

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

ZIPIT WIRELESS, INC.,
Patent Owner.

IPR2021-01129
Patent 7,894,837 C1

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, 3–7, 10,¹ 17, 21, 22, 28, 33–39, and 43–45 of U.S. Patent No. 7,894,837 C1² (“the ’837 patent,” Ex. 1001) owned by Zipit Wireless, Inc. (“Patent Owner” or “Zipit”). The Petition is supported by the Declaration of Dr. Patrick Traynor (Ex. 1003, “Traynor Decl.”). 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.”).

¹ Claim 11 of the ’837 patent was determined to be unpatentable in *Google LLC et al. v. Zipit Wireless, Inc.*, IPR2019-01568, Paper 39 at 49–51 (PTAB Mar. 9, 2021) (Final Written Decision) (finding that claims 11, 12, 14–16, and 20 of the ’837 patent were unpatentable). Because the challenged dependent claim 17 of the ’837 patent depends from independent claim 11, the Petition addresses claim 11 as a part of addressing the challenged dependent claim 17.

² An *Ex Parte* Reexamination Certificate issued for the ’837 patent on November 23, 2020 with amendments to independent claim 1 and newly added claims 21–50, each of which depend directly or indirectly from claim 1. *See* Ex. 1043, 151–152. Although the Petitioner’s declarant refers to Exhibit 1042 as providing the Reexamination Certificate (*see* Ex. 1003 ¶¶ 68, 71 (referring to the Notice of Intent to Issue Ex Parte Reexamination Certificate in Exhibit 1042)), no exhibit marked 1042 was filed. Indeed, the exhibit list in the Petition shows the 1042 was “RESERVED.” Pet. v. We note that Petitioner filed the Reexamination Certificate as part of Exhibit 1043 (excerpts of the Reexamination file history). *See* Ex. 1043, 151–52.

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 Reply (Paper 10), requested "issuance of an FWD invalidating the Challenged Claims" in the pending proceeding. Paper 10, 2. Finally, Patent Owner did not file any substantive papers or evidence to the Petition, leaving Petitioner's contentions un rebutted on the record.

On December 9, 2022, we granted Microsoft and Zipit's Joint Motion to terminate the proceeding as to Microsoft (Paper 11). Paper 13. 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 14. 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 15, 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,

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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, claims 1, 3–7, 10, 17, 21, 22, 28, 33–39, and 43–45 of the '837 patent are unpatentable.

A. Real Parties in Interest

Apple asserts that it is the real party-in-interest. Pet. 98.

B. Related Matters

Microsoft and Apple filed three concurrent Petitions for *inter partes* review of the '837 patent, the instant petition IPR2021-01129 (challenging claims 1, 3-7, 10, 11, 17, 21, 22, 28, 33–39, and 43–45); *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01130 (challenging claims 1, 2, 11–13, 19, 23, 24, 27, 29–31, 40–42, 46, and 48–50), and *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01131 (challenging claims 11–13, 17–19). Paper 2, 1–5; Paper 6, 2–3. We issued Final Written Decision in IPR2021-01130 and IPR2021-01131. In addition, Microsoft and Apple filed three concurrent Petitions for *inter partes* review of related U.S. Patent No. 7,292,870: *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01124; *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01125; and *Microsoft Corporation and Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01126. *Id.*

Microsoft and Apple provide that the '837 patent was the subject of Final Written Decisions in IPR2014-01506³ and in *Google LLC et al. v. Zipit Wireless, Inc.*, IPR2019-01568, Paper 39 (PTAB Mar. 9, 2021) (Final Written Decision) (“*Google '837 IPR*”) (finding that claims 11, 12, 14–16, and 20 of the '837 patent were unpatentable). Pet. 98. In addition, related U.S. Patent No. 7,292,870 was the subject of *Google LLC v. Zipit Wireless, Inc.*, IPR2019-01567, Paper 38 (PTAB Mar. 9, 2021) (Final Written Decision) (finding the challenged claims unpatentable). *Id.* Finally, Microsoft and Apple state that the '837 patent is involved in *Zipit Wireless, Inc. v. LG Electronics Inc.*, Case No. 6-18-cv-02016 (D. S.C.). *Id.*

Patent Owner indicates that the *inter partes* review of the '837 patent may also 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 '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

³ *Blackberry Corp. v. Zipit Wireless, Inc.*, IPR2014-01506, 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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