

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESEARCH IN MOTION CORPORATION
Petitioner,

v.

WI-LAN USA INC.
Patent Owner.

Case IPR2013-00126 (JL)
Patent 6,240,088

Before JAMESON LEE, GLENN J. PERRY, and THOMAS L. GIANNETTI,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Research in Motion Corporation (“RIM”) filed a petition (Paper 1) requesting *inter partes* review of claims 19-21 of Patent 6,240,088 (Ex. 1001, “the ’088 patent”). A corrected petition (Paper 5) was also filed. In this decision, we refer to the corrected petition as the petition (“Pet.”). The patent owner, Wi-Lan USA Inc. (“WI-LAN”), filed a preliminary response (Paper 9, “Prel. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides as follows:

THRESHOLD -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.

Upon consideration of the petition¹ and WI-LAN’s preliminary response, we determine that the information presented in the petition establishes that there is a reasonable likelihood that RIM would prevail on at least one alleged ground of unpatentability with respect to claims 19-21 of the ’088 patent. Accordingly, pursuant to 35 U.S.C. § 314, we authorize an *inter partes* review to be instituted on claims 19-21. The petition for instituting *inter partes* review is **granted**.

¹ The petition does not rely on the testimony of any technical expert.

A. Related Proceedings

RIM indicates that the following litigation would affect or be affected by a decision in this proceeding: *Wi-Lan USA Inc. et al. v. Research In Motion Ltd., et al.*, Case No. 12-cv-20232 (S.D. Fla.).

B. The '088 Patent

The disclosed invention relates to sequential transmission of at least two portions of a data package. (Ex. 1001, 1:5-7.) In the background portion of its disclosure, the '088 patent describes that Narrow-band Personal Communications Systems (NPCS), or alternatively two-way paging, is an ideal platform for extending electronic mail to wireless devices such as pagers. (Ex. 1001, 1:10-13.) Specifically, an e-mail subscriber can designate, in his e-mail account, that e-mail communications be forwarded to the subscriber's two-way pager, and the e-mail subscriber, upon receiving the e-mail forwarded to his two-way pager, can send a response back to the sender. (Ex. 1001, 1:16-22.)

One of the problems encountered by the pre-existing interface between e-mail systems and two-way pagers is that the e-mail sender can transmit an excessively large message or other data to the two-way pager of the recipient. (Ex. 1001, 1:33-36.) The receipt of such excessively large amount of data can be costly to the recipient and can cause RF channel delays and unpredictable RF statistics. (Ex. 1001, 1:36-38.)

According to the specification of the '088 patent, a need exists for a method of transmission of large amounts of data to a wireless device, such as a pager, where no large amounts of data are transmitted in a single occurrence on the RF

channel. (Ex. 1001, 1:56-59.) Also according to the specification of the '088 patent, a need exists for the two-way pager user to control the number of data-packages sent, and therefore the cost, if the charge for the data transmission is on a data-amount basis. (Ex. 1001, 2:5-8). Further according to the specification of the '088 patent, a need exists for a user to determine, based on the data already sent and received, the importance of subsequent data which have not yet been sent. (Ex. 1001, 2:9-13.)

The subject matter of claim 19 of the '088 patent is directed to a method for wireless transmission of an alphanumeric message having at least a first portion, a second portion, and a third portion from an electronic communication transmitter to an electronic communication receiver. Claims 20 and 21 each depend on claim 19. Claim 19 is reproduced below:

19. A method for wireless transmission of an alphanumeric message having **at least a first portion, a second portion, and a third portion** from an electronic communication transmitter to an electronic communication receiver, the method comprising:

transmitting from the electronic communication transmitter to the electronic communication receiver the first portion of the alphanumeric message, the first portion being an initial portion of the alphanumeric message;

having the electronic communication receiver provide a user thereof with the first portion in a form comprehensible to the user;

having the electronic communication receiver provide the user thereof with a choice of whether to receive the second portion;

transmitting from the electronic communication receiver transmission instructions to the electronic communication transmitter in response to an affirmative selection by the user of the electronic communication receiver to **the choice of whether to have the second portion;**

transmitting from the electronic communication transmitter **the second portion in response to the transmission instructions** from the electronic communication receiver, the electronic communication receiver providing the user thereof with the second portion in a form comprehensible to the user;

having the electronic communication receiver provide the user thereof with a choice of whether to receive the third portion;

transmitting from the electronic communication receiver transmission instructions to the electronic communication transmitter in response to an affirmative selection by the user of the electronic communication receiver to **the choice of whether to have the third portion;** and

transmitting from the electronic communication transmitter **the third portion in response to the transmission instructions** from the electronic communication receiver, the electronic communication receiver providing the user thereof with the third portion in a form comprehensible to the user.

(Emphasis added.)

Thus, data transmission is divided into three sequential stages, through which the user recipient is provided successive opportunities to choose whether or not to receive a subsequent portion of the data not yet transmitted.

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