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Paper 49
Entered: March 29, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BLACKBERRY CORP., and BLACKBERRY LTD.,
Petitioner,

v.

ZIPIT WIRELESS, INC.,
Patent Owner.

Case IPR2014-01509
Patent 8,190,694 B2

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, 4–7, 9, 10, and 12 of U.S. Patent No. 8,190,694 B2 (Ex. 1001, “the ’694 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, 4–7, 9, 10, and 12 as follows:

Reference(s)	Basis	Claim(s) Challenged
Lotter ¹	§ 102	9, 10, and 12
Lotter and Patron ²	§ 103	1, 2, 4, and 5
Lotter, Patron, and Walter ³	§ 103	6 and 7
Adams ⁴ and Patron	§ 103	1, 2, and 4–7

Paper 6, 25 (“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

¹ U.S. Patent No. 7,996,005 B2; issued Aug. 9, 2011 (Ex. 1005, “Lotter”).

² U.S. Patent Publication No. 2005/0060167 A1; published March 17, 2005 (Ex. 1006, “Patron”).

³ U.S. Patent Publication No. 2006/0014547 A1; published Jan. 19, 2006 (Ex. 1007, “Walter”).

⁴ U.S. Patent Publication No. 2005/0257209 A1; published Nov. 17, 2005 (Ex. 1004, “Adams”).

a notice withdrawing portions of its Reply.⁵ 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 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, 4–7, 9, 10, and 12. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, and 4–7 are unpatentable. However, as explained below, Petitioner has not demonstrated, by a preponderance of the evidence, that claims 9, 10, and 12 are unpatentable.

A. Related Proceedings

The ’694 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

⁵ Petitioner’s Exhibit 1028 is a red-lined version of its Reply showing withdrawn portions.

certain claims of Patent Owner's U.S. Patent Nos. 7,292,870 B2 (IPR2014-01507); 7,894,837 B2 (IPR2014-01506); and 8,086,678 B2 (IPR2014-01508).

B. The '694 Patent

The '694 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 '694 patent is reproduced below.

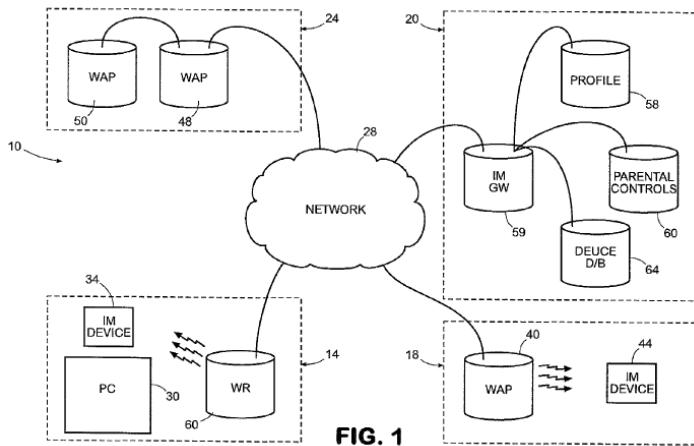


Figure 1 shows system 10 that regulates usage of a mobile computer network communication device. *Id.* at 3:7–9. System 10 includes home location 14, remote site location 18, device regulation/support site 20, and internet service provider (“ISP”) site 24. *Id.* at 3:42–45. As shown, these sites and locations are coupled to one another through a computer network 28. *Id.* at 3:45–47. 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 3:49–52. As shown, these devices communicate with ISP site 24 or device regulation/support site 20 through wireless router 38. *Id.* at 3:52–54.

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, 5:4–7. 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 '694 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.

The '694 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 7:62–64. 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 requires evaluation by control site 20. *Id.* at 9:10–11. For example, a user command may prompt the communication module to generate a monitor message that includes the unique device identifier and data from the

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