

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SLACK TECHNOLOGIES, LLC,  
Petitioner,

v.

GINEGAR LLC,  
Patent Owner.

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IPR2022-00542  
Patent 9,760,865 B2

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Before HYUN J. JUNG, MONICA S. ULLAGADDI, and  
MICHAEL T. CYGAN, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Slack Technologies, LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of an *inter partes* review of claims 1–16 of

U.S. Patent No. 9,760,865 B2 (Ex. 1001, “the ’865 patent”). Ginegar LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

Under 35 U.S.C. § 314, an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition in view of the present record and for the reasons explained below, we determine that Petitioner has shown a reasonable likelihood of prevailing with respect to at least one of the challenged claims.

Thus, we institute an *inter partes* review of claims 1–16 of the ’865 patent on the only presented challenge.

*B. Real Parties in Interest*

Petitioner identifies itself, “a wholly owned subsidiary of Salesforce.com, Inc.,” as a real party in interest. Pet. 61. Petitioner also states that “[n]o unnamed entity is funding, controlling, or directing this Petition, or otherwise has had an opportunity to control or direct this Petition or Petitioner’s participation in any resulting IPR.” *Id.*

Patent Owner identifies itself as a real party in interest and indicates that its parent is KMizra, LLC. Paper 4, 2. Patent Owner indicates that no publicly held corporation owns 10% or more of the stock of KMizra, LLC or Ginegar, LLC. *Id.*

*C. Related Matters*

Petitioner identifies *Ginegar LLC v. Slack Technologies, Inc.*, 1:21-cv-00494-RMR-STV (D. Col.) as a related matter that has been transferred and is now identified as 3:22-cv-00044-WHO (N.D. Cal.). Pet. 61. Petitioner also indicates that another petition has been filed for a related patent. *Id.* at 62. A petition for U.S. Patent No. 9,367,521 B2 owned by Patent Owner was filed in IPR2021-00541.

Patent Owner identifies the Northern District of California litigation as a related matter. Paper 4, 2.

*D. The '865 Patent (Ex. 1001)*

The '865 patent issued on September 12, 2017 from an application filed on August 16, 2007. Ex. 1001, codes (22), (45). The '865 patent relates “particularly to instant messaging in a collaborative computing environment.” *Id.* at 1:7–9.

The '865 patent describes that “synchronous messaging technologies include several, real-time human-to-human collaborative environments such as instant messaging,” but that “existing instant messaging systems have several deficiencies with regard to automatically logging a chat transcript that contains multi-modal communication, such as text and voice in one conversation.” Ex. 1001, 1:23–25, 1:40–43. According to the '865 patent, “the chat transcript excludes any audio portion of the chat session,” and “the audio portion of the chat session is stored separately from the chat transcript in an audio file.” *Id.* at 1:53–56.

The '865 patent “provide[s] a method, system and computer program product for generating a unified chat transcript for a multi-modal conversation in an instant messaging session.” Ex. 1001, 3:14–17. Figure 1 of the '865 patent is reproduced below.

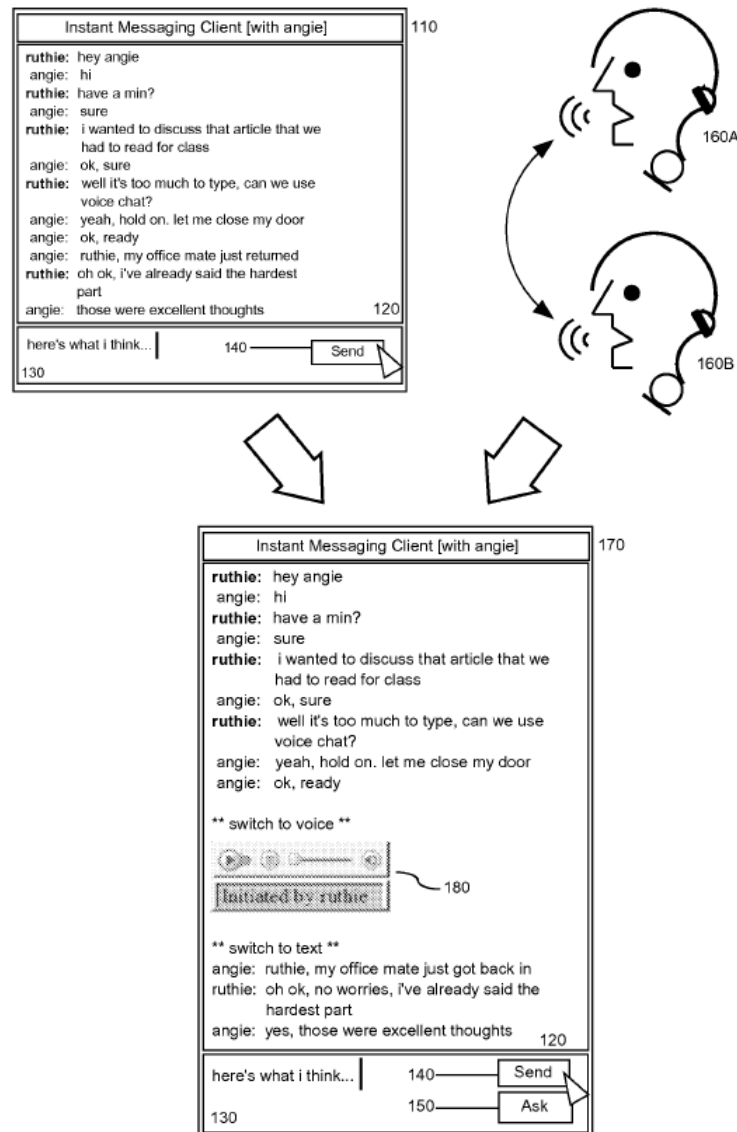


FIG. 1

Figure 1 “is a pictorial illustration of an instant messenger configured for multi-modal transcript unification.” Ex. 1001, 2:66–67. In “a process for generating a unified transcript for a multi-modal conversation,” “an instant messaging session can be initialized between at [least] two conversants,” and then “a voice messaging session can be activated.” *Id.* at 4:30–35, Fig. 4. “Since an instant message can contain multi-modal messages such as text messages or voice messages, each message entry can be classified.” *Id.* at 4:37–39. “[I]f the message is a voice message then the

voice message can be logged in chronological order along with text messages that have occurred between the two conversants.” *Id.* at 4:39–42, Fig. 4. “The voice messages and text messages can be logged into a single chat transcript, and additionally can be stored as a single chat transcript log file for future reference.” *Id.* at 4:42–45.

*E. Illustrative Claim*

The ’865 patent includes claims 1–16, all of which Petitioner challenges. Claims 1, 8, and 10 are independent, and claim 1 is reproduced below.

1. A method for generating a unified chat transcript for a multi-modal conversation in an instant messaging session, the method comprising:
  - establishing a single instant messaging session between two conversants;
  - receiving text messages as part of a conversation between the two conversants, through the single instant messaging session;
  - embedding in the instant messaging session a voice message received from one of the two conversants;
  - classifying each one of the embedded voice message and the received text messages by type, the type of message being one of a voice message and a text message;
  - determining if the one of the voice and text messages is classified as a voice message; and,
  - logging the classified voice and text messages in a single transcript of conversation between the two conversants occurring in the single instant messaging session in response to determining that the one of the received voice and text messages is classified as a voice message.

Ex. 1001, 5:24–44.

Independent claim 8 recites a “collaborative computing data processing system” that includes a processor, an instant messenger, and logic executed on the processor to perform operations similar to the steps of

claim 1. Ex. 1001, 5:65–6:25. Independent claim 10 recites a “computer program product comprising a computer usable storage medium” that has “computer usable program code . . . for generating a unified transcript for a multi-modal conversation,” and when the program code is executed, it causes a computer hardware device to perform operations corresponding to the steps of claim 1. *Id.* at 6:29–55.

*F. Asserted Prior Art and Proffered Testimonial Evidence*

Petitioner identifies the following references as prior art in the asserted ground of unpatentability:

| Name    | Reference                                   | Exhibit |
|---------|---------------------------------------------|---------|
| Griffin | US 2004/0015547 A1, published Jan. 22, 2004 | 1005    |
| Selbie  | US 2007/0036292 A1, published Feb. 15, 2007 | 1004    |

Pet. 2–3. Petitioner contends that Griffin is prior art under § 102(b) and that Selbie is prior art under § 102(e).<sup>1</sup> *Id.* at 12–14. Petitioner also provides a Declaration of Arthur T. Brody, Ph.D. Ex. 1003.

*G. Asserted Ground*

Petitioner asserts that claims 1–16 are unpatentable on the following ground:

| Claims Challenged | 35 U.S.C. § | References/Basis |
|-------------------|-------------|------------------|
| 1–16              | 103(a)      | Selbie, Griffin  |

Pet. 2–3.

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<sup>1</sup> The relevant sections of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (Sept. 16, 2011), took effect on March 16, 2013. Because the ’865 patent claims priority to an application filed before that date, our citations to 35 U.S.C. §§ 102 and 103 in this Decision are to their pre-AIA versions. *See also* Pet. 9 (stating that “[f]or the purpose of this Petition, Petitioner assumes the priority date of August 16, 2007”).

## II. ANALYSIS

### A. Legal Standards

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent [claim] it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). This burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). The Board may authorize an *inter partes* review if we determine that the information presented in the Petition shows that there is a reasonable likelihood that Petitioner will prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314(a).

Petitioner contends that the challenged claims of the ’865 patent are unpatentable under § 103. Pet. 3–4. A claim is unpatentable under § 103 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) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). When evaluating a combination of teachings, we must also “determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Whether a

combination of elements produces a predictable result weighs in the ultimate determination of obviousness. *Id.* at 416–417.

*B. Level of Ordinary Skill in the Art*

Petitioner asserts that one of ordinary skill in the art

would have had a bachelor’s degree in computer science, computer engineering, electrical engineering, or a similar field (or equivalent work experience to such a degree) with at least two years of experience in communications systems and systems for analyzing language, or . . . a master’s degree in computer science, computer engineering, electrical engineering, or a similar field with a specialization in communications systems and systems for text processing and analysis.

Pet. 12 (citing Ex. 1003 ¶ 60). Petitioner also argues that such an ordinary skilled artisan “would have known and had the skills necessary to design or implement communications systems and applications, to implement known techniques for analyzing text and audio, and to understand common techniques for embedding audio and text data.” *Id.* (citing Ex. 1003 ¶ 61).

At this stage, Patent Owner does not dispute Petitioner’s asserted level of ordinary skill nor propose its own level of ordinary skill. *See generally* Prelim. Resp.

Based on the preliminary record, we adopt Petitioner’s asserted level of ordinary skill only to determine whether there is a reasonable likelihood that Petitioner would prevail with respect to at least one of the claims challenged in the Petition. This level of skill in the art is consistent with the disclosure of the ’865 patent and the prior art of record. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (*Citing Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

*C. Claim Construction*

In an *inter partes* review based on a petition filed on or after November 13, 2018, the claims are construed

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), 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).

Petitioner proposes interpreting “a single transcript” to mean “a written, typewritten, or printed copy; something transcribed or made by transcribing,” if the term needs to be construed, with citations to the record. Pet. 3–7. Patent Owner does not propose an interpretation for any claim term at this stage. *See generally* Prelim. Resp.

Petitioner does not point to any language in the claims themselves to support its proposed interpretation of “a single transcript.” *See* Pet. 3–7. On the present record, the claims themselves do not provide or imply any specific meaning or definition of “a single transcript.”

Turning to the Specification, Petitioner points to Figure 1 and its related description. Pet. 3–4 (citing Ex. 1001, 3:43–45, Fig. 1). According to Petitioner, Figure 1 provides an example of “a single transcript,” and the ’865 patent states that “each of the text messages and voice messages can be logged in a single chat transcript 170 displaying a chronological order.” *Id.*; Ex. 1001, 3:43–45, Fig. 1. At this stage, we agree with Petitioner that the Specification of the ’865 patent supports Petitioner’s proposed interpretation of “a single transcript.” Ex. 1001, 3:43–45, Fig. 1. On the present record,

the Specification does not present a definition of “transcript” and does not indicate a narrower interpretation for the term.

Regarding prosecution history, Petitioner argues that “[t]he challenged claims were examined and allowed under a dictionary definition of ‘transcript,’ which is Petitioner’s proposed construction.” Pet. 3 (citing Ex. 1002, 323–324). Petitioner also argues that “Applicants tried to urge a narrow construction so that the phrase ‘single transcript’ refers not to a single display but rather specifically to a single data file or transcript comprising both text and audio data.” *Id.* at 5; *see also* Ex. 1002, 323 (“Appellants contend that the claim term ‘transcript’ should be construed as ‘a data structure in which a conversation is transcribed.’”). According to Petitioner, Applicants argued that an applied reference did not disclose a transcript because the reference showed “‘a window that displays the current communications thread.’” Pet. 5–6 (citing Ex. 1002, 409–410; Ex. 1006, Fig. 36).

Petitioner also contends that Applicants in an appeal brief argued that “transcript” is “a data structure that ‘includes both voice messages and text messages’ in an ordered fashion” and that “a ‘graphical user interface’ . . . is different from the data structure meaning.” Pet. 6–7 (citing Ex. 1002, 366–367, 368); *see also* Ex. 1002, 367 (arguing that “the broadest reasonable claim construction of the term ‘transcript’ . . . is a data structure in which a conversation is transcribed,” “includes both voice messages and text messages,” and “includes the order in which the conversation took place”). Petitioner further notes that the proposed interpretation was not accepted because the Specification did not support such a narrow construction. Pet. 7 (citing Ex. 1002, 323–325); *see also* Ex. 1002, 323 (“The Board agrees with the Examiner that there is no mention of a

‘transcript’ as a ‘data structure’ in the Specification, and that the term ‘transcript’ in the Specification is used broadly.”).

At this stage, prosecution history supports Petitioner’s proposed interpretation of “a single transcript.” Ex. 1002, 323–324. On the present record, we also agree with Petitioner that “a single transcript” would be broader than a single data file or a data structure with both voice and text messages. *See id.*

Thus, for the reasons discussed above, we preliminarily adopt Petitioner’s proposed interpretation of “a single transcript” to mean “a written, typewritten, or printed copy; something transcribed or made by transcribing.” Pet. 3–7.

Also, at this preliminary stage, we determine that no other claim term requires express interpretation. *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

#### *D. Asserted Obviousness Based on Selbie and Griffin*

Petitioner contends that Selbie and Griffin teach the limitations of claims 1–16 with citations to the record. Pet. 19–56. Petitioner also asserts a reason why one of ordinary skill in the art would have combined Selbie and Griffin with citations to the references and declarant testimony. *Id.* at 16–19.

Patent Owner responds that Petitioner fails to show that the references teach all the limitations of the independent claims, fails to identify any differences between the claims and the asserted references, fails to

sufficiently show a motivation to combine the references, and fails to establish a reasonable expectation of success. Prelim. Resp. 7–20.

For the reasons that follow, Petitioner shows a reasonable likelihood of prevailing with respect to at least one claim.

*1. Selbie (Ex. 1004)*

Selbie describes embodiments that employ “asynchronous voice message . . . to enable individuals to send voice clips back and forth over a network.” Ex. 1004 ¶ 16.

Selbie states that “any suitable application can be utilized to asynchronously send and receive instant voice messages,” and “such application can reside in the form of an instant messaging application.” Ex. 1004 ¶ 32. Selbie describes that “instant messaging connection is a relatively lightweight connection that enables text messages to be sent back and forth,” but a “peer-to-peer connection is a generally more robust direct connection between individuals that allows higher bandwidth activities to take place, such as file transfers and voice clip object exchanges.” *Id.* ¶ 34. Figure 3 of Selbie is reproduced below.

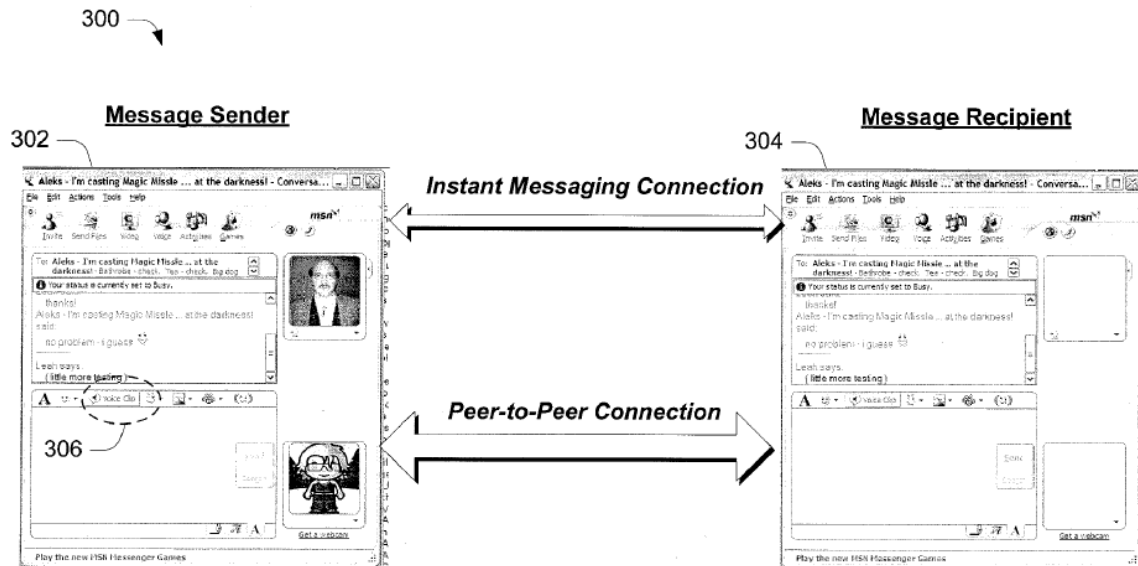


**Fig. 3**

Figure 3 shows an exemplary user interface. Ex. 1004 ¶ 7. In one embodiment, two users “have an open text session that utilizes the instant messaging connection to send text back and forth between them,” and one user can send a voice clip to the other user by holding a button to begin recording a message with a microphone attached to the first user’s computing device. *Id.* ¶¶ 28, 35, Figs. 2, 3. The voice clip can be “in the form of discrete, manageable objects that can be easily managed by the user” and “can be cached, stored, copied, sent, received, played, stopped, forwarded, replayed or otherwise manipulated in a manner that leverages file system utilities.” *Id.* ¶ 16.

The voice clip can be sent to one or more recipients “in an asynchronous manner by delivering the corresponding voice clip object over a network,” for example, “by an instant messaging application.” Ex. 1004 ¶ 29, Fig. 2. After receiving the voice clip, the recipient plays the instant voice message “either contemporaneously with receiving the message (such

as automatically upon receiving the message), or at a later time.” *Id.* ¶ 30, Fig. 2. “For example, if the intended recipient is unavailable, the corresponding voice clip object can be cached and maintained until the intended recipient is able to receive and listen to the voice message.” *Id.*

Selbie describes that “a particular type” of instant message can “indicate[] that it is not a normal text message with text that is to be displayed for the recipient” and that “the message contains data that is to be used in connection with voice clip activities.” Ex. 1004 ¶ 38. “The data that this message contains, in one embodiment, is the object store name that corresponds to the voice clip object that resides on the message sender’s computer.” *Id.* “By virtue of the message type (i.e. DATA type), the recipient’s messaging application knows that the message is not a text message to be displayed for the user, but rather is a data message that contains data associated with a voice clip object.” *Id.* ¶ 39. “[T]he intended recipient’s application can take steps to acquire the voice clip object from the sender’s computer” by using the voice clip’s object store name. *Id.*

The recipient’s application can then “take steps to enable its user to listen to the voice clip object.” Ex. 1004 ¶ 41. For example, “the application caches the voice clip object and provides user interface instrumentalities to enable the user to listen to the clip or otherwise manage the clip.” *Id.* Figure 5 of Selbie is reproduced below.

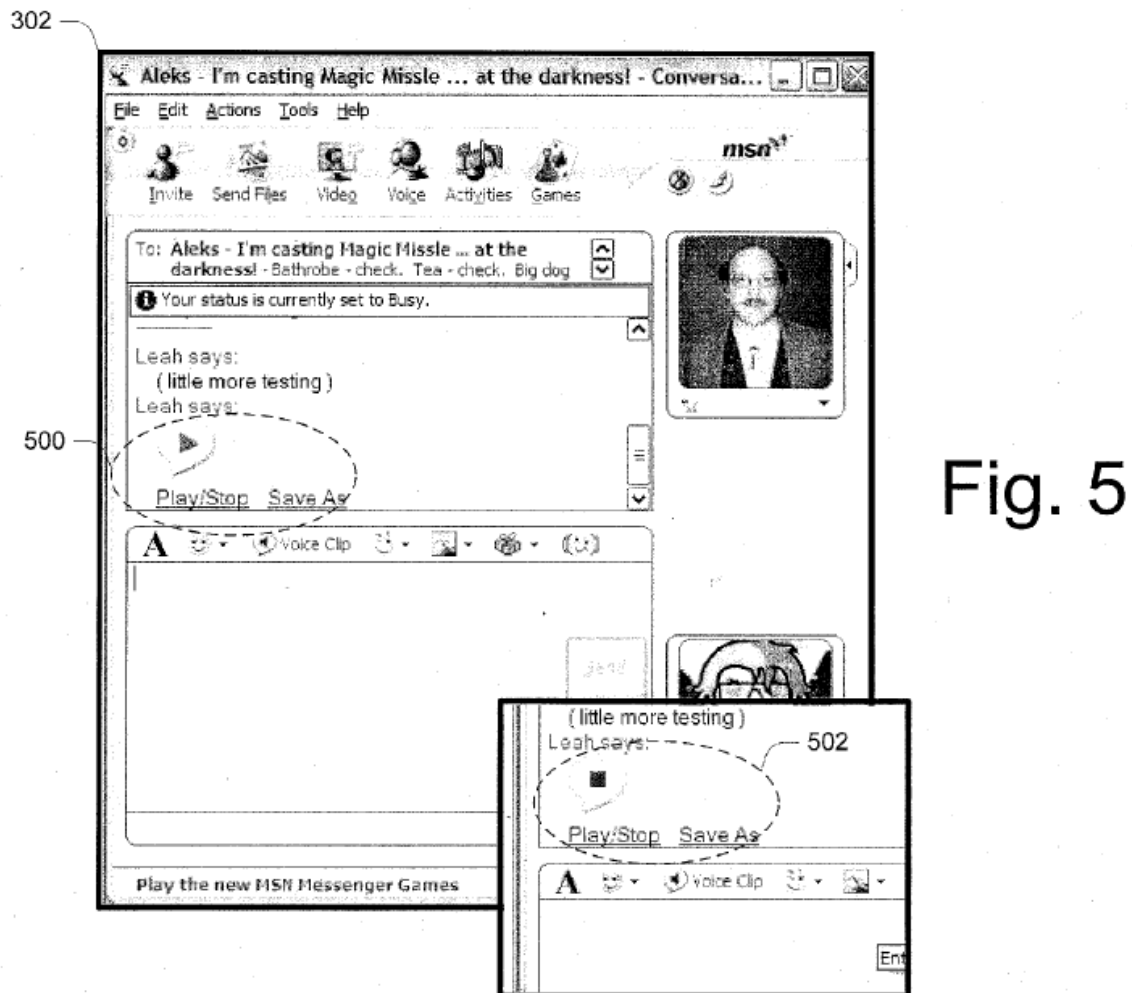


Figure 5 shows an exemplary user interface. Ex. 1004 ¶ 9. Figure 5 shows conversation window 3 from Figure 3. Ex. 1004 ¶ 42. “[W]hen the voice clip object is received it can be automatically played for the recipient,” and “[i]n the event the recipient wishes to replay the voice clip object or stop the voice clip object, buttons 500, 502 respectively can be used.” *Id.* “[A] ‘Save As’ link is provided and enables the recipient to manage the voice clip object by being able to save the voice clip object to a desired location on their computing device.” *Id.*

## 2. *Griffin* (Ex. 1005)

Griffin “relates generally to communication systems incorporating speech and textual input and output modalities and, in particular, to a wireless system for permitting real-time speech and text conversations (e.g., chat threads) on mobile units.” Ex. 1005 ¶ 2. Griffin provides “methods and systems for managing both single-modal (i.e., either voice or text) and multi-modal (i.e., voice and text) wireless chat systems.” *Id.* ¶ 6.

Griffin states that “when a plurality of users chat together (i.e., send chat messages from one terminal 100 to another), data comprising text, speech, and/or graphical messages (or some combination thereof) are sent to the server complex 204” that “then sends copies of the message out to the targeted terminals 100, preferably including, in one embodiment, the initiating or sending terminal.” Ex. 1005 ¶ 28, Fig. 2; *see also id.* ¶ 42 (describing inbound message 500 illustrated in Fig. 5), Fig. 5. Figure 11 of Griffin is reproduced below.

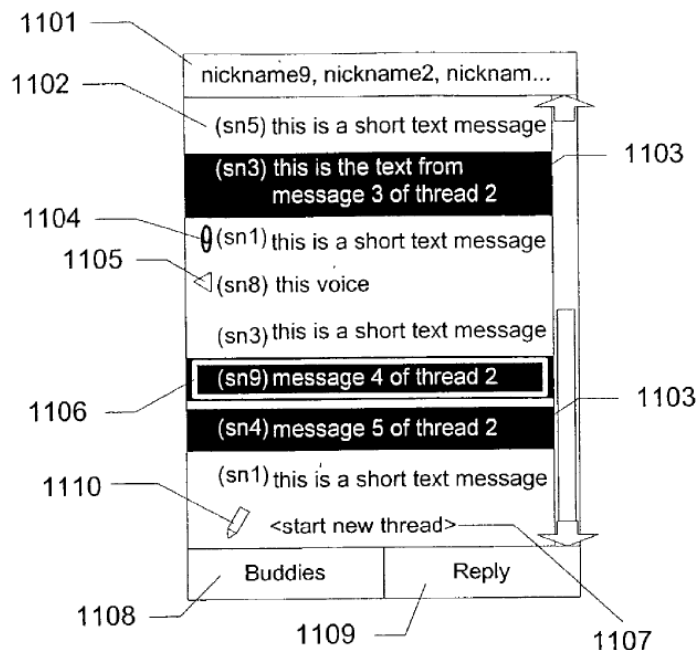


FIG. 11

Figure 11 shows a chat history display. Ex. 1005 ¶¶ 21, 53. The chat history display has content region 1103 with inbound chat messages received by terminal 100 and outbound chat messages transmitted by terminal 100. *Id.* ¶ 53. In an embodiment, however, “the speech content of an outbound voice message is not copied back to the transmitting terminal; only a text portion of a voice message is sent back as in inbound message.” *Id.* “[I]n a presently preferred embodiment, voice messages have text appended to them, even if only a generic character string or symbol is used to indicate that the message was a voice message,” and “if speech-to-text conversion is available, the actual speech content of the message could be converted to text and copied back to the transmitting terminal.” *Id.* Thus, “the occurrence of voice message results in an entry being displayed on the screen.” *Id.* “[I]f an inbound speech message arrives while the chat history display is not visible to the user, the received speech is queued up,” either at the receiving terminal, a server complex, or both so that the speech message is ready for automatic playback when the user switches back to the chat history display. *Id.* ¶ 59.

According to Griffin, “[u]nambiguous delivery of speech messages to the user is a problem when integrating multiple multi-modal threads of conversation into a single chat history” because “it is difficult for a user to associate speech with a particular discussion threads.” Ex. 1005 ¶ 60. Griffin “solves the association problem” by “each speech message leav[ing] an entry on the display” so that “[t]he entries link to their corresponding threads and represents at least the sender and the list of other recipients of the message.” *Id.*

Griffin also states that it “uses a second technique in conjunction with the first” so that, “when a user selects a thread, all speech messages

associated with the selected thread are played back to the user automatically, unless otherwise provisioned by the user.” Ex. 1005 ¶ 60. “Any speech messages not belonging to the selected thread are not played back automatically,” and “mobile terminal 100 presents an audible signal to the user indicating that there is other incoming speech message(s) in other thread(s).” *Id.* “Irrespective of whether the incoming speech message is played, the text portion of the incoming speech message is presented on the display” to “help[] the user in the decision process of choosing to listen to the message or ignoring it.” *Id.*

Griffin further states that “outbound chat message 400 comprises a message type 401 (e.g., text, speech, and so on),” as well as “number of intended recipients 402, a plurality of recipient identifiers 403, a thread identifier 404, a message length 405, message content 406, and a number of attachments 407.” Ex. 1005 ¶ 40, Fig. 4; *see also id.* ¶ 56 (stating that “[i]n the example of FIG. 11, each entry comprises an attachment indicator 1104-1105 that indicates if there is any attached content (e.g., documents, files, etc.) or transmitted speech available” and that “lesser amounts of information may be included in each entry of the display”). “[I]nbound message 500 is largely a copy of an outbound chat message 400 sent from a terminal 100 to the server complex 204.” *Id.* ¶ 42, Fig. 5. “[M]essages are delivered and the program updates the chat history display as described above and resumes operations until either the user terminates the session or a timeout occurs.” *Id.* ¶ 74.

### 3. Claims 1–7

For the preamble and each of the limitations of claim 1, Petitioner argues that Selbie in view of Griffin teaches the preamble and limitations. Pet. 19, 20, 21, 22, 26, 28, 29. Petitioner first argues specifically how Selbie

teaches the preamble and each of the limitations with citations to Selbie and declarant testimony. *Id.* at 19, 20, 21, 22–25, 26–27, 28, 29–32.

According to Petitioner, Griffin also teaches the preamble with citations to the record. Pet. 19–20. Petitioner further contends that, “[t]o the extent Patent Owner argues that Selbie’s teachings are not explicit and not sufficient,” Griffin teaches the limitations of claim 1 with citations to Griffin and declarant testimony. *Id.* at 20–21, 22, 25–26, 27, 28–29, 32–34. Petitioner provides a reason why one of ordinary skill in the art would have combined Selbie with Griffin with support from declarant testimony. *Id.* at 16–19, 20, 21, 22, 26, 27, 29, 34.

For each of claims 2–7 which depend directly from claim 1, Petitioner asserts with citations to the record that Selbie in view of Griffin teaches their limitations by arguing how each of Selbie and Griffin teaches the limitations and why one of ordinary skill in the art would have combined the two references. Pet. 34–45.

Based on the arguments and citations to record evidence presented in the Petition, Petitioner shows a reasonable likelihood of prevailing with respect to at least one of claims 1–7 in its challenge based on Selbie and Griffin.

*a) Patent Owner’s Preliminary Response*

*(1) identifying the ground with particularity*

Patent Owner responds that Petitioner fails to identify any differences between the challenged claims and the asserted prior art. Prelim. Resp. 7–11. In particular, Patent Owner argues that, for the limitations of claims 1–4, Petitioner relies on Griffin if Patent Owner argues that there is a difference between Selbie and these claims. *Id.* at 8–9 (citing Pet. 20, 22, 25, 27, 28, 31, 36, 39, 40). Patent Owner contends that Petitioner fails to

identify the differences and asks the Board to pick and choose the best combinations. *Id.* at 10. Patent Owner also contends that it does not have the burden to identify the differences between the prior art and the challenged claims. *Id.* at 11.

Petitioner’s arguments for the limitations of claims 1–4 clearly indicate that, in Petitioner’s view, at least Selbie teaches those limitations. Pet. 20, 21, 22–24, 26–27, 28, 29–32, 34–36, 38–39, 40. Petitioner argues similarly for the other challenged claims. *See id.* at 41–56. Petitioner is not arguing that there is a difference between Selbie and claims 1–4. *See id.*; *see also* Ex. 1003 ¶¶ 85, 90, 95, 101, 106, 111, 120, 126 (stating at these paragraphs that “[i]t is also my opinion that Selbie and Griffin separately each teach this limitation” or “this claim”). Based on the circumstances of this proceeding, Petitioner’s primary contention based only on Selbie satisfies Petitioner’s burden to show with particularity why the challenged claims are unpatentable. *See Harmonic*, 815 F.3d at 1363; 35 U.S.C. § 312(a)(3). It “is well settled” that “a disclosure that anticipates . . . also renders the claim invalid under § 103, for ‘anticipation is the epitome of obviousness.’” *Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1373 (Fed. Cir. 2019). Thus, a showing by Petitioner that Selbie discloses all of the claim limitations is sufficient to show obviousness over Selbie.

Because Petitioner primarily contends that Selbie sufficiently teaches the limitations, our analysis at this preliminary stage also focuses on Selbie to determine whether Petitioner sufficiently shows a reasonable likelihood of prevailing on at least one challenged claim. We also provide below our preliminary analysis below regarding the proposed combination of Selbie with Griffin to assist the parties in presenting their arguments during trial. Patent Owner should note for trial that Petitioner’s position is that Selbie and

Griffin each teach the limitations of, at least, claim 1. *See, e.g.*, Pet. 29 (“Selbie teaches . . .”), 32 (“Griffin also teaches . . .”); Ex. 1003 ¶¶ 85, 90, 95, 101, 106, 111.

In making our final determination of whether a preponderance of the evidence supports Petitioner’s argument that Selbie would have rendered obvious the challenged claims, if the full record indicates that Selbie does not teach or suggest all the limitations, we will consider the sufficiency of Petitioner’s arguments for its proposed combination to reach the missing limitation.

(2) *“logging the classified voice and text messages in a single transcript”*

Patent Owner also responds that Petitioner fails to show that either Selbie or Griffin disclose a method of automatically logging a unified multi-modal transcript. Prelim. Resp. 1–2, 11–13. In its summary of the references, Patent Owner argues that both references do not use the word “transcript.” *Id.* at 5, 6.

Regarding Petitioner’s arguments for “logging the classified voice and text messages in a single transcript,” Patent Owner contends that Petitioner cites only its declarant testimony, but that testimony fails to indicate that Selbie’s voice clip object is automatically logged in a multi-modal transcript. *Id.* at 11–12 (citing Ex. 1003 ¶ 112); *see also id.* at 2 (arguing that “Petitioner’s expert declaration provides no substantive guidance and appears to merely mimic the conclusory statements in the Petition”). In Patent Owner’s view, Petitioner’s declarant testimony indicates that a user manually manipulates a voice clip object, not automatically logged in a transcript with text messages. *Id.* at 12 (citing Ex. 1003 ¶ 112); *see also id.*

at 6 (arguing that Selbie does not disclose any embodiment with a multi-modal transcript containing text and voice messages).

Regarding Griffin, Patent Owner argues that Petitioner cites paragraph 53 and Figure 11 of Griffin, where a chat history display is described or shown. Prelim. Resp. 12. Patent Owner contends that, although arguably a transcript may be shown in Figure 11, Griffin does not disclose a multi-modal transcript, and Figure 11 shows a transcript with text only. *Id.* at 12–13; *see also id.* at 7 (arguing that Griffin discloses a chat history, but that is not a multi-modal transcript). Patent Owner also contends that attachment indicator 1105 links to a voice file that “would be played outside of the transcript.” *Id.* at 13. Patent Owner further contends that Petitioner’s cited declarant testimony is conclusory and unsupported. *Id.* (citing Ex. 1003 ¶ 117).

On the preliminary record, Petitioner makes a sufficient showing for “logging the classified voice and text messages in a single transcript of conversation between the two conversants occurring in the single instant messaging session in response to determining that the one of the received voice and text messages is classified as a voice message.” Pet. 29 (citing Ex. 1003 ¶¶ 111–118). Patent Owner’s arguments that Griffin does not teach this limitation are unavailing because Petitioner also argues that Selbie teaches the above-quoted limitation. *Id.* at 29–32 (citing Ex. 1003 ¶¶ 112, 114; Ex. 1004 ¶ 42, Figs. 5, 6).

Paragraph 42 of Selbie describes conversation window 302 shown in Figure 5. The same paragraph states that conversation window 302 is from Figure 3. Ex. 1004 ¶ 42. In describing Figure 3, Selbie states that such a window is an exemplary user interface “that can be presented by an instant messaging application.” *Id.* ¶ 32. Selbie also describes that, in conversation

window 302, “two users in the Fig. 3 example have an open text session that utilizes the instant messaging connection to sent text back and forth between them” and that “voice clip button 306 is provided.” *Id.* ¶ 35.

Figure 5 shows buttons 500, 502 for playing and stopping a voice clip object. Ex. 1004 ¶ 42. Petitioner’s declarant opines that Figure 5 shows a text message and a voice message logged in chronological order. Ex. 1003 ¶ 112. Figure 6, which Petitioner also cites, similarly shows a voice clip after text messages. Reproduced below are Figures 5 and 6 from Selbie.

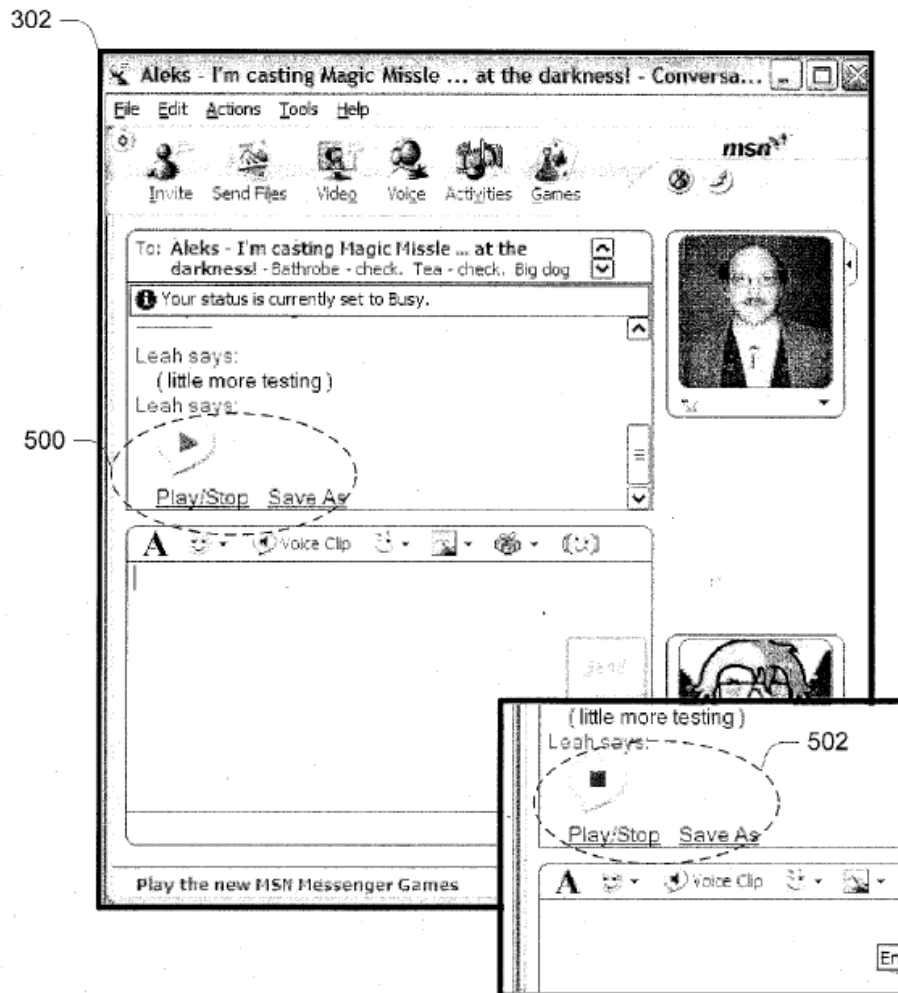


Fig. 5

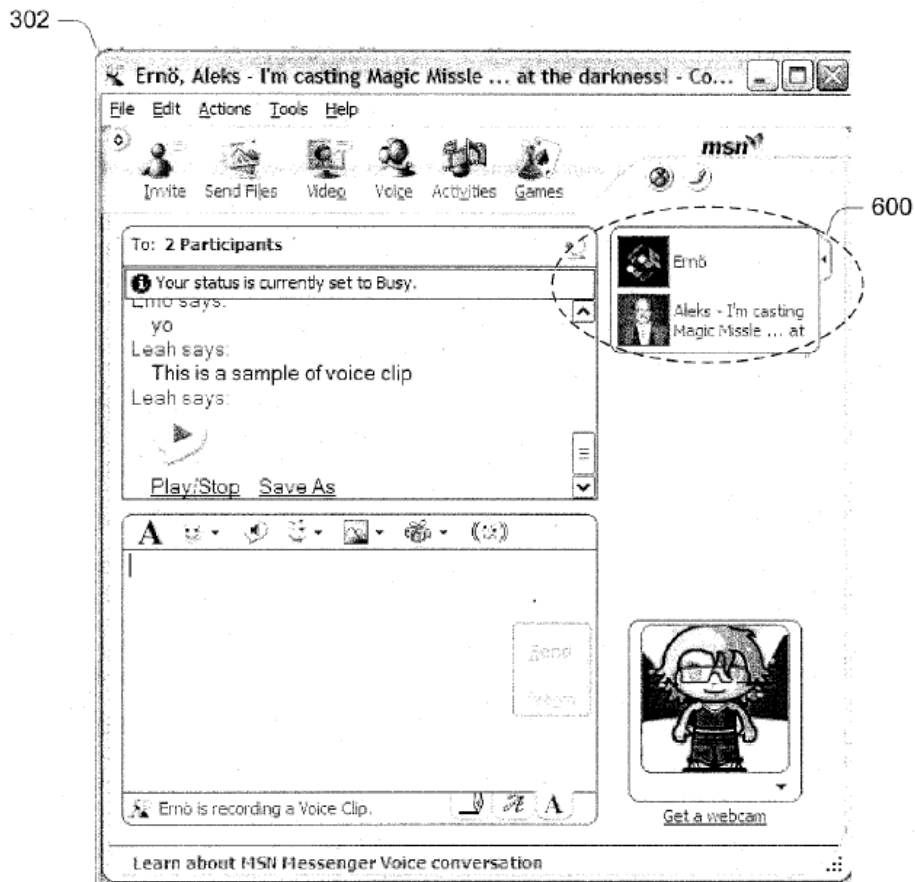


Fig. 6

Figures 5 and 6 each show an exemplary user interface. Ex. 1004 ¶¶ 9, 10. In view of the teachings upon which Petitioner relies, Petitioner sufficiently shows on the present record that Selbie teaches presenting text and voice messages in a single conversation window presented by an instant messaging application, and that they are presented in “a single transcript.” Ex. 1003 ¶ 112; Ex. 1004 ¶¶ 32, 35, 42, Figs. 5, 6. Petitioner’s challenge relying on Selbie persuasively shows “a single transcript” in accordance its proposed construction of this term, which we adopted (*supra* § II.C). Pet. 3–7.

At this stage, the record sufficiently supports Petitioner’s contention that Selbie teaches “logging the classified voice and text messages in a single transcript of conversation between the two conversants occurring in

the single instant messaging session in response to determining that the one of the received voice and text messages is classified as a voice message.”

*(3) Petitioner’s asserted motivation to combine*

Patent Owner further responds that Petitioner does not sufficiently present a motivation to combine Selbie and Griffin. Prelim. Resp. 2, 14–18. We need not determine this issue for purposes of institution, because we have determined that Petitioner has shown obviousness over Selbie alone. However, we provide this discussion to provide further guidance to the parties on this issue.

In particular, Patent Owner argues that Petitioner not only fails to identify any differences between the asserted art and the challenged claims, but also merely argues that the references “share the same field, share the same objective, and share the same methods to solve the same issues.” *Id.* at 15–16 (citing Pet. 16). According to Patent Owner, such argument and evidence are insufficient for articulating any motivation to combine because they only explain what one of ordinary skill in the art *could* do, not *would* be motivated to do. *Id.* at 16; *see also id.* at 18 (arguing that broad characterizations of references being in the same field are not sufficient for a motivation to combine the references).

Patent Owner additionally responds that Petitioner fails to establish a reasonable expectation of success for combining Selbie and Griffin. Prelim. Resp. 18–19. In particular, Patent Owner argues that Petitioner fails to argue any specific combination and fails to provide evidence of a reasonable expectation of success in combining any combination because Petitioner provides only a conclusory statement regarding expectation of success. *Id.* (citing Pet. 18–19).

Petitioner argues that Selbie and Griffin are in the same field of invention with citations to these references and declarant testimony. Pet. 16. Petitioner also goes on to argue that one of ordinary skill in the art would have been motivated to modify Selbie in view of Griffin “because Selbie teaches the desirability of classifying, presenting, logging, and saving voice and text content related to a conversation and Griffin discloses additional ways of achieving that goal and does so in a multi-modal messaging system on mobile cellphones as envisioned by Selbie.” *Id.* at 17 (citing Ex. 1003 ¶ 78).

Petitioner further argues that one of ordinary skill in the “would have been motivated to import features from Griffin to solve specific issues.” Pet. 18 (citing Ex. 1003 ¶ 78). Petitioner additionally contends that the “proposed combination would have been nothing more than the combination of prior art elements according to known methods to yield predictable results (a better voice message management system).” *Id.* (citing Ex. 1003 ¶ 78).

Based on the preliminary record, Petitioner’s asserted reasons for combining Selbie and Griffin are more than merely arguing that the references “share the same field, share the same objective, and share the same methods to solve the same issues,” as asserted by Patent Owner. *Id.* at 15–16. For example, Petitioner argues that one of ordinary skill would have been motivated to modify Selbie in view of Griffin because Griffin discloses other ways to classify, present, log, and save voice and text content in a multi-modal messaging system and that the combination would have been nothing more than combining prior art elements according to known methods with predictable results. See Pet. 17, 18. Thus, Patent Owner’s arguments regarding the asserted reason to combine do not provide a basis for denying institution.

4. *Claims 8 and 9*

For independent claim 8, Petitioner contends with citations to the record that Selbie in view of Griffin teaches its preamble and recited processor, instant messenger, and multi-modal transcript unification logic. Pet. 45–48. Petitioner argues that each of Selbie and Griffin teaches the preamble and the processor, instant messenger, and multi-modal transcript unification logic. *Id.* (citing Ex. 1003 ¶¶ 163–172, 174–181; Ex. 1004 ¶¶ 23, 26, 32–35, 72, Fig. 1; Ex. 1005 ¶¶ 6, 28, 31). Petitioner also argues why one of ordinary skill in the art would have modified Selbie in view of Griffin. *Id.* For the remaining limitations, Petitioner refers to its arguments for claim 1 with citations to declarant testimony. *Id.* at 48–49 (citing also Ex. 1002, 63).

Claim 9 depends from claim 8 and recites “wherein the multi-modal transcript unification logic is configured to couple the voice messaging session to the single instant messaging session.” Ex. 1001, 6:26–28. For this claim 9, Petitioner contends that Selbie in view of Griffin teaches its limitations by arguing how each of Selbie and Griffin teaches the limitations and why one of one of ordinary skill in the art would have modified Selbie in view of Griffin. Pet. 50–51 (citing Ex. 1003 ¶¶ 204–206; Ex. 1004 ¶¶ 16, 48; Ex. 1016).

Based on the arguments and citations to record evidence presented in the Petition, Petitioner shows a reasonable likelihood of prevailing with respect to claims 8 and 9 in its only challenge based on Selbie and Griffin.

Patent Owner responds that Petitioner fails to show that either Selbie or Griffin disclose “multi-modal transcript unification logic, executing on the processor,” as recited by independent claim 8. Prelim. Resp. 1–2, 13–14. In particular, Patent Owner argues that Petitioner cites paragraph 26 of

Selbie, but that the cited portion of Selbie only describes “the creation and management of voice clips” and does not discuss the required “multi-modal transcript unification logic.” *Id.* at 13–14 (citing Pet. 47). Regarding Griffin, Patent Owner argues that Petitioner cites paragraph 6 of Griffin but that portion of Griffin does not disclose “multi-modal transcript unification logic.” *Id.* at 14.

For “multi-modal transcript unification logic, executing on the processor . . . ,” Petitioner argues that Selbie in view of Griffin teaches the limitation. Pet. 47 (citing Ex. 1003 ¶¶ 178–181). As Patent Owner notes, Petitioner relies on paragraph 26 of Selbie specifically for this limitation. *Id.* at 47–48 (citing also Ex. 1003 ¶ 179). That paragraph states that “any suitable application can be utilized to enable a user to create and manage voice clip objects” and that “an application in the form of an instant messaging application, such as Microsoft’s Window® Live Messenger, can be utilized and can leverage infrastructure that is already in place to support the instant voice messaging functionality, as will be appreciated by the skilled artisan.” Ex. 1004 ¶ 26. Petitioner’s declarant opines that “Selbie discloses multi-model logic executing on the processor by sending both text and voice messages within an instant messaging environment” with support from Selbie. Ex. 1003 ¶ 179.

On the preliminary record, Petitioner sufficiently shows that Selbie teaches “multi-modal transcript unification logic” because Selbie describes using an instant messaging application to create and manage voice clip objects “as will be appreciated by the skilled artisan” and because Petitioner’s declarant testimony for this limitation finds support from Selbie. Ex. 1003 ¶ 179; Ex. 1004 ¶ 26.

Patent Owner also presents for claim 8 the arguments discussed above for claim 1. *See* Prelim. Resp. 1–13, 14–19. For the reasons discussed above, on the preliminary record, Patent Owner’s responsive arguments do not show a defect in Petitioner’s position regarding claims 8 and 9.

5. *Claims 10–16*

For independent claim 10, Petitioner contends with citations to the record that Selbie in view of Griffin teaches a computer program product and why one of ordinary skill in the art would have modified Selbie in view of Griffin. Pet. 51–53. For the remaining limitations, Petitioner refers to its arguments for claim 1 with citations to declarant testimony. *Id.* at 53–54. For claims 11–16 that each depend directly from claim 10, Petitioner refers to its arguments for claims 2–7 with additional citations to declarant testimony. *Id.* at 55–56.

Based on the arguments and citations to record evidence presented in the Petition (Pet. 51–54 (citing Ex. 1003 ¶¶ 209–238; Ex. 1004 ¶¶ 23, 32–35, 75; Ex. 1005 ¶ 31) (claim 10), *id.* at 55 (citing Ex. 1003 ¶¶ 240–242) (claim 11), *id.* (Ex. 1003 ¶¶ 244–246) (claim 12), *id.* (Ex. 1003 ¶¶ 248–251) (claim 13), *id.* at 56 (Ex. 1003 ¶¶ 253–256) (claim 14), *id.* (Ex. 1003 ¶¶ 258–261) (claim 15), *id.* (Ex. 1003 ¶¶ 263–266) (claim 16)), Petitioner shows a reasonable likelihood of prevailing with respect to claims 10–16 in its obviousness challenge based on Selbie and Griffin.

Patent Owner does not present separate arguments for claims 10–16. *See generally* Prelim. Resp.

### III. CONCLUSION

After considering the evidence and arguments presented in the Petition and the cited evidence, we determine that Petitioner has

demonstrated a reasonable likelihood of prevailing in proving that at least one of claims 1–16 of the '865 patent is unpatentable, and thus, we institute an *inter partes* review of all challenged claims on the only presented challenge. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim or any underlying factual and legal issues.

#### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–16 of U.S. Patent No. 9,760,865 B2 is instituted with respect to the only ground set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of U.S. Patent No. 9,760,865 B2 shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

IPR2022-00542  
Patent 9,760,865 B2

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