

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01685
Patent 7,804,948 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); 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioner¹ filed a Petition for *inter partes* review of claims 1–4, 6–8, 18, 21, and 22 of U.S. Patent No. 7,804,948 B2 (Ex. 1001, “the ’948 patent”). Paper 1 (“Pet.”). Patent Owner² filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). On January 16, 2018, we instituted an *inter partes* review of all the challenged claims. Paper 10. Patent Owner filed a Response to the Petition, Paper 13 (“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 1–4, 6–8, 18, 21, and 22 of the ’948 patent are unpatentable.

A. Related Matters

The ’948 patent is also the subject of IPR2017-00058.³

The parties identify several U.S. District Court cases and Patent Trial and Appeal Board cases as matters involving or related to the ’948 patent, including *Uniloc USA, Inc. v. Google, Inc.*, Case No. 2:16-cv-00566 (E.D.

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.

² Patent Owner’s Mandatory Notice filed on July 20, 2017, identified Uniloc Luxembourg S.A. as the Patent Owner. Paper 5. More recently, Patent Owner filed an Updated Mandatory Notice identifying Uniloc 2017 LLC as the Patent Owner. Paper 17.

³ *Cisco Systems, Inc. (Petitioner) v. Uniloc 2017 LLC (Patent Owner)*. In a Final Written Decision, all challenged claims were held unpatentable.

Tex.). Pet. 2, 63–65; Paper 5.

Additionally, Patent Owner identifies as related matters IPR2017-01683 (Patent 8,571,194 B2) and IPR2017-01684 (Patent 7,853,000 B2), which involve the same parties as the present proceeding. PO Resp. 1–2. Oral arguments in those two *inter partes* review were heard along with those in the present proceeding. See Tr. 3:3–4.

B. The '948 Patent

The '948 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, 1:13–17. 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 '948 patent is reproduced below.

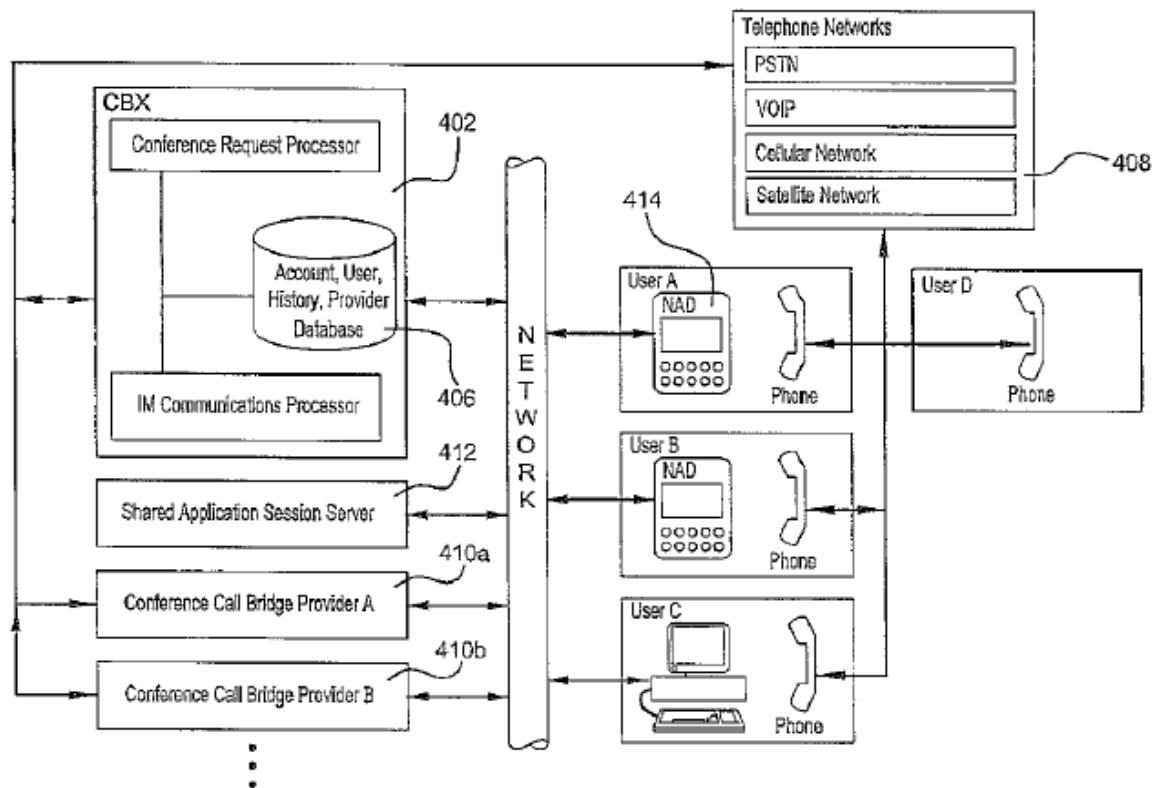


Figure 4 above shows a block diagram of a system for accomplishing the initiation of conference calls. Ex. 1001, 9:13–14. Conference call server 402 is connected to network 404. *Id.* at 9:14–15. Database 406, associated with conference call server 402, stores account information, user information, and call management information. *Id.* at 9:15–18. The conference call server can be connected directly to telephone network 408, or indirectly through third party conference bridge 410. *Id.* at 9:22–25. 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 9:26–30. 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 9:39–41.

For example, during an IM session involving User A, User B, and User C, a conference call requester (User A) requests a conference call through User A's NAD. *Id.* at 7:27–34. The IM service in communication with User A's NAD is aware of the IM session, and determines the list of conference call targets from the list of parties presently in the IM session. *Id.* at 7:34–38. The conference call server sends a conference call invitation to User B and User C. *Id.* at 7:64–66. If User B and User C accept the conference call invitation, the conference call server prompts User B and User C, via the IM functionality, to verify their phone numbers for the conference call. *Id.* at 7:66–8:10. The conference call server then initiates a conference call bridge between the conference requester and the targets. *Id.* at 8:11–12.

C. Illustrative Claim

Claim 1 of the challenged claims of the '948 patent is the only independent claim. Claim 1 follows:

1. A method for initiating a conference call, comprising the steps of:

providing a conference call requester with a network access device, said network access device communicating via an instant messaging service, said instant messaging service being adapted to communicate conference call request information with a conference call server;

establishing a communications connection from said network access device to the conference call server;

presenting said conference call requester with a display showing a plurality of potential targets then being connected to said instant messaging service and participating in a given instant

messaging session with the conference call requester and with whom a conference call may be initiated;

generating a conference call request responsively to a single request by the conference call requester, said conference call request identifying each of the potential targets for said conference call request;

transmitting said conference call request from said network access device to said conference call server; and

automatically establishing a conference call connection to said conference call requester, said conference call connection initiated by said conference call server, said conference call connection further being connected to each of the potential targets.

Ex. 1001, 11:58–12:17.

D. Evidence

Petitioner relies on the following references. Pet. 9–10.

Reference	Title	Date	Ex. No.
Tanigawa	US 7,233,589 B2	Filed Aug. 30, 2002	Ex. 1014
Liversidge	US 2002/0076025 A1	Filed Dec. 18, 2000	Ex. 1004

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 19, 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 1–4, 6–8, 18, 21, and 22 of the '948 patent are unpatentable under 35 U.S.C. § 103 over Tanigawa and Liversidge.

II. ANALYSIS

A. *Principles of Law*

Petitioner bears the burden of proving unpatentability of the claims challenged in the Petition, and that burden never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).⁴ To prevail, Petitioner must establish by a preponderance of the evidence that the challenged claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter 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. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). 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 skill in the art; and (4) any objective evidence of non-obviousness.⁵ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. *The Level of Ordinary Skill in the Art*

Petitioner's expert, Mr. Lipoff, opines that:

[A] person of ordinary skill in the art would have been someone knowledgeable in collaboration applications and telecommunications services. That person would have held at least a Bachelor's degree in Computer or Electrical Engineering,

⁴ To the extent that Petitioner asserts that Patent Owner bears the burden to demonstrate patentability, Petitioner is incorrect. See Pet. Reply 1.

⁵ The parties have not directed our attention to any objective evidence of non-obviousness.

Computer Science, or the equivalent training, and that person would have had approximately five years of experience working on computer-based collaboration or telecommunications services.

Ex. 1002 ¶ 42; *see also* Pet. 13–14. Patent Owner’s expert, Mr. Easttom, agrees with Mr. Lipoff as to the academic background and states that his opinion regarding the level of ordinary skill “appears to largely overlap with that offered by Mr. Lippoff,” but “disagree[s] with Mr. Lipoff’s definition to the extent ‘ordinary skill’ is interpreted to require more than 4 years of academic of experience working on computer-based collaboration or telecommunications services [and states that s]uch an amount seems inordinate.” Ex. 2001 ¶¶ 13–14. Mr. Easttom opines that the experience level should be “at least two years of experience in computer programming and software development, including the development of software for communication with other computers over a network.” *Id.* ¶ 13. Mr. Easttom does not elaborate as to why he believes the amount of experience in Mr. Lipoff’s opinion “seems inordinate.” Rather, Mr. Easttom states that he finds his definition indistinguishable from that offered by another declarant in another *inter partes* review involving a different, but related, patent. *Id.* ¶ 15.⁶

We discern no material difference between the two experts’ definitions offered in this case. *Cf.* PO Resp. 10 (Patent Owner arguing that the dispute should be resolved in its favor “to the extent it is outcome

⁶ In an earlier *inter partes* review that involves the ’948 patent, we applied a definition similar to the present-Petitioner’s, namely that involving “approximately five years of experience working in computer-based collaboration or telecommunications services.” IPR2017-00058, Paper 17, 6–7.

determinative” but not identifying an outcome-determinative difference). Both experts’ definitions are consistent with the level of ordinary skill reflected in the prior art references of record. We adopt Mr. Lipoff’s definition of the person of ordinary skill in the art.

C. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b) (2018)⁷; *see also* *Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would have been understood by one 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).

Patent Owner asserts that there is a dispositive claim construction dispute concerning the recitation “generating a conference call request responsively to a single request by the conference call requester.” PO Resp. 12. Patent Owner argues that Petitioner’s obviousness theory involves an implied construction of the phrase that would “encompass what was expressly and successfully distinguished and disclaimed during prosecution.” *Id.* Patent Owner argues “the intrinsic evidence proscribes interpreting ‘generating a conference call request responsively to a single request by the conference call requester’ to encompass having the

⁷ 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).

conference call requester **individually select** those attendees whom she wants invited to join the call.” *Id.* Patent Owner relies on the testimony of Mr. Easttom, who offers the opinion that the subject phrase “**excludes** scenarios where a user determines whether attendees are available for a conference call and **selects** such attendees for invitation.” Ex. 2001 ¶ 31 (emphasis in original); see PO Resp. 12 (citing Ex. 2001 ¶ 31). Patent Owner attempts to distinguish the Tanigawa reference by arguing that that reference teaches “manually selecting corresponding clients for invitation.” PO Resp. 14–16. At oral argument, Patent Owner referred to the claims as containing “negative limitations.” Tr. 21:1–22:3. Thus, we understand Patent Owner to assert that, through prosecution history disclaimer, the “generating” step should be read as containing a negative limitation that precludes the requester from determining attendee availability and manually selecting attendees for invitation to the conference call.

We begin our claim construction analysis with the claim language itself. The pertinent language of independent claim 1 is “generating a conference call request responsively to a single request by the conference call requester.” Ex. 1001, 12:7–8. This claim term contains two distinct requests. One is “a single request” made by the person wishing to initiate a conference call (the claimed “conference call requester”). Another is the “conference call request” generated in response to that “single request.” It is the scope of the “single request” that is the subject of dispute.

Patent Owner contends that “the explicit claim language” is consistent with its argument “that there is a patentable distinction between ‘a single request by the conference call requester’ and, instead, requiring the requester to select those attendees who will be invited to join the call.” PO Resp. 14–

15. Petitioner, on the other hand, argues that “nothing in the claims precludes selecting attendees before a conference call requester issues the ‘single request’ to convert an instant messaging session into a conference call.” Pet. Reply 2.

While the claim language does contain a recitation of a “single request” by the user to generate a conference call request, we fail to discern any explicit claim language that precludes the user’s determination as to availability or the selection of call participants as part of or as a prelude to that recited “single request.” In other words, the language of claim 1 does not contain the negative limitation proposed by Patent Owner. Further, if Patent Owner’s proposed negative limitation is set forth explicitly in the claim language, as Patent Owner suggests, there would be no need for Patent Owner to argue that there is a reduction in scope due to a disclaimer. *Cf. Biogen Idec, Inc. v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1095 (Fed. Cir. 2013) (“[W]hen the patentee unequivocally and unambiguously disavows a certain meaning to obtain a patent, the doctrine of prosecution history disclaimer narrows the meaning of the claim [relative to the full ordinary and customary meaning] consistent with the scope of the claim surrendered.”); see Pet. Reply 2 (Petitioner arguing that “Patent Owner appears to concede that the claim language itself contemplates selecting attendees, otherwise there would be no need to resort to a disclaimer argument”).

We now turn to the remainder of the Specification. Neither party directs us to any use in the Specification of the phrase “single request” other than in the claims themselves. We do, however, find informative the Specification’s description of the invention. Additionally, Petitioner points

to an example in the Specification as supporting its argument that Patent Owner's proposed negative limitation precluding user selection of attendees is inconsistent with the Specification. Pet. Reply 2 (citing Ex. 1001 (the '948 patent), 7:34–44; Ex. 1032 (the cross-examination testimony of Patent Owner's expert), 22:19–25).

The Specification describes the problem addressed as the need for integration of a conference call into the collaboration process and for a more efficient way to initiate such a conference call. *See, e.g.*, Ex. 1001, 2:25–47, 3:16–20. According to the Specification, there were, at the time, two ways to initiate a conference call: 1) via a “Meet Me” call with all the users individually dialing in to a conference bridge, or 2) via a “Host-Initiated” call with the host calling all the participants individually or with the host entering all the phone numbers into a web site that initiates a conference bridge or providing them to an operator who initiates the call. *Id.* at 2:59–3:15. The Specification explains that “[t]hese methods are inefficient, in that they require a conference call requester or party to the conference call to manually inform either the parties to the conference call, or the conference bridge itself, of parameters, passwords, and phone numbers for the call.” *Id.* at 3:16–20. Thus, contrary to Patent Owner's characterization, this portion of the Specification does not identify the general act of “separately identify[ing] each conference participant[.]” as an inefficiency problem to be overcome. PO Resp. 2–3 (citing Ex. 1001, 2:49–3:20; Ex. 2001 ¶ 20). Rather, the Specification identifies the undesirable inefficiencies as those flowing from the need to call everyone individually or to have each participant call in individually or for the requestor to identify several specific pieces of data, namely parameters, passwords, and phone numbers for the

call. *See* Ex. 1001, 3:16–20.

The disclosed method, according to the Specification, addresses the problems of the past, in part, by allowing a conference call requestor to transition from an instant messaging session to a conference call without requiring each person to dial-in individually or requiring the host to look up each participant's phone number in order to call those persons. *Id.* at 4:7–19.

The present invention may further use the presence component of an instant messaging system to determine whether prospective attendees are available for a conference call through this presence with the instant messaging service, then using stored information that includes an address for a party, either through an IM channel or at a specific phone number or VOIP address, create the ability for instant messaging users to immediately create any combination of PSTN, Cellular, and VOIP conference calls between users some of whom may be in instant messaging sessions, and 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.

Id.

Patent Owner identifies, as an example of a single request by the conference call requester, that described in the Specification as follows:

When a conference call requester desires to initiate a conference call, the conference call requester may generate 106 a message (hereafter referred to as the “conference request message”) to the conference server identifying parties who are potential participants (“potential targets”) to a conference call.

Id. at 6:36–40; *see* PO Resp. 4 (citing Ex. 1001, 6:22–59).⁸

Both parties identify a description of the “more robust embodiment” of Figure 3 (Ex. 1001, 7:27–28) as providing further examples of a single request. *See* PO Resp. 4 (citing Ex. 1001, 7:27–48); Pet. Reply 2 (citing Ex. 1001, 7:34–44). That portion of the Specification provides:

As shown in FIG. 3, a more robust embodiment of the present invention may be implemented to allow further functionality. For the purposes of illustration, the Figure shows three parties, User A 302, User B 304, and User C 306, involved 308 in an IM session, such as a chat session which could occur during a shared application session. User A 302, the conference call requester, could request a conference call through the NAD in use by User A. The IM service in communication with User A's NAD could be implemented 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. Thus, *User A could request a conference call with one step, such as through actuation of a “call now” button or icon associated with User A's IM service. Alternately, User A could be provided with a list of participants of the on-going IM session, and be provided 312 with the opportunity to add or remove potential participants from a planned conference call.*

Ex. 1001, 7:27–44 (emphasis added); *see also id.* at Fig. 3 (the above-referenced box 312 labeled “User A selects which people to have joined in the conference”). Thus, the Specification describes that there are at least two alternatives by which the requester may make a request—either via a

⁸ While we agree that this portion of the Specification is informative, we note that the quoted language more closely tracks with the claim language prior to amendment and when the actor performing the “generating” was the requester, as opposed to the current phrasing where the “generating” is performed responsively to request by the requester. *See* Ex. 1018, 112 (the Amendment that is related to Patent Owner's prosecution history disclaimer argument).

one-step button, or by first being offered the opportunity to add or remove participants. Accordingly, the Specification indicates that the recited “single request” is in contrast to the prior need to make multiple requests, for example where the user would have to call (i.e. “request”) each conference call participant separately or each participant would have to call in separately.

We now turn to the prosecution history, and specifically to that of the ’948 patent’s parent application, which contains the interactions between the examiner and the applicant that are discussed by the parties in the context of Patent Owner’s disclaimer argument. *See, e.g.*, PO Resp. 13 (identifying Ex. 1018 as the subject prosecution history, and asserting that “[d]uring prosecution of the application that issued as the ’948 patent, Applicant successfully distinguished the Haims reference, at least in part, with the following remarks (which the Office ultimately found persuasive)”).

“Prosecution disclaimer ‘promotes the public notice function of the intrinsic evidence and protects the public’s reliance on definitive statements made during prosecution.’” *Elbex Video, Ltd. v. Sensormatic Elecs. Corp.*, 508 F.3d 1366, 1371 (Fed. Cir. 2007) (quoting *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003)). “The doctrine is rooted in the understanding that ‘[c]ompetitors are entitled to rely on those representations when determining a course of lawful conduct, such as launching a new product or designing-around a patented invention.’” *Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1359 (Fed. Cir. 2017) (quoting *Biogen Idec, Inc. v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1095 (Fed. Cir. 2013)); *see also* *Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973, 978 (Fed. Cir. 2014) (“[T]he PTO is under no obligation to accept a claim construction proffered

as a prosecution history disclaimer, which generally only binds the patent owner.”). 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*, 508 F.3d at 1371 (citations omitted).

Patent Owner, the proponent of the disclaimer argument, refers to a three-sentence quotation from the prosecution history, which we discuss further below. PO Resp. 13; *id.* at 14–17 (Patent Owner again citing the prosecution history section of its brief and arguing that Petitioner’s primary reference, Tanigawa, is similar to art discussed during prosecution history, and therefore the disclaimer distinguishes the claims over Tanigawa).

Patent Owner’s expert, Mr. Easttom, states the opinion, based on *all of the intrinsic evidence*, that a person of ordinary skill would understand the “generating” claim phrase to exclude user determination of availability and selection of attendees. Ex. 2001 ¶ 31. Mr. Easttom testifies that his opinion is “*partially based* on the prosecution history” and “note[s]” that quoted arguments were made. *Id.* ¶ 32 (emphasis added). Mr. Easttom concludes this section of his declaration with the opinion: “The above phrasing pointing to claim language that **excludes** scenarios where a user determines whether attendees are available for a conference call and **selects** such attendees for invitation.” *Id.* ¶ 33 (emphasis in original). Mr. Easttom does not explain how or to what extent his opinion is “partially based” on the prosecution history and his conclusory declaration testimony does not support a determination that a person of ordinary skill in the art would understand there to have been an unambiguous, clear, and unmistakable disclaimer of claim scope due to the applicant’s arguments during

prosecution. To the contrary, Mr. Easttom's opinion is that it is the claim language itself that excludes the specified scenario. *Id.* (referring to "claim language that ***excludes*** scenarios"). As discussed above, we fail to see the proposed negative limitation in the claim language, and Mr. Easttom's conclusory opinion does not change our determination in that regard.

Petitioner, in contrast to Patent Owner's treatment of the issue, discusses more of the prosecution history to place the quotation in context, and persuasively argues that the applicant did not clearly and unambiguously disavow coverage of the selection of attendees. Pet. Reply 1–7. In particular, Petitioner contends that Applicant tried to distinguish claim 1 over Haims by arguing that Haims did not disclose "users who are then participating in a common IM session." Reply 6; see Ex. 1018, 124 (Applicant argued that "Claim 1 calls for the system to automatically establish a conference call with a plurality of users *who are then participating in a common IM session with the requestor* responsively to a single requestor request."). Petitioner contends that Applicant's statements do not pertain to a call started by converting from an existing IM session, because Haims does not disclose starting a conference call from an existing IM session. Reply 6; see Reply 4 ("Nowhere does Haims describe converting any on-going instant messaging session to a conference call, much less selecting a subset of participants from the instant messaging session to attend the call.").

We agree with Petitioner that Applicant did not clearly and unambiguously disavow coverage of the selection of attendees. During the prosecution, the Examiner rejected independent claim 1 as anticipated by Haims (Ex. 1017). Ex. 1018, 142–143. Applicant responded by making

several amendments to, *inter alia*, claim 1, and by presenting arguments. *Id.* at 112 (showing amendments to claim 1), 123–125 (arguments regarding claim 1). Applicant amended the “presenting,” “generating,” and “establishing” limitations and emphasized all of those limitations in arguing against the rejection. *Id.* We note that, prior to the amendment, the claims broadly recited presenting a display of at least one target and recited “generating a conference call request by said conference call requestor [i.e. the user],” whereas after amendment, the claim required presenting a display of a plurality of targets, that the “generating” is performed responsively to a single request by that person, and that the step of “establishing a conference call connection” was limited to being performed “automatically.” *Id.* at 112. In arguing that the claim as amended overcame the Haims reference, the applicant made the following statement that Patent Owner now asserts constitutes a disclaimer of subject matter:

Haims neither teaches nor even suggests such a methodology. Rather, Haims proposes that a user determine whether attendees are available and select ones for invitation. *See, e.g., pars. [0110] and [0111]*. In contrast, Claim 1 calls for the system to automatically establish a conference call with a plurality of users who are then participating in a common IM session with the requester responsively to a single requester request.

Id. at 124; *see* PO Resp. 13.

Immediately preceding these assertions is a quotation of the entire claim, as amended, with emphasis added to five different phrases. Ex. 1018, 124. Applicant’s statement that “such a methodology” is lacking in Haims refers to the entire claim and specifically to the five emphasized claim phrases. Those emphasized phrases include the “automatically establishing a conference call connection” that is the subject of the sentence purportedly

creating the disclaimer. *Id.* (“In contrast, Claim 1 calls for the system to automatically establish a conference call”). The emphasized phrases also include “a plurality of potential targets then . . . participating in a given instant messaging session with the conference call requester,” that is also the subject of the sentence purportedly creating the disclaimer. *Id.* (“In contrast, Claim 1 calls for . . . a conference call with a plurality of users who are then participating in a common IM session with the requester”). Thus, the record does not indicate an unambiguous narrowing of claim scope associated with the step of “generating . . . responsively to a single request” that would include a negative limitation not already explicit in the claim language after amendment. Rather, the record indicates that the applicant was attempting to distinguish the claim over Haims due to the combination of several phrases that together persuaded the Examiner to allow claim 1.

Although Patent Owner now ascribes the prosecution argument to the “generating” limitation (PO Resp. 13), the record indicates that Applicant directed that argument to the Examiner’s findings regarding a different limitation. *See* Ex. 1018, 124 (Applicant arguing that Haim’s paragraphs 110 and 111 “propose[] that a user determine whether attendees are available and select ones for invitation”); *id.* at 143 (the Examiner relying on paragraph 111 for a “display showing the potential target and indicating whether the target is connected to the IM service” but paragraph 112 for the pre-amendment “generating” and “transmitting a conference call request” limitations). At best, this leaves an ambiguity and is one not addressed by Patent Owner.

Prior to quoting the as-amended claim, the applicant characterized “certain embodiments” in the Specification as being consistent with the

amended claim. Ex. 1018, 123–124. Applicant—rather than indicate a desire to limit the claims via argument—expressly stated the opposite. *Id.* at 123 n.1 (“The following discussion may identify exemplary reference characters, and/or references particular portions of the disclosure. Such identification and/or references do not constitute a representation that any claim element is limited to the embodiment illustrated at any identified character or described in any referenced portion of the disclosure.”). While we recognize that the applicant discussed a particular embodiment in asserting that the amended claim is consistent with the Specification (*id.* at 123–124), we decline Patent Owner’s implied request to narrow the claim by limiting it to that one embodiment, particularly where Applicant was silent regarding the disclosed alternative that Patent Owner’s proposed negative limitation would exclude. *See* Ex. 1001, 7:41–44 (“Alternately, User A could be provided with a list of participants of the on-going IM session, and be provided 312 with the opportunity to add or remove potential participants from a planned conference call.”).

The Examiner issued a Notice of Allowability without providing a Statement of Reasons for Allowability. Ex. 2002, 102. Contrary to Patent Owner’s arguments, the evidence does not support a finding that the Examiner allowed the claims because of the presence of a negative limitation produced via disclaimer. *See* PO Resp. 6–7.

We conclude that there was not an unambiguous, clear, and unmistakable prosecution history disclaimer evident to one of ordinary skill in the art. *Elbex Video*, 508 F.3d at 1371.

As for extrinsic evidence, we have discussed above Mr. Easttom’s testimony.

After having considered the parties' arguments, and on the record before us, we do not find sufficient evidence that the claim language or a prosecution history disclaimer requires a negative limitation that precludes the requester from determining attendee availability and manually selecting attendees for invitation to the conference call.

D. Asserted Obviousness Over Tanigawa and Liversidge

Petitioner, relying on the Declaration of Stuart Lipoff (Ex. 1002), challenges claims 1–4, 6–8, 18, 21, and 22 as obvious over the combination of Tanigawa (Ex. 1014) and Liversidge (Ex. 1004). Pet. 15–63.

1. Tanigawa (Ex. 1014)

Tanigawa relates to communication technology such as Instant Messaging. Ex. 1012, 1:6–7. Figure 1 of Tanigawa is reproduced below.

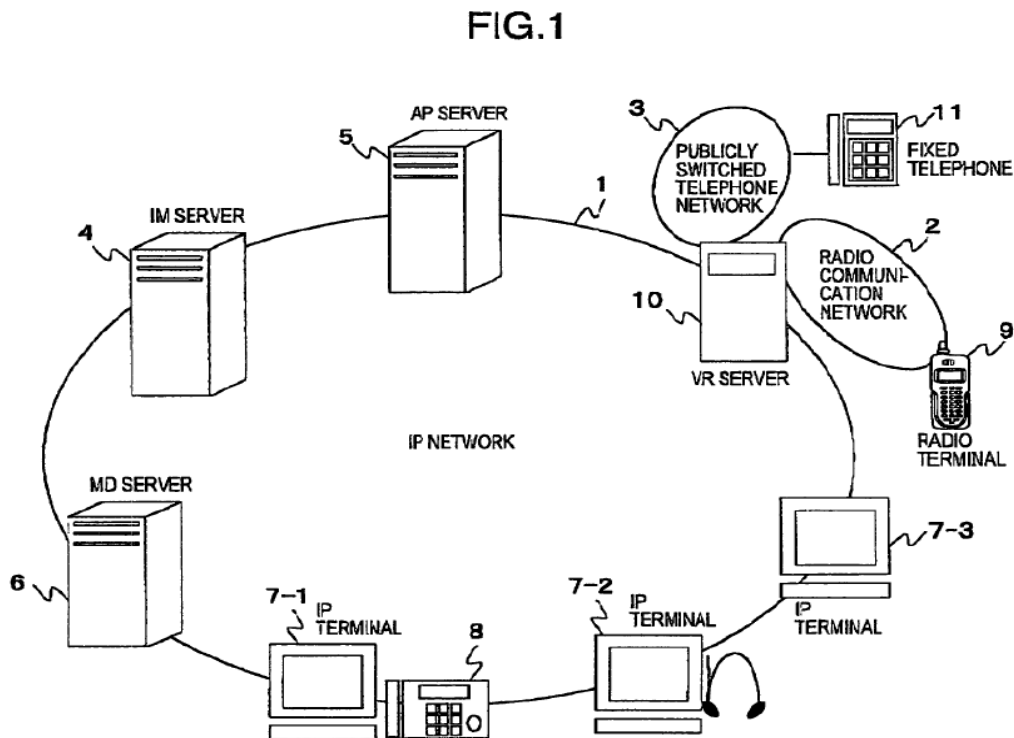


Figure 1 above shows a diagram of an IM-Voice over Internet Protocol (VoIP) communication system. Ex. 1014, 3:56–59. An IM client is installed in each of IP terminals 7-1 to 7-3. *Id.* at 3:67–4:1. IM server 4 manages presence information regarding each of the IM clients. *Id.* at Abstract. In order to perform text chatting, IM server 4 manages a connection between each of the IM clients participating in the chat. *Id.* In order to perform voice chatting, AP server 5 manages a connection between each of the IM clients participating in the chat and MD server 6. *Id.*

Figure 11 of Tanigawa is reproduced below.

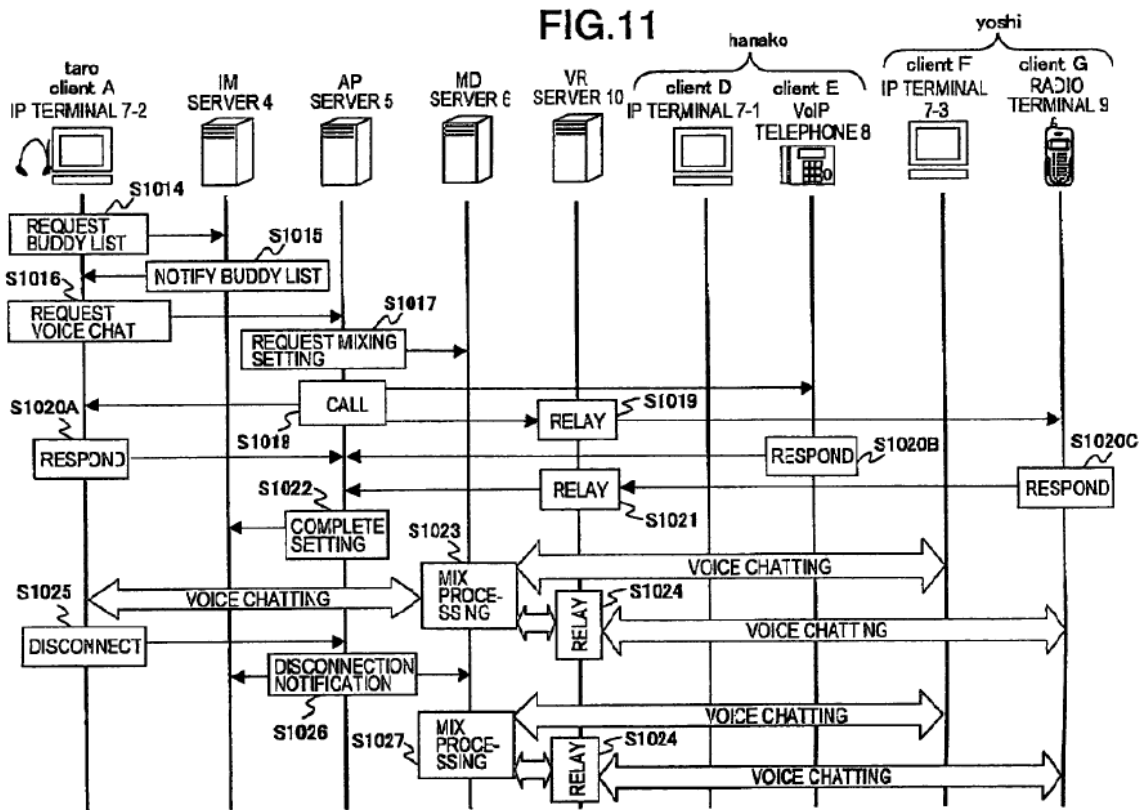


Figure 11 above shows a diagram for an operation of switching from text chat to voice chat. Ex. 1014, 3:17–20. In this example, a user having a nickname “taro” participates in IM using IP terminal 7-2 (with account name “client A”) including both text chat and voice chat functions. *Id.* at 10:32–

36. Another user having a nickname “hanako” participates in the IM using IP terminal 7-1 (with account name “client D”) including only text chat functions, and using VoIP telephone 8 (with account name “client E”). *Id.* at 10:36–42. Another user having a nickname “yoshi” participates in the IM using IP terminal 7-3 (with account name “client F”) including only text chat functions, and using radio terminal 9 (with account name “client G”). *Id.* at 10:42–46.

IP terminal 7-2 receives an instruction for requesting information regarding chat buddies during text chatting from taro and sends the buddy list request to IM server 4 (S1014). *Id.* at 15:10–22. The buddy list is then created and sent to IP terminal 7-2 (S1015), where the list is displayed to taro, so that taro can check whether a buddy in the conference room can voice chat. *Id.* at 15:36–52. Taro determines from the information in the buddy list and through text chatting that the users hanako and yoshi, who are participating in the text chat, can participate in voice chatting using client E and client G, respectively, and also have an intention to participate in voice chatting. *Id.* at 15:53–62.

Taro inputs an instruction for requesting to voice-chat with the IM clients whose account names are client E and client G to input device 44 of IP terminal 7-2. *Id.* at 15:62–65. IP terminal 7-2, in accordance with the instruction for requesting voice chatting from user taro, creates a voice chatting request command, including the names of the IM clients to be invited to the voice chat, and sends the command to AP server 5 (S1016). *Id.* at 15:67–16:11. AP server 5 sends a mixing setting request command to MD server 6 (S1017). *Id.* at 16:12–30. Once processing is completed, a connection for voice chatting is established between the MD server 6 and

each of the IM clients (IP terminal 7-2, VoIP telephone 8, and radio telephone 9). *Id.* at 17:57–60.

2. *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). *Id.* at 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.*

Current participants of an instant messaging session may terminate the instant messaging session and continue the conversation using an alternative type of communication such as voice. *Id.* ¶¶ 126, 176. An appropriate icon or button, such as a convert session button, enables a team member to launch a convert session message to facilitate converting the session to the desired type of communication. *Id.*

3. *Analysis of Claim 1*

Claim 1 recites “providing a conference call requester with a network access device.” Petitioner contends this limitation is disclosed by Tanigawa

in describing a user nicknamed “taro” provided with an IP terminal 7-2 connected to an IP network. Pet. 29–33 (citing Ex. 1014, Figs. 1, 11, 10:32–46, 15:53–65).

Based on Petitioner’s contentions and evidence, we find that Tanigawa discloses this limitation.

Claim 1 recites “said network access device communicating via an instant messaging service.” Petitioner contends this limitation is disclosed by Tanigawa in describing the user taro participating in IM with other users using IP terminal 7-2. Pet. 32–34 (citing Ex. 1014, 6:58–66, 10:32–46).

Based on Petitioner’s contentions and evidence, we find that Tanigawa discloses this limitation.

Claim 1 recites “said instant messaging service being adapted to communicate conference call request information with a conference call server.” Petitioner contends this limitation is disclosed by Tanigawa in describing an IM client such as IP terminal 7-2 being adapted to communicate a voice chatting request command to AP server 5 over the IP network. Pet. 34–37 (citing Ex. 1014, 6:18–22, 6:58–66, 7:57–63, 15:60–16:11, Fig. 11 (step 1016)).

Based on Petitioner’s contentions and evidence, we find that Tanigawa discloses this limitation.

Claim 1 recites “establishing a communications connection from said network access device to the conference call server.” Petitioner contends this limitation is disclosed by Tanigawa in describing IP terminal 7-2 logging in to the IM server to initiate an IM session with IP terminals 7-1 and 7-2, then sending a voice chatting request command to the AP server

during the IM session. Pet. 37–38 (citing Ex. 1014, Figs. 10 and 11, 15:53–16:11).

Based on Petitioner’s contentions and evidence, we find that Tanigawa discloses this limitation.

Claim 1 recites “presenting said conference call requester with a display showing a plurality of potential targets then being connected to said instant messaging service and participating in a given instant messaging session with the conference call requester and with whom a conference call may be initiated.” Petitioner contends this limitation is disclosed by Tanigawa in describing a buddy list displayed at IP terminal 7-2 indicating which buddies participating in the text conference room can voice chat. Pet. 38–40 (citing Ex. 1014, 15:40–52).

Based on Petitioner’s contentions and evidence, we find that Tanigawa discloses this limitation.

Claim 1 recites “generating a conference call request responsively to a single request by the conference call requester, said conference call request identifying each of the indicated potential targets.” This “generating” step limitation contains two phrases, separated by a comma, which the parties address individually. *See, e.g.*, Pet. 32, 35; PO Resp. 15, 19.

“generating a conference call request responsively to a single request by the conference call requester”

The “generating” limitation of claim 1 first recites “generating a conference call request responsively to a single request by the conference call requester,” which Petitioner contends is taught by Tanigawa alone or, alternatively, by the combination of Tanigawa and Liversidge. Pet. 40–43.

Petitioner asserts that Tanigawa discloses a “request by the conference call requester” in describing the user taro inputting into terminal 7-2 an

instruction for requesting to voice-chat with the IM clients corresponding to hanako and yoshi. *Id.* at 40 (citing Ex. 1014, 15:53–65). Petitioner maintains that this is a “single request” as claimed. *Id.* (citing Ex. 1002 ¶ 85). Petitioner further contends that Tanigawa discloses “generating a conference call request responsively” to the request in describing creating a voice chatting request command in response to the instruction from taro requesting a voice-chat. Pet. 40–41 (citing Ex. 1014, 15:66–16:7; Ex. 1002 ¶ 86).

Petitioner maintains, in the alternative, that Liversidge supplies the teaching of the claimed “single request” for generating a conference call request. *Id.* at 41–42. Specifically, Petitioner contends Liversidge discloses that the conference call request is generated “responsively to a single request” in describing a “ConvertSession” button viewable in the instant messaging interface, which enables a user to launch a convert session message to facilitate converting the Instant Messaging session to a voice communications session. *Id.* at 33–34 (citing Ex. 1004 ¶¶ 126, 176; Ex. 1002 ¶ 87).

Petitioner, relying on testimony from Mr. Lipoff, reasons that a person of ordinary skill in the art would use the single ConvertSession button of Liversidge in the interface of Tanigawa to provide the benefit of a simple, user-friendly way to automatically initiate a conference call between participants of an IM session. *Id.* at 29 (citing Ex. 1002 ¶ 69). Petitioner contends that the use of a single button to generate a conference call request as described in Liversidge would operate successfully in the system of Tanigawa and would increase the utility of the graphical interface of Tanigawa by simplifying the interface. *Id.* at 42 (citing Ex. 1002 ¶ 88).

Patent Owner argues that Tanigawa fails to disclose the claimed “single request by the conference call requester,” and “teaches away from the claim language at issue at l[e]ast by expressly requiring what the prosecution history unambiguously disclaims.” PO Resp. 14. According to Patent Owner, Tanigawa discloses the user “first determining which other users can likely participate in voice chatting, and then manually selecting corresponding clients for invitation to participate in voice chatting.” *Id.* at 14–15 (quoting Ex. 1014 (Tanigawa), 15:53–65). Patent Owner contends that Tanigawa “unambiguously requires” the user to make a selection of the call attendees. *Id.* at 16.

As discussed above, there was no prosecution history disclaimer that would narrow the claim by the addition of Patent Owner’s proposed negative limitation. Therefore, we are not persuaded by Patent Owner’s arguments that Tanigawa lacks the negative limitation or teaches away from subject matter having the same.

Even if the claim did include Patent Owner’s proposed negative limitation—namely, excluding user manual selection—we, for the reasons discussed below, do not find Patent Owner’s arguments persuasive because Tanigawa does not disclose requiring manual selection of conference call attendees. *See* Pet. Reply 8 (disputing Patent Owner’s argument).

According to Patent Owner, Tanigawa “unambiguously requires” the user to select each of the conference call attendees. PO Resp. 16. Patent Owner contends that the following portion of Tanigawa discloses the user known as taro selecting attendees for invitation:

Now, it is assumed that, the user “taro” determines, from the information on the buddy list displayed in the display device and by exchanging messages through text chatting, that the users

“hanako” and “yoshi” participating in the conference can participate in voice chatting by using IM client (the VoIP telephone 8 and the radio terminal 9) having the account names “client E” and “client C”, respectively. In addition, it is assumed that the user “taro” determines that each of the users “hanako” and “yoshi” has an intention to participate in voice chatting. *Then, it is assumed that an instruction for requesting to voice-chat with the IM clients whose account names are “client E” and the “client G”, respectively, is input to the input device 44.*

Ex. 1014, 15:53–65 (emphasis added); see PO Resp. 15–16. We agree with Petitioner (Pet. Reply 8) that the first portion of the above-quoted excerpt indicates that taro assesses via IM whether hanako and yoshi are available and wish to participate in a call, but that this assessment does not constitute a manual selection. Tanigawa does not state explicitly that taro manually selects hanako and yoshi for the conference call. Thus, we are left with Patent Owner’s inference based on the last sentence in the quotation above, which recites: “Then, it is assumed that an instruction for requesting to voice-chat with the IM clients whose account names are ‘client E’ [the VoIP telephone associated with hanako] and the ‘client G’ [the radio terminal associated with yoshi], respectively, is input to the input device 44.”

Ex. 1014, 15:62–65; 10:32–46 (identifying the clients). While we agree with Petitioner (Pet. Reply 8) that this sentence teaches the claimed “single request,” we find that it does not teach, as Patent Owner urges, that user taro engaged in the act of manually selecting hanako and yoshi as part of the request. Patent Owner does not suggest, for example, that there are any participants other than taro, hanako, and yoshi in the IM session such that an act of selecting resulted in a subset of IM participants being transferred to the conference call. See Pet. Reply 8–9 (explaining how all of the IM participants capable of voice chatting are invited to the voice chat), 11

(“Three, and only three, users are participating in the text session, and all three of the users are converted to the voice chat when taro issues the instruction.”).

In further support of its argument that Tanigawa unambiguously requires manual selection of call participants by the user, Patent Owner asserts that:

With reference to Figure 11, *Tanigawa* discloses that the user taro again accesses the available presence information and then selects which clients to invite to a voice chat. *See, e.g.*, EX1014 at S1014 and at 15:10-16:16; EX2001 ¶¶ 45-46. In the example provided in *Tanigawa*, taro chooses to select Client E and Client G for invitation to a voice chat. *Id.*

PO Resp. 7. We understand Patent Owner’s citation of “S1014” to refer to the method step bearing that number as shown on Figure 11. The box for step S1014 recites “REQUEST BUDDY LIST.” Ex. 1014, Fig. 11. We fail to see, and Patent Owner does not explain adequately, how the mere request for a buddy list constitutes manual selection of invitees, from the buddy list or otherwise, by the user.

Additionally, Patent Owner’s use of a citation to a lengthy discussion in *Tanigawa*—line 10 of column 15 through line 16 of column 16—without a more precise pinpoint citation, and without adequate elaboration, does not help us understand Patent Owner’s basis for the assertion that user selection for voice chat is unambiguously required. *See* PO Resp. 16. The cited section of *Tanigawa* discusses step S1014 (request list of chat buddies during text chatting, Ex. 1014, 15:10–18) through step S1017 (mixing setting request after receipt of the voice chatting request command, *id.* at 16:12–30). While it appears that there is no disagreement that, within that string of steps, there is an issuance of a request to switch from instant

messaging to voice communication, Patent Owner does not adequately explain its theory as to how there is a disclosure of taro manually selecting participants for the call.

We do not find Patent Owner's cited portions of Mr. Easttom's declaration to be helpful or persuasive either. See PO Resp. 9 (citing Ex. 2001 ¶¶ 45–46). The essence of Mr. Easttom's opinion is a conclusory assertion that “[j]ust like Figure 10 [where taro selects participants for the IM session], taro then selects which clients it would like to voice chat with to request a voice chat.” Ex. 2001 ¶¶ 40–43 (describing Figure 10), 46 (citing Ex. 1014 “at S1016,” 15:40–16:16, and “specifically” 15:63–65); see also *id.* at ¶¶ 60–62 (similar opinion in the context of Patent Owner's “teach away” argument). The specifically cited portion is the same sentence emphasized above: “Then, it is assumed that an instruction for requesting to voice-chat with the IM clients whose account names are ‘client E’ and the ‘client G’, respectively, is input to the input device 44.” Ex. 1014, 15:63–65. Mr. Easttom equivocates on the possible meaning of this sentence, testifying only that “taro *can* choose to select client E and client G of Figure 11.” Ex. 2001 ¶ 46 (emphasis added). Even if correct, the opinion that the user *can* choose call participants does not support Patent Owner's argument that Tanigawa discloses requiring the act of manual choosing (selection) or the performance thereof. Importantly, Mr. Easttom does not explain adequately why user taro, after selecting and initiating an IM session with hanako and yoshi, would need to again select those same people when switching to voice chat. In other words, Mr. Easttom does not explain adequately why the cited sentence represents a requirement to take any action beyond merely issuing a request to voice-chat with the IM clients

(e.g., phones) associated with the other two persons involved in the IM session.

Having considered the parties' arguments and the evidence, we find that a person of ordinary skill in the art would understand Tanigawa to disclose, or at least suggest, generating a conference call request responsively to a single request by the conference call requester, as recited in claim 1. We further find that, even under Patent Owner's disclaimer theory, Tanigawa does *not* disclose the action that is purportedly precluded by Patent Owner's proposed negative limitation—the user's manual selection of attendees for the invitation to the conference call.

Accordingly and even if there was a disclaimer, we again do not find to be persuasive Patent Owner's argument that Tanigawa “fails to disclose and teaches away from the claim language at issue at [least] by expressly requiring what the prosecution history unambiguously disclaims.” PO Resp. 14; *see id.* at 16–17; *cf.* Pet. Reply 15 (Petitioner arguing: “But even if it had taught attendee selection, it is not clear how this would teach away from a streamlined system where selection would be boiled down to a single request, as taught by *Liversidge*”). Tanigawa does not teach that which Patent Owner characterizes as a teaching away.

Patent Owner also argues that Tanigawa is cumulative of Haims (the reference that is the subject of Patent Owner's prosecution history disclaimer argument) and contends that this “cumulative teaching” would lead a person of ordinary skill away from “generating a conference call request responsively to a single request” under Patent Owner's proposed construction. PO Resp. 16. Patent Owner does not explain how, even if Tanigawa is “cumulative” of Haims, a person of ordinary skill in the art

would be discouraged from using Liversidge’s single ConvertSession button in the interface of Tanigawa. *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”).

Patent Owner, further building on its unpersuasive assertion that Tanigawa requires selection by the user in order to initiate a conference call, argues that the combination of the teachings of Tanigawa and Liversidge would render Tanigawa inoperable for its intended purpose. PO Resp. 17–18. Patent Owner contends that using Liversidge’s ConvertSession button, rather than Tanigawa’s purported “feature that enables a user to subjectively select the clients for invitation to a conference call” would result in a system that requires the system to read the user’s mind in order to determine which IM participants should be selected for the conference call. *Id.* Patent Owner’s theory again is rooted in the incorrect assertion that Tanigawa requires the user to select the attendees. Notably, Patent Owner does not offer a precise citation to any expert testimony on the fact-specific inquiry of whether something would be inoperative for its intended purpose. *See id.*; *but see id.* at 1 (Patent Owner listing its “overarching” arguments, including the inoperability assertion, with the citation “*See generally* Declaration of Chuck Easttom II (‘EX2002’)”). Petitioner, however, did locate Mr. Easttom’s testimony regarding inoperability and correctly characterizes it as too conclusory to be given anything more than little weight. Pet. Reply 16–17 (citing Ex. 2001 ¶ 70). Petitioner’s expert, Mr. Lipoff, credibly testifies that Tanigawa and Liversidge both describe similar systems for

converting an IM session to a conference call and that a person of ordinary skill would have understood that using a single button to generate a call request as described in Liversidge would also operate successfully in Tanigawa. Ex. 1002 ¶¶ 85–88.

“said conference call request identifying each of the indicated potential targets”

The “generating” limitation of claim 1 also recites “said conference call request identifying each of the indicated potential targets.” Petitioner contends this is disclosed in Tanigawa’s description of the voice chatting request command as including the names, client addresses, and client nicknames of the “clients to be invited [to] the chat.” Pet. 43 (quoting Ex. 1014, 15:66–16:7). Petitioner asserts that the “clients to be invited” are the claimed “potential targets” for the conference call. *Id.* (citing Ex. 1002 ¶ 89).

Patent Owner argues that Liversidge does not disclose and, rather, teaches away from identifying each potential target. PO Resp. 18 (quoting an assertion made by Petitioner in a different case and citing Ex. 2001 ¶ 64). These arguments are not persuasive because Petitioner’s articulated combination relies on Tanigawa and not Liversidge for this feature, and Patent Owner does not explain how Liversidge’s alleged failure to disclose the feature constitutes a teaching away from the combination. Pet. 43; PO Resp. 18–19; Pet. Reply 17; *see also* Ex. 2001 ¶ 64 (the cited portion of Patent Owner’s expert’s declaration lacking an opinion that Liversidge’s alleged lack of the feature teaches away from the proposed combination).

Patent Owner further argues that Tanigawa cannot cure the alleged deficiencies of Liversidge. PO Resp. 19–20. As Petitioner notes (Pet. Reply 17–18), Patent Owner’s arguments focus on whether certain of Tanigawa’s

client devices have voice or text capability, rather than Tanigawa's disclosures related to users. Tanigawa, in the portion upon which Petitioner relies, pertains to "creat[ing] a voice chatting request command including various informations (such as the account names, the client addresses and the client nicknames) of the IM client of the user 'taro' and the IM clients to be invited the chat, and the address and the nickname of the participating conference room." Ex. 1014, 16:2–7; *see* Pet. 43 (citing and quoting Ex. 1014, 15:66–16:7)). Tanigawa labels devices as specific "clients," with those devices including a VoIP telephone, an IP terminal, and a radio terminal. *See, e.g.*, Ex. 1014, 15:53–59, Fig. 11. For example, user hanako has an IP terminal ("client D") and a VoIP telephone ("client E"). *See id.* at Fig. 11. While Tanigawa does refer to "voice-chat[ting] with IM clients" (Ex. 1014, 15:63), the context makes clear that Tanigawa discloses user taro seeking to voice-chat by, *e.g.*, phone with users hanako and yoshi, those same users involved in the IM session, rather than seeking to text-chat with a device having only voice capabilities, contrary to Patent Owner's apparent arguments.⁹ *See, e.g., id.* at 15:53–59 ("Now, it is assumed that, the user 'taro' determines, from the information on the buddy list displayed in the display device and by exchanging messages through text chatting, that the

⁹ Much of Patent Owner's argument is that a preliminary determination in the institution decision mischaracterizes Tanigawa. PO Resp. 19. We admittedly could have been more precise in the institution decision when referring to clients. *See* Paper 10, 15 ("Clients E and G, corresponding to users named 'hanako' and 'yoshi,' appear to be the only clients in the IM session who are both present and capable of voice chat."). Nonetheless, we find to be unhelpful Patent Owner's focus on our loose language in the institution decision rather than the Tanigawa's disclosure as understood by one of ordinary skill in the art or of Petitioner's articulation of the ground.

users ‘hanako’ and ‘yoshi’ participating in the conference can participate in voice chatting by using IM client (the VoIP telephone 8 and the radio terminal 9) having the account names ‘client E’ and ‘client C’, respectively.”); Ex. 1002 ¶¶ 82–86, 89; *see* PO Resp. 19 (Patent Owner equating Tanigawa’s “IM clients” with specific devices rather than users). As Petitioner correctly notes, the ’948 patent describes a “target” as a user rather than the specific devices employed by the user. Pet. Reply 18 (quoting, *inter alia*, Ex. 1001, 7:1–2 (“[E]ach of the conference call targets have an NAD [i.e. a device] in communication with an instant messaging service.”)).

We agree with Petitioner and find that Tanigawa discloses a conference call request identifying each of the indicated potential targets as claimed. Accordingly, Tanigawa does not contain the alleged deficiency so there is no need to turn to Liversidge to cure it.

Patent Owner further argues that Tanigawa and Liversidge “teach different approaches and systems that are incompatible with one another” and that this renders the reason to combine the references’ teachings as “illusory.” PO Resp. 20 (citing Ex. 2001 ¶¶ 66–67). Specifically, Patent Owner asserts that Tanigawa’s system involves client-side user selection while Liversidge discloses attendee selection being done automatically at a central server. *Id.* Patent Owner relatedly argues that Liversidge’s disclosure of action being performed at the central server constitutes a teaching away from the proposed combination, reasoning that it would be inefficient and redundant to also have client-side identification of each of the potential participants. *Id.* (citing Ex. 2001 ¶¶ 66–67).

As discussed above, Petitioner, in the proposed combination, relies on

Tanigawa for the teaching of this limitation and relies on Liversidge for the teaching of the ConvertSession button. Neither Patent Owner nor its expert explains adequately why one of ordinary skill in the art would have understood that the implementation of Liversidge's ConvertSession button in Tanigawa's system implicates the purported client-side/server-side distinction asserted by Patent Owner. We do not find the purported distinction to negate the reason to combine the references' teachings, namely, that the ConvertSession button of Liversidge would simplify the graphical interface of Tanigawa, providing the benefit of a simple, user-friendly way to automatically initiate a conference call between participants of an IM session.

Having considered the parties' arguments and the evidence, we find that a person of ordinary skill in the art would have understood Tanigawa to disclose the conference call request identifying each of the indicated potential targets, as claimed, and would have reason to combine the teachings of Tanigawa and Liversidge as proposed by Petitioner.

Claim 1 recites "transmitting said conference call request from said network access device to said conference call server." Petitioner contends this limitation is disclosed by Tanigawa in describing IP terminal 7-2 sending the voice chatting request command to the AP server over the IP network. Pet. 43–44 (citing Ex. 1014, 16:7–11, Fig. 11).

Based on Petitioner's contentions and evidence, we find that Tanigawa discloses this limitation.

Claim 1 recites "automatically establishing a conference call connection to said conference call requester, said conference call connection

initiated by said conference call server, said conference call connection further being connected to each of the potential targets.”

Petitioner contends Tanigawa discloses this limitation in describing an AP server that receives the voice chatting request identifying each target from the IP terminal 7-2, and establishes a connection for voice chatting that connects the requester, “taro,” and each of the targets, “hanako” and “yoshi.” *Id.* at 45 (citing Ex. 1014, 15:59–17:39, 17:57–60, 26:53–57). In particular, Petitioner contends Tanigawa discloses a method of switching from a text session to a group voice chat as one continuous process. *Id.* (citing Ex. 1014, 15:59–62, 26:53–57; Ex. 1002 ¶ 92). Petitioner contends that a requester, “taro,” inputs an instruction requesting voice chat, and IP terminal 7-2 creates and sends a request identifying each target to the AP server. *Id.* (citing Ex. 1014, 15:62–16:11). Petitioner contends that after the AP server has completed processing the request, a connection for voice chatting is established that connects the conference call requester, “taro,” and each of the targets, “hanako” and “yoshi.” *Id.* (citing Ex. 1014, 16:12 –17:39, 17:57–60). Petitioner contends that a person of ordinary skill in the art would have understood the AP server establishes the connection automatically because the conference call is established in direct response to IP terminal 7-2 transmitting its request command over the IP network to the AP server, without further interaction from the user. *Id.* at 45–46 (citing Ex. 1002 ¶ 92).

We are persuaded by Petitioner’s contention and find that Tanigawa describes the conference call connection being automatically established responsively to the transmitted conference call request as recited in claim 1. Based on Petitioner’s contentions and evidence, we find that Tanigawa

teaches this limitation. Having found that Tanigawa teaches this limitation, we need not reach Petitioner's argument, offered in the alternative, that Liversidge also teaches automatic connection. Pet. 45–48.

Conclusion Regarding Claim 1

The combination of Tanigawa and Liversidge 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. In sum, upon consideration of all the evidence, we conclude that Petitioner has shown by a preponderance of the evidence that the subject matter of independent claim 1 would have been obvious over Tanigawa and Liversidge.

4. Discussion of Dependent Claims 2–4, 6–8, 18, 21, and 22

Claims 2–4, 6–8, 18, 21, and 22 each depends directly or indirectly from claim 1. Petitioner sets forth a specific analysis of the limitations appearing in these dependent claims that cites to the previous analysis of claim 1. Pet. 48–63. Patent Owner does not offer specific and separate arguments for the dependent claims. PO Resp. 21. Rather, Patent Owner relies on and references its earlier unpersuasive arguments for independent claim 1—that Tanigawa teaches away from certain limitations and therefore Tanigawa and Liversidge cannot be combined or modified to arrive at the claimed subject matter, and that the proposed combination renders Tanigawa inoperable for its intended purpose. *Id.*

We have reviewed Petitioner’s explanations and supporting evidence regarding dependent claims 2–4, 6–8, 18, 21, and 22, and we determine that Petitioner, for the reasons set forth in its analysis, has shown by a preponderance of the evidence that dependent claims 2–4, 6–8, 18, 21, and 22 are unpatentable under 35 U.S.C. § 103 over Tanigawa and Liversidge.

E. Constitutionality of Inter Partes Review

Patent Owner challenges the constitutionality of *inter partes* review based on the then-pending review of that issue by the United States Supreme Court. PO Resp. 21–22 (citing *Oil States Energy Servs., LLC v. Greene’s Energy Grp., 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 Servs., 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 1–4, 6–8, 18, 21, and 22 of the ’948 patent are unpatentable under 35 U.S.C. § 103 as obvious over Tanigawa and Liversidge.

IV. ORDER

Accordingly, it is

ORDERED that claims 1–4, 6–8, 18, 21, and 22 of the '948 patent 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.

IPR2017-01685
Patent 7,804,948 B2

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