

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.

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.

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.

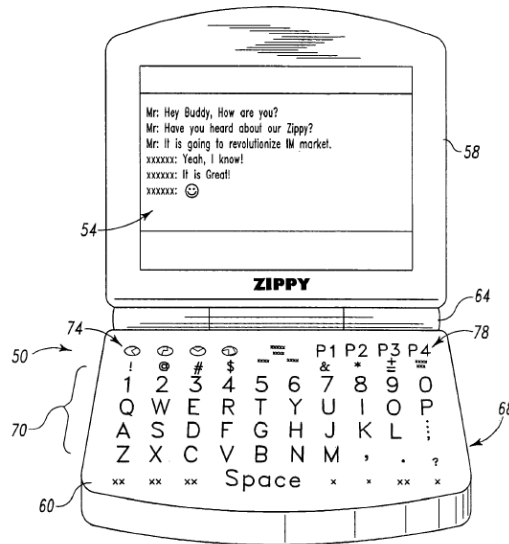


Fig. 2

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.

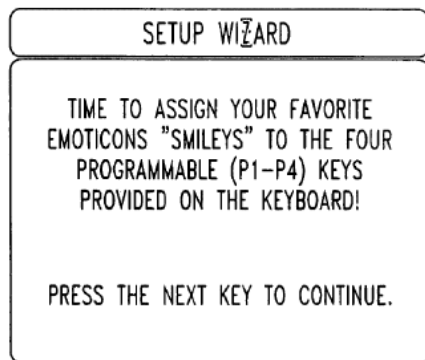


Fig. 12A

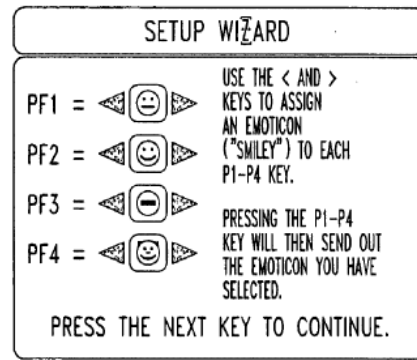


Fig. 12B

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

Dependent claims 23 and 31 are illustrative.

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.

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

identifying a key on the data entry device with a graphical symbol that is generated by depressing the key.

22. The method of claim 21, the conversation session control further comprising:

associating at least one programmable key with a set of characters corresponding to a graphical symbol supported by an instant messaging service provider.

23. The method of claim 22, the conversation session control further comprising:

generating in accordance with an instant messaging service protocol being used to communicate with a buddy, a character sequence to represent the graphical symbol supported by the instant messaging service provider in response to the depression of the programmable key.

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, 26:41–27:14; 27:38–49 (bracketed letters added).

E. Evidence and Instituted Grounds

Petitioner relies on the following references. Pet. 2–3.

Name	Reference	Exhibit
Van Dok	Van Dok, U.S. Patent App. Pub. No. 2004/0162877, filed Feb. 19, 2003, published Aug. 19, 2004	1060
Sinivaara	Sinivaara, U.S. Patent App. Pub. No. 2004/0202141, filed Jan. 9, 2003, published Oct. 14, 2004	1062
Chiu	Chiu, U.S. Patent App. Pub. No. 2003/0204748, filed May 20, 2002, published Oct. 30, 2003	1063
McCarthy	McCarthy, U.S. Patent No. 7,328,242, filed Sep. 17, 2002, issued Feb. 5, 2008	1064
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
Canfield	Canfield, et al., U.S. Patent No. 7,281,215 B1, filed Jul. 31, 2002, issued Oct. 9, 2007	1045
Im	Im, KR Patent Pub. 2003-0068662, published Aug. 25, 2003	1044
Saric	Saric, et al., Canadian Patent App. No. 2,363,978, filed Nov. 26, 2001, published May 26, 2003	1065
Capps	Capps, U.S. Patent No. 7,519,667 B1, filed Apr. 16, 2002, issued Apr. 14, 2009	1011
Rucinski	Rucinski, U.S. Patent App. Pub. No. 2003/0130014, filed Aug. 30, 2002, published July 10, 2003	1040

Petitioner also relies on the declarations of Patrick Traynor, Ph.D. (Ex. 1003), Dr. Gregory Abowd (Ex. 1049) (asserted in the *Google IPR*), and Duncan Hall (Ex. 1021).

We instituted the proceeding that claims 22, 23, and 31–40 would have been unpatentable based on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
31–33	103(a)	Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II) or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Rucinski
34, 35	103(a)	Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield, Rucinski
36–40	103(a)	Van Dok, Sinivaara, Chiu, McCarthy, Capps
22, 23	103(a)	Van Dok, Sinivaara, Chiu, McCarthy, Saric, Im

Dec. on Inst. 19; Pet. 1–2.

II. ANALYSIS

A. Legal Standard

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *see also* 37 C.F.R. § 42.104(b) (requiring a petition for *inter partes* review to identify how the challenged

claim is to be construed and where each element of the claim is found in the prior art patents or printed publications relied upon).

A patent claim is unpatentable under 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved based on underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when presented, objective evidence of nonobviousness, i.e., secondary considerations.⁴ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements,” but “must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

⁴ Patent Owner did not provide any evidence or argument contesting Petitioner’s unpatentability arguments. Thus, Patent Owner presents no secondary considerations evidence.

B. Level of Ordinary Skill in the Art

Petitioner asserts the level of skill adopted in the Final Written Decision in IPR2019-01567, *Google IPR* at 8. *See* Pet. 9 n.3; 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

Petitioner offers no proposed claim constructions and applies the constructions determined by the Board in the IPR2019-01567 Final Written Decision. Pet. 6–7. We adopt the claim constructions determinations in IPR2019-01567 provided in the table below for the reasons discussed there.

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 Claims 31–33: Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II) or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Rucinski

Petitioner asserts that claims 31–30 are unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II) or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Rucinski. Pet. 4–50. To support their contentions, Petitioner provides explanations as to how the prior art discloses each claim limitation and the motivations to combine the prior art teachings. *Id.* Petitioner also cites to the Traynor and Abowd declarations in support of their contentions. Ex. 1003 ¶¶ 507–618; Ex. 1049 ¶¶ 52–263. The prior art is summarized below.

1. Van Dok (Ex. 1060)

Van Dok discloses a system providing “enhancements to a real-time communications user interface” that “add functionality and personality” in “instant messaging.” Ex. 1060, code (57), ¶ 3. Van Dok addresses shortcomings of traditional instant messaging through “automatic emoticon replacement.” *Id.* ¶¶ 7, 9, 56. Van Dok discloses that “[k]nown instant messaging implementations . . . fail to show a graphical representation [e.g., ☺] for a textually entered emoticon [e.g., ‘:’)'] . . . until after a message is sent.” *Id.* ¶ 14. Van Dok teaches that when the user types a text sequence for an emoticon (e.g., “:”) for a smiley face emoticon), the system automatically interprets the text sequence and displays its graphical representation (e.g., ☺) in the “input box” of a “conversation window” before the message is sent, “allow[ing] the user composing the message to preview how the message will appear when received.” *Id.* ¶ 56. Figure 5A depicts the automatic emoticon replacement disclosed in Van Dok. *Id.* ¶ 26.

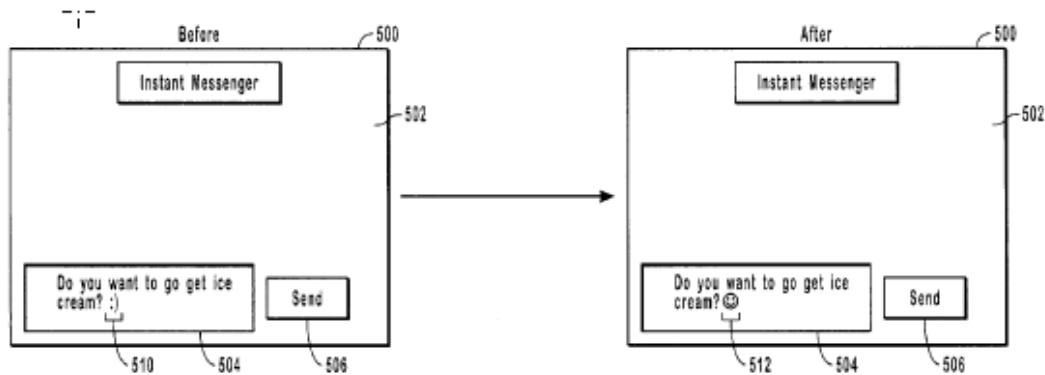


FIG. 5A

Van Dok states that Figure 5A illustrates

instant messaging user interface 500, having conversation window 502, input box 504, and send button 506, both “Before” and “After” automatic emoticon replacement in accordance with the present invention. The user interface interprets, for example, the text sequence “:)” 510 automatically as the smiley face character ☺ 512, before a user selects the send button 506 for the instant message in input box 504. Among other things, replacement before sending the real-time message allows the user composing the message to preview how the message will appear when received. Of course, text sequence 510 is merely one example of many possible text sequences for potentially many different emoticons that may be available. Which text sequences correspond to which emoticons may be user configurable, including the ability to specify user defined emoticons. . . .

Id. ¶ 56.

Van Dok also discusses use of “hand-held devices” and network computing environments and handheld device markup language (HDML) operating in wireless network environments. *Id.* ¶¶ 16, 66–69.

2. Sinivaara (Ex. 1062)

Sinivaara discloses a method for a “mobile terminal” to select an “access point in a wireless communication system.” Ex. 1062, code (57). Sinivaara teaches that

a group of mobile terminals in a cell utilize predetermined attributes which give an indication of the quality of service (QoS) currently experienced by the terminal, by collecting a set of such attributes and sending the set to the serving access point. The serving access point processes the attribute sets received from the mobile terminals and compiles a cell report on the basis of the sets. The cell report indicates the current overall quality of service in the cell. . . .

The service report is then transmitted so that each mobile terminal in the neighborhood, which is about to select an access point, may receive it.

Id. ¶¶ 16–17. Sinivaara describes WLAN in “infrastructure mode” is “preferably based on the IEEE 802.11 [Wi-Fi] standard for wireless local area networking” for a mobile terminal to use “beacon” information to select an access point to use. *Id.* ¶¶ 1–5, 15, 55, 56.

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 manual 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. *McCarthy (Ex. 1064)*

McCarthy teaches improving upon “prior art messaging systems” such as “instant messaging” systems by allowing a user to “participate in the chat while not connected and . . . pick up in a past [messaging] discussion if they later rejoin the chat.” Ex. 1064, 1:24, 2:12–51, 2:66–3:17, 3:54–4:10.

5. *Rucinski (Ex. 1040)*

Rucinski discloses a user interface for use in an instant messaging service application. Ex. 1040, code (57). Rucinski teaches a dedicated button to launch a buddy list. Ex. 1040 ¶ 50. Specifically, Rucinski teaches a “WHO’s ON” which upon activation displays a screen “identify[ing] those subscribers that are online and within, for example, a buddy list or chat group associated with the user.” *Id.*

6. *Motivation to Combine*

Petitioner argue that the *Google IPR* found that a person of ordinary skill in the art would have had reasons to combine VD, Sinivaara, Chiu, McCarty to implement Van Dok’s device as set forth in IPR2019-01567. Pet. 9 (citing *Google IPR* at 16–17). Thus, Petitioner reasserts the arguments presented in the *Google IPR* supporting the motivation to combination VD, Sinivaara, Chiu, and McCarty. Pet. 9–14; Ex. 1003 ¶¶ 522–522; Ex. 1049 ¶¶ 119–128. We agree and find that Petitioner provides persuasive argument and evidence supporting the combination of Van Dok’s instant messaging device with features from the Sidekick as

asserted in the *Google IPR* (Pet. 29–35; Ex. 1003 ¶¶ 532–545) and in the alternative with Sidekick and Rucinski (Pet. 38–39; Ex. 1003 ¶¶ 546–560).

In view of the final record here, Petitioner provides persuasive rationales by a preponderance of the evidence to combine the teachings of Van Dok, Sinivaara, Chiu, McCarthy, and (Sidekick I or Sidekick II); and Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), and Rucinski.

7. *Claims 31–33*

In view of the *Google IPR* which canceled claims 20, 24–30 based on Van Dok, Sinivaara, Chiu, and McCarty (Pet. 14–30; *Google IPR* at 18–26), Petitioner asserts that Van Dok, Sinivaara, Chiu, and McCarty in combination with the teachings of Sidekick (Sidekick-I and Sidekick-II) discloses the limitations of claims 31–33, which require conversation control involving generating and displaying a buddy list. Pet. 29–38; Ex. 1003 ¶¶ 532–552. In the alternative, Petitioner argues that Rucinski in combination with Van Dok, Sinivaara, Chiu, McCarty, and Sidekick provides a dedicated button to launch a buddy list for an instant messaging service. Pet. 38–39; Ex. 1003 ¶¶ 552–560.

Based on the full record, we find no deficiencies in Petitioner’s evidence and argument regarding the functions, knowledge in the art, or in Petitioner’s analysis regarding the why one of ordinary skill in the art would have been prompted to implement the Van Dok, Sinivaara, Chiu, McCarty, and Sidekick device or the Van Dok, Sinivaara, Chiu, McCarty, Sidekick, and Rucinski device. In addition, we find persuasive Petitioner’s declarant testimony concerning the relevant teachings of the cited references and knowledge of an ordinarily skilled artisan.

We find that Petitioner has shown that the asserted prior art teaches the handheld instant messaging terminal accessing an instant messaging through an access point (claims 20 and 30, Pet. 14–29), and further teaches the limitations of claims 31–33, directed toward conversation session control that generates a buddy list (claim 31), displays a buddy list for active conversations (claim 32), and generating and displaying an active buddy list conversation window (claim 33). *Id.* at 35–50; Ex. 1003 ¶¶ 546–591. We have reviewed Petitioner’s arguments and evidence and find them persuasive that proposed Van Dok, Sinivaara, Chiu, McCarty, and Sidekick combination or Van Dok, Sinivaara, Chiu, McCarty, Sidekick, and Rucinski combination teach the session controls for a buddy lists, active buddy conversations, and conversation windows as recited in claims 31–33. *Id.* (providing buddy list screens and conversation sessions showing claim features for each limitation of claims 31–33).

Patent Owner provided no opposition contesting Petitioner’s arguments or evidence. Indeed, Patent Owner stated on the record in a hearing for the related IPRs (IPR2021-01130 and IPR2021-01131) that they are not contesting a final written decision or adverse judgment in the cases where Patent Owner did not file a response. IPR2021-01130 Paper 29, 64:3–64:20 (stating that Patent Owner is not contesting adverse judgment “if the Board determines [Petitioner] met their burden of proof with respect to those claims [where Patent Owner] hasn’t filed any opposition”). We find that Petitioner has shown by a preponderance of the evidence that Van Dok, Sinivaara, Chiu, McCarty, and Sidekick or Van Dok, Sinivaara, Chiu, McCarty, Sidekick, and Rucinski teach the limitations of claims 31–33 by a preponderance of the evidence.

E. Obviousness of Claims 34 and 35: Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield, Rucinski

Petitioner asserts that claims 34 and 35, which depend from claims 30–33, are unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), and Canfield or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield, and Rucinski. Pet. 50–64. As stated above, claim 30 was found unpatentable over Van Dok, Sinivaara, Chiu, and McCarthy. *Google IPR* at 25–26. To support their contentions, Petitioner provides explanations as to how the prior art discloses each claim limitation and the motivations to combine the prior art teachings of Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield, Rucinski. Pet. 50–64; Ex. 1003 ¶¶ 592–650.

Canfield discloses an “IM conversation counter and indicator” that “provides . . . statistics regarding concurrent instant messaging sessions.” Ex. 1045, codes (54), (57). Canfield teaches a system that “determine[s]” “statistics,” such as “a total number of concurrent instant messaging sessions; a number of instant messaging sessions with new messages; a number of new instant messaging sessions; and a number of new instant messages.” *Id.* at 1:45–62.

Petitioner provides persuasive evidence and argument that the combination of Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), and Canfield, or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield, and Rucinski teach the conversation session windows for messaging buddies and parsing data entries for

compatibility with instant messaging services required in claims 34 and 35. *See* Pet. 50–64; Ex. 1003 ¶¶ 592–650.

Patent Owner provided no response contesting Petitioner’s arguments or evidence. Based on the record here, we find that Petitioner has shown by a preponderance of the evidence that claims 34 and 35 are unpatentable over Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), and Canfield, or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield, and Rucinski.

F. Obviousness of Claims 36–40: Van Dok, Sinivaara, Chiu, McCarthy, Capps

In view of the *Google IPR* which canceled claims 20, 24–30 based on Van Dok, Sinivaara, Chiu, and McCarty (Pet. 14–30; *Google IPR* at 18–26), Petitioner asserts that claims 36–40 are unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Chiu, McCarthy, and Capps. Pet. 64–73. Petitioner provides persuasive argument and evidence that a person of ordinary skill in the art would have been motivated to combine Capps’ teachings with Van Dok, Sinivaara, Chiu, and McCarty. Pet. 65–67; Ex. 1003 ¶¶ 652–657.

Capps discloses a method and system for “integrating an instant messaging client application, a streaming audio server application, and an audio playback application” in a client computer. Ex. 1011, code (57), 1:18–20. Capps teaches that “media player application is utilized to play an audio track” or play audio from “a streaming audio radio station,” while a user of an “instant messaging client application” is “engage[d] in an instant messaging session with other users.” *Id.* at 2:31–48, 7:43–54.

In view of our prior determinations, *see Google IPR* at 18–26, Petitioner provides persuasive argument and evidence that motivation exists

to combine Van Dok, Sinivaara, Chiu, McCarty, and Capps and that the asserted references teach the limitations of claims 36–40, which depend from cancelled claim 20. Pet. 67–74; Ex. 1003 ¶¶ 659–689. For example, Petitioner offers persuasive evidence that Van Dok, Sinivaara, Chiu, McCarty, and Capps teach the downloading and storing audio files (claim 37), generating sound from downloaded file while performing IM communication over the IM device including decoding and playback of an analog signal (claim 36 and 38), generating sound from streamed and downloaded sources while using an IM terminal (claims 39 and 40). Pet 67–74 (mapping each limitation of claims 36–40 to the asserted art).

Patent Owner provided no response contesting Petitioner’s arguments or evidence. Based on the Petitioner’s record, we find, by a preponderance of the evidence, that claims 36–40 are unpatentable over Van Dok, Sinivaara, Chiu, McCarty, and Capps.

G. Obviousness of Claims 22 and 23: Van Dok, Sinivaara, Chiu, McCarthy, Saric, Im

Petitioner asserts that claims 22 and 23, which depends from claims 20 and 21, are unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Chiu, McCarthy, Saric, Im. We determined in the *Google IPR* that Van Dok, Sinivaara, Chiu, McCarthy, and Saric rendered claim 21 obvious. *Google IPR* at 40–43.

In view of our prior determinations, *see id.*, Petitioner provides persuasive argument and evidence that Van Dok, Sinivaara, Chiu, McCarthy, and Saric in combination with Im teach the additional limitations of claims 22 and 23. Pet. 74–84; Ex. 1003 ¶¶ 690–735. For example, Petitioner provides that “Im and VD, the combination’s data entry device would have been configured to include a programmable key that is assigned

a character string (i.e., a set of characters) that corresponds to a graphical emoticon.” Pet. 80 (citing Ex. 1003 ¶ 715; Ex. 1044, 2–4; Ex. 1060 ¶¶ 56–63). Furthermore, Petitioner persuasively argued that it would be obvious to include an assigned programmable key that corresponds to a graphical emoticon. Pet. 82 (citing Ex. 1003 ¶ 727; Ex. 1044, 2–4; Ex. 1060 ¶ 56).

Patent Owner provided no response contesting Petitioner’s arguments or evidence. Based on the Petitioner’s record, we find, by a preponderance of the evidence, that claims 22 and 23 are unpatentable over Van Dok, Sinivaara, Chiu, McCarthy, Saric, and Im.

III. CONCLUSION⁵

For the reasons given, based on the arguments and evidence of record, Petitioner has met its burden to prove by a preponderance of the evidence that (1) claims 31–30 are unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II) or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), and Rucinski; (2) claims 34 and 35 are unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), and Canfield or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield, and Rucinski; (3) claims 36–40 are unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Chiu,

⁵ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

McCarthy, and Capps; and (4) claims 22 and 23 are unpatentable under 35 U.S.C. § 103(a) as obvious over Van Dok, Sinivaara, Chiu, McCarthy, Saric, and Im.

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claim(s) Shown Unpatentable	Claim(s) Not Shown Unpatentable
31–33	103(a)	Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II); or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Rucinski	31–33	
34, 35	103(a)	Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield; or Van Dok, Sinivaara, Chiu, McCarthy, (Sidekick I or Sidekick II), Canfield, Rucinski	34, 35	
36–40	103(a)	Van Dok, Sinivaara, Chiu, McCarthy, Capps	36–40	
22, 23	103(a)	Van Dok, Sinivaara, Chiu, McCarthy, Saric, Im	22, 23	
Overall Outcome			22, 23, 31–40	

IV. ORDER

Accordingly, it is:

ORDERED that claims 22, 23, and 31–40 of the '870 patent are unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2021-01126
Patent 7,292,870 B2

FOR PETITIONER:

W. Karl Renner
David Holt
Karan Jhurani
FISH & RICHARDSON P.C.
axf-ptab@fr.com
holt2@fr.com
jhurani@fr.com

FOR PATENT OWNER:

Stephen R. Risley
Cortney S. Alexander
KENT & RISLEY LLC
steverisley@kentrisley.com
cortneyalexander@kentrisley.com