

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION and APPLE INC.,
Petitioners,

v.

ZIPIT WIRELESS, INC.,
Patent Owner.

IPR2021-01125
Patent 7,292,870 B2

Before TREVOR M. JEFFERSON, NEIL T. POWELL, and
JOHN D. HAMANN, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioners Microsoft Corporation (“Microsoft”) and Apple Inc. (“Apple”) (collectively, “Petitioners”) filed a Petition (“Pet.,” Paper 3) pursuant to 35 U.S.C. § 311 to institute an *inter partes* review of claims 2–4, 11–14, 22, 23, and 31–33¹ 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”) did not file a Preliminary Response.

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” The following findings of fact and conclusions of law are not final, but are made for the sole purpose of determining whether Petitioners meet the threshold for initiating review. Any final decision shall be based on the full trial record, including any response timely filed by Patent Owner. Any arguments not raised by Patent Owner in a timely filed response may be deemed waived.

For the reasons set forth below, we institute an *inter partes* review of claims 2–4, 11–14, 23, and 31–33 of the ’870 patent.

¹ Claims 20, 21, and 24–30 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 31–33 of the ’870 patent depend from canceled claims 20, 21, and 30, Petitioners address claims 20, 21 and 30 in the Petition.

A. Real Parties in Interest

Petitioners Microsoft and Apple assert they are the real parties-in-interest. Pet. 86.

B. Related Matters

Petitioners filed three concurrent Petitions for *inter partes* review of the '870 patent, the instant petition IPR2021-01125 (challenging claims 2–4, 11–14, 22, 23, and 31–33); *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.*, IPR2021-01126 (challenging claims 22, 23, and 31–40). Paper 2, 1–5; Paper 7, 2–3. In addition, Petitioners 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.*

Petitioners provide that the '870 patent was the subject of Final Written Decisions in IPR2014-01507² and in *Google LLC et al. 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. 90–91. 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.*

² *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, Petitioners 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. 90.

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 7, 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.

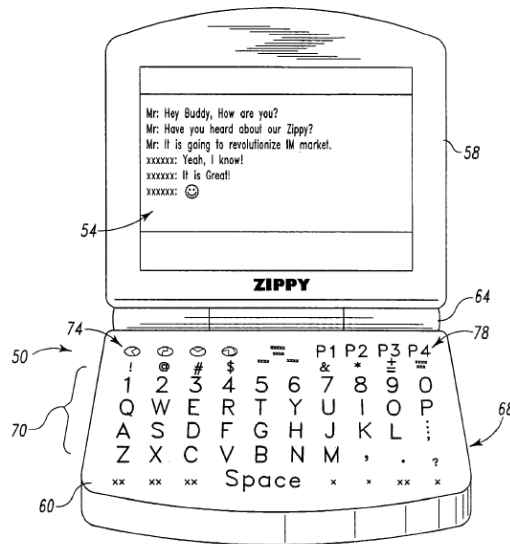


Fig. 2

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 9:40–42.

Figures 12a and 12b, provided below, show user interface screens that associate emoticon pictorial images with programmable keys. *Id.* at 10:6–7.

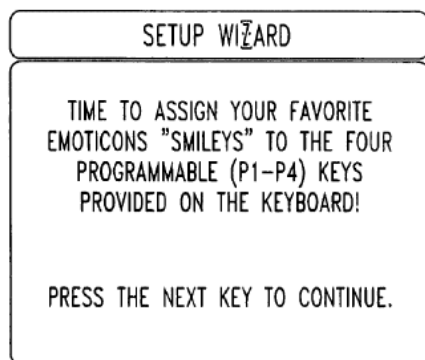


Fig. 12A

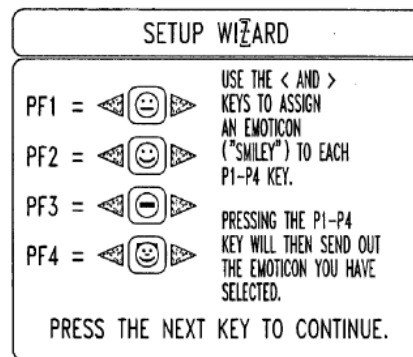


Fig. 12B

Figures 12a and 12b show screens used in the emoticon selection procedure. Figure 12a identifies keys of keyboard 68 (not shown) that are associated

with selected emoticons. *Id.* Figure 12b shows a screen that instructs the user to use the “<” and “>” keys on either side of the displayed symbol to change the graphical symbol that is associated with a programmable key, e.g., PF2. *Id.* at 16:62–17:5.

The handheld terminal of the ’870 patent manages multiple IM conversations over Internet Protocol (“IP”) through different IM service providers. *Id.* at 5:32–6:15, code (57). The device generates a buddy list of contacts associated with each IM service provider and displays conversation windows for each buddy with whom the user is engaged in active conversation. *Id.* at 5:32–51. The device detects signals from local wireless access points, prioritizes the access points according to their signal strength, and selects the one having the strongest signal for local network access. *Id.* at 5:4–11.

D. Illustrative Claims

Claims 2 and 31 are illustrative. Claim 2 depends from, independent claim 1, and claim 31 depends from canceled claims 20 and 30. Claims 1, 2, 20, 30, and 31 are reproduced below with bracketed lettering added.

1. [pre] An instant messaging terminal comprising:
 - [a] a handheld terminal housing;
 - [b] a display mounted in the terminal housing for displaying textual characters and graphical symbols;
 - [c] a data entry device integrated in the terminal housing for the display, the data entry device for generating textual characters and graphical symbols;
 - [d] a wireless, Internet protocol communications module coupled to a wireless transceiver, both being within the housing, for communicating messages with a wireless, Internet protocol access point; and
 - [e] a control module within the housing, the control module including at least one processor for executing an application program to implement instant messaging and session

protocols for at least one conversation session that is communicated by the wireless, Internet protocol communications module and the wireless transceiver through the wireless, Internet protocol access point, [f] the control module, in response to a loss of a network connection, displays conversation histories for conversations that were active when the network connection was lost, and [g] automatically searches for wireless, Internet protocol network beacons upon all of the conversation histories being displayed.

2. The terminal of claim 1, the data entry device further comprising:

a plurality of keys for graphical symbols, each graphical symbol key including indicia identifying the graphical symbol generated by depressing the key bearing the indicia.

20. [pre] A method for managing wireless network access and instant messaging through a wireless access point with a handheld instant messaging terminal comprising:

[a] entering textual characters and graphical symbols with a data entry device of a handheld terminal to form instant messages for delivery to an instant messaging service;

[b] displaying the entered textual characters and graphical symbols on a display of the handheld terminal;

[c] communicating instant messages with a wireless, Internet protocol access point, the instant messages being communicated with a communications module and wireless transceiver in the handheld terminal;

[d] coordinating authentication for coupling the handheld instant messaging terminal to a local network through the wireless, Internet protocol access point;

[e] implementing instant messaging and sessions protocols to control a conversation session through the wireless, Internet protocol access point, the instant messaging and session protocols being implemented within the handheld instant messaging terminals;

[f] displaying conversation histories for active conversations terminated by a loss of a network connection; and

[g] automatically searching for wireless, Internet protocol network beacons after the conversation histories are displayed.

30. The method of claim 20, the conversation session control further comprising:

accessing at least one instant messaging service provider through the access point.

31. The method of claim 30, the conversation session control further comprising:

generating a buddy list identifying buddies coupled to each instant messaging service accessed by the handheld instant messaging terminal controlling the conversation session and displaying the buddy list in response to a buddy list key being depressed on the data entry device.

Ex. 1001, 25:12–41, 26:41–65; 27:44–28:3 (bracketed letters added).

E. Evidence and Asserted Grounds

Petitioners rely on the following references. Pet. 1–3.

Name	Reference	Exhibit
Sidekick-I	T-Mobile Sidekick Owner's Manual, Release 1.01, March 11, 2003	1005
Sidekick-II	T-Mobile Sidekick Owner's Manual, https://web.archive.org/web/20030202154930/http://help.sidekick.dngr.com/OwnersManual.Html	1006
Heikes	Heikes, et al., U.S. Patent App. Pub. No. 2003/0225846 A1, filed Nov. 27, 2002, published Dec. 4, 2003	1007
Jonker	Jonker, et al., U.S. Patent No. 7,483,984 B1, filed Dec. 19, 2002, issued Jan. 27, 2009	1008
Brittan	Brittan, UK Patent App. GB 2,376,379, published Dec. 11, 2002	1009
Miller	Miller, et al., U.S. Patent No. 6,629,793 B1, filed Apr. 26, 2002, issued Oct. 7, 2003	1012
Rucinski	Rucinski, U.S. Patent App. Pub. No. 2003/0130014 A1, filed Aug. 20, 2002, published July 10, 2003	1040
Im	Im, KR Patent Pub. 2003-0068662, published Aug. 25, 2003	1044

Petitioners assert that claims 2–4, 11–14, 22, 23, and 31–33³ would have been unpatentable based on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
11	103(a)	Heikes, Jonker, (Sidekick I or Sidekick II), Brittan
2	103(a)	Heikes, Jonker, (Sidekick I or Sidekick II), Brittan, Miller
12–14, 31–33	103(a)	Heikes, Jonker, (Sidekick I or Sidekick II), Brittan
12–14, 31–33	103(a)	Heikes, Jonker, (Sidekick I or Sidekick II), Brittan, Rucinski
3, 4, 22, 23	103(a)	Heikes, Jonker, (Sidekick I or Sidekick II), Brittan, Miller, Im

Pet. 1–2. Petitioners also rely on the declarations of Patrick Traynor, Ph.D. (Ex. 1003) and Duncan Hall (Ex. 1021).

II. ANALYSIS

A. Board Discretion

Petitioners provide argument that the Board should not exercise its discretion under Sections 314(a) and 325(d) as addressed in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 3 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”) and *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sep. 6, 2017) (precedential as to Section II.B.4.i) (“*General Plastic*”). See Pet. 87–90; see also Patent Trial and Appeal Board Consolidated Trial Practice Guide 58 (Nov. 2019), <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>) (explaining

³ Claims 20, 21, and 24–30 of the ’870 patent were determined to be unpatentable in the *Google IPR*. *Google IPR* at 53 (finding that claims 20, 21, and 24–30 of the ’870 patent were unpatentable). Petitioners list previously cancelled claim 21 in the challenged claims as a predicate to claims that depend from claims 20 and 21.

that parties may wish to address the Board’s discretion to institute review in their papers). In addition, Petitioners filed a paper ranking the petitions filed challenging the ’870 patent and supporting the material differences among the petitions. Paper 2. Patent Owner did not file a preliminary response, and, accordingly, we do not reach or address Petitioners’ arguments on these issues.

B. Level of Ordinary Skill in the Art

Petitioners assert the level of skill adopted in the Final Written Decision in IPR2019-01567, *Google IPR* at 8. See Pet. 4 n.2; Ex. 1003 ¶¶ 37–38. Our prior decision in IPR2019-01567 found that

[a person of ordinary skill in the art] has an accredited bachelor’s degree in computer science, electrical engineering, or a related discipline that included coverage of wireless communications and the use of communication protocols used for real-time communications, and also at least two years of industry experience. In lieu of specific academic training, a [person of ordinary skill in the art] may draw upon appropriate industry experience to meet the foregoing requirements.

Google IPR at 8. We apply this level of skill in the present case.

C. Claim Construction

Petitioners offer no proposed claim constructions and apply the constructions determined by the Board in the IPR2019-01567 Final Written Decision. Pet. 3–4. Petitioners argue that the remaining terms are given their “ordinary and customary meaning as understood by a Person of Ordinary Skill in the Art as of the Critical Date . . . and the patent’s prosecution history.” *Id.* at 4 (citing Ex. 1003 ¶ 69; 37 C.F.R. §42.100(b)).

We adopt the claim constructions determinations in IPR2019-01567 provided in the table below.

Claim Term	IPR2019-01567 Construction
“a data entry device of a handheld terminal” (claim 20)	“a handheld terminal capable of data entry”
“network connection” (claim 20)	No construction required
“graphical symbols” (claim 20)	“graphical emoticons that differ from textual characters representing emoticons”
“entering textual characters and graphical symbols with a data entry device” (claim 20)	“ordinary meaning in the context of the claims”

Google IPR at 9–13.

D. Obviousness of Claim 11: Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), and Brittan

Petitioners assert that claim 11, which depends from claim 1, is unpatentable under 35 U.S.C. § 103(a) as obvious over Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), and Brittan. Pet. 28–54. Claim 11 limits the control module of claim, stating that “terminal of claim 1 wherein the control module accesses at least one instant messaging service provider through the access point.” Ex. 1001, cl. 11. To support their contentions, Petitioners provide explanations as to how the prior art discloses each claim limitation and the motivations to combine the prior art teachings. *Id.* Petitioners also provide citations to the Traynor Declaration in support of their contentions. Ex. 1003 ¶¶ 208–330. The prior art is summarized below.

1. Heikes (Ex. 1007)

Heikes discloses an Instant Messaging Personalization system (Ex. 1007, code (54)), disclosing IM sender systems communicating with IM recipients system and IM host systems through a communication link including users such as AIM, ICQ, Yahoo Messenger and Microsoft

Messenger (*id.* ¶ 50). Figure 4, provided below, illustrates such a communication system. *Id.* ¶ 56.

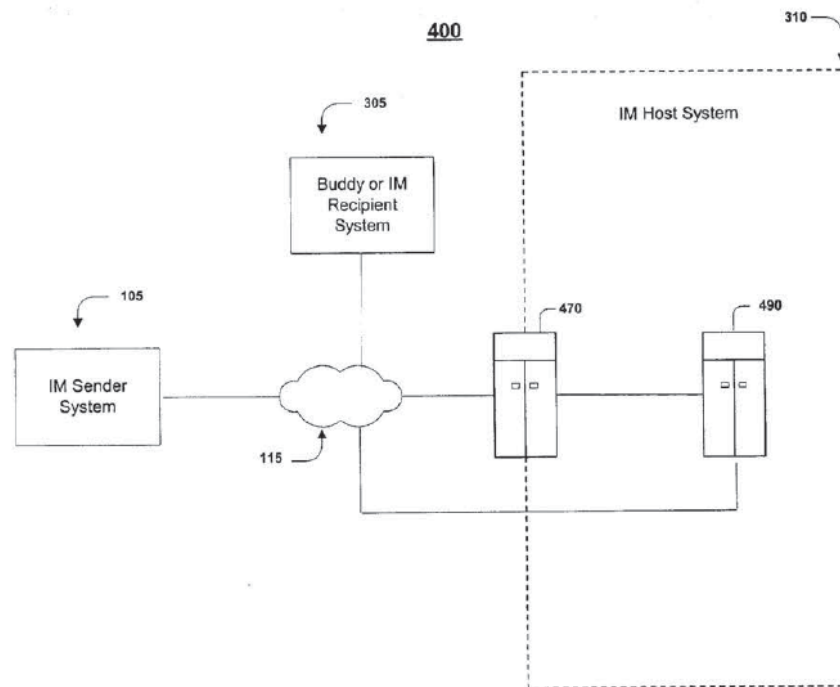


Fig. 4

Figure 4 shows IM host system 310 “support[s] IM services” and “allow[s] users to send and receive IMs” using “standard or exclusive IM protocols.” *Id.* ¶¶ 52, 58. “By accessing the IM host system, an IM sender can use the IM client application to view whether particular users (‘buddies’) are online, exchange IMs with particular buddies, . . . [and] trade files.” *Id.* ¶ 53, *see id.* ¶¶ 54, 55, 60. Heikes provides examples of user interfaces of IM conversation sessions where user select and send emoticons. *Id.* ¶¶ 84, 110–112, 116, Figs 11, 12, 15. Heikes further shows that IM recipient systems use an IM services over a wireless network or LAN as shown in Figure 1 below. *Id.* ¶¶ 2, 39, 50.

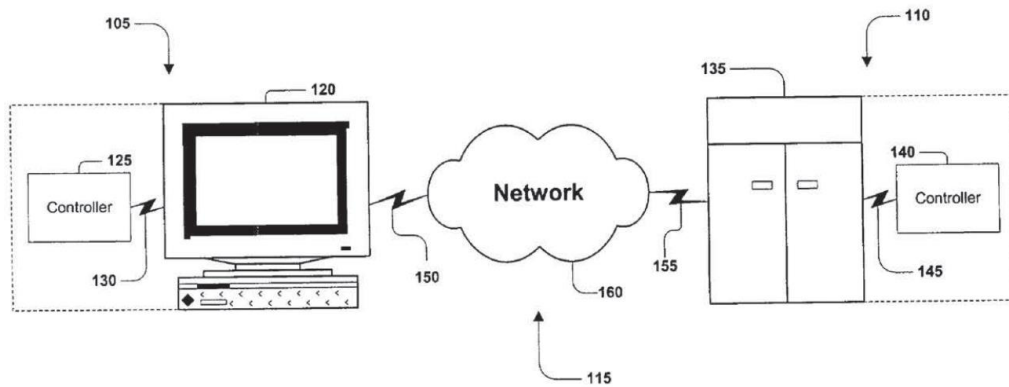


Fig. 1

Figure 1 shows IM sender system 105 typically includes client device 120 and/or client controllers 125 that use an IM service over network 160, which may be a LAN or WAN. IM sender that enables IM sender system 105 to send and receive IMs with IM recipient systems using an IM service and over a wireless network 160 (e.g., LAN). *Id.* ¶¶ 2, 39, 50.

2. *Jonker (Ex. 1008)*

Jonker discloses a method for accessing wireless carrier networks by mobile computing devices. Ex. 1008, code (57). Figure 1 below depicts a mobile computing device accessing a network. *Id.* at 3:7–9.

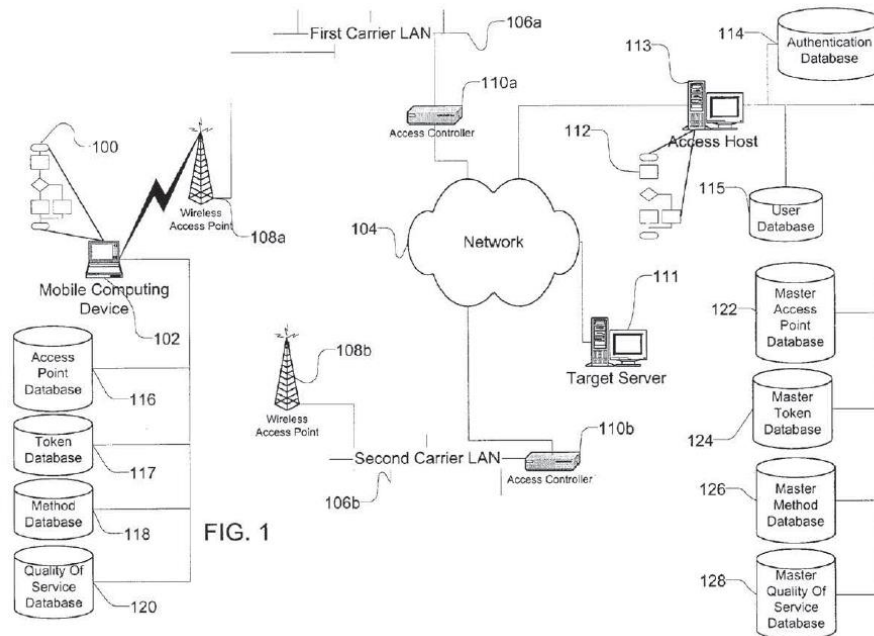


Figure 1 shows mobile device 102 that includes access client 100, which enables access to network 104 via carrier LAN network 106a/106b using Wireless Access Point (AP) 108a. *Id.* at 4:1–8, 26:32–35, Fig. 1. Access client 100 uses a network device “to transmit and receive carrier network signals.” *Id.* at 26:36–41. In addition, Jonker teaches that access client 100 includes sniffer 200 to “detect access points” by receiving “carrier network signals transmitted by the AP,” which include “a carrier network identifier used by devices coupled to the carrier network to identify the network.” *Id.* at 6:54–66. Jonker further teaches that sniffer 200 “continuously polls access points” and if the sniffer logic determines that the access client is not currently connected to a carrier network, it determined if an access point is available. *Id.* at 11:32–12:6.

3. *Sidekick-I (Ex. 1005) and Sidekick II (Ex. 1006)*

Sidekick-I (a PDF manual) and Sidekick II (an internet based publication of a user manual) are the user manuals for a handheld mobile communication device that uses IM and wireless networking. Ex. 1005, 1,

9, 14; Ex. 1006, 5, 9. Petitioner cites to the two Sidekick manuals in parallel asserting that “Sidekick-II is the earliest publically accessible portions of a user manual relied upon” and Sidekick-I “has a slightly later known public accessibility date than Sidekick-II.” Pet. 3. Petitioner relies primarily on Sidekick-I, but to the extent that Sidekick-I is challenged, Petitioner also relies independently on Sidekick-II. *Id.*

The Sidekick manuals disclose a device, with display keyboard and control buttons that also has wireless network connectivity to connect to IM functions such as AOL Messenger (AIM). Ex. 1005, 14, 19–22, 43, 46, 73, 75; Ex. 1006, 9–12, 24–26, 52–55. The Sidekick manuals disclose that “[w]ith AIM, you can have up to 10 online [IM] conversations going at the same time.” Ex 1005, 81–82; Ex. 1006, 47–48. The Sidekick manuals state that the display screen provides indications for when a message has been sent successfully or queued for delivery when a connection is lost when a device was out of radio range. Ex. 1006, 48, 72; Ex. 1005, 81.

4. *Brittan (Ex. 1009)*

Brittan discloses an “emotion key for user selection of an emotion from a set of emotions,” within “text messaging device[s] such as a mobile phone” and utilizing messaging systems such as “instant messaging” systems. Ex. 1009, codes (54), (57). Brittan discloses that keys are assigned “smilies” represented in text form by “corresponding character strings” that can be inserted into messages using the assigned key and displayed on the “sender-device display by the corresponding graphic.” *Id.* at 12, Fig. 4.

5. *Motivation to Combine*

Petitioners assert that Heikes, Jonker, Sidekick (Sidekick-I or Sidekick-II), and Brittan teach the limitations of claims 1. Pet. 14–28; Ex. 1003 ¶¶ 150–207. For the motivation to combine the references,

Petitioners assert a person of ordinary skill in the art would have been motivated to combine Heikes, Jonker, Sidekick (Sidekick-I or Sidekick-II), and Brittan, to implement a mobile device in Heikes with connection to a LAN or WAN as disclosed in Jonker in accordance with the Heikes' system. Pet. 14–17; Ex. 1003 ¶¶ 152–160; Ex. 1007 ¶¶ 2, 38, 45–47; Ex. 1005 ¶¶ 39–45, Fig. 1. Petitioners argue that both Heikes and Jonker teach wireless communication and that it was “well known and common knowledge for wireless LANs (as described in Heikes) to operate and be implemented in either an ad-hoc mode or an infrastructure mode, in which a device connects to an access point associated with the LAN.” Pet. 17; see *id.* 17–18; Ex. 1003 ¶¶ 161–166.

Petitioners further assert that an ordinarily skilled artisan would have utilized the Sidekick features of an integrated display and keyboard in the mobile device of Heikes which does not expressly teach how data is entered or displayed, finding it obvious to implement a well-known PDA device with IM capabilities and form to navigate and perform data entry. Pet. 18–20; Ex. 1003 ¶¶ 167–177. Petitioner also argues that “based on Brittan, a POSITA would have found it obvious to modify the Heikes- Jonker- Sidekick device to enable a key/button on the device to be used to select/add a smiley into the IM conversation from a menu of smilies (as already disclosed and shown in Heikes . . .)” (Pet. 23), as it was well known to use buttons or related menus to select emoticon smilies (*id.* at 27). Petitioners argue that

configuring Heikes-Sidekick-Jonker's device to implement Brittan's teachings would have amounted to the use of a known technique to improve similar devices in the same way, and combining prior art elements according to known methods to yield predictable results—a device that enables pressing one or

more buttons to select a smiley from a menu of smilies and providing the selected smiley for display in graphical form in the IM conversation.

Pet. 25 (citing Ex. 1003 ¶¶ 191–192).

Finally, Petitioners argues that it would have been motivated to implement Sidekick’s teachings of displaying chat history and when the network connection is lost and re-connecting to the network after such a connection is lost. Pet. 25–28; Ex. 1003 ¶¶ 195–207. Petitioners provide sufficient rationales to combine the teachings of Heikes, Sidekick, Jonker, and Brittan as adding Sidekick’s well-known teachings amounted to using known techniques to improve similar devices in the same way, yielding predictable results for handheld IM devices that that lose connectivity. Pet. 27–28.

6. *Claim 11 Analysis*

Petitioners provide sufficient analysis and citation mapping the limitations of claim 11, which depends from claim 1, to the combination of Heikes, Jonker, Sidekick (with parallel citations to Sidekick-I and Sidekick-II), and Brittan. Pet. 28–54; Ex. 1003 ¶¶ 208–330. Petitioners provide citation to declarant testimony to support that the Heikes, Jonker, Sidekick, and Brittan device teaches the limitations of claim 1. *Id.* For example, Petitioner provides evidence that “Heikes-Jonker-Sidekick-Brittan provides a device . . . having having IM capabilities” with a handheld terminal (claim limitation 1[a]). Pet. 28–30; Ex. 1003 ¶¶ 208–214; *see* Ex. 1005, 1, 9, 14; Ex. 1006, 5, 9–11. Petitioners’ evidence supports that the proposed combination teaches limitations 1[b] and 1[c], where the Sidekick manuals disclose a display and data entry keyboard (Pet. 30–36; Ex. 1003 ¶¶ 222–229) and Heikes and Brittan teach “key or a set of keys/buttons on the data

entry device to be used to enter/generate graphical symbols, e.g., for input into an IM conversation session” (Pet. 35 (citing Ex. 1003 ¶ 226)). Thus, Petitioners argue that the “Heikes-Jonker-Sidekick-Brittan’s device (*see* [1pre]) includes a data entry device (e.g., a keyboard and additional buttons) that is integrated in the terminal housing (*see* [1a]) for the display and that generates textual characters and graphical symbols (e.g., graphical emoticons).” Pet. 36 (citing Ex. 1003 ¶¶ 222–229).

With respect to the wireless communication limitations 1[d], Petitioners also provide sufficient evidence and argument that the “Heikes-Jonker-Sidekick-Brittan’s device includes wireless, Internet protocol communication module (e.g., client controller 125 and/or access client) coupled to a wireless transceiver, both being within the terminal housing and for communicating messages with a wireless Internet protocol access point.” Pet. 37 (citing Ex. 1003 ¶¶ 230–254); *see* Pet. 37–43. Further, for limitation 1[e], Petitioners provide sufficient evidence that Heikes discloses including” within a client device . . . (1) a ‘central processing unit 282 (CPU) for executing instructions’ and (2) an ‘internal memory’ for storing an ‘instant messaging application’ (e.g., AOL Instant Messenger or another IM application). Pet. 43–44 (citing Ex. 1007 ¶¶ 45–47, 50, 60; Ex. 1003 ¶¶ 256–257). Finally, Petitioners provide sufficient evidence that “Heikes-Jonker-Sidekick-Brittan’s control module” would respond to a loss of network connection by displaying conversation histories and searching for wireless for active IM conversations as required in limitations 1[f] and 1[g]. Pet. 48–52; Ex. 1003 ¶¶ 271–289.

With respect to dependent claim 11, Petitioners aver that:

Heikes-Jonker-Sidekick-Brittan’s control module
(processor executing the AIM client application or another IM

application—as in [1e]) accesses an IM service (AIM or another service). APMT-1007, [0037] (identifying various IM services), [0045]–[0048] (identifying IM applications executing on the client device), FIGS. 3–4 and [0052]–[0060] (describing IM communications establishment and management between an IM sender and recipient), [0110]–[0116] and FIGS. 11–15 (describing and showing various user interfaces “presented to an IM sender of an IM service provider such as the AOL Instant Messenger (AIM) service”); see APMT-1005, 73-82 (describing Sidekick device accessing the AIM service); APMT-1006, 43-48 (same); APMT-1003, ¶326.

Pet. 53. Petitioners assert that in accordance with the [1d] and [1e] limitations of claim 1, the “Heikes-Jonker-Sidekick-Brittan’s device communicates data over a network, including sending and receiving IM messages while connected to an IM service, via the wireless, . . . the client controller together with the access client[] and the wireless transceiver through the wireless, Internet protocol access point. *Id.* (citing Ex. 1007 ¶¶ 39–49, 59; Ex. 1008, 4:1–50, 5:55–6:8, 26:32–45; Ex. 1003 ¶ 328).

Based on the current record, we find no deficiency in Petitioners’ evidence and argument regarding the Heikes-Jonker-Sidekick-Brittan IM device combination and functions, as well as knowledge in the art, or in Petitioners’ analysis regarding why one of ordinary skill in the art would have been prompted to implement the Heikes-Jonker-Sidekick-Brittan IM device. In addition, for purposes of institution, we accept Dr. Traynor’s testimony concerning the relevant teachings of the cited references and knowledge of an ordinarily skilled artisan. Accordingly, Petitioner has shown a reasonable likelihood that it would prevail in showing that Heikes-Jonker-Sidekick-Brittan (based on either Sidekick-I or Sidekick-II) teach the limitations of claim 11.

7. *Analysis of Claims 20 and 30*

Petitioners provide analysis of claims 20 and 30, which form the basis of additional grounds in the Petition directed to dependent claims 22, 23, and 31–33 in related grounds discussed below. *See* Pet. 1–2. Petitioners provide sufficient evidence that Heikes-Jonker-Sidekick-Brittan (based on either Sidekick-I or Sidekick-II) teach the limitations of claims 20 and 30. Pet. 54–60; Ex. 1003 ¶¶ 331–350. Petitioners address claims 20 and 30 as they provide supporting analysis for challenged claims 31–33 addressed below.

E. Obviousness of Claim 2: Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, and Miller

Petitioners assert that claim 2 is unpatentable under 35 U.S.C. § 103(a) as obvious over Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, and Miller. Pet. 60–65; *see id.* at 28–52 (addressing claim 1 from which claim 2 depends). To support their contentions, Petitioners provide explanations as to how the prior art discloses each claim limitation and the motivations to combine the prior art teachings. *Id.* Petitioners also provide citations to the Traynor Declaration in support of their contentions. Ex. 1003 ¶¶ 408–424.

Miller teaches a computer system (e.g., PDA) that includes a keyboard, an operating system, and a[n] “instant messaging application.” Ex. 1012, 4:13–50, Fig. 1. Miller discloses that when a user selects a key on the keyboard, the corresponding characters or graphical emoticons associated with the key are used to input text or graphics into an IM application display. Ex. 1012, 7:60–8:31, 8:66–9:35, 9:49–52 (stating that an “emoticon can be a set of text characters” or “a graphic”), Fig. 5–7.

Petitioners provide sufficient argument that the “Heikes-Jonker-Sidekick-Brittan’s device is the type of device that Miller sought to improve

upon” (Ex. 1012, 1:22–2:60) as “Miller explains that conventional devices/software required users to choose a graphic emoticon for display by ‘press[ing] more than one key or using a graphical menu’ of such emoticons, which can ‘be confusing and distracting to the instant messaging experience’” (*id.* at 1:22–2:60). Pet. 62 (citing Ex. 1003 ¶¶ 412–413). Based on the current evidence, Petitioners provide sufficient rationales to support that a skilled artisan “would have been motivated to include one or more dedicated emoticon keys, on the combination’s keyboard, which upon being depressed would result in entering a graphical emoticon in the IM application’s display.” Pet. 63 (citing Ex. 1003 ¶ 418; Ex. 1012, 2:20–45).

1. *Claim 2*

Claim 2 depends from claim 1. Petitioners argue that “based on Miller, it would have been obvious for the combination’s keyboard to include multiple (at least two) emoticon keys such that pressing one such key would have resulted in the corresponding graphical emoticon to be displayed (e.g., in the IM application’s interface provided on the display). Pet. 63–64 (citing Ex. 1012, 4:5–12, 7:60–8:31, 8:66–9:35, 9:49–52, Figs. 3–7; Ex. 1003 ¶¶ 421–422).

For the reasons discussed above, we find Petitioners have provided sufficient evidence that Heikes-Jonker-Sidekick-Brittan in combination with Miller teaches the keyboard data entry limitations of claim 2. We have reviewed Petitioners’ assertions and supporting evidence for this claims, and we find them to be persuasive based on the current record.

F. Obviousness of Claims 12–14 and 31–33: Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), and Brittan, or Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, and Rucinski

Petitioners assert that claims 12–14 and 31–33 are unpatentable under 35 U.S.C. § 103(a) as obvious over the Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan combination in view of the features of the Sidekick, or Rucinski in combination with the Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan combination. Pet. 65–79; *see id.* at 59–60 (addressing claim 30 from which claims 31–33 depend). To support their contentions, Petitioners provide explanations as to how the prior art discloses each claim limitation and the motivations to combine the prior art teachings. *Id.* Petitioners also provide citations to the Traynor Declaration in support of their contentions. Ex. 1003 ¶¶ 326–330, 350, 429–477.

Petitioners provide argument and evidence that in view of the features of the Sidekick device, Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan teach the buddy list and controller limitations of claims 12–14 and 31–33. Pet. 65–79; Ex. 1003 ¶¶ 326–330, 350, 429–477. In the alternative, Petitioners argue that Rucinski discloses a dedicated button to launch a buddy list. Pet. 68 (citing Ex. 1003 ¶¶ 435–436; Ex. 1040 ¶ 50). Petitioners also argue that the combination of Rucinski’s dedicated single buddy list button or key and the Heikes-Jonker-Sidekick-Brittan, the device would display the buddy list upon pressing the device’s buttons (Ex. 1005, 73, 77, 81; Ex. 1006, 43, 45, 48; Ex. 1003 ¶ 438) would motivate a skilled artisan to provide a control module that generates a buddy list as recited in the claims. Pet. 67–69; Ex. 1003 ¶¶ 435–444.

We find that Petitioners have demonstrated a reasonable likelihood of success in showing the Heikes, Jonker, Sidekick (Sidekick I or Sidekick II),

Brittan combination in view of the features of the Sidekick, or Rucinski in combination with the Heikes, Jonker, Sidekick (Sidekick I or Sidekick II) would render claims 12–14 and 31–33. We have reviewed Petitioners’ assertions and supporting evidence for these claims and the rationales for their combination, and we find them to be persuasive based on the current record.

G. Obviousness of Claims 3, 4, 22, and 23: Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, Miller, and Im

Petitioners assert that claims 3, 4, 22, and 23 are unpatentable under 35 U.S.C. § 103(a) as obvious over Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, Miller, and Im. Pet. 79–87; *see id.* at 54–59, 65 (addressing claims 20 from which claims 22 and 23 depend). To support their contentions, Petitioners provide explanations as to how the prior art discloses each claim limitation and the motivations to combine the prior art teachings. *Id.* Petitioners also provide citations to the Traynor Declaration in support of their contentions. Ex. 1003 ¶¶ 331–349, 425–428, 478–506.

Im teaches “shortcut key[s]” on a keyboard of a device (e.g., a PDA) that can be programmed to be associated with a “character string” that can be input into applications. Ex 1044, Abstract, 2. Petitioners support their contentions, arguing that a skilled artisan would have been motivated to “seek out and implement user-definable, programmable emoticon key(s), contemplated by Miller, within the combination [of Heikes].” Pet. 81 (citing Ex. 1003 ¶¶ 483–484). Petitioners provide multiple rationales to combine Im with Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, and Miller based on the disclosures in Im, Heikes, and Brittan. Pet. 80–81; Ex. 1003 ¶¶ 483–484; Ex. 1009, 12–13.

Petitioners provide sufficient evidence that Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, Miller and Im teach the programmable key limitations of claims 3, 4, 22, and 23. Pet. 83–87; Ex. 1003 ¶¶ 492–506; see Ex. 1044, 2–4; Ex. 1007 ¶¶ 110–112, Figs. 11, 12; Ex. 1010, 90; Ex. 1009, 11–13, Figs. 3, 4; see also Pet. 54–59, 65 (discussing claims 20 and 21).

We have reviewed Petitioners’ assertions and supporting evidence that Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, Miller, and Im render claims 3, 4, 22, and 23 unpatentable, and we find them to be persuasive based on the current record.

III. CONCLUSION

On this record, we are persuaded that Petitioners demonstrate a reasonable likelihood that they would prevail in showing the unpatentability of at least one of challenged claims 2–4, 11–14, 22, 23, and 31–33 of the ’870 patent. We, accordingly, institute an *inter partes* review of the challenged claims.

Our determination in this Decision is not a final determination on either the patentability of any challenged claims or the construction of any claim term and, thus, leaves undecided any remaining fact issues necessary to determine whether sufficient evidence supports Petitioners’ contentions by a preponderance of the evidence in the final written decision. See *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) (noting that “there is a significant difference between a petitioner’s burden to establish a ‘reasonable likelihood of success’ at institution, and actually proving invalidity by a preponderance of the evidence at trial”) (quoting 35 U.S.C. § 314(a) and comparing *id.* § 316(e)).

IV. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted for all asserted grounds; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this Decision.

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