

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.

IPR2019-01568
Patent 7,894,837 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 11, 12, 14–16, and 20 of U.S. Patent No. 7,894,837 B2 (“the ’837 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 11, 12, 14–16, and 20 are unpatentable

A. Procedural History

Petitioners filed a Petition challenging claims 11, 12, 14–16, and 20 of the ’837 patent (Pet. 3, 7–73), and Patent Owner filed a Preliminary Response (Paper 6). We instituted trial on all grounds of unpatentability. Paper 9 (“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 31, “Pet. Mot.”), and Patent Owner filed an opposition (Paper 32, “PO Opp.”) thereto to which Petitioners replied (Paper 34).

The Petition is supported by the Declaration of Dr. Gregory Abowd (Ex. 1004) and the Reply Declaration of Dr. Gregory Abowd (Ex. 1060). Patent Owner supports its response with the Declaration of Karl Ginter (Ex. 2017) and the Declaration of Rafael Heredia (Ex. 2018). 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, 7–73.

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
Werndorfer	U.S. Patent App. Pub. No. 2004/0024822, filed Aug. 1, 2002, published Feb. 5, 2004	1010
Capps	U.S. Patent No. 7,519,667, filed Apr. 16, 2002, issued Apr. 14, 2009	1025

Petitioners assert that claims 11, 12, 14–16, and 20 would have been unpatentable based on the following grounds:

Claim(s) Challenged	35 U.S.C. §	References/Basis
11, 12, 14, 16	103(a) ¹	Van Dok, Sinivaara, Werndorfer
12	103(a)	Van Dok, Sinivaara, Werndorfer, Saric

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 ’837 Patent has an effective filing date prior to the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of § 103.

Claim(s) Challenged	35 U.S.C. §	References/Basis
15	103(a)	Van Dok, Sinivaara, Werndorfer, Chiu
20	103(a)	Van Dok, Sinivaara, Werndorfer, Capps
11, 12, 14, 16	103(a)	Zaner, Sinivaara, Werndorfer
12	103(a)	Zaner, Sinivaara, Werndorfer, Saric
15	103(a)	Zaner, Sinivaara, Werndorfer, Chiu
20	103(a)	Zaner, Sinivaara, Werndorfer, Capps

Dec. on Inst. 6, 35.

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 '837 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 '837 patent was also the subject of IPR2014-01506 and was not shown to be unpatentable. *See Blackberry Corp. v. Zipit Wireless, Inc.*, IPR2014-01506, Paper 50 (PTAB Mar. 29, 2016) (Final Written Decision) (“*Blackberry '837 IPR*”).

A related *inter partes* review of claims 20, 21, and 24–30 of U.S. Patent No. 7,292,870 B2 (“the '870 patent”), the parent to the '837 patent, is addressed in *Google LLC et al. v. Zipit Wireless, Inc.*, IPR2019-01567 Paper 10 (PTAB March 9, 2020) (“the *1567 IPR*”).

E. The '837 Patent

The '837 patent relates to a handheld instant messaging (“IM”) device. Ex. 1001, 1:16–18. The '837 patent discloses an IM terminal that

includes a display and a data entry device integrated in a housing for the IM terminal. *Id.* at 4:25–28. 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 4:28–35, 4:36–55, Figs. 12a and 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 8:62–65.

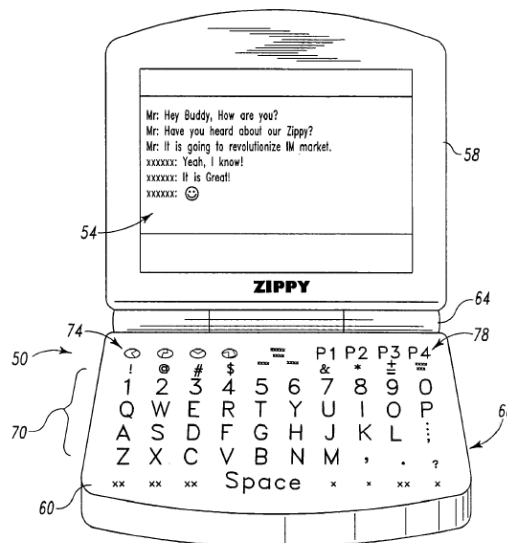


Fig. 2

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 11:10–15.

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