

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

ZIPIT WIRELESS, INC.,
Patent Owner.

IPR2021-01126
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 22, 23, and 31–40¹ of U.S. Patent No. 7,292,870 B2 (“the ’870 patent,” Ex. 1001). 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.* Patent Owner did not arrange for such a conference call. Petitioner’s Reply² (Paper 9), requested “issuance of an FWD invalidating the Challenged

¹ Claims 20 and 21 of the ’870 patent were 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 22, 23, and 31–40 of the ’870 patent depend from claims 20 and 21, the Petition addresses claim 20 as a part of addressing the challenged dependent claims.

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.

IPR2021-01126
Patent 7,292,870 B2

Claims” in the pending proceeding. Paper 9, 2. Finally, Patent Owner did not file any substantive papers or evidence to the, 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 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 22, 23, and 31–40 of the ’870 patent are unpatentable.

IPR2021-01126
Patent 7,292,870 B2

A. Real Parties in Interest

Apple asserts that it is the real party-in-interest. Pet. 87.

B. Related Matters

Microsoft and Apple filed three concurrent Petitions for *inter partes* review of the '870 patent, the instant petition IPR2021-01126 (challenging claims 22, 23, and 31–40); *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01124 (challenging claims 1, 5–10, 17–19, and 36–40), and *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01125 (challenging claims 2–4, 11–14, 22, 23, and 30–33). 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 v. Zipit 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. 87–88. In addition, related U.S. Patent No. 7,894,837 (the '837 patent) was the subject of *Google LLC et al. v. Zipit Wireless, Inc.*, IPR2019-01568, Paper 39 (PTAB Mar. 9, 2021) (Final Written Decision) (finding the challenged claims unpatentable). *Id.*

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).

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. 87–88.

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.

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.

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.