

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

FLYPSI, INC.,
Patent Owner.

IPR2023-00358
Patent 10,334,094 B1

Before ROBERT J. WEINSCHENK, JAMES J. MAYBERRY, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Google LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–4 (“the challenged claims”) of U.S. Patent No. 10,334,094 B1 (Ex. 1001, “the ’094 patent”). Flypsi, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition. With our authorization, Petitioner filed a Reply (Paper 7, “Reply”) to the Preliminary Response, and Patent Owner filed a Sur-reply (Paper 8, “Sur-reply”) to the Reply.

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . 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.” 35 U.S.C. § 314(a). Further, a decision to institute may not institute on fewer than all claims challenged in the petition. 37 C.F.R. § 42.108(a). Here, Petitioner demonstrates a reasonable likelihood of prevailing in showing that at least one of the challenged claims is unpatentable. Thus, we institute an *inter partes* review of the challenged claims on all the grounds of unpatentability in the Petition.

B. *Real Parties in Interest*

The parties identify themselves as the only real parties in interest. Pet. 1; Paper 4, 2.

C. *Related Matters*

The parties indicate that the ’094 patent is the subject of the following district court cases: 1) *Flypsi, Inc. (d/b/a Flyp) v. Google LLC*, No. 6:22-cv-00031 (W.D. Tex.) (“District Court Litigation”); and 2) *Flypsi, Inc. (d/b/a Flyp) v. Dialpad, Inc.*, No. 6:21-cv-00642 (W.D. Tex.). Pet. 1; Paper 4, 2.

The parties also indicate that the '094 patent is the subject of a petition for *inter partes* review in IPR2022-01048, and that patents related to the '094 patent are the subject of petitions for *inter partes* review in IPR2022-01049, IPR2022-01050, IPR2022-01051, IPR2023-00357, IPR2023-00359, IPR2023-00360, and IPR2023-00361. Pet. 2; Paper 4, 2–3.

D. The '094 Patent

The '094 patent relates to “providing telephone service by transmitting call handling information between a handset and a switch using an [Internet Protocol (‘IP’)] channel or similar protocol channel and by transmitting a voice call associated with the call handling information between the handset and the switch using a voice channel.” Ex. 1001, 1:50–59. Figure 3 of the '094 patent is reproduced below.

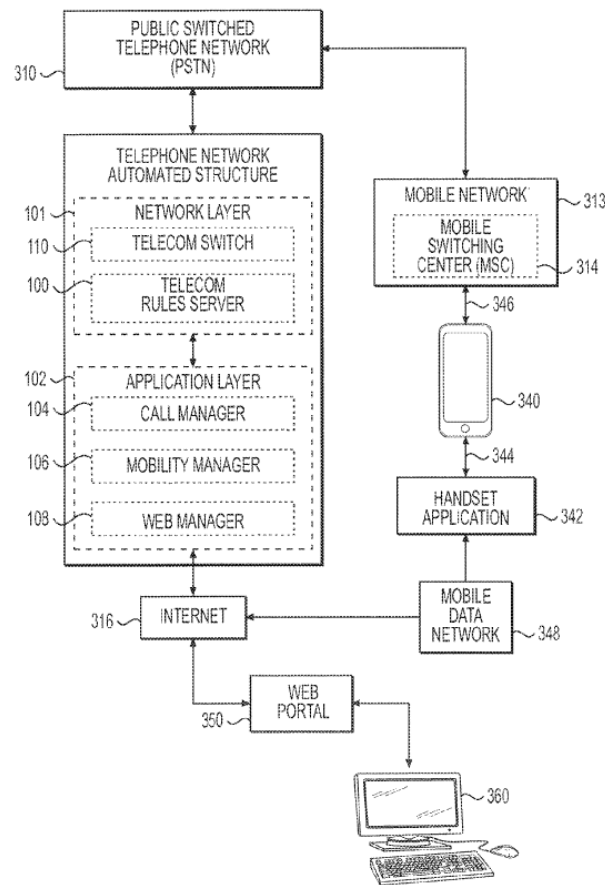


FIG. 3

Id. at Fig. 3. Figure 3 shows server 100 and telephone handset 340. *Id.* at 4:22–27. According to the '094 patent, server 100 and handset 340 may communicate via Internet 316 (i.e., a data channel) and via Public Switched Telephone Network (“PSTN”) 310 (i.e., a voice channel). *Id.* at 4:44–55.

The '094 patent explains that handset 340 transmits information to server 100 via Internet 316 requesting that one or more secondary telephone numbers be associated with the primary telephone number assigned to handset 340 at activation. *Id.* at 5:6–17. To place an outgoing call, handset 340 transmits information to server 100 via Internet 316 selecting one of the aforementioned secondary numbers as the origination number and selecting a contact number to be called. *Id.* at 7:36–52. In response, server 100

transmits a bridge number to handset 340 via Internet 316. *Id.* at 7:53–63. Handset 340 then calls the bridge number via PSTN 310, and switch 110 connects the outgoing call from handset 340 to the contact number via PSTN 310. *Id.* at 8:14–31. Switch 110 sends information to the contact number that “causes the secondary telephone number [of handset 340] to be displayed as the number from which the call appears to have been placed.” *Id.* at 8:31–35.

E. Illustrative Claim

Of the challenged claims, claim 1 is independent and is reproduced below.

1. A method of providing telephone service, comprising:
 - automatically storing electronic information that indicates an association of a secondary telephone number and a primary telephone number with a telephone handset in a computer memory associated with a server;
 - automatically associating a bridge or access telephone number with each of a plurality of contact telephone numbers in the computer memory;
 - automatically transmitting information that indicates the association of the bridge or access telephone number with each of a plurality of contact telephone numbers to the handset via a data channel;
 - automatically associating each primary telephone number and bridge or access telephone number pairing with a corresponding secondary telephone number and contact telephone number pairing in the computer memory;
 - receiving, at a switch associated with the server, an outgoing call from the handset to the bridge or access telephone number via a second channel;
 - receiving, at the server, information from the switch indicating the outgoing call is being made to the bridge or

access telephone number from the primary telephone number;
and

receiving, at the switch, information from the server
directing the switch to:

(a) connect the outgoing call to a contact telephone
number associated with the primary telephone number
and bridge or access telephone number pairing, and

(b) identify a telephone number from which the
outgoing call is being made as the secondary telephone
number.

Ex. 1001, 10:7–36.

F. Evidence

Petitioner submits the following evidence:

Evidence	Exhibit No.
Declaration of Dr. Bill Lin (“Lin Declaration”)	1002
Backhaus, US 2013/0295892 A1, published Nov. 7, 2013 (“Backhaus”)	1005
Taylor, US 2009/0052437 A1, published Feb. 26, 2009 (“Taylor”)	1007
Saksena, US 2006/0077956 A1, published Apr. 13, 2006 (“Saksena”)	1008

G. Asserted Grounds

Petitioner asserts that the challenged claims are unpatentable on the
following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 4	102	Backhaus
3	103	Backhaus, Saksena
1, 2, 4	103	Backhaus, Taylor
3	103	Backhaus, Saksena, Taylor

II. ANALYSIS

A. 35 U.S.C. § 314(a)

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 314(a) to deny the Petition. Prelim. Resp. 25–30; Sur-reply 1–3. Section 314(a) states that

[t]he Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.

Under § 314(a), we have discretion to deny institution of an *inter partes* review. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016). We consider several factors when determining whether to deny institution under § 314(a) based on a parallel district court proceeding, specifically

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Apple Inc. v. Fintiv, Inc., IPR2020-00019, Paper 11 at 5–6 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). We also consider “several clarifications” made by the Director of the United States Patent and

Trademark Office (“USPTO”). See USPTO Memorandum, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation, 2 (June 21, 2022), *available at* https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf (“Director’s Memo”).

1. *Factor 1 – Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted*

Under the first *Fintiv* factor, we consider “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted.” *Id.* at 6. Petitioner argues that the District Court “previously granted motions to stay pending instituted IPRs,” so the first factor “weighs against denial” or “is at least neutral.” Reply 1. Patent Owner argues that the District Court denied Petitioner’s “motion for stay relating to [its] mandamus petition,” so the first factor “is neutral.” Prelim. Resp. 25–26.

Neither party identifies any statements by the District Court or other evidence that specifically addresses a stay of the District Court Litigation pending this proceeding. See Pet. 58–59; Prelim. Resp. 25–26; Reply 1; Sur-reply 1. We decline to speculate based on the record in this case whether the District Court would grant a stay of the District Court Litigation. See *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative) (“*Fintiv II*”). As a result, we determine that the first *Fintiv* factor is neutral.

2. *Factor 2 – Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision*

Under the second *Fintiv* factor, we consider the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final

written decision.” *Fintiv*, Paper 11 at 6. Petitioner argues that the District Court’s trial date of February 19, 2024 “cannot be reliably used” because “[t]rial has already been postponed several times.” Reply 1. Petitioner also argues that the District Court’s “median time from filing to trial . . . is more than 28 months,” so “trial will likely be in May/June 2024.” Pet. 59. Petitioner concludes that the second factor “weighs against denial or is at least neutral.” Reply 1. Patent Owner argues that the second factor favors denial because the District Court’s trial date of February 19, 2024 is “around six months before the expected final written decision date of August 8, 2024.” Prelim. Resp. 26. Patent Owner also argues that Petitioner relies on “time-to-trial statistics for the entire Western District of Texas,” but more specific statistics for the presiding judge show that “trial is likely to occur faster” in “December 2023 or January 2024.” *Id.* at 26–27.

The current trial date in the District Court Litigation is February 19, 2024. Ex. 2003, 3. The projected statutory deadline for a final written decision in this case is in July 2024. However, Petitioner presents statistics indicating that the median time to trial in the Western District of Texas is 28 months (Ex. 1014, 37), and Patent Owner presents statistics indicating that the median time to trial for the presiding judge is 23 months (Ex. 2004, 1). See Director’s Memo at 8–9. On this record, we find Petitioner’s statistics more indicative of the likely time to trial because Petitioner’s statistics represent the median time to trial for civil cases during the recent 12-month period ending on June 30, 2022. Ex. 1014, 37 (“12-Month Periods Ending . . . Jun 30 2022 . . . Civil Only”). Although Patent Owner’s statistics are specific to the presiding judge, Patent Owner does not assert that its statistics are limited to civil cases or to a recent time period. See Prelim. Resp. 26–

27; Ex. 2004, 1 (“pending between 2009-01-01 and 2023-05-03 . . . Trial . . . 46 cases”). Based on Petitioner’s statistics, the trial in the District Court Litigation is likely to occur in May 2024, which is a couple months before the projected statutory deadline for a final written decision in this case. As a result, we determine that the second *Fintiv* factor slightly favors discretionary denial of institution.

3. *Factor 3 – Investment in the parallel proceeding by the court and the parties*

Under the third *Fintiv* factor, we consider the “investment in the parallel proceeding by the court and the parties.” *Fintiv*, Paper 11 at 6. Petitioner argues that “fact discovery and expert discovery do not close until after the institution deadline,” so the third factor “favors institution or is at least neutral.” Reply 2. Patent Owner argues that the third factor “strongly weighs in favor of denying the Petition” because 1) the District Court “has performed claim construction, decided a motion to transfer, and decided a motion to stay”; 2) the parties “have engaged in substantial discovery, including production and review of source code, depositions, service of final contentions, written discovery, and document production”; and 3) fact discovery closes on August 22, 2023, and expert discovery closes in October 2023. Prelim. Resp. 27–28.

The evidence of record indicates that the District Court and the parties have invested only some resources in the District Court Litigation as to issues of unpatentability involving the ’094 patent. The District Court issued a claim construction order that addresses two terms in the ’094 patent, but the District Court stated only that those terms have their “[p]lain and ordinary meaning.” Ex. 1016, 2. And the evidence of record indicates that

fact discovery is ongoing, expert discovery has not begun, and the deadline for dispositive motions is not until October 2023. Ex. 2003, 1–2. Thus, we determine that the third *Fintiv* factor weighs slightly against discretionary denial of institution.

4. *Factor 4 – Overlap between issues raised in the petition and in the parallel proceeding*

Under the fourth *Fintiv* factor, we consider the “overlap between issues raised in the petition and in the parallel proceeding.” *Fintiv*, Paper 11 at 6. Petitioner states that “if the IPR is instituted, Petitioner will not pursue the IPR grounds in the [D]istrict [C]ourt [L]itigation.” Pet. 59. Thus, according to Petitioner, the fourth factor “weighs against denial.” *Id.* Patent Owner argues that Petitioner’s “narrow[] stipulation only mitigates concerns about overlap ‘to some degree’ and thus, at best, only ‘weighs marginally in favor of not exercising discretion to deny institution.’” Prelim. Resp. 28–29.

The Petition challenges claims 1–4, and relies on Backhaus, Saksena, and Taylor. Pet. 3. Neither party explains which claims and references are at issue in the District Court Litigation. See Pet. 59–60; Prelim. Resp. 28–29; Reply 2–3; Sur-reply 2. Thus, on this record, we cannot determine whether there is overlap between issues raised in the Petition and District Court Litigation. Nonetheless, Petitioner’s stipulation that it will not pursue the grounds asserted in the Petition in the District Court Litigation mitigates to some degree concerns of duplicative efforts and potentially conflicting decisions. Pet. 59; see *Sand Revolution II, LLC v. Continental Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020) (informative). Thus, even if we assume that there is overlap between the issues raised in the Petition and the District Court Litigation, we

determine that the fourth *Fintiv* factor weighs slightly against discretionary denial of institution.

5. *Factor 5 – Whether the petitioner and the defendant in the parallel proceeding are the same party*

Under the fifth *Fintiv* factor, we consider “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11 at 6. Here, Petitioner is the defendant in the District Court Litigation. Prelim. Resp. 29. But, as we discussed for the second factor, the projected trial date in the District Court Litigation is only a couple months before the projected statutory deadline for a final written decision in this case. Under these circumstances, we determine that the fifth *Fintiv* factor slightly favors discretionary denial of institution.

6. *Factor 6 – Other circumstances that impact the Board’s exercise of discretion, including the merits*

Under the sixth *Fintiv* factor, we consider “other circumstances that impact the Board’s exercise of discretion, including the merits.” *Fintiv*, Paper 11 at 6. “[W]here the PTAB determines that the information presented at the institution stage presents a compelling unpatentability challenge, that determination alone demonstrates that the PTAB should not discretionarily deny institution under *Fintiv*.” Director’s Memo at 4–5. Petitioner argues that the sixth factor “weighs against denial as the merits of Petitioner’s arguments are compelling.” Pet. 60. Patent Owner argues that the sixth factor “weighs in favor of denial” because “the primary reference Backhaus fails to disclose [several] limitations.” Prelim. Resp. 29–30; see Sur-reply 2–3.

On balance, we determine that *Fintiv* factors 1–5 do not favor discretionary denial of institution. Specifically, we determine that

Petitioner’s stipulation and the parties’ minimal investment in the District Court Litigation as to issues of unpatentability outweigh the projected trial date. As a result, we need not decide whether Petitioner presents a compelling unpatentability challenge. *See CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 4–5 (PTAB Feb. 27, 2023) (decision on Director review) (precedential) (“[I]n circumstances where the Board determines that the other *Fintiv* factors 1–5 do not favor discretionary denial, the Board shall decline to discretionarily deny under *Fintiv* without reaching the compelling merits analysis.”).

7. Summary

Based on our holistic view of the *Fintiv* factors, we decline to exercise our discretion under § 314(a) to deny the Petition.

B. Level of Ordinary Skill in the Art

Petitioner argues that a person of ordinary skill in the art would have had “an undergraduate degree in electrical engineering, computer engineering, computer science, or a related field along with two years of work experience in the field of telecommunication.” Pet. 4 (citing Ex. 1002 ¶¶ 17–18). Petitioner’s description of the level of ordinary skill in the art is supported by the testimony of Petitioner’s declarant, Dr. Bill Lin. Ex. 1002 ¶¶ 17–18. Patent Owner does not dispute Petitioner’s description at this stage of the proceeding. Prelim. Resp. 5. We adopt Petitioner’s description for purposes of this Decision.

C. Claim Construction

In an *inter partes* review proceeding, a patent claim is construed using the same standard used in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary

meaning of the 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). Neither party proposes an express construction for any claim terms. Pet. 7; Prelim. Resp. 6. We determine that no claim terms require express construction for purposes of this Decision.

D. Anticipation of Claims 1, 2, and 4 by Backhaus

Petitioner argues that claims 1, 2, and 4 are anticipated by Backhaus. Pet. 8–48. For the reasons discussed below, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 1, 2, and 4 are anticipated by Backhaus.

1. Claim 1

Claim 1 recites “[a] method of providing telephone service.” Ex. 1001, 10:7. Petitioner presents evidence that Backhaus discloses a method for routing calls between a third party telecommunication device (“TD”) and a subscriber TD. Pet. 8–14 (citing 1005 ¶¶ 9, 30, code (57)). Patent Owner does not dispute that Backhaus discloses the preamble of claim 1. On this record, Petitioner shows sufficiently that Backhaus discloses the preamble of claim 1.¹

Claim 1 recites “automatically storing electronic information that indicates an association of a secondary telephone number and a primary telephone number with a telephone handset in a computer memory associated with a server.” Ex. 1001, 10:8–11. Petitioner presents evidence that Backhaus discloses automatically storing an association of a primary

¹ Because Petitioner presents evidence that the prior art discloses the recitations in the preamble of claim 1, at this stage of the proceeding, we need not decide whether the preamble is limiting.

number and an SLS number (i.e., a secondary number) for the subscriber TD in a SLS Master ID Table in a SLS platform. Pet. 14–19 (citing Ex. 1005 ¶¶ 31, 33–34, 39–40, 42–44, 60, 75, Fig. 3A). Petitioner also presents evidence that Backhaus’s subscriber TD is a wireless handset. *Id.* at 14 (citing Ex. 1005 ¶¶ 29, 31, 33, 50, 81–83). Patent Owner does not dispute that Backhaus discloses this limitation of claim 1. On this record, Petitioner shows sufficiently that Backhaus discloses this limitation of claim 1.

Claim 1 recites “automatically associating a bridge or access telephone number with each of a plurality of contact telephone numbers in the computer memory.” Ex. 1001, 10:12–14. Petitioner presents evidence that Backhaus discloses associating a relationship number (i.e., a bridge or access number) with each of a plurality of third party numbers (i.e., contact numbers) in memory. Pet. 20–23 (citing Ex. 1005 ¶¶ 42–43, 46–47, 49, 52–54, 57, code (57), Fig. 3A).

Patent Owner argues that Petitioner does not show sufficiently that Backhaus discloses associating a relationship number with “each of a plurality” of third party numbers. Prelim. Resp. 13–15. Specifically, Patent Owner contends that Petitioner “fails to address the word ‘each’ at all,” and “at most shows that Backhaus associates a *single* relationship number with a *single* third party number.” *Id.* at 13–14. According to Patent Owner, the portion of Backhaus cited by Petitioner indicates “that relationship numbers may be used for a ‘**plurality of subscriber number and third-party number combinations,**’ i.e., for **two or more** users (subscribers) in combination with a third-party number for each user, not two or more contact telephone numbers.” *Id.* at 15.

On this record, Patent Owner’s argument is unavailing. The portion of Backhaus cited by Petitioner discloses “that certain relationship numbers may be used for a *plurality of subscriber number and third party number combinations*, i.e., in certain embodiments a given relationship number may not be unique to a given subscriber number and third party number combination.” Ex. 1005 ¶ 47 (emphasis added); see Pet. 22–23. Patent Owner appears to interpret the phrase “plurality of subscriber number and third party number combinations” in Backhaus as indicating that a relationship number may be associated with “two or more . . . subscriber” numbers, but “not two or more [third party] numbers.” See Prelim. Resp. 15 (emphasis omitted). We disagree. On this record, we see no reason to interpret the phrase “plurality of subscriber number and third party number combinations” in Backhaus as excluding combinations of one subscriber number with two or more third party numbers. See Ex. 1005 ¶ 47.

Claim 1 recites “automatically transmitting information that indicates the association of the bridge or access telephone number with each of a plurality of contact telephone numbers to the handset via a data channel.” Ex. 1001, 10:15–18. Petitioner presents evidence that Backhaus discloses transmitting the relationship number for each of the plurality of third party numbers from the SLS platform to the subscriber TD. Pet. 26–28 (citing Ex. 1005 ¶¶ 62–63, 67, 71–74). Petitioner also presents evidence that Backhaus’s SLS platform transmits the information to the subscriber TD via

a data channel, such as an IP channel.² *Id.* at 28–29 (citing Ex. 1005 ¶¶ 54–55, 72–74).

Patent Owner argues that Petitioner does not show sufficiently that Backhaus discloses transmitting information that indicates the association of the relationship number “with each of a plurality” of third party numbers. Prelim. Resp. 16–18. First, Patent Owner contends that Petitioner presents “inconsistent arguments” because Petitioner relies on “an *incoming* call” for the “associating” limitation of claim 1, and relies on “an *outgoing* call” for the “transmitting” limitation of claim 1. *Id.* at 17. On this record, Patent Owner’s argument is unavailing. Petitioner’s argument regarding the “associating” limitation of claim 1 is not limited to just an incoming call. For example, Petitioner cites to a portion of Backhaus that discloses associating a relationship number with a third party number for both incoming and outgoing calls. Ex. 1005 ¶ 53 (“The SLS platform 115 creates the following relationship . . . [w]hen 1.770.555.0001 *receives (or places)* a call from/to 1.305.229.9999.”) (emphasis added); see Pet. 21. Thus, on this record, we find no inconsistency in Petitioner’s arguments regarding the “associating” and transmitting” limitations of claim 1.

Second, Patent Owner argues that “Backhaus at most discloses a *single* alleged association of a *single* relationship number to a *single* contact number.” Prelim. Resp. 17–18. According to Patent Owner, the portion of Backhaus cited by Petitioner discloses “an alleged association that occurs

² Petitioner presents evidence that Backhaus discloses transmitting the relationship number to the subscriber TD “via a data channel” in two ways. Pet. 23–29. For purposes of this Decision, we rely on the “second way.” *Id.* at 26–29 (emphasis omitted). Nonetheless, Patent Owner may present arguments regarding both ways in the Response after institution.

during a single outgoing call to a single third party number, and thus does not disclose transmitting information regarding an association of a bridge number with ‘each’ of two or more contact telephone numbers.” *Id.* On this record, Patent Owner’s argument is unavailing. As discussed above, Petitioner shows sufficiently that Backhaus discloses associating a relationship number with a plurality of third party numbers. Pet. 22–23; Ex. 1005 ¶ 47. Even if Patent Owner is correct that Backhaus only discloses transmitting one association at a time, we nonetheless are persuaded that Backhaus discloses the disputed limitation. Specifically, on this record, we find nothing in the claim language or the written description of the ’094 patent that precludes transmitting the associations separately, i.e., transmitting the relationship number for one third party number during an outgoing call and then transmitting the same relationship number for a different third party number during another outgoing call. *See* Ex. 1001, 7:42–63, 10:15–18.

Patent Owner also argues that Petitioner does not show sufficiently that Backhaus discloses transmitting a relationship number “via a data channel.” Prelim. Resp. 18–22. Specifically, Patent Owner contends that “the mere fact that Backhaus describes that unspecified communications can occur via various channels is not enough for anticipation: Backhaus must teach the specific arrangement of the claims, in which specific transmissions occur via a ‘data channel.’” *Id.* at 22. On this record, Patent Owner’s argument is unavailing. The portion of Backhaus cited by Petitioner discloses that “an IP-based interaction over the TD’s data service may be used” for “sharing information between the SLS module 105 [of the subscriber TD 110] and the SLS platform 115.” Ex. 1005 ¶ 73; *see* Pet. 28–

29. And Backhaus explains that one piece of information shared between the SLS platform and the subscriber TD is a relationship number. Ex. 1005 ¶ 72 (“the SLS module 105 may communicate with the SLS platform 115 . . . to obtain a relationship number”); *id.* ¶ 74 (“[T]he determined next available relationship number is returned to the SLS module 105 of the subscriber TD 110.”). Thus, Backhaus refers to a specific transmission—the sharing of a relationship number between the SLS platform and the subscriber TD—as occurring via an IP data channel.

Claim 1 recites “automatically associating each primary telephone number and bridge or access telephone number pairing with a corresponding secondary telephone number and contact telephone number pairing in the computer memory.” Ex. 1001, 10:19–22. Petitioner presents evidence that Backhaus discloses pairing a primary number with a relationship number and pairing a SLS number with a third party number. Pet. 30–32 (citing Ex. 1005 ¶¶ 49, 52–53, 60, 70, Fig. 4C). Petitioner also presents evidence that Backhaus discloses associating the primary and relationship number pairing with the SLS and third party number pairing. *Id.* at 32–35 (citing Ex. 1005 ¶¶ 10, 15, 44, 46, 53, 59, 60). Patent Owner does not dispute that Backhaus discloses this limitation of claim 1. On this record, Petitioner shows sufficiently that Backhaus discloses this limitation of claim 1.

Claim 1 recites “receiving, at a switch associated with the server, an outgoing call from the handset to the bridge or access telephone number via a second channel.” Ex. 1001, 10:23–25. Petitioner presents evidence that Backhaus’s subscriber TD calls the relationship number via a PSTN. Pet. 35–37 (citing Ex. 1005 ¶¶ 32, 49, 59). Petitioner also presents evidence that the PSTN necessarily includes a local switch associated with the SLS

platform that receives the outgoing call to the relationship number. *Id.* at 37–42 (citing Ex. 1002 ¶¶ 19–26, 82–84; Ex. 1005 ¶¶ 34–35, 39–40; Ex. 1007 ¶ 4, Fig. 1A; Ex. 1011, 6–7, 62–63, 81–82). Patent Owner argues that Petitioner does not show sufficiently that Backhaus discloses this limitation of claim 1. We address Patent Owner’s argument below.

Claim 1 recites “receiving, at the server, information from the switch indicating the outgoing call is being made to the bridge or access telephone number from the primary telephone number.” Ex. 1001, 10:26–29. Petitioner presents evidence that Backhaus’s SLS platform receives information indicating that the outgoing call is being made to the relationship number from the primary number. Pet. 42–43 (citing Ex. 1005 ¶¶ 49, 59–60, 69–70). Petitioner also presents evidence that the SLS platform’s local switch provides that information to the SLS platform. *Id.* at 37–43 (citing Ex. 1002 ¶¶ 19–26, 82–84, 86; Ex. 1005 ¶¶ 34–35, 39–40; Ex. 1007 ¶ 4, Fig. 1A; Ex. 1011, 6–7, 62–63, 81–82). Patent Owner argues that Petitioner does not show sufficiently that Backhaus discloses this limitation of claim 1. We address Patent Owner’s argument below.

Claim 1 recites “receiving, at the switch, information from the server directing the switch to: (a) connect the outgoing call to a contact telephone number associated with the primary telephone number and bridge or access telephone number pairing, and (b) identify a telephone number from which the outgoing call is being made as the secondary telephone number.” Ex. 1001, 10:30–36. Petitioner presents evidence that Backhaus’s SLS platform provides information for connecting the outgoing call to the third party number and identifying the outgoing call as made from the SLS number. Pet. 43–47 (citing Ex. 1005 ¶¶ 60, 70). Petitioner also presents

evidence that the SLS platform provides that information to its local switch. *Id.* at 37–47 (citing Ex. 1002 ¶¶ 19–26, 82–84, 88; Ex. 1005 ¶¶ 34–35, 39–40; Ex. 1007 ¶ 4, Fig. 1A; Ex. 1011, 6–7, 62–63, 81–82). Patent Owner argues that Petitioner does not show sufficiently that Backhaus discloses this limitation of claim 1. We address Patent Owner’s argument below.

Patent Owner argues that the three above limitations of claim 1 “require[] the same ‘switch’ to send or receive information related to the call,” and Petitioner’s “inherency argument fails because using the same switch to perform all three limitations is merely a possibility or a probability.” Prelim. Resp. 6–13. Specifically, Patent Owner contends that Petitioner “does not offer any reason why Backhaus would necessarily use the same switch (as required by the claims), rather than using multiple switches in the network (as was known in the art).” *Id.* at 8. For example, according to Patent Owner, the evidence of record indicates that “multiple switches,” including “at least one intermediate node,” can be used to route signals. *Id.* at 8–10 (citing Ex. 1007, Fig. 1A; Ex. 1011, 40, 53). Patent Owner also contends that “Backhaus teaches that the SLS platform may be connected to the subscriber’s device by ‘a first provider network’ . . . , and a POSITA would have readily understood that provider networks could span vast distances (e.g., across the US), such that the two ends of a call would not necessarily use the same ‘local’ switch.” *Id.* at 11 (citing Ex. 1005 ¶ 38).

On this record, Patent Owner’s argument is unavailing. Petitioner presents evidence that each telecommunication device or server necessarily is connected to a PSTN by its own local switch. Ex. 1002 ¶ 83 (“A local SSP is a switch that connects to a telecommunication device or server so as to allow the device/server to access the PSTN.”); Ex. 1007, Fig. 1A

(showing a local switch 12 associated with server 50); Ex. 1011, 6–7 (“the calling party’s local switch . . . the called party’s local switch”). Thus, because Backhaus’s SLS platform is connected to the PSTN by its own local switch, the same local switch that receives an outgoing call from the subscriber TD also routes the outgoing call from the SLS platform to the third party device. Ex. 1002 ¶ 83 (“a local switch . . . necessarily receives the outgoing calls before routing the same to SLS platform 115”); *id.* ¶ 88 (“the local switch . . . route[s] the call to the third party”). Even if Patent Owner is correct that Backhaus’s PSTN also includes additional intermediate switches for completing the outgoing call, we do not find any language in claim 1 that prohibits such additional switches. *See* Ex. 1001, 10:23–36.

For the foregoing reasons, on this record, Petitioner shows sufficiently that Backhaus discloses the limitations of claim 1.

2. Claims 2 and 4

Dependent claims 2 and 4 depend from claim 1. Petitioner presents evidence that Backhaus discloses the limitations of claims 2 and 4. Pet. 47–48. Other than the arguments discussed above for claim 1, Patent Owner does not dispute that Backhaus discloses the limitations of claims 2 and 4. Prelim. Resp. 22. On this record, Petitioner shows sufficiently that Backhaus discloses the limitations of claims 2 and 4.

3. Summary

For the foregoing reasons, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 1, 2, and 4 are anticipated by Backhaus.

E. Obviousness of Claim 3 over Backhaus and Saksena

Petitioner argues that claim 3 would have been obvious over Backhaus and Saksena. Pet. 49–53. Petitioner identifies evidence indicating that the Backhaus and Saksena combination teaches the limitations of claim 3, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* Other than the arguments discussed above, Patent Owner does not raise any arguments relating to this asserted ground. Prelim. Resp. 23. On this record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claim 3 would have been obvious over Backhaus and Saksena.

F. Obviousness of Claims 1, 2, and 4 over Backhaus and Taylor

Petitioner argues that claims 1, 2, and 4 would have been obvious over Backhaus and Taylor. Pet. 53–58. Petitioner identifies evidence indicating that the Backhaus and Taylor combination teaches the limitations of claims 1, 2, and 4, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* In particular, Petitioner asserts that “to the extent Backhaus is read not to disclose the claimed ‘switch,’ it would have been obvious to modify Backhaus . . . to implement a PSTN interface in light of Taylor and a POSITA’s contemporaneous knowledge.” *Id.* at 57 (citing Ex. 1002 ¶ 103).

Patent Owner argues that Petitioner “relies on Taylor in relation to the ‘switch,’” but Petitioner “does not even attempt to show that it would have been obvious to use the same switch for the functionalities listed in” the three limitations of claim 1 that include the switch. Prelim. Resp. 23–25. On this record, Patent Owner’s argument is unavailing. As discussed above, Petitioner presents evidence that each telecommunication device or server

necessarily is connected to a PSTN by its own local switch. Ex. 1002 ¶ 83; Ex. 1007, Fig. 1A; Ex. 1011, 6–7. Thus, because Backhaus’s SLS platform is connected to the PSTN by its own local switch, the same local switch that receives an outgoing call from the subscriber TD also routes the outgoing call from the SLS platform to the third party device. Ex. 1002 ¶¶ 83, 88.

For the foregoing reasons, on this record, Petitioner shows sufficiently that the Backhaus and Taylor combination teaches the limitations of claims 1, 2, and 4.

G. Obviousness of Claim 3 over Backhaus, Saksena, and Taylor

Petitioner argues that claim 3 would have been obvious over Backhaus, Saksena, and Taylor. Pet. 53–58. Petitioner identifies evidence indicating that the Backhaus, Saksena, and Taylor combination teaches the limitations of claim 3, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* Other than the arguments discussed above, Patent Owner does not raise any arguments relating to this asserted ground. Prelim. Resp. 23–25. On this record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claim 3 would have been obvious over Backhaus, Saksena, and Taylor.

III. CONCLUSION

Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of at least one of the challenged claims of the ’094 patent. At this stage of the proceeding, we have not made a final determination with respect to the patentability of any of the challenged claims.

IV. ORDER

It is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–4 of the '094 patent is instituted with respect to all grounds of unpatentability 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 the '094 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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Patent 10,334,094 B1

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