

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EPIC GAMES, INC.,
Petitioner,

v.

INGENIOSHARE, LLC,
Patent Owner.

IPR2022-00291
Patent 10,708,727 B2

Before JONI Y. CHANG, PATRICK M. BOUCHER, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

BOUCHER, Administrative Patent Judge.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

Epic Games, Inc. (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–9 and 15–17 of U.S. Patent No. 10,708,727 B2 (Ex. 1001, “the ’727 patent”). Paper 1 (“Pet.”). IngenioShare, LLC (“Patent Owner”) filed a Preliminary

Response. Paper 7 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply.¹ Paper 9; *see* Paper 8.

We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4. Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we grant the Petition and institute an *inter partes* review. The Board has not made a final determination regarding the patentability of any claim.

I. BACKGROUND

A. The ’727 Patent

The ’727 patent relates to “automatically remov[ing] unwanted communications.” Ex. 1001, 3:33–34. Figure 6 of the ’727 patent is reproduced below.

¹ We also authorized Patent Owner to file a Sur-reply, but Patent Owner did not do so. *See* Paper 8.

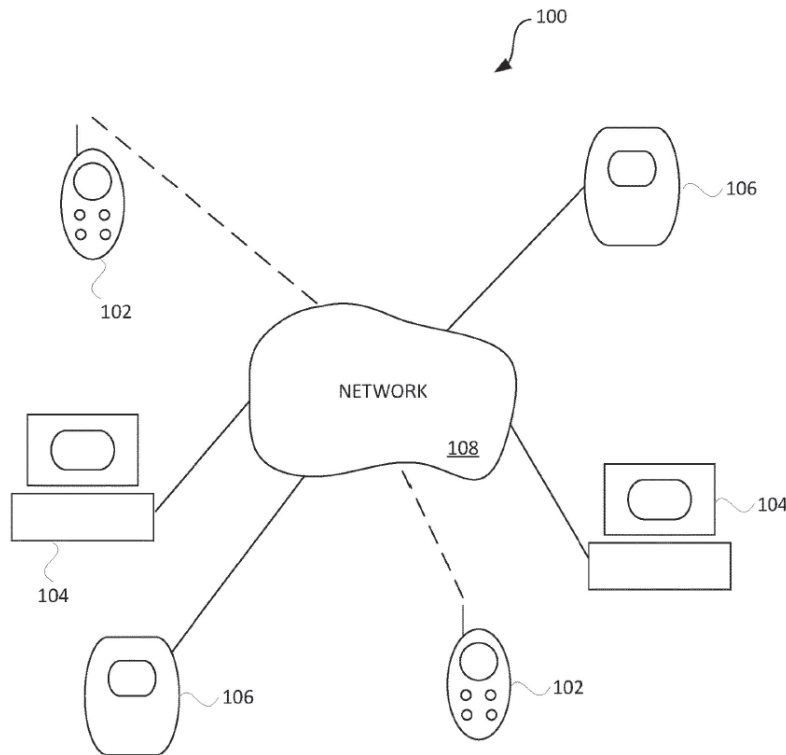


FIG. 6

Figure 6 depicts communication system 100, which can support different communication devices, including mobile telephones 102, computers 104, and/or wireless personal digital assistants 106. *Id.* at 8:16–21. Users of such communication devices can communicate “with like or different communication devices,” each of which offers one or both of audio or text communication capabilities. *Id.* at 8:21–24. Intercommunication of devices 102–106 can take place through network 108, which “can include one or more of voice networks and data networks.” *Id.* at 8:24–27.

With the system, “[a] communication gateway or a portal is formed,” thereby allowing a user “to receive communications from numerous sources through different modes.” *Id.* at 4:3–5. “Based on the portal, the user can securely determine who can reach him at what conditions.” *Id.* at 4:15–16.

Such conditions may include the status of the user, “access priorities” of the person trying to reach the user, and/or the urgency of the message from the person. *Id.* at 4:17–22.

The following table is reproduced from the ’727 patent.

Alice (Wife)	ContactClass1
Peter (Close Friend)	ContactClass2
Colina (Close Friend’s wife)	ContactClass2

The table identifies relationships of different people to a particular user, as well as “ContactClasses” to which such people are assigned and which reflect the various access priorities. *Id.* at 6:4–10. By way of example, if Peter wants to make a mobile phone call to the user, Peter calls the portal, which can be the user’s internet service provider. *Id.* at 6:12–14. After verifying Peter’s identity, the portal establishes contact by creating a virtual address for a communication session and determines that Peter belongs to “ContactClass2.” *Id.* at 6:14–30. The portal implements various options depending on the status of the user, Peter’s access priority according to his ContactClass, and Peter’s urgency setting. *Id.* at 6:35–37. Such options include allowing the user to receive Peter’s call directly or asking Peter to leave a voicemail message, with the user notified of Peter’s call by a short mobile message. *Id.* at 6:35–40. In some instances, communication requests can be classified into “different degrees of undesirability,” thereby automatically blocking some requests from the user or automatically diverting them to be handled by another mechanism, “such as diverting a phone call to an email or voice mail.” *Id.* at 4:37–42.

B. Illustrative Claim

Independent claim 1, the only independent claim of the '727 patent, is illustrative of the challenged claims and is reproduced below.

1. A computer-implemented method to facilitate electronic communication of a plurality of users using at least a network-based portal at least based on Internet protocol, the method comprising:

providing a plurality of modes of communication to a first user to allow the first user to use one of the plurality of modes of communication as a selected mode of communication for a first message to be sent from the first user to a second user, based on an identifier associated with the first user previously set by the first user via the network-based portal,

wherein the plurality of modes of communication supported by the network-based portal include at least text communication using a personal computer, voice communication using a personal computer, and communication with at least an image, and

wherein messages are eligible to be received by the second user via the network-based portal, based on any of the plurality of modes of communication, all depending on an identifier associated with the second user previously set by the second user via the network-based portal, which allows the second user to efficiently maintain the second user's communication using the plurality of modes of communication;

enabling the second user to block the first user from using at least the selected mode of communication to communicate with the second user via the network-based portal, based on the identifier associated with the first user;

enabling the first message to be provided to the second user, using the selected mode of communication, depending on the identifier associated with the second user, in view of the second user not blocking the first user from using the selected mode of communication to communicate with the second user, via the network-based portal; and

receiving a second message from the second user to the first user, to respond to the first message, after the second user has received the first message,

wherein one of the first message or the second message is voice and the other of the first message or the second message is text,

wherein even when the first message is received by the second user via the selected mode of communication, contact information associated with the second user and provided by the second user to the network-based portal is not provided via the network-based portal to the first user, and contact information associated with the first user and provided by the first user to the network-based portal is not provided via the network-based portal to the second user, so as to provide an option to the second user to keep the contact information associated with the second user confidential from the first user, and to provide an option to the first user to keep the contact information associated with the first user confidential from the second user,

wherein the identifier associated with the second user is distinct from the contact information associated with the second user, and the identifier associated with the first user is distinct from the contact information associated with the first user,

wherein the contact information associated with the second user includes at least one of a phone number or an email address of the second user, and

wherein the contact information associated with the first user includes at least one of a phone number or an email address of the first user.

Ex. 1001, 19:61–20:63.

C. Evidence

Petitioner relies on the following references:

Diacakis	US 2002/0116461 A1	Aug. 22, 2002	Ex. 1007
Loveland	US 7,287,056 B2	Oct. 23, 2007	Ex. 1008
Takahashi	US 2002/0183114 A1	Dec. 5, 2002	Ex. 1009

Tanigawa	US 2004/0001480 A1	Jan. 1, 2004	Ex. 1010
Hullfish	US 7,428,580 B2	Sept. 23, 2008	Ex. 1011

In addition, Petitioner relies on a Declaration by Kevin C. Almeroth, Ph.D. Ex. 1003.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–9 and 15–17 on the following grounds.
Pet. 6.

Claim(s) Challenged	35 U.S.C. § ²	References
1–6, 15, 17	103(a)	Diacakis
7–9	103(a)	Diacakis, Loveland
16	103(a)	Diacakis, Takahashi
1–3, 6, 15, 17	103(a)	Tanigawa, Hullfish
7–9	103(a)	Tanigawa, Hullfish, Loveland
16	103(a)	Tanigawa, Hullfish, Takahashi

E. Real Parties in Interest

The parties identify only themselves as real parties in interest. Pet. 2; Paper 5, 2.

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102 and 103 effective March 16, 2013. Petitioner asserts that, “[b]ased on the claimed priority date of the ’727 patent, Pre-AIA versions of §102(a) and §103 apply.” Pet. 4 n.1. Patent Owner does not contest that the pre-AIA versions apply, and we apply those versions herein.

F. Related Matters

The parties identify *IngenioShare, LLC v. Epic Games, Inc.*, No 6:21-cv-00663 (W.D. Tex.) (“the related litigation”) as a related matter. Pet. 2; Paper 5, 2.

In addition, Patent Owner notes that related patents are challenged by Petitioner in IPR2022-00202, IPR2022-00294, IPR2022-00295, and IPR2022-00297. Paper 5, 2–3.

II. ANALYSIS

A. Legal Principles

A claim is unpatentable for obviousness 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) when in evidence, objective indicia of nonobviousness, i.e., secondary considerations.³ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

³ At this time, the parties do not address objective indicia of nonobviousness, which accordingly do not form part of our analysis. See Pet. 90 (“Petitioner is unaware of any evidence of secondary considerations that would support a finding of non-obviousness.”)

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)); see *In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016) (citing *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006)).

B. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person of ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). “This legal construct is akin to the ‘reasonable person’ used as a reference in negligence determinations” and “also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan.” *Id.* (citing *In re Carlson*, 983 F.2d 1032, 1038 (Fed. Cir. 1993)).

Petitioner proposes that a person of ordinary skill in the art “would have had a Bachelor’s degree in Computer Science, or an equivalent field, and three to five years of experience working with Internet communication

systems.” Pet. 25. According to Petitioner, “[a]dditional education might compensate for less experience, and vice-versa.” *Id.* Dr. Almeroth supports this articulation, and Patent Owner does not, at this time, propose any different articulation. *See* Ex. 1003 ¶¶ 92–97.

Because we find Petitioner’s proposal reasonable, consistent with the level of skill reflected by the prior art, and supported by the testimony of Dr. Almeroth, we adopt it for purposes of this Decision. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art may reflect an appropriate level of skill in the art).

C. Claim Construction

The Board uses “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2021); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). Although “Petitioner does not believe that any terms need to be construed to assess the arguments presented” in its Petition, Patent Owner raises an issue with respect to the challenged claims’ recitation of a “network-based portal.” *See* Pet. 25; Prelim. Resp. 15–16. In particular, Patent Owner contends that “[t]he specification of the ’727 Patent uses the term ‘network-based portal’ consistently as being at the server-side of a network.” Prelim. Resp. 15.

Patent Owner supports its contention by identifying examples where the specification of the ’727 patent describes a “portal” as separate from a

“mobile phone” or from a person’s “wireless device.” *Id.* at 15–16 (citing Ex. 1001, 6:12–13, 6:32–33, 6:55–63, 16:1–3). But the specification also includes numerous examples where the portal functionality is implemented in a “mobile phone,” i.e., a client-side device. *See* Ex. 1001, 3:10–19, 9:3–10:2, 10:17–13:27, 14:64–15:54, Figs. 7–11. For example, the specification explains that a “mobile communication device,” such as a “mobile telephone,” may perform steps depicted in Figures 7 through 11. *See id.* at 9:4–8, 10:17–28, 11:60–12:5, 13:1–9, 14:7–13, 14:66–67, 15:44–46; *see also id.* at 14:36–38 (identifying a “mobile telephone” as an example of a “mobile communication device), 17:53–55 (same). And Patent Owner categorizes a “mobile phone” as a client-side device. *See* Prelim. Resp. 16–22. To adopt Patent Owner’s exclusion of client-side functionality from the scope of the recited “network-based portal” would thus exclude preferred embodiments. *See PPC Broadband, Inc. v. Corning Optical Commc’ns RF, LLC*, 815 F.3d 747, 755 (Fed. Cir. 2016). Accordingly, for purposes of this Decision, we decline to adopt such an exclusion. The parties will have an opportunity to elaborate on their positions for proper construction of “network-based portal” during the trial.

On the record before us, we do not find it necessary to construe any other term for purposes of this Decision. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Overview of the Prior Art

1. Diacakis

Diacakis “relates generally to communications and, more particularly, to presence and availability management systems.” Ex. 1007 ¶ 3. Figure 1 of Diacakis is reproduced below.

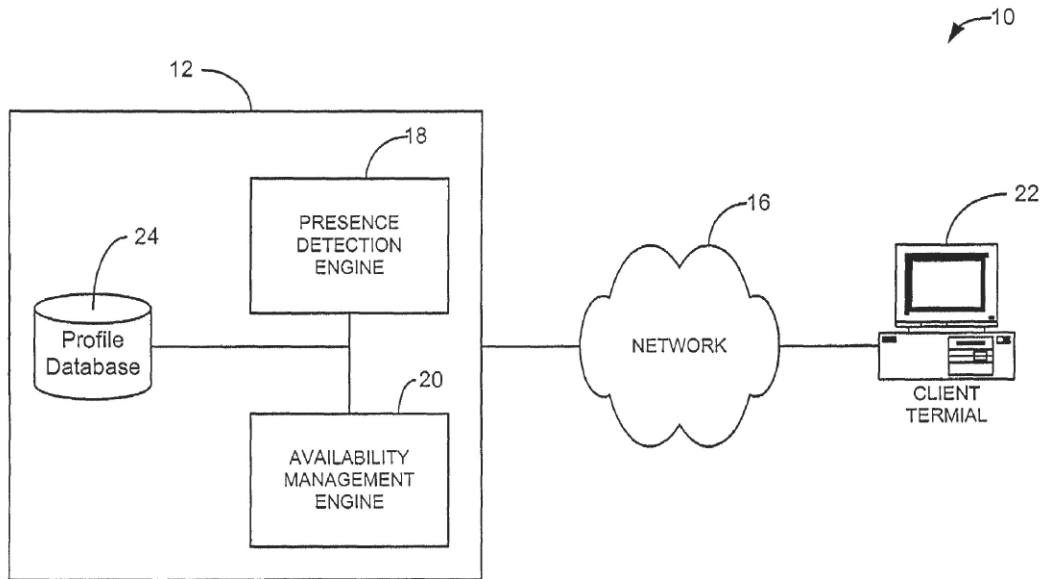


Fig. 1

Figure 1 is a diagram of “a presence and availability (P&A) management system.” *Id.* ¶ 24. System 10 includes P&A management server 12 in communication with client terminal 22 via network 16. *Id.* P&A management server 12 includes presence detection engine 18, availability management engine 20, and profile database 24. *Id.* Functions of P&A management server 12 include determining whether a user is *present* on the network, determining whether the user is *available* on the network, and communicating such presence and availability information to others, depending on the user’s preferences. *Id.* ¶¶ 24–27.

Figure 4 of Diacakis is reproduced below.

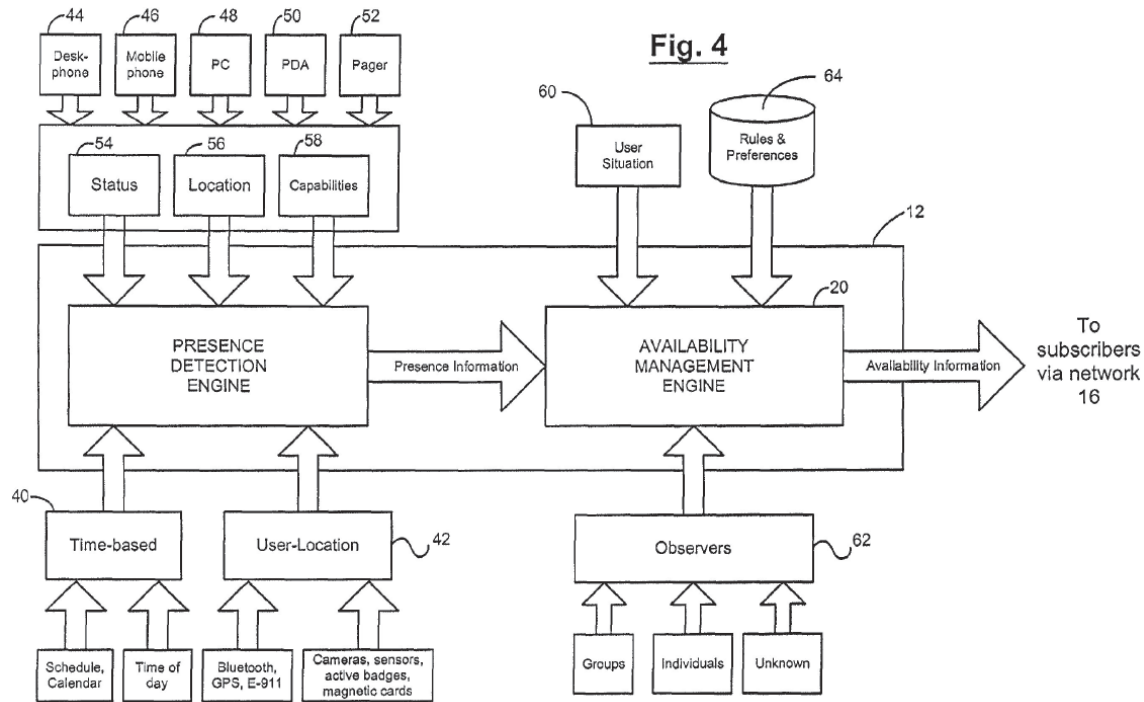


Figure 4 is a diagram illustrating details of P&A management server 12. *Id.* ¶¶ 15, 38. As illustrated, presence detection engine 18 may be in communication with various devices to help determine presence information, such as landline desk phone 44, mobile phone 46, personal computer 48, personal digital assistant 50, and pager 52. *Id.* ¶¶ 43–44. Based on the information from such devices, presence detection engine may determine an individual’s status 54 on particular networks, the individual’s physical location 56, and the individual’s capabilities 58. *Id.* ¶ 45.

Presence information determined by presence detection engine 18 is communicated to availability management engine 20. *Id.* ¶ 46. Such presence information, in combination with the individual’s situation 60 and the individual’s rules and preferences 64, is used to determine the individual’s availability. *Id.* ¶¶ 46–47. “Additionally, the individual may specify the observers 62 who receive the individual’s contact information,”

with such observers 62 specified on a “group basis or an individual basis.”
Id. ¶ 47.

2. Tanigawa

Tanigawa “relates to a communication technology such as Instant Messaging (IM),” and endeavors “to achieve group chat using multimedia.”
Ex. 1010 ¶¶ 1, 8. Figure 1 of Tanigawa is reproduced below.

FIG.1

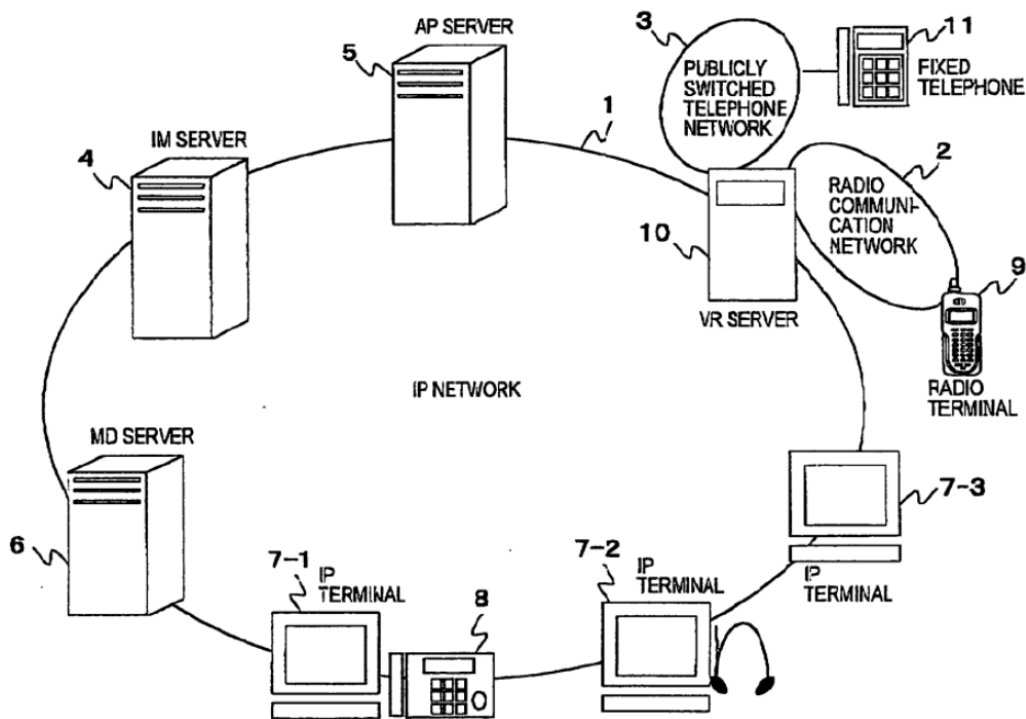


Figure 1 is a schematic diagram of a voice-over-IP (“VoIP”) communication system that includes a variety of communication devices, such as IP terminals 7, fixed telephone 11, and mobile telephone 9. *Id.* ¶¶ 34–35. IM server 4 “manages presence information of an IM client,” AP server 5 “manages connections for a voice chat using VoIP,” MD server 6 “implements multi-party voice speech by mixing voice data,” and VR

server 10 “performs voice relay” with publicly switched telephone network 3 and radio communication network 2. *Id.* ¶ 35.

Figure 3 of Tanigawa is reproduced below.

FIG.3

431 ACCOUNT NAMES	432 CLIENT ADDRESSES	433 CLIENT NICKNAMES	434 AUTHENTICATION KEYS	435 PRESENCE	436 USABLE MEDIA	437 CONFERENCE ADDRESSES	438 CONFERENCE NICKNAMES	439 BUDDY LIST	440
Client A	***,***,***,***	taro	***	text/voice	text/voice	***,***,***/ ***,***,***	room1	A,B,C,D,E,F,G...	
Client B	***,***,***,***	jiro	***	off	text/voice	***,***,***		A,B,C,D,E,F,G...	
Client C	***,***,***,***	ichiro	***	idle	text	***,***,***		A,B,C,D,E,F,G...	
Client D	***,***,***,***	hanako	***	text	text	***,***,***	room1	A,B,C,D,E,F,G...	
Client E	***,***,***,***	hanako	***	voice	voice	***,***,***	room1	A,B,C,D,E,F,G...	
Client F	***,***,***,***	yoshi	***	text	text	***,***,***	room1	A,B,C,D,E,F,G...	
Client G	***,***,***,***	yoshi	***	voice	voice	***,***,***	room1	A,B,C,D,E,F,G...	
...	...	...	...	...	...	...	...	...	

PRESENCE INFORMATION MANAGEMENT TABLE 488

Figure 3 is an example of a “presence management table” used by IM server 4 to manage presence information. *Id.* ¶ 49; *see id.* ¶¶ 40, 47. Chat participants are identified by nicknames 433, with the same nickname being used for a particular user across all devices. *Id.* ¶¶ 133, 194. This is illustrated in Figure 3, for example, for devices D and E, both of which belong to “hanako,” and for devices F and G, both of which belong to “yoshi.” *See id.* ¶ 50.

Figure 12 of Tanigawa is reproduced below.

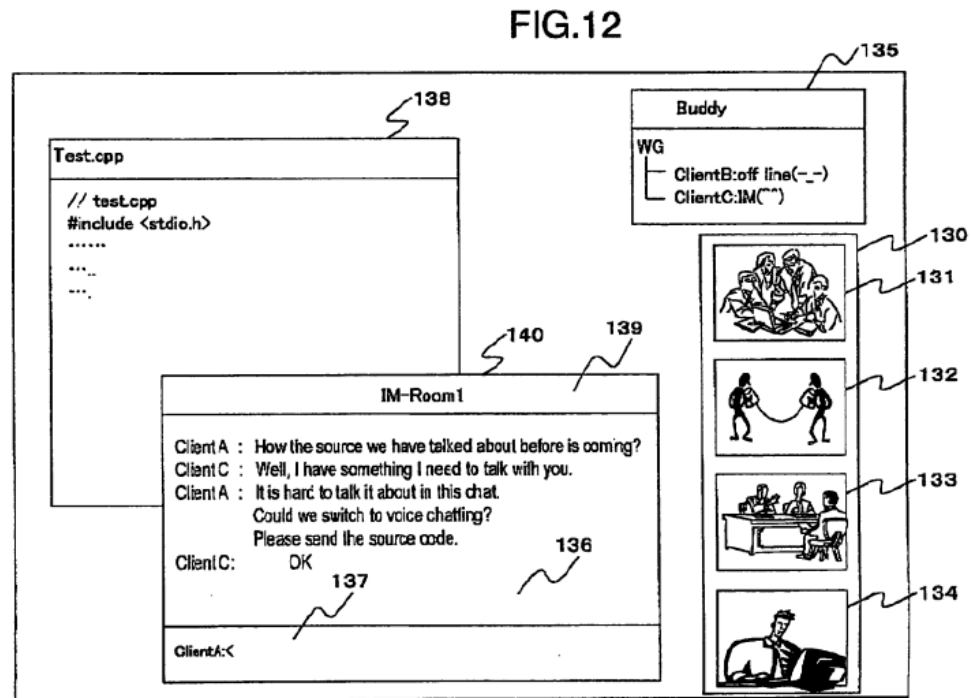


Figure 12 shows an example of a user interface of an IM client, such as may be displayed on IP terminal 7. *Id.* ¶ 162. Display area 135 shows presence information of “chatting buddies.” *Id.* ¶ 164. In addition, several chatting options are provided on main menu bar 130, which includes icon 131 “indicating an operation relating to presence information,” icon 132 indicating one-to-one voice chatting, icon 133 indicating multiparty voice chatting, and icon 134 “indicating text chatting.” *Id.* ¶ 163.

3. *Hullfish*

Hullfish “relates to electronic messaging systems in a computer environment.” Ex. 1011, 1:6–9. Figure 5 of Hullfish is reproduced below.

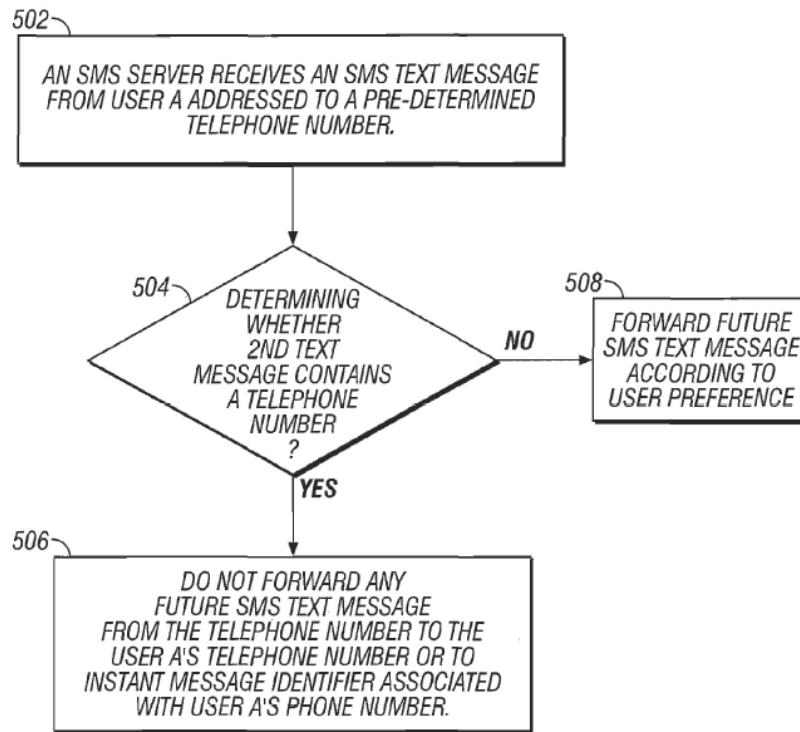


FIG. 5

Figure 5 is a flow diagram depicting a method that incorporates a privacy feature into receiving short-message-service (“SMS”) text messages. *Id.* at 8:59–61. The method is implemented when a first user (“User A”) wants to stop receiving messages from a second user (“User B”). *Id.* at 8:62–64. To implement this, User A sends a text message containing User B’s telephone number to a predetermined telephone number. *Id.* at 9:1–4. Thus, when an SMS server receives a text from User A at the predetermined telephone number at step 502, it is determined at step 504 whether the text contains a telephone number, i.e., User B’s number. *Id.* at 9:5–9. If so, future messages from User B to User A are blocked at step 506. *Id.* at 9:9–18. Otherwise, future messages are forwarded “according to user preference” at step 508. *Id.* at 9:30–33.

4. Loveland

Loveland “relates to methods, systems and computer program products for notifying a user of an event via voice notifications or other notification methods depending on the user’s dynamic circumstances.”

Ex. 1008, 1:8–11. Figure 3 of Loveland is reproduced below.

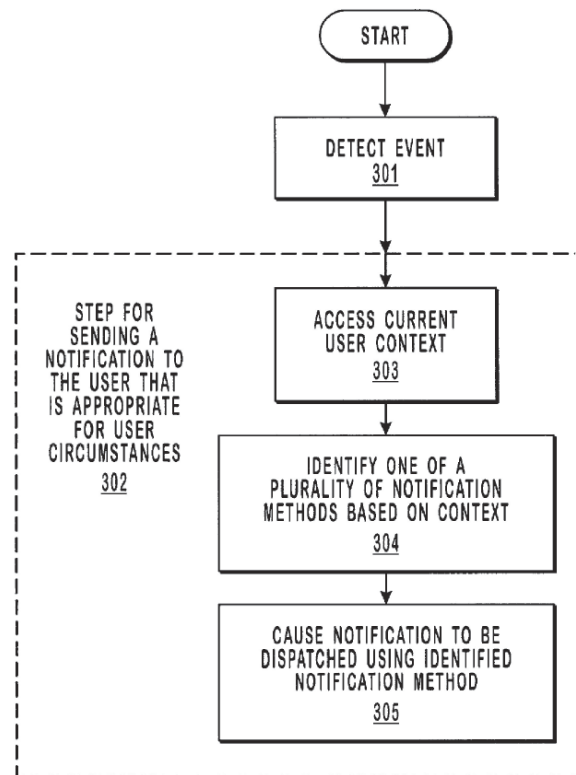


FIG. 3

Figure 3 is a “flowchart of a method for notifying a user of an event in a context sensitive manner that takes into consideration the user’s current state.” *Id.* at 2:65–67. After the process is initiated at step 301 upon detection of an event that requires notification to a user, such notification is sent at step 302 in a manner “that is appropriate for the user’s circumstances.” *Id.* at 6:25–27, 6:36–38.

This includes accessing a current context of the user at step 303, such as “whether or not the user’s telephone is on, busy, in hands-free mode, out of range, in meeting mode or the like for each of the user’s telephones.” *Id.* at 6:40–47. At step 304, one of a plurality of notification methods is identified:

There is an endless permutation of possible rules. As an illustrative example, the rules might define which telephonic devices to notify given the current time, and what notification methods to use if the current device is on or off, in hands-free mode or not, and busy or not. As a more specific example, the user may state that she wants to be notified by audible voice message if she receives an e-mail from a certain individual, except if she is already using the telephone through which the voice message was to be rendered, in which case the user may specify to be notified via a text message.

Id. at 6:60–7:3. Loveland also explains that “the user may specify that a voice notification interrupt the current conversation even if the user is currently on the telephone.” *Id.* at 2:29–32; *see also id.* at 6:31–33 (“the notification may be that a new e-mail from an important individual has been received in the user’s in-box”). At step 305, the notification is then dispatched to the user using the identified notification method. *Id.* at 7:4–6.

5. *Takahashi*

Takahashi describes “a server device for net games which is communicably connected to a plurality of terminal devices” via the Internet. Ex. 1009 ¶¶ 8, 29. Figure 7 of Takahashi is reproduced below.

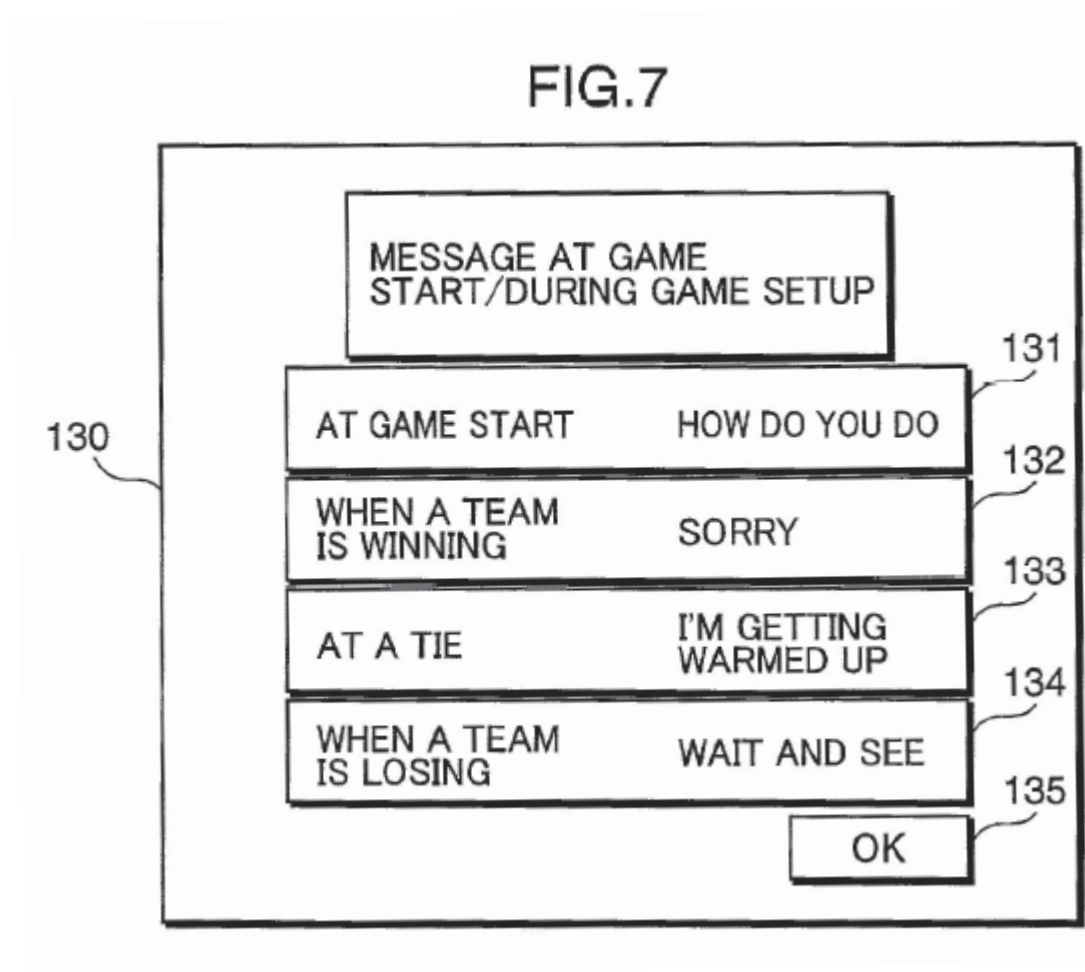


Figure 7 depicts a set of messages that a user may send to other users. *Id.*

¶ 72. “For each one of the above messages, the member can select a desired message out of a plurality of predetermined messages.” *Id.* ¶ 74.

E. Grounds Based on Diacakis

Petitioner challenges claims 1–6, 15, and 17 as unpatentable under 35 U.S.C. § 103 over Diacakis; challenges claims 7–9 as unpatentable under 35 U.S.C. § 103 over Diacakis and Loveland; and challenges claim 16 as unpatentable under 35 U.S.C. § 103 over Diacakis and Takahashi. Pet. 35–63.

1. Independent Claim 1

In addressing independent claim 1, Petitioner draws a correspondence between Diacakis’s P&A management server and a computer that performs the recited “computer-implemented method.” Pet. 35 (citing Ex. 1003 ¶ 293). In doing so, Petitioner observes that Diacakis’s P&A management server is in communication with a client terminal via a network that may be the Internet. *Id.* (citing Ex. 1007 ¶¶ 24–25). Both the preamble and the body of the claim recite a “network-based portal,” which Petitioner identifies as “a web page or interface that connects multiple users to a network.” *Id.* at 36.

Figure 9 of Diacakis, annotated by Petitioner, is reproduced below.
See id.

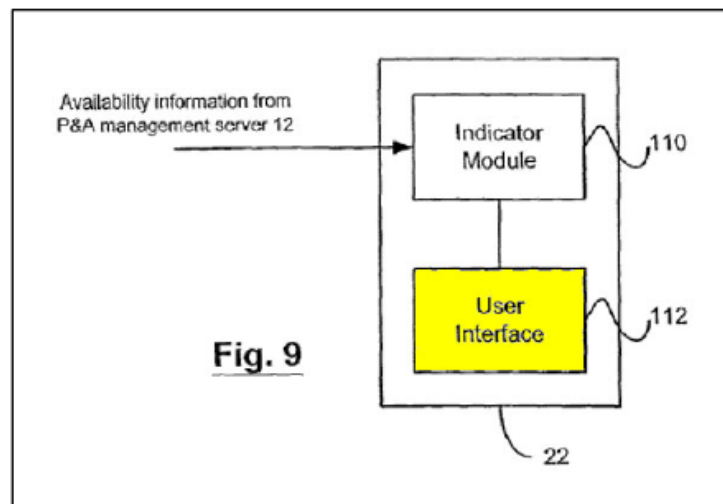


Figure 9 is a block diagram of client terminal 22, which includes indicator module 110 in communication with user interface 112 (highlighted in yellow by Petitioner). *Id.*; Ex. 1007 ¶ 63. User interface 112 “may include, for example, a GUI (Graphical User Interface) or a CUI (Character-based user interface).” Ex. 1007 ¶ 63; *see* Ex. 1003 ¶ 119. User interface 112 may

display information about a user's contacts, such as the contact's name, work telephone number, work email address, home telephone number, home email address, and instant-messaging (IM) address. Ex. 1007 ¶¶ 56, 59, Fig. 8; *see* Ex. 1003 ¶¶ 116, 119. User interface 112 enables a user to communicate with a contact via network 16, e.g., the Internet. Ex. 1007 ¶¶ 24–25, 62–64, Fig. 9; *see* Ex. 1003 ¶ 131.

Based on the current record, Petitioner establishes sufficiently for purposes of institution that user interface 112 functions as a “network-based portal.” Patent Owner disputes Petitioner's showing because “[t]he portion of Diacakis that the Petition relies upon merely teaches a user interface provided by a client device at the client-side of a network, not at the server-side of the network.” Prelim. Resp. 17. But, for the reasons discussed above, we disagree with Patent Owner's construction of the recited “network-based portal” as residing only “at the server-side of a network,” at least based on the preliminary record. *See id.* at 4–5, 17; *supra* § II.C.

At this time, Patent Owner does not dispute any other aspect of Petitioner's analysis of independent claim 1. We have reviewed that analysis and find it sufficient under the standard that applies at the preliminary stage of the proceeding. In brief, Petitioner relies on Diacakis's disclosure of message communications among users via a plurality of communication modes, with the ability of users to limit the availability of those communication modes to other users according to identification and categorization of such other users. Pet. 37–47. On an element-by-element basis, Petitioner explains how the specific limitations of independent claim 1 are met within the context of such disclosure. *Id.*

We particularly note that, in its analysis, Petitioner does not contend that Diacakis expressly discloses “receiving a second message from the second user to the first user, to respond to the first message, after the second user has received the first message,” as independent claim 1 requires. *See* Ex. 1001, 20:32–35. Instead, Petitioner argues that this limitation would have been obvious because Diacakis discloses that a first and second user communicate with each other, and cites testimony by Dr. Almeroth to support its contention a person of ordinary skill in the art “would have found it obvious that Diacakis’[s] modes of communication (including telephones and IM) allow recipients to respond to messages.” Pet. 44 (citing Ex. 1007 ¶¶ 8, 56; Ex. 1003 ¶ 132). At this stage, Petitioner’s reasoning is sufficient and is not disputed by Patent Owner.

We also particularly note Petitioner’s treatment of the negative limitations recited in maintaining user confidentiality of contact information. *See* Ex. 1001, 20:39–52 (“wherein even when the first message is received by the second user via the selected mode of communication, contact information associated with the second user and provided by the second user to the network-based portal is not provided via the network-based portal to the first user, and contact information associated with the first user and provided by the first user to the network-based portal is not provided via the network-based portal to the second user, so as to provide an option to the second user to keep the contact information associated with the second user confidential from the first user, and to provide an option to the first user to keep the contact information associated with the first user confidential from the second user”). Petitioner addresses these negative limitations of “not provid[ing]” contact information to other users by observing that Diacakis

expressly discloses that “[a] presence and availability management service provides users with the ability to configure an observer’s access settings, thereby giving users the ability to control what contact information observers are allowed to view.” Pet. 46; Ex. 1007 ¶¶ 7, 47 (“[T]he individual may specify the observers 62 who receive the individual’s contact information.”). Petitioner supports this reasoning, which we find sufficient at this stage, and which is not disputed by Patent Owner, with testimony by Dr. Almeroth. Ex. 1003 ¶¶ 133–134.

We conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of independent claim 1 as unpatentable under 35 U.S.C. § 103(a) over Diacakis.

2. Dependent Claims 2–6, 15 and 17

Claims 2–6, 15, and 17 depend directly or indirectly from independent claim 1. Ex. 1001, 20:64–21:34, 22:34–39, 22:45–48. In challenging those claims for obviousness over Diacakis alone, Petitioner provides an analysis that explains its position that the additional limitations are also disclosed by Diacakis. Pet. 47–53. Petitioner’s analysis is supported by testimony by Dr. Almeroth and is not disputed by Patent Owner outside of Patent Owner’s argument directed at underlying independent claim 1 that Diacakis does not disclose a “network-based portal” residing at the server side of a network. *See* Ex. 1003 ¶¶ 137–151; Prelim. Resp. 17–20.

We have reviewed Petitioner’s analysis and determine that it is sufficient at this stage. For the reasons discussed above, Patent Owner’s argument is not persuasive on the current record. We accordingly conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its

challenge of claims 2–6, 15, and 17 as unpatentable under 35 U.S.C. § 103(a) over Diacakis.

3. Dependent Claims 7–9

In challenging claims 7–9, which depend from independent claim 1, Petitioner relies on Loveland in combination with Diacakis to meet the additional notification-related limitations. Pet. 57–59. Petitioner specifically contends that, given the “complementary” teachings of the two references, a person of ordinary skill in the art “would have been motivated to implement Loveland’s urgent message notification features in Diacakis’[s] communications system, and would have had several reasons to do so.” *Id.* at 53.

Among such reasons, Petitioner identifies both references’ teachings regarding prioritization of communications from certain individuals, as well as the similarity of Diacakis’s “presence and availability” information with Loveland’s “current circumstance” information. *Id.* at 53–56 (citing Ex. 1007 ¶¶ 8, 24; Ex. 1008, 3:45–5:24, Figs. 1–2). Petitioner supports this identification with testimony by Dr. Almeroth, who also supports Petitioner’s contention that the combination would both yield predictable results and be reasonably expected to succeed. Ex. 1003 ¶¶ 152–161; Pet. 54–57.

At this time, Patent Owner disputes neither Petitioner’s reasoning to effect the combination nor Petitioner’s specific analysis of the individual limitations of claims 7–9. On the current record, and mindful of the standard that applies during this preliminary phase of the proceeding, we find that Petitioner’s reasoning is sufficiently supported by rational underpinning.

We have also reviewed Petitioner’s specific analysis of each of claims 7–9 and, similarly mindful of the applicable standard, we determine that that analysis is sufficient.

Accordingly, we conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of claims 7–9 as unpatentable under 35 U.S.C. § 103(a) over Diacakis and Loveland.

4. Dependent Claim 16

Claim 16 depends from claim 1 and recites “enabling the second user to select a predetermined message to send to the first user, the predetermined message being selected from a set of predetermined messages provided to the second user.” Ex. 1001, 22:40–44. For this limitation, Petitioner relies on Takahashi’s teaching of selecting predetermined messages, in combination with the teachings of Diacakis. Pet. 62. Petitioner specifically contends that a person of skill in the art “would have been motivated to implement Takahashi’s predetermined messaging features in Diacakis’[s] communications system, and would have had several reasons to do so.” *Id.* at 59. Such reasons include Diacakis’s general recognition that “reduc[ing] the amount of resources required” results in faster response time and decreased latency, which improve user experience. *Id.* at 60 (citing Ex. 1007 ¶¶ 57–58). Petitioner further contends that the combination involves a known technique, would yield predictable results, and that a person of ordinary skill in the art would have a reasonable expectation of success in effecting the combination. *Id.* at 60–62. Petitioner supports its contentions and reasoning with testimony by Dr. Almeroth. Ex. 1003 ¶¶ 168–174.

At this time, Patent Owner does not dispute Petitioner’s reasoning, which, on the current record, we find sufficient. We accordingly conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of claim 16 as unpatentable under 35 U.S.C. § 103(a) over Diacakis and Takahashi.

F. Grounds Based on Tanigawa and Hullfish

Petitioner challenges claims 1–3, 6, 15, and 17 as unpatentable under 35 U.S.C. § 103(a) over Tanigawa and Hullfish; challenges claims 7–9 as unpatentable under 35 U.S.C. § 103(a) over Tanigawa, Hullfish, and Loveland; and challenges claim 16 as unpatentable under 35 U.S.C. § 103(a) over Tanigawa, Hullfish, and Takahashi. Pet. 63–89.

1. Independent Claim 1

In addressing independent claim 1, Petitioner identifies Tanigawa’s communication system as performing most of the steps of the recited “computer-implemented method.” Pet. 67–68. For the “network-based portal,” Petitioner relies on the user interface illustrated in Figure 12, reproduced above: “Tanigawa’s terminals (user devices) contain a ‘network-based portal,’—a user interface connecting users to a network.” *Id.* at 68–69. Similar to its argument advanced for the Diacakis-based grounds, Patent Owner disputes that Tanigawa discloses the recited “network-based portal” because “Tanigawa’s user interface is not at the server-side of the network.” Prelim. Resp. 22. But, as we discuss above, on the preliminary record before us, we do not agree with Patent Owner’s

construction of the recited “network-based portal” as residing only “at the server side of a network.” *See id.* at 4–5, 22; *supra* § II.C.

The only aspects of independent claim 1 for which Petitioner relies on a reference other than Tanigawa—specifically, Hullfish—are those that recite aspects that involve blocking users. In particular, Petitioner contends that the combination of Tanigawa and Hullfish renders obvious the following two recitations: (1) “enabling the second user to block the first user from using at least the selected mode of communication to communicate with the second user via the network-based portal, based on the identifier associated with the first user,” and (2) “enabling the first message to be provided to the second user, using the selected mode of communication, depending on the identifier associated with the second user, in view of the second user not blocking the first user from using the selected mode of communication to communicate with the second user, via the network-based portal.” Pet. 74–77; Ex. 1001, 20:19–30.

Supported by the testimony of Dr. Almeroth, Petitioner reasons that, “[g]iven their complementary teachings,” the combination of Tanigawa and Hullfish “would have involved routine implementation with no technical risks.” Pet. 63–64 (citing Ex. 1003 ¶ 178). In particular, Petitioner contends that a person of ordinary skill in the art “would have been motivated to implement Hullfish’s blocking features in Tanigawa’s communications system, and would have had several reasons to do so.” *Id.* at 64. Such reasons include, according to Petitioner, Tanigawa’s express teaching that, when a first user invites a second user to chat, the second user “can determine[] whether or not she will respond to the participation invitation.” *Id.* (quoting Ex. 1010 ¶ 134). Because Tanigawa thereby contemplates

scenarios where a first user wishes to chat with a second user, but the second user does not, Petitioner reasons that a person of ordinary skill in the art “would have been motivated to modify Tanigawa’s teachings to give the second user control over who may reach her via the network-based portal (such as using Hullfish’s teachings).” *Id.* (citing Ex. 1003 ¶ 179).

Petitioner additionally notes that “Hullfish provides specific examples supporting this motivation,” including a description of its blocking capabilities as a “privacy feature” used when one user “wants to stop receiving messages from” another user. *Id.* (citing Ex. 1011, 8:59–65). Supported by Dr. Almeroth’s testimony, Petitioner accordingly reasons that a person of ordinary skill in the art would have found it obvious in Internet-based communication systems for user to wish to block annoying or abusive users, or to stop receiving messages while sleeping, busy, or traveling. *Id.* at 64–65 (citing Ex. 1003 ¶¶ 179–180). Dr. Almeroth’s testimony also supports Petitioner’s contention that the combination would both yield predictable results and be reasonably expected to succeed. Ex. 1003 ¶¶ 178–185; Pet. 65–67.

Patent Owner does not dispute Petitioner’s reasoning for effecting the combination, nor does Patent Owner dispute Petitioner’s specific analysis of the individual limitations that involve blocking capabilities. We have reviewed Petitioner’s analysis of those limitations, as well as Petitioner’s analysis of the limitations where Petitioner relies on Tanigawa alone, and find it sufficient under the standard we apply at this stage.

We accordingly conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of independent claim 1 as unpatentable under 35 U.S.C. § 103(a) over Tanigawa and Hullfish.

2. Dependent Claims 2, 3, 6, 15, and 17

Of the dependent claims that Petitioner challenges for obviousness over Tanigawa and Hullfish, claims 2 and 3 involve aspects that relate to blocking of a user; while claims 6, 15, and 17 do not. For the latter group, Petitioner provides an analysis that supports its position that the additional limitations of claims 6, 15, and 17 are also disclosed by Tanigawa. Pet. 81–83. For the former group, Petitioner provides an analysis that supports its position that the additional limitations of claims 2 and 3 would have been obvious over the combination of Tanigawa and Hullfish, particularly for claim 2’s recited use of an alternative communication mode when a user has been blocked. *Id.* at 80–81. Petitioner’s analysis for both groups of dependent claims is supported by Dr. Almeroth’s testimony and is not disputed by Patent Owner outside of Patent Owner’s argument directed at underlying independent claim 1 that Tanigawa does not disclose a “network-based portal” residing at the server side of a network. *See* Ex. 1003 ¶¶ 208–217; Prelim. Resp. 20–22.

We have reviewed Petitioner’s analysis and determine that it is sufficient at this stage. As discussed above, Patent Owner’s argument is not persuasive on the preliminary record. We accordingly conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of claims 2, 3, 6, 15, and 17 as unpatentable under 35 U.S.C. § 103(a) over Tanigawa and Hullfish.

3. *Dependent Claims 7–9*

Petitioner’s analysis of dependent claims 7–9 relies on Loveland in combination with Tanigawa and Hullfish to meet the additional notification-related limitations. Pet. 84–87. Specifically, Petitioner contends that, given the “complementary” teachings of Tanigawa, Hullfish, and Loveland, a person of ordinary skill in the art “would have had several reasons for implementing Loveland’s urgent notification features and Hullfish’s blocking features in Tanigawa’s system.” *Id.* at 84.

Petitioner highlights Loveland’s teaching that “even when certain modes of communication are blocked, communications from ‘important’ people may nevertheless be transmitted.” *Id.* (citing Ex. 1008, 2:28–33, 6:31–33, 6:64–7:3). According to Petitioner, and supported by Dr. Almeroth’s testimony, a person of ordinary skill in the art “would have been motivated to implement Loveland’s teachings into Tanigawa and Hullfish, as Loveland’s teachings provide users more control over blocked communications, and would prevent inadvertent blocking of important communications.” *Id.* at 84–85 (citing Ex. 1003 ¶ 219). In addition, and also supported by Dr. Almeroth’s testimony, Petitioner contends that the combination would yield both predictable results and be reasonably expected to succeed. *Id.* at 85–86 (citing Ex. 1003 ¶¶ 220–224).

Patent Owner does not, at this time, dispute Petitioner’s reasoning to effect the combination. Nor does Patent Owner dispute Petitioner’s specific analysis of the individual limitations of claims 7–9, which refers to and relies on Petitioner’s analysis of how Loveland meets those limitations in the context of the Diacakis-based challenge. *See id.* at 86–87. Because Petitioner provides adequate reasoning, supported by rational underpinning,

to combine the teachings as proposed, and because Petitioner’s analysis reasonably demonstrates how the combination meets the limitations of claims 7–9, we determine that Petitioner makes a sufficient showing at this preliminary stage.

Accordingly, we conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of claims 7–9 as unpatentable under 35 U.S.C. § 103(a) over Tanigawa, Hullfish, and Loveland.

4. Dependent Claim 16

Petitioner’s analysis of dependent claim 16 relies on Takahashi in combination with Tanigawa and Hullfish to meet the additional predetermined-message limitation. Pet. 87–90. In particular, Petitioner contends that a person of ordinary skill in the art would have combined Takahashi’s predetermined messaging features in the combination of Tanigawa and Hullfish because “Tanigawa and Hullfish both address the situation where users may not wish to communicate with others, and provide users control over how others may communicate with them.” *Id.* at 88. Because “Takahashi similarly discloses that over a network, ‘anonymous users’ may send ‘unfavorable messages, such as slander,’ which may be disruptive,” Petitioner reasons that a person of ordinary skill in the art “would have been motivated to modify the combination of Tanigawa and Hullfish to allow for predetermined messages (as disclosed in Takahashi) to prevent unwanted communications.” *Id.* (citing Ex. 1009 ¶¶ 138–139; Ex. 1003 ¶¶ 232–233). Petitioner supports this reasoning with testimony by Dr. Almeroth, who also supports Petitioner’s contention that the combination would yield predictable results and have a reasonable

expectation of success. Ex. 1003 ¶¶ 231–238; *see* Pet. 88–90. In addressing how the combination meets the predetermined-message limitation of claim 16 through Takahashi’s disclosure, Petitioner relies on its earlier analysis of how Takahashi meets the limitation in the context of the Diacakis-based challenge. Pet. 90.

Patent Owner does not dispute Petitioner’s rationale for combining the reference teachings, and does not dispute Petitioner’s contention that the limitation is met through Takahashi’s disclosure. On the record before us, we determine that Petitioner’s showing is sufficient under the standard applicable to this preliminary proceeding for both these aspects of Petitioner’s analysis.

We accordingly conclude that Petitioner demonstrates a reasonable likelihood of prevailing on its challenge of claim 16 as unpatentable under 35 U.S.C. § 103(a) over Tanigawa, Hullfish, and Takahashi.

III. DISCRETIONARY DENIAL

In its Preliminary Response, Patent Owner asks that we exercise our discretion under 35 U.S.C. § 314(a) to deny the Petition in light of the state of the related litigation. Prelim. Resp. 9–14 (citing, *inter alia*, *NHK Spring Co., Ltd. v. Intri-plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential)). But on the same date Patent Owner filed its Preliminary Response, the district court granted Petitioner’s motion to dismiss for improper venue, thereby terminating the related litigation. *See* Ex. 3001, 9. We agree with Petitioner that “this dismissal moots Patent Owner’s arguments based on *Fintiv*” and that “[b]ecause there is no longer

any parallel proceeding, there is no basis for a discretionary denial under § 314(a).”⁴ Reply 1.

We accordingly decline to exercise our discretionary authority to deny the Petition.

IV. CONCLUSION

For the foregoing reasons, we conclude that the information presented in the Petition establishes a reasonable likelihood that Petitioner would prevail in showing that at least one of claims 1–9 and 15–17 of the ’727 patent is unpatentable. Accordingly, we institute an *inter partes* review, which will include all challenged claims and grounds asserted in the Petition. See *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *AC Techs. S.A. v. Amazon.com, Inc.*, 912 F.3d 1358, 1364 (Fed. Cir. 2019) (“[I]f the Board institutes an IPR, it must . . . address all grounds of unpatentability raised by the petitioner.”); U.S. Patent and Trademark Office, *Guidance on the impact of SAS on AIA trial proceedings* (Apr. 26, 2018), <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial> (“SAS Guidance”).

⁴ We note that Patent Owner filed no Sur-reply to Petitioner’s Reply, where Petitioner made this argument, although Patent Owner was authorized to do so. See Paper 8; *supra* n.1.

IV. ORDER

In consideration of the foregoing, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review is hereby instituted as to claims 1–9 and 15–17 of the '727 patent on all grounds set forth in the Petition; and

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

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