

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

ZIPIT WIRELESS, INC.,
Patent Owner.

IPR2021-01124
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 on Remand
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318

I. INTRODUCTION

Microsoft Corporation (“Microsoft”) and Apple Inc. (“Apple” or “Petitioner”) filed a Petition (“Pet.,” Paper 3) pursuant to 35 U.S.C. § 311 to institute an *inter partes* review of claims 1, 5–10, 17–19, and 36–40¹ of U.S. Patent No. 7,292,870 B2 (“the ’870 patent,” Ex. 1001). The Petition is supported by the Declaration of Dr. Patrick Traynor (Ex. 1003, “Traynor Decl.”). Zipit Wireless, Inc. (“Patent Owner” or “Zipit”) did not file a Preliminary Response.

We determined that the information presented in the Petition established that there was a reasonable likelihood that Apple and Microsoft would prevail with respect to its unpatentability challenges. Pursuant to 35 U.S.C. § 314, we instituted this proceeding on December 21, 2021, as to all challenged claims and all grounds of unpatentability. Paper 7 (“Dec. on Inst.”).

Pursuant to the Scheduling Order, Patent Owner was to file a response to the petition or a motion to amend the patent by March 15, 2022. Paper 8, 11 (Due Date 1). Patent Owner did neither. Additionally, the Scheduling Order instructed Patent Owner to arrange for a conference call with the Board if Patent Owner elected to not file a response to the petition. *Id.*

¹ Claim 20 of the ’870 patent was determined to be unpatentable in *Google LLC et al. v. Zipit Wireless, Inc.*, IPR2019-01567, Paper 38 at 53 (PTAB Mar. 9, 2021) (Final Written Decision) (finding that claims 20, 21, and 24–30 of the ’870 patent were unpatentable). Because the challenged dependent claims 36–40 of the ’870 patent depend from independent claim 20, Petitioner addresses claim 20 as a part of addressing the challenged dependent claims.

Patent Owner did not arrange for such a conference call. Petitioner's Reply² (Paper 9), requested "issuance of an FWD invalidating the Challenged Claims" in the pending proceeding. Paper 9, 2. Patent Owner did not file any substantive papers or evidence to the Petition, leaving Petitioner's contentions unrebutted on the record.

On December 9, 2022, we granted Microsoft and Zipit's Joint Motion to terminate the proceeding as to Microsoft (Paper 10). Paper 12. Thus, the proceeding continues with Apple as sole Petitioner.

Following an oral hearing in the related cases, we issued an Adverse Judgment Order on December 13, 2022. Paper 13. The Director subsequently *sua sponte* issued an Order "vacat[ing] the Board's adverse judgment[] and remand[ing] [the proceeding] back to the panel to either issue a show cause order clarifying whether Patent Owner is indeed abandoning the contest or to issue a final written decision addressing the patentability of the challenged claims." Paper 14, 4 (Director's decision Ordering Rehearing, Vacating Adverse Judgment, and Remanding to the Patent Trial and Appeal Board Panel for Further Proceeding Petitioner's Reply). Pursuant to the Director's order, we issue this Final Written Decision addressing the patentability of the challenged claims.

Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must prove unpatentability by

² Although Patent Owner did not file a response, Petitioner filed a paper styled as a reply that noted Patent Owner's failure to comply with the scheduling order.

a preponderance of the evidence. *See* 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2022).

This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the claims on which we instituted trial. Based on the record before us, Petitioner has shown, by a preponderance of the evidence, that claims 1, 5–10, 17–19, and 36–40 of the ’870 patent are unpatentable.

A. Real Parties in Interest

Apple asserts it is the real party-in-interest. Pet. 86.

B. Related Matters

Microsoft and Apple filed three concurrent Petitions for *inter partes* review of the ’870 patent, the instant petition (IPR2021-01124 (challenging claims 1, 5–10, 17–19, and 36–40); *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01125 (challenging claims 2–4, 11–14, 22,23, and 30–33), and *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01126 (challenging claims 22, 23, and 31–40). Paper 2, 1–5; Paper 6, 2–3. In addition, Microsoft and Apple filed three concurrent Petitions for *inter partes* review of related U.S. Patent No. 7,894,837: *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01129; *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01130; and *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01131. *Id.* We issued Final Written Decision in IPR2021-01130 and IPR2021-01131.

Microsoft and Apple provide that the ’870 patent was the subject of Final Written Decisions in IPR2014-01507³ and in *Google LLC et al. v. Zipit*

³ *Blackberry Corp. v. Zipit Wireless, Inc.*, IPR2014-01507, Paper 50 (PTAB March 29, 2016) (Final Written Decision) (“*Blackberry IPR*”) (finding that the challenged claims were not shown to be unpatentable).

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Wireless, Inc., IPR2019-01567, Paper 38 at 53 (PTAB Mar. 9, 2021) (Final Written Decision) (“*Google IPR*”) (finding that claims 20, 21, and 24–30 of the ’870 patent were unpatentable). Pet. 86–87. In addition, related U.S. Patent No. 7,894,837 (the ’837 patent) was the subject of *Google LLC v. Zipit Wireless, Inc.*, IPR2019-01568, Paper 39 (PTAB Mar. 9, 2021) (Final Written Decision) (finding the challenged claims unpatentable). *Id.* Finally, Microsoft and Apple state that the ’870 patent is involved in *Zipit Wireless, Inc. v. LG Electronics Inc.*, Case No. 6-18-cv-02016 (D.S.C.). Pet. 87.

Patent Owner indicates that the *inter partes* review of the ’870 patent may affect the following matters: *Ex Parte Zipit Wireless, Inc.*, Reexamination No: 90/014,722; *Apple Inc. v. Zipit Wireless, Inc.*, Case No. 5:20-cv-04448-EJD (N.D. Cal.); *Apple Inc. v. Zipit Wireless, Inc.*, Appeal No. 21-1760 (Court of Appeals for the Federal Circuit); *Zipit Wireless, Inc. v. LG Electronics Inc.*, Case No. 6-18-cv-02016 (D.S.C.) (case currently stayed); and *Zipit Wireless, Inc. v. LG Electronics U.S.A., Inc.*, No. 2:20-cv-01494-KM-JBC (D.N.J.). Paper 6, 3–4.

C. *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 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.

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