

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BLACKBERRY CORP., and BLACKBERRY LTD.,  
Petitioner,

v.

ZIPIT WIRELESS, INC.,  
Patent Owner.

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Case IPR2014-01508  
Patent 8,086,678 B2

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Before TREVOR M. JEFFERSON, NEIL T. POWELL, and  
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

## I. INTRODUCTION

Petitioner Blackberry Corp. and Blackberry LTD. filed a Petition on September 16, 2014, requesting an *inter partes* review of claims 1, 2, 5, and 7 of U.S. Patent No. 8,086,678 B2 (Ex. 1001, “the ’678 patent”). Paper 1 (“Pet.”). Patent Owner Zipit Wireless, Inc. did not file a Preliminary Response to the Petition.

Based on these submissions, we instituted trial as to claims 1, 2, 5, and 7 of the ’678 patent as anticipated by Adams.<sup>1</sup> Paper 6, 19 (“Dec. to Inst.”).

After institution, Patent Owner filed a Patent Owner’s Response (Paper 10, “PO Resp.”), and Petitioner filed a Reply (Paper 13, “Reply”). Additionally, we authorized a Patent Owner Sur-Reply, which Patent Owner filed on November 6, 2015 (Paper 24, “Sur-Reply”). Petitioner further filed a notice withdrawing portions of its Reply.<sup>2</sup> Paper 36.

Petitioner also filed a Motion to Exclude. Paper 32 (“Pet. Mot. Exclude”). Patent Owner filed an Opposition to Petitioner’s Motion to Exclude (Paper 39, “PO Exclude Opp.”), and Petitioner filed a Reply (Paper 43, “Pet. Exclude Reply”).

Additionally, Patent Owner filed a Motion to Exclude. Paper 35 (“PO Mot. Exclude”). Petitioner filed an Opposition to Patent Owner’s Motion to Exclude (Paper 40, “Pet. Exclude Opp.”), and Patent Owner filed a Reply (Paper 45, “PO Exclude Reply”).

An oral hearing was conducted on December 7, 2015. A transcript of

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<sup>1</sup> U.S. Patent Publication No. 2005/0257209 A1, published Nov. 17, 2005 (Ex. 1004, “Adams”).

<sup>2</sup> Petitioner’s Exhibit 1028 is a red-lined version of its Reply showing withdrawn portions.

the oral hearing is included in the record. Paper 47 (“Tr.”).

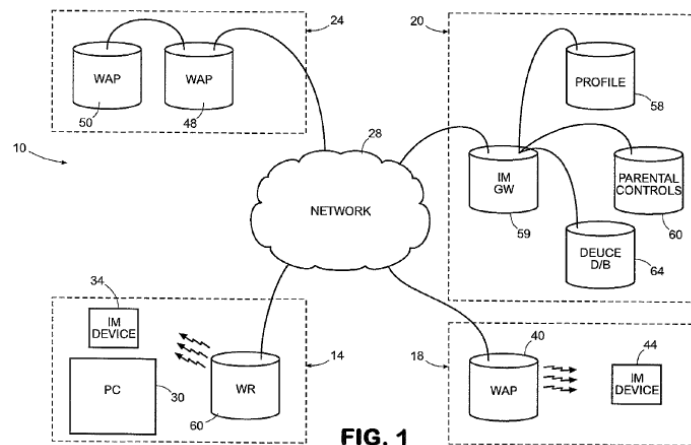
We have jurisdiction under 35 U.S.C. § 6(c). This decision is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 1, 2, 5, and 7. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, 5, and 7 are unpatentable.

### A. Related Proceedings

The '678 patent is involved in a district court proceeding in the U.S. District Court for the District of South Carolina captioned *Zipit Wireless Inc. v. BlackBerry Ltd.*, No. 6:13-cv-2959-JMC (D.S.C. 2013). Pet. 1. Additionally, Petitioner has filed Petitions challenging the patentability of certain claims of Patent Owner’s U.S. Patent Nos. 7,292,870 (IPR2014-01507); 7,894,837 (IPR2014-01506); and 8,190,694 (IPR2014-01509).

### B. The '678 Patent

The '678 patent is directed to controls for network communication devices such as parental controls for mobile instant messaging terminals. Ex. 1001, 1:7–9. Figure 1 of the '678 patent is reproduced below.



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Patent 8,086,678 B2

Figure 1 shows system 10 that regulates usage of a mobile computer network communication device. *Id.* at 3:7–9. System 10 includes home location 14, remote site location 18, device regulation/support site 20, and internet service provider (“ISP”) site 24. *Id.* at 3:32–34. As shown, these sites and locations are coupled to one another through a computer network 28. *Id.* at 3:34–36. Home location 14 has a local area network (“LAN”) that includes personal computer (“PC”) 30 and a mobile computer communication device, such as instant messaging terminal 34. *Id.* at 3:38–41. As shown, these devices communicate with ISP site 24 or device regulation/support site 20 through wireless router 38. *Id.* at 3:41–43.

Figure 1 further shows device regulation/support site 20 includes mobile device communication gateway 54 that communicates with device database 58, profile server 60, and regulation database 64. Ex. 1001, 4:60–63. Regulation database 64 stores the controls and rules selected or generated by an administrative user for a device registered with regulation/support site 20. *Id.* at 5:13–16. These are the rules and controls applied to communications made with a particular mobile device registered with the site 20. *Id.* at 5:16–18. Regulation site 20 may include identification data unique for each mobile computer network communication device registered with site 20. *Id.* at 4:65–5:6. The unique identifier enables the regulation of the device to be implemented without recourse to a user or account identification. *Id.* at 6:25–27. The ’678 patent indicates regulation database 64 may store the controls and rules selected or generated by an administrative user for a device registered with regulation/support site 20 that apply to communications made with a particular mobile device registered with site 20. *Id.* at 5:13–16.

Figure 3 is reproduced below.

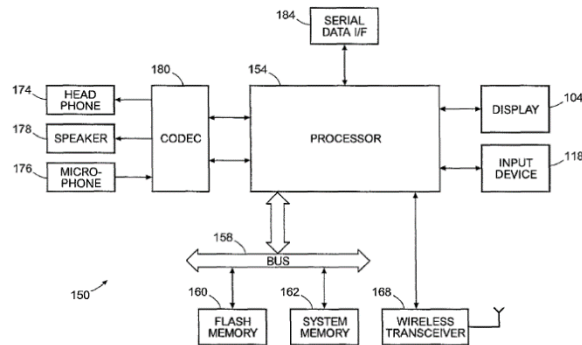


FIG. 3

Figure 3 shows components of mobile communication device 34 (e.g., instant messaging terminal) having a unique terminal identifier for enabling parental regulation of the terminal's use. Ex. 1001, 3:13–15, 6:4–5. As shown, device 34 includes system 150 with processor 154 coupled through system bus 158 to memory components 160 and 162. *Id.* at 6:5–7. The '678 patent discloses that memory 160 or 162 may be used to store a unique identifier that is installed by the manufacturer of device 34. *Id.* at 6:20–21. The '678 patent further indicates memories 160 and 162 may be non-volatile so the unique identifier remains the same during the life of the device. *Id.* at 6:23–25.

The '678 patent further discloses that mobile communication device 34 includes a support communication module configured to communicate with regulation/support site 20 in response. Ex. 1001, 6:52–55, 6:62–65. For registration of device 34, communication module sends a registration message to regulation/support site gateway 54 that includes the unique identifier for device 34. *Id.* at 7:60–64. Gateway 54 determines if the unique identifier is in the device database 58. *Id.* at 7:64–67. The communication module also monitors a user's command input to device 34. *Id.* at 9:7–10; Fig. 6. This process determines whether the entered command

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