

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner

v.

UNILOC 2017 LLC
Patent Owner

Case IPR2017-01683
U.S. Patent No. Patent 8,571,194

PATENT OWNER'S NOTICE OF APPEAL

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 35 U.S.C. §§ 141 and 142 and 37 C.F.R. §§ 90.2 and 90.3, Patent Owner Uniloc 2017 LLC. (“Patent Owner”) hereby provides notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision entered Jan. 14, 2019 (Paper 24); the Decision Denying Patent Owner’s Request for Rehearing entered May 8, 2019 (Paper 26); and from all underlying findings, orders, decisions, rulings, and opinions, including, without limitation the institution decision entered Jan. 17, 2018 (Paper 10).

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Patent Owner states that the issues for appeal include, but are not limited to: the Patent Trial and Appeals Board (“Board”)’s determinations in the institution that Claims 1–16 of U.S. Patent No 8,571,194 (the “194 patent”) were shown by a reasonable likelihood to be unpatentable; the Board’s subsequent determination that Claims 1–16 are unpatentable; the Decision Denying Patent Owner’s Request for Rehearing; the Board’s consideration and analysis of the expert testimony, prior art, and other evidence in the record; and the Board’s factual findings, conclusions of law, or other determinations supporting or relating to the above issues.

Pursuant to 35 U.S.C. § 142 and 37 C.F.R. § 90.2(a), this Notice is being filed with the Director of the United States Patent and Trademark Office. Simultaneous with this submission, a copy of this Notice is being filed with the Patent Trial and Appeal Board. In addition, a copy of this Notice, along with the required docketing fees, is being filed with the Clerk’s office of the United States Court of Appeals for

the Federal Circuit.

DATED: July 9, 2019

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CERTIFICATE OF SERVICE

The undersigned certifies that, in addition to being filed electronically through the Patent Trial and Appeal Board’s E2E, the foregoing Notice of Appeal was filed by Priority Mail Express on July 9, 2019, with the Director of the United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
P.O. Box 1450
Alexandria, VA 22313-1450

The undersigned certifies that a copy of the foregoing Notice of Appeal, along with the required docket fee, was filed on July 9, 2019, with the Clerk’s Office for the United States Court of Appeals for the Federal Circuit through the Court’s CM/ECF filing system.

The undersigned certifies service pursuant to 37 C.F.R. § 42.6(e) of a copy of this Notice of Appeal by electronic mail on July 9, 2019, on the counsel of record for Petitioner:

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DATED: July 9, 2019

By: /s/ Brett A. Mangrum
Brett A. Mangrum

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC¹,

Petitioner,

v.

UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.,
Patent Owner.

Case IPR2017-01683
Patent 8,571,194 B2

Before KARL EASTHOM, JEFFREY S. SMITH, and MINN CHUNG,
Administrative Patent Judges.

SMITH, *Administrative Patent Judge.*

DECISION
Instituting *Inter Partes* Review
37 C.F.R. § 42.108

¹ Petitioner indicates “Google Inc. converted from a corporation to a limited liability company and changed its name to Google LLC on September 30, 2017.” Paper 7, 2.

I. INTRODUCTION

Petitioner filed a Petition for *inter partes* review of claims 1–16 of U.S. Patent No. 8,571,194 B2 (Ex. 1001, “the ’194 patent”). Paper 1 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition . . . and any response . . . 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); *see* 37 C.F.R. § 42.108.

Upon consideration of the Petition and the Preliminary Response, we are persuaded Petitioner has demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of claims 1–16 of the ’194 patent. Accordingly, we institute an *inter partes* review.

A. *Related Matters*

The ’194 patent is the subject of IPR2017-00597 (instituted), IPR2017-01076 (terminated before institution), and IPR-01756 (instituted).

Both parties also identify several civil actions related to the ’194 patent. Pet. 62–64; Paper 4.

B. *The ’194 Patent*

The ’194 patent relates generally to a method for initiating a conference call between two or more users, and more particularly to initiating a voice conference call between two or more users using a central server to communicate parameters for the call and for initiating the call itself. Ex. 1001, 1:18–22. Conference calls are initiated via an instant messaging (IM) system to reduce the effort required to initiate and manage the call. *Id.* at Abstract. “The system uses an IM connection between a

requesting party and a conference call server to inform the conference call server of the desire to initiate the conference call.” *Id.* The conference call server initiates the conference call by having involved parties called by a conference bridge, thus reducing the effort required by the parties to join the call. *Id.* Figure 4 of the '194 patent is reproduced below.

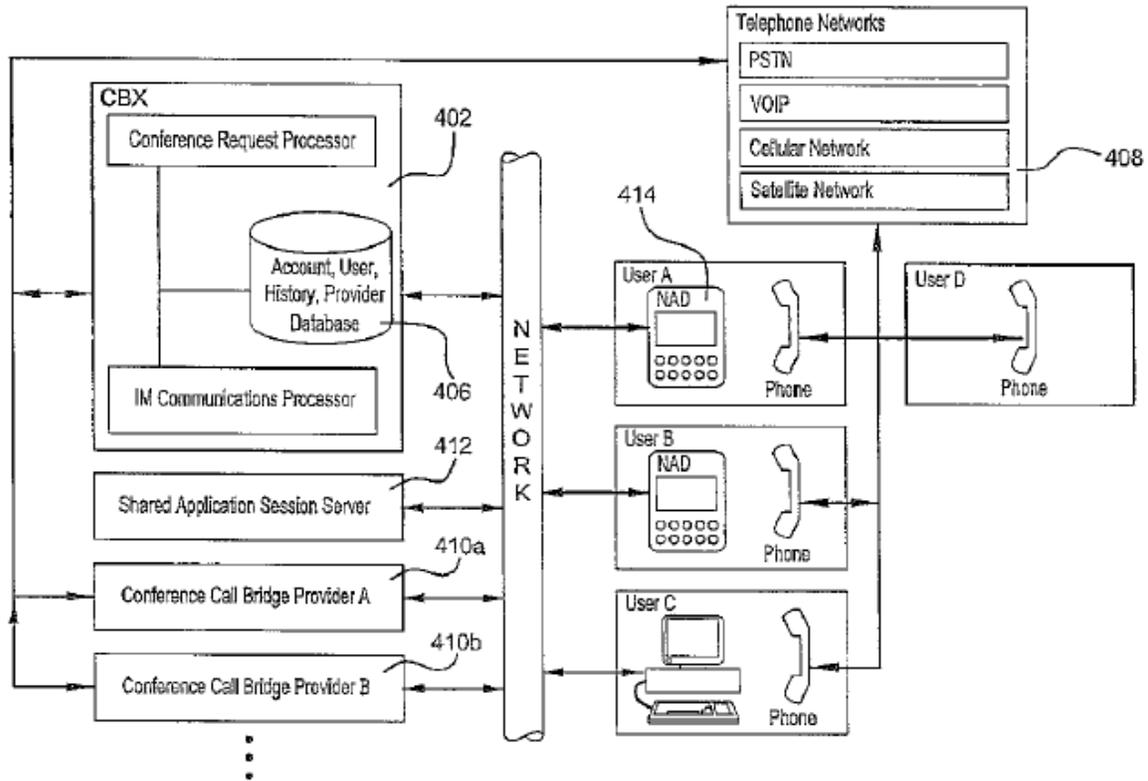


Figure 4 above shows a block diagram of a system for accomplishing the initiation of conference calls. Ex. 1001, 4:61–63. Conference call server 402 is connected to network 404. *Id.* at 9:22–23. Database 406, associated with conference call server 402, stores account information, user information, and call management information. *Id.* at 9:23–26. The conference call server can be connected directly to telephone network 408, or indirectly through third party conference bridge 410. *Id.* at 9:30–33. Shared application server 412 can also be “connected to allow information

generated during a shared application session to be accessed by the conference call server as required, such as to determine a list of parties involved in a shared application session.” *Id.* at 9:34–38. The users connect to the system via network access device (NAD) 414, which may be any network communicable device having the appropriate IM software service access. *Id.* at 9:47–49.

A conference call requester provided with a NAD sends a conference call request to the conference call server using an instant messaging service. *Id.* at 6:30–39. When a conference call request is received by the conference server, the conference server generates a conference request message to the conference call targets. *Id.* at 7:15–21. The conference call targets respond via their instant messaging software. *Id.* at 7:21–24. The conference call server then generates a list of targets for the conference call and initiates the conference call. *Id.* at 7:24–26.

C. Illustrative Claim

Claims 1, 6, 11, and 16 of the challenged claims of the ’194 patent are independent. Claim 1 is illustrative of the claimed subject matter:

1. A non-transitory computer readable medium containing computer instructions configured to operate with electronic computer hardware to perform the following steps:

display, in an instant messaging (IM) chat window of a first party, an exchange of IM messages between the first party and at least one other party, the first party and the at least one other party being current participants to an IM session;

display for the first party an indication of whether the at least one other party is communicably connected to the IM session;

display for the first party an option to automatically initiate voice communication between the current participants of the IM

session without requiring individual selection of potential members including the first party and the at least one other party and without requiring registration with a conference call server for establishing the voice communication by the potential members including the first party and the at least one other party; and

request, in response to selection of the option, voice communication between the first party and the at least one other party;

wherein in response to the request, the voice communication is established between the first party and those of the at least one other party.

Ex. 1001, 12:2–27.

D. References

Petitioner relies on the following references. Pet. 3.

Reference	Title	Date	Ex. No.
Liversidge	US 2002/0076025 A1	published June 20, 2002	Ex. 1004
Beyda	US 2003/0233417 A1	filed June 17, 2002	Ex. 1028

E. Asserted Ground of Unpatentability

Petitioner contends that claims 1–16 of the '194 patent are unpatentable based on the following specific ground:

References	Basis	Challenged Claims
Liversidge and Beyda	§ 103	1–16

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b);

Cuozzo Speed Techs., LLC v. Lee, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim interpretation standard to be applied in *inter partes* reviews). Consistent with the broadest reasonable construction, claim terms are presumed to have their ordinary and customary meaning as understood by a person of ordinary skill in the art in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor may provide a meaning for a term that is different from its ordinary meaning by defining the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner proposes the claim phrase “without requiring . . . registration with a conference call server for establishing the voice communication by [the] potential members including the first party and the at least one other party” should be interpreted to mean, “IM session participants are [not] required to complete an additional or separate registration with a conference call server before participating in voice communication between the current participants of the IM session from within the IM session.” Pet. 19.

Petitioner highlights that during prosecution, Applicant explained to the Examiner that users of the claimed system did not need to register with the present IM session or any associated group to be joined to a conference call, because the system would “be aware of the on-going IM session, such that the software would determine the list of conference call targets from the list of parties presently in the IM session.” *Id.* at 18 (citing Ex. 1018, 111–15, 134–36).

Petitioner also highlights that during prior litigations involving the '194 patent, Patent Owner asserted that “without requiring registration with a conference call server” as recited in claim 1 should be construed as “separate registration with a conference call server is not required to initiate voice communication between current participants of an instant message session.” Pet. 18–19 (citing Ex. 1019, 6; Ex. 1020, 14 (rephrasing this construction as “wherein the potential members do not need to provide the conference call server with their addresses to establish voice communication between the potential members”); Ex. 1021, 6 (explaining that “[t]he claim is thus silent with respect to registration for the IM session . . . [I]f someone is a ‘current participant’ of an IM session, then that individual must have provided at least *some* information to the *IM system* . . . ”)).

Patent Owner argues that this claim term should be interpreted in light of the specification and prosecution history. Prelim. Resp. 30–31. Specifically, Patent Owner argues that the broadest reasonable interpretation for this phrase is a meaning based on Hamberg’s teaching. Prelim. Resp. 31. According to Patent Owner, Hamberg requires a predefined group of conference call participants, and requires a form a registration. *Id.*

When describing Hamberg during prosecution, Patent Owner stated to the Examiner that “the conference call [of Hamberg] is set up between persons registered to the group at the conference call server which establishes the conference call.” Ex. 1018, 113. Patent Owner distinguished the invention from Hamberg by explaining that “current participants of the IM session (or other potential members) need not have registered, e.g., *with the conference call server that establishes the conference call*, in order to be

potential members for the voice communication” Ex. 1018, 114 (emphasis added).

Patent Owner also explained during prosecution that conference calls of the invention can be created between users “without the necessity of each user to dial a telephone number or having the host look up the phone number of each participant in order to place an outbound telephone call,” because the “invention may collect, through a variety of means, the information needed to join those users into a telephone conference call, pass the dialing information and other parameters to a central server, and send an invitation to each participant in advance of placing the call.” Ex. 1018, 112 (quoting Ex. 1001, 4:12–28).

Nevertheless, on this limited record, Patent Owner does not explain adequately how its prosecution history arguments pertain to a dispositive issue in this case. For example, Patent Owner does not explain sufficiently how the prosecution history relates to the meaning or the scope of the negative limitation with respect to the conference call server as recited in challenged claim 1 (i.e., “without requiring registration with a conference call server for establishing the voice communication by the potential members including the first party and the at least one other party”).

We determine that the scope of “without requiring . . . registration with a conference call server for establishing the voice communication by [the] potential members including the first party and the at least one other party,” read in light of the specification and prosecution history of the ’194 patent, encompasses at least “current participants of an IM session are not required to complete an additional or separate registration with a conference call server before establishing voice communication between current

participants of the IM session.” As a corollary, we determine that the claim language does not exclude registration by the potential members, as long as the registration is not “with a conference call server.”

Petitioner contends antecedent basis for “said display for the first party” recited in each of claims 4, 9, and 14, should be construed as “display for the first party an option” recited in independent claims 1, 6, and 11. Pet. 20. On the present record, we adopt this construction.

Patent Owner contends that Petitioner’s constructions of “without requiring individual selection” recited in claims 1, 6, and 11, and “request lacking a specific indication of the at least one other party” recited in claim 16, are incorrect. PO Prelim. Resp. 32–33. However, Petitioner did not propose constructions of these terms. Patent Owner also does not propose constructions of these terms. We determine that these terms do not require express construction at this stage.

We further determine that none of the other terms require express construction at this stage.

B. Obviousness Over Liversidge and Beyda

Petitioner, relying on the Declaration of Stuart Lipoff (Ex. 1002), challenges claims 1–16 as obvious over the combination of Liversidge and Beyda.² Pet. 20–60.

² Petitioner contends that a “non-transitory computer readable medium” recited in the preamble of claim 1 is inherent in Liversidge, but addresses this issue as a matter of obviousness in light of Beyda. Pet. 20–23. To the extent the preamble should be given patentable weight, Petitioner sufficiently establishes on this limited record that a “non-transitory computer readable medium” would have been obvious over the combination of Liversidge and Beyda.

1. Liversidge (Ex. 1004)

Liversidge relates to a virtual team environment that facilitates collaboration among geographically dispersed team members using a distributed application. Ex. 1004 ¶ 3. Communications sessions are automatically set up by the collaboration services suite in response to request messages generated by a virtual team environment (VTE) client when a team member initiates a communications session request using a graphical user interface (GUI). Ex. 1004, Abstract. Team members require no knowledge of another team member's communications device address in order to initiate a communications session. *Id.* A collaboration services suite “includes a VTE server that communicates with the VTE clients, a presence engine that collects and maintains a status of communications devices specified in a current profile of the team member,” and “a call server for handling setup and control of a voice component of each communications session completed.” *Id.*

Figure 2 of Liversidge is reproduced below.

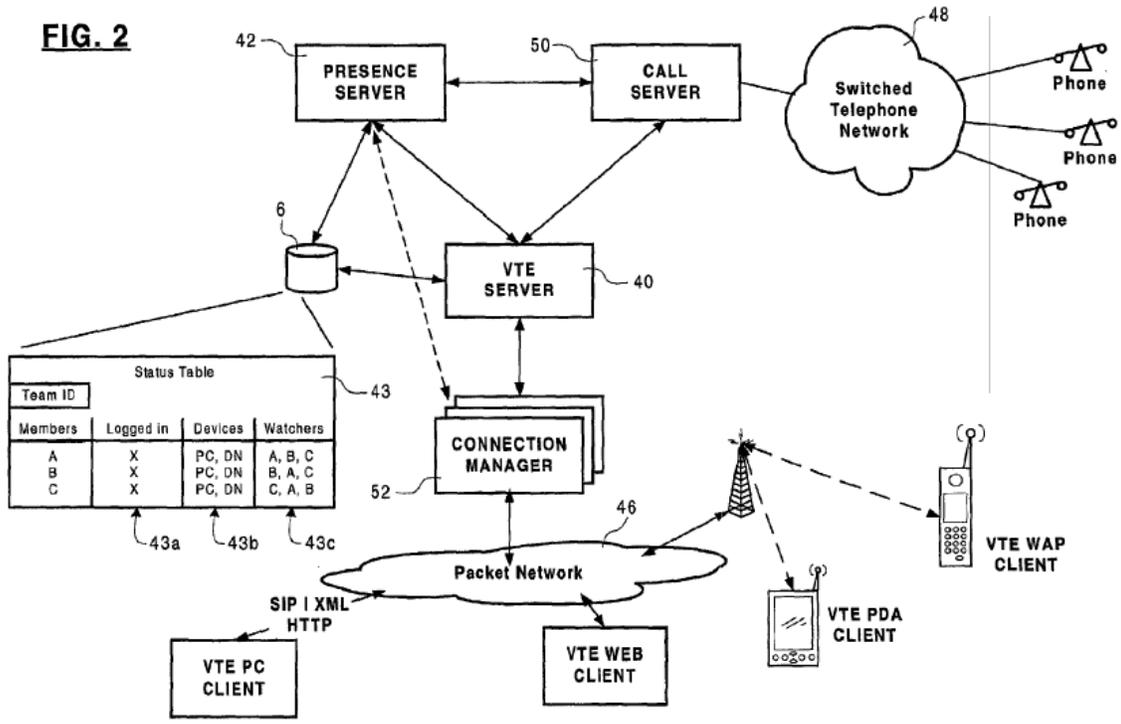


Figure 2 above shows a block diagram illustrating a system for implementing a collaborative services suite, including VTE server 40, presence server 42, and database 6. Ex. 1004 ¶ 65. Each VTE client can be a communications device such as a telephone, a personal computer, a personal digital assistant, or another messaging device. *Id.* VTE server 40 controls interaction between the collaboration services suite and communications devices associated with each team member. *Id.* Presence server 42 maintains status table 43, which indicates whether a respective team member is currently logged-in to the collaboration services suite. *Id.* ¶¶ 66–67. Call server 50 facilitates interaction between VTE server 40, presence server 42, and public switched telephone network (PSTN 48). *Id.* ¶ 68. Similarly, connection manager 52 facilitates protocol-independent

messaging between VTE server 40 and packet-based communications devices associated with the VTE clients. *Id.*

Figure 21 of Liversidge is reproduced below.

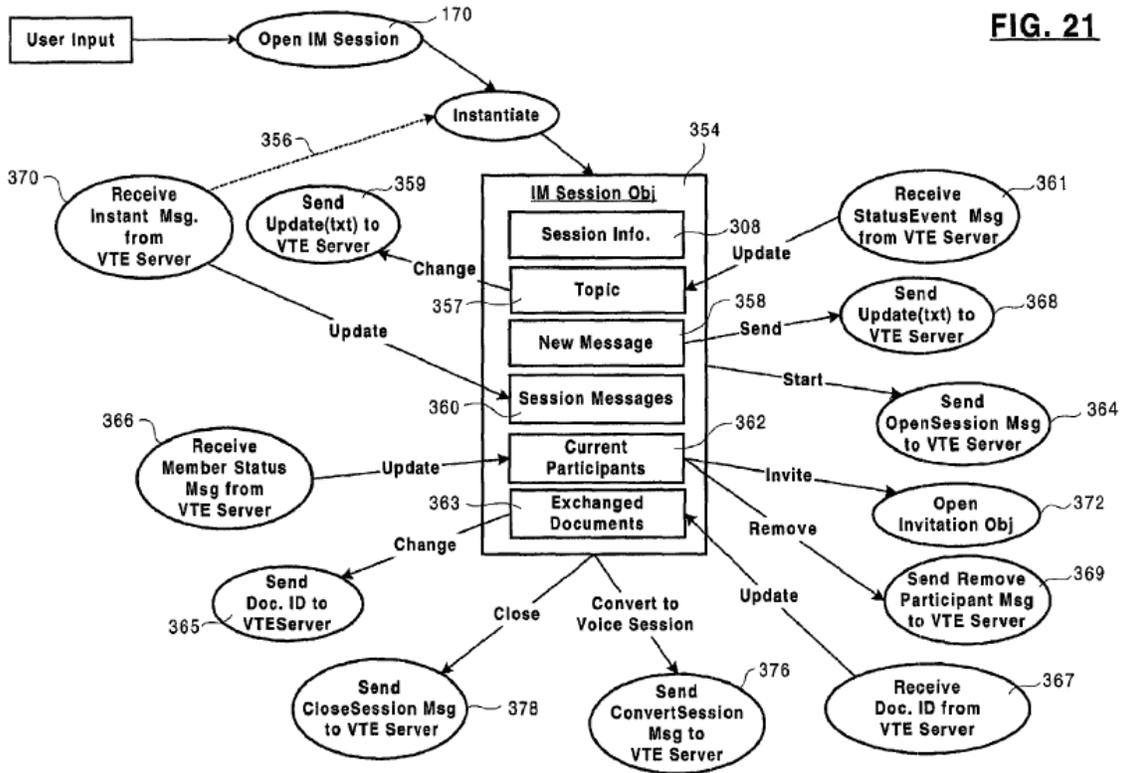


Figure 21 above shows a block diagram schematically illustrating functionality associated with an Instant Messaging Session Object instantiated by a VTE client application in respect of an Instant Messaging communications session. Ex. 1004 ¶ 44. IM session object 354 serves as a container for information regarding an instant messaging session, such as session information 308, “new message 358 entered by the team member for transmission to other participants of the IM session, a record of session messages 360 previously exchanged between participants in the IM session, and a listing 362 identifying each of the current participants in the IM session.” Ex. 1004 ¶ 121. The current session participants may terminate

the instant messaging session and continue the conversation using as alternative type of communication such as voice. Ex. 1004 ¶ 126. An appropriate icon or button, such as a convert session button, enables the team member to launch convert session message 376 to facilitate converting the session to the desired type of communication. *Id.*

2. *Beyda (Ex. 1028)*

Beyda relates to a system for multimedia telephony-over-LAN conferences. Ex. 1028, ¶ 3. The system includes an instant messaging (IM) server and a VoIP server, and a plurality of system clients having both VoIP and IM sub-clients. Ex. 1028, Abstract. The system clients can log on to their respective servers in parallel. *Id.* The IM server and the VoIP server can communicate lists of common participants and allow for IM conferences among at least subsets of the system clients while an audio or video teleconference is ongoing. *Id.*

3. *Analysis of Claims 1–16*

a. *Analysis of independent claims 1, 6, and 11*

Claim 1 recites “display, in an instant messaging (IM) chat window of a first party, an exchange of IM messages between the first party and at least one other party, the first party and the at least one other party being current participants to an IM session.” Claims 6 and 11 recite a similar limitation. Petitioner contends this limitation is disclosed by Liversidge’s description of displaying a record of session messages 360 previously exchanged between participants in an IM session. Pet. 23–25 (citing Ex. 1002 ¶¶ 69, 70, 111, 125, Fig. 21 (session messages 360)).

Claim 1 recites “display for the first party an indication of whether the at least one other party is communicably connected to the IM session.”

Claims 6 and 11 recite a similar limitation. Petitioner contends this limitation is disclosed by Liversidge's description of presence icons that display presence and status information of current participants in an IM session, including whether a particular user is logged-in to the collaboration services suite, and whether the user is idle. Pet. 25–26 (citing Ex. 1004 ¶¶ 67, 83, 106, 121, 123).

Claim 1 recites “display for the first party an option to automatically initiate voice communication between the current participants of the IM session.” Claims 6 and 11 recite a similar limitation. Petitioner contends this limitation is disclosed by Liversidge in describing a convert session button to automatically initiate voice communication between current participants of an IM session. Pet. 26–28 (citing Ex. 1004 ¶¶ 126, 176–181, Fig. 21).

Claim 1 recites “without requiring individual selection of potential members including the first party and the at least one other party.” Claims 6 and 11 recite a similar limitation. Petitioner reads this limitation on Liversidge's description of three users converting an overly complex IM discussion into a voice communications session, with a team member using VTE client A (the first party) to initiate a convert session message, which causes the VTE client A to formulate a convert session message. Pet. 28 (citing Ex. 1004 ¶ 176). According to Petitioner, the first party does not select individual participants, rather, the VTE server determines the participants of the current IM session using a session ID provided by the convert session message. *Id.*

Claim 1 recites “without requiring registration with a conference call server for establishing the voice communication by the potential members

including the first party and the at least one other party.” Claims 6 and 11 recite a similar limitation. Petitioner contends this limitation reads on Liversidge’s description of converting an IM session to a new communications type and joining all current participants of the IM session to the new communication session, without any additional registration. Pet. 29–32 (citing Ex. 1004 ¶¶ 117–120, 125–126, 176–181). According to Petitioner, the user information of Liversidge is not obtained by requiring registration with a conference call server, but rather, is obtained from VTE server 40, which is aware of the on-going IM session, and uses the session ID included in the convert session message to determine the participants of the current IM session. Pet. 29 (citing Ex. 1004 ¶ 176).

Patent Owner, relying on testimony of William Easttom, contends Liversidge describes the same registration process as Hamberg. Prelim. Resp. 33–41 (citing Ex. 2001 ¶¶ 78–92). According to Patent Owner, the registration process for team members shown in Figure 2 of Liversidge is the same as the registration process for group members shown in Figure 2 of Hamberg. Pet. 34–40 (citing Ex. 1004 ¶¶ 100, 102, 134, 176–181, Fig. 2; Ex. 1013 ¶¶ 23, 25, Fig. 2). However, claim 1 recites “without requiring registration *with a conference call server.*” (emphasis added). As we discussed in our construction of this term, the claim language does not exclude registration by the potential members, as long as the registration is not “with a conference call server.” Status table 43, with team members A, B, and C shown in Figure 2 of Liversidge, is maintained by presence server 42, not call server 50. Ex. 1004 ¶ 67.

Petitioner further contends that Liversidge allows users to communicate not only with their team members but also with other persons

who may not be a member of the team. Pet. 31 (citing Ex. 1004 ¶¶ 82, 134–135). According to Petitioner, an IM session that includes both team members and non-team members can be converted to voice communication by clicking the convert session button. Pet. 32 (citing Ex. 1004 ¶¶ 126, 176). Mr. Lipoff testifies that an IM session participant can launch a voice communication between the current participants of an IM session, regardless of whether those participants are members of a team or not, by clicking on the convert session button, and the VTE server then determines the participants of the current IM session. Ex. 1002 ¶¶ 83–84 (citing, *inter alia*, Ex. 1004 ¶¶ 125, 126). The supporting paragraphs of Liversidge describe inviting another person, who may or may not be a member of the team, to join an IM session, and also describe providing a convert session button to cause the IM session to terminate and continue the conversation using voice communication. Ex. 1004 ¶¶ 125–126.

Patent Owner contends that Petitioner’s argument that registering with a team is not required in Liversidge, because anyone in Liversidge can join a session, does not address the claim as a whole. Prelim. Resp. 39–41, 46–47. According to Patent Owner, the claim also requires “without requiring individual selection of potential members including the first party and the at least one other party.” *Id.* at 47. Patent Owner contends that when Petitioner identifies Liversidge’s disclosure of selecting members to join an IM session to describe “without registering,” Petitioner does not establish that Liversidge also discloses “without requiring individual selection.” *Id.*

However, considering the claim as a whole, the claim recites “an option to automatically initiate voice communication between the current participants of the IM session without requiring individual selection of

potential members” of the voice communication. The “individual selection” that is not required is for potential members of the voice communication. The claim does not exclude individually selecting members of the IM session. Patent Owner’s contention is not commensurate with the scope of the claim.

Claim 1 recites “request, in response to selection of the option, voice communication between the first party and the at least one other party.” Claims 6 and 11 disclose a similar limitation. Petitioner contends this limitation is disclosed by Liversidge in describing automatically setting up communications sessions in response to request messages generated by the VTE client when a team member initiates a communications session request. Pet. 32 (citing Ex. 1004, Abstract, ¶¶ 126, 176). According to Petitioner, the communications session request is in the form of the convert session message that provides a session ID and a new session type used by the VTE server to initiate the voice communication session between participants of the IM session. Pet. 32–33 (citing Ex. 1004 ¶¶ 176–181).

Claim 1 recites “wherein in response to the request, the voice communication is established between the first party and those of the at least one other party.” Claims 6 and 11 recite a similar limitation. Petitioner contends this limitation is disclosed by Liversidge in describing VTE server 40 formulating and sending a make call message in response to the convert session message to a public switched telephone network (PSTN) virtual switching point, causing each current participant to be called and conferenced with a conference bridge. Pet. 33 (citing Ex. 1004, Abstract, ¶¶ 141, 176–181).

At this stage of the proceeding, Petitioner has established sufficiently that Liversidge teaches the limitations of claims 1, 6, and 11. We also determine the Petition and supporting evidence establishes a reasonable likelihood that independent claims 1, 6, and 11 would have been obvious over the combination of Liversidge and Beyda.

b. Analysis of dependent claims 2–5, 7–10, and 12–15

Claims 2, 7, and 12 recite “wherein the at least one other party comprises at least two parties.” Petitioner contends this limitation is disclosed by Liversidge in describing initiating a voice communication session between a first user A and two other users B and C via a conference bridge. Pet. 34 (citing Ex. 1004 ¶¶ 175–181).

Claims 3, 8, and 13 recite “said display an option comprising display of a click-on icon that allows for a single step selection of the option.” Petitioner contends this limitation is disclosed by Liversidge in describing a convert session button to automatically convert an IM session to another session type. Pet. 34–36 (citing Ex. 1006, Fig. 21, ¶¶ 44, 125, 126, 176).

Claims 4, 9, and 14 recite “wherein said display an exchange of IM and said display for the first party comprise display within a common browser or application window.” Petitioner contends this limitation is disclosed by Liversidge in describing a record of session messages and a convert session option within the user interface of IM session object 354. Pet. 37 (citing Ex. 1004, Fig. 21, ¶¶ 122, 125, 126, 176).

Claims 5, 10, and 15 recite “wherein the voice communication includes audio and video.” Petitioner contends Liversidge discloses this limitation in describing a multi-media session such as video conferencing

that uses streaming video and audio transmission. Pet. 40 (citing Ex. 1004 ¶¶ 70, 126, 133, 183–185).

At this stage of the proceeding, Petitioner has established sufficiently that Liversidge teaches the limitations of claims 2–5, 7–10, and 12–15. We also determine the Petition and supporting evidence establishes a reasonable likelihood that claims 2–5, 7–10, and 12–15 would have been obvious over the combination of Liversidge and Beyda.

c. Analysis of independent claim 16

Claim 16 recites “exchange IM messages between a first party and at least one other party, the first party and the at least one other party being current participants to an IM session.” Petitioner contends Liversidge discloses this limitation in describing an active IM session between users A, B, and C. Pet. 52–53 (citing Ex. 1004 ¶¶ 65, 73, 118, 125, 126).

Claim 16 recites “send to the first party an indication of whether the at least one other party is communicably connected to the IM session.” Petitioner contends Liversidge discloses this limitation in describing a collaboration services suite that monitors the status of each participant in the communications session and forwards member status messages to the participants. Pet. 53–54 (citing Ex. 1004 ¶¶ 65, 67, 73, 83, 106, 123).

Claim 16 recites “receive a request from the first party to establish voice communications amongst current participants of the IM session.” Petitioner contends Liversidge discloses this limitation in describing a first party launching a convert session message, or request, to the collaboration services suite to facilitate conversion of the communications session to a desired communications type, such as voice. Pet. 54–55 (citing Ex. 1004 ¶¶ 126, 176–181, Fig. 21).

Claim 16 recites “without requiring registration with a conference call server for establishing the voice communication by potential members including the first party and the at least one other party.” Petitioner contends Liversidge discloses this limitation in describing joining all current participants of an IM session in a new communication session using user information obtained by a VTE server. Pet. 56–59 (citing Ex. 1004 ¶¶ 125–126, 176–181).

Claim 16 recites “the request lacking a specific identification of the at least one other party.” Petitioner contends Liversidge discloses this limitation in describing a convert session request received by a VTE server, where the server, not the request, determines the participants. Pet. 59 (citing Ex. 1004, ¶¶ 75, 117–123, 126, 176–181).

Claim 16 recites “determine, after reception of the request, the at least one other party from information associated with the IM session.” Petitioner contends Liversidge discloses this limitation in describing a VTE server receiving the request, and translating the IM session ID contained in the request to determine the session type and participants. Pet. 59–60 (citing Ex. 1004 ¶¶ 75, 122, 176).

Claim 16 recites “wherein after determining the at least one party, the voice communication is established between the first party and those of the at least one other party.” Petitioner contends Liversidge discloses this limitation in describing the VTE server formulating and sending a make call message with dialed numbers of team members and the conference bridge to a switching point, causing each of the session participants to be called and joined to the conference bridge. Pet. 60 (citing Ex. 1004 ¶¶ 176–181).

At this stage of the proceeding, Petitioner has established sufficiently that Liversidge teaches the limitations of claim 16. We also determine the Petition and supporting evidence establishes a reasonable likelihood that independent claim 16 would have been obvious over the combination of Liversidge and Beyda.

III. CONCLUSION

We have considered the information presented in the Petition and Preliminary Response and determine that there is a reasonable likelihood that Petitioner would prevail with respect to claims 1–16 challenged in the Petition. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108.

IV. ORDER

Accordingly, it is

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review of claims 1–16 of U.S. Patent No. 8,571,194 B2 is instituted on the following ground: obviousness in view of Liversidge and Beyda;

FURTHER ORDERED that pursuant to 35 U.S.C. 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial commences on the entry date of this decision.

IPR2017-01683
Patent 8,571,194 B2

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.,
Patent Owner.

Case IPR2017-01683
Patent 8,571,194 B2

Before KEN B. BARRETT, JEFFREY S. SMITH, and MINN CHUNG,
Administrative Patent Judges.

SMITH, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a)

I. INTRODUCTION

Petitioner filed a Petition for *inter partes* review of claims 1–16 of U.S. Patent No. 8,571,194 B2 (Ex. 1001, “the ’194 patent”). Paper 1 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

On January 17, 2018, we instituted an *inter partes* review of all the challenged claims. Paper 10. Patent Owner filed a Response to the Petition, Paper 14 (“PO Resp.”), and Petitioner filed a Reply, Paper 15 (“Pet. Reply”). An oral hearing was held on October 16, 2018, and a transcript of the hearing is included in the record. Paper 23 (“Tr.”).

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). For the reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–16 of the ’194 patent are unpatentable.

A. *Related Matters*

The ’194 patent is the subject of IPR2017-00597 (instituted), IPR2017-01076 (terminated before institution), and IPR2017-01756 (instituted).

Both parties also identify several civil actions related to the ’194 patent. Pet. 62–64; Paper 4.

B. *The ’194 Patent*

The ’194 patent relates generally to a method for initiating a conference call between two or more users, and more particularly to initiating a voice conference call between two or more users using a central server to communicate parameters for the call and for initiating the call itself. Ex. 1001, 1:18–22. Conference calls are initiated via an instant

messaging (IM) system to reduce the effort required to initiate and manage the call. *Id.* at Abstract. “The system uses an IM connection between a requesting party and a conference call server to inform the conference call server of the desire to initiate the conference call.” *Id.* The conference call server initiates the conference call by having involved parties called by a conference bridge, thus reducing the effort required by the parties to join the call. *Id.* Figure 4 of the ’194 patent is reproduced below.

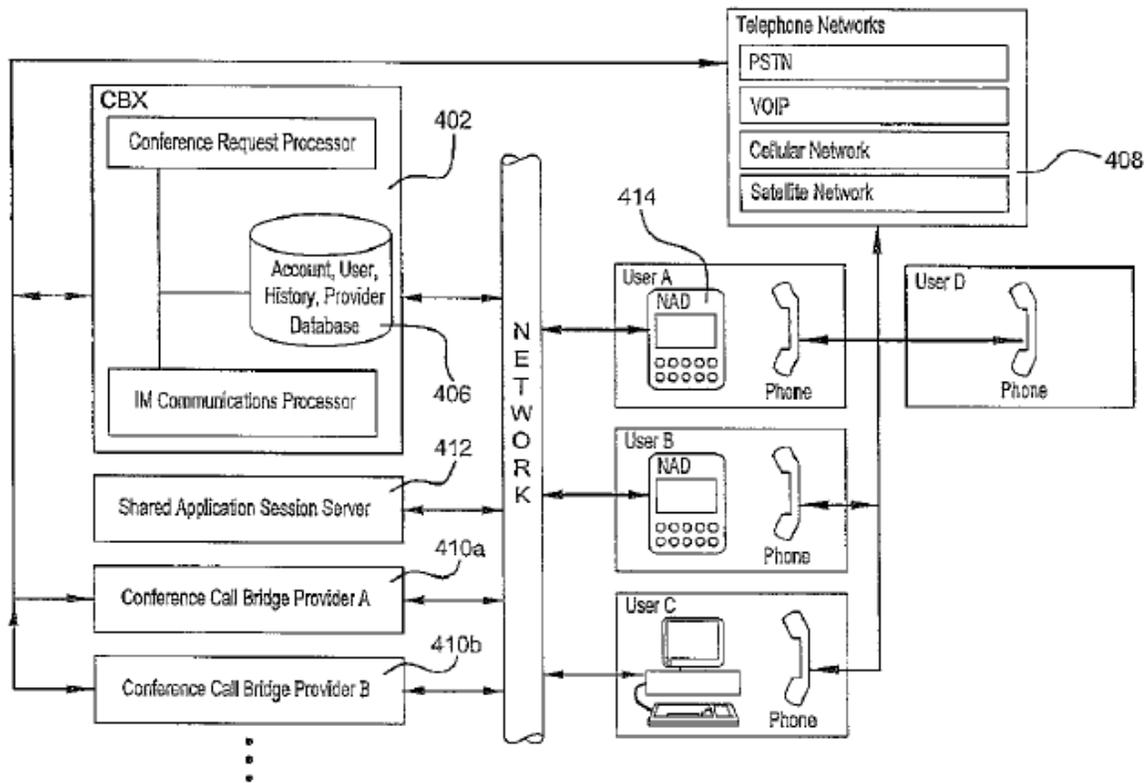


Figure 4 above shows a block diagram of a system for accomplishing the initiation of conference calls. Ex. 1001, 4:61–63. Conference call server 402 is connected to network 404. *Id.* at 9:22–23. Database 406, associated with conference call server 402, stores account information, user information, and call management information. *Id.* at 9:23–26. The conference call server can be connected directly to telephone network 408,

or indirectly through third party conference bridge 410. *Id.* at 9:30–33. Shared application server 412 can also be “connected to allow information generated during a shared application session to be accessed by the conference call server as required, such as to determine a list of parties involved in a shared application session.” *Id.* at 9:34–38. The users connect to the system via network access device (NAD) 414, which may be any network communicable device having the appropriate IM software service access. *Id.* at 9:47–49.

A conference call requester provided with a NAD sends a conference call request to the conference call server using an instant messaging service. *Id.* at 6:30–39. When a conference call request is received by the conference server, the conference server generates a conference request message to the conference call targets. *Id.* at 7:15–21. The conference call targets respond via their instant messaging software. *Id.* at 7:21–24. The conference call server then generates a list of targets for the conference call and initiates the conference call. *Id.* at 7:24–26.

C. Illustrative Claim

Claims 1, 6, 11, and 16 of the challenged claims of the '194 patent are independent. Claim 1 is illustrative of the claimed subject matter:

1. A non-transitory computer readable medium containing computer instructions configured to operate with electronic computer hardware to perform the following steps:

display, in an instant messaging (IM) chat window of a first party, an exchange of IM messages between the first party and at least one other party, the first party and the at least one other party being current participants to an IM session;

display for the first party an indication of whether the at least one other party is communicably connected to the IM session;

display for the first party an option to automatically initiate voice communication between the current participants of the IM session without requiring individual selection of potential members including the first party and the at least one other party and without requiring registration with a conference call server for establishing the voice communication by the potential members including the first party and the at least one other party; and

request, in response to selection of the option, voice communication between the first party and the at least one other party;

wherein in response to the request, the voice communication is established between the first party and those of the at least one other party.

Ex. 1001, 12:2–27.

D. Evidence

Petitioner relies on the following references. Pet. 3.

Reference	Title	Date	Ex. No.
Liversidge	US 2002/0076025 A1	published June 20, 2002	Ex. 1004
Beyda	US 2003/0233417 A1	filed June 17, 2002, published Dec. 18, 2003	Ex. 1028

Petitioner also relies on the Declaration of Stuart J. Lipoff, dated June 28, 2017 (Ex. 1002), in support of its arguments. Patent Owner relies on the Declaration of William Charles Easttom II, dated October 24, 2017 (Ex. 2001), in support of its arguments. The parties rely on other exhibits as discussed below.

E. Asserted Ground of Unpatentability

Petitioner contends that claims 1–16 of the ’194 patent are unpatentable based on the following specific ground:

References	Basis	Challenged Claims
Liversidge and Beyda	§ 103	1–16

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b) (2016)¹; *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim interpretation standard to be applied in *inter partes* reviews). Consistent with the broadest reasonable construction, claim terms are presumed to have their ordinary and customary meaning as understood by a person of ordinary skill in the art in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor may provide a meaning for a term that is different from its ordinary meaning by defining the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

¹ A recent amendment to this rule does not apply here because the Petition was filed before November 13, 2018. *See* “Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board,” 83 Fed. Reg. 51,340, 51,340 (Oct. 11, 2018) (to be codified at 37 C.F.R. pt. 42).

without requiring registration

In the Decision to Institute, we construed the scope of “without requiring registration with a conference call server for establishing the voice communication by [the] potential members including the first party and the at least one other party,” read in light of the specification and prosecution history of the ’194 patent, to encompass at least “current participants of an IM session are not required to complete an additional or separate registration with a conference call server before establishing voice communication between current participants of the IM session.” As a corollary, we determined that the claim language does not exclude registration by the potential members, as long as the registration is not “with a conference call server.”

Patent Owner contends that we expanded the scope of this term to encompass (a) the registration disclosed in Hamberg (Ex. 2002) (a reference discussed during prosecution of the underlying patent application), (b) the allegedly disclaimed registration of the ’194 patent, and (c) the registration of Liversidge considered by the Examiner. PO Resp. 26. According to Patent Owner, neither Hamberg nor the allegedly disclaimed registration of the ’194 patent requires an additional or separate registration, but instead, they both check stored information to see whether a user is registered. PO Resp. 28 (citing Ex. 1018, 124).

Petitioner contends the plain language of this claim limitation states that the option for initiation of voice communication must not require (1) “registration,” (2) “with a conference call server,” (3) “by the potential members including the first party and the at least one other party.” Reply 2. Petitioner contends that a prior art reference discloses this negative

limitation if it lacks one of these three things. Reply 2. We agree with Petitioner that the explicit language of the claim itself recites “without requiring” (1) “registration,” (2) “with a conference call server,” and (3) “by the potential members including the first party and the at least one other party,” and that a reference lacking one of these things discloses this negative limitation. *See* Ex. 1001, 12:18–21.

With respect to Hamberg, Petitioner contends that the Board’s preliminary construction does not encompass Hamberg, because Hamberg specifically requires registration with a conference call server for the requested conference call service. Reply 4–5. We agree with Petitioner. When describing Hamberg during prosecution, Patent Owner stated to the Examiner that “the conference call [of Hamberg] is set up between persons registered to the group at the conference call server which establishes the conference call.” Ex. 1018, 113. Patent Owner distinguished the invention from Hamberg by explaining that “current participants of the IM session (or other potential members) need not have registered, e.g., *with the conference call server that establishes the conference call*, in order to be potential members for the voice communication” Ex. 1018, 114 (emphasis added).

With respect to the alleged disclaimer, Patent Owner contends that “the disclaimed form of registration disclosed in the ’194 Patent . . . simply involved checking stored information ‘to see whether a user is or is not already [registered as] a subscriber’ to the requested conference call service.” PO Resp. 28 (citing Ex. 1018, 124 (Advisory Action mailed May 31, 2012)). According to Patent Owner, requiring confirmation of whether a potential participant is or is not currently registered as a subscriber to the requested call service (which is based on already existing registration

information) is excluded by the claim language “without requiring registration with a conference call server.” PO Resp. 28. In an amendment preceding the cited Advisory Action of May 31, 2012, Applicant amended the claim to recite “without requiring . . . prior registration with a conference call server.” Ex. 1018, 106. We understand Patent Owner to assert that, through prosecution history disclaimer, the claim term “without requiring registration” should be read to mean “without requiring . . . prior registration,” in light of the Examiner’s comments in an Advisory Action addressing “without requiring . . . prior registration.” See PO Resp. 28; Ex. 1018, 124.

For prosecution history disclaimer to apply and thereby result in a narrowing of the breadth that the claim would have otherwise, the disavowal of claim scope must be unambiguous, clear, and unmistakable to one of ordinary skill in the art. *Elbex Video, Ltd. v. Sensormatic Elecs. Corp.*, 508 F.3d 1366, 1371 (Fed. Cir. 2007) (citations omitted). With respect to this form of registration cited during prosecution, Patent Owner is identifying a statement from the Examiner made in the Advisory Action, about a claim term rejected by the Examiner and deleted from the claims by Applicant, and not recited in the issued claims of the ’194 patent. See PO Resp. 28 (citing Ex. 1018, 124). In particular, the Examiner found that the claim term “without requiring . . . prior registration” was “not described and supported in the specification” because the application “plainly points out that ‘prior registration’ takes place.” Ex. 1018, 124. In the next Office Action, the Examiner rejected the claims because the term “prior” rendered the claims indefinite. Ex. 1018, 82. Applicant deleted “the term ‘prior’ . . . from the claims in order to address the Examiner’s concerns” and overcome the

rejection. Ex. 1018, 70. The Examiner then allowed the claims without providing a Statement of Reasons for Allowability. Ex. 1018, 50. As a result of the Examiner's rejection and Applicant's amendment, claim 1 of the '194 patent recites "without requiring registration," not "without requiring . . . prior registration."

The record does not indicate an unambiguous narrowing of claim scope associated with "without requiring registration" to mean "without requiring prior registration." Rather, the record indicates (a) that the Examiner would not allow a claim that recited "without requiring . . . prior registration" (Ex. 1018, 124, 82), (b) that applicant deleted "prior" from the claims "in order to address the Examiner's concerns" (Ex. 1018, 70), and (c) as a result, the language of claim 1 does not include the limitation proposed by Patent Owner. Contrary to Patent Owner's arguments, the evidence does not support a finding that the Examiner allowed the claims because of a prosecution history disclaimer. We do not find sufficient evidence that the claim language or a prosecution history disclaimer requires "without requiring registration" to mean "without requiring prior registration." We conclude that there was not an unambiguous, clear, and unmistakable prosecution history disclaimer evident to one of ordinary skill. *Elbex Video*, 508 F.3d at 1371. We determine Patent Owner's contention that claim 1 encompasses "without requiring prior registration," is not commensurate with the scope of claim 1.

Even if we were to agree with Patent Owner that the prosecution history shows the claimed "without requiring registration" means "without requiring prior registration," this limitation would still encompass requiring prior registration, or any registration, with a server other than a "conference

call server.” See Ex. 1001, 12:18–19. During prosecution, Applicant explained to the Examiner that users of the claimed system *did not need to register with the present IM session or any associated group* to be joined to a conference call, because the system would “be aware of the on-going IM session, such that the software would determine the list of conference call targets from the list of parties presently in the IM session.” See Pet. 18 (citing Ex. 1018, 111–15, 134–36) (emphasis added). Applicant explained that conference calls of the invention would be created between users “*without the necessity of each user to dial a telephone number or having the host look up the phone number of each participant in order to place an outbound telephone call,*” because the “invention may collect, through a variety of means, the information needed to join those users into a telephone conference call, *pass the dialing information and other parameters to a central server,* and send an invitation to each participant in advance of placing the call.” Ex. 1018, 112 (quoting Ex. 1001, 4:12–28) (emphasis added).

Petitioner highlights that during prior litigations involving the ’194 patent, Patent Owner asserted that “without requiring registration with a conference call server” as recited in claim 1 should be construed as “separate registration with a conference call server is not required to initiate voice communication between current participants of an instant message session.” Pet. 18–19 (citing Ex. 1019, 6; Ex. 1020, 14; Ex. 1021, 9 (Uniloc explaining that “[t]he claim is thus silent with respect to registration for the IM session . . . [I]f someone is a ‘current participant’ of an IM session, then that individual must have provided at least *some* information to the *IM system*”)). We determine that the claim language does not exclude registration by

the potential members, as long as the registration is not “with a conference call server.”

With respect to Patent Owner’s contention that the Examiner, during prosecution, considered the registration disclosed by Liversidge, Patent Owner relies on paragraph 32 of the declaration of Mr. Easttom. PO Resp. 26–27 (citing Ex. 2001 ¶ 32). However, the cited paragraph does not identify where the Examiner considered Liversidge. In fact, the cited paragraph does not mention Liversidge at all. In addition, Petitioner contends that Patent Owner is incorrect, because Liversidge does not require registration “with a conference call server.” Reply 3. We agree with Petitioner, that Liversidge does not require registration with a conference call server, for the reasons discussed in our obviousness analysis below.

Patent Owner contends that the Board did not explain the meaning of an additional or separate registration. PO Resp. 27–28. Petitioner contends that Patent Owner itself used the term “separate” to describe “without requiring” as claimed in prior litigation, stating that “without requiring” should be construed to mean “separate registration with a conference call server is not required to initiate voice communication between current participants of an instant messaging session.” Reply 4 (citing Pet. 18–19; Ex. 1019, 7). Petitioner contends that Patent Owner cannot credibly state that it is unable to discern the meaning of “additional or separate registration.” Reply 4. We agree with Petitioner.

We adopt our previous construction of “without requiring registration with a conference call server for establishing the voice communication by [the] potential members including the first party and the at least one other party” from the Decision to Institute as stated above.

without requiring individual selection

Patent Owner contends that “without requiring individual selection of potential members including the first party and the at least one other party” as recited in claim 1 should be construed to mean without selectively adding new invitees who are not currently registered as team members. PO Resp. 29–30. Patent Owner presents a similar contention for “request lacking a specific indication of the at least one other party” as recited in claim 6. *Id.* Petitioner contends that these terms do not need to be construed to resolve a controversy. Reply 7.

Considering the claim as a whole, the claim recites “an option to automatically initiate voice communication between the current participants of the IM session without requiring individual selection of potential members” of the voice communication. Therefore, the “individual selection” that is not required is for potential members of the voice communication, not for potential members of the IM session. We determine the claim does not exclude individually selecting members of the IM session. We determine no further construction of this term is necessary to resolve a dispute in this proceeding.

said display for the first party

Petitioner contends antecedent basis for “said display for the first party” recited in each of claims 4, 9, and 14, should be construed as “display for the first party an option” recited in independent claims 1, 6, and 11. Pet. 20. In the Decision to Institute, we adopted Petitioner’s construction. We adopt it again here.

We further determine that no other terms require express construction for this Final Written Decision because we need only construe terms “that

are in controversy, and only to the extent necessary to resolve the controversy.” *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

B. Obviousness Over Liversidge and Beyda

Petitioner, relying on the Declaration of Stuart Lipoff (Ex. 1002), challenges claims 1–16 as obvious over the combination of Liversidge and Beyda. Pet. 20–60.

1. Liversidge (Ex. 1004)

Liversidge relates to a virtual team environment that facilitates collaboration among geographically dispersed team members using a distributed application. Ex. 1004 ¶ 3. Communications sessions are automatically set up by the collaboration services suite in response to request messages generated by a virtual team environment (VTE) client when a team member initiates a communications session request using a graphical user interface (GUI). Ex. 1004, Abstract. Team members require no knowledge of another team member's communications device address in order to initiate a communications session. *Id.* A collaboration services suite “includes a VTE server that communicates with the VTE clients, a presence engine that collects and maintains a status of communications devices specified in a current profile of the team member,” and “a call server for handling setup and control of a voice component of each communications session completed.” *Id.*

Figure 2 of Liversidge is reproduced below.

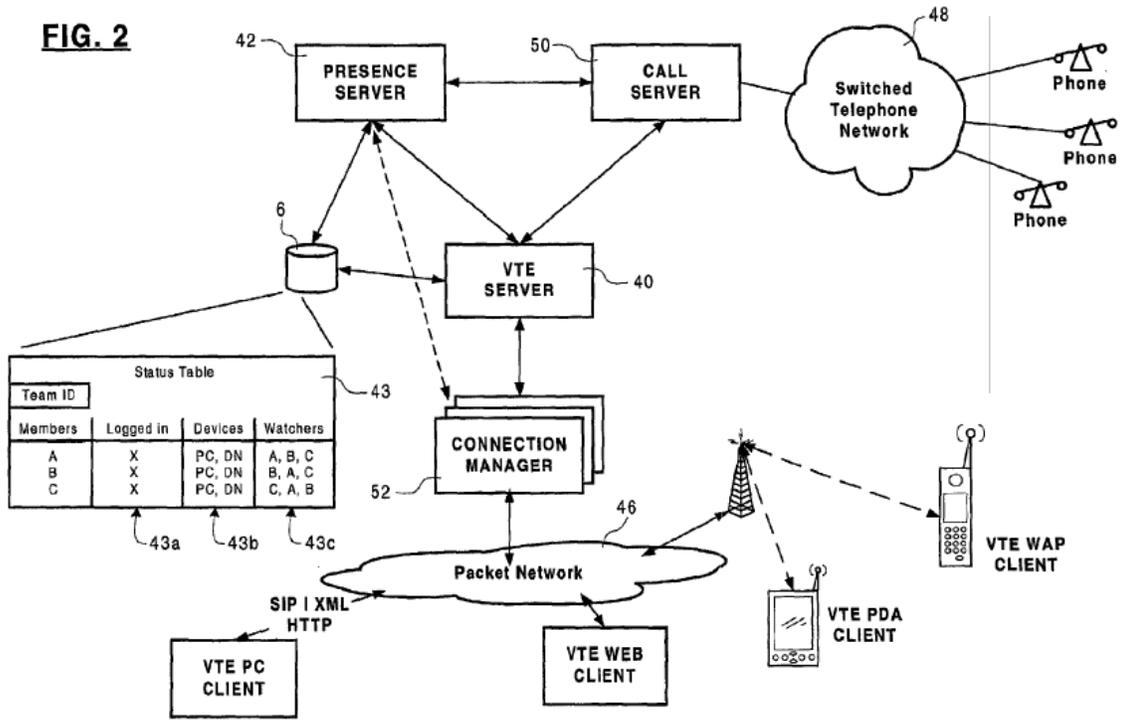


Figure 2 above shows a block diagram illustrating a system for implementing a collaborative services suite, including VTE server 40, presence server 42, and database 6. Ex. 1004 ¶ 65. Each VTE client can be a communications device such as a telephone, a personal computer, a personal digital assistant, or another messaging device. *Id.* VTE server 40 controls interaction between the collaboration services suite and communications devices associated with each team member. *Id.* Presence server 42 maintains status table 43, which indicates whether a respective team member is currently logged-in to the collaboration services suite. *Id.* ¶¶ 66–67. Call server 50 facilitates interaction between VTE server 40, presence server 42, and public switched telephone network (PSTN 48). *Id.* ¶ 68. Similarly, connection manager 52 facilitates protocol-independent

messaging between VTE server 40 and packet-based communications devices associated with the VTE clients. *Id.*

Figure 21 of Liversidge is reproduced below.

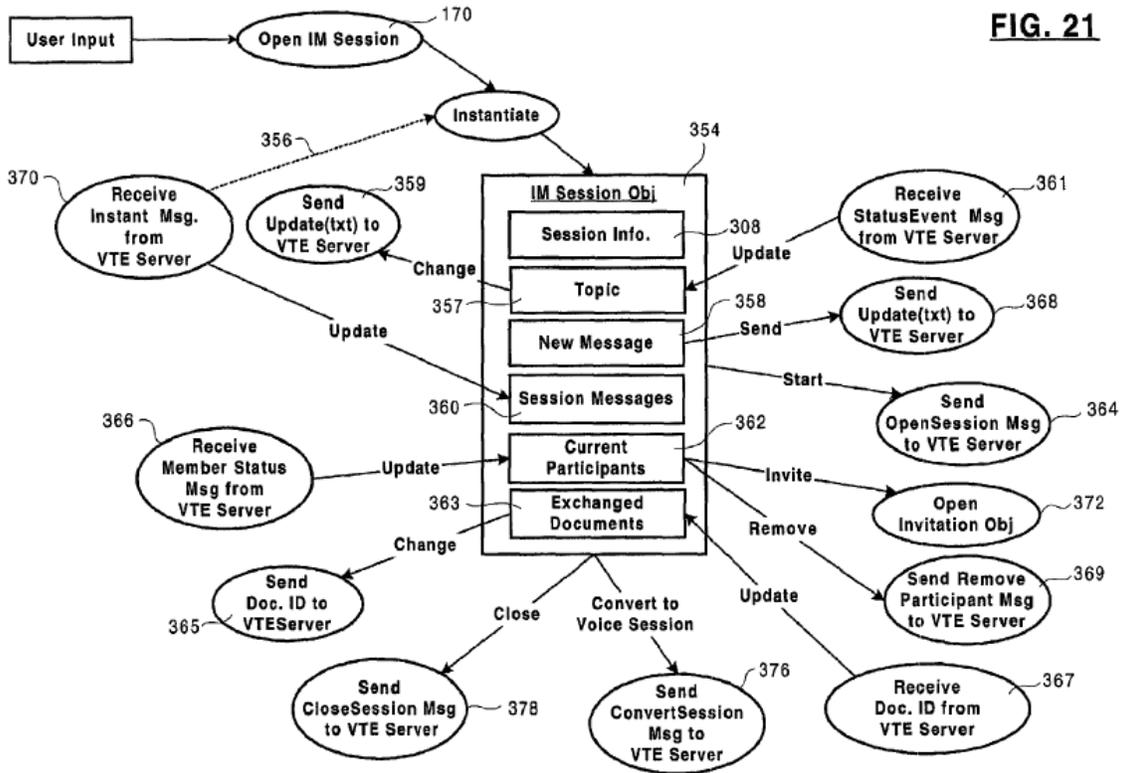


Figure 21 above shows a block diagram schematically illustrating functionality associated with an Instant Messaging Session Object instantiated by a VTE client application in respect of an Instant Messaging communications session. Ex. 1004 ¶ 44. IM session object 354 serves as a container for information regarding an instant messaging session, such as session information 308, “new message 358 entered by the team member for transmission to other participants of the IM session, a record of session messages 360 previously exchanged between participants in the IM session, and a listing 362 identifying each of the current participants in the IM session.” *Id.* ¶ 121. The current session participants may terminate the

instant messaging session and continue the conversation using as alternative type of communication such as voice. *Id.* ¶ 126. An appropriate icon or button, such as a convert session button, enables the team member to launch convert session message 376 to facilitate converting the session to the desired type of communication. *Id.*

2. *Beyda (Ex. 1028)*

Beyda relates to a system for multimedia telephony-over-LAN conferences. Ex. 1028 ¶ 3. The system includes an instant messaging (IM) server and a VoIP server, and a plurality of system clients having both VoIP and IM sub-clients. Ex. 1028, Abstract. The system clients can log on to their respective servers in parallel. *Id.* The IM server and the VoIP server can communicate lists of common participants and allow for IM conferences among at least subsets of the system clients while an audio or video teleconference is ongoing. *Id.*

3. *Analysis of Claims 1–16*

a. *Analysis of independent claims 1, 6, and 11*

The preamble of claim 1 recites a “non-transitory computer readable medium containing computer instructions configured to operate with electronic computer hardware to perform the following steps.” Petitioner contends that a “non-transitory computer readable medium” recited in the preamble of claim 1 is inherent in *Liversidge*, but addresses this issue as a matter of obviousness in light of *Beyda*. Pet. 20–23.

Petitioner contends *Liversidge* discloses “VTE client[s] 4” that may include “one or more communications devices, such as personal computers (PCs),” and that PCs include computer hardware and memory. Pet. 20–21 (citing Ex 1004 ¶¶ 63–65; Ex. 1022, 210–11). Petitioner contends

Liversidge discloses installing a VTE client application on the communications device, but does not explicitly state that the installed application program is stored in memory. Pet. 21 (citing Ex. 1004 ¶ 108). Petitioner contends Beyda discloses storing software for implementing clients on a disk drive or memory of a computer in a known manner. Pet. 22 (citing Ex. 1028 ¶¶ 33–34, 42; Ex. 1002 ¶ 67). Petitioner contends a person of ordinary skill in the art would have stored the VTE client of the communications device taught by Liversidge in a memory of the device as taught by Beyda for the benefit of allowing subsequent and repeated access to relevant information. Pet. 22–23 (citing Ex. 1004 ¶ 108; Ex. 1028 ¶¶ 33–34; Ex. 1022, 209–11; Ex. 1023, 336, 339; Ex. 1002 ¶ 68).

We determine that storing the VTE client of Liversidge in a memory of a communications device using the known manner taught by Beyda does no more than yield the predictable results of installing the VTE client on the communications device, allowing subsequent and repeated access to relevant information. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

Claim 1 recites “display, in an instant messaging (IM) chat window of a first party, an exchange of IM messages between the first party and at least one other party, the first party and the at least one other party being current participants to an IM session.” Claims 6 and 11 recite a similar limitation. Petitioner contends this limitation is disclosed by Liversidge’s description of displaying a record of session messages 360 previously exchanged between participants in an IM session. Pet. 23–25 (citing Ex. 1002 ¶¶ 69, 70, 111, 125, Fig. 21 (session messages 360)).

Based on Petitioner's contention and evidence, we find that Liversidge teaches this limitation.

Claim 1 recites "display for the first party an indication of whether the at least one other party is communicably connected to the IM session." Claims 6 and 11 recite a similar limitation. Petitioner contends this limitation is disclosed by Liversidge's description of presence icons that display presence and status information of current participants in an IM session, including whether a particular user is logged-in to the collaboration services suite, and whether the user is idle. Pet. 25–26 (citing Ex. 1004 ¶¶ 67, 83, 106, 121, 123).

Based on Petitioner's contention and evidence, we find that Liversidge teaches this limitation.

Claim 1 recites "display for the first party an option to automatically initiate voice communication between the current participants of the IM session." Claims 6 and 11 recite a similar limitation. Petitioner contends this limitation is disclosed by Liversidge in describing a convert session button to automatically initiate voice communication between current participants of an IM session. Pet. 26–28 (citing Ex. 1004 ¶¶ 126, 176–181, Fig. 21).

Based on Petitioner's contention and evidence, we find that Liversidge teaches this limitation.

Claim 1 recites "without requiring individual selection of potential members including the first party and the at least one other party." Claims 6 and 11 recite a similar limitation. Petitioner reads this limitation on Liversidge's description of three users converting an overly complex IM discussion into a voice communications session, with a team member using

VTE client A (the first party) to initiate a convert session message, which causes the VTE client A to formulate a convert session message. Pet. 28 (citing Ex. 1004 ¶ 176). According to Petitioner, the first party does not select individual participants, rather, the VTE server determines the participants of the current IM session using a session ID provided by the convert session message. *Id.*

Patent Owner contends that Petitioner, in addition to relying on paragraph 176 of Liversidge, also relies on paragraph 134 of Liversidge. PO Resp. 29. Patent Owner, relying on testimony of Mr. Easttom, contends paragraph 134 requires a user to select each person. PO Resp. 29–30 (citing Pet. 30; Ex. 1004 ¶ 134; Ex. 2001 ¶¶ 35–36). Mr. Easttom quotes one sentence from this paragraph, and concludes Liversidge requires selection. Ex. 2001 ¶¶ 35–36. The quoted paragraph states “the invitation object 374 includes a directory search frame 422 which provides access to one or more directories enabling the user to identify and *select* each person to whom they wish to direct the invitation.” Ex. 2001 ¶ 35 (quoting Ex. 1004 ¶ 134) (emphasis in original).

However, paragraph 134 discloses that invitation object 374 allows a user to “invit[e] one or more new participants to join an active communications session,” where the communications session can be an IM session, a voice session, or a multi-media session. In our claim construction above, we determined the “individual selection” that is not required is for potential members of the voice communication, not for potential members of the IM session, and that the claim does not exclude individually selecting members of the IM session. To the extent Petitioner relies on paragraph 134

to teach selecting and inviting new participants to join an IM session, this teaching is within the scope of claim 1.

Further, the Petition cites to paragraph 176 of Liversidge to teach “without requiring individual selection of potential members” of the voice communication. Paragraph 176 discusses an example of converting an existing IM session into a voice session. Patent Owner’s contention does not address this teaching of Liversidge. In particular, Patent Owner does not persuasively explain how converting an IM session into a voice session as discussed in paragraph 176 of Liversidge requires the user to individually select potential members of the voice communication.

Based on Petitioner’s contention and evidence, we find that Liversidge teaches this limitation.

Claim 1 recites “without requiring registration with a conference call server for establishing the voice communication by the potential members including the first party and the at least one other party.” Claims 6 and 11 recite a similar limitation. Petitioner contends this limitation reads on Liversidge’s description of converting an IM session to a new communications type and joining all current participants of the IM session to the new communication session, without any additional registration. Pet. 29–32 (citing Ex. 1004 ¶¶ 117–120, 125–126, 176–181). According to Petitioner, the user information of Liversidge is not obtained by requiring registration with a conference call server, but rather, is obtained from VTE server 40, which is aware of the on-going IM session, and uses the session ID included in the convert session message to determine the participants of the current IM session. Pet. 29 (citing Ex. 1004 ¶ 176).

Patent Owner contends that Petitioner's statement, that "the user information of Liversidge . . . is obtained from VTE server 40" (PO Resp. 31 (citing Pet. 29)), "at least tacitly admits that Liversidge's VTE server also requires a registration process" (PO Resp. 32). We disagree with Patent Owner. The next sentence in the Petition states that

[t]his description in Liversidge accords with Applicant's discussion of the 'without requiring registration' limitation during prosecution, in which Applicant explained that one way of initiating communication without users "need[ing] to register" would be for the IM service (i.e., VTE server 40) . . . "to be aware of the on-going IM session, such that the software would determine the list of conference call targets from the list of parties presently in the IM session."

Pet. 29–30 (citing Ex. 1018, 134–36; Ex. 1002 ¶¶ 80–84). We agree with Petitioner that Liversidge's teaching of a VTE server obtaining user information accords with Applicant's discussion of the IM service determining a list of conference call targets from the list of parties presently in the IM session, and we do not agree with Patent Owner's assertion that Petitioner admits the VTE server requires registration.

Patent Owner contends that the Petition concedes that the VTE server of Liversidge is a conference call server, by stating that VTE server 40 "initiate[s] the voice communication session between the current participants of the IM session." PO Resp. 31 (quoting Dec. Inst. 17; Pet. 32–33; Ex. 1004 ¶¶ 176–181). To the contrary, Petitioner contends that VTE server 40 is not a conference call server. Reply 13. Petitioner contends "[c]all server 50 facilitates interaction between VTE server 40, presence server 42, and public switched telephone network (PSTN 48)." Reply 13–14 (quoting Dec. Inst. 11, Ex. 1004 ¶ 68). We agree with Petitioner and find that call server 50, not VTE server 40, teaches a conference call server as claimed,

because call server 50 controls the switch network 48 to place call connections to the telephones to initiate the voice communication. Ex. 1004, Fig. 2, ¶ 68.²

Patent Owner contends that the VTE server of Liversidge requires a registration process. PO Resp. 30–34 (citing Dec. Inst. 15, 17; Pet. 29–33; Ex. 1004 ¶¶ 175–181). Patent Owner contends that in “every passage of Liversidge cited in the Petition, at a minimum, only a user who is registered as a team member with the VTE server . . . may initiate a communication session.” PO Resp. 32. Patent Owner’s contention that the VTE server requires registration is based on the premise that VTE server 40, not call server 50, is the conference call server, which we find unpersuasive as discussed above.

Even if we were to accept Patent Owner’s premise that the VTE server, not the call server, is the conference call server, Petitioner contends that Liversidge allows users to communicate not only with their team members but also with other persons who may not be a member of the team. Pet. 31 (citing Ex. 1004 ¶¶ 82, 134–135); Reply 11. According to Petitioner, an IM session that includes both team members and non-team members can be converted to voice communication by clicking the convert session button. Pet. 32 (citing Ex. 1004 ¶¶ 126, 176); Reply 12–13 (citing Pet. 11; Ex. 1004, Fig. 32, ¶ 176). Mr. Lipoff testifies that an IM session participant can launch a voice communication between the current participants of an IM

² Our finding is consistent with our finding in the Final Written Decision of related IPR2017-00597, where we found that a telecommunications network server was a conference call server because it controlled the public phone switch to place telephone call connections to the telephones in order to initiate the voice communication.

session, regardless of whether those participants are members of a team or not, by clicking on the convert session button, and the VTE server then determines the participants of the current IM session. Ex. 1002 ¶¶ 83–84 (citing, *inter alia*, Ex. 1004 ¶¶ 125, 126). The supporting paragraphs of Liversidge describe inviting another person, who may or may not be a member of the team, to join an IM session (Ex. 1004 ¶ 125 (An IM participant may “invite another person (who may or may not be a member of the team) to join the IM session.”), and also describe providing a convert session button to cause the IM session to terminate and continue the conversation using voice communication (Ex. 1004 ¶ 126 (The “current session participants [can] terminate the instant messaging session and continue the conversation” as voice communications, by using a convert session button.)).

Patent Owner contends that, in every passage of Liversidge cited in the Petition, only a registered team member, not a non-team member, may initiate a communication session. PO Resp. 32–33. According to Patent Owner, Liversidge does not teach “without requiring registration,” because the scope of “without requiring registration . . . by the potential members including the first party and the at least one other party” as claimed encompasses not requiring registration by either the requesting “first party,” or “the at least one other party,” and Liversidge requires registration by the “first party.” PO Resp. 32. However, Patent Owner does not propose a construction of “potential members including the first party and the at least one other party,” other than this conclusory contention. *See id.* Claim 1 does not recite “without requiring registration by either the first party or the at least one other party.” Claim 1 recites “without requiring registration” by

“the first party *and* the at least one other party.” We decline to change the claimed “and” into “or” as argued by Patent Owner. The scope of this limitation encompasses without requiring registration by the at least one other party. We determine that Liversidge’s disclosure of inviting a person who is not a member of a team to join an IM session, and using a convert session button to convert the IM session into a voice session, teaches “without requiring registration” by “the at least one other party” as claimed.

Patent Owner contends Liversidge discloses that only team members can be part of a conversion from an IM session to a voice session. PO Resp. 33. Patent Owner, relying on testimony of Mr. Easttom, contends that paragraph 176 of Liversidge identifies all those participating in the IM session as team members who must each be registered with the VTE server in order to be part of the conversion from an IM session to the voice session. PO Resp. 33 (citing Ex. 1004 ¶ 176; Ex. 2001 ¶ 91).

However, contrary to Patent Owner’s contention, paragraph 91 of Mr. Easttom’s declaration does not state that paragraph 176 of Liversidge discloses that only team members can be part of a conversion from an IM session into a voice session. Rather, Mr. Easttom testifies that “Petitioner appear to be identifying selection and non-selection features from different embodiments and arguing that individually they satisfy the claims.” Ex. 2001 ¶ 91. The issue raised by Mr. Easttom, whether the selection and non-selection features of Liversidge are from different embodiments, is separate from whether Liversidge discloses that only team members can be a part of a conversion from an IM session into a voice session. We do not agree with Patent Owner, that paragraph 91 of Mr. Easttom’s declaration supports Patent Owner’s contention that paragraph 176 of Liversidge teaches

that only users who are team members can be part of a conversion from an IM to a voice call.

We do not agree with Mr. Easttom, that the selection and non-selection features of Liversidge are from different embodiments. We find paragraph 176 of Liversidge emphasizes that it is describing an example of converting a session, with phrases like “[a]s described above” and “[b]y way of example.” The example of paragraph 176 is consistent with, not a different embodiment from, paragraphs 125, 126, and 134. Even so, the relevant inquiry is whether the claimed subject matter would have been obvious to those of ordinary skill in the art in light of the combined teachings of the references. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). We agree with Petitioner, that paragraphs 125, 126, and 134 of Liversidge teach that non-team members can be part of an IM session, and the participants of the IM session, including non-team members, can be part of a conversion to voice communication.

Even if only team members are involved in the conversion process as described in paragraph 176 of Liversidge, Petitioner contends that the convert session function disclosed in this paragraph and shown in Figure 32 of Liversidge teaches that the translate step 1138 performed by the VTE server does not require the team members to reenter any registration information. Reply 12–13 (citing Pet. 29–32; Ex. 1004 ¶ 176, Fig. 32).

Paragraph 176 discloses that

[d]uring the Instant Messaging session between the three team members, it is decided that the discussion is becoming too complex to be efficiently handled through an Instant Messaging session. The team members therefore agree to convert to a voice communications session and the team member using VTE client (A) initiates a ConvertSession message On receipt of the

message, the VTE server translates the session ID (step 1138) to determine the session type and the participants. The VTE server then closes the Instant Message session (step 1140) and sends StatusEvent messages to the respective GUIs to remove the Instant Message session from the session display window in steps 1142-1150. Status information may also be sent to the Presence Server (not shown) as explained above. The VTE server then translates (step 1152) the personal identifiers associated with the respective team members to determine the dialed numbers of a preferred telephone device associated with each team member, as explained above

Ex. 1004 ¶ 176. We determine Liversidge teaches that after an IM participant initiates a convert session message, the VTE server determines the dialed numbers of a telephone associated with each IM participant, without requiring an additional or separate registration by the current IM participants, then the system uses the dialed numbers to ring the associated telephones and join the members in voice communications. *Id.* at ¶¶ 176–181. We determine that the convert session function disclosed in paragraph 176 and Figure 32 of Liversidge teaches “current participants of an IM session are not required to complete an additional or separate registration with a conference call server before establishing voice communication between current participants of the IM session.”

Patent Owner contends that Petitioner’s argument that registering with a team is not required in Liversidge is immaterial, because the claim language defines the “option to automatically initiate voice communication” in terms of “without requiring individual selection of members.” PO Resp. 33–34 (citing Ex. 2001 ¶ 89), 39–40 (citing Ex. 2001 ¶ 95). Mr. Easttom testifies that paragraph 134 of Liversidge discloses that the user is enabled “to identify and select each person to whom they wish to direct the invitation,” including non-team members. Ex. 2001 ¶ 89 (quoting Ex. 1004

¶ 134). According to Patent Owner, “Petitioner impermissibly points to both a non-selection embodiment and a separate selection embodiment in Liversidge” PO Resp. 40.

Paragraph 134 of Liversidge discloses that a user can invite a non-member to join an active communications session, such as an IM session, a voice session, or a multi-media session. Patent Owner is correct that paragraph 134 teaches a user selecting a person to invite to a communications session, but does not address the additional teaching in this paragraph that the communications session can be an IM session. Considering the claim as a whole, the claim recites “an option to automatically initiate voice communication between the current participants of the IM session without requiring individual selection of potential members” of the voice communication. The “individual selection” that is not required is for potential members of the voice communication. The claim does not exclude individually selecting members of the IM session. Patent Owner’s contention is not commensurate with the scope of the claim.

Also, as discussed above, we do not agree with Patent Owner nor Mr. Easttom that paragraph 134 of Liversidge, which teaches selecting participants to join an IM session, is a separate embodiment from paragraph 176 of Liversidge, which teaches converting an IM session into a voice session. Paragraph 134 teaches that the non-member who is invited to join the IM session is an “individual for whom appropriate contact information is available.” Paragraph 176 teaches converting the IM session into a voice session. We agree with Petitioner, that the resulting voice session would include the non-member from the IM session, given that “appropriate contact information is available” for the non-member, and that Patent Owner

does not persuasively explain otherwise. *See* Reply 12, 17–18 (citing Pet. 28–33; Ex. 1004 ¶¶ 82, 134–135, 176; Ex. 1002 ¶¶ 82–83).

Patent Owner contends that paragraph 100 of Liversidge teaches a registration process that is virtually identical to Hamberg’s registration requirement. PO Resp. 34–38 (citing Ex. 1004 ¶ 100, Fig. 14; Ex. 2001 ¶¶ 78–88). Patent Owner, relying on testimony of Mr. Easttom, contends that paragraph 100 of Liversidge uses the word “registration,” and describes locating registration information on a database connected to a server that establishes the voice communication. PO Resp. 34–38 (citing Ex. 1004 ¶ 100, status table 43 of Fig. 2, Fig. 14; Ex. 2002, Figs. 2 and 3; Ex. 1013 ¶ 23; Ex. 2001 ¶¶ 80–87). Mr. Easttom testifies that members register in status table 43 of Liversidge. Ex. 2001 ¶¶ 80–88 (citing Ex. 1004 ¶ 100, Figs. 2 and 14). Although Patent Owner’s contention does not specify which server maintains status table 43, Patent Owner’s contention appears based on the premise that VTE server 40 maintains status table 43.

Petitioner contends that even if registration occurs, the registration does not occur with a conference call server (i.e., the VTE server). Reply 14. Petitioner contends presence server 42, not VTE server 40, maintains status table 43. *Id.* Petitioner contends that paragraph 100 and Figure 14 of Liversidge disclose that presence server 42 instantiates a status table and populates the status table with information, and that VTE server 40 acts as a messenger between a user and presence server 42. Reply 15–16 (citing Ex. 1004 ¶ 100, Fig. 14). Petitioner also contends that Liversidge discloses presence server 42 may alternatively obtain information from users directly, through packet network 46, without using VTE server 40 as a messenger. Reply 14–15, 16 (citing Ex. 1004 ¶ 66).

Paragraph 67 of Liversidge discloses that presence server 42 maintains status table 43 for controlling the detection and propagation of team member status and availability information. Paragraph 100 of Liversidge discloses

Upon receipt of the CreateTeam message 228, the VTE server 40 . . . forwards the CreateTeam message (at 230) to the Presence Server 42. Upon receipt of the CreateTeam message 230, the *Presence Server 42 instantiates a status table 43 respecting the new team.* The VTE server 40 can then send an AddTeamMember message 232 to *the Presence Server 42, which responds to the AddTeamMember message 232 by populating the status table 43 with information (e.g. the personal identifier and communications information) respecting the team creator (i.e. the user of VTE client (A) 4a).* Upon successful creation of the status table 43 and registration of the team creator as a team member, the Presence Server 42 returns a StatusEvent message 234 to the VTE server 40 Upon receipt of the InvitationResponse message 266, the VTE server 40 forwards an AddTeamMember message 268 to *the Presence Server 42 in order to update the status table 43 with appropriate information (e.g. a personal identifier and communications information, if available) respecting the user of VTE client (B).* *The Presence Server 42 then returns a StatusEvent message 270, indicating successful registration of the new team member in the status table 43, to the VTE server 40*

Ex. 1004 ¶ 100 (emphases added). Paragraph 100 of Liversidge discloses that the presence server instantiates the status table, populates the status table, updates the status table, and indicates successful registration in the status table. We agree with Petitioner that paragraph 100 of Liversidge discloses that the presence server, not the VTE server, registers a team member in the status table.

Paragraph 66 of Liversidge discloses that presence server 42 detects the current operational status of each of the communication devices in a

current profile, and stores the detection result within a database. The presence server can interact with packet-based communication devices through a packet network to receive status update messages and determine presence information. *Id.* We agree with Petitioner that paragraph 66 of Liversidge teaches the presence server can obtain information directly from a user's packet-based communication device, through a packet network.

Petitioner highlights that, in the Decision to Institute, we found “[s]tatus table 43, with team members A, B, and C shown in Figure 2 of Liversidge, is maintained by presence server 42, not call server 50.” Reply 14 (citing Dec. Inst. 15; Ex. 1004 ¶ 67). Petitioner contends that this “statement is completely ignored and unchallenged in Patent Owner’s Response. Indeed, the Patent Owner’s Response never once mentions this statement by the Board, and provides no discussion as to ‘presence server 42’ or ‘call server 50.’” Reply 14. We agree with Petitioner, that Patent Owner’s Response has not addressed our finding that presence server 42 maintains status table 43.

At the hearing, Patent Owner seemed to argue that presence server 42 is located within VTE server 40 in the form of a presence manager shown in Figure 5 of Liversidge. *See* Trans. 29:20–31:13 (“So the VT server has a presence manager, for example. That’s part of its functionality that’s actually drawn inside of the box of what’s of the description of the VT server.”). Patent Owner, however, did not make this argument in its Response, so this argument is not timely. Even if we were to accept this argument as timely, Patent Owner has not adequately explained how presence manager 72 shown in Figure 5 is, or functions as, presence server 42 shown in Figure 2. To the contrary, Liversidge discloses that “the

presence manager 72 instantiates a Presence Server interface 92 facilitating interaction between the VTE server 40 and the Presence Server 42 using a suitable messaging protocol, such as, for example, session initiation protocol (SIP).” Ex. 1004 ¶ 74. Contrary to Patent Owner’s contention, a presence manager instantiating an interface to facilitate interaction between the VTE server and the presence server is not performing the functionality of the presence server. Rather, the description of the presence manager in Liversidge shows that the VTE server and the presence server are separate servers, because they need an interface and a messaging protocol to interact with each other.

Patent Owner contends that both Hamberg and Liversidge rely upon a conference call server performing a registration check by accessing registration information in order to convert an outgoing IM session to a voice communication session. PO Resp. 38. However, “accessing registration information” is within the scope of the claim, read in light of the specification. The ’194 patent discloses that the “invention may collect, through a variety of means, the information needed to join those users into a telephone conference call, *pass the dialing information and other parameters to a central server*, and send an invitation to each participant in advance of placing the call.” Ex. 1001, 4:12–28 (emphasis added); *see* Ex. 1018, 112 (quoting Ex. 1001, 4:12–28). Patent Owner’s contention is inconsistent with the ’194 patent’s disclosure of using presence information and stored address information to create a conference call (Ex. 1001, 4:12–28) and is not commensurate with the scope of the claim.

Based on Petitioner’s contentions and evidence, we find that Liversidge teaches “without requiring registration with a conference call

server for establishing the voice communication by the potential members including the first party and the at least one other party.”

Claim 1 recites “request, in response to selection of the option, voice communication between the first party and the at least one other party.” Claims 6 and 11 disclose a similar limitation. Petitioner contends this limitation is disclosed by Liversidge in describing automatically setting up communications sessions in response to request messages generated by the VTE client when a team member initiates a communications session request. Pet. 32 (citing Ex. 1004, Abstract, ¶¶ 126, 176). According to Petitioner, the communications session request is in the form of the convert session message that provides a session ID and a new session type used by the VTE server to initiate the voice communication session between participants of the IM session. Pet. 32–33 (citing Ex. 1004 ¶¶ 176–181).

Based on Petitioner’s contention and evidence, we find that Liversidge teaches this limitation.

Claim 1 recites “wherein in response to the request, the voice communication is established between the first party and those of the at least one other party.” Claims 6 and 11 recite a similar limitation. Petitioner contends this limitation is disclosed by Liversidge in describing VTE server 40 formulating and sending a make call message in response to the convert session message to a public switched telephone network (PSTN) virtual switching point, causing each current participant to be called and conferenced with a conference bridge. Pet. 33 (citing Ex. 1004, Abstract, ¶¶ 141, 176–181).

Based on Petitioner’s contention and evidence, we find that Liversidge teaches this limitation.

The combination of Liversidge and Beyda teaches each limitation of claim 1. Petitioner has introduced persuasive evidence that a person of ordinary skill in the art would have had reasons to combine the teachings of those references to arrive at the claimed subject matter and that the proposed combination would have yielded predictable results. We have fully considered all of Patent Owner's arguments and evidence in response, but do not find them persuasive, for the reasons given in our analysis above. We conclude that Petitioner has shown by a preponderance of the evidence that the subject matter of independent claims 1, 6, and 11 would have been obvious over the combination of Liversidge and Beyda.

b. Analysis of dependent claims 2–5, 7–10, and 12–15

Claims 2, 7, and 12 recite “wherein the at least one other party comprises at least two parties.” Petitioner contends this limitation is disclosed by Liversidge in describing initiating a voice communication session between a first user A and two other users B and C via a conference bridge. Pet. 34 (citing Ex. 1004 ¶¶ 175–181).

Claims 3, 8, and 13 recite “said display an option comprising display of a click-on icon that allows for a single step selection of the option.” Petitioner contends this limitation is disclosed by Liversidge in describing a convert session button to automatically convert an IM session to another session type. Pet. 34–36 (citing Ex. 1006, Fig. 21, ¶¶ 44, 125, 126, 176).

Claims 4, 9, and 14 recite “wherein said display an exchange of IM and said display for the first party comprise display within a common browser or application window.” Petitioner contends this limitation is disclosed by Liversidge in describing a record of session messages and a

convert session option within the user interface of IM session object 354. Pet. 37 (citing Ex. 1004, Fig. 21, ¶¶ 122, 125, 126, 176).

Claims 5, 10, and 15 recite “wherein the voice communication includes audio and video.” Petitioner contends Liversidge discloses this limitation in describing a multi-media session such as video conferencing that uses streaming video and audio transmission. Pet. 40 (citing Ex. 1004 ¶¶ 70, 126, 133, 183–185).

Patent Owner does not offer specific and separate arguments for claims 2–5, 7–10, and 12–15, but rather relies on and references its earlier unpersuasive arguments for claim 1. PO Resp. 40–41. We have reviewed Petitioner’s explanations and supporting evidence regarding claims 2–5, 7–10, and 12–15, and determine that Petitioner, for reasons set forth in its analysis, has shown by a preponderance of the evidence that dependent claims 2–5, 7–10, and 12–15 are unpatentable under 35 U.S.C. § 103 over Liversidge and Beyda.

c. Analysis of independent claim 16

The preamble of claim 16 recites a “non-transitory computer readable medium containing computer instructions configured to operate with an electronic hardware computer server to perform the following steps.” Petitioner contends Liversidge describes a VTE server which performs communications functions, but does not explicitly discuss storing instructions for performing the functions in memory. Pet. 50 (citing Ex. 1004 ¶ 21; Ex. 1002 ¶¶ 122–25). Petitioner contends Beyda discloses storing information in memory. Pet. 50–51 (citing Ex. 1028, Abstract, Fig. 1, ¶¶ 29–31; 43–47, 50, 66). Petitioner contends that a person of ordinary skill in the art at the time of the invention would have used the storage

technique of Beyda to store instructions to perform the functions of the server of Liversidge for the benefit of permitting subsequent and repeated access to relevant information, with predictable results. Pet. 51–52 (citing Ex. 1002 ¶ 125).

We determine that using the storage technique of Beyda to store instructions to perform the functions of the VTE server of Liversidge does no more than yield the predictable results of permitting subsequent and repeated access to relevant information.

Claim 16 recites “exchange IM messages between a first party and at least one other party, the first party and the at least one other party being current participants to an IM session.” Petitioner contends Liversidge discloses this limitation in describing an active IM session between users A, B, and C. Pet. 52–53 (citing Ex. 1004 ¶¶ 65, 73, 118, 125, 126).

Based on Petitioner’s contention and evidence, we find that Liversidge teaches this limitation.

Claim 16 recites “send to the first party an indication of whether the at least one other party is communicably connected to the IM session.” Petitioner contends Liversidge discloses this limitation in describing a collaboration services suite that monitors the status of each participant in the communications session and forwards member status messages to the participants. Pet. 53–54 (citing Ex. 1004 ¶¶ 65, 67, 73, 83, 106, 123).

Based on Petitioner’s contention and evidence, we find that Liversidge teaches this limitation.

Claim 16 recites “receive a request from the first party to establish voice communications amongst current participants of the IM session.” Petitioner contends Liversidge discloses this limitation in describing a first

party launching a convert session message, or request, to the collaboration services suite to facilitate conversion of the communications session to a desired communications type, such as voice. Pet. 54–55 (citing Ex. 1004 ¶¶ 126, 176–181, Fig. 21).

Based on Petitioner’s contention and evidence, we find that Liversidge teaches this limitation.

Claim 16 recites “without requiring registration with a conference call server for establishing the voice communication by potential members including the first party and the at least one other party.” Petitioner contends Liversidge discloses this limitation in describing joining all current participants of an IM session in a new communication session using user information obtained by a VTE server. Pet. 56–59 (citing Ex. 1004 ¶¶ 125–126, 176–181).

Patent Owner does not offer specific arguments for claim 16. To the extent that Patent Owner contends its unpersuasive arguments for the “without requiring registration with a conference call server” offered for claim 1 also apply to this limitation of claim 16, we disagree with Patent Owner for the reasons discussed in our analysis of claim 1. Based on Petitioner’s contention and evidence, we find that Liversidge teaches this limitation.

Claim 16 recites “the request lacking a specific identification of the at least one other party.” Petitioner contends Liversidge discloses this limitation in describing a convert session request received by a VTE server, where the server, not the request, determines the participants. Pet. 59 (citing Ex. 1004 ¶¶ 75, 117–123, 126, 176–181).

Based on Petitioner’s contention and evidence, we find that Liversidge teaches this limitation.

Claim 16 recites “determine, after reception of the request, the at least one other party from information associated with the IM session.” Petitioner contends Liversidge discloses this limitation in describing a VTE server receiving the request, and translating the IM session ID contained in the request to determine the session type and participants. Pet. 59–60 (citing Ex. 1004 ¶¶ 75, 122, 176).

Based on Petitioner’s contention and evidence, we find that Liversidge teaches this limitation.

Claim 16 recites “wherein after determining the at least one party, the voice communication is established between the first party and those of the at least one other party.” Petitioner contends Liversidge discloses this limitation in describing the VTE server formulating and sending a make call message with dialed numbers of team members and the conference bridge to a switching point, causing each of the session participants to be called and joined to the conference bridge. Pet. 60 (citing Ex. 1004 ¶¶ 176–181).

Based on Petitioner’s contention and evidence, we find that Liversidge teaches this limitation.

We have reviewed Petitioner’s explanations and supporting evidence regarding claim 16, and determine that Petitioner, for the reasons set forth in the Petition, has shown by a preponderance of the evidence that claim 16 is unpatentable under 35 U.S.C. § 103 over Liversidge and Beyda.

C. Constitutionality of Inter Partes Review

Patent Owner challenges the constitutionality of *inter partes* review based on the pending review of that issue by the United States Supreme

Court. PO Resp. 41 (citing *Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, cert. granted, 137 S. Ct. 2239 (June 12, 2017) (No. 16-712)); *id.* (“Out of an abundance of caution, Patent Owner hereby adopts this constitutional challenge to preserve the issue pending the Supreme Court’s decision.”). On April 24, 2018, the U.S. Supreme Court held that “*inter partes* review does not violate Article III or the Seventh Amendment” of the Constitution. *Oil States Energy Servcs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1379 (2018). Patent Owner’s challenge based on *Oil States* is moot.

III. CONCLUSION

Petitioner has shown by a preponderance of the evidence that claims 1–16 of the ’194 patent are unpatentable under 35 U.S.C. § 103 as obvious over Liversidge and Beyda.

IV. ORDER

Accordingly, it is
ORDERED that claims 1–16 of U.S. Patent No. 8,571,194 B2 are unpatentable.

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2017-01683
Patent 8,571,194 B2

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01683
Patent 8,571,194 B2

Before KEN B. BARRETT, JEFFREY S. SMITH, and MINN CHUNG,
Administrative Patent Judges.

SMITH, *Administrative Patent Judge.*

DECISION
On Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

On January 24, 2019, Patent Owner Uniloc 2017 LLC filed a Request for Rehearing (Paper 25, “Req.”) of our Final Written Decision (“FWD”) dated January 14, 2019, which held that claims 1–16 of U.S. Patent No. 8,571,194 B2 (Ex. 1001, “the ’194 patent”) are unpatentable.

Patent Owner argues that the Decision misapprehended applicant’s purported disclaimer made during prosecution, of requiring prior registration with a conference call server. Req. 3–6 (citing PO Resp. 7–8; Ex. 1018, 113–114). Patent Owner contends that the Decision did not consider that the registration process of Liversidge (Ex. 1004) is the same as the registration process of Hamberg (Ex. 1013) (cited by the Examiner during prosecution). Req. 6–10. Patent Owner contends that the Decision provides almost no reasoning, analysis, or evidence as to why the VTE server of Liversidge could not be considered a conference call server, and that Petitioner raised this issue as an untimely argument in its Reply. Req. 10.

For the reasons set forth below, Patent Owner’s Request for Rehearing is denied.

II. STANDARD OF REVIEW

Section 37 C.F.R. § 42.71(d) states the following:

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

III. DISCUSSION

Patent Owner contends that the Decision overlooked Patent Owner's contention that, during prosecution, applicant disclaimed requiring prior registration. Req. 3–6. According to Patent Owner, applicant explained to the Examiner that the claim “displays an option for the first party to automatically initiate voice communication . . . without requiring prior registration with a conference call server by potential members.” Req. 5 (quoting Ex. 1018, 114) (emphasis in original). However, during subsequent prosecution, the Examiner rejected the claims, and applicant responded with an amendment and remarks. *See* FWD 9–10 (citing Ex. 1018, 70, 82). We found that the prosecution history shows that the Examiner rejected the claims because they recited “without requiring prior registration,” applicant deleted “prior” from the claims in order to overcome the rejection, and, as a result, the claims do not include the language asserted by Patent Owner. FWD 10. Patent Owner has not shown that applicant made a clear and unmistakable disclaimer of any subject matter beyond that already reflected in the claims, which we considered in evaluating Petitioner's challenges. *Id.* We are not persuaded that we overlooked the prosecution history.

With respect to Patent Owner's argument that we did not consider that “both the *Liversidge* and *Hamberg* references had the same registration” (Req. 6–9), we find this argument unpersuasive. In our Decision, we determined that *Hamberg* requires registration with the conference call server. FWD 8. In contrast to *Hamberg*, we found that the registration of *Liversidge* is with a presence server, which is not a conference call server. FWD 29–30. We also found that *Liversidge*, unlike *Hamberg*, does not require registration, because *Liversidge* teaches inviting a person who is not

registered as a member of a team to join an IM session, then converting the IM session into a voice session, where the voice session includes the person who is not registered. FWD 23–26, 28–29. We also found the convert session function of Liversidge does not require a separate or additional registration before establishing voice communication. FWD 26–27. We are not persuaded that we overlooked the registration of Hamberg, nor that we overlooked the registration of Liversidge.

Patent Owner contends Petitioner’s argument that the VTE server is not a conference call server is untimely, because Petitioner raised this argument in the Reply. Req. 10. We disagree. Petitioner’s Reply responds to Patent Owner’s argument that the VTE server is a conference call server. *See* PO Resp. 30–32. Patent Owner “is the party that first raised this issue,” and Petitioner “simply countered, as it was entitled to do.” *Idemitsu Kosan Co., LTD. v. SFC Co. LTD.*, 870 F.3d 1376, 1381 (Fed. Cir. 2017). Patent Owner has not persuasively explained why Petitioner’s Reply to Patent Owner’s argument was beyond the scope of a proper reply.

Patent Owner contends that the Decision provides almost no reasoning, analysis, or evidence as to why the VTE server of Liversidge could not be considered a conference call server. Req. 10. To the contrary, we found that Liversidge discloses that the call server facilitates interaction between the VTE server, the presence server, and the public switched telephone network. FWD 22 (citing Ex. 1004 ¶ 68). Our analysis explains that because Liversidge’s call server controls the public switched telephone network to place call connections to telephones and initiate voice communication, the call server is a conference call server. FWD 22–23 (citing Ex. 1004 ¶ 68, Fig. 2). Contrary to Patent Owner’s contention, the

Decision points to evidence and provides analysis to support our finding that Liversidge's call server, rather than the VTE server, teaches the conference call server as claimed.

We also provided three distinct analyses of Patent Owner's premise that the VTE server of Liversidge is a conference call server. First, we found that "[e]ven if we were to accept Patent Owner's premise that the VTE server, not the call server, is the conference call server" (FWD 23), Liversidge teaches inviting a person who is not registered as a team member to join the IM session, then converting the IM session into a voice session, where the resulting voice session includes the person who is not registered. *See* FWD 23–26, 28–29. Second, we found that the convert session function of Liversidge does not require team members to reenter any registration information, which teaches "current participants of an IM session are not required to complete an additional or separate registration before establishing voice communication." FWD 26–27. Third, we found that registration does not occur with the VTE server, because "paragraph 100 of Liversidge discloses that the presence server, not the VTE server, registers a team member in the status table." FWD 29–30. We did not overlook this contention.

IV. CONCLUSION

For the foregoing reasons, Patent Owner did not show that the Board misapprehend or overlooked any arguments or evidence presented by Patent Owner in determining that claims 1–16 of the '194 patent are unpatentable.

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V. ORDER

Accordingly, it is

ORDERED that the Request for Rehearing is denied.

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