

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.,

Petitioner,

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*.

DECISION

*Denying Petitioner's Requests for Rehearing*  
*37 C.F.R. § 42.71(d)*

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<sup>1</sup> This decision addresses issues pertaining to both cases. Therefore, we exercise our discretion to issue a single Decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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

In each of the instant proceedings, T-Mobile US, Inc. and T-Mobile USA, Inc. (collectively, “Petitioner”) filed a Request for Rehearing of our Decision not to institute *inter partes* review for certain claims challenged in the petition.<sup>2</sup> Petitioner’s arguments in the Request for Rehearing filed in the IPR2017-01098 proceeding relate to our denial of institution of *inter partes* review of claims 1 and 3–15 of the ’306 patent, and in the IPR2017-01099 proceeding relate to our denial of institution of *inter partes* review of claims 1 and 4–7 of the ’369 patent. The arguments made by the parties and the factual circumstances of each case are similar. For the purposes of this Decision, we treat the Request for Rehearing in Case IPR2017-01099 as representative, and specifically discuss the circumstances of that request. The present Decision, however, applies equally to both Requests for Rehearing. For the reasons below, Petitioner’s Requests for Rehearing are *denied*.

#### *Standard of Review*

In determining whether to institute an *inter partes* review, the Board may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b). When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). “An abuse of discretion occurs if a decision is based

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<sup>2</sup> See IPR2017-01098, Papers 12, 14; IPR2017-01099, Papers 11 (“Institution Decision” or “Dec.”), 14 (“Req. Reh’g”). Unless otherwise specified, we refer to papers filed in IPR2017-01099 and, with respect to the specification of the patents, to U.S. Pat. No. 9,042,306 (Ex. 1002) (“the ’306 patent”). The written description of U.S. Pat. No. 8,559,369 (the “’369 patent”) is substantively identical.

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on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). The party requesting rehearing bears the burden of showing an abuse of discretion, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.”

37 C.F.R. § 42.71(d).

Petitioner’s Requests for Rehearing specifically assert that we erred in adopting a construction of a claim term which is narrower than that applied by a district court in a related case. Because the district court’s construction applied the *Phillips* standard, Petitioner argues that adopting a narrower construction is improper and contrary to the public interest and injects uncertainty and ambiguity into the claims. Req. Reh’g. 6–7. Petitioner notes that Petitioner and Patent Owner supported adopting the district court construction. *Id.* at 9–10. Petitioner argues that we “did not properly consider how a person of ordinary skill in the art would read” certain portions of the specification. *Id.* at 11–12.

For the reasons discussed below, Petitioner’s Requests for Rehearing are *denied*.

### *Background*

In the Institution Decision, we addressed the construction of “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” (the “communication module limitation”) Dec. 8–14.

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The United States District Court for the Eastern District of Texas issued a Claim Construction Memorandum and Order in a case involving the same patents (*Barkan Wireless Access Technologies, LP v. Cellco Partnership d/b/a Verizon Wireless et al.*, 2:16-cv-00293 (E.D. Tex.) (filed Mar. 29, 2016)), 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.

We agreed with the parties, for the purposes of institution, that the communication module limitation should be construed as a means-plus-function term under 35 U.S.C. § 112 ¶ 6. *Id.* at 8–9.

Petitioner argued that we should find “software in a computing device” to be the corresponding structure. Paper 2 (“Pet.”) 16–17. In supplemental briefing, Petitioner indicated that we should adopt the corresponding structure identified by the district court. Paper 9, Petitioner’s Supplemental Brief Regarding “Communication Module” (“Pet. Supp. Br.”), 2 nn.3, 4. Petitioner argued that the disclosed structure could be met by prior art having “either one, two, or more network cards, or equivalents thereof.” Pet. Supp. Br. 2–3.

Patent Owner also argued that we should adopt the district court’s corresponding structure. Paper 7 (“Prelim. Resp.”), 8–10 (citing Ex. 2001, 33–34); Paper 10, Patent Owner’s Supplemental Brief Addressing the Construction of the “Communication Module” Limitation (hereinafter “Pat. Own. Supp. Br.”) 2–3.

We determined in our preliminary construction that the disclosed structure only supports the use of a single wireless network card. Dec. 12–14. Although the district court cited column 31, lines 22–24 of the

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'306 Patent in its analysis of the disclosed structure for the communication module limitation (Ex. 2001, 34), we determined that that portion of the '306 Patent specification is not related to the identified function for the communication module limitation. Dec. 12–13.

### *Analysis*

In the Institution Decision, we interpreted the claims using the broadest reasonable construction in light of the Specification. Dec. 7–13. Contrary to Petitioner's contentions, our interpretation was not inconsistent with the broadest reasonable interpretation and its purpose.

Petitioner argues that the Board's preliminary construction of the communication module limitation is erroneous in light of the district court's interpretation according to the *Phillips* standard. Req. Reh'g 4–8; *see generally Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). Petitioner contends that it is error for a claim interpretation under the broadest reasonable interpretation standard to be narrower than one reached under the *Phillips* standard, and that we have done so in this case, which is improper and contrary to the public interest. Req. Reh'g. 4–7 (citing *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016)). Petitioner argues that “[t]he district court's construction of ‘communication module’ is reasonable.” Req. Reh'g 9–11. Because of this, Petitioner contends, it must be included within the scope of the construction under the broadest reasonable interpretation standard. *Id.* at 10.

Initially, we note that, because “a wireless network card” is not necessarily broader than “a single wireless network card,” the question of whether the district court's construction of the disclosed structure (“a wireless network card, and equivalents thereof”) is narrower than the

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