

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

ZIPIT WIRELESS, INC.,
Patent Owner.

IPR2021-01131
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

Determining All Challenged Claims Unpatentable

Denying Patent Owner's Motion to Exclude

35 U.S.C. § 318(a); 42 C.F.R. §§ 42.64, 42.71

Microsoft Corporation (“Microsoft”) and Apple Inc. (“Apple”) jointly filed a Petition (“Pet.,” Paper 3) pursuant to 35 U.S.C. § 311 to institute an *inter partes* review of claims 13 and 17–19¹ 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.”), Dr. Gregory Abowd (Ex. 1050), and Duncan Hall (Ex. 1021). 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.”).

During the course of trial, Patent Owner filed a Patent Owner Response (Paper 10, “PO Resp.”), and Microsoft and Apple filed a Reply to the Patent Owner Response (Paper 13, “Reply”). Patent Owner also filed a

¹ Claims 11 and 12 of the ’837 patent were 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) (“*Google ’837 IPR*”) (finding that claims 11, 12, 14–16, and 20 of the ’837 patent were unpatentable). Because the challenged dependent claims 13 and 17–19 of the ’837 patent depend from claims 11 and 12, Petitioner addresses claims 11 and 12 as a part of addressing the challenged claims.

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. The Reexamination did not amend the challenged claims (i.e., claims 13 and 17–19) in the present Petition. Compare Ex. 1001, claims 13, 17–19, with Ex. 1043, 151–152.

Corrected Sur-reply. Paper 21 (“Sur-reply”). The parties requested an oral hearing. Papers 16, 17.

Prior to the oral hearing, Microsoft and Zipit filed a Joint Motion to terminate the proceeding as to Microsoft (Paper 26), which we granted. Paper 28. Thus, the trial proceeded to an oral hearing with Apple as sole Petitioner. An oral hearing was held on September 21, 2022, and a transcript of the hearing is included in the record. Paper 29 (“Tr.”).

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) (2019).

We have jurisdiction under 35 U.S.C. § 6. 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 13 and 17–19 are unpatentable.

I. BACKGROUND

A. *Real Parties-in-Interest*

The Petition asserts that Apple is the real party-in-interest. Pet. 82. Patent Owner asserts that Zipit is the real party-in-interest. Paper 6, 2.

B. *Related Matters*

Petitioner filed three concurrent Petitions for *inter partes* review of the ’837 patent, the instant petition IPR2021-01131 (challenging claims 13 and 17–19); *Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01129 (challenging

IPR2021-01131
Patent 7,894,837 C1

claims 1, 3–7, 10, 11, 17, 21, 22, 28, 33–39, and 43–45); 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). Paper 2, 1–5; Paper 6, 2–3. Adverse judgment against Patent Owner was entered in IPR2021-01129. IPR2021-01129 Paper 30. In addition, Petitioner filed three concurrent Petitions for *inter partes* review of related U.S. Patent No. 7,292,870: *Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01124; *Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01125; and *Apple Inc. v. Zipit Wireless, Inc.*, IPR2021-01126. *Id.* Adverse judgment against Patent Owner was entered in each of these three cases. See IPR2021-01124 Paper 13; IPR2021-01125 Paper 14; IPR2021-01126 Paper 13.

The Petition provides 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) (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 et al. v. Zipit Wireless, Inc.*, IPR2019-01567, Paper 38 (PTAB Mar. 9, 2021) (Final Written Decision) (finding the challenged claims unpatentable). *Id.* Finally, Petitioner states that the '837 patent is involved in *Zipit Wireless, Inc. v. LG Electronics Inc.*, Case No. 6-18-cv-02016 (D.S.C.). Pet. 82–83.

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

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).

IPR2021-01131
Patent 7,894,837 C1

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 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.

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.