

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,

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).

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, 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.

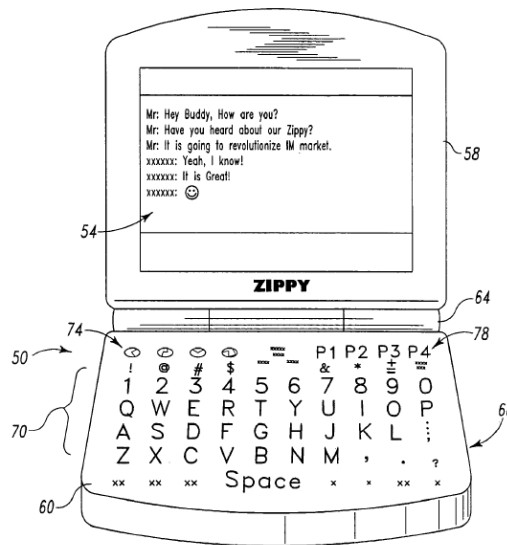


Fig. 2

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 11:10–15.

Figures 12a and 12b, provided below, show user interface screens that associate emoticon pictorial images with programmable keys. *Id.* at 9:27–28.

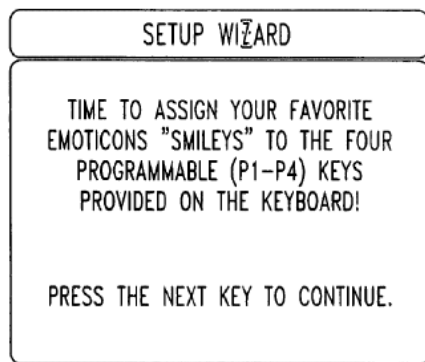


Fig. 12A

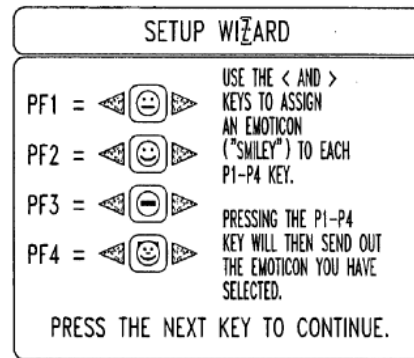


Fig. 12B

Figures 12a and 12b show screens used in the emoticon selection procedure. *Id.* at 9:27–28. Figure 12a identifies keys of keyboard 68 (not shown) that are associated with selected emoticons. 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 16:1–8.

The handheld terminal of the '837 patent manages multiple IM conversations over Internet Protocol (“IP”) through different IM service providers. *Id.* at 5:16–63, 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.* 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 4:56–62.

D. Illustrative Claim

Claim 1 reproduced below with bracketed lettering added is illustrative.

1. [pre] A handheld instant messaging terminal comprising:
 - [1a] handheld terminal housing;
 - [1b] a data entry device integrated in the terminal housing, the data entry device being configured to generate textual characters and graphical symbols in response to actuation of the data entry device;
 - [1c] a display mounted in the terminal housing to display textual characters and graphical symbols including the textual characters and graphical symbols generated by the data entry device;
 - [1d] an Internet protocol communications module located within the handheld terminal housing to generate data messages in an Internet protocol;
 - [1e] a wireless transceiver mounted within the handheld terminal housing and coupled to the Internet protocol communications module to generate wireless data messages that include the data messages in the Internet protocol, the wireless transceiver radiates the wireless data messages from an antenna coupled to the wireless transceiver, and
 - [1f] a control module located within the handheld terminal housing and coupled to the Internet protocol communications module, the control module including at least one processor that executes an application program to implement at least one instant messaging protocol for generation of instant messaging (IM) data messages that are compatible with at least one instant messaging service, [1g] the control module providing the generated IM data messages that are compatible with the at least one instant messaging service to the Internet protocol communications module to enable the IM data messages to be communicated during at least one conversation session through the Internet protocol communications module and the wireless transceiver, [1h] the control module being further configured to determine a character sequence corresponding to one of the graphical symbols in the generated IM messages that are compatible with the at least one instant messaging service.

Ex. 1043, 151 (1:21–59) (bracketed letters added); *see* Pet. x–xi.

E. Evidence and Instituted Grounds

Petitioner relies on the following references. Pet. 4.

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, 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
Capps	Capps, U.S. Patent No. 7,519,667 B1, filed Apr. 16, 2002, issued Apr. 14, 2009	1011
Werndorfer	Werndorfer et al., U.S. Patent App. Pub. No. 2004/0024822 A1, filed Aug. 1, 2002, published Feb. 5, 2004	1013

Petitioner also relies on the declarations of Patrick Traynor Ph.D. (Ex. 1003) and Duncan Hall (Ex. 1021).

We instituted the proceeding on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3, 4, 21, 22, 28, 33–38	103(a)	Heikes, Jonker, (Sidekick I or Sidekick II), Brittan
10, 43–45	103(a)	Heikes, Jonker, (Sidekick I or Sidekick II), Brittan, Capps
5–7, 17, 39	103(a)	Heikes, Jonker, (Sidekick I or Sidekick II), Brittan, Werndorfer

Dec. on Inst. 23; Pet. 3–4.

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

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

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).

B. Level of Ordinary Skill in the Art

Petitioner asserts the level of skill adopted in the Final Written Decision in IPR2019-01568, *Google ’837 IPR* at 8–9. *See* Pet 5 n.3;⁵ Ex. 1003 ¶¶ 37. Our prior decision in IPR2019-01568 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 ’837 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 IPR2019-01568 Final Written

⁵ We note that the Petition and Petitioner’s declarant cite erroneously to Exhibit 1042 here (*see, e.g.*, Ex. 1003 ¶ 66; Pet. 3 n.2, 5 n.3), we view references to Exhibit 1042 in this context as citations to *Google LLC et al. v. Zipit Wireless, Inc.*, IPR2019-01568, Paper 39 (PTAB Mar. 9, 2021) (Final Written Decision), which was not provided as part of Petitioner’s exhibits. *See* Pet. v (noting Exhibit 1042 is RESERVED).

Decision. Pet. 5. Petitioner also asserts 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 [at] prosecution history.” *Id.* at 5–6 (citing Ex. 1003 ¶¶ 73–74; 37 C.F.R. §42.100(b)).

We adopt the claim constructions determinations in IPR2019-01568 provided in the table below for the reasons discussed there.

Claim Term	IPR2019-01568 Construction
“generating textual characters and graphical symbols in response to manipulation of keys on a data entry device”	“graphical symbols” refers to “graphical emoticons;” phrase is given its “ordinary meaning in the context of the claims”
“a data entry device of a handheld terminal”	“a handheld terminal capable of data entry”

Google ’837 IPR at 9–12.

D. Obviousness of Claims 1, 5–10: Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), and Brittan

Petitioner asserts that claims 1, 3, 4, 21, 22, 28, 33–38 are unpatentable under 35 U.S.C. § 103(a) as obvious over Heikes, Jonker, Sidekick (Sidekick-I or Sidekick-II), and Brittan. Pet. 27–67. 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 Declaration in support of their contentions. Ex. 1003 ¶¶ 199–365. 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.

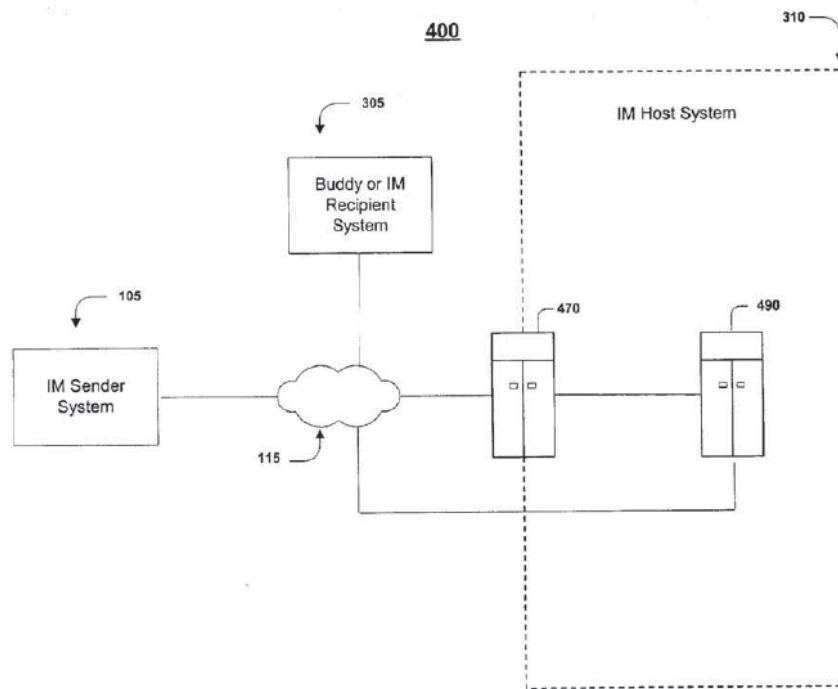


Fig. 4

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.

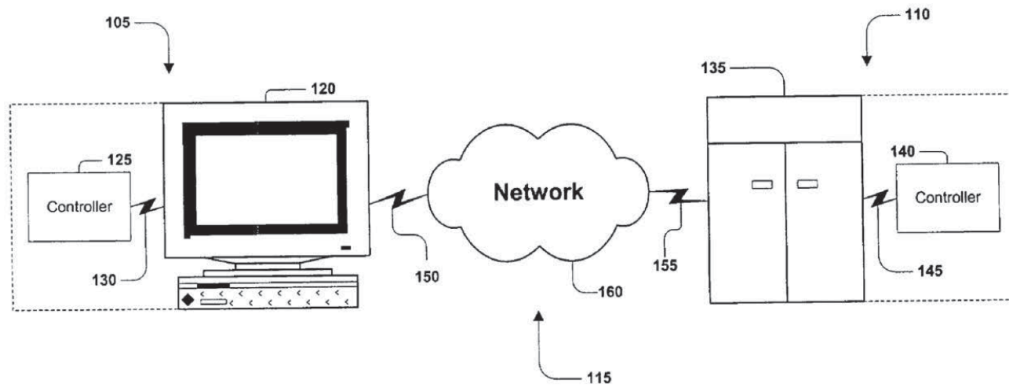


Fig. 1

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.

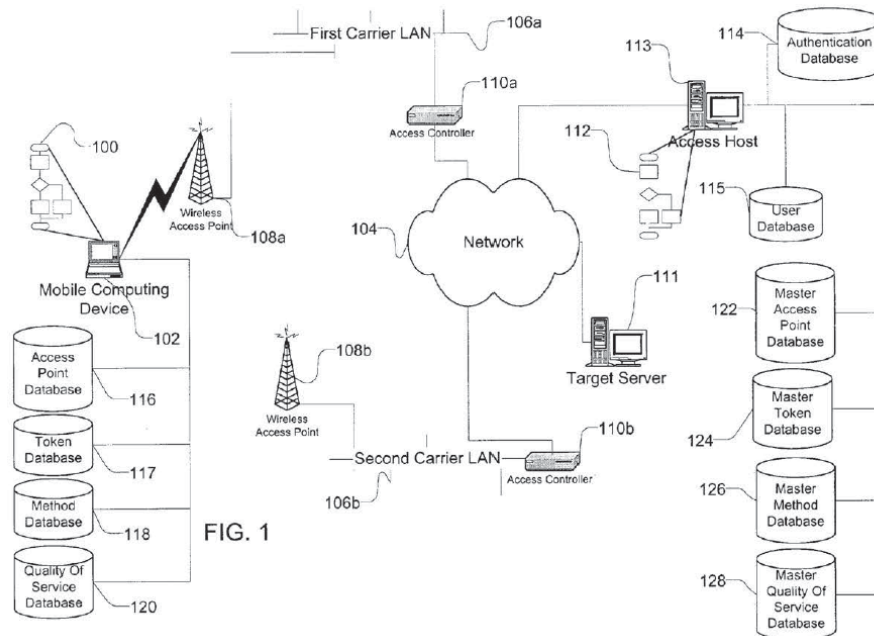


Figure 1 shows mobile device 102 that includes access client 100, which enables access to network 104 via carrier LAN network 106a/106b using Wireless Access Point (AP) 108a. *Id.* at 4:1–8, 26:32–35, Fig. 1. Access client 100 uses a network device “to transmit and receive carrier network signals.” *Id.* 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.* 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. 4. Petitioner relies primarily on Sidekick-I, but to the extent that Sidekick-I is challenged, Petitioner also relies independently on Sidekick-II. *Id.* at 4–5.

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*

For the motivation to combine Heikes, Jonker, Sidekick (Sidekick-I or Sidekick-II), and Brittan, Petitioner asserts 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. 16–20; Ex. 1003 ¶¶ 157–170; Ex. 1007 ¶¶ 2, 38, 45–47; Ex. 1005 ¶¶ 39–45, Fig. 1. Petitioner argues that both Heikes and Jonker teach wireless communication and that it was “well known and common knowledge for wireless LANs to operate and be implemented in: (1) ad-hoc mode or (2) an ‘infrastructure mode.’” Pet. 17–18; Ex. 1003 ¶¶ 161–162.

Petitioner further asserts 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 to navigate and perform data entry. Pet. 20–22; Ex. 1003 ¶¶ 171–181. Petitioner argues that “[b]ased 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. 24–25) as it was well known to use buttons or related menus to select emoticon smilies (*id.* at 25). Petitioner further contends 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. 26 (citing Ex. 1003 ¶¶ 195–196).

In view of the full unrebutted record, Petitioner provides persuasive rationales by a preponderance of the evidence to combine the teachings of Heikes, Jonker, Sidekick (Sidekick-I or Sidekick-II), and Brittan.

6. *Claim 1 Analysis*

Petitioner provides persuasive analysis and citation mapping the limitations of claim 1 to the combination of Heikes, Jonker, Sidekick (with parallel citations to Sidekick-I and Sidekick-II), and Brittan. Pet. 27–49; Ex. 1003 ¶¶ 199–284. Petitioner provides 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 IM capabilities” and a housing with integrated data entry and display as required in claim 1 (preamble and limitations [1a], [1b], and [1c]). Pet. 27–35; Ex. 1003 ¶¶ 200–224). Further, Petitioner shows that the Heikes-Jonker-Sidekick-Brittan’s device includes an Internet protocol (IP) communication module that performs the controller communications with the wireless transceiver as required in limitation [1d]. Pet. 32–41; Ex. 1003 ¶¶ 225–239. Petitioner’s evidence also supports that the Heikes-Jonker-Sidekick-Brittan’s device teaches wireless transceiver that transmits data messages over a network in accordance with requirements of limitation [1e]. Pet. 38–42; Ex. 1003 ¶¶ 240–254. Finally, Petitioner provides detailed evidence supporting that Heikes-Jonker-Sidekick-Brittan teaches the control module limitations of claim [1f], [1g], and [1h]. Pet. 42–49; Ex. 1003 ¶¶ 255–284. In particular, Petitioner asserts that Brittan teaches a controller that “detect[s] and interpret[s] key presses to output, from an associated memory, the appropriate character string’ corresponding to the selected smiley (i.e., determines the character sequence corresponding to one of the graphical

symbols) and display controller 131 then recognizes the character string and displays it using the corresponding graphic” in accordance with limitation [1h]. Pet. 48; Ex. 1003 ¶ 282; Ex. 1009, 12–13, Figs. 3, 4.

Based on the current record, we find no deficiency in Petitioner’s evidence and argument regarding the Heikes-Jonker-Sidekick-Brittan IM device combination and functions, knowledge in the art, or in Petitioner’s 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, we find persuasive Dr. Traynor’s testimony concerning the relevant teachings of the cited references and knowledge of an ordinarily skilled artisan. Accordingly, Petitioner has shown by a preponderance of the evidence that Heikes-Jonker-Sidekick-Brittan (based on either Sidekick-I or Sidekick-II) teach the limitations of claim 1.

7. Analysis of Claims 3, 4, 21, 22, 28, 33–38

Challenged claims 3, 4, 21, 22, 28, and 33–38 depend from claim 1. Ex. 1001, 24:9–18 (claims 3 and 4); Ex. 1043, 151–152 (claims 21, 22, 28, and 33–38). Petitioner provides persuasive evidence with citation to the teachings from the references and knowledge of ordinarily skilled artisans that the Heikes-Jonker-Sidekick-Brittan combination teaches the device limitations of claims 3, 4, 21, 22, 28, and 33–38. *See* Pet. 49–67; Ex. 1003 ¶¶ 285–365.

Claim 3 recites a control module configured to detect beacons from wireless access points and prioritize beacons by signal strength. Petitioner provides detailed citations that the Heikes-Jonker-Sidekick-Brittan combination teaches the limitations based on Jonker’s access client sniffer logic that obtains and sorts detected beacons based on signal strength. Pet. 50–52; Ex. 1008, 8:42–9:50, 12:30–50; Ex. 1003 ¶¶ 290–294.

With respect to the remaining challenged claims, Petitioner provides citations to the evidence and persuasive argument mapping the claim limitations to the challenged claims. Pet. 52–67; Ex 1003 ¶¶ 295–365. For example, Petitioner maps the stored profile containing network settings of claim 4 to Jonker’s stored account management data (Pet. 52; Ex. 1003 ¶¶ 295–296). For claim 21 and 22, Petitioner persuasively asserts that “Heikes discloses sending IM messages over a network, and further discloses a client controller that directs and commands network communications that are transmitted/received over the network by the wireless transceiver” and sending data over the network. Pet. 57–58 (citing *inter alia* Ex. 1007 ¶¶ 39–48, 60; Ex. 1003 ¶¶ 317–319). Similarly, Petitioner maps the limitations of control module for a first conversation session between the client device and a communication device of claim 28 to the Heikes IM host and conversation session. Pet. 58–59; Ex. 1003 ¶¶ 320–324. Finally, Petitioner persuasively demonstrates that the Heikes, Jonker, Sidekick (Sidekick-I or Sidekick-II), and Brittan teaches the visible display terminal limitations of claims 33–38. Pet. 59–67.

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”). On the record here, we find that Petitioner has shown by a preponderance of the

evidence that Heikes, Jonker, Sidekick (Sidekick-I or Sidekick-II), and Brittan teach the limitations of claims 3, 4, 21, 22, 28, and 33–38.

E. Obviousness of Claims 10, 43–45: Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, and Capps

Petitioner asserts that claims 10 and 43–45 are unpatentable under 35 U.S.C. § 103(a) as obvious over Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, and Capps. Pet. 68–76. 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 cites to the Traynor Declaration in support of their contentions. Ex. 1003 ¶¶ 368–417. The prior art is summarized below.

1. Capps (Ex. 1011)

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. Capps’ IM client application “notifies participating users that an audio stream” is available, allowing users to “use their instant messaging client application to select the audio stream,” streams the audio to the media player application for playback from the “streaming audio server.” *Id.* Capps discloses that the audio stream can be “an audio track currently being played by the media player application or a streaming audio radio station.” *Id.* at 4:63–66. Thus, Capps explains “two instant messaging users can simultaneously listen to the same audio track.” *Id.* at 2:60–65.

Petitioner provides persuasive evidence to support the motivation to combine the Heikes-Jonker-Sidekick-Brittan's IM client application with Capps to improve the ability of "remote users to converse in 'real-time' over a network and to 'transmit files' to each other—consistent with Heikes—those IM applications did not 'permit users to listen to music together in real-time' during communications." Pet. 68–69 (citing Ex. 1011 1:45–2:3, Ex. 1003 ¶ 374). Petitioner argues that it "would have been straightforward to modify and/or program Heikes-Jonker- Sidekick-Brittan's device to implement Capps' functionality" where the system "would perform in the combination as it is described in the individual references." Pet 69 (citing Ex. 1003 ¶ 379).

2. Analysis of Claims 10 and 43–45

Claims 10 and 43–45 depend from claim 1. Petitioner asserts persuasive evidence with citation to the teachings from the references and knowledge of ordinarily skilled artisans that Heikes-Jonker-Sidekick-Brittan-Capps device teach the audio limitations of claims 10 and 43–45. Pet. 70–76; Ex. 1003 ¶¶ 382–417. Specifically, Petitioner asserts it would be obvious to modify the IM client to stream audio, including downloading an audio file in accordance with the teachings of Capps. Pet 70–71; Ex. 1003 ¶¶ 380–391. In addition, Petitioner asserts that the Heikes device with Capp's functions teaches storing the downloaded audio stream in memory. Similarly, Petitioner provides citations to record and supporting testimony that the asserted combination teaches the decoding and converting of audio signals into analog to generate sound and that the audio device is integrated into the IM terminal. Pet. 71–76; Ex. 1003 ¶¶ 395–417.

On the record here, we find that Petitioner has shown by a preponderance of the evidence that Heikes, Jonker, Sidekick (Sidekick-I or

Sidekick-II), Brittan, and Capps teach the limitations of claims 10 and 43–45.

F. Obviousness of Claims 5–7, 17, and 39: Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, and Werndorfer

Petitioner asserts that claims 5–7, 17, and 39 are unpatentable under 35 U.S.C. § 103(a) as obvious over Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, and Werndorfer. Pet. 76–95. 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 provides citations to the Traynor Declaration in support of their contentions. Ex. 1003 ¶¶ 478–560. The prior art is summarized below.

1. Werndorfer (Ex. 1013)

Werndorfer discloses a “unified instant messaging client platform” designed to address the “lack of interoperability between the different instant messaging services” in conventional IM systems. Ex. 1013 ¶¶ 47, 48. Werndorfer explains that a “basic principle[]” of IM is that “proprietary instant messaging client software” is required “to communicate with the specified instant messaging service.” *Id.* ¶¶ 8–9. For example, AOL’s Instant Messenger (“AIM®”) software “allows the client computers . . . to communicate with the AIM server using AOL’s proprietary instant messaging protocol.” *Id.* “Moreover, the client IM software and associated IM protocols required by each service . . . are not compatible.” *Id.* ¶ 10.

Figure 2, below, depicts an instant messaging client architecture. *Id.* ¶ 18.

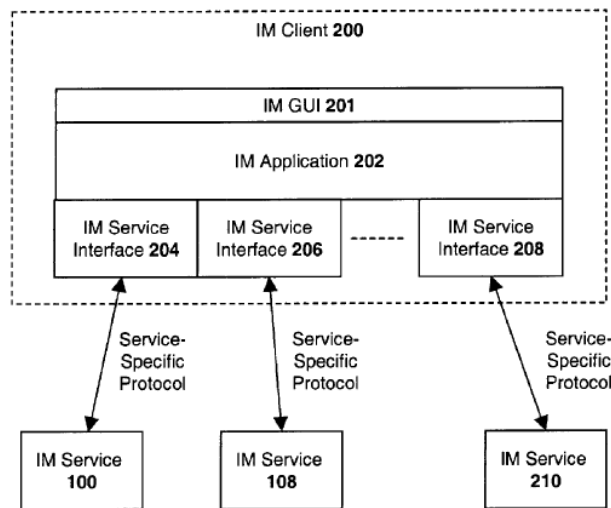


Fig. 2

Figure 2 shows IM client platform 200 comprised of IM application portion 202, which contains standard IM functions used by each IM service 100, 108, 210 (e.g., a buddy list, user-defined online/offline parameters, and other universal IM features described below). *Id.* ¶ 48. Users interact with the IM application 202 via IM graphical user interface 201. *Id.* Werndorfer teaches interoperability with the different, normally incompatible, IM services, using IM service interface module 204, 206, 208, which is provided for each IM service 100, 108, and 210, respectively. *Id.* The IM service interface modules 204, 206, 208 provide service-specific features and communicate with the respective IM services 100, 108, 210 using the IM protocol required by that service. *Id.*

Petitioner provides persuasive evidence to support the motivation to combine the Heikes-Jonker-Sidekick-Brittan’s IM client application with Werndorfer, as Heikes discloses that its “communication system may be used by users of [various IM service providers].” Ex. 1007 ¶ 50; Ex. 1003

¶¶ 487–488. Petitioner asserts that a POSITA would have been motivated to modify Heikes-Jonker-Sidekick-Brittan’s IM client application to make interoperable with different services as Wendorfer discloses. Pet. 79–81; Ex. 1003 ¶¶ 487–496.

2. Analysis of Claims 5–7, 17, and 39

Claims 5–7, 17, and 39 depend from claim 1. Petitioner provides persuasive evidence with citation to the teachings from the references and knowledge of ordinarily skilled artisans that Heikes-Jonker-Sidekick-Brittan-Wendorfer device teaches the IM service limitations of claims 5–7, 17, and 39. Pet. 81–95; Ex. 1003 ¶¶ 497–560; *see* Pet. 53–57 (addressing claim 11 from which claims 17 depends), Ex. 1003 ¶¶ 497–560 (same). Petitioner provides detailed citations to the record to support the accessing of multiple IM services and identify active buddies of the user and display their conversations as recited in claims 5–7 and the motivation to combine the asserted art. Pet. 79–92; Ex. 1003 ¶¶ 487–541. Petitioner provides similar analysis claims 17 and 39, offering persuasive argument and testimony that the Heikes-Jonker-Sidekick-Brittan-Wendorfer device teaches the method of generating buddy lists of active IMs and displaying the messages or the list in response to a key selection as recited in claims 17 and 39. Pet. 92–95; Ex. 1003 ¶¶ 544–560.

Patent Owner provided no response contesting Petitioner’s arguments or evidence. On the record here, we find that Petitioner has shown by a preponderance of the evidence that Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, and Wendorfer teaches the limitations of claims 5–7, 17, and 39.

III. CONCLUSION⁶

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 1, 3, 4, 21, 22, 28, and 33–38 are unpatentable under 35 U.S.C. § 103(a) as obvious over Heikes, Jonker, Sidekick (Sidekick-I or Sidekick-II), and Brittan; (2) claims 10 and 43–45 are unpatentable under 35 U.S.C. § 103(a) as obvious over Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, and Capps; and (3) claims 5–7, 17, and 39 are unpatentable under 35 U.S.C. § 103(a) as obvious over Heikes, Jonker, Sidekick (Sidekick I or Sidekick II), Brittan, and Werndorfer.

⁶ 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).

In summary:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claim(s) Shown Unpatentable	Claim(s) Not Shown Unpatentable
1, 3, 4, 21, 22, 28, 33–38	103(a)	Heikes, Jonker, (Sidekick I or Sidekick II), Brittan	1, 3, 4, 21, 22, 28, 33–38	
10, 43–45	103(a)	Heikes, Jonker, (Sidekick I or Sidekick II), Brittan, Capps	10, 43–45	
5–7, 17, 39	103(a)	Heikes, Jonker, (Sidekick I or Sidekick II), Brittan, Werndorfer	5–7, 17, 39	
Overall Outcome			1, 3–7, 10, 17, 21, 22, 28, 33– 39, 43–45	

IV. ORDER

Accordingly, it is:

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

IPR2021-01129
Patent 7,894,837 C1

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