

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HTC CORPORATION, HTC AMERICA, INC., AND ZTE (USA), INC.,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

Case IPR2019-00485
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

HTC Corporation, HTC America, Inc., and ZTE (USA), INC. (collectively, “Petitioner”)¹ filed a request for *inter partes* review of claims 1 and 3–9 (the “challenged claims”) of U.S. Patent No. 8,213,970 B2 (Ex. 1001, “the ’970 patent”). Paper 3 (“Pet.” or “Petition”). Concurrent with the filing of the Petition, Petitioner filed a Motion for Joinder to *Inter Partes* Review (35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b)), seeking to join IPR2018-01079 instituted on November 20, 2018 (“the ’1079 IPR”). Paper 4 (“Mot.” or “Motion”). AGIS Software Development, LLC (“Patent Owner”)² filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

Under 35 U.S.C. § 315(a)(1), “[a]n *inter partes* review may not be instituted if, before that date on which the petition for such a review is filed, the petitioner or real party in interest filed a civil action challenging the validity of a claim of the patent.” 35 U.S.C. § 315(a)(1). Upon considering the evidence presented and the arguments made, we determine that *inter partes* review is barred under 35 U.S.C. § 315(a)(1). Accordingly, we do not institute an *inter partes* review.

A. *Related Proceedings*

The parties advise that the ’970 patent has been asserted in various district court proceedings, including, in pertinent part, *ZTE (USA), Inc. v. AGIS Software Development LLC et al.*, No. 4:18-cv-06185 (N.D. Cal.) (filed October 9, 2018). Pet. 79–81; Paper 6, 3. Patent Owner further

¹ The Petition identifies as real parties-in-interest HTC Corporation, HTC America, Inc., ZTE (USA), Inc., and ZTE (TX) Inc. Pet. 79.

² Patent Owner identifies itself, pursuant to 37 C.F.R. § 42.8(b)(2), as the real party-in-interest. Paper 6, 1.

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advises that the '970 patent and patents related to the '970 patent are the subject of various filings requesting *inter partes* review. Paper 6, 2–3 (*see* table identifying *inter partes* review case numbers).

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 an 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 1:62–67. 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

- (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 and 3–9 of the '970 patent. Claims 1 and 6 are independent. Claim 1 is illustrative (brackets and numbering added).

1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

[1.1] a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display and a CPU memory;

[1.2] a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;

[1.3] a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;

[1.4] a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;

[1.5] means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;

[1.6] means for requiring a required manual response from the response list by the recipient in order to clear the recipient's response list from recipient's cell phone display;

[1.7] means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;

[1.8] means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and

[1.9] means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the responses from each recipient PDA/cell phone that responded.

Ex. 1001, 8:65-9:39.

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