

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., SAMSUNG ELECTRONICS CO., LTD.,
and SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

ROSETTA-WIRELESS CORPORATION,
Patent Owner.

Case IPR2016-00616
Patent 7,149,511 B1

Before JUSTIN T. ARBES, PATRICK R. SCANLON, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

HUDALLA, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

Apple Inc., Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc. (collectively “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–10 and 58–65 of U.S. Patent No. 7,149,511 B1 (Ex. 1001, “the ’511 patent”) pursuant to 35 U.S.C.

IPR2016-00616
Patent 7,149,511 B1

§§ 311–19. Patent Owner, Rosetta-Wireless Corporation (“Rosetta”), filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Under 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, we institute an *inter partes* review as to claims 1–6, 8–10, 58–63, and 65 of the ’511 patent on the asserted ground of unpatentability presented.

I. BACKGROUND

A. *Related Proceedings*

Both parties identify the following proceedings related to the ’511 patent (Pet. 1–2; Paper 6, 2):

Rosetta-Wireless Corp. v. Apple Inc., No. 1:15-cv-00799 (N.D. Ill., filed Jan. 27, 2015);

Rosetta-Wireless Corp. v. High Tech Computer Corp., No. 1:15-cv-10603 (N.D. Ill., filed Nov. 24, 2015);

Rosetta-Wireless Corp. v. Samsung Elecs. Co., Ltd., No. 1:15-cv-10605 (N.D. Ill., filed Nov. 24, 2015);

Rosetta-Wireless Corp. v. LG Electronics Co., No. 1:15-cv-10608 (N.D. Ill., filed Nov. 24, 2015); and

Rosetta-Wireless Corp. v. Motorola Mobility LLC, No. 1:15-cv-10611 (N.D. Ill., filed Nov. 24, 2015).

Petitioner has filed another petition for *inter partes* review of the ’511 patent in co-pending Case IPR2016-00622.

B. The '511 patent

The '511 patent is directed to “a wireless intelligent personal server that receives data transmitted over a wireless communications channel and automatically processes it so as to maintain a copy of at least one electronic file stored in a source computer.” Ex. 1001, 1:8–12. Figure 1 of the '511 patent is reproduced below.

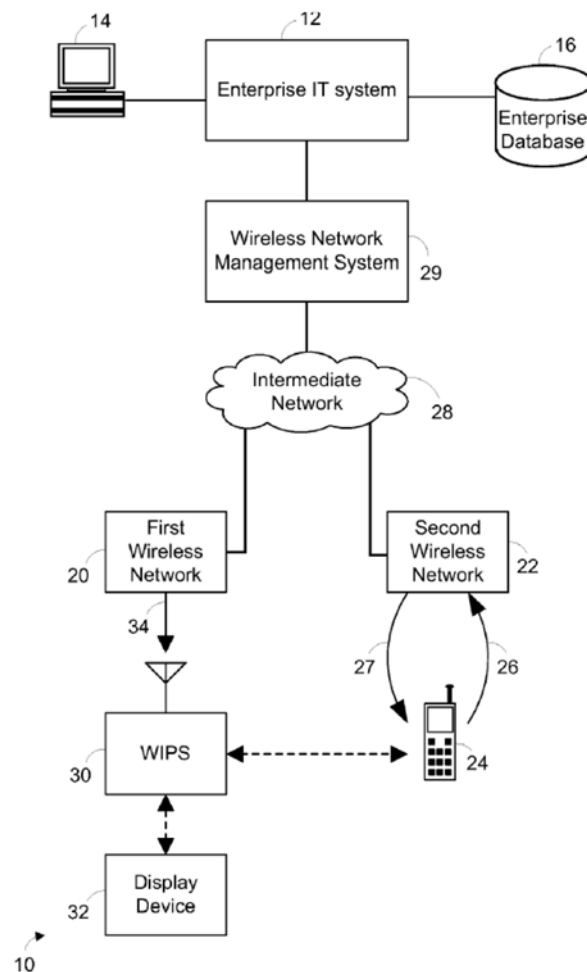


Figure 1 depicts wireless communication system 10 having enterprise information technology (IT) system 12 connected to one or more personal computers 14 and centralized enterprise database 16. *Id.* at 3:62–4:6. Enterprise IT system 12 uses wireless network management system 29 to communicate with first wireless network 20 and second wireless network 22

via intermediate network 28, which may be a wide-area network (WAN) or a local-area network (LAN). *Id.* at 4:34–41.

Wireless intelligent personal server (WIPS) 30 receives and stores data wirelessly transmitted over downstream channel 34 by first wireless network 20. *Id.* at 4:44–46, 5:35–36. WIPS 30 can use the received data to either update one or more of the files stored in its memory or to add a new file to its memory. *Id.* at 5:41–44. WIPS 30 also may transmit signals to second wireless network 22 over upstream channel 26. *Id.* at 6:16–21. Moreover, WIPS 30 is able to transfer data stored in its memory to and from different types of display devices 32 on an intermittent basis. *Id.* at 4:48–50.

Display device 32, which may be a desktop PC or a personal digital assistant (PDA), interfaces with WIPS 30 to display data stored in WIPS 30. *Id.* at 4:55–67. This is accomplished by WIPS 30 copying requested data and transmitting it to display device 32. *Id.* at 9:64–10:8. Applications running on display device 32 also may allow a user to modify data stored in WIPS 30. *Id.* at 4:55–67; 8:39–41; 10:9–16.

The patent application that issued as the '511 patent was filed on August 31, 2000. *Id.* at 1.

C. Claim 1

Claims 1 and 58 of the '511 patent are independent and have been amended by *Ex Parte* Reexamination Certificate US 7,149,511 C1, dated Jan. 10, 2012. Ex. 1001, 16–17 (certificate issued from Reexamination

Control No. 90/011,569).¹ The remaining claims have not been amended. Claims 2–10 directly or indirectly depend from claim 1, and claims 59–65 directly or indirectly depend from claim 58. Claim 1 is illustrative of the challenged claims and recites:

1. A wireless intelligent personal network server, comprising:

a radio frequency (RF) receiver for receiving downstream data transmitted over a first wireless communications channel;

a memory;

a central processing unit (CPU);

a set of embedded machine language instructions within said personal network server, said set of embedded machine language instructions being executable by said CPU for processing said downstream data to provide at least one electronic file in said memory; and

a first interface for allowing an application on an external display device to pick and open said at least one electronic file while said at least one electronic file remains resident on said personal network server, wherein said personal network server is hand-portable.

Ex. 1001, 17 (1:21–2:9). Claim 58 only differs from claim 1 insofar as the word “receiver” in “radio frequency (RF) receiver” is replaced with “transceiver.” *Id.* at 17 (2:12).

D. The Prior Art

Petitioner relies on the following prior art:

¹ The '511 patent also was the subject of a request for *ex parte* reexamination in Reexamination Control No. 90/011,418, which was terminated.

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.