

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Haller, et al.
U.S. Patent No.: 7,039,033 Attorney Docket No.: 39521-0020IP1
Issue Date: May 2, 2006
Appl. Serial No.: 09/850,399
Filing Date: May 7, 2001
Title: System, device and computer readable medium for providing
a managed wireless network using short-range radio signals

Mail Stop Patent Board

Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT
NO. 7,039,033 PURSUANT TO 35 U.S.C. §§ 311–319, 37 C.F.R. § 42**

TABLE OF CONTENTS

INTRODUCTION 1

RELEVANT BACKGROUND 3

I. APPLE’S PETITION IS NOT BARRED BECAUSE IXI’S NEW CLAIMS ARE NOT PART OF THE SAME “PATENT” FOR TIME-BAR PURPOSES AND CERTAINLY NOT PART OF IXI’S PRIOR SERVICE..... 6

 A. The Federal Circuit’s *Click-to-Call* Decision Leaves Institution Decisions On Ex Parte Reexaminations To the Discretion of the Board, Based On Whether New Claims Contain the Same Scope 7

 B. *Chevron* Step One: The Time-Bar Statute is Ambiguous As to Whether a Petition Like Apple’s Should Be Barred..... 9

 C. *Chevron* Step Two: The Board Should Allow Petitions Challenging Substantively Different New Claims Obtained in Ex Parte Reexaminations..... 12

 D. IXI’s New Claims Are Not “Substantially Identical” To The Original Claims And, Thus, Created a New Patent 16

II. IN THE ALTERNATIVE, THE BOARD SHOULD JOIN THE PRESENT IPR WITH APPLE’S PREVIOUS IPR 18

III. REQUIREMENTS FOR IPR 19

 A. Grounds for Standing..... 19

 B. Challenge and Relief Requested..... 20

IV. Estoppel 21

V. The ’033 Patent..... 22

VI. Level of Ordinary Skill..... 23

VII. Claim Construction..... 23

VIII. APPLICATION OF PRIOR ART TO CHALLENGED CLAIMS	24
A. [GROUND 1] – Claims 65, 67, 69, 72, and 74 are obvious over Marchand, Nurmman, Vilander, and Williams	24
B. [GROUND 2] – Claims 73 and 87 are obvious over Marchand, Nurmman, Vilander, Williams, and Larsson	48
C. [GROUND 3] – Claims 85 and 86 are obvious over Marchand, Nurmman, Vilander, Williams, and RFC 2543	54
D. [GROUND 4] – Claims 66, 68, and 71 are obvious over Marchand, Nurmman, Vilander, Williams, and 802.11b.....	57
E. [GROUND 5] – Claim 79 is obvious over Marchand, Nurmman, Vilander, Williams, 802.11b, and Narayanaswami.....	64
IX. PAYMENT OF FEES	66
X. CONCLUSION.....	66
XI. MANDATORY NOTICES UNDER 37 C.F.R § 42.8(a)(1).....	67
A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)	67
B. Related Matters Under 37 C.F.R. § 42.8(b)(2).....	67
C. Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3).....	67
D. Service Information	68

EXHIBITS

- EXHIBIT 1001 U.S. Patent No. 7,039,033 to Haller et al. (“’033 patent”)
- EXHIBIT 1002 Prosecution History of the ’033 patent
- EXHIBIT 1003 Declaration of Dr. Sayfe Kiaei
- EXHIBIT 1004 Curriculum Vitae of Dr. Sayfe Kiaei
- EXHIBIT 1005 International Publication No. WO 2001/76154 A2 to Marchand (“Marchand”)
- EXHIBIT 1006 U.S. Patent Application No. 09/541,529 to Marchand (“Marchand Priority”)
- EXHIBIT 1007 Handley et al., Request For Comments 2543 SIP: Session Initiation Protocol, The Internet Society, March, 1999 (“RFC 2543”)
- EXHIBIT 1008 U.S. Patent No. 6,836,474 to Larsson (“Larsson”)
- EXHIBIT 1009 K. Arnold et al., The JINI™ Specification, Addison-Wesley, June 1, 1999 (“JINI Spec.”)
- EXHIBIT 1010 U.S. Patent No. 6,560,642 to Nurmman (“Nurmman”)
- EXHIBIT 1011 U.S. Patent No. 6,771,635 to Vilander (“Vilander”)
- EXHIBIT 1012 U.S. Patent Application Publication No. 2002/0068608 to Souissi (“Souissi”)
- EXHIBIT 1013 U.S. Patent No. 6,486,832 to Abramov, et al. (“Abramov”)
- EXHIBIT 1014 U.S. Patent No. 7,193,965 to Nevo, et al. (“Nevo”)
- EXHIBIT 1015 U.S. Patent No. 6,556,222 to Chandrasekhar Narayanaswami (“Narayanaswami”)
- EXHIBIT 1016 International Publication No. WO 1999/22338 to Williams (“Williams”)

- EXHIBIT 1017 U.S. Patent No. 7,155,163 to Cannon (“Cannon”)
- EXHIBIT 1018 802.11b, “Supplement to IEEE Standard for Information Technology – Telecommunications and Information Exchange Between Systems – Local and Metropolitan Area Networks – Specific Requirements. Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications: Higher-Speed Physical Layer Extension in the 2.4 GHz Band,” Print ISBN 0738118117, published January 20, 2000 (“802.11b”)
- EXHIBIT 1019 IEEE 802.11, “IEEE Standard for Information Technology—Telecommunications and Information Exchange Between Systems—Local and Metropolitan Area Networks—Specific requirements. Part 11: Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications,” ISBN 0-7381-1658-0, published August 20, 1999 (“802.11”)
- EXHIBIT 1020 A COLLECTION OF JINI TECHNOLOGY HELPER UTILITIES AND SERVICES SPECIFICATIONS (“JINI Collection”)
- EXHIBIT 1021 U.S. Patent No. 5,465,401 to Thompson (“Thompson”)
- EXHIBIT 1022 GSM Phase 2+ General Packet Radio Service GPRS: Architecture, Protocols, and Air Interface (“Bettstetter”)
- EXHIBIT 1023 U.S. Patent No. 6,557,037 to Provino (“Provino”)
- EXHIBIT 1024 U.S. Patent No. 6,028,848 to Bhatia (“Bhatia”)
- EXHIBIT 1025 U.S. Patent No. 6,185,611 to Waldo, et al. (“Waldo”)
- EXHIBIT 1026 Bluetooth Specification, Version 1.0B (“Bluetooth Spec.”)
- EXHIBIT 1027 IPR2015-01443, Petition
- EXHIBIT 1028 IPR2015-01444, Petition

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.