

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

Case IPR2018-00821
Patent 8,213,970 B2

Before TREVOR M. JEFFERSON, CHRISTA P. ZADO, and
KEVIN C. TROCK, *Administrative Patent Judges*.

ZADO, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Apple, Inc. (“Petitioner”) filed a request for *inter partes* review of claims 1–13 (the “challenged claims”) of U.S. Patent No. 8,213,970 B2 (Ex. 1001, “the ’970 patent”). Paper 1 (“Pet.”). AGIS Software Development, LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Petitioner filed a Reply to the Preliminary Response. Paper 8.

Under 35 U.S.C. § 314, an *inter partes* review must not be instituted “unless . . . the information presented in the petition . . . 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.” 35 U.S.C. § 314(a). Upon considering the evidence presented and the arguments made, we determine Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing the unpatentability of at least one of the challenged claims. Accordingly, we do not institute an *inter partes* review.

A. *Related Proceedings*

Petitioner advises that the ’970 patent is asserted against Petitioner in *AGIS Software Development LLC v. Apple Inc.*, No. 2:17-cv-00516-JRG (E.D. Tex.). Pet. 2. Petitioner also advises the ’970 patent is asserted against third parties in four other cases: *AGIS Software Development LLC v. Huawei Device USA Inc. et al.*, No. 2:17-cv-00513 (E.D. Tex.); *AGIS Software Development LLC v. LG Electronics, Inc.*, No. 2:17-cv-00515 (E.D. Tex.); *AGIS Software Development LLC v. ZTE Corporation et al.*, No. 2:17-cv-00517 (E.D. Tex.); *AGIS Software Development LLC v. HTC Corporation*, No. 2:17-cv-00514 (E.D. Tex.). *Id.* Petitioner further advises that it is filing petitions for *inter partes* review challenging U.S. Patent Nos.

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9,408,055, 9,455,251, and 9,467,838, which are asserted in the above district court cases. *Id.*¹

Patent Owner acknowledges the same proceedings. Paper 5, 2–3.

B. The '970 Patent

The '970 patent generally discloses a specialized software application program on a personal computer (“PC”) or PDA/cell phone for creating and processing forced message alerts. Ex. 1001, Abstract. The specification of the '970 patent (“Specification”) discloses it is desirable for a PDA/cell phone user to be able to simultaneously send Digital Smart Message Service (“SMS”) or TCP/IP messages to a large group of PCs or cell phones using cellular technology (such as GSM or CDMA) or WiFi. *Id.* at 1:51–57. The Specification further discloses that in some situations it is additionally desirable to know which PCs and PDA/cell phones received the message, which PCs and PDA/cell phones did not receive the message, and the response of each recipient of the message. *Id.* at 1:57–61. “As a result, what is needed is a method in which a sender of a text or voice message can force automatic acknowledgement upon receipt from a recipient’s cell phone or PC and a manual response from the recipient via the recipient’s cell phone or PC.” *Id.* at 1:65–67. In addressing these issues, the Specification discloses “[t]he heart of the invention lies in [a] forced message alert software application program provided in each PC or PDA/cell phone.” *Id.* at 4:47–49. The software provides the ability to

¹ The petitions for *inter partes* review are in cases IPR2018-00817, IPR2018-00818, and IPR2018-00819.

(a) allow an operator to create and transmit a forced message alert from a sender PDA/cell phone to one or more recipient PCs and PDA/cell phones within the communication network; (b) automatically transmit an acknowledgement of receipt to the sender PDA cell phone upon the receipt of the forced message alert; (c) periodically resend the message to the recipient PCs and PDA/cell phones that have not sent an acknowledgement; (d) provide an indication of which recipient PCs and PDA/cell phones have acknowledged the forced message alert; (e) provide a manual response list on the display of the recipient PC and PDA/cell phone's display that can only be cleared by manually transmitting a response; and (f) provide an indication on the sender PDA/ cell phone of the status and content the manual responses.

Id., Abstract. The Specification explains that a forced message alert is comprised of a text or voice message and a forced message alert software packet. *Id.* at 2:11–13, 8:23–25.

C. Challenged Claims

Petitioner challenges claims 1–13 of the '970 patent. Claims 1, 6, and 11 are independent. Claim 6 is illustrative.

6. A method of sending a forced message alert to one or more recipient PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PDA/cell phone is tracked, said method comprising the steps of:

[a] accessing a forced message alert software application program on a sender PDA/cell phone;

[b] creating the forced message alert on said sender PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message;

[c] designating one or more recipient PDA/cell phones in the communication network;

[d] electronically transmitting the forced message alert to said recipient PDA/cell phones;

[f] receiving automatic acknowledgements from the recipient PDA/cell phones that received the message and displaying a listing of which recipient PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PDA/cell phones have not acknowledged receipt of the forced message alert;

[g] periodically resending the forced message alert to the recipient PDA/cell phones that have not acknowledged receipt;

[h] receiving responses to the forced message alert from the recipient PDA/cell phones and displaying the response from each recipient PDA/cell phone;
and

[i] providing a manual response list on the display of the recipient PDA/cell phone that can only be cleared by the recipient providing a required response from the list;

[j] clearing the recipient's display screen or causing the repeating voice alert to cease upon recipient selecting a response from the response list required that can only be cleared by manually selecting and transmitting a response to the manual response list.

Ex. 1001, 10:7–41 (brackets and lettering added).

D. Priority of the '970 Patent

The '970 patent was filed November 26, 2008, and claims priority through a chain of continuation-in-part applications to an application filed on September 21, 2004 (“earliest filing date”). Ex. 1001, [22], [63].

However, Petitioner asserts the earliest filing date to which the '970 patent

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