

Google Gets Messaging Patent Trimmed At PTAB

By Dani Kass

Law360 (November 20, 2019, 7:18 PM EST) -- The Patent Trial and Appeal Board has invalidated several claims from an AGIS Software Development LLC electronic messaging patent, following a challenge from Google.

In a final decision Tuesday, the board said all eight claims challenged by Google LLC are invalid as obvious based on the combination of two pieces of prior art. Google had filed its petition for inter partes review in May 2018 after several of its partners were accused of infringement, and it was sued itself this month.

The tech giant had raised two other obviousness challenges in the same petition, based on different combinations of prior art, but the PTAB said those arguments were unsuccessful. The ruling also chided AGIS for attempting to introduce a new argument during oral hearings based on how a piece of prior art relates to the patent.

The patent covers a "specialized software application program" for a personal computer, personal digital assistant or cell phone that creates and processes forced message alerts. It's used in AGIS' LifeRing System, which "provides first-responders, law enforcement, and military personnel with what is essentially a tactical operations center built into hand-held mobile devices," according to court filings.

AGIS had filed five lawsuits in 2017 accusing Huawei Device USA Inc., HTC Corp., LG Electronics, Inc., Apple Inc. and ZTE Corp. of infringing the patent with certain devices, including Android-based smartphones and tablets. Google licenses the Android operating system to each of those companies, excluding Apple, according to the complaints. All of these cases have settled.

Then on Nov. 4, AGIS sued Google for patent infringement in Texas federal court, naming the instant patent and five others. Specifically, the complaint says Google's "Find My Device" application and service infringes this patent.

HTC and ZTE had also sought to invalidate this same patent at the PTAB, but the board **rejected** their bid in July. ZTE had questioned whether the patent was valid in district court, so the PTAB said it was barred from instituting an IPR.

Brown Rudnick LLP's Vincent Rubino, who represents AGIS, told Law360 that Google has filed more than 10 IPR requests based on this portfolio of patents, and that eight of its petitions have been denied. He said this is the only one that's gone to a final written decision.

“My client reserves the right to appeal the decision and is evaluating [its] options,” Rubino said.

Counsel for Google didn’t immediately respond to a request for comment Wednesday.

Administrative Patent Judges Trevor M. Jefferson, Christa P. Zado and Kevin C. Trock sat on the panel for the Patent Trial and Appeal Board.

The patent-in-suit is U.S. Patent No. 8,213,970.

Google is represented by Jonathan Tuminaro, Robert Sokohl and Karen Wong-Chan of Sterne Kessler Goldstein & Fox PLLC.

AGIS is represented by Vincent Rubino, Peter Lambrianakos and Enrique Iturralde of Brown Rudnick LLP.

The case is Google LLC v. AGIS Software Development LLC, case number IPR2018-01079, before the Patent Trial and Appeal Board.

--Additional reporting by Matthew Bultman. Editing by Haylee Pearl.