

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUEST TEK INTERACTIVE ENTERTAINMENT LTD.,
Petitioner,

v.

NOMADIX, INC.,
Patent Owner.

IPR2019-01191
Patent 8,606,917 B2

Before SALLY C. MEDLEY, AMBER L. HAGY, and
MATTHEW J. McNEILL, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

Guest Tek Interactive Entertainment Ltd. (“Petitioner”) filed a Petition under 35 U.S.C. § 311 requesting *inter partes* review of claims 1 and 11 (“the challenged claims”) of U.S. Patent No. 8,606,917 B2 (“the ’917 patent”). Paper 1 (“Pet.”). Nomadix, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 5 (“Prelim. Resp.”). With the Board’s authorization (Paper 6), Petitioner filed a Reply (Paper 7 (“Reply”)) and Patent Owner filed a Sur-Reply (Paper 8 (“Sur-Reply”)), both limited to addressing the priority date of the ’917 patent and whether the Board should exercise its discretion under 35 U.S.C. § 314(a) to deny institution in light of pending district court litigation. *See* Paper 6, 4 (authorizing limited briefing).

Section 314(a) does not authorize institution of review unless Petitioner demonstrates a reasonable likelihood that it will prevail with respect to at least one challenged claim. 35 U.S.C. § 314(a). Applying that standard on behalf of the Director (37 C.F.R. § 42.4(a)), we do not institute the petitioned review.

Petitioner presents three grounds of unpatentability, two of which rely on the Trudeau reference (Ex. 1004, U.S. Patent No. 8,046,578 B1, issued October 25, 2011 (“Trudeau ’578”)), as prior art. Pet. 5. Petitioner acknowledges the ’917 patent asserts priority to the October 20, 2000, filing date of U.S. Patent Application No. 09/693,060 (Ex. 1003, “the ’060 application”) via a series of continuation applications. *Id.* at 12. Petitioner asserts Trudeau ’578 is nonetheless prior art to the ’917 patent because the ’060 application lacks written description support for at least two limitations of the challenged claims of the ’917 patent. *Id.* at 12–18.

Having reviewed all of the submissions by the parties, we determine Petitioner fails to demonstrate that the challenged claims of the '917 patent lack written description support in the cited priority documents. Therefore, the Petition fails to establish Trudeau '578 is prior art to the '917 patent and, consequently, fails to demonstrate a reasonable likelihood of success as to Grounds 1 and 2. We do not reach the other issues raised in the Petition and the Preliminary Response as to Grounds 1 and 2. We also determine Petitioner has not demonstrated a reasonable likelihood of success as to Ground 3, for the reasons stated herein.

II. BACKGROUND

A. *Real Parties in Interest and Related Proceedings*

Petitioner identifies itself as the real party-in-interest. Pet. 2.
Nomadix identifies itself as the real party-in-interest. Paper 3, 1.

Pursuant to 37 C.F.R. § 42.8(b)(2), both parties identify as a “related matter” the following co-pending litigation in the United States District Court for the Central District of California: *Nomadix, Inc. v. Guest Tek Interactive Entertainment Ltd.*, Case 2:16-CV-08033-AB-FFM (“the Litigation”). Pet. 3; Paper 3, 1. Patent Owner additionally identifies several other litigations filed between 2004–2014, but does not indicate what patents are or were at issue or whether any of those proceedings remain pending. Paper 3, 2.

Both parties also identify several petitions filed by Petitioner for review of patents that both parties indicate are “related” to the '917 patent. Pet. 3; Paper 3, 1. Of such petitions, IPR2018-00376, IPR2018-00392, IPR2018-01660, and IPR2018-01668 have been denied, and IPR2019-00211 and IPR2019-00253 have been instituted and are pending.

B. '917 Patent

The '917 patent is entitled “Systems and Methods for Providing Content and Services on a Network System,” and issued on December 10, 2013. Ex. 1001, codes (54), (45). The '917 patent issued from U.S. Patent Application No. 13/659,851 (“the '851 application”), filed on October 24, 2012. *Id.* at codes (21), (22). The '917 patent claims priority to and incorporates by reference the following U.S. patent applications: 13/566,904, 12/685,585, 11/427,143, 09/693,060, 09/458,602, 09/458,569, 60/161,189, 60/161,182, 60/161,181, 60/161,139, 60/161,093, 60/160,973, 60/160,890, and 60/111,497. *Id.* at 1:8–51. As noted above, of particular relevance to our determination here is the '060 application, which was filed on October 20, 2000, and claims priority to and incorporates by reference several applications, including U.S. Provisional Application No. 60/160,890 (“the '890 provisional”), filed October 22, 1999. Ex. 1003, 2, 9.¹

The '917 patent describes “a method and system for selectively implementing and enforcing Authentication, Authorization and Accounting (AAA) of users accessing a network via a gateway device.” Ex. 1001, 8:8–11. Users may be, for example, guests of a hotel attempting to access an Internet site from their laptop in their hotel room. *Id.* at 3:15–18, 4:56–57. The system includes a network access controller that receives a request in TCP format from a source computer, such as a user laptop, for access to the Internet or other network. *Id.* at 3:57–61. Figure 1 of the '917 patent illustrates the computer system, and is reproduced below.

¹ References herein to the page numbers of Exhibit 1003 are to the numbers added by Petitioner to the document in the lower left hand corner of each page, not to the original page numbers.

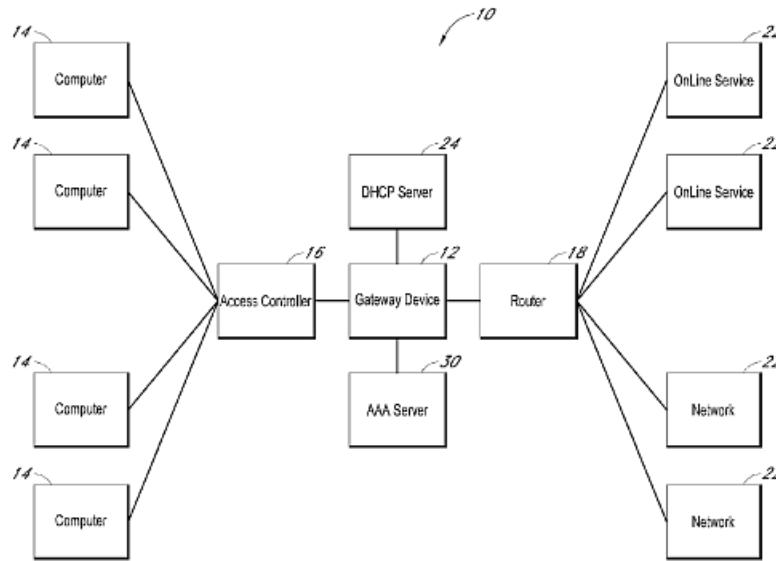


FIG. 1

Figure 1 of the '917 patent “is a block diagram of a computer system that includes [an] AAA server for authenticating, authorizing and accounting sources accessing networks and/or online services” *Id.* at 5:24–26. As illustrated in Figure 1, the computer system includes “a plurality of computers 14 that can communicate with one or more online services 22 or networks via a gateway device 12” *Id.* at 18:15–19. Gateway device 12 “includes the ability to recognize computers attempting to access a network 12, the location of computers attempting to access a network, the identity of users attempting to gain network access, and additional attributes” *Id.* at 18:29–33.

According to the '917 patent, gateway device 12 may identify the source computer by “one or more attributes” contained within data packets transmitted to the gateway device by the source computer. *Id.* at 19:5–14. The attributes contained in such data packets “can include network information, source IP address, source port, link layer information, source

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