

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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T-MOBILE US, INC. AND T-MOBILE USA, INC.,

Petitioners,

v.

BARKAN WIRELESS ACCESS TECHNOLOGIES, L.P.,

Patent Owner.

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Case IPR2017-01098 (Patent 8,559,369 B2)

Case IPR2017-01099 (Patent 9,042,306 B2)<sup>1</sup>

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Before MEREDITH C. PETRAVICK, JOHN A. HUDALLA, and  
SHARON FENICK, *Administrative Patent Judges*.

FENICK, *Administrative Patent Judge*.

ORDER  
*Conduct of the Proceeding*  
37 C.F.R. § 42.5

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<sup>1</sup> The issues are the same in each of the proceedings listed above. We, therefore, issue one Order to be filed in each proceeding.

IPR2017-01098 (Patent 8,559,369 B2)

IPR2017-01099 (Patent 9,042,306 B2)

Certain claims of U.S. Patent No. 8,559,369 B2 and U.S. Patent No. 9,042,306 B2 recite the following limitation:

[“a” or “at least one”] communication module adapted to: (1) wirelessly connect said computing device to an IP based network via a first wireless access point (AP) having a first AP Identification (APID); and (2) wirelessly communicate with other wireless enabled computing devices.

*See* Ex. 1001<sup>2</sup>, claim 1 (“the communication module limitation”).

Both parties indicate that the communication module limitation is in means-plus-function format and should be construed according to 35 U.S.C. § 112(6). *See* Paper 2 (“Pet.”) 16–17, Paper 7 (“Prelim. Resp.”) 8–10. The Federal Circuit recently explained that, “regardless of the context in which the interpretation of means-plus-function arises,”

the construction of a means-plus-function limitation under § 112 ¶ 6 “must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.”

*IPCom GmbH & Co. v. HTC Corp.*, 861 F.3d 1362, 1369 (Fed. Cir. 2017) (quoting *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc)); *see Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349–50 (Fed. Cir. 2015) (en banc in relevant part).

Petitioner identifies portions of the specifications that allegedly disclose “software in a computing device” that corresponds to the function of “wireless communication.”<sup>3</sup> Pet. 16–17. After the Petition was filed, the

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<sup>2</sup> For the purposes of this Order, IPR2017-01099 is representative and all citations are to papers in IPR2017-01099 unless otherwise noted.

<sup>3</sup> Petitioner also states that “[n]o construction is necessary.” Pet. 16. We find this statement confusing as it seems to suggest that Petitioner does not

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United States District Court for the Eastern District of Texas issued a Claim Construction Memorandum and Order in a related case determining that the communication module limitation is in means-plus-function format and that the corresponding structure is “a wireless network card, and equivalents thereof.” Ex. 2001, 33–35. Patent Owner points to this as the corresponding structure. Prelim. Resp. 9–10, 20.

The parties, thus, point to different structure in the patents as the corresponding structure. For the purpose of determining whether to institute trial in these *inter partes* reviews, and in light of the Texas district court’s recent order, we now require additional briefing concerning the construction of the communication module limitation. The briefs should:

- (1) address whether the communication module limitation is in means-plus-function format requiring construction according to 35 U.S.C. § 112(6), answering yes or no, and explaining why or why not; and
- (2) if the communication module limitation is governed by § 112(6), state the corresponding structure of the communication module limitation and explicitly provide citation to the corresponding description in the patents.

Each party should file one brief addressing the construction of the communication module limitation in both patents. A copy of the brief should be filed in both IPR2017-01098 and IPR2017-01099.

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contend that the communication module limitation is in means-plus-function format.

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It is:

ORDERED that the parties shall file additional briefing, no later than September 12, 2017, limited, for each party, to 800 words, and limited to addressing the construction of the communication module limitation as specified above.

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