

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T SERVICES INC., T-MOBILE USA, INC.,
CELLCO PARTNERSHIP D/B/A VERIZON WIRELESS,
ERICSSON INC., and NOKIA OF AMERICA CORP.,
Petitioner,

v.

INNOVATIVE SONIC LTD.,
Patent Owner.

IPR2024-01144
Patent 9,237,489 B2

Before St. JOHN COURTENAY III, MICHAEL R. ZECHER, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, AT&T Services Inc., T-Mobile USA, Inc., Cellco Partnership d/b/a Verizon Wireless, Ericsson Inc., and Nokia of America Corp. (collectively, “AT&T”), filed a Petition requesting an *inter partes* review (“IPR”) of claims 1–22 of U.S. Patent No. 9,237,489 B2 (Ex. 1001, “the ’489 patent”). Paper 1 (“Pet.”). Patent Owner, Innovative Sonic Ltd. (“Innovative Sonic”), filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). With our authorization, AT&T filed a Preliminary Reply (Paper 12, “Prelim. Reply”) and Innovative Sonic filed a Preliminary Sur-reply (Paper 13, “Prelim. Sur-reply”), each of which is narrowly tailored to address AT&T’s stipulation provided in response to Innovative Sonic’s arguments for discretionary denial under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (Order Authorizing Supplemental Briefing on Discretionary Denial) (precedential), and the resulting impact of that stipulation.¹

Based on the authority delegated to us by the Director under 37 C.F.R. § 42.4(a), we may not institute an IPR unless the information presented in the Petition and any responses thereto shows “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). Taking into account Innovative Sonic’s Preliminary Response, AT&T’s Preliminary Reply, and Innovative Sonic’s Preliminary Sur-reply, we conclude that the information

¹ We do not reach whether we should exercise our discretion to deny the Petition under *Fintiv* because, as we explain below, we deny the Petition based on the merits. *See infra* Sections II.B.5 and II.C.1.

presented in the Petition does not establish that there is a reasonable likelihood that AT&T would prevail in demonstrating at least one of claims 1–22 of the ’489 patent is unpatentable. We, therefore, *deny* AT&T’s Petition.

A. Real Parties in Interest (“RPIs”)

The Petition identifies AT&T Enterprises, LLC, AT&T Mobility LLC, AT&T Mobility II LLC, AT&T Services Inc., Cellco Partnership d/b/a Verizon Wireless, Verizon Corporate Resources Group LLC, T-Mobile USA, Inc., Ericsson Inc., Telefonaktiebolaget LM Ericsson, and Nokia of America Corp. as RPIs. Pet. 2–3. Innovative Sonic identifies itself and Celebrity IP, who “assists Innovative Sonic in the licensing of the [’489] patent,” as RPIs. Paper 10 (Orca’s Updated Mandatory Notices), 2.

B. Related Matters

The parties identify the following district court cases as related matters: (1) *ASUS Tech. Licensing, Inc. v. AT&T Inc.*, No. 2:23-cv-00486-JRG-RSP (E.D. Tex. filed Oct. 19, 2023); (2) *ASUS Tech. Licensing, Inc. v. T-Mobile USA, Inc.*, No. 2:23-cv-00487-JRG-RSP (E.D. Tex. filed Oct. 19, 2023); (3) *ASUS Tech. Licensing, Inc. v. Verizon Commc’ns*, No. 2:23-cv-0488-JRG-RSP (E.D. Tex. filed Oct. 19, 2023); (4) *Innovative Sonic Ltd. v. AT&T Inc.*, 2:23-cv-00489-JRG-RSP (E.D. Tex. filed Oct. 19, 2023); (5) *Innovative Sonic Ltd. v. T-Mobile USA, Inc.*, 2:23-cv-00490-JRG-RSP (E.D. Tex. filed Oct. 19, 2023); and (6) *Innovative Sonic Ltd. v. Verizon Commc’ns, Inc.*, 2:23-cv-00491-JRG-RSP (E.D. Tex. filed Oct. 19, 2023). Pet. 3–4; Paper 10, 2–3. Innovative Sonic also identifies a Board proceeding titled *Samsung Elecs., Co., Ltd. v. ASUS Tech. Licensing, Inc.*, IPR2024-00614, Paper 1 (PTAB Mar. 13, 2024) (Petition) as a related matter.

Samsung's Petition was denied by another Board panel on the merits.
Samsung Elecs., Co., Ltd. v. ASUS Tech. Licensing, Inc., IPR2024-00614,
Paper 10 (PTAB Sept. 24, 2024) (Decision Denying Institution).

C. The '489 Patent

The '489 patent, titled “Method and Apparatus for Secondary Cell Release During Handover in a Wireless Communication System,” issued from U.S. Patent Application No. 13/282,974 (“the '974 application”), filed on October 27, 2011. Ex. 1001, codes (54), (21), (22). The '489 patent claims priority to U.S. Provisional Patent Application No. 61/409,416, filed on November 2, 2010. *Id.* at code (60).

The '489 patent generally relates to “wireless communication networks” and, in particular, “to a method and apparatus for Secondary Cell (SCell) release during handover in a wireless communication system.” Ex. 1001, 1:15–18. Currently, in 3GPP Long Term Evolution access for mobile communications, “a Primary Cell includes the cell operating in the primary frequency in which the [User Equipment (“UE”)] either performs the initial connection establishment procedure or initiates the connection re-establishment procedure, or the cell indicated as the primary cell in the handover procedure.” *Id.* at 5:51–55. “A Secondary Cell (SCell) includes the cell operating on a secondary frequency which may be configured once [a Radio Resource Control (“RRC”)] connection is established and which may be used to provide additional radio resources.” *Id.* at 5:58–61.

The '489 patent further explains that “UE mobility is realized with a handover procedure, which is triggered by the network.” Ex. 1001, 6:2–4. “The network may initiate handover by first configuring the UE to perform measurement reporting or initiate handover without having received

measurement reports from the UE.” *Id.* at 6:4–7. During the handover procedure, “the source eNB first[] selects the target eNB. The source eNB may also provide the target eNB with a list of cells,” which, in turn, the target eNB may use to “decide[] which serving cells are to be configured for use after handover.” *Id.* at 6:21–25. This list “may include cells other than the ones indicated by the source eNB.” *Id.* at 6:25–26.

The ’489 patent, however, states the following:

currently there is no information included in RRCConnectionReconfiguration message for a UE to distinguish whether the handover is an intra-eNB or inter-eNB handover. Accordingly, the UE cannot decide whether or not to release the current SCells upon handover. As a result, the target eNB has to include a sCellToReleaseList with all valid SCell indexes in the handover command for the UE to release all the potentially configured SCells even when there is actually no SCell configured to the UE.

Ex. 1001, 6:45–53. The ’489 patent purportedly addresses this need by allowing the source eNB to include information “in the HandoverPreparationInformation message for the target eNB to control SCell release in a UE during an inter-eNB handover procedure.” *Id.* at 6:61–64. “More specifically, the information indicates the SCell indexes of all the SCells configured to the concerned UE, thereby allowing the target eNB to include the sCellToReleaseList with the SCell’s configured to the UE in the RRCConnectionReconfiguration message so that the UE can release the SCell(s) according to the sCellToReleaseList.” *Id.* at 6:65–7:4.

Figure 6 of the ’489 patent, reproduced below, illustrates “a method of Secondary Cell (SCell) release during handover” according to one embodiment. Ex. 1001, 2:3–4.

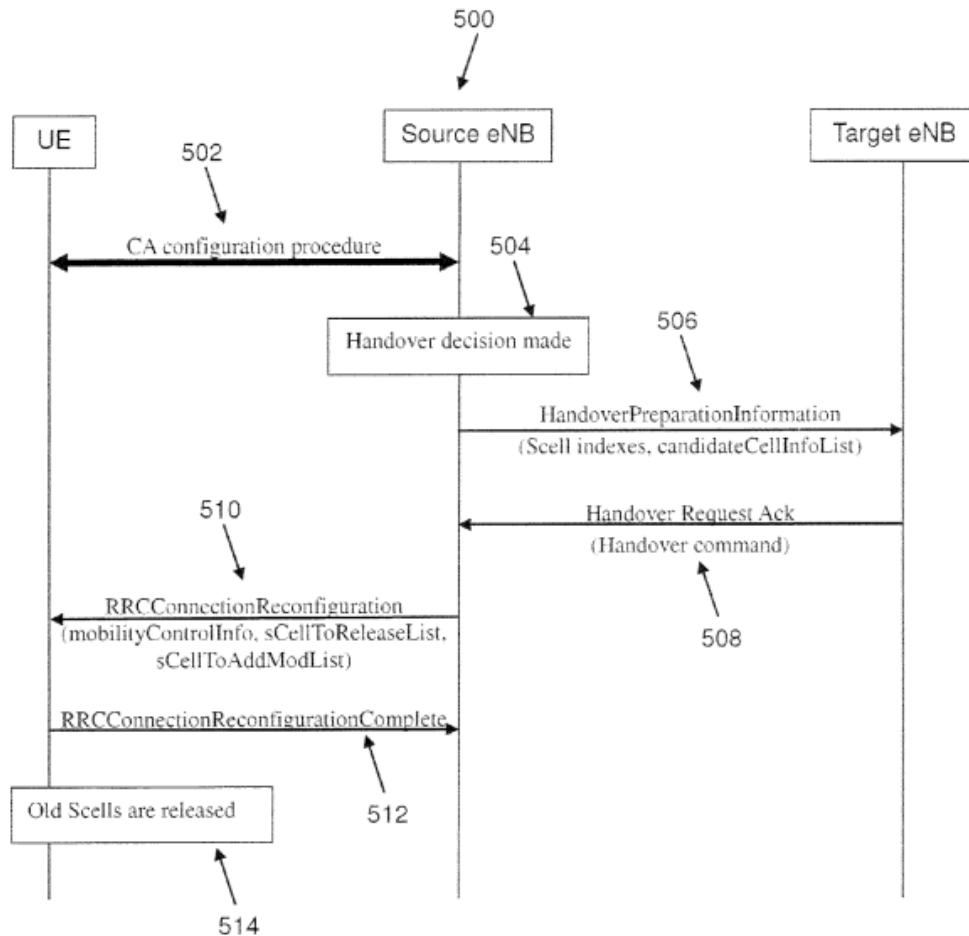


FIG. 6

Figure 6 illustrates “method 500 for SCell release during handover” that begins with “configuring at least one SCell by a source eNB to a UE at step 502.” *Id.* at 7:16–18. After the handover decision has been made at step 504, the source eNB includes “information in a HandoverPreparationInformation message at [step] 506 for a target eNB to control SCell release in the UE during handover.” *Id.* at 7:19–22. “[This] information indicates the SCell indexes of all the SCells configured to the UE, thereby allowing the target eNB to include the sCellToReleaseList with the SCells configured to the UE in a handover command.” *Id.* at 7:22–26.

Later, “[b]ased on the sCellToReleaseList, the UE releases the SCell(s) configured before handover at step 514.” *Id.* at 7:34–36.

D. Challenged Claims

Of the challenged claims, claims 1 and 12 are independent. Independent claim 1 is directed to “[a] method of Secondary Cell (SCell) release during handover,” whereas independent claim 12 is directed to “[a] communication device for use in a wireless communication system.” Ex. 1001, 9:55–56, 10:28–29. Claims 2–11 directly or indirectly depend from independent claim 1 and claims 13–22 directly or indirectly depend from independent claim 12. *Id.* at 10:1–27, 10:47–11:5. Independent claim 1 is illustrative of the challenged claims and is reproduced below.

1. A method of Secondary Cell (SCell) release during handover comprising:

 configuring at least one SCell by a source eNB to a User Equipment (UE); and

 including information by the source eNB in a HandoverPreparationInformation message for a target eNB to control SCell release in the UE during a handover,

 wherein the information indicates SCell indexes of all SCells configured to the UE before the handover, thereby allowing the target eNB to include a sCellToReleaseList with all the SCells configured to the UE in a handover command for the UE to release the SCells included in the sCellToReleaseList.

Id. at 9:55–67.

E. Prior Art References

AT&T relies on the prior art references set forth in the table below.

Printed Publication	Exhibit No.
“ASN.1 Structure for SCell Configuration,” Nokia Siemens Networks, Nokia Corp., 3GPP TSG-RAN WG2 Meeting #71 bis, Xian, China (Oct. 11 th –15 th , 2010) (“Nokia”)	1004
“Physical layer parameters to be configured by RRC,” Ericsson, ST-Ericsson, 3GPP TSG-RAN WG2 Meeting #71 bis, Xian, China (Oct. 11 th –15 th , 2010) (“Ericsson”)	1005
“3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA); Radio Resource Control (RRC); Protocol Specification,” (Release 9) 3GPP TS 36.331 v9.4.0 (Sept. 2010) (“3GPP-Standard” ²)	1006
3rd Generation Partnership Project; Technical Specification Group Radio Access Network; Evolved Universal Terrestrial Radio Access (E-UTRA) and Evolved Universal Radio Access Network (E-UTRAN); Overall description, Stage 2,” (Release 9) 3GPP TS 36.300 v9.5.0 (Sept. 2010) (“3GPP-Standard”)	1007
Change Request or Update for 3GPP TS 36.331 v.9.4.0, 3GPP TSG-RAN WG2 Meeting #71 bis, Xian, China (Oct. 11 th –15 th , 2010) (“3GPP-Standard”)	1008

F. Grounds of Unpatentability

AT&T challenges claims 1–22 of the ’489 patent based on the asserted grounds of unpatentability set forth in the table below. Pet. 6–7, 21–69.

² AT&T collectively refers to 3GPP TS 36.331 v9.4.0 (Ex. 1006), 3GPP TS 36.300 v.9.5.0 (Ex. 1007), and the Update for 3GPP TS 36.331 v.9.4.0 (Ex. 1008) as the “3GPP-Standard.” See Pet. 17–20.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–22	103(a) ³	Nokia, 3GPP-Standard ⁴
1–22	103(a)	Ericsson, 3GPP-Standard ⁵

II. ANALYSIS

A. Claim Construction

In this IPR, claim terms are construed using the same claim construction standard as in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b). That is, claim terms generally are construed in accordance with their ordinary and customary meaning, as would have been understood by a person of ordinary skill in the art, in view of the specification and the prosecution history pertaining to the patent at issue. *See id.* The ordinary and customary meaning of a claim term “is its meaning to the ordinary artisan after reading the entire patent” “as of the effective

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the ‘489 patent claims the benefit of the ‘974 application, which was filed before this date, the pre-AIA version of § 103 applies. Ex. 1001, codes (21), (22).

⁴ In the section of the Petition titled “Relief Requested,” AT&T asserts that claims 1–22 of the ‘489 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over (1) Nokia alone and (2) Ericsson alone, but in its substantive analysis of these two asserted grounds found later in the Petition, AT&T asserts that claims 1–22 of the ‘489 patent are unpatentable under 35 U.S.C. § 103(a) as obvious (1) Nokia in view of the 3GPP-Standard and (2) Ericsson in view of the 3GPP-Standard. *Compare* Pet. 6–7, *with id.* at 25, 47.

⁵ *See supra* n.4.

filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 1321 (Fed. Cir. 2005) (en banc).

In the Petition, AT&T contends that “the Board does not need to expressly construe any [claim] terms to resolve the arguments presented herein” because the asserted prior art “discloses all limitations under any plausible construction.” Pet. 14 (citing Ex. 1002 (Declaration of Dr. Christopher Hansen) ¶ 45⁶). In the Preliminary Response, Innovative Sonic “agrees with [AT&T] that no [claim] term needs to be construed.” Prelim. Resp. 4 (citing Pet. 14).

For purposes of this Decision, there is no readily discernible controversy between the parties that requires us to construe any claim terms at this time. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we 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))).

⁶ The Petition is replete with inaccurate citations to Dr. Hansen’s Declaration. For example, Dr. Hansen does not address how we should construe the claim terms of the ’489 patent in paragraph 45 of his Declaration. Instead, Dr. Hansen testifies in paragraph 45 that it is his understanding that “the Board must determine the scope of the claims by using the same claim construction standard that United States District Courts use,” which includes giving “the words of a claim . . . their ‘ordinary’ and ‘customary’ meaning as would have been understood by a person of ordinary skill in the art at the time of the invention.” Dr. Hansen testifies in paragraph 59 of his Declaration that “all [claim] terms should be given their ordinary and customary meaning.”

*B. Obviousness Over the Combined Teachings of
Nokia and the 3GPP-Standard*

AT&T contends that claims 1–22 of the '489 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the combined teachings of Nokia and the 3GPP-Standard. Pet. 21–47. AT&T contends that the combined teachings of Nokia and the 3GPP-Standard account for the subject matter of each challenged claim, and provides reasoning as to why a person of ordinary skill in the art would have been prompted to modify these references. *Id.* AT&T submits the Declaration of Dr. Hansen to support its positions. *See* Ex. 1002.

Based on this record, we determine that AT&T has not shown that there is a reasonable likelihood that it would prevail in demonstrating at least one of claims 1–22 of the '489 patent is unpatentable. We begin our analysis with the principles of law that generally apply to an asserted ground based on obviousness, then we assess the level of skill in the art, next we provide an overview of Nokia and the 3GPP-Standard, and then we address the parties' contentions with respect to independent claims 1 and 12.

1. Principles of Law

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, “would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in

the art; and (4) when in evidence, objective indicia of obviousness or non-obviousness (i.e., secondary considerations, such as commercial success, long-felt but unsolved needs, failure of others, etc.).⁷ *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966). We analyze the asserted grounds based on obviousness with the principles we identify above in mind.

2. *Level of Skill in the Art*

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person having ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Factors pertinent to a determination of the level of ordinary skill in the art include “(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Envtl. Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed.

⁷ In the Preliminary Response, Innovative Sonic does not present arguments or evidence of secondary considerations. See Prelim. Resp; see also Pet. 69 (arguing that AT&T is “unaware of any evidence of secondary considerations that would support a finding of non-obviousness”).

Cir. 1983)). “Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case.” *Id.* at 696–97.

Relying on the testimony of Dr. Hansen, AT&T argues the following:

[a]s of the earliest claimed priority date, a person of ordinary skill in the art at the time of the alleged invention of the ’489 patent . . . would have had a [Bachelor of Science] in Electrical Engineering or a related field with at least three years of experience designing, developing, and/or testing telecommunication systems. A [person of ordinary skill in the art] would also have familiarity with the wireless standards and well-known protocols for accessing wireless networks. More education may supplement practical experience or *vice versa*.

Pet. 14 (citing Ex. 1002 ¶ 36⁸). In the Preliminary Response, Innovative Sonic does not address AT&T’s assessment of the level of skill in the art. *See* Prelim. Resp. For purposes of this Decision, we adopt AT&T’s uncontested assessment of the level of skill in the art because it is consistent with the ’489 patent and the asserted prior art.

3. Overview of Nokia

Nokia generally relates to “grouping of SCell configuration parameters” and, in particular, to “a different way of grouping” these parameters “so that configuring the SCell can be more efficient depending on which [Carrier Aggregation]⁹ functionalities are used.” Ex. 1004, 1. Nokia discloses providing SCell configuration parameters “under the

⁸ Dr. Hansen does not address the level of skill in the art in paragraph 36 of his Declaration, but rather addresses this issue in paragraph 57 of his Declaration.

⁹ The Update for 3GPP TS 36.331 v.9.4.0 discloses that “CA” is an abbreviation for “Carrier Aggregation.” Ex. 1008 § 3.2.

‘radioResourceConfigDedicated’ [information element].” *Id.* More specifically, Nokia discloses that the “radioResourceCongFigDedicated” information element includes a “SecCell-ToRelease List” as illustrated below:

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SecCell-ToReleaseList-r10 ::=
SEQUENCE (SIZE (1..maxSecCell-r10)) OF CellIndex-r10
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Id. at 8. According to AT&T, the “SeCell-ToRelease List” “includes SCell values from 1 to the maxSecCell of the CellIndex.” Pet. 31 (citing Ex. 1004, 8).

4. Overview of 3GPP-Standard

The overview of the 3GPP-Standard that follows focuses on the Update for 3GPP TS 36.331 v.9.4.0 that is Exhibit 1008. The Update for 3GPP TS 36.331 v.9.4.0 updates the original 3GPP TS 36.331 v.9.4.0 (Ex. 1006) by including “[a]dditional specification regarding transfer of system information for secondary cells.” Ex. 1008, 2 (“Other comments”). Importantly, the Update for 3GPP TS 36.331 v.9.4.0 discloses that “E-UTRAN may configure a UE that supports Carrier Aggregation, with one or more SCells in addition to the PCell that is initially configured during connection establishment.” *Id.* § 5.3.1.1.¹⁰ “E-UTRAN [also] can independently add, remove, or modify SCells by means of the RCC connection reconfiguration procedure using the

¹⁰ For purposes of consistency, and where possible, we cite to the Update for 3GPP TS 36.331 v.9.4.0 using the section identifiers that AT&T cites in the Petition. *See, e.g.*, 26–27 (arguing that the 3GPP-Standard teaches “configuring at least one SCell by a source eNB to a User Equipment (UE)” by citing to, among other things, §§ 5.3.1.1, 5.3.1.3, 5.3.5.1 of the Update for 3GPP TS 36.331 v.9.4.0), 48–49 (arguing the same).

RRCCConnectionReconfiguration message.” *Id.* § 5.3.1.3. The Update for 3GPP TS 36.331 v.9.4.0 further discloses that the purpose of the RCC connection reconfiguration procedure “is to modify an RCC connection, e.g. to establish/ modify/ release [Radio Bearers (“RBs”)], to perform handover, to setup/ modify/ release measurements, to add/ modify/ release SCells.” *Id.* § 5.3.5.1.

5. *Claims 1 and 12*

Our analysis below focuses on a dispositive limitation—namely, “configuring at least one SCell by a source eNB to a User Equipment (EU),” as recited in each of independent claims 1 and 12. Ex. 1001, 9:57–58 (claim 1), 10:36–37 (claim 12). AT&T contends that the Update for 3GPP TS 36.331 v.9.4.0 teaches this limitation because “the E-UTRAN (*i.e.*, the source eNB) ‘may configure a UE to support Carrier Aggregation, with one or more SCells in addition to the PCell that is initially configured during connection establishment.’” Pet. 26 (quoting Ex. 1008 § 5.3.1.1). AT&T also argues that the Update for 3GPP TS 36.331 v.9.4.0 discloses “the E-UTRAN (*i.e.*, the source eNB) ‘can independently add, remove or modify SCells by means of the RCC connection reconfiguration procedure using the *RRCCConnectionReconfiguration* message.’” *Id.* (quoting Ex. 1008 § 5.3.1.3). AT&T asserts that the purpose of the RCC connection reconfiguration procedure “is ‘to modify an RCC connection, e.g. to establish/ modify/ release RBs, to perform handover, to setup/ modify/ release measurements, to add/ modify/ release SCells.’” *Id.* at 27 (quoting Ex. 1008 § 5.3.5.1) (citing Ex. 1008 §§ 5.4.2.3, 6.2.2, Fig. 5.3.5.1-1). Relying on the testimony of Dr. Hansen, AT&T asserts that a person of ordinary skill in the art would have understood that the Update for 3GPP TS

36.331 v.9.4.0’s disclosure of “the E-UTRAN configuring the UE with one or more SCells” teaches the disputed limitation. *Id.* (citing Ex. 1002 ¶ 91). AT&T relies on the same arguments and evidence identified above to explain how the Update for 3GPP TS 36.331 v.9.4.0 teaches the same limitation required by independent claim 12. *Id.* at 43.

In the Preliminary Response, Innovative Sonic contends that AT&T’s arguments that the Update for 3GPP TS 36.331 v.9.4.0 teaches the disputed limitation of independent claims 1 and 12 miss the mark. *See* Prelim. Resp. 14–16. Innovative Sonic argues that, “[r]ather than presenting evidence that a source eNB configures *an SCell* as required by the [independent] claims, [AT&T] instead presents evidence that the source eNB configures *an UE*.” *Id.* at 14–15 (citing Pet. 26, 48–49). Innovative Sonic asserts that, because “[t]he only evidence presented is that an UE is configured,” which “is not what is claimed,” AT&T “fails to establish that configuring a SCell would have been obvious in view of the alleged prior art.” *Id.* at 16.

Based on this record, we agree with Innovative Sonic that the Update for 3GPP TS 36.331 v.9.4.0 does not teach “configuring at least one SCell by a source eNB to a User Equipment (EU),” as recited in each of independent claims 1 and 12. The plain language of this disputed limitation requires a source eNB to configure at least one SCell to a UE. AT&T’s arguments and evidence, however, focus on the E-UTRAN, which AT&T maps to the claimed “source eNB,” configuring the EU with one or more SCells. *See* Pet. 26, 43. The Update for 3GPP TS 36.331 v.9.4.0 bears this out because AT&T relies on certain disclosures that support the E-UTRAN configuring a UE with at least one SCell. *See, e.g.,* Ex. 1008 §§ 5.3.1.1 (stating the “E-UTRAN may configure the UE . . . with one or more

SCells”). Put simply, AT&T does not explain adequately why the Update for 3GPP TS 36.331 v.9.4.0’s disclosure of the E-UTRAN configuring the UE with at least one SCell teaches “configuring at least one SCell by a source eNB to a User Equipment (UE),” as recited in each of independent claims 1 and 12.

The testimony of AT&T’s declarant, Dr. Hansen, on this particular issue fares no better. With one exception, Dr. Hansen, relies on the same disclosures of the Update for 3GPP TS 36.331 v.9.4.0 to support his testimony, which, as we explain above, does not account for the plain language of the disputed limitation. *Compare* Pet. 26–27, 43, *with* Ex. 1002 ¶¶ 87–90. In addition, Dr. Hansen testifies that a person of ordinary skill in the art would have understood that “the E-UTRAN configuring the UE with one or more SCells would *necessarily* include the configuring of at least one SCell by a source eNB to a UE.” Ex. 1002 ¶ 91 (emphasis added). But neither AT&T nor Dr. Hansen establish inherency in its obviousness analysis. *See PAR Pharm., Inc. v TWI Pharms., Inc.*, 773 F.3d 1186, 1194–95 (Fed Cir. 2014) (recognizing that “inherency may supply a missing claim limitation in an obviousness analysis,” but limiting the doctrine of inherency “only when the limitation at issue is the ‘natural result’ of the combination of prior art elements” (quoting *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981))).

Apart from the conclusory assertion above, Dr. Hansen does not identify sufficient evidentiary support demonstrating that the requirement identically recited in each of independent claims 1 and 12 of “configuring at least one SCell by a source eNB to a User Equipment (UE)” would have been the “natural result” flowing from the Update for 3GPP TS 36.331

v.9.4.0's disclosure of the E-UTRAN configuring the UE with at least one SCell. *PAR Pharm.*, 773 F.3d at 1195. Accordingly, we do not credit Dr. Hansen's testimony that implicates the doctrine of inherency because it not supported by evidence of record.

In summary, AT&T has not shown a reasonable likelihood that it would prevail on its assertions that the subject matter of independent claims 1 and 12 would have been obvious over the combined teachings of Nokia and the 3GPP-Standard.

6. Claims 2–11 and 13–22

By virtue of their dependency, claims 2–11 and 13–22 include the same limitations as either independent claim 1 or 12. AT&T does not present arguments or evidence with respect to these dependent claims that remedy the deficiencies in its obviousness analysis of independent claims 1 and 12. *See* Pet. 35–47. Accordingly, for the same reasons we identify above with respect to independent claims 1 and 12, AT&T has not shown a reasonable likelihood that it would prevail on its assertions that the subject matter of dependent claims 2–11 and 13–22 would have been obvious over the combined teachings of Nokia and the 3GPP-Standard.

*C. Obviousness Over the Combined Teachings of
Ericsson and 3GPP-Standard*

AT&T contends that claims 1–22 of the '489 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over the combined teachings of Ericsson and the 3GPP-Standard. Pet. 21–25, 47–69. AT&T contends that the combined teachings of Ericsson and the 3GPP-Standard account for the subject matter of each challenged claim, and provides reasoning as to why a person of ordinary skill in the art would have been prompted to combine

these references. *Id.* AT&T submits the testimony of Dr. Hansen to support its positions. *See* Ex. 1002.

Based on this record, we determine that AT&T has not shown that there is a reasonable likelihood that it would prevail in challenging at least one of claims 1–22 of the '489 patent as unpatentable. We begin our analysis by addressing the parties' contentions with respect to the independent claims 1 and 12.

1. Claims 1 and 12

AT&T relies on essentially the same arguments and evidence that it identifies above with respect to the obviousness ground based on the combined teachings of Nokia and the 3GPP-Standard to explain how the combined teachings of Ericsson and the 3GPP-Standard account for “configuring at least one SCell by a source eNB to a User Equipment (EU),” as recited in each of independent claims 1 and 12. *Compare* Pet. 26–27, 43, *with id.* at 48–49, 65. For the same reasons we identify above, we agree with Innovative Sonic's argument that the Update for 3GPP TS 36.331 v.9.4.0 does not teach this limitation. *See supra* Section II.B.5.

Accordingly, AT&T has not shown a reasonable likelihood that it would prevail on its assertions that the subject matter of independent claims 1 and 12 would have been obvious over the combined teachings of Ericsson and the 3GPP-Standard.

2. Claims 2–11 and 13–22

By virtue of their dependency, claims 2–11 and 13–22 include the same limitations as either independent claim 1 or 12. AT&T does not present arguments or evidence with respect to these dependent claims that remedy the deficiencies in its obviousness analysis of independent claims 1

and 12. *See* Pet. 57–69. Accordingly, for the same reasons we identify above with respect to independent claims 1 and 12, AT&T has not shown a reasonable likelihood that it would prevail on its assertions that the subject matter of dependent claims 2–11 and 13–22 would have been obvious over the combined teachings of Ericsson and the 3GPP-Standard.

III. CONCLUSION

Taking into account Innovative Sonic’s Preliminary Response, AT&T’s Preliminary Reply, and Innovative Sonic’s Preliminary Sur-reply, we conclude that the information presented in the Petition does not demonstrate that there is a reasonable likelihood that AT&T would prevail in challenging any one of claims 1–22 of the ’489 patent as unpatentable.

IV. ORDER

In consideration of the foregoing, it is ORDERED that the Petition is *denied* and no trial is instituted.

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