

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

AGIS SOFTWARE DEVELOPMENT, LLC,
Patent Owner.

IPR2018-01079
Patent 8,213,970

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

ZADO, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision issues pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed herein, we determine that Google LLC (“Petitioner”)¹ has shown, by a preponderance of the evidence, that claims 1 and 3–9 (“challenged claims”) of U.S. Patent No. 8,213,970 B2 (Ex. 1001, “the ’970 patent”) are unpatentable. *See* 35 U.S.C. § 316(e) (2012); 37 C.F.R. § 42.1(d) (2017).

A. Procedural History

Petitioner filed a Petition for *inter partes* review of claims 1 and 3–9 of the ’970 patent. Paper 2 (“Pet.” or “Petition”). AGIS Software Development, LLC (“Patent Owner”)² subsequently filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Petitioner filed an authorized Reply to Patent Owner’s Preliminary Response. Paper 8. On November 20, 2018, the Board entered a decision instituting an *inter partes* review of all claims and all grounds presented in the Petition. Paper 9 (“Institution Decision” or “Inst. Dec.”).

After institution, Patent Owner filed a Response to the Petition. Paper 17 (“Response” or “PO Resp.”). Petitioner thereafter filed a Reply to Patent Owner’s Response. Paper 22 (“Pet. Reply” or “Reply”). Patent Owner filed a Sur-reply to Petitioner’s Reply to Patent Owner’s Response.

¹ Pursuant to 37 C.F.R. § 42.8, Petitioner identifies as real parties-in-interest Google LLC, Huawei Device USA Inc., Huawei Device Co., Ltd., Huawei Device (Dongguan) Co., Ltd., Huawei Technologies USA Inc., Huawei Technologies Co., Ltd., and LG Electronics, Inc. Pet. 79.

² Pursuant to 37 C.F.R. § 42.8, Patent Owner identifies only itself as a real party-in-interest. Paper 5, 1.

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Paper 27 (“Sur-reply”). Patent Owner also filed a Request for Rehearing of the Institution Decision, Paper 12, which we denied, Paper 26.

An oral hearing was held on Sept. 5, 2019. A transcript of the hearing is included in the record. Paper 33 (“Tr.”).

B. Related Matters

The parties advise that the ’970 patent has been asserted in *AGIS Software Development LLC v. Huawei Device USA Inc. et al.*, No. 2:17-cv-00513 (E.D. Tex.); *AGIS Software Development LLC v. HTC Corporation*, No. 2:17-cv-00514 (E.D. Tex.); *AGIS Software Development LLC v. LG Electronics, Inc.*, No. 2:17-cv-00515 (E.D. Tex.); *AGIS Software Development LLC v. Apple Inc.*, No. 2:17-cv-00516-JRG (E.D. Tex.); *AGIS Software Development LLC v. ZTE Corporation et al.*, No. 2:17-cv-00517 (E.D. Tex.). Pet. 79–80; Paper 5, 3–4. Patent Owner further advises that the ’970 patent and patents related to the ’970 patent are the subject of various filings requesting *inter partes* review. Paper 5, 2–3 (table identifying *inter partes* review case numbers)

C. 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, code (57). 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 1:65–67. 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

- (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., code (57). 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

D. Illustrative Claims

Petitioner challenges claims 1 and 3–9 of the ’970 patent. Pet. 12. Claims 1 and 6 are independent. Claim 1, reproduced below, is illustrative.

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;

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