UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MOTOROLA MOBILITY LLC,
Petitioner,

v.

INTELLECTUAL VENTURES I LLC,
Patent Owner.

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Case CBM2015-00174
Patent 7,810,144 B2

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Before MICHAEL W. KIM, PATRICK R. SCANLON, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges.*

ABRAHAM, *Administrative Patent Judge*.

DECISION
Denying Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

I.   INTRODUCTION

A.   *Background*

Petitioner Motorola Mobility LLC filed a Petition (Paper 1, "Pet.") requesting a covered business method patent ("CBM patent") review of claims 10, 14, 15, and 41 of U.S. Patent No. 7,810,144 B2 (Ex. 1001, "the '144 patent") pursuant to Section 18 of the Leahy–Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"). Patent Owner Intellectual Ventures I LLC filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

A transitional proceeding under § 18 of the AIA may be instituted only for a patent that is a covered business method patent. AIA § 18(a)(1)(e). Upon consideration of the Petition and Preliminary Response, we conclude Petitioner has not met its burden of demonstrating sufficiently that the '144 patent is a CBM patent pursuant to the statutory definition in § 18(d)(1) of the AIA. Therefore, we deny the Petition.

B.   *Related Proceedings*

The parties identify *Intellectual Ventures I LLC v. Motorola Mobility LLC*, No. 1:11-cv-00908 (D. Del.), and U.S. Patent Nos. 8,406,825, 8,185,736, 8,522,313, and 8,667,460, as well as pending application nos. 13/987,534 and 14/807,475, all of which claim the benefit of the '144 patent. Pet. 1; Paper 5, 1.

C.   *The '144 Patent*

The '144 patent relates to the "electronic transfer of computer files directly between two or more computers or computing devices." Ex. 1001, 2:4–7. In one embodiment, the '144 patent describes a file transfer system

having multiple personal computers ("PCs") connected to one or more communication pathways (e.g., the internet or a public switched telephone network (PSTN)), wherein each PC runs a computer program incorporating functional modules that enable the direct transfer of electronic files. *Id.* at 10:25–11:3, Fig. 1. A user selects one or more files to be transferred from the "sending PC," and selects a "recipient PC" from a list of candidate PC destinations. *Id.* at 11:25–45. The user may also add a text message to accompany the transferred files. *Id.* at 21:39–41. A "compression control module" then copies and compresses any files selected for transfer and any text messages into a "file packet." *Id.* at 11:58–67, 21:41–47. At a predetermined time, a control module initiates a connection with the destination PC, identifies the sending PC by its name and destination address, and transmits the packet containing the compressed files. *Id.* at 12:1–6. When the transmission from the sending PC to the receiving PC is complete, the control module then notes the date, time, and content (e.g., file name and file structure) of the transfer on an event log. *Id.* at 12:6–9. The '144 patent additionally teaches that the control module in the receiving PC can respond to inbound file transmissions by creating a received file list, and may provide a visible indication that a packet has been received. *Id.* at 12:16–26.

According to one preferred embodiment of the '144 patent, the sending PC can request a confirmation of the transfer, in the form of a returned file that includes a received file list and the identity of the recipient and sender. *Id.* at 18:66–19:4. The confirmation file may be returned from the receiving PC to the sending PC directly or through a third party authenticator. *Id.* at 19:4–6.

D.   The Challenged Claims

Petitioner challenges claims 10, 14, 15, and 41. Pet. 2–3. Claims 10

and 41 are independent claims, and claims 14 and 15 depend from claim 10.

Claim 10 is illustrative and reproduced below.

> 10.   A method for transferring files from a first device to
> a second device over a communications network, comprising:
>
> > displaying, on the first device, a collection of file
> > identifiers, wherein each file identifier represents a
> > selectable file;
> >
> > receiving, at the first device, a user selection of at least one
> > file identifier representing a file selected to be
> > transferred to the second device;
> >
> > displaying, on the first device, a collection of destinations
> > identifiers, wherein each destination identifier
> > represents a remote device having a numbered
> > destination address on a circuit switched or packet
> > switched network;
> >
> > receiving, at the first device, a user selection of at least one
> > destination identifier as selection of the second device:
> >
> > displaying, on the first device, a data entry field in which
> > a text message can be entered;
> >
> > receiving, at the first device, the text message;
> >
> > encapsulating, at the first device, the text message with the
> > selected file into a single combined file;
> >
> > generating, at the first device, a unique transaction
> > identifier that identifies a transfer of the single
> > combined file;
> >
> > transferring, from the first device to the second device, the
> > single combined file, including:
> >
> > > sending, to the second device at its numbered
> > > destination address, the single combined file
> > >
> > > receiving, at the second device, the single combined
> > > file irrespective of user action at the second device;

generating, at the second device, a delivery confirmation message confirming reception of the single combined file;

transmitting, from the second device to an authenticating device of the communications network, the delivery confirmation message; and

generating, at the authenticating device, a delivery report that indicates a delivery event and a time of the delivery event;

providing, at the second device, an alert indicating reception of the single combined file;

displaying, on the second device, an identification of the first device in relation to at least one of the selected file or the associated text file, wherein the identification includes at least one of a communications address of the first device, a name of the first device, or a username associated with the first device; and

displaying, on the second device, at least a portion of content of the selected file or the text message.

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