

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SEVEN NETWORKS, LLC,
Patent Owner.

IPR2020-00281
Patent 10,027,619 B2

Before THU A. DANG, KARL D. EASTHOM, and JONI Y. CHANG,
Administrative Patent Judges.

CHANG, *Administrative Patent Judge.*

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

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review (“IPR”) of claims 22–28, 32, 33, 36–42, 46, and 50–52 (“the challenged claims”) of U.S. Patent No. 10,027,619 B2 (Ex. 1001, “the ’619 patent”). Paper 3 (“Pet.”), 1. Petitioner also filed a parallel Petition (“the ’280 IPR Petition”), challenging the same claims of the same patent. IPR2020-00280, Paper 2. In each IPR proceeding, Petitioner filed a Notice ranking the Petitions in the order that Petitioner wishes the Board to consider the merits—namely, ranking the ’280 IPR Petition first and the instant Petition second. Paper 2 (“Notice”). Seven Networks, LLC, (“Patent Owner”) filed a Preliminary Response, arguing that the instant Petition should be denied as an improper parallel petition. Paper 8 (“Prelim. Resp.”), 1–7. For the reasons stated below, we exercise our discretion under § 314(a) and deny institution of *inter partes* review in the instant proceeding.

A. Related Matter

The parties indicate that the ’619 patent is involved in *Seven Networks, LLC v. Apple Inc.*, Case No. 2:19-cv-115 (E.D. Tex.). Pet. 75; Paper 5, 1.

B. The ’619 Patent

The ’619 patent discloses methods and systems for transmitting electronic mail (e-mail) messages to or from a mobile terminal. Ex. 1001, code(57), 1:20–22. Figure 1 of the ’619 patent is reproduced below.

Fig. 1

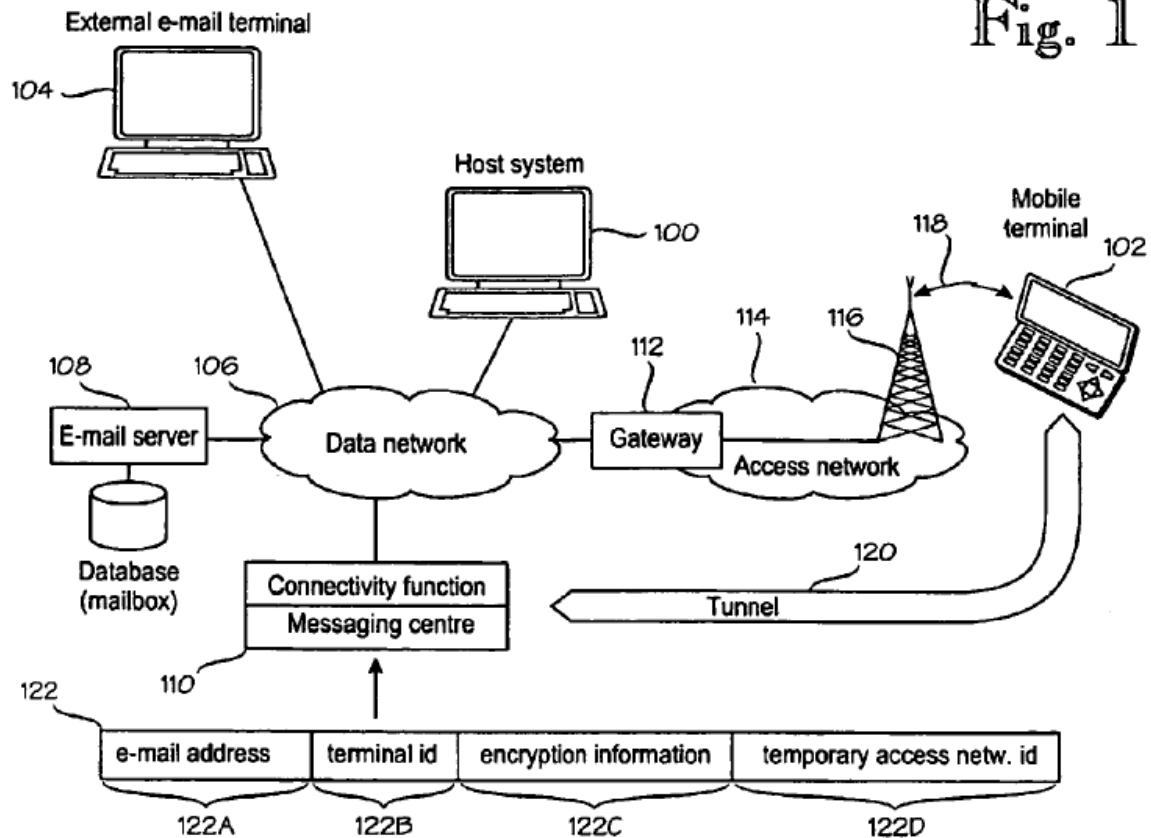


Figure 1 above shows an exemplary system architecture. *Id.* at 3:9–10. The '619 patent “aims at improving cooperation between the host system 100 and mobile terminal 102 such that they can use a single e-mail account.” *Id.* at 3:15–18. The '619 patent also describes a secure e-mail provisioning technique in which host system 100 authenticates the use of mobile terminal 102 by receiving a service activation code and conveying the code to message center 110. *Id.* at 4:56–5:37. Mobile terminal 102 generates and displays a service activation code and host system 100 authenticates the user who enters the code. *Id.*

C. Illustrative Claim

Of the challenged claims, claims 22, 37, and 51 are independent. Claims 23–28, 32, 33, and 36 depend from claim 22; claims 38–42, 46, and 50 depend from claim 37; claim 52 depends from claim 51. Claim 22 is illustrative:

22. A device comprising:
a radio;
a processor and memory containing instructions executable by the processor whereby the device is operable to:
optically receive information including a displayed service activation code from a remote device;
register the remote device for access to a messaging account using the service activation code;
receive a message for the messaging account;
encrypt the message using an encryption key; and
send the message to the remote device,
wherein the device is authenticated to access the messaging account.

Ex. 1001, 11:5–17.

D. Prior Art Relied Upon

Petitioner relies upon the references listed below (Pet. 2):

Reference	Date	Exhibit No.
Nielson, PCT WO 2001/040605	June 7, 2001	1005
Thompson, PCT WO 2001/029731	Apr. 26, 2001	1006
Richardson, US 2005/0210259 A1	Sep. 22, 2005	1008

Reference	Date	Exhibit No.
Eaton, US 2003/0101343 A1	May 29, 2003	1009
Friend, US 2004/0049599 A1	Mar. 11, 2004	1010
Brown, US 7,603,556	Oct. 13, 2009	1012

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 1):

Claims Challenged	35 U.S.C. §	References
22–26, 32, 37–40, 46, 51	103	Brown, Thompson, Nielsen
22–28, 32, 33, 37–42, 46, 51	103	Brown, Thompson, Nielsen, Easton
32, 46	103	Brown, Thompson, Nielsen, Easton, Richardson
36, 50, 52	103	Brown, Thompson, Nielsen, Easton, Friend

II. ANALYSIS

Discretionary Denial Under 35 U.S.C. § 314(a)

Petitioner argues that institution is warranted in both the instant IPR proceeding and the '280 IPR proceeding, which challenge the same claims of the '619 patent. Notice, 2–5. Patent Owner counters that the instant

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