

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TOMTOM, INC., Petitioner,

v.

BLACKBIRD TECH, LLC d/b/a BLACKBIRD TECHNOLOGIES, LLC
Patent Owner.

Case IPR2017-02023
Patent 6,434,212 B2

Before DEBRA K. STEPHENS, THOMAS L. GIANNETTI, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

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

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6(c), and this Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that TomTom, Inc. (“Petitioner”) has shown by a preponderance of the evidence that claims 1–5 of U.S. Patent No. 6,434,212 B2 (Ex. 1001, “the ’212 patent”) are unpatentable and Petitioner has not shown by a preponderance of the evidence that claims 6–8 of the ’212 patent are unpatentable.

A. *Procedural History*

Petitioner filed a Petition requesting an *inter partes* review of claims 1–8 (“the challenged claims”) of the ’212 Patent (Paper 1 (“Pet.”)).

Petitioner relies on the following references in asserting their grounds:

Levi et. al., U.S. Patent 5,583,776 (Ex. 1003 (hereinafter, “Levi”));

Jimenez et al., U.S. Patent 4,367,752 (Ex. 1002 (hereinafter, “Jimenez”)); and

Ebeling et. al., U.S. Patent 6,145,389 (Ex. 1004 (hereinafter, “Ebeling”))

(Pet. 4–5). Blackbird Tech LLC (“Patent Owner”) filed a Preliminary Response (Paper 6 (“Prelim. Resp.”)). Pursuant to 35 U.S.C. § 314(a), we instituted an *inter partes* review (Paper 7, “Dec.”) of claims 1–5 as

unpatentable under 35 U.S.C. § 103(a)¹ in view of Jimenez, Levi, and “knowledge of a person having ordinary skill in the art” (Dec. 36).

On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition (*SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018)). Subsequent to the holding in *SAS*, we modified our institution decision to institute on all challenged claims and all grounds presented in the Petition (Paper 10). Specifically, we modified our institution decision to include review of

Claims 1–8 under 35 U.S.C. § 103(a) as obvious over Jimenez, Levi, and “knowledge of a person having ordinary skill in the art”; and

Claims 1–8 under 35 U.S.C. § 103(a) as obvious over Jimenez, Ebeling, and “knowledge of a person having ordinary skill in the art”

(*id.*).

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 15, “PO Resp.”), to which Petitioner filed a Reply (Paper 17, “Reply”). Pursuant to guidance provided in the Patent Trial and Appeal Board issued an updated Trial Practice Guide (PTAB Trial Practice Guide Update (August 2018)). Patent Owner requested authorization to file a sur-reply (Exhibit 3002). We authorized Patent Owner to file a sur-reply (*id.*; Paper 21), and Patent Owner thus filed a Sur-Reply (Paper 19).

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 100 et seq. effective on March 16, 2013. The ’212 Patent issued from an application filed before March 16, 2013; therefore, we apply the pre-AIA versions of the statutory bases for unpatentability.

At the parties' request (Papers 18, 20), an Oral Hearing was held on December 11, 2018, a transcript of which is included in the record (Paper 24, "Tr.").

B. Related Matters

The parties advise us that the '212 Patent is at issue in the following:

Blackbird Tech LLC d/b/a Blackbird Technologies v. Garmin International, Inc. and Garmin USA, Inc., Case No. 16-CV-689 (D. Del.),

Blackbird Tech LLC d/b/a Blackbird Technologies v. Fitbit, Inc., Case No. 16-CV-683 (D. Del.),

Blackbird Tech LLC d/b/a Blackbird Technologies v. Aliphcom d/b/a Jawbone, Case No. 16-CV-684 (D. Del.),

Blackbird Tech LLC d/b/a Blackbird Technologies v. Sony Corp. et al., Case No. 16-CV-685 (D. Del.),

Blackbird Tech LLC d/b/a Blackbird Technologies v. Timex Group USA, Inc., Case No. 16-CV-686 (D. Del.),

Blackbird Tech LLC d/b/a Blackbird Technologies v. TomTom, Inc., Case No. 16-CV-687 (D. Del.), and

Blackbird Tech LLC d/b/a Blackbird Technologies v. Wahoo Fitness, Inc., Case No. 16-CV-688 (D. Del.)

(Pet. 1–2; Paper 4, 2). The '212 Patent was additionally at issue in IPR2017-01058 (*Garmin International, Inc. v. Blackbird Tech LLC d/b/a Blackbird Technologies*), now terminated, and IPR2017-02025 (*TomTom, Inc. v. Blackbird Tech LLC d/b/a Blackbird Technologies*), not instituted; and remains at issue in IPR2017-02012 (*Fitbit, Inc. v. Blackbird Tech LLC d/b/a Blackbird Technologies*) and IPR 2019-00275 (*Wahoo Fitness LLC v.*

Blackbird Tech LLC d/b/a Blackbird Technologies) (joined with IPR2017-02012).

C. *The '212 Patent*

The '212 Patent, entitled “Pedometer,” relates to a “pedometer having improved accuracy by calculating actual stride lengths of a user based on relative stride rates” ('212 Patent, Abstract). More particularly, the patent relates to “pedometers having a waist mounted stride-counting device and transmitter, and a wrist-mounted receiver and display” (*id.* at 1:9–11). The device calculates a distance walked or run based on converting a base stride length and a base stride rate to an actual stride length and using that to calculate distance traveled (*id.* at 1:12–17).

Specifically, a step counter, which is an inertia device, counts the number of steps a user takes (*id.* at 3:7–8). A data processor includes a data archive that stores historic data on stride length and pace and closed loop or fuzzy logic programming that continually or periodically replaces the base stride rate and length with recently calculated stride rates and lengths (*id.* at 3:39–47).

The pedometer of the '212 Patent may optionally require the user to operate a “sampling mode” (*id.* at 3:56–57). In this mode, a user walks or runs a predetermined distance with the distance then divided by the number of strides counted (*id.* at 3:58–62). The result is the average stride length, which is stored in the data archive as the “Base Stride Length” (*id.* at 3:62–64). The data processor further divides the number of strides by the time of the run or walk to calculate a “Base Stride Rate” (*id.* at 3:65–67).

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