

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC. and WAHOO FITNESS LLC.,
Petitioner,

v.

BLACKBIRD TECH, LLC d/b/a BLACKBIRD TECHNOLOGIES, LLC
Patent Owner.

Case IPR2017-02012¹
Patent 6,434,212 B2

Before DEBRA K. STEPHENS, THOMAS L. GIANNETTI, and
CHRISTA P. ZADO, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

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

¹ IPR2018-00275 has been joined to this proceeding.

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6(c), and this Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that FitBit, Inc. and Wahoo Fitness LLC. (collectively, “Petitioner”) has not shown by a preponderance of the evidence that claims 2, 5, and 6 of U.S. Patent No. 6,434,212 (Ex. 1001, “the ’212 Patent”) are unpatentable.

A. Procedural History

Petitioner filed a Petition requesting an *inter partes* review of claims 2, 5, and 6 of U.S. Patent No. 6,434,212 B2 (Paper 1 (“Pet.”)). Petitioner relied on the following references in asserting its grounds:

References	Patent Number	Exhibit
Amano, et al., (hereinafter, “Amano”)	US 6,241,684 B1	1003
Kato et al. (hereinafter, “Kato”)	US 5,033,013	1004

Petitioner also relies on the Declaration of Dr. Tanzeem Choudhury (Ex. 1005). Blackbird Tech LLC (“Patent Owner”) filed a Preliminary Response (Paper 7 (“Prelim. Resp.”)). Pursuant to 35 U.S.C. § 314(a), we instituted an *inter partes* review (“Dec.”) of claims 2 and 5 as unpatentable under 35 U.S.C. § 103(a)² over Amano; and claim 6 as unpatentable under 35 U.S.C. § 103(a) over Kato and Amano.

² The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 100 et seq. effective on March 16, 2013. The ’212 Patent issued

On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition (*SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018)). Subsequent to the holding in *SAS* we modified our institution decision to institute on all challenged claims and all grounds presented in the Petition (Paper 11). Specifically, we modified our institution decision to include review of

Claims 2 and 5 as anticipated under 35 U.S.C. § 102³ by Amano;

Claims 2 and 5 as unpatentable under 35 U.S.C. § 103(a) over Amano; and

Claim 6 as unpatentable under 35 U.S.C. § 103(a) over Kato and Amano

(*id.*).

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 16, “PO Resp.”), to which Petitioner filed a Reply (Paper 20, “Reply”). Pursuant to guidance provided in the Patent Trial and Appeal Board issued guidance for requesting sur-replies in an updated Trial Practice Guide (PTAB Trial Practice Guide Update (August 2018)). Patent Owner requested authorization to file a sur-reply (Exhibit 3001). We authorized

from an application filed before March 16, 2013; therefore, we apply the pre-AIA versions of the statutory bases for unpatentability.

³ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. § 100 et seq. effective on March 16, 2013. The ’212 Patent issued from an application filed before March 16, 2013; therefore, we apply the pre-AIA versions of the statutory bases for unpatentability.

Patent Owner to file a sur-reply (*id.*; Paper 25), and Patent Owner thus filed a Sur-Reply (Paper 24).

At the parties' request (Papers 22, 23), an Oral Hearing was held on December 11, 2018, a transcript of which is included in the record (Paper 27, "Tr.").

II. BACKGROUND

A. *Related Matters*

The parties advise us that the '212 Patent is at issue in the following:
Blackbird Tech LLC d/b/a Blackbird Technologies v. Sony Corp. et al., Case No. 16-CV-685 (D. Del.),

Blackbird Tech LLC d/b/a Blackbird Technologies v. Timex Group USA, Inc., Case No. 16-CV-686 (D. Del.),

Blackbird Tech LLC d/b/a Blackbird Technologies v. TomTom, Inc., Case No. 16-CV-687 (D. Del.),

Blackbird Tech LLC d/b/a Blackbird Technologies v. Wahoo Fitness, Inc., Case No. 16-CV-688 (D. Del.)

Blackbird Tech LLC d/b/a Blackbird Technologies v. Garmin International, Inc. and Garmin USA, Inc., Case No. 16-CV-689 (D. Del.),

Blackbird Tech LLC d/b/a Blackbird Technologies v. Fitbit, Inc., Case No. 16-CV-683 (D. Del.), and

Blackbird Tech LLC d/b/a Blackbird Technologies v. Aliphcom d/b/a Jawbone, Case No. 16-CV-684 (D. Del.)

(Pet. 4–5; Paper 4, 2).

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Additionally, the '212 Patent was at issue in IPR2017-01058 (*Garmin International, Inc. v. Blackbird Tech LLC d/b/a Blackbird Technologies*), now terminated and IPR2017-02025 (*TomTom, Inc. v. Blackbird Tech LLC d/b/a Blackbird Technologies*), not instituted; and remains at issue in IPR2017-02023 (*TomTom International, B.V. v. Blackbird Tech LLC d/b/a Blackbird Technologies*).

B. The '212 Patent

The '212 Patent, entitled “Pedometer,” relates to a “pedometer having improved accuracy by calculating actual stride lengths of a user based on relative stride rates” ('212 Patent, Abstract). More particularly, the patent relates to “pedometers having a waist mounted stride-counting device and transmitter, and a wrist-mounted receiver and display” (*id.* at 1:9–11). The device calculates a distance walked or run based on converting a base stride length and a base stride rate to an actual stride length and using that to calculate distance traveled (*id.* at 1:12–16).

Specifically, a step counter which is an inertia device, counts the number of steps a user takes (*id.* at 3:7–8). A data processor includes a data archive that stores historic data on stride length and pace and closed loop or fuzzy logic programming that continually or periodically replaces the base stride rate and length with recently calculated stride rates and lengths (*id.* at 3:39–47).

The pedometer of the '212 Patent may optionally require the user to operate a “sampling mode” (*id.* at 3:56–57). In this mode, a user walks or runs a predetermined distance with the distance then divided by the number

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