

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EPIC GAMES, INC.,
Petitioner,

v.

INGENIOSHARE, LLC,
Patent Owner.

IPR2022-00295
Patent 10,492,038 B2

Before THU A. DANG, PATRICK M. BOUCHER, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* BOUCHER.

Opinion Dissenting filed by *Administrative Patent Judge* AMUNDSON.

BOUCHER, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
35 U.S.C. § 318(a)

In response to a Petition (Paper 1, “Pet.”) filed by Epic Games, Inc. (“Petitioner”), we instituted an *inter partes* review of claims 7–12, 22–24, and 33–67 of U.S. Patent No. 10,492,038 B2 (Ex. 1001, “the ’038 patent”). Paper 11 (“Dec.”). During the trial, IngenioShare, LLC (“Patent Owner”) filed a Response (Paper 15, “PO Resp.”), to which Petitioner filed a Reply (Paper 17, “Reply”) and Patent Owner filed a Sur-reply (Paper 22, “Sur-reply”). The parties declined an oral hearing with the panel, and instead “rest[] on their briefs for any issues not addressed at the February 17th hearing directed to IPR2022-00202 and IPR2022-00291.” Ex. 3004; Paper 26 (order canceling oral hearing).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the claims on which we instituted trial. Based on the record before us, Petitioner has not shown, by a preponderance of the evidence, that any of claims 7–12, 22–24, and 33–67 is unpatentable.

I. BACKGROUND

A. *The ’038 Patent*

The ’038 patent relates to “automatically remov[ing] unwanted communications.” Ex. 1001, 3:52–53. Figure 6 of the ’038 patent is reproduced below.

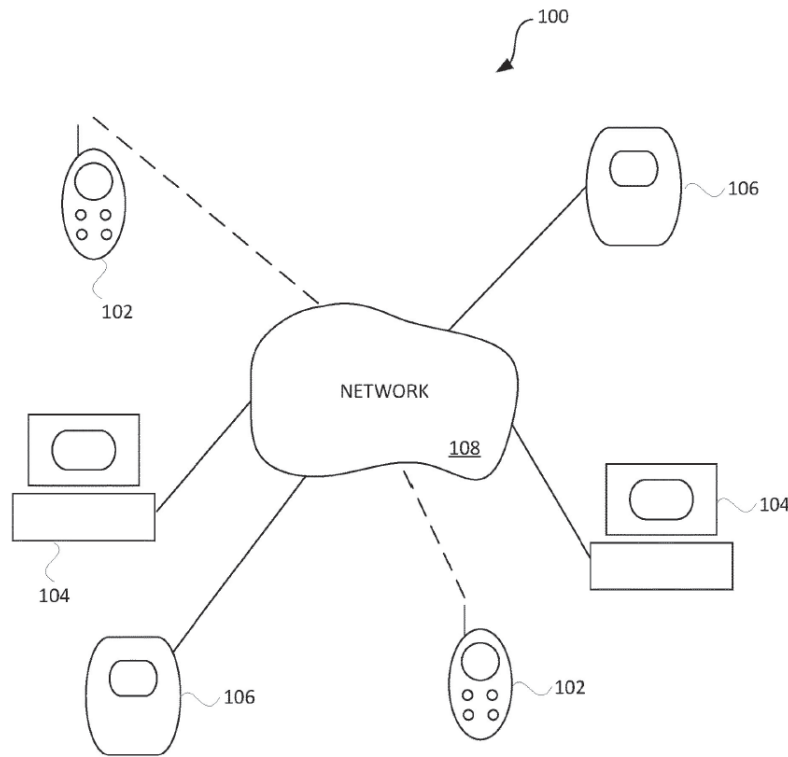


FIG. 6

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 8:35–40. 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 8:40–43. 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 8:43–46.

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 4:22–24. “Based on the portal, the user can securely determine who can reach him at what conditions.” *Id.* at 4:34–35.

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 4:36–41.

The following table is reproduced from the '038 patent.

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

The table identifies different people and their relationships to a particular user, as well as “ContactClasses” to which such people are assigned and which reflect the various access priorities. *Id.* at 6:24–32. 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 6:33–35. 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 6:35–51. The portal implements various connectivity options depending on the status of the user, Peter’s access priority according to his ContactClass, and Peter’s urgency setting. *Id.* at 6:56–58. Connectivity 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 6:56–61. 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 4:56–61.

B. Illustrative Claim

In addition to challenges of various dependent claims, Petitioner challenges three of the '038 patent's four independent claims. Independent claim 7 is representative of the challenged claims and is reproduced below.

7. A non-transitory computer readable medium including at least executable computer program code stored therein for managing electronic communications of a plurality of users using at least a network-based portal at least based on Internet protocol, with different communication modes allowed, depending on each of the plurality of users having an identifier for use with the different communication modes, with the corresponding identifier being set via the network-based portal, and without requiring the plurality of users to disclose their contact information to each other, said computer readable medium comprising:

computer program code for providing a plurality of communication modes to a first user to allow the first user to use one of the plurality of communication modes as a selected communication mode for a first message from the first user to a second user via an electronic device associated with the second user, with the first user being identified at least depending on a prior registration process by the first user regarding the use of the network-based portal,

wherein the plurality of communication modes include at least text communication using a personal computer, voice communication using a personal computer, text communication using a mobile phone, voice communication using a mobile phone, and communication with at least an image, and

wherein messages are eligible to be received by the electronic device associated with the second user based on any of the plurality of communication modes, all depending on an identifier associated with the second user being set by the second user via the network-based portal, at least in view of the network-based portal based on the Internet protocol;

computer program code for permitting the second user to block the first user from using at least the selected

communication mode to reach the second user via the network-based portal;

computer program code for enabling, via the network-based portal, the first message to be received by the second user via the electronic device associated with the second user, using the selected communication mode, depending on the identifier associated with the second user, in view of the second user not blocking the first user from using the selected communication mode to reach the second user, via the network-based portal;

computer program code for determining availability of the second user; and

computer program code for receiving, from the second user, contact information associated with the second user to allow the second user to participate and at least receive messages via the network-based portal,

wherein even when the first message is received by the second user via the electronic device associated with the second user depending on the identifier associated with the second user, the contact information associated with the second user is not provided via the network-based portal to the first user via an electronic device associated with the first user, and

wherein the identifier associated with the second user is distinct from the contact information associated with the second user.

Ex. 1001, 21:50–22:43.

C. Evidence

Petitioner relies on the following references:

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 Declarations by Kevin C. Almeroth, Ph.D. Exs. 1003, 1039. Patent Owner relies on a Declaration by George N.

Rouskas, Ph.D. Ex. 2005. Dr. Rouskas was cross-examined by Petitioner, and a transcript of his deposition was entered into the record. Ex. 1043.

D. Instituted Grounds of Unpatentability

We instituted review of claims 7–12, 22–24, and 33–67 on the following grounds. Dec. 15–16, 73; Pet. 6.

Claim(s) Challenged	35 U.S.C. §¹	References
7, 10–12, 22–24, 33–36, 38–41, 46, 49, 51–53, 55, 57, 58, 64–66	103(a)	Tanigawa, Hullfish
8, 9, 43, 44, 47, 48, 50, 54	103(a)	Tanigawa, Hullfish, Loveland
37, 42, 56, 59–63, 67	103(a)	Tanigawa, Hullfish, Takahashi
45	103(a)	Tanigawa, Hullfish, Loveland, Takahashi

E. Real Parties in Interest

The parties identify only themselves as real parties in interest. Paper 21, 1; Paper 6, 2.

F. Related Matters

The parties identify *IngenioShare, LLC v. Epic Games, Inc.*, No 6:21-cv-00663 (W.D. Tex.) as a related matter. Paper 21, 1; Paper 6, 2.

¹ 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 ’038 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.

According to Petitioner, “[t]his case was dismissed by order of the court on March 18, 2022.” Paper 21, 1.

In addition, Patent Owner notes that related patents are challenged by Petitioner in IPR2022-00202, IPR2022-00291, IPR2022-00294, and IPR2022-00297. Paper 6, 2–3. Of these, *inter partes* review was instituted in IPR2022-00202, IPR2022-00291, and IPR2022-00294, but institution was denied in IPR2022-00297.

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.² *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

² The parties do not address objective indicia of nonobviousness, which accordingly do not form part of our analysis. *See* Pet. 86 (“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. Direct Testimony by Dr. Rouskas

Petitioner contends that Dr. Rouskas’s Declaration testimony is entitled to no weight because it “repeats the [Patent Owner Response] nearly verbatim,” “appears to contain opinions he did not develop,” and “is contradicted by Dr. Rouskas’s own deposition testimony.” Reply 4–5. Although Petitioner makes multiple allegations of deficiencies in Dr. Rouskas’s direct testimony, none of these allegations is sufficiently developed with specific examples.

First, we disagree that mere verbatim duplication between an expert declaration and an attorney brief defines “a classic example of a cursory expert declaration the Board disregards.” See *id.* at 4. The Board’s concern is rather whether expert testimony “cite[s] to any additional supporting evidence or provide[s] any technical reasoning to support [its] statement[s].” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential); see also *id.* at 16 (“Dr. Jones offers only a *verbatim* restatement of the assertion being supported, *without any supporting evidence or technical reasoning*” (emphasis added)). As Patent Owner

asserts, “Petitioner fail[s] to provide a single example of how Dr. Rouskas’s testimony is ‘cursory or unsupported.’” Sur-reply 1.

Second, Petitioner provides only a single example to support its allegation that the direct testimony in Dr. Rouskas’s Declaration “appears to contain opinions he did not develop.” This example relates to an issue we discuss at length below, namely whether a “network-based portal” recited in the challenged claims must reside at a server side of a network or can reside on the client side as a user interface in a client device. Reply 4–5. Petitioner accurately states that, on cross-examination, “Dr. Rouskas admitted he was retained months after the [Preliminary Response] was filed and that he did not review the [Preliminary Response],” where Patent Owner argued that a “network-based portal” must reside at a server side. *Id.* at 5 (citing Ex. 1043, 25:2–26:2).

Dr. Rouskas’s cross-examination also included the following exchange:

BY MR. SHI:

Q. The essence of your opinion is that Diacakis [i.e., a reference relied on by Petitioner in related cases] does not teach a network-based portal because that network-based portal must be in a server device and not a client device; correct?

MR. RISLEY: Object to form.

THE WITNESS: That is correct, yes.

BY MR. SHI:

Q. Did you come up with this argument, Dr. Rouskas?

A. I did, yes.

Ex. 1043, 53:22–54:7. Petitioner characterizes Dr. Rouskas’s statement as “claim[ing] he *conceived of* [Patent Owner’s] [network-based portal] argument.” Reply 5. According to Petitioner, such a claim is “not credible” because at least some form of the argument was presented during the preliminary phase of this proceeding, before Dr. Rouskas was retained. *Id.*

Petitioner did not explore Dr. Rouskas’s answer on cross-examination in a manner that would have allowed the witness to expand on his brief statement that “[he] did, yes.” But even if we were to agree with Petitioner’s characterization, we see insufficient reason on that basis alone to discount *all* of Dr. Rouskas’s direct testimony. As Patent Owner says, “Petitioner cross-examined (deposed) Dr. Rouskas for two days,” and “Petitioner does not cite to *any* cross-examination question that Dr. Rouskas was *not* able to answer.” Sur-reply 1. The totality of Dr. Rouskas’s testimony is useful and his direct testimony was subject to extensive cross-examination that allows us to evaluate the weight to accord his testimony in individual contexts.

Third, Petitioner contends that, on cross-examination, “Dr. Rouskas contradicted his declaration and admitted the opinions therein rest on fundamental misunderstandings of the challenged claims and prior-art references.” Reply 5. We evaluate Petitioner’s specific arguments in our assessment of the weight to accord Dr. Rouskas’s testimony below, and see no compelling basis to discount his direct testimony wholesale. *See* Sur-reply 2 (Patent Owner asserting that “the rule of completeness shows that Dr. Rouskas did not contradict his Declaration testimony” (citing Fed. R. Evid. 106)).

For these reasons, we decline Petitioner’s request to give no weight to Dr. Rouskas’s direct testimony in our analysis.

C. 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. 1992)).

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. *See* Ex. 1003 ¶¶ 92–97. Patent Owner does not propose any different expression of the level of ordinary skill, and Dr. Rouskas testifies that he has “employed Dr. Almeroth’s definition” in his Declaration. Ex. 2005 ¶ 21.

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).

D. 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). The specification may reveal a special definition given to a claim term by the patentee. *Phillips*, 415 F.3d at 1316. If an inventor acts as his or her own lexicographer, the definition must be set forth in the specification with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998).

Although Petitioner asserts in its Petition that it “does not believe that any terms need to be construed to assess the arguments presented,” we specifically “invite[d] the parties to provide additional briefing in the Response, Reply, and Sur-reply about the meaning of ‘network-based portal’ in the ’038 patent’s claims.” Pet. 26; Dec. 25. We address this term as follows, and 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))).

The phrase “network-based portal” is recited numerous times in the challenged independent claims of the ’038 patent, and its construction is central to the parties’ respective positions regarding application of Petitioner’s asserted prior art to the challenged claims. *See generally* Ex. 1001, 21:50–22:43, 26:1–57, 27:37–28:39. In particular, Petitioner broadly describes a “network-based portal” as “a user interface that connects clients to a network.” Pet. 38. Patent Owner argues that a “network-based portal” excludes a user terminal or client communication device. PO Resp. 16–17; *see also* Reply 9 (Petitioner asserting that Patent Owner’s argument that “the [network-based portal] resides only at the server-side of a network and excludes user interfaces of ‘client communication devices[.]’” is “wrong”).

The issue before us is therefore well-defined, namely whether a “network-based portal” as recited in the challenged claims is sufficiently broad to encompass residing at either a client or server side of a network, as Petitioner contends, or is limited to residing at the server side, as Patent Owner contends. On the preliminary record, we declined to adopt Patent Owner’s exclusion of residing at a client side when extending our invitation to the parties to elaborate on their positions. Dec. 23–25. But we are mindful that “the Board is not bound by any findings made in its Institution Decision. At that point, the Board is considering the matter preliminarily without the benefit of a full record. The Board is free to change its view of the merits after further development of the record, and *should do so* if

convinced its initial inclinations were wrong.” *TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016).

The full record developed at trial includes the Declaration of Dr. Rouskas (Patent Owner’s expert), who directly opines on this issue. Ex. 2005 ¶¶ 60–85. Although the record also includes a Declaration by Petitioner’s expert, Dr. Almeroth, that Declaration was filed with the Petition and neither responds to Dr. Rouskas’s opinions nor provides any testimonial evidence to support Petitioner’s positions beyond what was available at the preliminary stage of the proceeding.³ *See generally* Ex. 1003. In evaluating the fully developed record, we necessarily accord greater weight to Dr. Rouskas’s testimony than to Petitioner’s attorney argument as advanced in Petitioner’s Reply. *See, e.g., Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1380 (Fed. Cir. 2009) (“[U]nsworn attorney argument . . . is not evidence and cannot rebut . . . other admitted evidence . . .”).

Our evaluation also necessarily remains cognizant that “[i]n an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C.

³ Petitioner filed a second Declaration by Dr. Almeroth after institution (such that it was not available on the preliminary record), but that Declaration is provided primarily as supplemental evidence under 37 C.F.R. § 42.64(b)(2) to address objections by Patent Owner to the authenticity of various other exhibits. Ex. 1039 ¶ 2. Dr. Almeroth’s second Declaration otherwise merely incorporates Dr. Almeroth’s “technical opinions” by reference to his first Declaration, without providing any further facts or expressing any further opinions that bear on the merits, including claim construction. *Id.* ¶ 1.

§ 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Against this backdrop, we address the parties’ arguments, ultimately concluding that Patent Owner articulates the more persuasive position that a “network-based portal” as recited in the claims is limited to residing at a server side of a network.

1. Dictionary Definitions

Patent Owner begins its argument by quoting dictionary definitions of “portal” offered by Dr. Rouskas in his Declaration: (1) “In the context of the Internet, a portal refers to any commonly used website serving as an entry point to the Internet, usually with many links to a wide variety of information, data, resources, and services,” Ex. 2005 ¶ 64 (quoting <https://www.techopedia.com/definition/13077/portal-internet>); and (2) “Portal is a term, generally synonymous with gateway, for a World Wide Web site that is or proposes to be a major starting site for users when they get connected to the Web or that users tend to visit as an anchor site. There are general portals and specialized or niche portals,” *id.* (quoting <https://www.techtarget.com/whatis/definition/portal>). Dr. Rouskas relies on these dictionary definitions to distinguish a “portal” from a client communication device, testifying specifically that “[w]ebsites are hosted on web servers, not on client communication devices.” *Id.*

While we recognize that such dictionary definitions fall within the category of extrinsic evidence, as they do not form part of an integrated patent document, we find it useful to begin with such definitions because they provide context for evaluation of the intrinsic evidence. In doing so, we recall that the Federal Circuit has advised that dictionary definitions are “worthy of special note”: “Judges are free to consult such resources at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 n.6 (Fed. Cir. 1996).

With its Reply, Petitioner counters Patent Owner’s position by providing dictionary definitions of its own: (1) “A portal is a web-based platform that collects information from different sources into a single user interface and presents users with the most relevant information for their context,” Ex. 1041; and (2) “A mobile portal is an Internet gateway that enables mobile devices to connect remotely with an enterprise intranet or extranet, typically via a Web browser interface,” Ex. 1042. According to Petitioner, Dr. Rouskas “selectively disregarded” definitions like these that include the word “interface.” Reply 10. But as Patent Owner points out, “that a definition includes the term ‘interface’ does not mean a ‘portal’ is an interface.” Sur-reply 7. We find Patent Owner’s explanation that “[t]he term ‘interface’ is used to indicate *how a user accesses the portal* (i.e., via a web browser interface), *not what a portal is*” to be consistent with Petitioner’s preferred definitions. *See id.*

More generally, we discern no meaningful conflict between the definitions provided by Dr. Rouskas and those provided by Petitioner. For example, the second of Petitioner’s preferred definitions expressly defines a “mobile portal” as an “Internet gateway” with certain features, thereby differentiating it from a web browser interface that is used to connect a device to the portal. *See* Ex. 1042; Sur-reply 6–7. And that definition’s expression of equivalence between a “mobile portal” and an “Internet gateway” is consistent with the ’038 patent specification’s use of the terms “portal” and “gateway,” as we discuss in the next subsection.

2. Specification

a. “portal or gateway”

Both parties quote various portions of the specification of the ’038 patent as supporting their respective positions, with much of their arguments focusing particularly on the specification’s repeated use of the phrase “portal or gateway” (or similar variant). *See, e.g.*, Ex. 1001, 4:22, 4:62, 7:11–12, 7:15. According to Patent Owner, such phrasing amounts to a “definition” by the specification of a “portal” as a “communication gateway.” PO Resp. 17. And in turn, Patent Owner says, “[t]he specification also defines a ‘gateway’ as a ‘networked server’” by stating that “[t]he remote server computer can be a networked server coupled to the network 108. One example of a networked server is a gateway computer for a wireless 10 electronic device, such as a mobile telephone.” *Id.* (quoting Ex. 1001, 16:15–18).

We do not agree that such phrases are definitional because they lack the deliberateness and precision that characterize definitions. *See Renishaw*,

158 F.3d at 1249. But they nonetheless raise a relevant question as to whether the specification’s phrase “portal or gateway” uses different words to describe the same thing or instead refers to distinct alternatives. *See* Reply 11 (Petitioner arguing that “the ’038 Patent’s recitation of ‘portal or gateway’ means the two are alternatives, not that one redefines the other”). As a matter of common English usage, we agree with Dr. Rouskas that both understandings are possible. *See* Ex. 1043, 90:10–20 (testifying on cross-examination that the word “or” can be a “disjunctive conjunction” or can be used “to refer to things that are synonymous to each other”). Mere use of the word “or” does not end the inquiry.

Patent Owner has the stronger position. First, Patent Owner correctly observes that “Dr. Rouskas’s testimony that to a [person of ordinary skill in the art] the word ‘or’ in the specification means that ‘portal’ and ‘gateway’ are used synonymously is un rebutted.” Sur-reply 9.

Second, Petitioner observes that the specification does not always use the phrase “portal or gateway,” but sometimes uses one word or the other. *See, e.g.*, Ex. 1001, 4:48–61 (referring only to “portal”), 4:66–5:4 (referring only to “gateway”), 5:64–6:3 (referring only to “portal”). According to Petitioner, the specification is thus “using these phrases to describe different embodiments, indicating that portals and gateways are two alternative means to establish communication.” Reply 11. But Petitioner does not meaningfully explain how such embodiments are, in fact, different. We have reviewed the passages Petitioner identifies and we instead agree with Dr. Rouskas’s more prosaic explanation that the specification sometimes uses one of two equivalent terms to avoid repetition. *See* Ex. 1043, 91:10–15 (“So to a person skilled in the art, this implies that instead of just saying

portal or gateway all the time and because the claims refer to portal, not gateway, these, you know -- you know, the two terms are used synonymously.”).

Third, as we note above, one of Petitioner’s own preferred dictionary definitions of “portal” expresses an equivalence between a “mobile portal” and an “Internet gateway.” Ex. 1042. This independent evidence adds further support to Patent Owner’s position, particularly in light of its overall consistency with Dr. Rouskas’s unrebutted testimony.

b. Implementation of Portal Functionality

When instituting this proceeding, we acknowledged that Patent Owner supported its contention that a “network-based” portal resides at a server side with examples drawn from the specification of the ’038 patent. Dec. 23. Specifically, Patent Owner identified examples in which the specification describes a “portal” as separate from a “mobile phone” or from a person’s “wireless device.” Paper 8, 13–14 (citing Ex. 1001, 6:33–34, 6:53–55, 7:9–17, 16:17–19); *see* Dec. 23. But we *sua sponte* expressed a concern that “[t]he ’038 patent’s specification discloses embodiments where claimed functionality resides in a ‘mobile phone,’ i.e., a client-side device.” Dec. 23 (citing Ex. 1001, 3:29–38, 9:22–10:19, 10:34–13:43, 15:12–16:2, Figs. 7–11). When extending our invitation for the parties to elaborate on their positions for proper construction of “network-based portal,” we accordingly stated that “construing ‘network-based portal’ to exclude ‘client-side functionality,’ such as mobile-phone functionality, would exclude preferred embodiments from claim scope.” *Id.* at 24. The parties have now had a full opportunity to develop their positions and, in particular,

to address the concern we raised when instituting the proceeding. We have reconsidered our initial view in light of that fully developed record.

The parties' dispute on this point centers on Figures 7–11, and we reproduce Figure 7 below, with highlighting provided by Petitioner. *See* Reply 15.

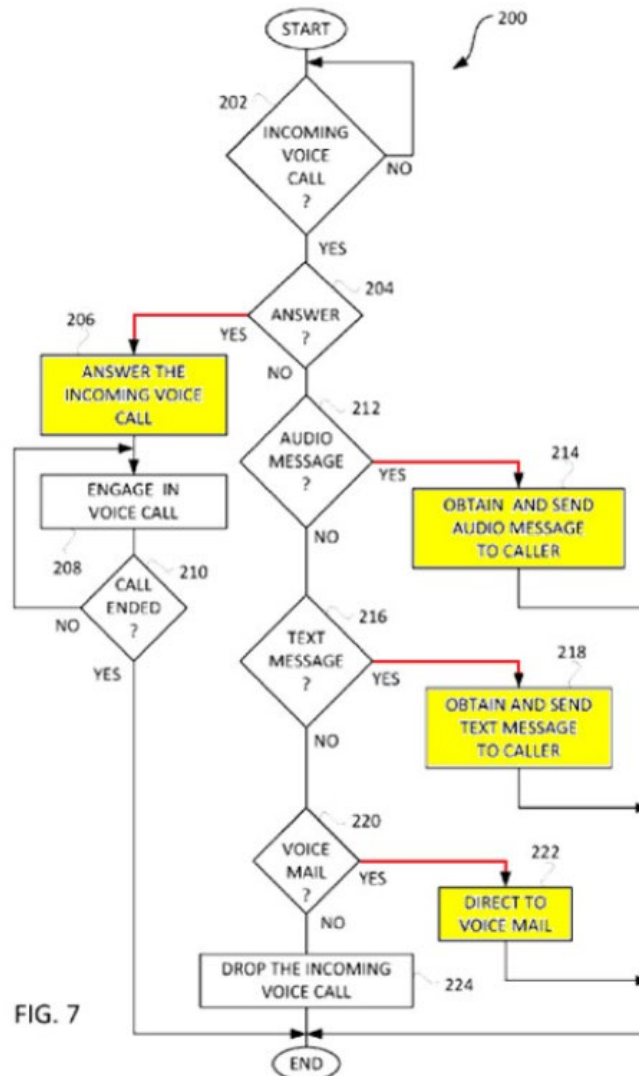


Figure 7 is “a flow diagram of a personal call response process according to one embodiment of the invention.” Ex. 1001, 3:29–30. The patent uses similar language to describe Figures 8–11, which relate respectively to “an audio message response process,” “a text message response process,” “an

automated call response process,” and “a message presentation process.”
Ex. 1001, 3:31–38.

According to Patent Owner, “the embodiment[s] in Figs. 7-11 are not embodiments concerning use of a [network-based portal],” but instead “concern how a recipient user interacting with their client device can respond to an incoming call or message.” PO Resp. 23–24. This distinction is meaningful because each of the challenged claims is directed to either “[a] non-transitory computer readable medium” or “[a] computer-implemented method” that manages or facilitates electronic communications of users “using at least a network-based portal at least based on Internet protocol.” See, e.g. Ex. 1001, 21:50–54, 26:1–3, 27:37–41. According to Patent Owner, the embodiments illustrated by Figures 7–11 are not directed to such a facilitation method, but are instead “methods performed by the second user’s device *upon receiving a message*.” PO Resp. 24 (citing Ex. 1001, Figs. 7–11; Ex. 2005 ¶ 77). As such, Patent Owner argues, “a construction that has the [network-based portal] at a server distinct from the second user’s communication device *does not exclude a preferred embodiment, if anything, it enables them*.” *Id.* (citing Ex. 2005 ¶ 77). Patent Owner supports its argument with testimony by Dr. Rouskas, and we additionally note that Patent Owner’s argument is consistent with the ’038 patent specification’s description of Figures 7–11 as illustrating “message *response* process[es].” Ex. 2005 ¶ 77; Ex. 1001, 3:29–38 (emphasis added).

Petitioner notes that the challenged independent claims recite that “the first message is received by the second user.” Reply 14, Ex. 1001, 22:34–35, 26:48–49, 28:23–24. The portions of Figure 7 that Petitioner highlights refer to “answer[ing] the incoming voice call” at step 206, “obtain[ing] and

send[ing] audio message to caller” at step 214, “obtain[ing] and send[ing] text message to caller” at step 218, and “direct[ing] to voice mail” at step 222, which Petitioner contends are examples where client devices “enable messages to be received.” Reply 15–16. Petitioner appears to infer that these highlighted steps must correspond to the claim limitation it identifies. *See id.* at 14–16. But even if we agree that these are examples of client devices that “enable messages to be received,” Petitioner cites no evidence that links such functionality with the claims’ further requirement that “the second user . . . at least receive messages” “via” the recited “network-based portal.” *See* Ex. 1001, 22:32–33, 26:45–47, 28:21–22. In other words, the issue is not merely whether the client device is capable of implementing functionality in some embodiments that is implemented by a server-resident network-based portal in other embodiments (as appears to undergird the dissent’s analysis); the issue is instead whether that functionality is specifically implemented at the client with what Petitioner adequately shows to be “a network-based portal.”

Petitioner argues inferentially that “[a]ll of the ’038 Patent’s independent claims recite a[] [network-based portal]—thus, because the patent’s figures are embodiments of the patent, they must include a[] [network-based portal].” Reply 16. But Petitioner cites no legal authority to support its implied proposition that a patent’s claims and drawings must have such a correspondence. *See* Sur-reply 14 (“Petitioner’s position that every issued claim must encompass every figure/embodiment of a patent is wrong as a matter of law.”). Indeed, it is not particularly uncommon that a patent describes unclaimed embodiments. *See, e.g., Eli Lilly & Co. v. Hospira, Inc.*, 933 F.3d 1320, 1334 (Fed. Cir. 2019) (“Under the disclosure-

dedication rule, subject matter disclosed by a patentee, but not claimed, is considered dedicated to the public.”). Although Petitioner asserts that “[Patent Owner] remains silent as to the purpose of these disclosures, if not related to the claims,” Petitioner again cites no legal authority to support imposing such a requirement on a patent owner, and we are aware of none. *See Reply 16.*

In addition to failing to cite any authority that supports its legal position on this issue, Petitioner also cites no testimonial evidence that supports its factual interpretation of Figures 7–11. *See generally Reply.* We are accordingly left to discern how a person of ordinary skill in the art would understand these drawings and their related descriptions by weighing Petitioner’s attorney argument against the expert testimony of Dr. Rouskas that Patent Owner cites. *See Ex. 2005 ¶¶ 74–77.* As we note above, we necessarily accord greater weight to Dr. Rouskas’s testimonial evidence. We reiterate that Petitioner was notified of this issue in the Institution Decision, but declined during the trial to introduce additional expert testimonial evidence that might bear on the issue and that Patent Owner might have cross-examined. *See Dec. 25* (“We invite the parties to provide additional briefing in the Response, Reply, and Sur-reply about the meaning of ‘network-based portal’ in the ’038 patent’s claims.”); 37 C.F.R. § 42.23(b) (authorizing reply that responds to arguments raised in a patent owner response or institution decision without limiting introduction of new evidence).

We accordingly determine that Petitioner does not persuasively support its contention that Patent Owner’s proposed construction of “network-based portal” would exclude a preferred embodiment.

3. *Prosecution History*

Neither party cites the prosecution history of the '038 patent when addressing the meaning of “network-based portal.” *See* Pet. 38; PO Resp. 14–28; Reply 9–16; Sur-reply 6–16. During prosecution, the Examiner did not reject any claim based on any prior art. *See, e.g.*, Ex. 1002, 99–105, 164–171, 242–249, 337–344, 424–427, 517–526, 682–690. Instead, in an Examiner-initiated interview early during prosecution, the Examiner suggested that the Applicant submit a terminal disclaimer to obviate a nonstatutory obviousness-type double patenting rejection over a related patent. *Id.* at 106. The Applicant’s filing of such a terminal disclaimer was followed by several Notices of Allowance as prosecution was repeatedly reopened to address Amendments and/or Information Disclosure Statements filed by the Applicant. *See id.* at 88–96, 99–105, 164–171, 242–249, 337–344, 517–526, 682–690. In each Notice of Allowance, the Examiner indicated that the claims were allowed based on the “history rejection” or “previous record[] of rejection” of ancestor applications and patents. *Id.* at 104, 169, 247, 342, 525, 688.

We note that several of the Applicant’s amendments introduced language that refers to the “network-based portal,” either to a then-pending claim or a newly introduced claim. *Id.* at 216–228, 298–311, 318–335, 493–515, 546–570. But the Applicant offered no explanation for those amendments other than that they “further clarify the subject matter regarded as the invention.” *Id.* at 228, 311, 335; *see id.* at 515, 570 (noting addition of claims without explanation). And the Examiner similarly did not address

that language. *See id.* at 99–105, 164–171, 242–249, 337–344, 517–526, 682–690.

While we have thus reviewed the prosecution history, we do not consider it helpful in construing “network-based portal,” particularly in the absence of any arguments presented by either party.

4. Other Arguments

The parties address other points that we also do not find helpful in resolving the precise claim-construction issue before us, i.e. whether the recited “network-based portal” is broad enough to encompass residing at a client side of a network as well as residing at a server side. First, Patent Owner contends that the ’038 patent specification supports concluding that a “network-based portal” has different functionality from a client communication device because the former “allows worldwide access to the user” and the latter is “associated with a user.” PO Resp. 18–19. Petitioner discounts this as “a distinction without a difference.” Reply 11–12.

While we agree that the record supports a meaningful functionality difference between a “network-based portal” and a client communication device, whether that difference lies in “worldwide access” does not bear on our analysis. When questioned about this point on cross-examination, Dr. Rouskas provided responses that we do not find illuminating because Dr. Rouskas agreed that a user’s mobile phone allows that user worldwide access by allowing others to communicate with the user. *See Ex. 1043*, 110:20–24, 114:2–5 (“One is worldwide access to the user. A phone provides that. There’s no question about that.”).

Second, Patent Owner contends that a contradiction arises within independent claims 7, 38, and 46 if the recited “network-based portal” is mapped to a user interface on the client communication device of the recited “first user.” PO Resp. 24–25. Patent Owner’s contention appears to be correct, such as it is. But the contention is clearly driven by one of Petitioner’s arguments in applying the asserted prior art to the claim, rather than as a matter of claim construction itself. *See* Reply 12 (Petitioner disputing that it advances an argument that only the first user’s device contains the network-based portal). That is, Patent Owner’s scenario imposes an additional limit on the network-based portal (not merely residing on a client side, but residing on a specific client device). That scenario therefore does not address the broader claim-construction issue that confronts us, namely whether a “network-based portal” encompasses residing at a client side generally, rather than limited to a specific client communication device.

We accordingly give little weight to these additional arguments by Patent Owner in our evaluation of the claim-construction issue.

5. *Summary*

As we note above, we find certain of Patent Owner’s arguments adequately rebutted by Petitioner, such that we do not consider them in our assessment. Nevertheless, Patent Owner retains compelling arguments for its proposed construction, supported by expert testimonial evidence, including dictionary definitions and the ’038 patent specification’s reference to a “portal or a gateway.” We find such references more compellingly refer to “portal” and “gateway” as synonyms rather than alternatives. In addition,

Patent Owner provides convincing evidence and argument that rebuts the concern raised by the Board at institution whether Patent Owner’s proposed construction would exclude preferred embodiments. Petitioner, who bears the overall burden, addresses that concern only with attorney argument, which we accord less weight.

In light of these considerations, we construe “network-based portal” as Patent Owner advocates, namely as residing on a server side of a network.

E. Overview of the Prior Art

1. 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

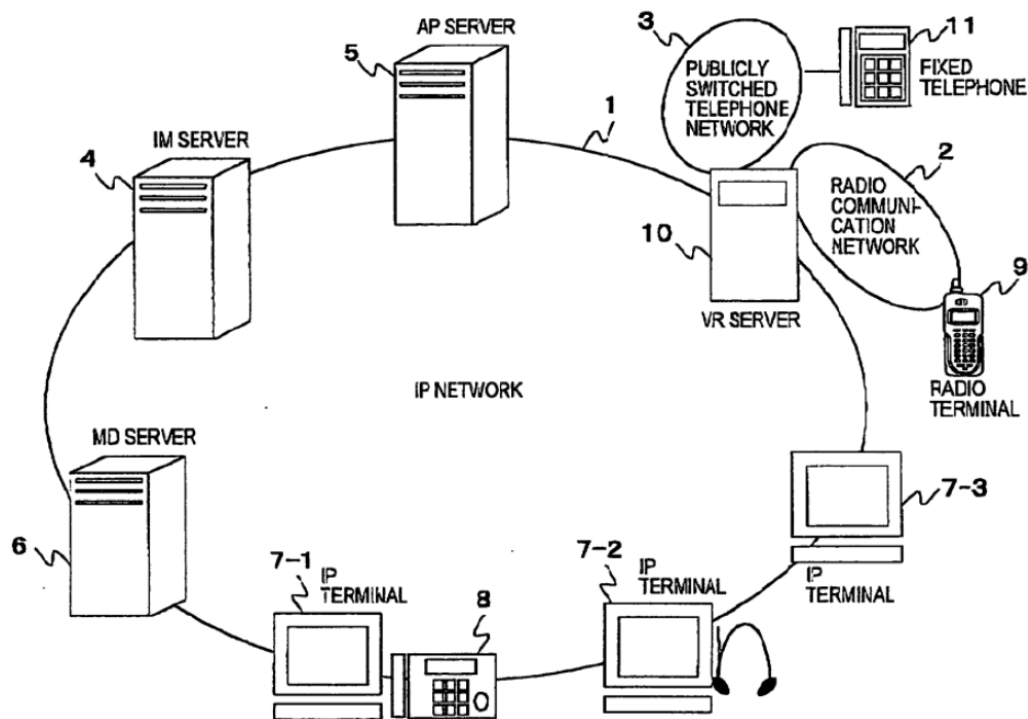


Figure 1 is a schematic diagram of a voice-over-IP (“VoIP”) communication system that includes a variety of communication devices, such as IP terminals 7, fixed telephone 11, and mobile telephone 9. *Id.* ¶¶ 34–35. IM server 4 “manages presence information of an IM client,” AP server 5 “manages connection[s] 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 information 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.

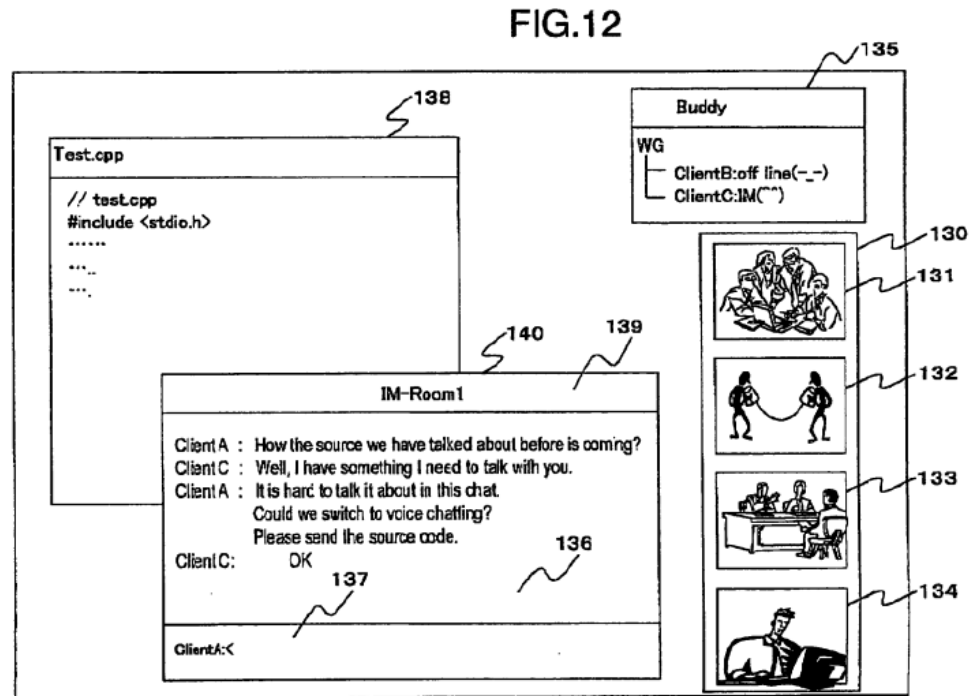


Figure 12 shows an example of a user interface of an IM client, such as may be displayed on IP terminal 7. *Id.* ¶ 162. Display area 135 shows presence information of “chatting buddies.” *Id.* ¶ 164. In addition, several chatting options are provided on main menu bar 130, which includes icon 131 “indicating 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.

2. Hullfish

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

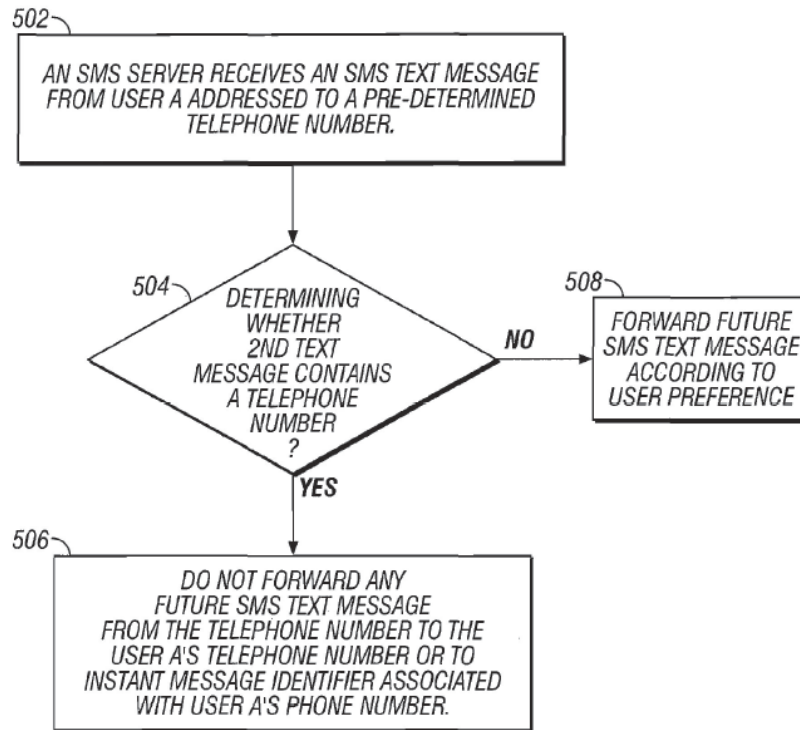


FIG. 5

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.

3. 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.

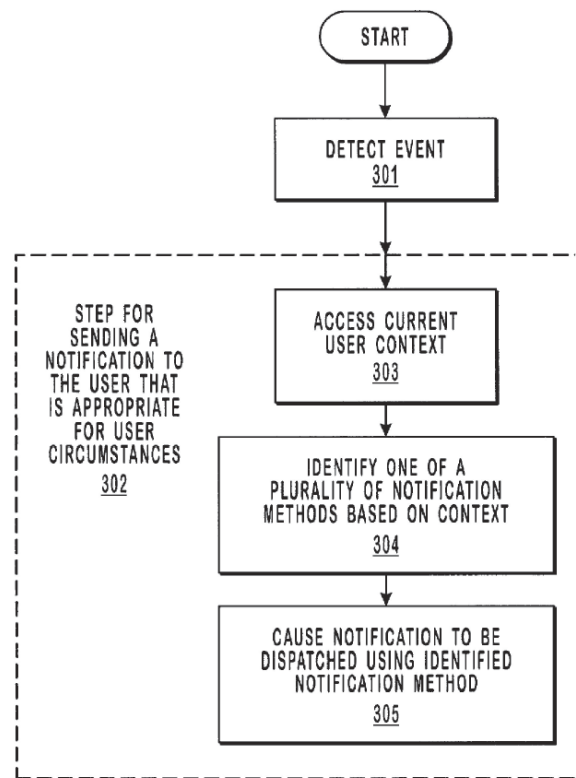


FIG. 3

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 2:28–32; *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.

4. *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.

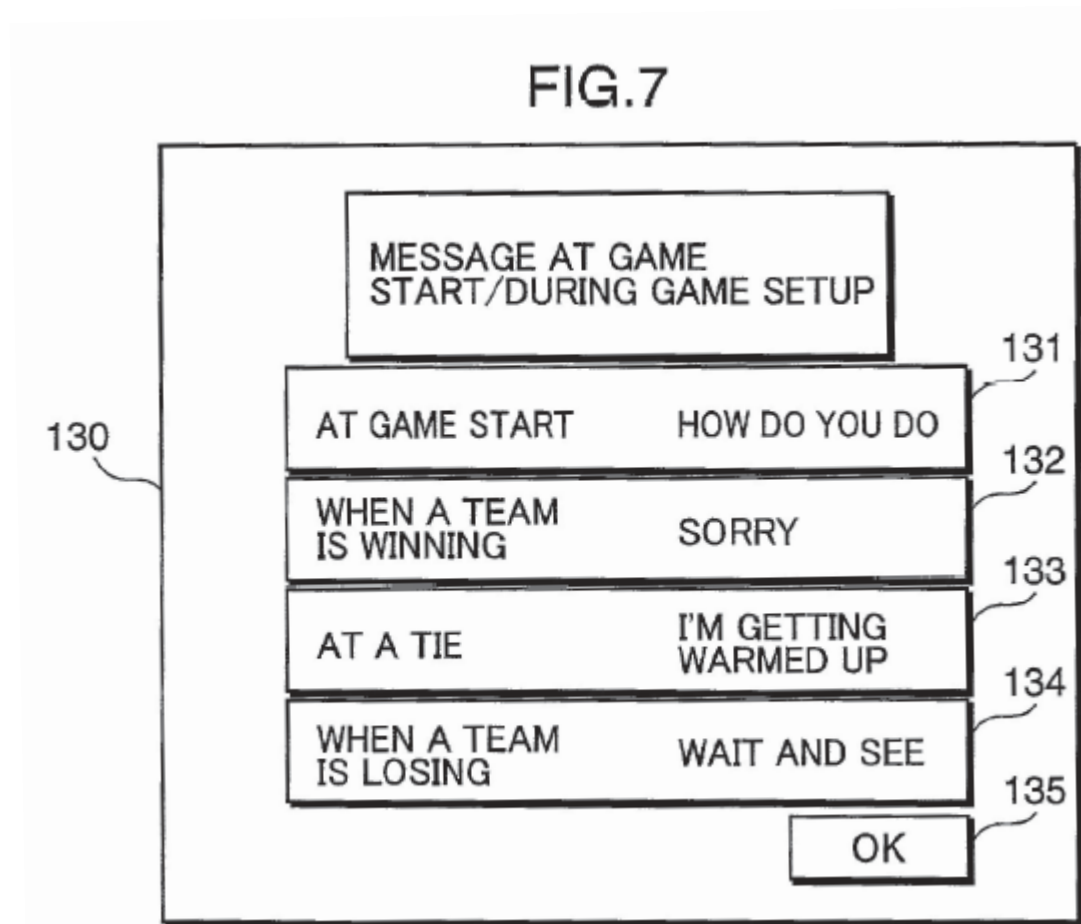


Figure 7 depicts a set of messages that a user may send to other users. *Id.*

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

F. Analysis

Petitioner challenges claims 7, 10–12, 22–24, 33–36, 38–41, 46, 49, 51–53, 55, 57, 58, and 64–66 as unpatentable under 35 U.S.C. § 103(a) over Tanigawa and Hullfish; challenges claims 8, 9, 43, 44, 47, 48, 50, and 54 as unpatentable under 35 U.S.C. § 103(a) over Tanigawa, Hullfish, and Loveland; challenges claims 37, 42, 56, 59–63, and 67 as unpatentable under 35 U.S.C. § 103(a) over Tanigawa, Hullfish, and Takahashi; and challenges

claim 45 as unpatentable under 35 U.S.C. § 103(a) over Tanigawa, Hullfish, Loveland, and Takahashi. Pet. 33–86. In addressing independent claim 7, Petitioner contends that “Tanigawa discloses managing electronic communications of a plurality of users using at least a network-based portal at least based on Internet protocol” by referring to the communication system illustrated in Figure 1 of Tanigawa, reproduced above. *Id.* at 37–38. For the “network-based portal,” Petitioner relies on the user interface illustrated in Figure 12, also reproduced above: “Tanigawa’s IP terminal contains a ‘network-based portal,’ which is a user interface that connects clients to a network.” *Id.* at 38–39. That is, Petitioner relies on Tanigawa’s disclosure of a client-resident interface to meet the claim’s recitation of a “network-based portal.”

The only aspects of independent claim 7 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) “computer program code for permitting the second user to block the first user from using at least the selected communication mode to reach the second user via the network-based portal”; and (2) “computer program code for enabling, via the network-based portal, the first message to be received by the second user via the electronic device associated with the second user, using the selected communication mode, depending on the identifier associated with the second user, in view of the second user not blocking the first user from using the selected

communication mode to reach the second user, via the network-based portal.” *Id.* at 49–52; Ex. 1001, 22:16–27.

Both the preamble and the body of independent claim 7 recite “a network-based portal.” Ex. 1001, 21:53, 21:58, 22:2, 22:14–15, 22:19, 22:20–21, 22:27, 22:33, 22:38–39; *see* PO Resp. 28 (Patent Owner noting repeated recitation of “network-based portal” in independent claim 7).

Under our adopted construction, Petitioner does not show that the combination of Tanigawa and Hullfish meets the claim requirements of a “network-based portal.” That is, Petitioner’s reliance on a client-resident interface to meet the claim’s recitation of a “network-based portal” is incompatible with our construction of that phrase.

We accordingly conclude that Petitioner does not show, by a preponderance of the evidence, that independent claim 7 is unpatentable under 35 U.S.C. § 103(a) over Tanigawa and Hullfish. The same deficiency exists with respect to Petitioner’s analysis of independent claims 38 and 46. *See* Pet. 64 (Petitioner’s analysis of claim 38 relying substantially on analysis of claim 7), 65–67 (Petitioner’s analysis of claim 46 relying substantially on analysis of claim 7). Because the deficiency in Petitioner’s showing also applies to the dependent claims, which inherit the “network-based portal” limitations, we conclude that Petitioner does not show that any of claims 7, 10–12, 22–24, 33–36, 38–41, 46, 49, 51–53, 55, 57, 58, or 64–66 is unpatentable under 35 U.S.C. § 103(a) over Tanigawa and Hullfish; that any of claims 8, 9, 43, 44, 47, 48, 50, or 54 is unpatentable under 35 U.S.C. § 103(a) over Tanigawa, Hullfish, and Loveland; that any of claims 37, 42, 56, 59–63, or 67 is unpatentable under 35 U.S.C. § 103(a) over Tanigawa, Hullfish, and Takahashi; or that claim 45 is unpatentable

under 35 U.S.C. § 103(a) over Tanigawa, Hullfish, Loveland, and Takahashi.

III. CONCLUSION

The table below summarizes our conclusions as to the challenged claims.

Claims	35 U.S.C. §	References	Claims Shown Unpatentable	Claims Not Shown Unpatentable
7, 10–12, 22–24, 33–36, 38–41, 46, 49, 51–53, 55, 57, 58, 64–66	103(a)	Tanigawa, Hullfish		7, 10–12, 22–24, 33–36, 38–41, 46, 49, 51–53, 55, 57, 58, 64–66
8, 9, 43, 44, 47, 48, 50, 54	103(a)	Tanigawa, Hullfish, Loveland		8, 9, 43, 44, 47, 48, 50, 54
37, 42, 56, 59–63, 67	103(a)	Tanigawa, Hullfish, Takahashi		37, 42, 56, 59–63, 67
45	103(a)	Tanigawa, Hullfish, Loveland, Takahashi		45
Overall Outcome				7–12, 22–24, 33–67

IV. ORDER

In consideration of the foregoing, it is

ORDERED that claims 7–12, 22–24, and 33–67 of U.S. Patent No. 10,492,038 B2 have not been shown, by a preponderance of the evidence, to be unpatentable; and

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EPIC GAMES, INC.,
Petitioner,

v.

INGENIOSHARE, LLC,
Patent Owner.

IPR2022-00295
Patent 10,492,038 B2

AMUNDSON, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the majority's determination that a "network-based portal" does not encompass "a user interface that connects clients to a network" and instead may reside only on a server side of a network. In my view, the majority gives too much weight to the extrinsic evidence in making that determination. The Federal Circuit has "viewed extrinsic evidence in general as less reliable than the patent and its prosecution history in determining how to read claim terms," e.g., because expert testimony "is generated at the time of and for the purpose of litigation

and thus can suffer from bias that is not present in intrinsic evidence.”

Phillips v. AWH Corp., 415 F.3d 1303, 1318 (Fed. Cir. 2005) (en banc).

Below, I discuss each party’s claim-construction arguments and then explain my analysis of the intrinsic evidence and the extrinsic evidence and the bases for my disagreement with the majority’s claim construction.

Based on my view that a “network-based portal” encompasses “a user interface that connects clients to a network” and my review of the evidence, I also respectfully dissent from the majority’s determination that Petitioner fails to demonstrate by a preponderance of the evidence that the challenged claims are unpatentable.

I. BACKGROUND

Each challenged independent claim requires a “network-based portal.” Ex. 1001, 21:50–22:43 (claim 7), 26:1–57 (claim 38), 27:37–28:39 (claim 46). Certain challenged dependent claims also require a “network-based portal.” *Id.* at 22:59–63 (claim 11), 23:28–32 (claim 16), 24:5–12 (claim 22), 25:20–51 (claims 34–35), 26:58–67 (claim 39), 28:40–49 (claim 47), 28:53–29:3 (claim 49), 29:7–48 (claims 51–53), 30:40–46 (claim 63), 30:64–31:3 (claim 66). In their respective arguments, the parties dispute the meaning of “network-based portal.” *See, e.g.*, Pet. 38–39; Resp. 14–28; Reply 9–16; Sur-reply 6–16.⁴

⁴ This decision uses the following abbreviations and words to identify documents filed with the Board: “Pet.” for the Petition (Paper 1); “Resp.” for Patent Owner’s Response (Paper 15); “Reply” for Petitioner’s Reply (Paper 17); “Sur-reply” for Patent Owner’s Sur-reply (Paper 22); and “Hr’g Tr.” for the transcript of the February 17, 2023, oral hearing in IPR2022-00202 for related U.S. Patent No. 10,142,810 B2 (Paper 28 in IPR2022-00202).

Petitioner contends that a “network-based portal” encompasses “a user interface that connects clients to a network.” Pet. 38–39; Reply 9, 12.

Patent Owner equates a “portal” to a “networked server.” *See* Resp. 17; Sur-reply 6. In particular, Patent Owner contends that the ’038 patent’s specification (1) defines a “portal” as a “gateway” and (2) defines a “gateway” as a “networked server.” Resp. 17 (citing Ex. 1001, 4:22, 4:62–63, 7:11–12, 7:15, 16:15–18; Ex. 2005 ¶ 65); *see* Hr’g Tr. 44:11–17; Sur-reply 6.

II. PATENT OWNER’S ARGUMENTS

Patent Owner asserts that the ’038 patent’s specification uses “portal” and “gateway” synonymously. Sur-reply 6. As support, Patent Owner quotes the following statements in the specification where the word “or” appears between “portal” and “gateway”: “A portal or gateway approach could provide general Internet access to one or more embodiments of the communication management systems The portal or gateway can then facilitate download of a database or update thereto to a communication device, such as a phone.” Resp. 18, 22 (quoting Ex. 1001, 7:11–17). Patent Owner also asserts that Dr. Rouskas provides “unrebutted” testimony that the specification uses “portal” and “gateway” synonymously because the word “or” sometimes appears between “portal” and “gateway” in the specification. Sur-reply 9 (citing Ex. 1043, 90:4–9, 91:10–15). According to Patent Owner, a “portal” or “gateway” connects “distinct networks” in contrast to a client device that does not do so. Resp. 22 (citing Ex. 2005 ¶ 73).

To support its contention concerning the equivalence of a “gateway” and a “networked server,” Patent Owner quotes the following statements in

the specification: “The remote server computer can be a networked server coupled to the network 108. One example of a networked server is a gateway computer for a wireless 10 [sic] electronic device, such as a mobile telephone.” Resp. 17 (quoting Ex. 1001, 16:15–18).

Further, Patent Owner asserts that the specification “does not define” a “portal” or “network-based portal” as a client device. Resp. 17 (citing Ex. 2005 ¶ 65). Patent Owner asserts that a “portal” or “network-based portal” differs from a client device because a client device is “associated with a user,” whereas a “portal” or “network-based portal” must allow “worldwide access” to a user. *Id.* at 18–19 (quoting Ex. 1001, 2:25–29, 4:52–53, 6:33–39, 7:11–14); Sur-reply 9. Patent Owner also asserts that a “portal” or “network-based portal” resides at a “server distinct from” a client device. Resp. 24; *see* Sur-reply 7, 15–16.

Additionally, Patent Owner contends that the claim language distinguishes a “network-based portal” from a client device. *See* Resp. 19. Patent Owner bases that contention on certain limitations in independent claims 7, 38, and 46, as exemplified by the following limitations in claim 7:

[7.7] computer program code for receiving, from the second user, contact information associated with the second user to allow the second user to participate and at least receive messages via the network-based portal; and

[7.8] wherein even when the first message is received by the second user via the electronic device associated with the second user depending on the identifier associated with the second user, the contact information associated with the second user is not provided via the network-based portal to the first user via an electronic device associated with the first user.

Id.; *see* Ex. 1001, 22:30–40.

Patent Owner contends that if the “network-based portal” is “on the client-side of the sender/originator of a communication” according to Petitioner’s position, then the “contact information of the recipient is also necessarily on” the sender’s client device. Resp. 35. Patent Owner also contends that this arrangement would violate claims 7, 38, and 46 because the claims require that “the contact information is not available to the sender,” i.e., the first user. *Id.* at 35, 46 (emphasis omitted).

Patent Owner asserts that claim 7’s preamble “expressly states that ‘each of the plurality of users’ have their ‘corresponding identifier’ ‘set via the network-based portal’.” Resp. 20 (citing Ex. 2005 ¶ 69). Patent Owner further asserts that claim 7’s preamble requires a single “network-based portal” through “which each of the plurality of users set their corresponding identifier.” Sur-reply 13. According to Patent Owner, Petitioner’s position “would require ‘a plurality’ of users to have access to the first user’s device so that ‘each of the plurality of users’ can set their respective identifier(s),” and “typically a user’s contact (or anyone else) is not allowed access to the user’s device.” Resp. 20–21 (citing Ex. 2005 ¶¶ 69, 71). Patent Owner also asserts that “[s]ince the recipients (contacts) cannot possibly use the sender’s communication device to set their identifier, the preamble’s requirement that ‘each of the plurality of users’ has his/her ‘corresponding identifier’ ‘set via the network-based portal’ invalidates Petitioner’s arguments” that a client device may include a “network based portal.” *Id.* at 21 (citing Ex. 2005 ¶ 71); *see id.* at 25; Sur-reply 13.

To further support its position, Patent Owner quotes two undated online definitions of “portal” that Dr. Rouskas found with a Google search. Resp. 16–17; *see* Ex. 1043, 61:17–63:10; Ex. 2005 ¶ 64. Patent Owner

quotes the first online definition located at <https://www.techopedia.com/definition/13077/portal-internet> as follows: “In the context of the Internet, a portal refers to any commonly used website serving as an entry point to the Internet, usually with many links to a wide variety of information, data, resources and services.” Resp. 16; Ex. 2005 ¶ 64. Patent Owner asserts that websites are “hosted on web servers” and not on client devices. Resp. 17 (citing Ex. 2005 ¶ 64). Patent Owner quotes the second online definition located at <https://www.techtarget.com/whatis/definition/portal> as follows: “Portal is a term, generally synonymous with gateway, for a World Wide Web site that is or proposes to be a major starting site for users when they get connected to the Web or that users tend to visit as an anchor site.” Resp. 16–17; Ex. 2005 ¶ 64.

Patent Owner notes that the Institution Decision cited the embodiments in the ’038 patent’s Figures 7–11 when stating that the ’038 patent “discloses embodiments where claimed functionality resides in a ‘mobile phone,’ i.e., a client-side device.” Resp. 23 (quoting Inst. Dec. 23). Patent Owner contends that “[c]laim 7 concerns ‘managing electronic communications of a plurality of users using at least a network-based portal.’” *Id.* at 24. Patent Owner then contends that the embodiments in Figures 7–11 are “methods performed by the second user’s device upon receiving a message” and “not embodiments for ‘managing electronic communications using at least a network based portal’ as are the claims of the ’038 Patent.” *Id.* (emphasis omitted); *see* Sur-reply 14–18.

III. PETITIONER’S ARGUMENTS

Petitioner asserts that the ’038 patent discloses the claimed functionality for a “network-based portal” residing in a client device, e.g., in

a mobile phone. Reply 9. Petitioner asserts that independent claims 7, 38, and 46 specify that “the first message is received by the second user.” *Id.* at 14. Petitioner then contends that the ’038 patent discloses (1) the recipient functionality of “allowing users to specify who may contact them and see their contact information” taking place “all in the phone” and (2) the phone “automatically manag[ing] the communication.” *Id.* at 14–15 (quoting Ex. 1001, 7:32–33, 7:35–36). Petitioner also contends that a “network-based portal” residing in a client device enables not only message receipt but also message management. *Id.* at 15 (citing Ex. 1003 ¶¶ 397–398).

To support its contentions about message receipt and message management taking place “all in the phone,” Petitioner provides the highlighted version of the ’038 patent’s Figure 7 reproduced below (Reply 15):

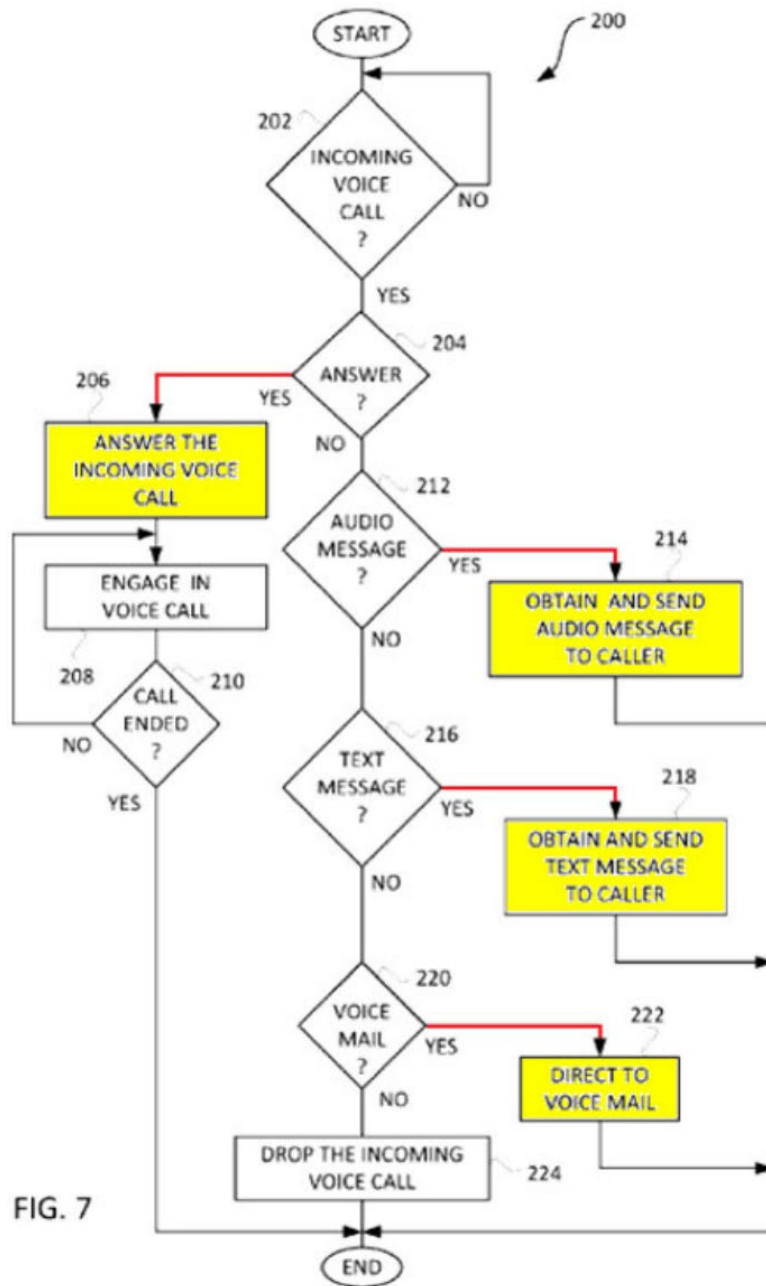


Figure 7 “is a flow diagram of a personal call response process 200” performed “by an electronic device, such as a mobile communication device

(e.g., mobile telephone).” Ex. 1001, 9:22–26, Fig. 7; *see id.* at 3:29–30.

This highlighted version of Figure 7 includes yellow highlighting over the following steps in process 200:

- step 206 “answer the incoming voice call”;
- step 214 “obtain and send audio message to caller”;
- step 218 “obtain and send text message to caller”; and
- step 222 “direct to voicemail.”

See Reply 15. Petitioner argues that “because the patent’s figures are embodiments of the patent, they must include” a “network-based portal.” *Id.* at 16.

Further, Petitioner asserts that the ’038 patent’s specification “treats the phrase ‘portal or gateway’ differently from the singular ‘portal,’ using these phrases to describe different embodiments, indicating that portals and gateways are two alternative means to establish communication.” Reply 11 (citing Ex. 1001, 4:33–5:4). Petitioner also asserts that the specification’s “recitation of ‘portal or gateway’ means the two are alternatives, not that one redefines the other.” *Id.* (citing *Thorner v. Sony Comput. Entm’t Am. LLC*, 669 F.3d 1362, 1368 (Fed. Cir. 2012)).

Regarding Patent Owner’s assertion that websites are “hosted on web servers” and not on client devices, Petitioner argues that no claim requires that a “network-based portal” be “hosted.” Reply 10; *see* Resp. 17.

Additionally, Petitioner contends that Patent Owner’s assertion about a “network-based portal” differing from a client device because a client device is “associated with a user” lacks merit since a client device may include a “network-based portal” that “connects a user to a network” even though the client device is “associated with a user.” Reply 11; *see* Resp.

18–19. Petitioner contends that Dr. Rouskas concedes that “a user’s mobile phone allows worldwide access to that user by allowing others to communicate with the user.” Reply 11–12 (citing Ex. 1043, 110:20–24, 114:2–5).

As for the claim language “each of the plurality of users” have their “corresponding identifier” “set via the network-based portal,” Petitioner asserts that a “network-based portal” does not “solely exist in a sender’s device.” Reply 12 (citing Ex. 1003 ¶ 398). Petitioner also asserts that each user (“both senders and recipients”) may have a client device with a “network-based portal.” *See id.* at 12–14.

Petitioner criticizes the two online definitions of “portal” that Dr. Rouskas found as “cherry-picked from search results for ‘portal’ rather than from any nuanced inquiry or analysis.” Reply 10 (citing Ex. 1043, 62:24–63:10); Hr’g Tr. 74:5–16. According to Petitioner, Dr. Rouskas “selectively disregarded definitions that include the word ‘interface.’” Reply 10. To undermine Dr. Rouskas’s credibility, Petitioner introduces two online definitions of “portal” with 2022 copyright dates that include the word “interface.” *Id.*; *see* Ex. 1041, 1, 5; Ex. 1042, 1, 5; Hr’g Tr. 73:22–74:16, 75:8–76:7. Petitioner does not rely on those online definitions to establish the meaning of “network-based portal.” Hr’g Tr. 75:8–76:7.

Petitioner quotes the first online definition located at <https://www.liferay.com/resources/l/web-portal> as follows: “A portal is a web-based platform that collects information from different sources into a single user interface.” Reply 10 (emphasis omitted) (quoting Ex. 1041, 1). Petitioner quotes the second online definition located at <https://www.gartner.com/en/>

information-technology/glossary/mobile-portal as follows: “A mobile portal is an Internet gateway that enables mobile devices to connect remotely . . . typically via a Web browser interface.” *Id.* (alteration by Petitioner) (emphasis omitted) (quoting Ex. 1042, 1).

IV. ANALYSIS

After analyzing the intrinsic evidence and the extrinsic evidence, I agree with Petitioner that a “network-based portal” encompasses “a user interface that connects clients to a network.” *See* Pet. 38–39; Reply 9, 12. Below, I explain my analysis of the intrinsic evidence and the extrinsic evidence.

Independent claims 7 and 38 recite “managing electronic communications of a plurality of users using at least a network-based portal,” and independent claim 46 recites “facilitates electronic communication of a plurality of users using at least a network-based portal.” Ex. 1001, 21:52–53, 26:1–3, 27:39–40. The ’038 patent’s specification discloses and depicts “managing electronic communications of a plurality of users” using a “phone” or a “mobile telephone,” i.e., a client device with a user interface. *See id.* at 3:16–38, 4:48–50, 6:4–6, 7:18–36, 7:52–56, 8:18–21, 9:15–18, 9:21–13:43, 14:44–53, 14:62–67, 15:12–16:2, 18:3–5, 18:11–14, 18:22–30, Figs. 1–11. Moreover, by “managing electronic communications of a plurality of users” according to claims 7 and 38, a “phone” or a “mobile telephone” facilitates electronic communication among the plurality of users according to claim 46.

For example, Figures 7–11 depict “managing” functionality as recited in claims 7 and 38 and “facilitating” functionality as recited in claim 46

performed “by an electronic device, such as a mobile communication device (e.g., mobile telephone)” as follows:

- providing a first user with a voice communication mode and a text communication mode, e.g., as recited in limitations [7.1], [7.2], [38.1], [38.2], [46.1], and [46.2];
- enabling a second user to receive a voice message or a text message using the selected communication mode in view of the second user not blocking the first user, e.g., as recited in limitations [7.4], [7.5], [38.4], [38.5], [46.4], and [46.5]; and
- allowing the second user to receive messages through an electronic device associated with the second user, e.g., as recited in limitations [7.8], [38.8], and [46.8].

Ex. 1001, 9:22–10:5, 10:34–14:57, 15:12–16:2, 21:50–22:43, 26:1–57, 27:37–28:39, Figs. 7–11; *see id.* at 3:29–38, 10:6–19.

Further, Figures 7–11 depict “managing” functionality and “facilitating” functionality as recited in certain dependent claims. In particular, dependent claims 37, 42, 45, and 56 specify that the second user may “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, 25:62–67 (claim 37), 27:15–19 (claim 42), 27:28–36 (claim 45), 29:58–63 (claim 56); *see id.* at 30:12–18 (claim 59), 31:4–10 (claim 67). The specification’s disclosure about the second user “select[ing] a predetermined message to send to the first user” appears in the discussion of Figures 8 and 9 depicting steps performed “by an electronic device, such as a mobile communication device (e.g., mobile telephone).” *Id.* at 9:22–26, 10:34–38, 10:63–66, 12:9–12, 12:21–23, Figs. 8–9; *see id.* at 3:29–34. As support for claims 37, 42, 45, and 56, the specification explains that:

- (1) Figure 8's step 306 "determines whether the user (i.e., called party) of the mobile communication device has selected one or more of the predetermined audio messages"; and
- (2) Figure 9's step 406 "determines whether one (or more) of the predetermined text messages has been selected."

Id. at 10:63–66, 12:21–23, Figs. 8–9.

As discussed above, Petitioner argues that "because the patent's figures are embodiments of the patent, they must include" a "network-based portal." Reply 16; *see supra* § III. Petitioner's argument disregards the general principle that a patent may disclose unclaimed embodiments. *See MyMail, Ltd. v. Am. Online, Inc.*, 476 F.3d 1372, 1377 (Fed. Cir. 2007). Nonetheless, as also discussed above, Figures 7–11 illustrate claimed embodiments, i.e., by depicting "managing" functionality and "facilitating" functionality as recited in various claims performed "by an electronic device, such as a mobile communication device (e.g., mobile telephone)." *See* Ex. 1001, 9:22–10:5, 10:34–14:57, 15:12–16:2, 21:50–22:43, 25:62–26:57, 27:15–19, 27:28–28:39, 29:58–63, Figs. 7–11.

Additionally, the specification indicates that a "portal" may reside in a "phone," i.e., a client device with a user interface. Ex. 1001, 4:48–50, 6:4–6, 7:25–33, 7:52–54, 14:62–65, 18:11–14, Figs. 1–5. In particular, the specification explains that "a portal provides a number of intelligent communication modes (ICM) for the user to select as shown in FIG. 1" and "the intelligent communication modes shown in FIG. 1 for the user to select are in the phone." *Id.* at 6:4–6, 7:25–26. The specification also explains that "the portal can be used to control the selection and setting of different intelligent communication modes" and "communication mode changes can

be performed at an electronic device to better suit the needs or condition of the electronic device or user preferences.” *Id.* at 4:48–50, 7:52–54, 14:62–65, 18:11–14. Because “the portal can be used to control the selection and setting of different intelligent communication modes” and “communication mode changes can be performed at an electronic device,” e.g., at a “phone,” the “portal” can reside in a “phone.”

The specification discloses an example of “managing electronic communications of a plurality of users” using a “phone.” *See* Ex. 1001, 7:27–36. In particular, the specification explains that “the phone could automatically manage the communication” from various individuals after a user configures the phone as follows:

define the contact classes, such as the ones shown in FIG. 2;
set up the urgency classes, such as the ones shown in FIG. 3;
define the statuses, such as the ones shown in FIG. 4; set up
the Access Priority Database, such as the one shown in FIG. 5;
and categorize a number of the user’s contacts into the
corresponding ContactClasses, all in the phone.

Id. at 7:27–33, Figs. 1–5; *see id.* at 18:22–30.

The specification discloses other techniques for “managing electronic communications of a plurality of users” using a “phone” as follows:

- “keep information in local databases, such as in such a phone”;
- configure “user settings (e.g., preferences) to decline calls/messages matching certain criteria”;
- “reduce user input at the mobile communication device by making use of stored data pertaining to its hardware components, configuration or preferences”;
- “provide feedback to a caller without answering a voice call from the caller”;

- “choose not to take the voice call from the calling party” and instead “provide the calling party with some limited information,” e.g., “in an audio or textual format”;
- “enable the called party to provide a brief audio or text message to the calling party”;
- “automatically (i.e., without user input) respond to the calling party via an audio or text message”; and
- “communicate in different ways depending on device configuration, user preferences, prior history, time or other criteria.”

Ex. 1001, 7:23–25, 7:54–56, 8:18–21, 9:15–18, 13:19–25, 14:44–53, 14:65–67, 18:3–5, 18:22–30; *see id.* at 13:44–55.

For these reasons, the '038 patent's specification discloses and depicts “managing electronic communications of a plurality of users” (and “facilitat[ing] electronic communication of a plurality of users”) using a “phone” or a “mobile telephone,” i.e., a client device with a user interface. *See* Ex. 1001, 3:16–38, 4:48–50, 6:4–6, 7:18–36, 7:52–56, 8:18–21, 9:15–18, 9:21–13:43, 14:44–53, 14:62–67, 15:12–16:2, 18:3–5, 18:11–14, 18:22–30, Figs. 1–11. For example, the specification explains that “the portal can be used to control the selection and setting of different intelligent communication modes” and “communication mode changes can be performed at an electronic device,” e.g., at a “phone” with the “portal.” *Id.* at 4:48–50, 7:52–54, 14:62–65, 18:11–14. Hence, construing “network-based portal” to exclude “a user interface that connects clients to a network” would exclude preferred embodiments from claim scope. *See id.* at 3:16–38, 4:48–50, 6:4–6, 7:18–36, 7:52–56, 8:18–21, 9:15–18, 9:21–13:43, 14:44–53, 14:62–67, 15:12–16:2, 18:3–5, 18:11–14, 18:22–30, 21:50–22:43, 25:62–26:57, 27:15–19, 27:28–28:39, 29:58–63, Figs. 1–11. As discussed

above, those preferred embodiments include mobile devices covered by the challenged independent claims and certain dependent claims.

A construction excluding a preferred embodiment is “rarely, if ever correct.” *PPC Broadband, Inc. v. Corning Optical Commc’ns RF, LLC*, 815 F.3d 747, 755 (Fed. Cir. 2016). Those rare circumstances do not exist here.

Moreover, a patent’s drawings “must show every feature of the invention specified in the claims.” 37 C.F.R. § 1.83(a). The ’038 patent’s drawings do not show a “portal” or “network-based portal” residing at a “server distinct from” a client device according to Patent Owner’s arguments. *See* Ex. 1001, 3:27–28, 8:35–9:21, Fig. 6; Resp. 24; Sur-reply 7, 15–16. The drawings do not even show a server. *See* Ex. 1001, 8:35–9:21, Fig. 6. Patent Owner does not contend otherwise. *See, e.g.*, Resp. 14–28; Sur-reply 6–16. But the drawings do show mobile telephones (items 102 in Figure 6) and steps performed by mobile telephones. Ex. 1001, 3:27–38, 8:35–40, 9:22–26, 10:34–38, 12:9–12, 13:17–25, 15:12–15, Figs. 6–11.

Consistent with the specification, the claim language does not preclude a “network-based portal” from encompassing “a user interface that connects clients to a network.” *See, e.g.*, Ex. 1001, 21:50–22:43 (claim 7), 22:59–63 (claim 11), 23:28–32 (claim 16), 24:5–12 (claim 22), 25:20–51 (claims 34–35), 26:1–67 (claims 38–39), 27:37–28:49 (claims 46–47), 28:53–29:3 (claim 49), 29:7–48 (claims 51–53), 30:40–46 (claim 63), 30:64–31:3 (claim 66). For instance, no challenged claim recites a “server.” *Id.* at 21:50–23:4, 24:5–22, 25:14–31:10. And no challenged claim specifies a location for a “network-based portal.” *Id.* If the patentee had wanted to

limit the location for a “network-based portal,” the patentee could have readily done so by reciting a “network-based portal at a server.”

As evidence of this, independent claim 1 and claims 3–6 that depend directly or indirectly from claim 1 expressly recite a “server.” Ex. 1001, 20:13–21:18 (claim 1), 21:22–49 (claims 3–6). Although Petitioner does not challenge claims 1–6, “[o]ther claims of the patent in question, both asserted and unasserted,” can be “valuable sources of enlightenment as to the meaning of a claim term.” *See Phillips*, 415 F.3d at 1314; Pet. 1, 33–86.

Patent Owner misinterprets the claims when contending that locating a “network-based portal” on the first user’s client device would violate claims 7, 38, and 46 because, according to Patent Owner, the claims require that “the contact information is not available to the sender,” i.e., the first user. *See* Resp. 35, 46. Patent Owner’s contention rests on the erroneous premise that the claims require that the second user’s contact information not be provided to the first user’s client device. *See id.* at 35–36.

Limitations [7.8], [38.8], and [46.8] specify that “the contact information associated with the second user is not provided via the network-based portal to the first user.” Ex. 1001, 22:37–39, 26:51–53, 28:25–27. Limitations [7.8], [38.8], and [46.8] do not exclude sending the second user’s “contact information” to the first user’s client device and then preventing the first user from viewing the second user’s “contact information,” e.g., by precluding the first user’s client device from displaying the second user’s “contact information.” *See id.* at 22:34–40, 26:48–54, 28:23–34.

The ’038 patent’s specification supports this interpretation by explaining that (1) “the user can be aware of the identity of the caller even

without being informed of the number of the caller” and (2) “the caller can reach the user without being aware of the number of the phone the user is using to receive the call.” Ex. 1001, 5:33–38. Additionally, the specification discloses an example where a second user with a “cellular phone” talks to a first user and the first user “is not aware of the phone number of the cellular phone.” *Id.* at 2:58–62.

As for the claim language “each of the plurality of users” have their “corresponding identifier” “set via the network-based portal,” the claims earlier recite “a plurality of users using at least a network-based portal.” Ex. 1001, 21:50–60, 26:1–9. The “indefinite article ‘a’ or ‘an’ in patent parlance carries the meaning of ‘one or more’ in open-ended claims containing the transitional phrase ‘comprising.’” *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000). “That ‘a’ or ‘an’ can mean ‘one or more’ is best described as a rule, rather than merely as a presumption or even a convention.” *Baldwin Graphic Sys., Inc. v. Siebert, Inc.*, 512 F.3d 1338, 1342 (Fed. Cir. 2008). “The subsequent use of definite articles ‘the’ or ‘said’ in a claim to refer back to the same claim term does not change the general plural rule, but simply reinvokes that non-singular meaning.” *Id.* “The exceptions to this rule are extremely limited: a patentee must evince a clear intent to limit ‘a’ or ‘an’ to ‘one.’” *01 Communique Lab., Inc. v. LogMeIn, Inc.*, 687 F.3d 1292, 1297 (Fed. Cir. 2012).

Here, Patent Owner does not identify evidence of a clear intent to limit “a network-based portal” to “one” portal in the challenged claims. *See, e.g.*, Resp. 14–28; Sur-reply 6–16. Hence, I agree with Petitioner that each user may have a client device with a “network-based portal.” *See* Ex. 1001, 21:50–60, 26:1–9; Reply 12. Moreover, each user may use their “network-

based portal” to set their “corresponding identifier.” *See* Ex. 1001, 21:50–60, 26:1–9.

Patent Owner’s contention that the embodiments in Figures 7–11 are “not embodiments for ‘managing electronic communications using at least a network based portal’ as are the claims of the ’038 Patent” lacks merit. *See* Resp. 24. The ’038 patent’s specification explains that the description and the drawings illustrate “by way of example the principles of the invention.” Ex. 1001, 3:7–11. Further, as discussed above, Figures 7–11 depict “managing” functionality and “facilitating” functionality as recited in the challenged independent claims and certain dependent claims performed “by an electronic device, such as a mobile communication device (e.g., mobile telephone).” *See, e.g.*, Ex. 1001, 9:22–10:5, 10:34–14:57, 15:12–16:2, 21:50–22:43, 25:62–26:57, 27:15–19, 27:28–36, Figs. 7–11; *see also id.* at 3:29–38, 10:6–19.

Additionally, contrary to Patent Owner’s contention, the ’038 patent’s specification does not (1) define a “portal” as a “gateway” or (2) define a “gateway” as a “networked server.” *See* Resp. 17; Sur-reply 6. An analysis of the specification shows that each part of Patent Owner’s attempt to equate a “portal” to a “networked server” fails.

Regarding a “portal” and a “gateway,” the specification explains that a “portal” and a “gateway” have functionality that overlaps but differs in different embodiments as follows:

A number of embodiments depend on the different modes of communication converging onto the internet protocol platform. A communication gateway or a portal is formed allowing the user to receive communications from numerous sources through different modes. . . .

One embodiment of the invention uses an open portal based on the web. Based on the portal, the user can securely determine who can reach him at what conditions. . . .

Thus, in one embodiment, the portal can be used to control the selection and setting of different intelligent communication modes for the user. These intelligent communication modes allow priorities of various kinds of communication options to be set by the user. . . . The portal . . . can dynamically determine, for example, whether a call initiated at different time by different callers should be accepted by the user in real-time or handled by other mechanisms. . . .

In one embodiment, the portal or gateway also includes a database to keep track of the user's different contacts or acquaintances, and the access priorities of each contact. . . .

In one embodiment, the portal can dynamically change the access priorities of a caller trying to reach the user. . . .

Ex. 1001, 4:20–24, 4:33–35, 4:48–56, 4:62–64, 5:5–6.

The '038 patent's specification uses the phrase “portal or gateway” three times and the phrase “communication gateway or a portal” once. Ex. 1001, 4:22–24, 4:62–64, 7:11–17. The specification uses the word “portal” or “gateway” separately and unconnected by “or” more than twenty times. *See, e.g., id.* at 4:20–7:17, code (57). The specification sometimes uses the phrase “portal or gateway” and sometimes uses the word “portal” or “gateway” separately to describe functionality that overlaps but differs in different embodiments, not to avoid repetition as Patent Owner contends. The specification's infrequent use of “or” between “portal” and “gateway” does not define “portal” to mean “gateway” or show that “portal” and “gateway” are used synonymously.

The Authoritative Dictionary of IEEE Standards Terms (7th ed. 2000) defines “gateway” as follows:

- (1) “A functional unit that interconnects a local area network (LAN) with another network having different higher layer protocols”;
- (2) “A dedicated computer that attaches to two or more networks and that routes packets from one to the other”;
and
- (3) “In networking, a device that connects two systems that use different protocols.”

IEEE 100 at 477 (Ex. 3005, 3). Additionally, the Microsoft Computer Dictionary (5th ed. 2002) defines “gateway” as follows: “A device that connects networks using different communications protocols so that information can be passed from one to the other. A gateway both transfers information and converts it to a form compatible with the protocols used by the receiving network.” Microsoft Comput. Dictionary at 232 (Ex. 3006, 3). The Microsoft Internet & Networking Dictionary (2003) defines “gateway” the same way as the Microsoft Computer Dictionary. Microsoft Inter. & Networking Dictionary at 98 (Ex. 3007, 3).

Consistent with those definitions of “gateway,” Patent Owner contends and Dr. Rouskas testifies that a “gateway connects distinct networks.” Resp. 22; Ex. 2005 ¶ 73. Inconsistent with those definitions of “gateway,” however, the ’038 patent’s specification describes a “portal” as performing other functions. *See, e.g.*, Ex. 1001, 4:48–50, 5:5–6, 5:10–12, 5:29–30, 5:64–6:9, 6:33–55.

As an example, the specification explains that “a portal provides a number of intelligent communication modes (ICM) for the user to select” and “the portal can be used to control the selection and setting of different intelligent communication modes for the user.” *Id.* at 4:48–50, 6:4–6, Fig. 1. As another example, the specification explains that “a portal also holds the

user’s electronic calendar.” *Id.* at 5:64–65. As yet another example, the specification explains that “the portal can dynamically change the access priorities of a caller trying to reach the user.” *Id.* at 5:5–6. Patent Owner does not contend that a “gateway” performs these “portal” functions. *See, e.g.,* Resp. 14–28; Sur-reply 6–16.

As noted above, Patent Owner asserts that Dr. Rouskas provides “unrebutted” testimony that the ’038 patent’s specification uses “portal” and “gateway” synonymously because the word “or” sometimes appears between “portal” and “gateway” in the specification. Sur-reply 5–6 (citing Ex. 1043, 90:4–9, 91:10–15); *see supra* § II. Although expert testimony “may be useful,” e.g., to “provide background on the technology at issue” or “explain how an invention works,” expert testimony “is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence.” *Phillips*, 415 F.3d at 1318–19. Here, in the context of the intrinsic evidence, e.g., the specification, Dr. Rouskas’s testimony seeks to contradict the specification’s infrequent use of “or” between “portal” and “gateway” compared to the many places where “portal” and “gateway” appear separately to describe functionality that overlaps but differs in different embodiments. *See* Ex. 1001, 4:20–7:17, code (57); Ex. 1043, 88:5–91:15.

Moreover, Dr. Almeroth’s testimony refutes Dr. Rouskas’s testimony. *See* Ex. 1003 ¶¶ 34, 41, 82–91, 116, 242, 398. Specifically, Dr. Almeroth testifies that he considered the ’038 patent’s claims, specification, and prosecution history. *Id.* ¶¶ 34, 82–91. He understands that “claims in an IPR are given their plain and ordinary meaning as understood by a person of ordinary skill in the art in view of the specification and prosecution history,

unless those sources show an intent to depart from such meaning.” *Id.* ¶ 41. He also testifies that a person of ordinary skill in the art would have understood that a “network-based portal” encompasses “a user interface . . . connecting clients devices to a network.” *Id.* ¶ 398; *see id.* ¶¶ 116, 242.

Regarding a “gateway” and a “networked server,” the ’038 patent’s specification describes a “gateway computer” as one type of “networked server” when discussing text-to-speech conversion as follows:

While text-to-speech conversion, particularly if high quality is desired, requires substantial processing capabilities, mobile electronic devices, such as mobile communication devices, given their small form factor and price competition, tend to have limited processing capability. Accordingly, in one embodiment, text-to-speech conversion can be off-loaded from the mobile device. For example, a remote server computer can be provided the text message and produce the resulting audio message, and then supply the audio message to the mobile device. The remote server computer can be a networked server coupled to the network 108. One example of a networked server is a gateway computer for a wireless electronic device, such as a mobile telephone.

Ex. 1001, 16:5–19. Hence, contrary to Patent Owner’s contention, the specification does not define “gateway” to mean “networked server” or use “gateway” and “networked server” as synonyms. *See* Resp. 17.

The ’038 patent’s specification also explains that “[t]he portal allows worldwide access to the user.” Ex. 1001, 4:52–53. As discussed above, Patent Owner asserts that a “portal” or “network-based portal” must allow “worldwide access” to a user. Resp. 18–19 (quoting Ex. 1001, 4:52–53); Sur-reply 9; *supra* § II. With that assertion, however, Patent Owner wrongly seeks to read a limitation from the specification into the claims. *See* Resp. 18–19; Sur-reply 9; *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

In any event, a user interface in a client device that connects the client device to a network such as the Internet allows “worldwide access” to a user. *See* Ex. 1043, 110:20–24, 114:2–5.

As for the undated or 2022 definitions of “portal” that the parties cite, no party provides evidence that any of those definitions applied at the time of the invention. *See* Resp. 16–17; Reply 10; Ex. 1041, 1–5; Ex. 1042, 1–5; Ex. 2005 ¶ 64. The issue here involves determining the meaning of “network-based portal” to “a person of ordinary skill in the art at the time of the invention.” *See Power Integrations*, 904 F.3d at 971. Hence, the definitions of “portal” that the parties cite provide little, if any, help in resolving that issue.

As for the ’038 patent’s prosecution history, neither party cites the prosecution history when addressing the meaning of “network-based portal.” *See* Pet. 38–39; Resp. 14–28; Reply 9–16; Sur-reply 6–16. I have reviewed the prosecution history and consider it unhelpful in determining the meaning of “network-based portal.”

During prosecution, the Examiner did not reject any claim based on any prior art. *See, e.g.*, Ex. 1002, 99–107, 164–71, 242–50, 278–81, 337–44, 424–27, 517–27, 682–90. In an Examiner-initiated interview early during prosecution, the Examiner discussed an obviousness-type double-patenting rejection based on a related application and a related patent. *Id.* at 106. In response, the applicant “agreed to submit a terminal disclaimer to obviate the rejection.” *Id.* After the applicant submitted a terminal disclaimer, the Examiner allowed the claims based on the terminal disclaimer and the “history of rejection” of ancestor applications and patents. *Id.* at 96, 104, 169, 247, 280, 342, 426, 525, 688.

After analyzing the intrinsic evidence and the extrinsic evidence, and for the reasons discussed above, I agree with Petitioner that a “network-based portal” encompasses “a user interface that connects clients to a network.”

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