

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*.

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

On April 24 2018, the Supreme Court held that, in a decision to institute an *inter partes* review under 35 U.S.C. § 314, the Board is not authorized to order a trial to proceed on fewer than all claims challenged in a petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018). On April 27, 2018, we modified our institution decision to institute on all of the challenged claims, *inter alia*, presented in the Petition (Paper 2). Paper 26.

Petitioner previously requested (Paper 18) and received (Paper 20) a refund in the amount of \$7,600.00 of the post-institution fee paid in connection with nineteen patent claims that were denied review in our institution decision. The introduction of newly instituted claims at this stage of the proceeding requires repayment of the refund. Accordingly, we require Petitioner to repay the post-institution fee that was refunded in the amount of \$7,600.00. Paper 20.

Repayment of the refunded post-institution fee in the amount of \$7,600.00 is due within five (5) business days of the date of this Order. Given that our authority to institute review is limited to a “binary choice” between proceeding on all, or none, of the claims challenged in a petition (*SAS* at 1355), **if repayment of the refunded post-institution fee is not timely made, the Board shall terminate this proceeding in its entirety.**

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is required to repay the refunded post-institution fee in the amount of \$7,600.00;

FURTHER ORDERED that repayment of the refunded post-institution fee is due within five (5) business days of the date this Order;

FURTHER ORDERED that, if repayment of the refunded post-institution fee is not timely made, this proceeding shall be terminated in its entirety.

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