

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIVEPERSON, INC.,
Petitioner,

v.

24/7 CUSTOMER, INC.,
Patent Owner.

Case IPR2017-00609
Patent 6,970,553 B1

Before CHRISTOPHER L. CRUMBLEY, ROBERT J. WEINSCHENK,
and JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

LivePerson, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–3 and 33–35 of U.S. Patent No. 6,970,553 B1 (Ex. 1001, “the ’553 patent”). Patent Owner 24/7 Customer, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 9 (“PO Prelim. Resp.”). We instituted review of only claims 1 and 33. Paper 12 (“Institution Decision” or “Inst.”). Our scheduling order cautioned Patent Owner that “any arguments for patentability not raised in the response will be deemed waived.” Paper 13, 6. Patent Owner did not file a Response to the Petition; we therefore advised the parties to inform the Board “if there is any reason the Board should not proceed to issue final written decisions without additional briefing or an oral argument.” Paper 22, 2.

On May 3, 2018, we expanded the scope of this proceeding to include review of all challenged claims and all grounds presented in the Petition. Paper 25; see United States Patent and Trademark Office, *Guidance on the impact of SAS on AIA trial proceedings*, PATENT TRIAL AND APPEAL BOARD TRIALS (April 26, 2018), <https://go.usa.gov/xQ93y>. Although presented with the opportunity to do so, the parties did not request further briefing or a hearing on the challenges added to this proceeding. Paper 26.

I. BACKGROUND

A. RELATED PROCEEDINGS

The parties assert the ’553 patent and patents related to it are involved in *24/7 Customer, Inc. v. LivePerson, Inc.*, 3:15-CV-05585-JST (N.D. Cal.) and *24/7 Customer, Inc. v. LivePerson, Inc.*, 3:15-CV-02897-JST (N.D. Cal.). See Pet. 2; Paper 8, 2. The following petitions for *inter partes* review are related to this case:

Case No.	Involved Patent
IPR2017-00610	U.S. Patent No. 9,077,084
IPR2017-00612	U.S. Patent No. 7,751,552
IPR2017-00613	U.S. Patent No. 7,027,586
IPR2017-00614	U.S. Patent No. 6,975,719
IPR2017-00615	U.S. Patent No. 7,245,715
IPR2017-00616	U.S. Patent No. 6,798,876

B. THE '553 PATENT

The '553 patent is directed to a phone system with an integrated chat client service. Ex. 1001, Abstract. The Specification describes a need for a “mechanism by which a called party can keep his/her side of the conversation private from others who may be present in the room.” *Id.* at 1:63–65. When a calling party places a call, the call processing system queries the network to determine whether the called party has an accessible chat client on their computer. *Id.* at 3:63–4:8. If they do, the system prompts the calling party, notifying them that the called party has an accessible chat client, and confirming that the calling party would like to send a chat invitation to the called party. *Id.* at 4:18–22. If the called party chooses to accept the invitation to chat, a chat session between the two parties may be arranged. *Id.* at 4:26–36.

C. CHALLENGED CLAIMS

Petitioner challenges claims 1–3 and 33–35. Independent claim 1 is reproduced below.

1. A method for converting a voice call attempt to an alternate medium for a real-time communication session, comprising:

receiving a telephone call request;
checking for accessibility of a called party chat client associated with a called party; and
prompting a calling party to choose whether or not to electronically chat with the called party in an electronic chat session when the called party chat client is accessible, wherein the electronic chat session is enabled between a calling party chat client and the called party chat client that are logged into respective electronic chat servers.

Ex. 1001, 11:36–48.

Claim 2 depends from claim 1 and adds “sending an invitation to the called party, inviting initiation of a chat session with the calling party when the calling party chooses to chat.” *Id.* at 11:49–52.

Claim 3 depends from claim 2 and adds “connecting a voice call when the calling party chooses not to chat.” *Id.* at 11:53–55.

Claims 33–35 parallel claims 1–3, except that they recite a computer-readable medium that has a program that performs the claimed method steps recited in claims 1–3. *See id.* at 14:1–22.

D. REVIEWED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability. Pet. 4.

Reference(s)	Basis	Claims
Truetken ¹	§ 102(e) ²	1–3 and 33–35

¹ U.S. Patent No. 6,493,324 B1, Dec. 10, 2002 (Ex. 1002, “Truetken”).

² Although Petitioner characterizes this ground as one based on obviousness, in substance, Petitioner asserts Truetken anticipates the challenged claims. *See* Pet. 16 (asserting that Truetken “discloses, and at a minimum renders obvious, the alleged invention claimed by each of the Challenged Claims”); *id.* at 17–28 (not identifying any potential differences between claimed subject matter and Truetken). We therefore treat Petitioner’s challenge as one based on anticipation, not obviousness.

Reference(s)	Basis	Claims
Truetken and Hansen ³	§ 103(a)	1–3 and 33–35

E. LEGAL PRINCIPLES

1. Burden of proof

In an *inter partes* review, the petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to the patent owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must support its challenge by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). Accordingly, all of our findings and conclusions are based on a preponderance of the evidence.

2. Anticipation

A patent claim is unpatentable under 35 U.S.C. § 102 if “the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation.” *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). “A single prior art reference may anticipate without disclosing a feature of the claimed invention if such feature is necessarily present, or inherent, in that reference.” *Allergan, Inc. v. Apotex Inc.*, 754 F.3d 952, 958 (Fed. Cir. 2014) (citing *Schering Corp. v. Geneva Pharm.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003)). We analyze the ground based on anticipation in accordance with the above-stated principles.

³ U.S. Patent No. 5,940,475, Aug. 17, 1999 (Ex. 1003, “Hansen”).

3. Obviousness

An invention is not patentable “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and, (4) where in evidence, so-called secondary considerations, including commercial success, long-felt but unsolved needs, and failure of others. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

When evaluating a combination of teachings, we must also “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Whether a combination of elements produced a predictable result weighs in the ultimate determination of obviousness. *Id.* at 416–17. We analyze the grounds based on obviousness in accordance with the above-stated principles.

II. ANALYSIS

A. CLAIM CONSTRUCTION

Neither party proposes any claim constructions, and we conclude no express claim constructions are necessary for our unpatentability determinations. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d

795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

B. ANTICIPATION BASED ON TRUETKEN

As explained below, Petitioner has made an adequate showing of anticipation regarding claims 1 and 33, but has not done so regarding claims 2, 3, 34, or 35.

1. *Truetken (Ex. 1002)*

Truetken was filed on March 29, 1999, before the earliest priority date of the ’553 patent, and is prior art under 35 U.S.C. § 102(e). Pet. 5. Truetken teaches an Internet Protocol (“IP”) telephony client that initiates and manages multimedia sessions. Ex. 1002, Abstract. When a calling party initiates a call, the system prompts the calling party to select from a list of available helper applications or media types, including “IP phone, browser, e-mail, chat, personal directory, video streaming applications, and the like.” *Id.* at 4:2–4, 15–33. Once selected, a Session Initiation Protocol or “SIP” invite is sent to the called party, prompting the called party to accept, decline, or negotiate for other options. *Id.* at 4:41–47. In particular,

if the called party wishes to negotiate for a different time or media for the call, the called party clicks on an other options button, which causes the called party client to open another options dialog box The options dialog box gives the called party the opportunity to suggest alternative media or an alternative time for the call. The called party client populates the options dialog box with the names of the other helper applications that the called party has available.

Id. at 4:59–67 (reference numerals omitted). Once the calling and called parties have agreed on a communications medium, the appropriate helper

application launches on the parties' respective systems. *See id.* at 5:9–19, 58–60, Fig. 6.

Petitioner asserts Truetken anticipates claims 1–3 and 33–35. Pet. 18–30. As explained below, Petitioner has shown by a preponderance of evidence that claims 1 and 33 are unpatentable. Petitioner has not shown, however, that claims 2, 3, 34, or 35 are unpatentable over Truetken.

2. Claims 1 and 33

As summarized above, independent claims 1 and 33 recite parallel limitations, with claim 1 reciting a method and claim 33 reciting a “computer-readable medium having a program for” performing a method with steps nearly identical to those of claim 1. We, therefore, address the two claims together.

We find that that Truetken teaches a method and a computer-readable medium for “converting a voice call attempt to an alternate medium for a real-time communication session.” *See* Pet. 18–19 (citing Ex. 1002, Abstract, 1:34–39, 1:51–55, 2:53–55, 4:15–33, 4:41–65, Fig. 3; Ex. 1005 ¶¶ 60–64).

We find that Truetken teaches “receiving a telephone call request.” *See* Pet. 20 (citing Ex. 1002, 1:51–55, 4:2–4, 4:34–39; Ex. 1005 ¶¶ 67–68), 24 (citing Ex. 1002, 1:51–55, 4:34–39).

We find that Truetken teaches “checking for accessibility of a called party chat client associated with a called party.” *See* Pet. 20–21 (citing Ex. 1002, 1:64–66, 4:59–67; Ex. 1005 ¶¶ 65–66), 24 (citing Ex. 1002, 1:64–66, 4:65–67). As Petitioner explains, in Truetken, when a called party wishes to negotiate for a different media for an incoming call, they can click on an “other options” button, which causes the called party client to

“populate[] [an] options dialog box 85 with the names of the other helper applications that the called party has available.” Ex. 1002, 4:59–67; *see* Pet. 20–21. In addition, Truetken discloses that helper applications types include chat applications. Ex. 1002, 4:2–4. We view the claimed “checking for accessibility” of a chat client as including Truetken’s determination of “available” applications, including chat clients. *See* Ex. 1002, 4:2–4, 4:65–67. Thus, based on the record, we agree with Petitioner and find that Truetken teaches “checking for accessibility of a called party chat client associated with a called party,” as claims 1 and 33 require.

We find that Truetken teaches “prompting a calling party to choose whether or not to electronically chat with the called party in an electronic chat session when the called party chat client is accessible,” as claims 1 and 33 require. *See* Pet. 21–22 (citing Ex. 1002, 5:13–20, Fig. 6; Ex. 1005 ¶¶ 70–73). In Truetken, the calling party’s chat-option prompt is premised on the called party first proposing chat as an alternative medium. *See* Ex. 1002, 5:9–17 (describing that “[a]fter the called party has selected an alternative option for the call, the called party clicks on an OK button 91, which causes the called party client to send a response with the selected option back to the calling party client”). As explained above, however, the called party’s chat proposal is itself premised on the system populating a list of alternative media applications that the called party has available. Thus, in Truetken, two conditions must be met before the calling party is prompted to choose whether to chat: (1) the called party electronic chat client must be accessible, and (2) the called party must propose the alternative chat media. Although the claim limitation at issue only recites the first of those two conditions, nothing in the limitation’s plain language precludes the second

condition as well. Thus, based on the record, we agree with Petitioner and find that Truetken teaches “prompting a calling party to choose whether or not to electronically chat with the called party in an electronic chat session when the called party chat client is accessible,” as claims 1 and 33 require.

We find that Truetken discloses “the electronic chat session is enabled between a calling party chat client and the called party chat client that are logged into respective electronic chat servers.” See Pet. 21 (citing Ex. 1002, 5:13–20, Fig. 6; Ex. 1005 ¶¶ 70–73), 24–25 (citing Ex. 1002, 3:15–19, 3:31–34, 4:15–28, 4:34–39, 4:47–52, 5:13–21).

Having considered the record, we find that Petitioner has demonstrated by a preponderance of the evidence that Truetken, in a single embodiment, discloses the limitations of claims 1 and 33. Accordingly, we find claims 1 and 33 are unpatentable as anticipated by Truetken.

3. Claims 2, 3, 34, and 35

Dependent claims 2 and 34 (and, by dependency, claims 3 and 35) require “sending an invitation to the called party, inviting initiation of a chat session with the calling party when the calling party chooses to chat.” Petitioner maps this additional invitation to Truetken’s initial “invitation to the called party that identifies the calling party and the requested media type—e.g., chat.” Pet. 22–23 (citing Ex. 1002, 3:15–19, 4:15–28, 4:34–39).

We conclude that Truetken’s initial chat invitation is insufficient. See PO Prelim. Resp. 23–25. For the limitations recited in claims 1 and 33, Petitioner relies on an embodiment in Truetken where the system converts a calling party’s initial *voice* call invitation to a chat session. See Pet. 18–20. For the additional-invitation limitation recited in claims 2 and 34, however, Petitioner relies on a distinct embodiment—i.e., a calling party’s initial *chat*

invitation. *See* Pet. 22–23. The two separate embodiments are mutually exclusive because one has the calling party initially select a voice call, whereas the other has the calling party initially select a chat. Thus, Truetken does not disclose all elements of claims 2 and 34 “arranged as in the claim[s].” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008). In addition, Petitioner does not acknowledge these distinct embodiments or offer any explanation as to why one skilled in the art would combine these distinct steps in the same system, as claims 2 and 34 require.⁴ *See* Pet. 37. Thus, we find Petitioner has not demonstrated by a preponderance of the evidence that claims 2, 3, 34, or 35 are unpatentable over Truetken.

C. OBVIOUSNESS OVER TRUETKEN AND HANSEN

Petitioner asserts claims 1–3 and 33–35 would have been obvious over Truetken and Hansen at the time of the invention. Pet. 29–43. As explained below, Petitioner has made an adequate showing regarding claims 1 and 33, but has not done so regarding claims 2, 3, 34, or 35.

1. Hansen (Ex. 1003)

Hansen issued more than one year before the earliest priority date of the ’553 patent on August 17, 1999 and is, therefore, prior art under 35 U.S.C. § 102(b). Pet. 5. Hansen addresses enhancing communication

⁴ As addressed above, Petitioner did not propose any combination of the embodiments of Truetken, or any other modification of Truetken, and for this reason we have considered the ground of unpatentability to be based on anticipation alone. Even if we were to consider Petitioner’s ground of unpatentability over Truetken as an obviousness ground, however, we would have found it insufficient for failing to acknowledge the distinct embodiments of Truetken or articulate a reason to combine them.

systems and processes used by the deaf, hearing-impaired, and/or speech-impaired community. Ex. 1003, 2:59–62. According to Hansen, “[d]eaf, hearing impaired, and/or speech impaired individuals primarily communicate with others via a Telecommunication Device for the Deaf (‘TDD’), which is primarily a teletypewriter (‘TTY’).” *Id.* at 2:6–9. Hansen teaches a system that “integrate[s] TDD and TTY calls into mainstream telephone system and computer communication functions.” *Id.* at 3:52–54. Relevant to this case, Hansen teaches that when a calling party initiates a TDD call, the system checks if the called party is listed in a database of individuals who have a networked computer with real-time chat functionality. *See id.* at 14:40–59. If so, the system can establish a connection that enables real-time chat between them. *Id.* at 15:6–24.

2. Claims 1 and 33

Petitioner’s obviousness challenge based on Truetken and Hansen largely parallels its anticipation challenge over Truetken alone, except that, for the obviousness ground, the Petition relies on Hansen to show the limitation “checking for accessibility of a called party chat client associated with a called party.” *See* Pet. 34–36, 39; Ex. 1005 ¶ 100. We conclude that Petitioner has made an adequate showing that Hansen teaches that limitation.

As Petitioner’s expert, Dr. Wicker, explains, Hansen discloses “checking a database to see if the called party has chat (teletypewriter, or ‘TTY’) capability.” Ex. 1005 ¶ 100 (citing Ex. 1003, Abstract, 14:40–49); *see* Pet. 34–35. We agree with Petitioner this disclosure teaches “checking for accessibility of a called party chat client associated with a called party.”

In addition, Petitioner made a sufficient showing that one skilled in the art had reason to combine the known elements in the manner Petitioner

suggests. *See KSR*, 550 U.S. at 418. The Petition explains, with relevant support from Dr. Wicker, that it would have been obvious for one skilled in the art to combine Hansen’s chat accessibility check with Truetken’s system “because a text server check would allow the options dialog box of Truetken to be automatically populated with communications medium options within the system capabilities of both parties,” and thus, “a SIP invitation is never sent requesting an unavailable communications medium.” Pet. 35–36 (citing Ex. 1005 ¶ 101).

In all other regards, we adopt our analysis of Petitioner’s anticipation challenge based on Truetken. Based on the analysis above and our findings from the anticipation challenge, Petitioner’s showing satisfies the legal thresholds for obviousness. We, therefore, conclude Petitioner has demonstrated by a preponderance of the evidence that the subject matter of claims 1 and 33 would have been obvious over Truetken and Hansen

3. Claims 2, 3, 34, and 35

Petitioner’s obviousness challenge based on Truetken and Hansen has the same deficiency as its ground based on Truetken alone. That is, Petitioner relies on distinct embodiments from Truetken, yet does not suggest combining those embodiments or explain why one skilled in the art would have done so. *See* Pet. 37. Thus, for the reasons explained above, we conclude Petitioner has not demonstrated by a preponderance of the evidence that the subject matter of claims 2, 3, 34, or 35 is unpatentable over Truetken and Hansen. *See supra* at 10.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has demonstrated by a preponderance of the evidence that:

- a) Claims 1 and 33 are unpatentable under 35 U.S.C. § 102(e) as anticipated by Truetken; and
- b) Claims 1 and 33 are unpatentable under 35 U.S.C. § 103(a) as obvious over Truetken and Hansen.

We further determine that Petitioner has not demonstrated by a preponderance of the evidence that:

- a) Any of claims 2, 3, 34, or 35 is unpatentable under 35 U.S.C. § 102(d) as anticipated by Truetken; or
- b) Any of claims 2, 3, 34, or 35 is unpatentable under 35 U.S.C. § 103(a) as obvious over Truetken and Hansen.

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.

IV. ORDER

Accordingly, it is:

ORDERED that claims 1 and 33 of the '553 patent are unpatentable;
and

FURTHER ORDERED that claims 2, 3, 34, and 35 of the '553 patent have not been proven unpatentable.

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