

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*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a)

I. INTRODUCTION

In this *inter partes* review, T-Mobile US, Inc. and T-Mobile USA, Inc. (collectively, “Petitioner”) challenge the patentability of claims 1–68 of U.S. Patent No. 9,042,306 B2 (Ex. 1002; “the ’306 patent”), which was assigned to Barkan Wireless Access Technologies, L.P. (“Patent Owner”).

We have jurisdiction under 35 U.S.C. § 6(b)(4). This Final Written Decision, issued pursuant to 35 U.S.C. § 318(a), addresses issues and arguments raised during this *inter partes* review. For the reasons discussed below, we determine that Petitioner has proven by a preponderance of the evidence that claims 1, 3–17, 19, 21–46, 48–56, and 58–68 of the ’306 patent are unpatentable. *See* 35 U.S.C. § 316(e) (“In an *inter partes* review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”).

A. Procedural History

On March 20, 2017, Petitioner requested *inter partes* review of claims 1–68 of the ’306 patent. Paper 2 (“Pet.”). The Petition relies on Declaration of Dr. Tal Lavian (Ex. 1003). Patent Owner filed a Preliminary Response. Paper 7. We required additional briefing regarding a claim construction issue (Paper 8) and Petitioner and Patent Owner each filed supplemental briefs. Paper 9 (“Pet. Supp. Br.”); Paper 10 (“PO Supp. Br.”).

On October 6, 2017, based on the record before us and in accordance with the Board’s practice at the time, we instituted an *inter partes* review of claims 16, 17, 19, 21–46, 48–56, and 58–68. Paper 11 (“Decision on Institution” or “Dec.”), 2, 55–56. Patent Owner filed a Patent Owner

Response (Paper 19, “PO Resp.”) and Petitioner filed a Reply (Paper 22, “Pet. Reply”), referring to an additional Declaration from Dr. Lavian (Ex. 1043).

On April 27, 2018, pursuant to the Supreme Court’s decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1358 (2018), holding that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition, we issued an Order modifying our Decision on Institution to institute review of all claims and all grounds of the Petition. Paper 26. Accordingly, the following grounds have been instituted:

Reference(s)	Basis	Claims Challenged
Buddhikot ¹ and Lord ²	§ 103	1–12, 14–22, 26–31, 34–37, 39, 40, 43, 47–53, 56–63, 65, and 66
Buddhikot, Lord, and Moran ³	§ 103	23–25, 41, 42, 44–46, 67, and 68
Buddhikot, Lord, and Abhishek ⁴	§ 103	32, 33, 54, and 55
Buddhikot, Lord, and Kim ⁵	§ 103	13, 38, and 64

See Pet. 1.

On May 3, 2018, we authorized additional briefing to address issues relating to the claims for which institution was not ordered originally in our Decision on Institution. Papers 26, 27. As per this authorization, Patent

¹ Buddhikot et al., U.S. Patent No. 7,562,393 B2, filed Oct. 20, 2003 (Ex. 1006).

² Lord et al., U.S. Patent No. 6,763,012 B1, issued Jul. 13, 2004 (Ex. 1007).

³ Moran, WO 2005/069577 A1, pub. July 28, 2005 (Ex. 1010).

⁴ Abhishek et al., U.S. Patent App. Pub. No. US 2004/0103278 A1, pub. May 27, 2004 (Ex. 1009).

⁵ Kim et al., U.S. Patent App. Pub. No. US 2004/0218611 A1, pub. Nov. 4, 2004 (Ex. 1008).

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Owner filed a Supplemental Response (Paper 28, “PO Supp. Resp.”), and Petitioner filed a Supplemental Reply (Paper 29, “Pet. Supp. Reply”). Oral Argument was conducted on July 10, 2018, and a transcript of that hearing is of record. Paper 41 (“Tr.”).

B. Related Matters

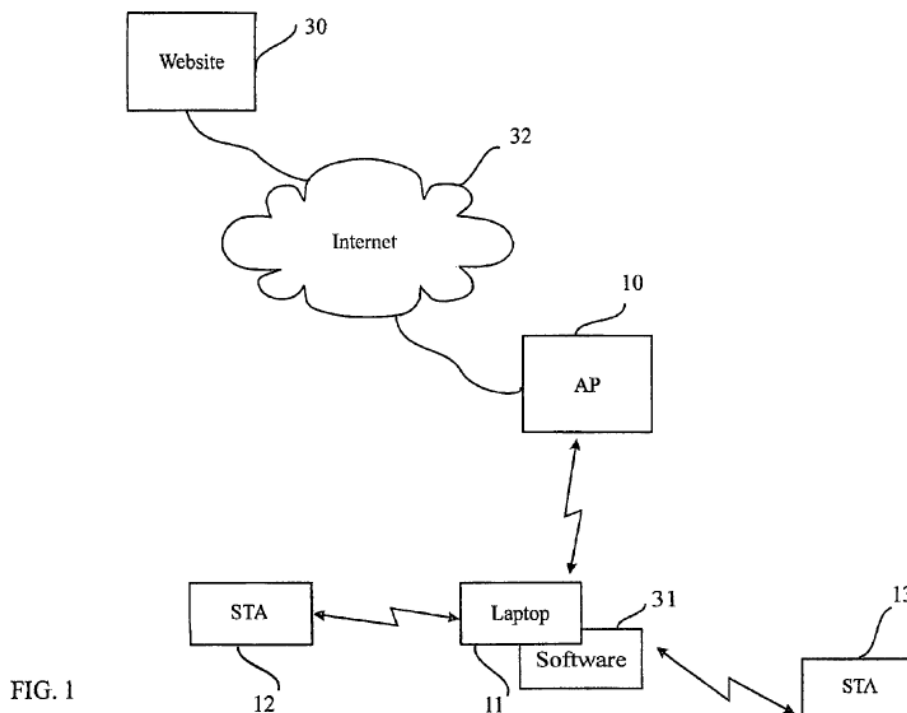
Petitioner and Patent Owner inform us that the ’306 patent is the subject of two lawsuits: *Barkan Wireless Access Technologies, L.P. v. T-Mobile US, Inc. and T-Mobile USA, Inc.*, 2:16-cv-00063 (E.D. Tex.) (filed Jan. 19, 2016) and *Barkan Wireless Access Technologies, LP v. Cellco Partnership d/b/a Verizon Wireless et al.*, 2:16-cv-00293 (E.D. Tex.) (filed Mar. 29, 2016) (“the Verizon case”). Pet. 2; Paper 4, 2.

Petitioner filed a petition for *inter partes* review of related U.S. Patent No. 8,559,369 B2 (Ex. 1001, “the ’369 patent”). Pet. 2; Paper 4, 2 (IPR2017-01098). IPR2017-01098 was terminated upon the Board granting Patent Owner’s request for adverse judgment under 37 C.F.R. § 42.73(b)(2). IPR2017-01098, Paper 19.

C. The '306 Patent

The '306 patent is titled “Wireless Internet System and Method” and generally relates to a device with Internet access through an access point that itself acts as an access point to allow other devices Internet access.

Ex. 1002, Abstr. Figure 1 of the '306 patent, reproduced below, illustrates an expanded wireless system for connecting mobile devices to the Internet through an intermediate device:



As shown above in Figure 1, the '306 patent discloses laptop 11 which is connected to Internet 32 via its access point (“AP”) 10. *Id.* at 10:49–50, 11:33–34, 11:37–38. Laptop 11 acts as a second AP for wireless-enabled devices, STA (for “station”) 12 and STA 13, with these devices connecting to the Internet 32 through laptop 11. *Id.* at Abstr., 1:31–32, 3:17–18, 11:37–41, 12:17–18.

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