

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

DSS TECHNOLOGY MANAGEMENT, INC.,
Patent Owner.

Case IPR2015-00373
Patent 6,128,290

Before JAMESON LEE, MATTHEW R. CLEMENTS, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Petitioner Apple Inc. (“Apple”) filed a Petition (Paper 2, “Pet.”) to institute *inter partes* review of claims 6, 7, 9, and 10 of U.S. Patent No. 6,128,290 to Carvey (Ex. 1001, “the ’290 patent”). Patent Owner DSS Technology Management, Inc. (“DSS”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). On June 25, 2015, we instituted an *inter partes* review of claims 6, 7, 9, and 10 on two of three grounds of unpatentability presented in the Petition (Paper 8, “Dec.”).

After institution of trial, DSS filed a Patent Owner Response (Paper 15, “PO Resp.”). DSS also filed a Notice of Filing of Statutory Disclaimer, notifying us of a statutory disclaimer of claims 6 and 7 of the ’290 patent, pursuant to 37 C.F.R. § 1.321(a), that DSS had filed on October 5, 2015 (Paper 18). Subsequently, Apple filed a Reply to DSS’s Patent Owner Response (Paper 23, “Reply”). An oral hearing was held on March 15, 2016, and a transcript of the hearing is included in the record (Paper 38, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Based on the record before us, and for the reasons that follow, we determine that Apple has demonstrated, by a preponderance of the evidence, that each of claims 9 and 10 of the ’290 patent is unpatentable. Further, because we treat DSS’s statutory disclaimer of claims 6 and 7 as a request for adverse judgment as those claims (*see* 37 C.F.R. § 42.73(b); Paper 20), we additionally enter judgment against DSS with respect to claims 6 and 7 of the ’290 patent.

B. Related Matters

The '290 patent has been the subject of two district court actions: *DSS Technology Management, Inc. v. Apple, Inc.*, No. 5:14-cv-05330-LHK (N.D. Cal.), and *DSS Technology Management, Inc. v. Lenovo (United States), Inc.*, No. 6:14-cv-00525-JDL (E.D. Tex.). Pet. 2; Paper 5, 2. IPR2015-00369 also involves claims of the '290 patent and was argued together with this proceeding at the March 15, 2016, oral argument.

C. The Instituted Grounds

We instituted a trial as to claims 6, 7, 9, and 10 of the '290 patent under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,241,542 to Natarajan et al. (Ex. 1003, "Natarajan") and U.S. Patent No. 4,887,266 to Neve et al. (Ex. 1004, "Neve"); and also as to claims 6 and 7 under § 103 over U.S. Patent No. 5,696,903 to Mahany. Dec. 11–21. As noted in Section I.A., *supra*, DSS subsequently disclaimed claims 6 and 7, leaving only claims 9 and 10 in trial on the single ground based on Natarajan and Neve.

II. ANALYSIS

A. The '290 Patent

The '290 patent, titled "Personal Data Network," issued October 3, 2000, from U.S. Patent Application No. 08/949,999 (Ex. 1005, 22–62, "the '999 application"). The '999 application was filed October 14, 1997, as a continuation-in-part of U.S. Patent Application No. 08/611,695 (Ex. 1006, 21–61, "the '695 application"), filed March 6, 1996, which matured into

U.S. Patent No. 5,699,357 (Ex. 2001, “the ’357 patent”). *See* Ex. 1001, 1:6–8.

The ’290 patent relates to a data network for bidirectional wireless data communications between a host or server microcomputer unit and a plurality of peripheral units referred to as personal electronic accessories (PEAs). Ex. 1001, 1:11–14, 2:15–18. Among the objects of the invention is the provision of a data network that requires extremely low power consumption, “particularly for the peripheral units,” avoids interference from nearby similar systems, and is relatively simple and inexpensive to construct. *Id.* at 1:33–34, 1:39–45. Figure 1 of the ’290 patent, reproduced below, is illustrative of the described wireless data network system.

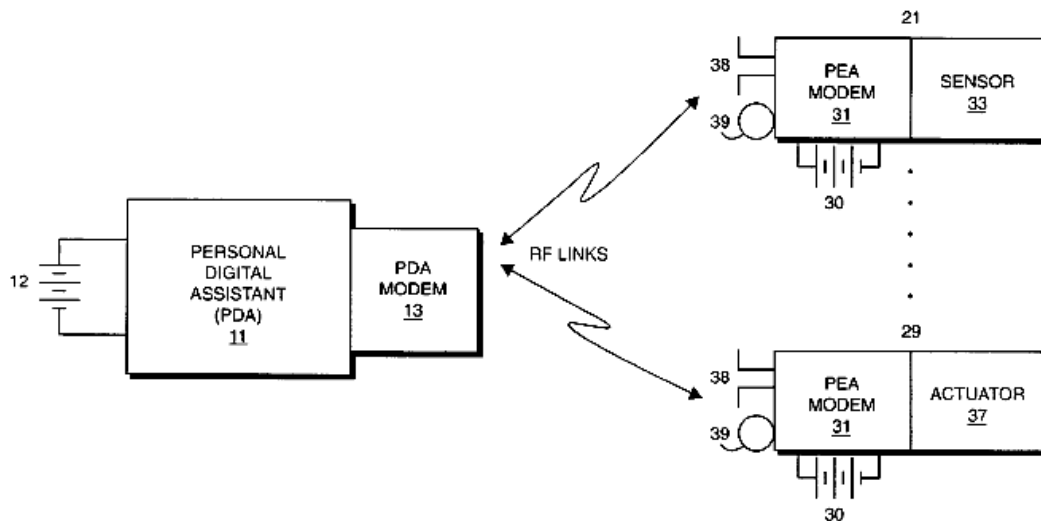


FIG. 1

Figure 1 is a block diagram of a wireless data network system linking a server microcomputer, referred to as personal digital assistant (PDA) 11, with a plurality of peripheral units, or PEAs, 21–29. *Id.* at 2:42–44, 2:66–3:15.

According to the '290 patent, “the server microcomputer unit and the several peripheral units which are to be linked are all in close physical proximity, e.g., within twenty meters, to establish, with very high accuracy, a common time base or synchronization.” *Id.* at 1:50–54. “Using the common time base, code sequences are generated which control the operation of the several transmitters in a low duty cycle pulsed mode of operation.” *Id.* at 1:57–59. “The server and peripheral unit transmitters are energized in low duty cycle pulses at intervals which are determined by a code sequence which is timed in relation to the synchronizing information initially transmitted from the server microcomputer.” *Id.* at 2:35–39. “The low duty cycle pulsed operation both substantially reduces power consumption and facilitates the rejection of interfering signals.” *Id.* at 1:59–61. “In the intervals between slots in which a PEA is to transmit or receive, all receive and transmit circuits are powered down.” *Id.* at 4:6–8.

B. Illustrative Claim

Independent claim 9 is reproduced below. Claim 10 depends directly from claim 9.

9. A data network system for effecting coordinated operation of a plurality of electronic devices, said system comprising:

a server microcomputer unit, said server unit including an oscillator for establishing a time base;

a plurality of peripheral units which provide either input information from the user or output information to the user, and which are adapted to operate within about 20 meters of said server unit;

said server microcomputer incorporating an RF transmitter controlled by said oscillator for sending commands and synchronizing information to said peripheral units, said synchronizing information

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