon’s testimony regarding the cited portion of Ingale, whether and/or how

Petitioner contends the SCI and SIT relate to the MSI. Nor is it clear whether and/or how Petitioner contends MIB#2 teaches or suggests the claimed “first type of system information block (SIB).” In any event, the only mention of MSI refers to when the UE is performing cell re-selection, not when the UE is already camped on a cell.

Paragraph 221 of Jung discloses that “[i]f the terminal does not acquire the compulsory system information . . . the terminal additionally attempts acquisition of the compulsory system information (S1150).” Ex. 1005 ¶ 221. Jung further discloses that a “system information acquisition failure report message may include information indicating a specific type of system information (e.g. MIB and/or specific SIB) in which the terminal fails to acquire.” *Id.* Paragraph 240 of Jung discloses that “[i]f the acquisition of the system information fails from the cell 1 within the specific time interval, the terminal may additionally attempt to acquire the compulsory system information.” *Id.* ¶ 240. The Petition characterizes paragraphs 221 and 240 of Jung as showing that if the UE did not receive one or more Other SI blocks prior to the expiration of a timer, “the UE would initiate another attempt to acquire the SI.” Pet. 44. However, neither the Petition nor Dr. Mahon attempts to relate this characterization to MSI or, more particularly, to explain how Jung’s disclosures in paragraphs 221 and 240 relate to Ingale’s disclosure of MSI other than to say that Jung’s teachings are “consistent with Ingale.” Pet. 44; Ex. 1003 ¶¶ 129–130.

Dr. Mahon’s Declaration in paragraphs 127 through 133 *substantially* reiterates the analysis in the Petition. Ex. 1003 ¶¶ 127–133. With respect to re-acquiring MSI, Dr. Mahon asserts that the POSA would have understood that that the MSI was reacquired because “the MSI includes scheduling information identifying the SI windows for acquiring one or more SI blocks

of the OSI and validity flags identify whether any stored information is valid” and therefore, “the UE would need to confirm that it has the current scheduling information so that the UE can determine how (e.g., broadcast or on-demand) and when (e.g., SI windows) to acquire on or more Other SI blocks.” *Id.* ¶ 131. Although this statement has logical appeal, it does not provide a compelling showing on the merits because the cited evidence and Dr. Mahon’s testimony do not support this conclusory assertion—for example by supporting a finding that same process used to initially acquire the MSI is necessarily, or would have been understood by a POSITA to be, the same as the process of *re-acquiring* the MSI. *Id.*

For the reasons set forth above, and even if we consider Petitioner’s proposed rationale for combining Ingale and Jung to be supported by sufficient rational underpinnings (*see e.g.*, Pet. 24–27), neither Jung nor Ingale, either individually or in the proposed combination set forth by Petitioner teach or suggest limitation 9.6 of claim 9 so as to rise to a compelling, meritorious showing for claim 9.

4. *Remaining Claims*

Petitioner’s arguments and evidence for independent claim 13 (Pet. 58–59) and dependent claims 10–12 and 14–16 (*id.* at 51–57, 59–60) are substantially similar to Petitioner’s arguments and evidence for claim 9 and are unopposed at this stage by Patent Owner (except for the issues discussed above with respect to independent claim 9) (*see e.g.*, Prelim. Resp. 15). Accordingly, Petitioner’s showing for claims 10–16 do not differ or deviate from the showing with respect to independent claim 9 so as to rise to the level of a compelling, meritorious showing, either for independent claim 9, or any of claims 10–16.

IV. CONCLUSION REGARDING COMPELLING MERITS

Because we find that neither challenge set forth in the Petition presents a compelling meritorious challenge to any of claims 9–16 of the ’557 patent, we exercise our discretion to deny institution under § 314(a). Guidance Memo 5 (“[T]he PTAB will not deny institution based on Fintiv if there is compelling evidence of unpatentability.”); *CommScope*, Paper 23 at 4 (same).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s request for *inter partes* review of challenged claims 9–16 of the ’557 patent is *denied*.

IPR2024-00886
Patent 11,019,557 B2

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