

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EPIC GAMES, INC.,  
Petitioner,

v.

INGENIOSHARE, LLC,  
Patent Owner.

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Case IPR2022-00297  
Patent 8,744,407 B2

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

CHANG, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314

## I. INTRODUCTION

Epic Games, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 2, 5, 7, 53, 54, 56, 57, and 59 (“the challenged claims”) of U.S. Patent No. 8,744,407 B2 (Ex. 1001, “the ’407 patent”). Paper 1 (“Pet.”). IngenioShare, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons stated below, we determine that Petitioner has not established a reasonable likelihood that it would prevail with respect to any of the challenged claims. We hereby decline to institute an *inter partes* review in this proceeding.

### A. Related Matters

The parties indicate that the ’407 patent also is involved in *IngenioShare, LLC v. Epic Games, Inc.*, No 6:21-cv-00663-ADA (W.D. Tex.). Pet. 2; Paper 5, 2.

### B. The ’407 Patent

The ’407 patent discloses a computer-implemented system and method to manage the communication of a user. Ex. 1001, code (57). The ’407 patent describes one approach to maintain confidentiality of the user’s location and status while maintaining real-time communication. Ex. 1001, 4:38–40. In particular, the ’407 patent discloses a system that digitally identifies the identities of the caller (or the person requesting to

communicate with the user or trying to send a message to the user) and the receiver or user. *Id.* at 4:38–44. After determining the identities, the system can establish connections between the caller and the user in real time. *Id.* at 4:46–47. However, the system does not have to disclose the phone numbers, electronic addresses, physical locations and/or other attributes of the caller and the user to each other. *Id.* at 4:50–52.

### *C. Illustrative Claims*

Of the challenged claims, claims 1 and 53 are independent. Claims 2, 5, and 7 depend from claim 1. Claims 54, 56, 57, and 59 depend from claim 53. Claims 1 and 53 are reproduced below (with the corrections to claim 53 set forth in the Certificate of Correction (Ex. 1001, 15–16)):

1. [1.0] A non-transitory computer-implemented method to manage the communication of a user via a server based on a communication protocol, in view of *a person, using a first device, trying to electronically convey a message from the first device to a second device of the user*, the method comprising:

[1.1] *receiving, by the server, the message from the person using the first device;*

[1.2] identifying, by the server, the person attempting to electronically convey the message; and

[1.3] setting, by the server, a process for the message using one or more rules based on at least a status associated with the user and an access priority associated with the person, the access priority depending on the person,

[1.4] wherein the server is configured to have access to contact information of the person,

[1.5] wherein even if the process includes transmitting the message to the second device via contact information of the user, the server does not provide the contact information of the user to

the first device to inhibit the person from sending messages to the user without via the server, and

[1.6] wherein the access priority associated with the person is configured to be set by the server depending at least in part on the user reacting by accepting or not accepting a prior message from the person.

Ex. 1001, 6:60–7:17 (emphases and bracketed matters added, using the same element numbering as in Petitioner’s claim listing (Ex. 1028)).

53. [53.0] A server based on a communication protocol for managing the communication of a user, in view of *a person, using a first device, trying to electronically convey a message from the first device to a second device of the user*, the second device being a handheld communication device, the server comprising:

[53.1] at least one computing device; and

[53.2] at least one storage device,

[53.3] wherein the at least one *computing device is configured to receive the message from the person using the first device*;

[53.4] identify the person attempting to electronically convey the message; and

[53.5] set a process for the message using one or more rules based on at least a status associated with the user and an access priority associated with the person, the status depending at least in part on the current activity or location of the user, or the current time, and the access priority depending on the person,

[53.6] wherein the server is configured to have access to contact information of the person,

[53.7] wherein even if the process includes transmitting the message to the second device via contact information of the user, the server does not provide the contact information of the user to the first device to inhibit the person from sending messages to the user without via the server,

[53.8] wherein the server is configured to be aware of the availability of the user, and

[53.9] wherein the server is configured to send information to the person regarding the availability of the user.

*Id.* at 12:25–54, 15–16 (emphases and bracketed matters added, using the same element numbering as in Petitioner’s claim listing (Ex. 1028)).

#### *D. Prior Art Relied Upon*

Petitioner relies upon the references listed below. Pet. 4.

| Name     | Reference                            | Date          | Exhibit No. |
|----------|--------------------------------------|---------------|-------------|
| Furlong  | U.S. Patent Pub. No. 2003/0028621 A1 | Feb. 6, 2003  | 1007        |
| Diacakis | U.S. Patent Pub. No. 2002/0116461 A1 | Aug. 22, 2002 | 1008        |

#### *E. Asserted Grounds of Unpatentability*

Petitioner asserts the following grounds of unpatentability (Pet. 5)<sup>1</sup>:

| Claims Challenged              | 35 U.S.C. § | References |
|--------------------------------|-------------|------------|
| 53, 54, 56, 59                 | 103(a)      | Furlong    |
| 1, 2, 5, 7, 53, 54, 56, 58, 59 | 103(a)      | Diacakis   |

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<sup>1</sup> Because the claims at issue have a filing date prior to March 16, 2013, the effective date of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), we apply the pre-AIA version of 35 U.S.C. § 103 in this Decision.

## II. ANALYSIS

### *A. Claim Construction*

In an *inter partes* review, we construe a patent claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b).” 37 C.F.R. § 42.100(b) (2021). Under this standard, the words of a claim generally are given their “ordinary and customary meaning,” which is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc).

In light of parties’ arguments and supporting evidence in this record, we find that it is necessary to address only the claim construction issues identified below. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we 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))).

### *Preambles of Claims 1 and 53*

In its Petition, Petitioner does not explain whether the preambles of claims 1 and 53 are limiting or not, but rather asserts that the prior art references disclose the subject matter recited in the preambles of these claims. Pet. 23–24, 32–34, 47–50, 65–68. Petitioner also does not address the antecedent basis of the first reference to the term “message” in the body of claim 1 that appears in the limitation, “receiving, by the server, *the*

*message from the person using the first device*” (Element 1.1), or the antecedent basis of the first reference to the term “message” in the body of claim 53 that appears in the limitation, “the server comprising: at least one computing device . . . wherein the at least one computing device is configured to *receive the message from the person using the first device*” (Element 53.3). *Id.*

In its Preliminary Response, Patent Owner implies that the phrase “a message from the first device to a second device of the user” recited in each preamble is limiting because the “message” recited in each of claims 1 and 53 refers back to the preamble for antecedent basis. Prelim. Resp. 1–2, 10.

“In general, a preamble limits the invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002) (quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). “Conversely, a preamble is not limiting ‘where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.’” *Id.* (quoting *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997)). “No litmus test defines when a preamble limits claim scope,” *id.* (citing *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989)), but “dependence on a particular disputed preamble phrase for antecedent basis may limit claim scope because it indicates a reliance on both the preamble and claim body to define the claimed invention.” *Id.* (citing *Bell Commc’ns Research, Inc. v. Vitalink Commc’ns Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995)); *see also Shoes by Firebug LLC v.*

*Stride Rite Children's Grp., LLC*, 962 F.3d 1362, 1368 (Fed. Cir. 2020) (holding that the “use of preamble terms to define positive limitations in the body of claims can evince an inventor’s intent that the preamble limit the scope of the claim”).

Here, the preamble of claim 1 recites “[a] non-transitory computer-implemented method to manage the communication of a user via a server based on a communication protocol, in view of *a person, using a first device, trying to electronically convey a message from the first device to a second device of the user.*” Ex. 1001, 6:60–65 (emphasis added). The preamble of claim 53 recites “[a] server based on a communication protocol for managing the communication of a user, in view of *a person, using a first device, trying to electronically convey a message from the first device to a second device of the user.*” *Id.* at 12:25–30 (emphasis added)

Each of these claims does not reintroduce the term “message” in the body of the claim but instead relies on the instance of “message” introduced in the preamble for antecedent basis. Notably, the first reference to “message” in the body of claim 1 (Element 1.1) appears in a limitation (“receiving, by the server, the message from the person using the first device”), describing a positive step in the claimed “method.” Similarly, the first reference to “message” in the body of claim 53 (Element 53.3) appears in a limitation (“wherein the at least one computing device [of the server] is configured to receive the message from the person using the first device”), describing a structural feature (“computing device”) of the claimed “server.” As Patent Owner notes, the “message” recited in each of Elements 1.1 and 53.3 refers back to the phrase “a person, using a first device, trying to

electronically convey a message from the first device to a second device” recited in the preambles. Prelim. Resp. 1–2, 10.

Because claims 1 and 53 require the server (or the computing device in the server) to “receive the message from the person using the first device,” the phrase “a person, using a first device, trying to electronically convey a message from the first device to a second device of the user” in the preambles of these claims is essential to understanding the limitations in these claims, not merely reciting an intended purpose of the claimed invention. This “indicates a reliance on both the preamble and claim body to define the claimed invention.” *Catalina*, 289 F.3d at 808; *Bell Commc’ns Research*, 55 F.3d at 620; *Shoes by Firebug*, 962 F.3d at 1368. Therefore, the phrase “a person, using a first device, trying to electronically convey a message from the first device to a second device of the user” in each of the preambles of claims 1 and 53 is limiting.

As discussed above, the “message” recited in each of Elements 1.1 and 53.3 refers back to the preamble for antecedent basis, specifically to the phrase “a person, using a first device, trying to electronically convey a message from the first device to a second device of the user.” Therefore, Elements 1.1 and 53.3 require that the “message” received by the server (or the computing device in the server) from the person using the first device is the message the person trying to electronically convey to the user’s device.

### *B. Principles of Law*

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that

the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness.<sup>2</sup> *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

### *C. Level of Ordinary Skill in the Art*

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). Here, Petitioner asserts that a person of ordinary skill in the art of the ’407 patent would have had “a Bachelor’s degree in Computer Science, or equivalent field and three to five years of experience working with Internet communication systems.” Pet. 23 (citing Ex. 1003 ¶¶ 67–72). At this juncture, Patent Owner does not proffer any assessment regarding the knowledge of an ordinarily skilled artisan.

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<sup>2</sup> At this time, the parties do not address objective indicia of nonobviousness, which accordingly do not form part of our analysis. See Pet. 75 (“Petitioner is unaware of any evidence of secondary considerations that would support a finding of non-obviousness.”).

For purposes of this Decision, we adopt the level of ordinary skill as articulated by Petitioner because, based on the current record, this proposal appears to be consistent with the '407 patent, prior art of record, and supported by the testimony of Dr. Kevin Almeroth.

#### *D. Obviousness over Furlong*

Petitioner asserts that claims 53, 54, 56, and 59 are unpatentable under 35 U.S.C. § 103(a) as obvious over Furlong, citing Dr. Almeroth's testimony for support. Pet. 39–47 (citing Ex. 1003). For the reasons provided below, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing on its assertion that claims 53, 54, 56, and 59 are unpatentable.

##### 1. Furlong (Ex. 1007)

Furlong discloses a system and method for managing subscriber presence, location, and availability ("PLA") information. Ex. 1007, code (57). Figure 1 of Furlong is reproduced below.

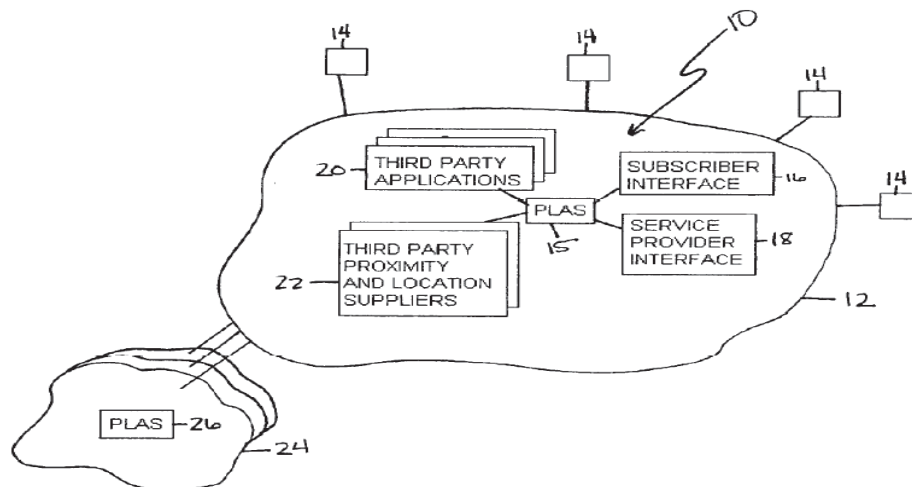


Figure 1 of Furlong above shows PLA system 10 on communication network 12. *Id.* ¶ 19. Network 12 includes subscriber devices 14. *Id.*

PLA system 10 includes subscriber interface 16, service provide interface 18, third-party applications 20, and third-party proximity and location suppliers 22. *Id.* ¶ 20. PLA system 10 is created around presence, location and availability server (“PLAS”) 15. *Id.* PLAS 15 keeps track of subscribers’ presence and availability in the network and processes third-party requests for information. PLAS 15 includes database 30 and preference engine 34, which serves as the central processor for PLAS 15. *Id.* ¶¶ 23–24. Other communication networks 24 may interface with network 12 and include PLA system 26 similar to PLA system 10. *Id.* ¶ 20.

## 2. Discussion

Claim 53 recites:

[53.0] A server based on a communication protocol for managing the communication of a user, in view of *a person, using a first device, trying to electronically convey a message from the first device to a second device of the user*, the second device being a handheld communication device, the server comprising:

[53.1] at least one computing device; and

[53.2] at least one storage device,

[53.3] wherein the at least *one computing device is configured to receive the message from the person using the first device*.

*Id.* at 12:25–35 (emphases and bracketed matters added).

For Element 53.0 (the preamble of claim 53), Petitioner avers that Furlong discloses a PLA system that features a PLAS for managing a subscriber’s location, presence and subscriber-designated availability options across potentially disparate networks with potentially disparate devices. Pet. 32–33 (citing Ex. 1007 ¶¶ 7, 8, 20, 92).

For Elements 53.1 and 53.2, Petitioner asserts that Furlong discloses a computing device because Furlong teaches preference engine 34, a computing device that “serves as the central processor” for PLAS 15 (server). *Id.* at 33–34 (citing Ex. 1007 ¶¶ 24, 30, 81–82, 92–96, Fig. 2; Ex. 1003 ¶ 86). Petitioner also argues that Furlong’s PLAS comprises database 30 (a storage device). *Id.* at 34 (citing Ex. 1007 ¶¶ 8, 23–27, 30, 57, 86–89, 92–94, Figs. 2–3; Ex. 1003 ¶ 87).

For Element 53.3, Petitioner argues that Furlong discloses wherein the computing device (preference engine 34) is configured to receive the message from a first device. *Id.* at 34–36 (citing Ex. 1007 ¶¶ 30, 59, 82, 84, 92–96, Fig. 5; Ex. 1003 ¶¶ 88–90). According to Petitioner, Furlong teaches that PLAS 15 (server) “provides value and utility to subscribers through applications which will typically be provided by third parties.” *Id.* at 34 (citing Ex. 1007 ¶ 59). Petitioner explains that Furlong also teaches that, for a third-party application (person) to send a message to a subscriber (user), the person “first establishes an authenticated session with the PLAS 15 (step 500) and sends a request to the PLAS 15 (step 502),” as shown in Figure 5 of Furlong. *Id.* at 34–35 (citing Ex. 1007 ¶¶ 59, 94, Fig. 5). Petitioner notes that Furlong teaches that if “the subscriber is both present and available, the PLAS 15 notifies the requesting application of the subscriber’s availability (step 512) and *the application sends the message to the subscriber* (step 514).” *Id.* (citing Ex. 1007 ¶ 94, Fig. 5) (emphasis added).

In addition, Petitioner argues that Furlong’s preference engine 34, which is part of the server, similarly facilitates the communication between the service provider and the subscriber. *Id.* at 36 (citing Ex. 1007 ¶¶ 24

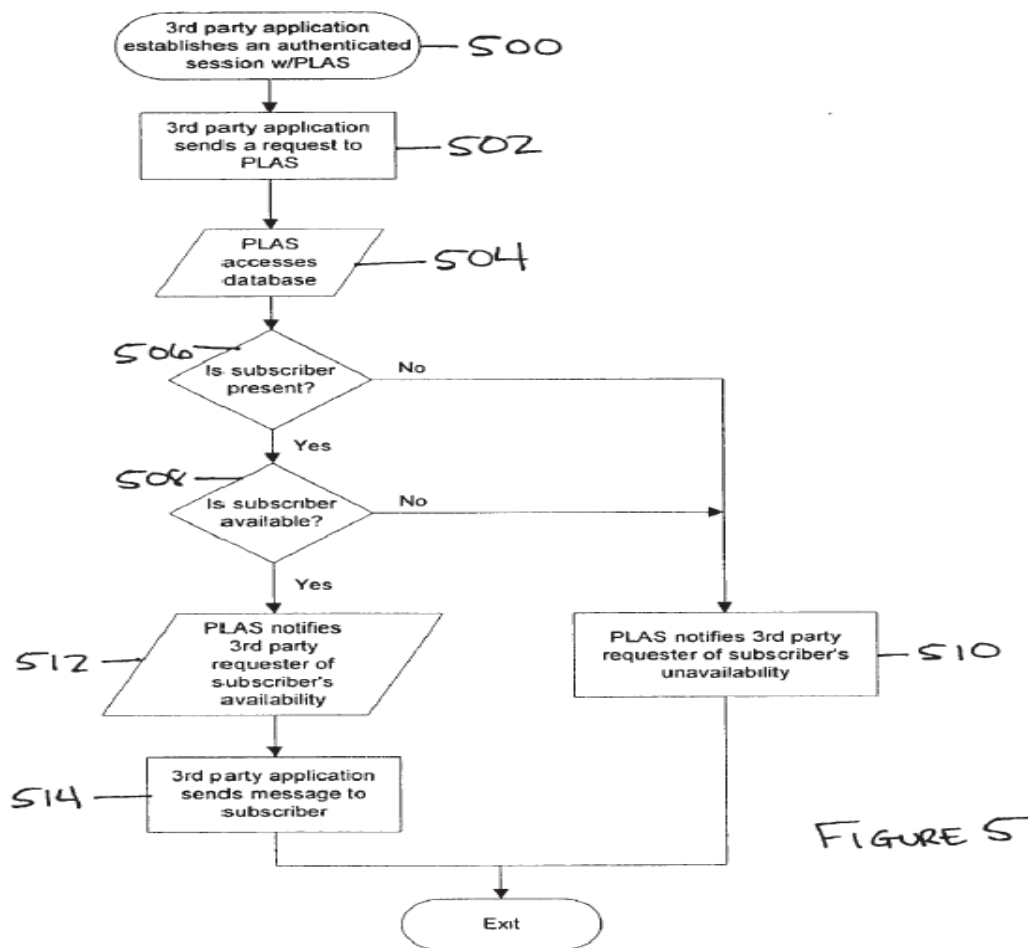
(“A preference engine 34 . . . facilitates processing of preference rules established by the service provider and the subscriber . . . to control access to the proximity, location and availability criteria of each subscriber.”), 30, 83, 84, 92–96; Ex. 1003 ¶¶ 88–90).

Patent Owner counters that Petitioner fails to show that Furlong teaches or suggests Element 53.3 because Furlong’s server does not receive “a message from a first user’s device intended for a second device.” Prelim. Resp. 1–4. We agree with Patent Owner.

As discussed above in Section II.A, the “message” recited in Element 53.3 refers back to the preamble for antecedent basis, specifically to the phrase “a person, using a first device, trying to electronically convey a message from the first device to a second device of the user.” Thus, Element 53.3 requires that the “message” received by the computing device in the server is the message the person is “trying to electronically convey” to the user’s device.

We are not persuaded by Petitioner’s arguments or Dr. Almeroth’s testimony. Pet. 32–36; Ex. 1003 ¶¶ 85–90. Petitioner fails to show a server receiving a “message” the person is trying to convey to the user’s device in Furlong. Petitioner’s and Dr. Almeroth’s reliance on the embodiment shown in Figure 5 of Furlong is misplaced.

Figure 5 of Furlong is reproduced below.



As shown in Figure 5 above, if a third-party application wants to send a message to a subscriber, it first establishes an authenticated session with PLAS 15 (step 500) and sends a request to PLAS 15 (step 502). Ex. 1007 ¶ 94. Preference engine 34 accesses the appropriate tables in database 30 (step 504) to determine if the subscriber is present (step 506) and available (step 508). *Id.* “If . . . the subscriber is both present and available, the PLAS 15 notifies the requesting application of the subscriber’s availability (step 512) and *the application sends the message to the subscriber* (step 514).” *Id.*

Notably, neither the authenticated session with PLAS 15, nor the request from the third-party application (steps 500 and 502), is the “message” the person is trying to convey to the device of the user, as required by Element 53.3. Significantly, Furlong discloses that, after PLAS 15 notifies the third-party application of the subscriber’s availability (step 512), “*the application sends the message to the subscriber* (step 514)” directly, not via the server, PLAS 15. Ex. 1007 ¶ 94 (emphasis added), Fig. 5. Thus, PLAS 15 in Furlong does not receive the message the third-party application (person) is trying to convey to the device of the subscriber (user).

Moreover, the examples related to this embodiment also do not teach or suggest that the server in Furlong receives the message the third-party application or person is trying to convey to the device of the subscriber (user). *Id.* ¶¶ 92–98. Notably, in those examples, Furlong discloses that the subscriber (e.g., John) receives the message from the third-party application or person (e.g., the traffic agency, the Mall Coupon application, the “Buddy Near” proximity service, John’s co-worker, or John’s wife) directly, not via the server, PLAS 15. *Id.* ¶ 93 (“If the conditions are met, the PLAS 15 notifies the third party event application (step 416) which takes the appropriate action (such as sending the subscriber coupons or advising the subscriber of traffic conditions in the area) (step 418).”), ¶ 95 (John on his way to work “receives an alert about an accident from the traffic agency (a third party application provider) over his WAP phone and changes his route to avoid the congestion.”), ¶ 96 (“At work, . . . he receives an instant message from a co-worker,” and “his wife . . . sends an instant message” and

“the message is delivered to John’s WAP phone.”), ¶ 98 (At the mall, “[t]he Mall Coupon service . . . sends him an electronic coupon,” and “the ‘Buddy Near’ proximity service . . . sends a message to John’s WAP phone informing him that Bob is nearby.”).

Therefore, the embodiment shown in Figure 5 of Furlong and the related examples do not support Petitioner’s arguments or Dr. Almeroth’s testimony that “Furlong renders at least obvious wherein at least one computer device (i.e. preference engine 34) is configured to receive the message from the first device (which is used by the ‘person’).” Pet. 34–36; Ex. 1003 ¶¶ 88–90.

In addition, we are not persuaded by Dr. Almeroth’s testimony that “the PLAS . . . conveys the message to the subscriber,” and that a person of ordinary skill in the art would have understood that, “in order to convey the message to the subscriber, the server would have a computing device (preference engine 34) that receives the initial message.” Ex. 1003 ¶ 89 (citing Ex. 1007 ¶¶ 24, 30, 82, 84, 92–96, Fig. 5). Preference engine 34, as described by Furlong, merely “facilitates processing preference rules established by the service provider and the subscriber . . . to control access to the proximity, location and availability criteria of each subscriber.” Ex. 1007 ¶¶ 24, 30. Furlong does not teach or suggest that preference engine 34 receives the message the third-party application (person) is trying to convey to the device of the subscriber (user), as required by Element 53.3. Moreover, in the examples relied upon by Dr. Almeroth, Furlong describes that, when the IM application queries PLAS 15 for the subscriber’s availability of instant messaging, preference engine 34 determines that the

subscriber is available via his WAP phone, and then “[t]he subscriber’s WAP phone address is provided to the IM application and *the IM application forwards the instant message to the subscriber*” directly, not via preference engine 34. *Id.* ¶¶ 82, 84 (emphasis added). Furlong does not teach that the instant message was received by preference engine 34. *Id.*

The embodiment shown in Figure 5 of Furlong and the related examples also do not support Dr. Almeroth’s testimony because Furlong describes that “the third party event application (step 416) . . . takes the appropriate action (such as sending the subscriber coupons or advising the subscriber of traffic conditions in the area) (step 418)” and “the application sends the message to the subscriber (step 514).” *Id.* ¶¶ 92–98, Figs. 4–5. As such, we do not find that either Furlong’s preference engine or PLAS receives the message the person is trying to convey to the user, as required by Element 53.3. Hence, Furlong does not support Dr. Almeroth’s testimony that “the PLAS . . . conveys the message to the subscriber,” and that a person of ordinary skill in the art would have understood that, “in order to convey the message to the subscriber, the server would have a computing device (preference engine 34) that receives the initial message.” Ex. 1003 ¶ 89.

Furthermore, we are not persuaded by Dr. Almeroth’s testimony that a person of ordinary skill in the art “would have understood that Furlong anticipates that the ‘third party application’ may also be provided by the PLAS provider.” Ex. 1003 ¶ 90 (citing Ex. 1007 ¶¶ 10–11, 59). The cited portions of Furlong do not support Dr. Almeroth’s testimony. Ex. 1007

¶¶ 10–11, 59. Notably, those portions of Furlong do not disclose any third-party application provided by the PLAS provider. *Id.*

Even if the PLAS provider provided a third-party application as Dr. Almeroth suggests, Dr. Almeroth fails to explain how such a proposed implementation would have taught “wherein the at least one *computing device* is configured to receive the message from the person using *the first device*,” as required by Element 53.3.

Dr. Almeroth also improperly conflates the server with the *provider*. Neither Petitioner nor Dr. Almeroth explains why a relevant artisan would have implemented a third-party application in preference engine 34, instead of a separate engine or server. Furlong’s preference engine 34 merely facilitates processing preference rules established by the service provider and the subscriber to control access to the proximity, location, and availability criteria of each subscriber. Ex. 1007 ¶ 24.

Moreover, even if the proposed third-party application were implemented in Furlong’s preference engine 34, neither Petitioner nor Dr. Almeroth explains how a single engine accounts for both the “computing device” and “the first device” used by the person. Element 53.3 specifies that the “*computing device* is configured to receive the message from the person using the *first device*,” which indicates that the “computing device” is separate from the “first device” and the receiving step is performed by a device other than the “first device.” *See Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1299 (Fed. Cir. 2015) (“Not only are the ‘two other computers’ recited independently from, and in addition to, the gateway and caching computer, the word ‘other’ denotes a further level of distinction.”);

*see also NTP, Inc. v. Research in Motion, Ltd.*, 419 F.3d 1282, 1300 (Fed. Cir. 2005) (holding that the “originating processor” and “gateway switch” are separate components because, *inter alia*, the claim language shows that information “is *transmitted from* an ‘originating processor’ to a gateway switch), *abrogated on other grounds by IRIS Corp. v. Japan Airlines Corp.*, 769 F.3d 1359, 1361 n.1 (Fed. Cir. 2014).

The Specification of the ’407 patent confirms that the “computing device” and the “first device” used by the “person” are separate components. In particular, the ’407 patent discloses a system that digitally identifies the identities of the person (the caller) requesting to communicate with the user (the receiver). Ex. 1001, 4:38–44. After determining the identities, the system can establish connections between the person and the user in real time. *Id.* at 4:46–47. However, the system does not have to disclose the phone numbers, electronic addresses, physical locations and/or other attributes of the person and the user to each other. *Id.* at 4:50–52.

Accordingly, we are not persuaded by Dr. Almeroth’s testimony that a person of ordinary skill in the art “would have understood that Furlong anticipates that the ‘third party application’ may also be provided by the PLAS provider.” Ex. 1003 ¶ 90.

For the foregoing reasons, we find that Petitioner fails to show that Furlong teaches or suggests Element 53.3. By virtue of their dependency, claims 54, 56, and 59 also require the limitation set forth in Element 53.3. Accordingly, we determine that Petitioner fails to demonstrate a reasonable likelihood of prevailing on its assertion that claims 53, 54, 56, and 59 are unpatentable under § 103(a) as obvious over Furlong.

### 3. *Obviousness over Diacakis*

Petitioner asserts that claims 1, 2, 5, 7, 53, 54, 56, 58, and 59 are unpatentable under 35 U.S.C. § 103(a) as obvious over Diacakis, citing Dr. Almeroth's testimony for support. Pet. 47–75 (citing Ex. 1003). For the reasons provided below, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing on its assertion that claims 1, 2, 5, 7, 53, 54, 56, 58, and 59 are unpatentable.

#### 1. Diacakis (Ex. 1008)

Diacakis discloses a presence and availability management server and a method for communicating communication network availability information regarding an individual to subscribers. Ex. 1008, code (57). Figure 1 of Diacakis is reproduced below.

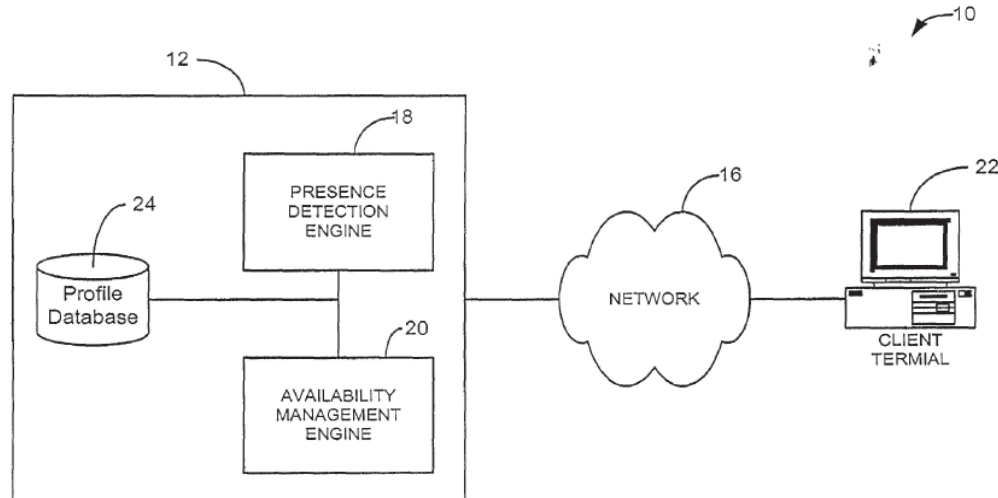


Figure 1 of Diacakis above shows a block diagram of presence and availability (“P&A”) management system 10. *Id.* ¶ 24. System 10 includes P&A management server 12 in communication with client terminal 22 via network 16. *Id.* P&A management server 12 includes presence detection

engine 18, availability management engine 20, and profile database 24. *Id.* P&A management server 12 may transmit the availability information to the subscriber at client terminal 22.

## 2. Discussion

Claim 1 recites:

[1.0] A non-transitory computer-implemented method to manage the communication of a user via a server based on a communication protocol, in view of *a person, using a first device, trying to electronically convey a message from the first device to a second device of the user*, the method comprising:

[1.1] *receiving, by the server, the message from the person using the first device.*

Ex. 1001, 6:60–67 (emphases and bracketed matters added).

Claim 53 recites:

[53.0] A server based on a communication protocol for managing the communication of a user, in view of *a person, using a first device, trying to electronically convey a message from the first device to a second device of the user*, the second device being a handheld communication device, the server comprising:

[53.1] at least one computing device; and

[53.2] at least one storage device,

[53.3] wherein the at least *one computing device is configured to receive the message from the person using the first device.*

*Id.* at 12:25–35 (emphases and bracketed matters added).

For Elements 1.0 and 53.0 (the preambles of claims 1 and 53), Petitioner relies on the presence and availability management server in Diacakis to disclose the claimed “server.” Pet. 47–48, 65–66 (citing Ex. 1008 ¶¶ 3, 5, 9). According to Petitioner, the server in Diacakis

manages communication of one user trying to electronically convey a message to another by “enabl[ing] users to view the availability of their contacts and use that information to determine whether or not and how to initiate communications.” *Id.* at 48 (citing Ex. 1008 ¶ 5). Petitioner contends that Diacakis discloses that a person (subscriber) may wish to communicate with a user (publisher or individual), and that “users can access the presence and availability management service if they are on a cellular phone, a handheld device or a computer workstation.” *Id.* (citing Ex. 1008 ¶¶ 7–8, 29, 31, 60, 62; Ex. 1003 ¶ 114).

For Elements 1.1 and 53.3, Petitioner argues that Diacakis discloses that “icons may indicate *types of data the individual is available to receive*,” and that “indicator module 110 may indicate whether the individual is available to receive, for example, certain data content type.” *Id.* at 49, 69 (citing Ex. 1008 ¶¶ 59, 64, 66 (“For example, with reference to FIG. 8, the indicator for Tom indicates that Tom is not available to receive IM (text) data.”), Fig. 8; Ex. 1003 ¶ 115).

Patent Owner counters that Petitioner fails to show that Diacakis teaches or suggests Elements 1.1 and 53.3 because Diacakis does not disclose a server receiving a message from a first device to a second device. Prelim. Resp. 10–14. Patent Owner also argues that “[n]or does the Petition present any argument that it would have been obvious to a person of ordinary skill in the art to modify Diacakis to provide such a system.” *Id.* at 12. We agree with Patent Owner.

As discussed above in Section II.A, the “message” recited in each of Elements 1.1 and 53.3 refers back to the preamble for antecedent basis,

specifically to the phrase “a person, using a first device, trying to electronically convey a message from the first device to a second device of the user.” Therefore, Elements 1.1 and 53.3 require that the “message” received by the server (or the computing device in the server) is the message the person is “trying to electronically convey” to the user’s device.

We are not persuaded by Petitioner’s arguments or Dr. Almeroth’s testimony. Pet. 47–48, 65–66; Ex. 1003 ¶¶ 114, 115. Petitioner fails to show a server receiving a “message” the person is trying to convey to the user’s device in Diacakis. Petitioner’s and Dr. Almeroth’s reliance on the icons and indicators shown in Figure 8 of Diacakis is misplaced because those icons and indicators merely “indicate whether the individual is available to receive . . . certain data content type.” Pet. 49–50; Ex. 1003 ¶ 115; Ex. 1008 ¶¶ 59, 64, 66, Fig. 8.

Figure 8 of Diacakis is reproduced below.

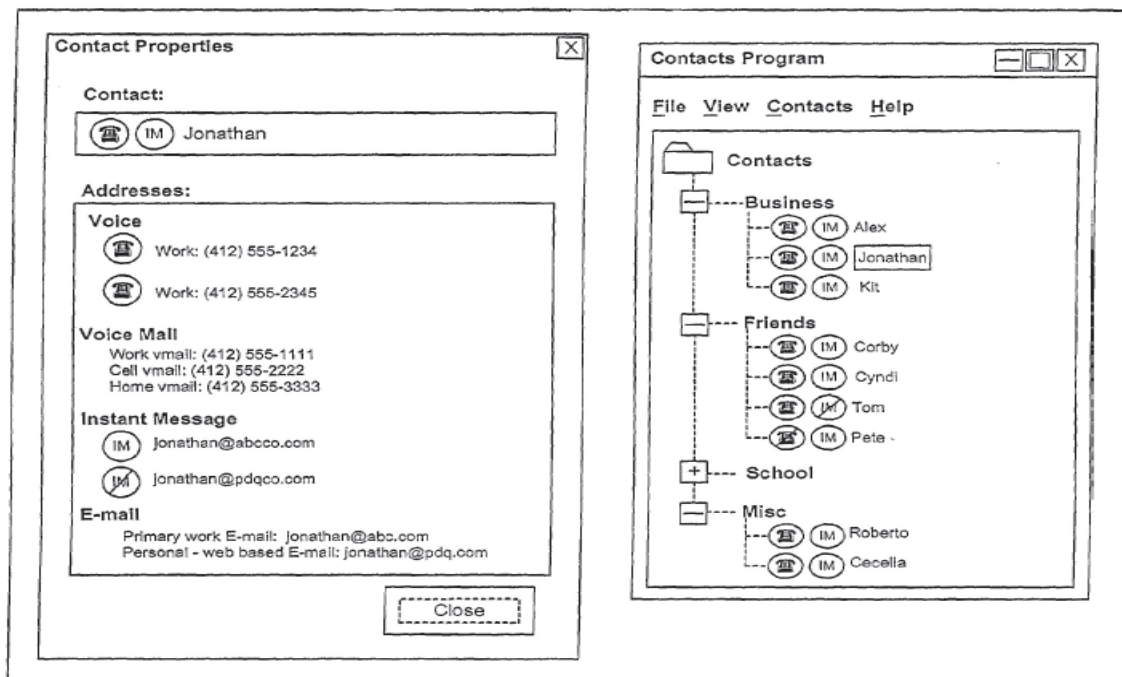


Figure 8 of Diacakis above shows a screen shot of the information that may be displayed to a subscriber (person) at client terminal 22 (person's device). Ex. 1008 ¶ 56. The subscriber may navigate the list of names in the right-hand window, "Contact Program," to access the presence and availability information regarding the highlighted individual, including the individual's phone numbers and addresses, in the left-hand window, "Contact Properties." *Id.* The indicator in the right-hand window adjacent to each listed individual may identify the availability means for the particular individual. *Id.* For example, Alex is available by telephone and instant messaging, but Tom is only available by telephone, and Pete is only available by instant messaging. *Id.* The contact information in the left-hand window may be updated based on availability information transmitted from P&A management server 12. *Id.*

In another example, Diacakis discloses that, if John Doe (user) has three telephone numbers and is currently present and available on only one telephone network, the server may notify a subscriber (person) of John Doe's information that he is present and available for telephone calls regardless of the particular telephone John Doe is currently capable of using. *Id.* ¶ 62. Diacakis teaches that, when a subscriber wishes to contact John Doe via instant messaging, "*server 12 provides the appropriate IM address to the subscriber*" (person). *Id.* (emphasis added). Diacakis also discloses that "[s]ubscribers may instead refer to a single indicator and use that information to initiate point-to-point contact." *Id.* (emphasis added).

Petitioner has not shown sufficiently that the portions of Diacakis relied upon by Petitioner and Dr. Almeroth (Ex. 1008 ¶¶ 3, 5, 7–9, 29, 31,

59–60, 62, 64, 66, Fig. 8) teach or suggest a server receiving the “message” the person is trying to convey to the user’s device. Notably, as discussed above, Diacakis discloses that, when a subscriber (person) wishes to contact an individual (user), “*server 12 provides the appropriate IM address to the subscriber,*” and that “[s]ubscribers may instead refer to a single indicator and use that information to *initiate point-to-point contact.*” *Id.* (emphases added).

In short, based on the evidence of record, Petitioner shows only that the server in Diacakis provides the appropriate address or phone number and the presence and availability information regarding the individual to the subscriber who wishes to contact an individual, not that the server receives the “message” the subscriber is trying to convey to the individual.

For the foregoing reasons, we find that Petitioner fails to show that Diacakis teaches or suggests Elements 1.1 and 53.3. By virtue of their dependency, claims 2, 5, 7, 54, 56, 58, and 59 also require the limitations set forth in Elements 1.1 and 53.3. Accordingly, we determine that Petitioner fails to demonstrate a reasonable likelihood of prevailing on its assertion that claims 1, 2, 5, 7, 53, 54, 56, 58, and 59 are unpatentable under § 103(a) as obvious over Diacakis.

### III. CONCLUSION

For the foregoing reasons, we conclude that the information presented in the Petition and evidence in this record do not establish that there is a reasonable likelihood that Petitioner would prevail in challenging claims 1, 2, 5, 7, 53, 54, 56, 57, and 59 of the ’407 patent.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied*, and no trial is instituted.

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