

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

Owner did not have any opportunity to respond.” Reh. Req. 2. Patent Owner specifically cites as exemplary our citation of Petitioner’s Supplemental Reply in the Final Written Decision. *Id.* (citing Dec. 13). Patent Owner references a prior request for rehearing (Paper 34) of our June 8, 2018, Order (Paper 30, “the June 8 Order”) relating to Patent Owner’s request for a Motion to Strike or to file a paper identifying portions of Petitioner’s Reply and Supplemental Reply that Patent Owner asserted were new arguments. Reh. Req. 2. Patent Owner additionally references our denial of that prior rehearing request. *Id.* (citing Paper 40). However, the June 8 Order granted Patent Owner the relief it requested as it related to the Supplemental Reply. Paper 30, 3. In particular, we authorized Patent Owner to file a list of the alleged new arguments in the Supplemental Reply. *Id.* And the prior rehearing request sought relief only as to our disposition of issues related to the Reply. Paper 34. Thus, it is unclear why Patent Owner cites these papers to show that it had no opportunity to respond to arguments it contends are improperly found in the Supplemental Reply.

Although 37 C.F.R. § 42.23(b) prohibits new issues presented for the first time in reply, the reply may respond to arguments made on an already contested issue with appropriate new evidence. *Intelligent Bio-Systems v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (citing 37 C.F.R. § 42.23(b)). As set forth in the Final Written Decision, we found that Petitioner’s arguments, including those listed in Paper 33 (Patent Owner’s List of Improper Supplemental Reply Arguments), related to arguments made in the Patent Owner Preliminary Response, which were incorporated by reference into Patent Owner’s Supplemental Response. Final Written Decision 61–62. Patent Owner does not present any reasoning

or argument that persuades us that in making this determination we misapprehended or overlooked any arguments or evidence.

C. Proxy Server

Patent Owner contends we erred in determining that the prior art included devices that satisfied the claims' requirements relating to a proxy server. Reh. Req. 2–4. Patent Owner lists its contrary evidence and arguments relating to its contention that a virtual private network (“VPN”) gateway device (as in the prior art) could not be a proxy server or act as a proxy. *Id.* at 2–3.

We adopted Patent Owner's proposed construction for “proxy server” (“an intermediate server that accepts requests from the device and acts on behalf of the device”) and determined that no construction of the term “acts as proxy” was necessary in light of that construction. Dec. 16–18. Patent Owner argues, without further explanation, that we “overlooked or misapprehended the fact that Patent Owner explained in its proposed claim construction that a proxy server must actually service requests.” Reh. Req. 3. Nevertheless, we considered this argument as part of our treatment of Patent Owner's “proxy server” construction argument, wherein we adopted Patent Owner's claim construction of that term. PO Resp. 8–9; Dec. 16–18. Patent Owner also argues that we “failed to apply the requirement that a proxy server accept a request on behalf of the issuer, and then, if necessary, re-issue the request.” Reh. Req. 3 (citing PO Resp. 8, 51). However, we did not adopt any such “requirement” in our construction of “proxy server.” Nor is this argument found in Patent Owner's claim construction arguments or its arguments relating to whether a VPN gateway

is a proxy server. See PO Resp. 50–51 (discussing whether a “home agent” is a proxy server).

Patent Owner argues that we “failed to differentiate Virtual Private Network (VPN) equipment and gateway devices from the requirement for a proxy server or the function of ‘acts as proxy.’” Reh. Req. 2–3. We specifically addressed the question of whether a VPN gateway device in the prior art would teach or suggest the proxy server limitations in the claim and Patent Owner’s arguments relating to this issue. Dec. 25–27. In particular, our Decision addressed Patent Owner’s contentions that a VPN gateway could not be the claimed “proxy server” and did not “act as a proxy,” including examining whether the VPN gateway of the prior art met the construction we applied, and an analysis of the specification of the challenged patent and its discussion of a trusted computer that effectively creates a VPN. *Id.* Patent Owner argues that we disregarded evidence it presented to make this distinction, but does not point out where this evidence was addressed, as required by 37 C.F.R. § 42.71. Reh. Req. 2–4. To the extent that Patent Owner argues that we disregarded such evidence presented in Patent Owner’s arguments relating to whether the prior art VPN gateway teaches or suggests a proxy server (PO Resp. 21–26 (citing Exs. 2002, 2004, 2006, 2010)), we note again that these arguments were addressed, as described above.

Patent Owner does not persuade us that we misapprehended or overlooked any arguments or evidence. Merely disagreeing with our analysis or conclusions does not serve as a proper basis for a request for rehearing.

Patent Owner additionally argues that the testimony of Petitioner's declarant, Dr. Lavian, is flawed because it is conclusory and because it uses common sense to supply a missing claim limitation. Reh. Req. 3. Patent Owner argues that our reliance on Dr. Lavian's testimony contravenes the Board's Revised Trial Practice Guide, which cautions against using conclusory and unsupported expert testimony to supply a limitation. *Id.* at 3–4 (citing August 2018 Revised Trial Practice Guide, 4–5). However, the question before us was not whether common sense should be used to supply a missing claim limitation, but whether the prior art teaches the proxy server. Final Written Decision 24–26; PO Resp. 21–26; PO Supp. Resp. 1–3. We found that it does, and Patent Owner's arguments do not persuade us that we misapprehended or overlooked evidence or arguments relating to this claim limitation. We further note that the portion of Dr. Lavian's declaration cited in the Final Written Decision contains “supporting evidence of record,” and thus is not a “conclusory assertion . . . about general knowledge in the art . . . without supporting evidence of record.” August 2018 Revised Trial Practice Guide, 5; *see* Ex. 1003 ¶¶ 263–264 (cited in Final Written Decision 24–25, 27; cited in Reh. Req. 3). Patent Owner does not present any reasoning or argument that persuades us that, in making our determinations relating to the proxy server, we misapprehended or overlooked any arguments or evidence.

V. CONCLUSION

We have reviewed and considered the arguments in Patent Owner's Rehearing Request and conclude that Patent Owner has not carried its burden of demonstrating that the Board misapprehended or overlooked any matters in rendering the Final Written Decision. 37 C.F.R. § 42.71(d).

IPR2017-01099
Patent 9,042,306 B2

Thus, Patent Owner's challenge does not meet the standard set forth for a request for rehearing.

The Request for Rehearing is *denied*.

IPR2017-01099
Patent 9,042,306 B2

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