

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS CO. LTD.,
SAMSUNG ELECTRONICS AMERICA, INC., and APPLE INC.,
Petitioner,

v.

ROSETTA-WIRELESS CORPORATION,
Patent Owner.

Case IPR2016-00622¹
Patent 7,149,511 B1

Before JUSTIN T. ARBES, PATRICK R. SCANLON, and
JOHN A. HUDALLA, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* HUDALLA.

Opinion Dissenting filed by *Administrative Patent Judge* ARBES.

HUDALLA, *Administrative Patent Judge*.

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

In Case IPR2016-00622 (“622 IPR”), Samsung Electronics Co., Ltd.,
Samsung Electronics America, Inc., and Apple Inc. (collectively

¹ Case IPR2016-00616 has been consolidated with this proceeding.

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“Petitioner”), filed a Petition (Paper 4², “622 Petition” or “622 Pet.”) requesting an *inter partes* review of claims 1–10, 19–22, 58–65, and 68–71 of U.S. Patent No. 7,149,511 B1 (Ex. 1001, “the ’511 patent”) pursuant to 35 U.S.C. §§ 311–319. Patent Owner, Rosetta-Wireless Corporation (“Patent Owner”), filed a Preliminary Response to the 622 Petition. Paper 8 (“622 Preliminary Response” or “622 Prelim. Resp.”). Taking into account the arguments presented in Patent Owner’s 622 Preliminary Response, we determined that the information presented in the 622 Petition established that there was a reasonable likelihood that Petitioner would prevail in challenging claims 1–10, 19–22, 58–65, and 68–71 of the ’511 patent under 35 U.S.C. § 103(a). Pursuant to 35 U.S.C. § 314, we instituted this proceeding on August 22, 2016, as to these claims of the ’511 patent. Paper 12 (“622 Institution Decision” or “622 Dec. on Inst.”).

In related Case IPR2016-00616 (“616 IPR”), Petitioner filed a second Petition (616 IPR, Paper 1, “616 Petition” or “616 Pet.”) requesting an *inter partes* review of claims 1–10 and 58–65 of the ’511 patent. Patent Owner filed a Preliminary Response to the 616 Petition. 616 IPR, Paper 7 (“616 Preliminary Response” or “616 Prelim. Resp.”). Taking into account the arguments presented in Patent Owner’s 616 Preliminary Response, we also determined that the information presented in the 616 Petition established that there was a reasonable likelihood that Petitioner would prevail in challenging claims 1–10 and 58–65 of the ’511 patent under 35 U.S.C. § 103(a). Pursuant to 35 U.S.C. § 314, we instituted an *inter partes* review proceeding on August 22, 2016, as to these claims of the

² Unless otherwise indicated, citations to papers and exhibits are made to Case IPR2016-00622.

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'511 patent. Paper 15³ (“616 Institution Decision” or “616 Dec. on Inst.”). In the 616 Institution Decision, we ordered the consolidation of the 616 IPR with the 622 IPR for purposes of trial. *Id.* at 30–31.

During the course of trial, Patent Owner filed a Patent Owner Response (Paper 28, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner Response (Paper 37, “Pet. Reply”). An oral hearing was held on February 14, 2017, and a transcript of the hearing is included in the record. Paper 46 (“Tr.”).

Petitioner proffered a Declaration of Erez Zadok, Ph.D. (Ex. 1004) with the 622 Petition and a Declaration of Nathaniel Polish, Ph.D. (Ex. 1058) with the 616 Petition. Petitioner also proffered a Declaration of Dr. Zadok (Ex. 1064) with its Reply. Patent Owner proffered Declarations of William H. Mangione-Smith, Ph.D. with its Preliminary Responses (Exs. 2001, 2016) and with its Response (Ex. 2022).

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claims 1–10, 19–22, 58–65, and 68–71 of the '511 patent. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that these claims are unpatentable under 35 U.S.C. § 103(a).

I. BACKGROUND

A. *Related Proceedings*

Both parties identify the following proceedings related to the '511 patent (616 Pet. 1–2; 622 Pet. 6–7; Paper 7, 2):

³ The 616 Institution Decision is included in the 622 IPR as Paper 15 because it includes a consolidation order.

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Rosetta-Wireless Corp. v. Apple Inc., No. 1:15-cv-00799 (N.D. Ill., filed Jan. 27, 2015);

Rosetta-Wireless Corp. v. High Tech Computer Corp., No. 1:15-cv-10603 (N.D. Ill., filed Nov. 24, 2015);

Rosetta-Wireless Corp. v. Samsung Elecs. Co., Ltd., No. 1:15-cv-10605 (N.D. Ill., filed Nov. 24, 2015);

Rosetta-Wireless Corp. v. LG Electronics Co., No. 1:15-cv-10608 (N.D. Ill., filed Nov. 24, 2015); and

Rosetta-Wireless Corp. v. Motorola Mobility LLC, No. 1:15-cv-10611 (N.D. Ill., filed Nov. 24, 2015).

B. The '511 patent

The '511 patent is directed to “a wireless intelligent personal server that receives data transmitted over a wireless communications channel and automatically processes it so as to maintain a copy of at least one electronic file stored in a source computer.” Ex. 1001, 1:8–12. Figure 1 of the '511 patent is reproduced below.

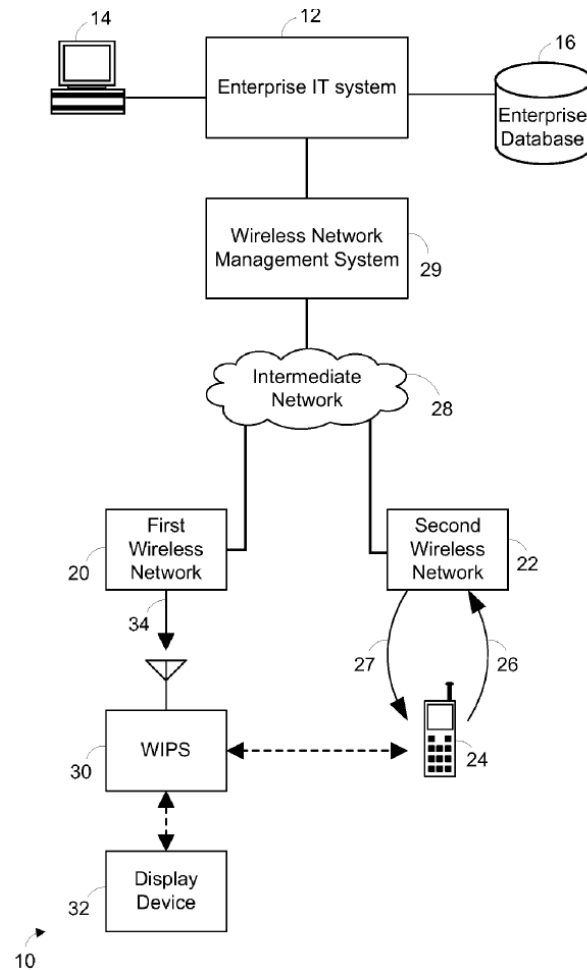


Figure 1 depicts wireless communication system 10 having enterprise information technology (IT) system 12 connected to one or more personal computers 14 and centralized enterprise database 16. *Id.* at 3:62–4:6. Enterprise IT system 12 uses wireless network management system 29 to communicate with first wireless network 20 and second wireless network 22 via intermediate network 28, which may be a wide-area network (WAN) or a local-area network (LAN). *Id.* at 4:34–41.

Wireless intelligent personal server (WIPS) 30 receives and stores data wirelessly transmitted over downstream channel 34 by first wireless network 20. *Id.* at 4:44–46, 5:35–36. WIPS 30 can use the received data to either update one or more of the files stored in its memory or to add a new

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