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Paper 19
Entered: July 31, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARRIS GROUP, INC.,
Petitioner,

v.

C-CATION TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2015-00635
Patent 5,563,883

Before BARBARA A. BENOIT, LYNNE E. PETTIGREW, and MIRIAM L. QUINN, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, ARRIS Group, Inc., filed a Petition for *inter partes* review of claims 1, 3, and 4 of U.S. Patent No. 5,563,883 (Ex. 1001, "the '883 patent"). Paper 2 ("Pet."). Patent Owner, C-Cation Technologies, LLC,

filed a Preliminary Response. Paper 16 ("Prelim. Resp.").[1] Institution of an *inter partes* review is authorized by statute when "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108. Upon consideration of the Petition and the Preliminary Response, we conclude the information presented shows there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1, 3, and 4 of the '883 patent.

A. Related Matters

The parties indicate that Patent Owner has asserted the '883 patent against Petitioner and other defendants in *C-Cation Technologies, LLC v. Time Warner Cable Inc.*, No. 2:14-cv-00059 (E.D. Tex.) (filed Feb. 4, 2014). Pet. 2; Paper 5, 1. The '883 patent also was asserted in *C-Cation Technologies, LLC v. Cable One, Inc.*, No. 2:11-cv-00030 (E.D. Tex.) (filed Jan. 25, 2011; terminated Jan. 21, 2014). Pet. 2; Prelim. Resp. 6.

The '883 patent has been the subject of other petitions for *inter partes* review. In *Cisco Systems, Inc. v. C-Cation Technologies, LLC*, Case IPR2014-00454 (PTAB Aug. 29, 2014) (Paper 12), the Board denied institution of *inter partes* review. In *ARRIS Group, Inc. v. C-Cation Technologies, LLC*, Case IPR2014-00746 (PTAB Nov. 24, 2014) (Paper 22), the Board instituted *inter partes* review, and subsequently granted Patent

[1] Patent Owner filed a Motion to Seal its Preliminary Response and Certain Associated Exhibits. Paper 17. Along with the Motion to Seal, Patent Owner filed a redacted version of the Preliminary Response to be available to the public. Paper 18.

Owner's request for adverse judgment (Paper 28). Another petition, filed on April 13, 2015, is pending. *See Unified Patents Inc. v. C-Cation Techs., LLC*, Case IPR2015-01045 (Paper 2).

B. The '883 Patent

The '883 patent "pertains generally to methods and apparatus for facilitating the two-way multi-media communication based on a shared transmission media such as coaxial cable-TV network, and more specifically to methods and apparatus for signalling channel management and protocol." Ex. 1001, 1:7–12.

Figure 1 of the '883 patent is reproduced below:

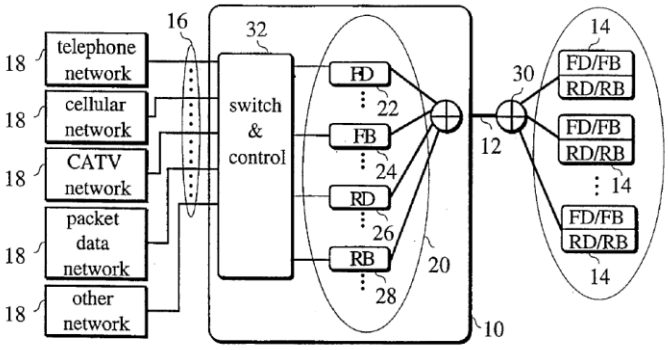

Figure 1

Figure 1 illustrates a multiple access communication system architecture comprising central controller 10, shared transmission media 12, and a plurality of remote terminals 14. *Id.* at 5:8–11. Central controller 10 interfaces with wide area networks 18 via a pool of communication channels 16. *Id.* at 5:12–14. Communication channels 20—including forward signalling channels 22, forward traffic bearer channels 24, reverse signalling channels 26, and reverse traffic bearer channels 28—support communications between central controller 10 and remote terminals 14. *Id.* at 5:15–21.

The ’883 patent describes a method for dynamic signalling channel allocation, assignment of remote terminals to signalling channels, and terminal reassignment. *Id.* at 2:38–51. Figure 6 is a logic flow diagram illustrating terminal registration, channel allocation, terminal assignment, and reassignment processes. *Id.* at 8:16–18. In a preferred embodiment, the central controller receives a registration message from a remote terminal and, if the remote terminal is newly registering and authorized, checks for available signalling channels. *Id.* at 8:18–23. Some factors for determining signalling channel availability include “the number of remote terminals using the signalling data channel, the traffic requirements, past collision count, channel error status, and bandwidth of the signalling data channel.” *Id.* at 8:35–39. “At any time, the central controller can initiate the terminal re-assignment process if deemed appropriate for the varying traffic demand or other system dynamics.” *Id.* at 8:32–34.

C. Illustrative Claim

Independent claim 1 of the ’883 patent is illustrative of the subject matter of the challenged claims:

> 1. In a multiple access communication system comprising a central controller, a shared transmission means for signalling data and user information, and a plurality of remote terminals, a method of allocating signalling data channels between said central controller and said plurality of remote terminals from a plurality of communication channels and of assigning remote terminals comprising the steps of:
>
> (a) establishing communications between said central controller and said plurality of remote terminals via a plurality of signalling data channels, each of said remote terminals being initially assigned to a pair of predetermined signalling data channels;

> (b) monitoring the status of a plurality of the signalling data channels in use between said central controller and said plurality of remote terminals for the usability of said signalling data channels;
>
> (c) determining whether one of said plurality of remote terminals needs to be reassigned to a different signalling data channel other than said predetermined signalling data channel;
>
> (d) determining whether a different and suitable signalling data channel is available other than said predetermined channel; and
>
> (e) reassigning by said central controller said remote terminal to a different and suitable signalling data channel for communication henceforward.

Ex. 1001, 14:27–53.

D. Asserted Grounds of Unpatentability

Petitioner contends that claims 1, 3, and 4 of the ’883 patent are unpatentable based on the following specific grounds (Pet. 19–60):

References	Basis	Challenged Claim(s)
MPT 1343,[2] MPT 1347,[3] and MPT 1327[4]	35 U.S.C. § 103(a)	1 and 4
MPT 1343, MPT 1347, MPT 1327, Zdunek,[5] and Dufresne[6]	35 U.S.C. § 103(a)	3

In its analysis, Petitioner relies on the declaration testimony of Mr. Stuart Lipoff. *See* Ex. 1002.

II. DISCUSSION

A. 35 U.S.C. § 325(d)

As an initial matter, we address Patent Owner's argument that we should exercise our discretion under 35 U.S.C. § 325(d) to deny the Petition. Prelim. Resp. 6–14. Under that provision, in determining whether to institute, "the Director *may* take into account whether, and reject a petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d) (emphasis added). Patent Owner urges us to exercise our discretion under § 325(d) in order to preclude "serial challenges" to the '883 patent. Prelim. Resp. 11–12.

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[2] MPT 1343 PERFORMANCE SPECIFICATION: SYSTEM INTERFACE SPECIFICATION FOR RADIO UNITS TO BE USED WITH COMMERCIAL TRUNKED NETWORKS OPERATING IN BAND III SUB-BANDS 1 AND 2 (1991) (Ex. 1006, "MPT 1343").

[3] MPT 1347 RADIO INTERFACE SPECIFICATION FOR COMMERCIAL TRUNKED NETWORKS OPERATION IN BAND III, SUB-BANDS 1 AND 2 (1991) (Ex. 1007, "MPT 1347").

[4] MPT 1327 A SIGNALLING STANDARD FOR TRUNKED PRIVATE LAND MOBILE RADIO SYSTEMS (1991) (Ex. 1005, "MPT 1327").

[5] U.S. Patent No. 4,870,408, issued Sept. 26, 1989 (Ex. 1008, "Zdunek").

[6] U.S. Patent No. 4,920,533, issued Apr. 24, 1990 (Ex. 1009, "Dufresne").

This is the third petition requesting inter partes review of the '883 patent. In the first petition, filed in February 2014, Cisco Systems, Inc. challenged claims 1–20 of the '883 patent. *See Cisco Sys., Inc. v. C-Cation Techs., LLC*, Case IPR2014-00454, slip op. at 2 (PTAB Aug. 29, 2014) (Decision Denying Institution, Paper 12) ("*Cisco*"). Among numerous other grounds, the Cisco petition asserted that claims 1, 3, and 4 were anticipated and rendered obvious by MPT 1343 and MPT 1327. *Id.* at 6–7. In August 2014, the Board denied institution of *inter partes* review in IPR2014-00454. *Id.* at 15.

In May 2014, while the Cisco petition was pending, Petitioner ARRIS Group filed a petition challenging claims 1, 3, 4, and 14 of the '883 patent. *See ARRIS Group, Inc. v. C-Cation Techs., LLC*, Case IPR2014-00746, slip op. at 2 (PTAB Nov. 24, 2014) (Institution Decision, Paper 22) ("*ARRIS I*"). In *ARRIS I*, Petitioner asserted grounds based primarily on two prior art references, McNamara and MetroNet. *Id.* at 14. In November 2014, the Board instituted *inter partes* review in *ARRIS I*, but only as to claim 14 of the '883 patent. *Id.* at 28. In February 2015, Petitioner filed the Petition in this case, which is Petitioner's second petition challenging the '883 patent, and the third overall.

Patent Owner asserts that in IPR2014-00454, substantially the same prior art and arguments in the instant Petition were presented to and considered by the Board, and the Board declined to institute *inter partes* review. Prelim. Resp. 13. Patent Owner also argues that we should exercise our discretion to deny the Petition because Petitioner has not explained why it did not assert the prior art on which it now relies earlier than February 2015, when it filed the present Petition. *Id.* at 12. In particular, Patent

Owner faults Petitioner for electing to request an *inter partes* review based on an alternative theory in *ARRIS I*, and pursuing its present course only after the Board denied institution on the alternative theory with respect to claims 1, 3, and 4. *Id.* Furthermore, Patent Owner complains that Petitioner did not attempt to join Cisco's petition in IPR2014-00454. *Id.*

Under the circumstances presented by this case, we decline to exercise our discretion under § 325(d) to deny the Petition. The same combination of prior art (MPT 1343, MPT 1347, and MPT 1327) has not been presented previously to the Office. Moreover, although Cisco's petition in IPR2014-00454 did present grounds based on MPT 1343 and MPT 1327, the Board found the petition to be deficient in several respects. *Cisco*, slip op. at 7–15. As a result, the decision denying institution in IPR2014-00454 did not address the substance of MPT 1343 and MPT 1327 or their applicability to claims 1, 3, and 4. *Id.* at 11–15. Based on a comparison of the instant Petition with the petition in IPR2014-00454, we agree with Petitioner that the arguments proffered in this case as a whole have not been presented previously to the Office. *See* Pet. 2–3 n.1 (citing 35 U.S.C. § 325(d)).

Furthermore, we are not persuaded by Patent Owner's argument that we should deny the Petition because it is the second one filed by Petitioner. Unlike several cases cited by Patent Owner, *see* Prelim. Resp. 13–14, this is not a case in which Petitioner is seeking a "second chance" to assert similar art or arguments as it did in a previous petition. We also note that Petitioner could not have sought to join IPR2014-00454 because no *inter partes* review was instituted in that case. *See* 35 U.S.C. § 315(c) (providing for joinder "[i]f the Director institutes an inter partes review"). Under these

circumstances, we decline to exercise our discretion to deny institution in this case.

B. 35 U.S.C. § 315(b) Time Bar Based on Privity

Patent Owner asserts that the Petition is barred under 35 U.S.C. § 315(b) because Petitioner is a privy of Comcast, who was served with a complaint for infringement of the '883 patent more than four years before the date on which the Petition was filed. Prelim. Resp. 15. In the infringement proceeding, *C-Cation Technologies, LLC v. Cable One, Inc.*, No. 2:11-cv-00030 (E.D. Tex.) ("the 2011 district court proceeding"), Patent Owner filed a complaint on January 25, 2011, and filed an amended complaint adding Comcast as a defendant on April 5, 2011. Prelim. Resp. 6 & n.3 (citing Exs. 2002, 2010). Pursuant to a settlement agreement, Patent Owner and Comcast stipulated to the dismissal of the 2011 district court proceeding on January 21, 2014. *Id.* at 7 (citing Ex. 2011).

Under 35 U.S.C. § 315(b), an *inter partes* review may not be instituted if the petition requesting the review is filed more than one year after the date on which a privy of the petitioner is served with a complaint. "Whether a party who is not a named participant in a given proceeding nonetheless constitutes a . . . 'privy' to that proceeding is a highly fact-dependent question." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (citing *Taylor v. Sturgell*, 553 U.S. 880 (2008)). "Privity is essentially a shorthand statement that collateral estoppel is to be applied in a given case . . . . The concept refers to a relationship between the party to be estopped and the unsuccessful party in the prior litigation which is sufficiently close so as to justify application of the doctrine of collateral estoppel." *Id.* (quoting 154 Cong. Rec. S9987 (daily

ed. Sept. 27, 2008) (statement of Sen. Kyl)). A "common consideration" in determining whether a non-party is in privity with a litigant is "whether the non-party exercised or could have exercised control over a party's participation in a proceeding." *Id.* (citing *Taylor*, 553 U.S. at 895).

In support of its assertion that Comcast is a privy of Petitioner, Patent Owner directs our attention to indemnification clauses in a first purchase agreement (Ex. 2013) and a second purchase agreement (Ex. 2015) between Petitioner and Comcast (collectively, "the Agreements"). Prelim. Resp. 15–18. Specifically, Patent Owner points to certain language contained in the Agreements directed to Comcast providing prompt notice to Petitioner of any infringement claims and Petitioner having sole control or full authority over any claim giving rise to indemnification obligations. *Id.* (citing Ex. 2013, 6; Ex. 2015, 22).[7]

Patent Owner alleges that Comcast made indemnification claims against Petitioner pursuant to the Agreements in connection with the 2011 district court proceeding. *Id.* at 18–19. To support its allegation, Patent Owner cites Petitioner's 2013 annual report, filed with the Securities and Exchange Commission, which states: "The Company and Comcast reached a settlement agreement related to Comcast's litigation with C-Cation, whereby the Company agreed to pay Comcast to settle indemnification claims against the Company in the quarter ended December 31, 2013." *Id.* (quoting Ex. 2003, 125) (emphasis and alteration omitted). Patent Owner contends that because indemnification claims were made according to the

[7] For Exhibits 2003, 2013, and 2015, we cite the page numbers of the exhibits as submitted in this proceeding, rather than other page numbers appearing on the documents.

provisions of the Agreements, Petitioner had, at the very least, the contractual ability to control the 2011 district court proceeding, and had actual notice of that proceeding nearly four years before it filed the Petition. *Id.* at 19.

As evidence that Petitioner did, in fact, exercise control over Comcast's participation in the 2011 district court proceeding, Patent Owner submits a privilege log provided to Patent Owner in connection with a later district court action in which Petitioner was a defendant, *C-Cation Technologies, LLC v. Time Warner Cable Inc.*, No. 2:14-cv-00059 (E.D. Tex.). *See* Ex. 2019. Patent Owner cites entries in the log indicating that during the 2011 district court proceeding, between January 2013 and January 2014, Petitioner's in-house counsel sent more than twenty emails reflecting "legal advice" to Comcast's in-house counsel or outside litigation counsel, and received more than twenty emails or documents reflecting "legal advice" from Comcast's outside litigation counsel. Prelim. Resp. 19–20 (citing Ex. 2019). Patent Owner also points out that the privilege log refers to Comcast's in-house counsel as "co-counsel." *Id.* at 19. In Patent Owner's view, this evidence demonstrates "Petitioner's constant involvement and control of Comcast's participation in" the 2011 district court proceedings. *Id.* at 20.

In *ARRIS I*, the Board addressed a similar privity argument presented by Patent Owner, based on all the evidence currently before us, with the exception of the privilege log (Ex. 2019). *ARRIS I*, slip op. at 8–10. In the earlier case, the Board determined Patent Owner had not provided evidence sufficient to demonstrate that Petitioner exercised or could have exercised control over Comcast's participation in the 2011 district court proceeding.

Id. at 9. With regard to the Agreements, the Board determined the evidence showed, at best, that Comcast made indemnification claims, and that Petitioner settled those claims with Comcast. *Id.* at 10; *see* Ex. 2003, 125. In particular, the Board found the evidence was insufficient to show that Comcast provided prompt notification to Petitioner under the Agreements or that Petitioner exercised sole control or full authority as provided for in the Agreements. *ARRIS I*, slip op. at 10.

We reach a similar conclusion based on the present record in this case. Contrary to Patent Owner's argument, the existence of written communications between Petitioner's in-house counsel and Comcast's counsel, even if characterized as "legal advice," does not establish that Petitioner controlled Comcast's participation in the 2011 district court proceeding. Moreover, the present record does not demonstrate sufficiently that Comcast made claims under the Agreements that would have triggered Petitioner's right to exercise control over the 2011 district court proceeding. As in *ARRIS I*, Patent Owner has not pointed to evidence in the record from which we could infer that Petitioner exercised control or could have exercised control as provided for in the Agreements. *See ARRIS I*, slip op. at 10.

Accordingly, based on the record at this preliminary stage, we determine that Patent Owner has not shown sufficiently that Petitioner and Comcast were in privity with respect to the 2011 district court proceeding. Thus, 35 U.S.C. § 315(b) does not bar institution of *inter partes* review. Our determination is without prejudice to Patent Owner presenting additional arguments or evidence regarding privity in a Patent Owner Response.

C. Claim Construction

As acknowledged by the parties, the '883 patent has expired. Pet. 6; Prelim. Resp. 25. For claims of an expired patent, the Board's claim construction analysis is similar to that of a district court. *See In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). In this context, claim terms "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). "In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence." *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17).

Petitioner asserts that for purposes of this proceeding, all claim terms should have their ordinary and customary meaning. Pet. 6. Patent Owner states that its arguments "are not predicated on any particular claim constructions being accepted by the Board." Prelim. Resp. 25–30. For purposes of this decision, we determine that no claim terms require express construction.

D. Asserted Obviousness Grounds

Petitioner contends that claims 1 and 4 are unpatentable under 35 U.S.C. § 103(a) as obvious over MPT 1343, MPT 1347, and MPT 1327. Pet. 19–51. Petitioner also contends that claim 3 is unpatentable under 35 U.S.C. § 103(a) as obvious over MPT 1343, MPT 1347, and MPT 1327, as applied to claim 1, and further in view of Zdunek and Dufresne. Pet. 51–60.

1. The MPT References

MPT 1343, MPT 1347, and MPT 1327 (collectively, the "MPT Specifications") are documents promulgated by the British Ministry of Post and Telecommunications providing standards for communications in trunked radio networks. *See generally* Exs. 1005, 1006, 1007. The MPT Specifications define interrelated aspects of a trunked radio system, and the three documents reference one another explicitly. *See, e.g.*, Ex. 1006 § 1.1 ("MPT 1343 is designed to be read in association with MPT 1327."); *id.* § 2 (MPT 1343 referring to MPT 1327 and MPT 1343 as "associated documents"); Ex. 1005, Foreword (MPT 1327 referring to MPT 1343 and MPT 1347); Ex. 1007, Foreword (MPT 1347 stating that "[a] companion specification, MPT 1343, contains the requirement to be met by radio units to be used with these networks").

MPT 1343 provides definitions of various terms used in the MPT Specifications. Ex. 1006 § 3.1. For example, a "radio unit" is "[a] mobile or other user station contacting a system by normal land mobile radio in accordance with the specification." *Id.* A "trunking system controller," or "TSC," is defined as "[t]he central intelligence necessary to enable the trunking system to function according to MPT 1327." *Id.* A "control channel" is defined as "[a] forward channel and return channel being used for the transmission of messages conforming to MPT 1327 with the primary purpose of enabling the [TSC] to control radio units." *Id.*

Together, the MPT Specifications describe processes for establishing and maintaining communications in a standard-compliant MPT-based network. For instance, when a radio unit is switched on and has valid registration information stored in memory from a prior use on a network, the

radio unit executes a "single channel hunt sequence" and tunes to the control channel indicated in the previous record. Ex. 1006 § 9.3.3.2.2. The radio then attempts to confirm the control channel by testing the channel in accordance with MPT 1343 § 9.3.4 before any transmissions on the control channel are allowed. *Id.* § 9.3.3.2.2. Once the control channel is confirmed, and the radio determines that registration is not required, the radio is free to initiate calls, and normal operation proceeds. *Id.* § 10.2.3. If registration is required, and the radio does not hold a successful registration, the radio executes the registration procedures of MPT 1343, which are allowed, denied, or failed by the TSC. *Id.* § 10.2.3; Ex. 1005 § 8.2.1.2. Once registered, the radio unit enters normal operations on the network. During normal operation, a radio unit monitors its control channel for a variety of conditions to determine whether it must leave that control channel and return to control channel hunting procedures. Ex. 1006 § 9.4.1.

In the event of network failure, the network may implement a fall-back procedure to provide reduced network capability until normal function is restored. *Id.* § 13. When fall-back operation is signaled, each radio unit relapses to a pre-programmed channel. *Id.* § 13.1. Fall-back procedures may be terminated through either the network signaling to exit from fall-back, or the user selecting to transfer to a different network. *Id.* § 13.5.

2. Claims 1 and 4

Petitioner contends that the MPT Specifications teach all of the limitations of independent claim 1. Pet. 19–46. First, Petitioner contends that if the preamble of claim 1 is construed as a limitation, the MPT

Specifications disclose all features set forth in the preamble.[8] *Id.* at 19. For example, Petitioner asserts that the MPT Specifications define a frequency divided "multiple access communication system." *Id.* at 20 (citing Ex. 1006 §§ 4.1, 4.1.1, 4.1.2, 5.1.1, 5.1.2; Ex. 1005 § 1.3.3.1 (describing use of a random access protocol based on slotted Aloha, which is used in multiple access communication systems); Ex. 1002 ¶¶ 87–88). Petitioner also submits that the TSC in the MPT Specifications, which is described as the "central control intelligence" and controls a number of processes, including registration, corresponds to the recited "central controller." *Id.* at 21 (citing Ex. 1006 § 3.1; Ex. 1005 §§ 8.1, 8.2). Further, according to Petitioner, the MPT "radio units" are a "plurality of remote terminals," and airwaves carrying user communications and signalling data on radio frequency channels are "a shared transmission means for signalling data and user information." *Id.* at 21–23 (citing Ex. 1006 §§ 4.1.1, 4.1.2, 5.1.1, 5.1.2; Ex. 1005 § 1.3.2).

Turning to the method recited in claim 1, Petitioner asserts that the MPT Specifications describe a "method of allocating signalling data channels" (i.e., MPT control channels) "from a plurality of communication channels" (channels in the MPT system which may be flexibly allocated as control channels or traffic channels). *Id.* at 23 (citing Ex. 1006 § 3.1). For limitations (a)–(e) in the body of claim 1, Petitioner details how the MPT Specifications describe two separate procedures that allegedly perform the recited steps—(i) the single channel hunt sequence, followed by normal operation, and (ii) the fall-back procedure. *Id.* at 24–46. In Petitioner's

[8] For purposes of this decision, we need not decide whether the preamble of claim 1 is limiting.

analysis of both procedures, each MPT control channel corresponds to a "pair" of "signalling data channels," as recited in the claim, because each control channel carries signalling messages and comprises both a forward channel and a return channel. *Id.* at 24–25 (citing Ex. 1006 § 3.1 (definition of "control channel")).

Petitioner contends that the MPT single channel hunt sequence and subsequent normal system operation meet the requirements of steps (a)–(e) in the following manner. Pet. 26–29, 32–33, 35–36, 38–41, 43–45.[9] When an MPT radio unit switches on, and the radio holds a valid record of a channel number on which the radio unit most recently was confirmed, the radio tunes to that control channel. Ex. 1006 § 9.3.3.2.2. Thus, according to Petitioner, remote terminals are "initially assigned to a pair of predetermined signalling data channels," as recited in step (a). Pet. 29. Petitioner asserts that after control channel confirmation and successful registration, normal operation ensues, so that communications between the central controller (i.e., TSC) and remote terminals (i.e., radio units) via a plurality of signalling data channels (i.e., MPT control channels) have been established, as required by step (a). *Id.* at 27–28.

Step (b) of claim 1 recites "monitoring the status of a plurality of the signalling data channels in use between said central controller and said plurality of remote terminals for the usability of said signalling data channels." Petitioner submits that the disclosed MPT system in normal

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[9] For purposes of this decision, we focus on Petitioner's contentions regarding the single channel hunt sequence and normal operation procedure. The Petition provides a similarly detailed analysis for its contention that the fall-back procedure also satisfies the limitations of claim 1. *See* Pet. 29–31, 33–34, 36–37, 42–43, 45–46.

operation meets this limitation because a radio unit monitors its current control channel, e.g., by carrying out error checking measurements, and must leave the channel when a certain error condition occurs. *Id.* at 32–33 (citing Ex. 1006 §§ 9.3.4.3, 9.4.1; Ex. 1007 § 9.4.4). Because the radio unit leaves the current control channel when this condition occurs, Petitioner contends that a determination has been made that the radio unit needs to be reassigned to a different control channel, satisfying step (c) ("determining whether one of said plurality of remote terminals needs to be reassigned to a different signalling data channel other than said predetermined signalling data channel"). *Id.* at 35 (citing Ex. 1006 § 9.4.1).

Step (d) of claim 1 recites "determining whether a different and suitable signalling data channel is available other than said predetermined channel." Petitioner submits that the system described in the MPT Specifications meets this limitation when a radio unit leaves the current control channel upon occurrence of an error condition and enters the "preferential hunt sequence." *Id.* at 38 (citing Ex. 1006 § 9.4.1). In the mandatory "preferential area hunt stage" of that sequence, the radio unit samples control channels identified in its read/write memory. *Id.* at 39 (citing Ex. 1006 § 9.3.3.3). Before communicating on a new (i.e., different) control channel, the radio must confirm the channel and perform error checking, a process that, according to Petitioner, determines whether the channel is available and suitable for use, as required by the claim. *Id.* at 40 (citing Ex. 1002 ¶¶ 154–55).

Finally, step (e) of claim 1 recites "reassigning by said central controller said remote terminal to a different and suitable signalling data channel for communication henceforward." Once a new (i.e., "different and

suitable") control channel has been confirmed, the radio unit initiates a process to register with the network. Ex. 1006 § 10.2.3. Petitioner contends that MPT 1327 describes various registration acknowledgement messages sent by the TSC (i.e., the claimed "central controller") and demonstrates that the TSC controls the registration process and updates and maintains registration records. Pet. 44–45 (citing Ex. 1005 § 8.2.1.2; Ex. 1006 §§ 10.1.1, 10.2.1; Ex. 1002 ¶¶ 166–67). Based on these disclosures, Petitioner contends that a person of ordinary skill in the art would understand that when the TSC grants a new registration, it reassigns the radio unit to the new control channel. *Id.* at 45 (citing Ex. 1002 ¶ 167).

Patent Owner contends that the MPT Specifications do not teach the steps recited in claim 1. Prelim. Resp. 31–44. According to Patent Owner, information obtained from "monitoring" step (b) must be used in step (c) to determine whether a remote terminal needs to be reassigned to a different signalling channel. *Id.* at 38. Then, contends Patent Owner, step (d) requires determining whether another channel exists that will resolve the problem on the original control channel determined previously. *Id.* at 33, 38. Only then in step (e), Patent Owner continues, does the central controller reassign a remote terminal to the alternative, more suitable channel determined in step (d). *Id.* at 33, 38. Patent Owner submits these steps cannot be performed in this manner without a central controller that is involved in the claimed monitoring, determining, and reassigning steps. *Id.* at 33, 38–39. Because the portions of the MPT Specifications relied on by Petitioner describe radio units, rather than a central controller, performing steps (b)–(d), Patent Owner argues that the MPT Specifications do not render claim 1 obvious. *Id.* at 33–34.

On this record, we are not persuaded by Patent Owner's arguments. With the exception of "reassigning" step (e), claim 1 does not explicitly require a central controller to perform the recited steps. In arguing that claim 1 requires steps (b)–(d) to be performed by the central controller, Patent Owner appears to read limitations into the claim. *See id.* at 33, 38–39. For example, step (c) does not recite using information obtained in step (b), as Patent Owner contends, nor does the claim require resolving the problem on the current channel. *See id.* at 38. Patent Owner's argument that step (b) requires a single device (e.g., a central controller) to monitor the status of a plurality of signalling channels is also unpersuasive, as the claim does not require any particular device or entity to perform the recited step. *See id.* Moreover, Patent Owner's argument is premised on the steps being performed in the order presented. *See id.* at 33. Unless a method claim actually recites a particular order, however, the steps are not ordinarily construed to require one. *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1342 (Fed. Cir. 2001). Patent Owner does not cite any specific support in the '883 patent for its narrow construction of claim 1.

Patent Owner also contends the Petition offers no explanation as to why it would have been obvious to combine the functionalities defined by the MPT Specifications in the manner asserted. Prelim. Resp. 32 n.16. We disagree. Petitioner explains the MPT Specifications define portions of an interrelated trunked radio system, such that their teachings naturally would have been combined to create an MPT-compliant network. Pet. 17; *see also* Ex. 1002 ¶¶ 170–72. Also, as discussed, the three documents relied upon by Petitioner explicitly reference one another. *Id.* at 18. Based on the current

record, we are persuaded that Petitioner has articulated a sufficient rationale for combining MPT 1343, MPT 1347, and MPT 1327.

On the present record, Petitioner has shown sufficiently that the combination of MPT 1343, MPT 1347, and MPT 1327 teaches all of the limitations of independent claim 1, and has provided articulated reasoning with rational underpinning for combining the references. Pet. 17–46. Petitioner also has shown sufficiently that the combination teaches the limitations of dependent claim 4, for which Patent Owner makes no additional arguments. *Id.* at 46–51; Prelim. Resp. 44. Accordingly, the information presented shows a reasonable likelihood that Petitioner would prevail in showing that claims 1 and 4 are unpatentable for obviousness over MPT 1343, MPT 1347, and MPT 1327.

3. Claim 3

Claim 3 depends from claim 1 and recites further limitations on the "monitoring" step. Based on the record before us, Petitioner has shown sufficiently that the combination of MPT 1343, MPT 1347, and MPT 1327, along with Zdunek and Dufresne, teaches the additional limitations of claim 3. *See* Pet. 51–60. Petitioner also has provided articulated reasoning with rational underpinning for combining the references. Pet. 54, 56–57 (citing Ex. 1002 ¶¶ 182, 190–91). Patent Owner makes no additional arguments with respect to claim 3. Prelim. Resp. 44. Accordingly, the information presented shows a reasonable likelihood that Petitioner would prevail in showing that claim 3 is unpatentable for obviousness over MPT 1343, MPT 1347, MPT 1327, Zdunek, and Dufresne.

E. Motion to Seal

Petitioner filed an unopposed Motion for Entry of the Default Protective Order, Paper 12, and a copy of the Board's default protective order, Exhibit 1020. We granted Petitioner's Motion. Paper 15. Patent Owner's Preliminary Response, Paper 16, was accompanied by a Motion to Seal its Preliminary Response and Certain Associated Exhibits, Paper 17 ("Mot. to Seal"), and a redacted version of the Preliminary Response, Paper 18.

The standard for granting a motion to seal is good cause. 37 C.F.R. § 42.54(a). Patent Owner asserts that the Preliminary Response should be sealed because it refers to and discusses confidential documents produced by Petitioner, designated as protective order material pursuant to the entered Protective Order. Mot. to Seal 1. Patent Owner also asserts that Exhibits 2013, 2015, 2016, and 2017 should be sealed because they include documents designated as protective order material. *Id.* We have reviewed the redacted material in the Preliminary Response and the cited Exhibits, and we are persuaded that good cause exists to have them remain under seal. Accordingly, we grant Patent Owner's Motion to Seal.

We also note that there is an expectation that confidential information subject to a protective order will be made public where the existence of the information is referred to in a decision to grant or deny a request to institute review or is identified in a final written decision. Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,761. In deciding to institute this *inter partes* review, we have found it necessary to discuss generally Petitioner's confidential and sensitive business information referenced by Patent Owner in its Preliminary Response. *See supra* Section II.B. Therefore, to the

extent that Petitioner's confidential and sensitive business information is discussed in this decision, there is an expectation it will be made public.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented establishes a reasonable likelihood that Petitioner would prevail in showing that claims 1, 3, and 4 of the '883 patent are unpatentable. At this preliminary stage, the Board has not made a final determination with respect to the patentability of the challenged claims or any underlying factual and legal issues.

IV. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted as to claims 1, 3, and 4 of the '883 patent on the following grounds of unpatentability:

A. Claims 1 and 4 under 35 U.S.C. § 103(a) as obvious over MPT 1343, MPT 1347, and MPT 1327; and

B. Claim 3 under 35 U.S.C. § 103(a) as obvious over MPT 1343, MPT 1347, MPT 1327, Zdunek, and Dufresne;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, which commences on the entry date of this decision; and

FURTHER ORDERED that Patent Owner's Motion to Seal (Paper 17) is granted, and the Preliminary Response (Paper 16) and Exhibits 2013, 2015, 2016, and 2017 will be kept under seal under the terms of the protective order entered in this proceeding (Ex. 1020).

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