

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

Held: July 10, 2018

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

Case IPR2017-01099
Patent 9,042,306 B2

APPEARANCES:

ON BEHALF OF THE PETITIONER:

MATTHEW C. BERNSTEIN, ESQUIRE
MIGUEL BOMBACH, ESQUIRE
Perkins Coie
11988 El Camino Real
Suite 350
San Diego, California 92130-2594

ON BEHALF OF PATENT OWNER:

ROBERT KATZ, ESQUIRE
Katz PLLC
6060 North Central Expressway
Suite 560
Dallas, Texas 75206

The above-entitled matter came on for hearing on Tuesday, July 10, 2018, commencing at 10:00 a.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

P R O C E E D I N G S

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JUDGE FENICK: Good morning. I'm Judge Fenick. This is Judge Petravick and Judge Hudalla. We'll hear argument now in case number IPR2017-01099, T-Mobile US, Inc., and T-Mobile USA, Inc., versus Barkan Wireless Access Technologies concerning U.S. patent number 9,042,306 B2. Will counsel for the parties please introduce yourselves, starting with petitioner.

MR. BERNSTEIN: Your Honor, Matthew Bernstein from Perkins Coie. And with me is Miguel Bombach, also from Perkins Coie, for T-Mobile.

MR. KATZ: Your Honors, Robert Katz for patent owner, Barkan Wireless Access Technologies.

MR. BERNSTEIN: Your Honor, I forgot to mention that Steve McGrath from T-Mobile is also here.

JUDGE FENICK: Thank you. Welcome to the Board. Per our order dated June 15, 2018, each side has 30 minutes to argue. The petitioner will argue first and may reserve rebuttal time. The patent owner may not reserve rebuttal time.

I'll remind the parties that the petitioner bears the burden of proving any proposition of unpatentability by a preponderance of the evidence. I also remind the parties that the hearing is open to the public. A full transcript will become part of the record.

With that, I invite Mr. Bernstein to begin. Would you like to reserve time for rebuttal?

1 MR. BERNSTEIN: Yes, Your Honor, I'm planning on reserving
2 15 minutes.

3 JUDGE FENICK: Thank you.

4 MR. BERNSTEIN: Thank you, Your Honor. Good morning,
5 Your Honors. I would like to make first a few preliminary points, the first
6 one being to follow-up on your last point, Your Honor, is that T-Mobile has
7 shown by a preponderance of the evidence that all of the challenged claims
8 are invalid. There's no disputes in this matter that the references are prior
9 art. There's no evidence of any secondary consideration of nonobviousness
10 in this trial. And petitioners and only petitioners have submitted expert
11 testimony. Barkan did not submit any expert declarations. Barkan did not
12 take the expert deposition of Dr. Lavian. Dr. Lavian's testimony is
13 un rebutted.

14 Finally, with respect to these preliminary points, the Board's
15 institution decision, while preliminary, contained many factual and legal
16 findings, and by and large Barkan, in its patent owner responses and
17 supplemental patent owner responses, has not addressed any of the
18 arguments in the actual preliminary response, in the actual institution
19 decision.

20 I would like to now turn to communication module which is found
21 in independent claim 1 and its dependents. The discussion of
22 communication module needs to start with what has happened in the District
23 Court. Barkan has worked it so that we are in a situation right now where
24 there's a District Court case with a claim construction for communication
25 module that includes one or two network cards. That matter, that case is up

1 at the Federal Circuit right now but that Barkan chose, I assume
2 intentionally, not to appeal that claim construction for communication
3 module even though it knows that that District Court claim construction is
4 broader than the claim construction that the Board reached in its preliminary
5 claim construction.

6 So what we have right now is a situation where Barkan, when the
7 case goes back down to the District Court, is going to be arguing
8 infringement that T-Mobile's, Verizon's phones are phones that they sell
9 contain or infringe because they contain two network cards, while at the
10 same time in front of the three of you is going to be arguing that Buddhikot's
11 two-card architecture does not meet the communication module claim
12 construction.

13 T-Mobile thinks that that is legally incorrect. We also think it's
14 unfair, and that is one of the reasons why we think that the Board's
15 preliminary claim construction is not supported.

16 JUDGE HUDALLA: Let me ask you a question about that,
17 counsel. Our preliminary construction said a single network card or
18 equivalents, right? Should the equivalents include more than one network
19 card? I mean, that's something we struggled with.

20 MR. BERNSTEIN: So I think that the specification actually
21 supports an actual claim construction of one or two network cards or
22 equivalents. But if the Board were to maintain its only one network card and
23 not two, I think certainly under the doctrine of -- under the equivalents
24 prong, Buddhikot would teach that.

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