

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC. and T-MOBILE USA, INC.,
Petitioner,

v.

BARKAN WIRELESS ACCESS TECHNOLOGIES, L.P.,
Patent Owner.

Case IPR2017-01099
Patent 9,042,306 B2

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

FENICK, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Barkan Wireless Access Technologies, L.P. (“Patent Owner”) filed a Request for Rehearing (Paper 44, “Request” or “Reh. Req.”) of our Final Written Decision (Paper 42, “Final Written Decision” or “Dec.”) in which we determined that claims 1, 3–17, 19, 21–46, 48–56, and 58–68 of U.S. Patent No. 9,042,306 B2 (Ex. 1002, “the ’306 patent”) are unpatentable. For the reasons that follow, Patent Owner’s Request for Rehearing is denied.

II. THE REQUEST FOR REHEARING

In pertinent part, 37 C.F.R. § 42.71(d) states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

Thus, a request for rehearing is not an opportunity merely to disagree with the Board’s assessment of the arguments or weighing of the evidence, or to present new arguments or evidence.

Patent Owner’s arguments relate to three elements of the Final Written Decision. First, with respect to the claim construction used for the “communication module limitation” (*see* Dec. 11), Patent Owner argues that that construction constitutes an impermissible change of theories without providing Patent Owner the opportunity to present arguments under the new theory (Reh. Req. 1); that “the Board failed to analyze” Patent Owner’s arguments concerning support in the ’306 patent’s Specification for Patent Owner’s claim construction (Reh. Req. 2–3); and that in reaching our claim

construction we “did not apply Federal Circuit precedent holding that ‘the fact that a patent asserts that an invention achieves certain objectives does not require that each of the claims be construed as limited to structures that are capable of achieving all of the objectives.’” Reh. Req. 2 (citing Paper 41 (“Tr.”), 29:1–4). Second, Patent Owner argues that the Final Written Decision improperly considered and relied upon new arguments by Petitioner. Reh. Req. 2. Lastly, Patent Owner argues error in the finding “that certain network devices identified in the prior art satisfied the claims’ requirements for the use of a proxy server.” Reh. Req. 2–4.

We have reviewed Patent Owner’s Request and carefully considered all of the arguments presented. For the following reasons, we are not persuaded that we misapprehended or overlooked any arguments or evidence.

III. REQUEST FOR EXPANDED PANEL

In the Request, Patent Owner “respectfully requests that an expanded panel be designated to consider this request for rehearing and to decide the rehearing on its merits.” Reh. Req. 4–5. Our governing statutes and regulations do not provide for parties to request, or panels to authorize, an expanded panel. *See generally* 35 U.S.C. § 6; 37 C.F.R. §§ 41.1–42.408. However, the Chief Judge may consider panel expansions upon a “suggestion” from, *inter alia*, a patent owner or petitioner. PTAB SOP 1, 15; *see also Apple Inc. v. Rensselaer Polytechnic Inst.*, Case IPR2014-00319, slip op. at 2 n.1 (PTAB Dec. 12, 2014) (Paper 20) (expanded panel) (per curiam).

The standard operating procedure describes some of the reasons for which the Chief Judge may expand a panel. PTAB SOP 1, 15 (§ III.M) (Rev. 15). For example, an expanded panel may be appropriate “to secure and maintain uniformity of the Board’s decisions, e.g., in related cases ordinarily involving different three judge panels.” *Id.* (§ III.M.1).

In this case, the Chief Judge has considered Patent Owner’s suggestion for an expanded panel, but has determined that an expanded panel is not warranted.

IV. DISCUSSION

A. *Change in Claim Construction*

For the “communication module limitation” of claim 1, the Decision on Institution preliminarily construed the limitation as a means-plus-function limitation, finding that the corresponding structure is “a single wireless network card, and equivalents thereof” and determining that the scope of equivalents excludes multiple wireless network cards. Paper 11 (“Decision on Institution”) 9–14. In the Final Written Decision, we modified this construction to remove the exclusion of multiple wireless network cards from the scope of the equivalents. Final Written Decision 11–16.

Patent Owner argues that this is a “midstream” change of theory, impermissibly adopted without providing Patent Owner an opportunity to respond. Reh. Req. 1 (citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015)).

However, the construction of the communication module limitation, including the scope of equivalents, was at issue throughout the proceeding, and thus Patent Owner has received sufficient “notice of and a fair

opportunity” to address the issue of whether multiple wireless network cards would be within the scope of equivalents for the disclosed structure. *Belden*, 805 F.3d at 1080.

Before institution, we asked the parties to address the issue of the disclosed structure in an order requiring pre-institution briefing. Paper 8. Pursuant to this order, the parties filed such briefing. Paper 9; Paper 10.

After institution, Patent Owner proposed in its response that the Board adopt the district court’s construction. Paper 19 (“PO Resp.”), 7–8. This construction, like our claim construction in the Final Written Decision, included no limitation on the scope of equivalents. Ex. 2001, 35. The issue was also discussed at the oral hearing. Tr. 5 (Judge Hudalla to Petitioner, “Our preliminary construction said a single network card or equivalents, right? Should the equivalents include more than one network card? I mean, that’s something we struggled with”), 28–30 (questions to Patent Owner regarding two cards as an equivalent to disclosed structure). Therefore, as in *Belden*, Patent Owner had notice of the issue and opportunity to respond.

With respect to the argument that we failed to analyze Patent Owner’s arguments concerning support in the ’306 patent’s Specification for its claim construction and that we did not properly apply Federal Circuit precedent, Patent Owner’s mere disagreement with our analysis is not a proper basis for a rehearing request, and does not persuade us that we overlooked or misapprehended the above evidence and argument that Patent Owner provided.

B. New Arguments

Patent Owner contends that we violated the Administrative Procedure Act by considering and relying upon “new arguments, to which Patent

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