

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, LG ELECTRONICS, INC.,
and LG ELECTRONICS U.S.A., INC.,
Petitioners,

v.

ZIPIT WIRELESS, INC.,
Patent Owner.

IPR2019-01567
Patent 7,292,870 B2

Before TREVOR M. JEFFERSON, NEIL T. POWELL, and
JOHN D. HAMANN, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
Denying Petitioners' Motion to Exclude
35 U.S.C. § 318(a)

I. INTRODUCTION

In this *inter partes* review, Petitioners Google LLC (“Google”) and LG Electronics, Inc. and LG Electronics U.S.A., Inc. (collectively, “LG”) (collectively, “Petitioners”) challenged claims 20, 21, and 24–30 of U.S. Patent No. 7,292,870 B2 (“the ’870 patent,” Ex. 1001) owned by Zipit Wireless, Inc. (“Patent Owner” or “Zipit”). Paper 2 (“Pet.” or “Petition”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision, issued pursuant to 35 U.S.C. § 318(a), addresses issues and arguments raised during the trial in this *inter partes* review. For the reasons discussed herein, we determine that Petitioners have shown by a preponderance of the evidence that claims 20, 21, and 24–30 are unpatentable.

A. Procedural History

Petitioners filed a Petition challenging claims 20, 21, and 24–30 of the ’870 Patent (Pet. 3, 6–74), and Patent Owner filed a Preliminary Response (Paper 7). We instituted trial on all grounds of unpatentability. Paper 10 (“Dec. on Inst.” or “Decision”), 32.

Patent Owner filed a Response (Paper 16, “PO Resp.”), Petitioners filed a Reply (Paper 23, “Reply”), and Patent Owner filed a Sur-reply (Paper 26, “Sur-reply”). Petitioners filed a Motion to Exclude (Paper 30, “Pet. Mot.”), and Patent Owner filed an opposition (Paper 31, “PO Opp.”) thereto to which Petitioners replied (Paper 33).

Petitioners submit the Declaration of Dr. Gregory Abowd (Ex. 1004, “Abowd Decl.”) and the Reply Declaration of Dr. Gregory Abowd (Ex. 1060) in support of the Petition and Reply. Patent Owner supports its Response and Sur-reply with the Declaration of Karl Ginter (Ex. 2017, “Ginter Decl.”) and the Declaration of Rafael Heredia (Ex. 2018).

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Petitioners also submit the Deposition of Karl Ginter (Ex. 1058) and the Deposition of Mr. Heredia (Ex. 1059). Patent Owner submits the Deposition of Dr. Abowd (Ex. 2056).

A combined oral hearing for this inter partes review and related case IPR2019-01568 was held on December 8, 2020, a transcript of which appears in the record in each case. Paper 37 (“Tr.”).

B. Instituted Grounds

Petitioners’ grounds rely on the following references. Dec. on Inst. 6; Pet. 3, 6–74.

Name	Reference	Exhibit
Van Dok	U.S. Patent App. Pub. No. 2004/0162877, filed Feb. 19, 2003 published Aug. 19, 2004	1005
Zaner	U.S. Patent App. Pub. No. 2004/0041836, filed Aug. 28, 2002, published Mar. 4, 2004	1006
Sinivaara	U.S. Patent App. Pub. No. 2004/0202141, filed Jan. 9, 2003, published Oct. 14, 2004	1007
Chiu	U.S. Patent App. Pub. No. 2003/0204748, filed May 20, 2002, published Oct. 30, 2003	1008
Saric	Canadian Patent App. No. 2,363,978, filed Nov. 26, 2001, published May 26, 2003	1009
Tracy	U.S. Patent App. Pub. No. 2003/0058223, filed Jan. 23, 2002, issued Mar. 27, 2003	1012
McCarthy	U.S. Patent No. 7,328,242, filed Sep. 17, 2002, issued Feb. 5, 2008	1023

We instituted inter partes review of the challenged claims, claims 20, 21, and 24–30, on the following grounds:

Claim(s) Challenged	35 U.S.C. §	References/Basis
20, 24–30	103(a) ¹	Van Dok, Sinivaara, Chiu, McCarthy

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Because the ’870 Patent has an

Claim(s) Challenged	35 U.S.C. §	References/Basis
21	103(a)	Van Dok, Sinivaara, Chiu, McCarthy, Tracy
21	103(a)	Van Dok, Sinivaara, Chiu, McCarthy, Saric
20, 21, 24–30	103(a)	Zaner, Sinivaara, Chiu, McCarthy
21	103(a)	Zaner, Sinivaara, Chiu, McCarthy, Saric

Dec. on Inst. 6, 32.

C. Real Parties in Interest

Petitioners Google and LG assert they are the real parties-in-interest.

Pet. ix.

D. Related Matters

The parties advise us that the '870 patent was asserted against Petitioners in *Zipit Wireless, Inc. v. LG Electronics Inc.*, Case No. 6-18-cv-02016 (D.S.C.). Pet. ix; Paper 4, 2. The '870 patent was also the subject of IPR2014-01507 and was not shown to be unpatentable. *See Blackberry Corp. v. Zipit Wireless, Inc.*, IPR2014-01507, Paper 50 (PTAB March 29, 2016) (Final Written Decision) (“*Blackberry IPR*”).

A related *inter partes* review of claims 11, 12, 14–16, and 20 of U.S. Patent No. 7,894,837 B2 (“the '837 patent”), the child to the '870 patent, is addressed in *Google LLC et al. v. Zipit Wireless, Inc.*, IPR2019-01568, Paper 9 (PTAB March 10, 2020) (“the *1568 IPR*”).

E. The '870 Patent

The '870 patent relates to a handheld instant messaging (“IM”) device. Ex. 1001, 1:6–9. The '870 patent discloses an IM terminal that

effective filing date prior to the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of § 103.

includes a display and a data entry device integrated in a housing for the IM terminal. *Id.* at 4:38–41. The data entry device allows entry of graphical symbols (such as emoticons supported by an IM service provider) or textual characters via dedicated or programmable keys, a Wi-Fi communications module for communicating messages with a Wi-Fi access point, and a control module for coordinating authorization to coupling the IM terminal to a local network using a wireless access point and for controlling the IM conversation session. *Id.* at 4:28–55, Figs. 12a, 12b.

Figure 2, provided below, “shows an embodiment of an instant messaging terminal that operates in accordance with the principles of the present invention.” *Id.* at 9:41–43.

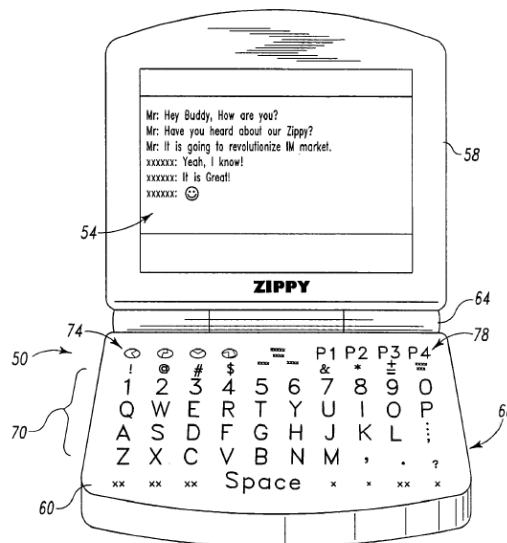


Fig. 2

Figure 2 shows terminal 50, display 54, and located on the bottom of the clamshell configuration 60 is data entry device 68, with QWERTY keyboard section 70, pre-programmed emoticon keys 74, and programmable emoticon keys 78. *Id.* at 9:40–42.

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