

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

ZILKR CLOUD TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2023-00553
Patent 9,210,254

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST

Currently Filed – Patent Owner

Ex. No.	Description
2002	Declaration of Robert Akl, D.Sc.
2003	Ex. A-19 Invalidity Chart (Bodart for '254) (Cisco's Invalidity Contentions in <i>Zilkr v Cisco Systems, Inc.</i> , No. 2:22-cv-00166-JRG-RSP (E.D. Tex.)
2004	Ex. A-1 Invalidity Chart (de Castro 932 for '254) (Cisco's Invalidity Contentions in <i>Zilkr v Cisco Systems, Inc.</i> , No. 2:22-cv-00166-JRG-RSP (E.D. Tex.)

CLAIM LISTING

Independent Claim 1	
1.0	A telephone system comprising:
1.1	a database; and
1.2	a server coupled to the database,
1.3	wherein the server is utilized by a first provider to provide a first service to a first user, wherein the first service is telephone service, and wherein the telephone service is associated with a first telephone number;
1.4	wherein the server is configured to: receive a request to provision a second service for the first user,
1.5	wherein the second service is provided by a second provider, and wherein the second provider is different than the first provider;
1.6	responsive to receiving the request: create a mapping from the first telephone number to a second identifier (ID), wherein the second ID is utilized by the second provider to identify the first user;
1.7	activate the second service with the second provider utilizing the second ID as a user ID for the first user; and
1.8	associate the second service with the first telephone number, wherein the first telephone number is associated with routing and interworking data necessary to utilize the second service.

Dependent Claims 2 and 6	
2.0	The telephone system as recited in claim 1, wherein the server is further configured to associate a plurality of services with the first telephone number,
2.1	wherein the plurality of services are provided by a plurality of providers different than the first provider, and wherein the plurality of services are utilized by the first user.
6.0	The telephone system as recited in claim 1, wherein the second service is a conferencing application, voice attendant application, or text messaging application.

Independent Claim 7	
7.0	A method comprising:
7.1	providing a first service to a first user by a first provider, wherein the first service is telephone service, and wherein the first user has a first telephone number;
7.2	receiving a request to provision a second service for the first user, wherein the second service is provided by a second provider, and wherein the second provider is different than the first provider;
7.3	responsive to receiving the request: creating a mapping from the first telephone number to a second identifier (ID), wherein the second ID is utilized by the second provider to identify the first user;
7.4	activating the second service with the second provider utilizing the second ID as a user ID for the first user; and
7.5	associating the second service with the first telephone number, wherein the first telephone number is associated with routing and interworking data necessary to utilize the second service.

Dependent Claims 8 and 12	
8.0	The method as recited in claim 7, further comprising associating a plurality of services with the first telephone number,
8.1	wherein the plurality of services are provided by a plurality of providers different than the first provider, and wherein the plurality of services are utilized by the first user.
12.0	The method as recited in claim 7, wherein the second service is a conferencing application, voice attendant application, or text messaging application.

Independent Claims 13	
13.1	A non-transitory computer readable storage medium comprising program instructions, wherein when executed the program instructions are operable to:
13.1	provide a first service to a first user by a first provider, wherein the first service is telephone service, and wherein the first user has a first telephone number;
13.2	receive a request to provision a second service for the first user, wherein the second service is provided by a second provider, and wherein the second provider is different than the first provider;
13.3	responsive to receiving the request: create a mapping from the first telephone number to a second identifier (ID), wherein the second ID is utilized by the second provider to identify the first user;
13.4	activate the second service with the second provider utilizing the second ID as a user ID for the first user; and
13.5	associate the second service with the first telephone number, wherein the first telephone number is associated with routing and interworking data necessary to utilize the second service.

Dependent Claim 14	
14.0	The non-transitory computer readable storage medium as recited in claim 13, wherein the program instructions are further operable to associate a plurality of services with the first telephone number,
14.1	wherein the plurality of services are provided by a plurality of providers different than the first provider, and wherein the plurality of services are utilized by the first user.

I. INTRODUCTION

Zilkr Cloud Technologies, LLC, the owner of U.S. Patent No. 9,210,254 (“the ’254 Patent”), submits this Preliminary Response to the Petition of Cisco Systems, Inc. (“Cisco” or “Petitioner”) challenging the validity of Claims 1, 2, 6-8, and 12-14 of the ’254 Patent (“Challenged Claims”). The Board should deny the Petition for discretionary reasons and/or based upon the merits.

Grounds 1 and 2 fail on the merits for multiple reasons. As one example, each of the Challenged Claims requires that the system or method “provide a first service [i.e., a telephone service] to a first user by a first provider [i.e., a telephone service provider].” According to Petitioner, a telephone service provider is a telephone carrier company, “such as AT&T, Verizon, and Sprint.” Pet. at 31. Petitioner has not shown that its references for either ground include a “server” that is “utilized by a telephone service provider” or disclose “provid[ing] a first service [i.e., a telephone service] to a first user by a first provider [i.e., a telephone service provider],” which is fatal to both grounds because all independent Challenged Claims require that feature. Ground 1 further fails because Petitioner did not meet its burden to provide an adequate explanation on the motivation to combine on Ground 1, including demonstrating a reasonable expectation of success for combining U.S. Patent Application Pub. No. 2007/0043687 (“Bodart”) with U.S. Patent No. 6,621,892 (“Banister”) and/or U.S. Patent No. 7,089,585 (“Dharmarajan”).

The *Fintiv* factors also favor denying institution of Cisco’s Petition. For example, Petitioner asserted Bodart and 2012/0016932 A1 (“de Castro”) in co-pending litigation, and based on the median time-to-trial statistics, a Texas jury will consider invalidity of the ’254 Patent more than three months before the Board is expected to render a final written decision here. Moreover, the co-pending litigation presents overlapping issues, and the parties and the district court have already expended (and will continue to expend) significant time and resources by the time the Board is expected to issue a decision on institution, including having conducted a claim construction hearing on July 14, 2023. Proceeding here is thus a poor use of the Board’s resources—especially given that Petitioner failed to provide an adequate *Sotera* stipulation.

II. RELATED PROCEEDINGS IN THE DISTRICT COURT

The ’254 Patent is involved in *Zilkr Cloud Technologies, LLC v. Cisco Systems, Inc.*, 2:22-cv-00166-JRG-RSP (E.D. Tex.) (“Texas Litigation”). The ’254 Patent was also involved in *Zilkr Cloud Technologies, LLC v. RingCentral, Inc.*, 3:21-cv-02807-S (N.D. Tex.), which was terminated on April 12, 2022.

III. THE ’254 PATENT PRESENTS A NOVEL SYSTEM AND METHOD FOR ENABLING THE TELEPHONE NUMBER AS A PLATFORM FOR THE ASSOCIATION OF IP-ENABLED SERVICES WITH TELEPHONE SERVICES

The ’254 Patent, entitled “Unified Services Platform Using a Telephone Number as a Common Subscriber Identifier,” was filed on November 22, 2013, and

issued on December 8, 2015. Ex. 1001 at 1. The '254 Patent claims priority to provisional application No. 61/888,856, filed on October 9, 2013. The '254 Patent “relates generally to integrating communications services, and in particular to managing services and applications using telephone numbers as common subscriber identifiers.” Ex. 1001, 1:16-19.

According to the '254 Patent, “telecommunications service providers still have large numbers of customers with traditional analog telephone service,” whose “telephone number remains the universal identifier (ID) for communicating with the outside world.” *Id.*, 1:21-26. With the availability of new technologies and services, “increasing numbers of customers wish to add services and applications to their existing telephone service,” but “many services and applications are supplied by third-party providers in different ecosystems,” which oftentimes “use different types of IDs and have different rules and policies for managing and activating their services and applications.” *Id.*, 1:27-33. For example, “if a user activated 10 different services from 10 different providers, the existing prior art techniques would require the user to use 10 different telephone numbers to activate these 10 services.” *Id.*, 10:60-63. The '254 Patent solves these issues by allowing the user “to use a single telephone number to associate with these 10 different services.” *Id.*, 10:63-65.

Figure 1 (shown below) describes an embodiment of an end user client connecting to a communications network:

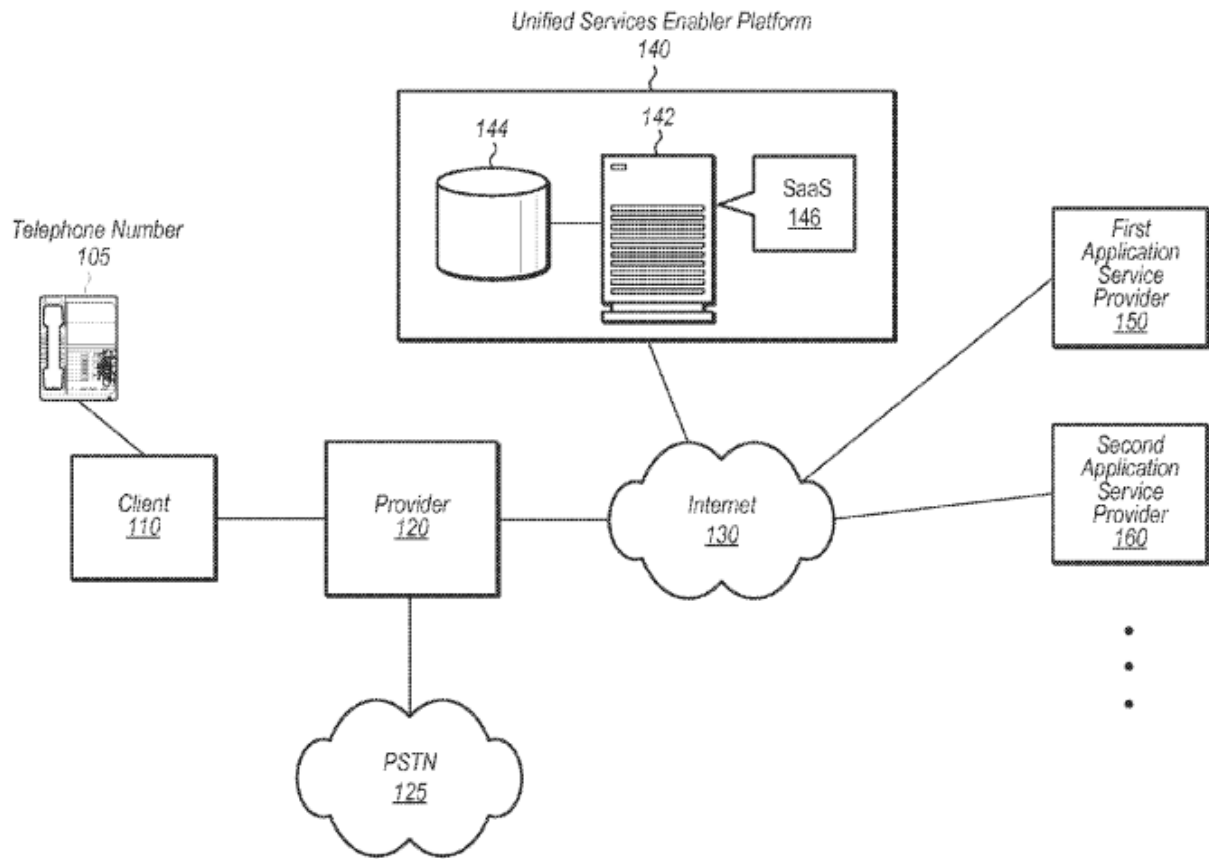


FIG. 1

Id., Fig. 1. “Client **110** may subscribe to a standard telephone service provided by provider **120**, and the telephone service may be associated with telephone number **105**.” *Id.*, 3:35-37. Client **110** may request to add services and applications from another application service provider (e.g., first application service provider **150** and/or second application service provider **160**) to the existing telephone service provided by provider **120**, such as “video conferencing, text messaging, interactive texting, hosted private branch exchange (PBX) seats, voice mail systems, and other services and applications.” *Id.*, 3:53-61.

First application service provider **150** and second application server **160** “may be part of a first ecosystem with a first identifier (ID) for each user and using a first application programming interface (API) for selecting and activating apps,” and “a second ecosystem with a second ID for each user and using a second API for selecting and activating apps,” respectfully. *Id.*, 3:65-4:4. “[T]he first and second ecosystems may not be compatible and may require separate IDs (for the same customer) and may have different types of rules and APIs for accessing, provisioning, and using their various services.” *Id.*, 4:4-13.

Unified services enabler platform **140**, which may be coupled to provider **120** via internet **130**, “may be configured to unify all of the available services and applications in a single platform that is associated with a single ID to identify client **110**.” *Id.*, 4:14-18. For example, “[r]ather than using an identifier such as an email address or a completely separate identifier, unified services enabler platform **140** may associate the various services and applications provided to client **110** with telephone number **105**.” *Id.*, 4:18-22. Unified services enabler platform **140** may include software and/or hardware for performing the various tasks to configure and provision a variety of services and applications and associate them with telephone number **105**. *Id.*, 4:32-35.

Client **110** may request to provision another application by selecting it from a catalog in the portal for platform **140**. *Id.*, 5:6-8. In response to detecting this

selection, “platform **140** may collect the relevant data from client **110** which the [selected] application needs to function properly for client **110**.” *Id.*, 5:8-11. Platform **140** activates the selected application by sending a standardized data notification to both provider **120** and the selected application provider. *Id.*, 5:16-33. Provider **120** and the selected application provider “may translate the information into appropriate systems, databases, and/or internally relevant systems required to allow telephone number **105** of client **110** to function with the [selected] application.” *Id.*, 5:21-25.

IV. OVERVIEW OF THE RELEVANT ALLEGED PRIOR ART

A. Bodart (Ex. 1005)

Bodart, entitled “Virtual Assistant,” was filed on August 19, 2005, and published on February 22, 2007. Bodart is directed to “personal productivity systems” (i.e., a virtual assistant), which “provide[] for the integration of personal and public information to enable more productive individuals by automating routine tasks.” *Id.*, [0001].

Figure 1 below “depicts one possible set of components of a virtual assistant 101,” which is “software designed to simplify, streamline and enhance the often repetitive activities which occupy the daily lives of many people”:

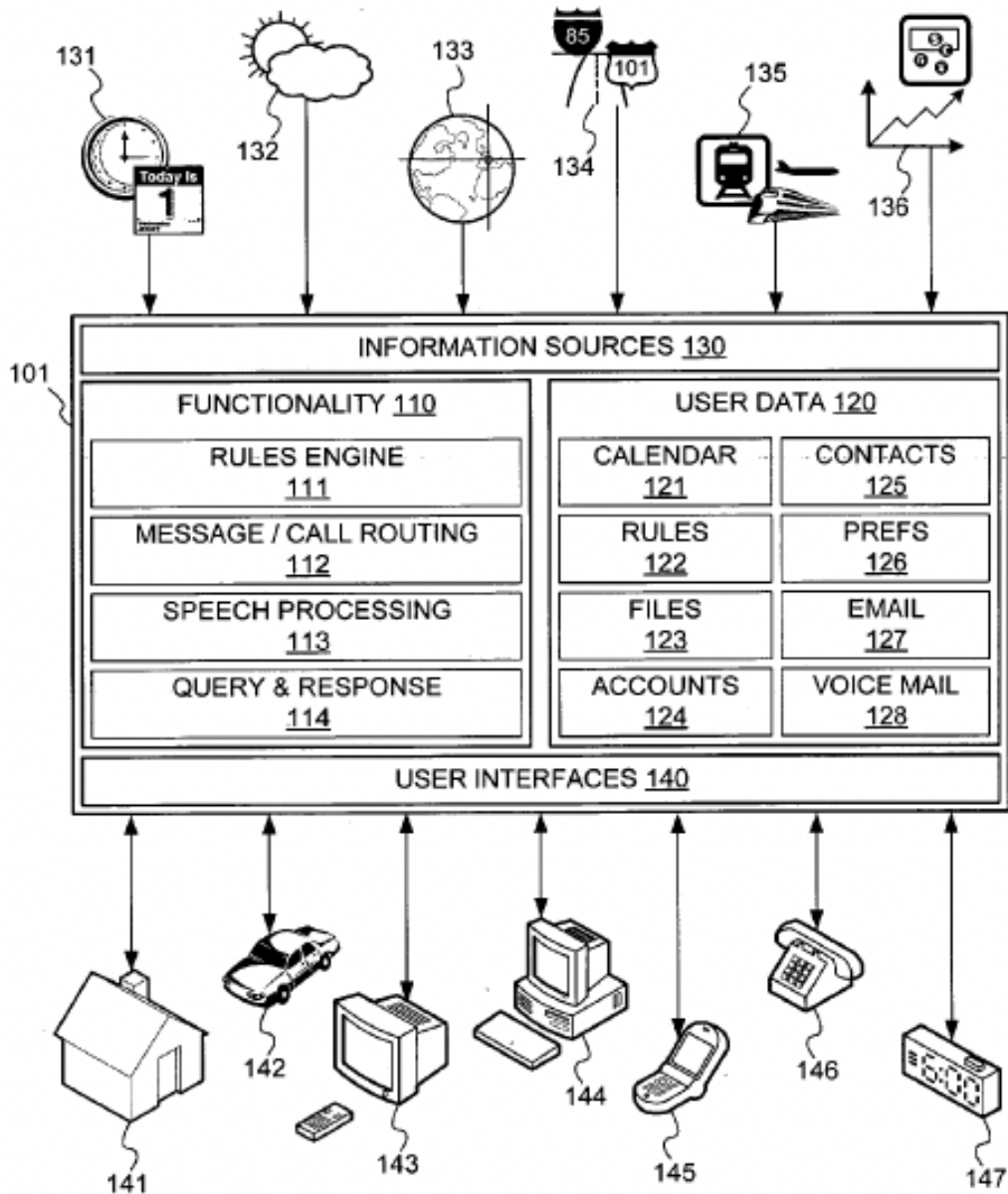


FIG. 1

Id., [0020]; Fig. 1. The “virtual assistant” software “may interact with a user via any number of interfaces 140,” “is able to retrieve data from a variety of information sources 130, in part to augment its ability to make decisions on the user’s behalf,” and “may include the ability to access user data 120, combined with technical

functionality 110, to assist the user and make the most accurate decisions possible.” *Id.*, [0020]. Virtual assistant 101 functions may be performed by a single device or by multiple devices in communication with each other. *Id.*

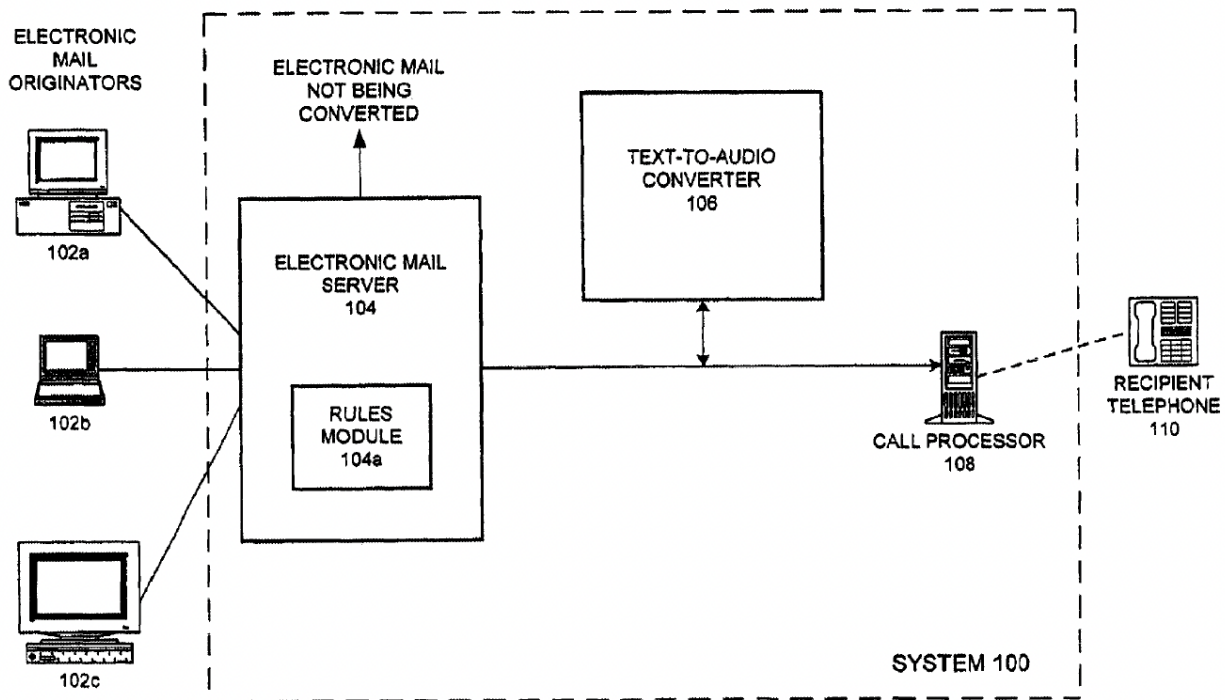
User data 120 may be available to virtual assistant 101 either through its own user interface and data storage, or by an electronic interface with the data and functions of other existing software packages. *Id.*, [0020]. User data may include “contact information 125, the equivalent of a software rolodex, where users can store contact email addresses and phone numbers, along with other information” and “a set of rules for use with rules engine 111, setting forth the logic used by virtual assistant to aid the user.” *Id.*, [0021].

“Rules engine 111 takes user-created rules, which may be represented as a series of textual if-then-else statements, and translates them into a series of actions.” *Id.*, [0024]. “Technologies such as voice over internet protocol (VoIP) may enable call routing functionality 112, where telephone conversations are converted to binary data which can be routed via a computer network such as the Internet.” *Id.*, [0025]. In addition, message & call routing 112 “may enable virtual assistant 101 to intercept incoming telephone calls, instant messages, and other real time communication requests.” *Id.* “Based on the rules set forth for rules engine 111, calls may be selectively routed to a user based on the current context of date, time, user location, and so forth.” *Id.*

B. Banister (Ex. 1006)

Banister, entitled “System and Method for Converting Electronic Mail Text to Audio for Telephonic Delivery,” was filed on July 14, 2000, and issued on September 16, 2003. Ex. 1006 at 1. Banister is directed to a system and method for receiving an electronic mail message, retrieving a telephone number associated with the intended recipient, converting the email message to audio, establishing a telephonic connection with the recipient, and playing an audio form of the message text to the recipient. *Id.*, 1:51-57.

Figure 1 below “depicts a system for converting an electronic mail message into an audio message for delivery via telephone according to one embodiment of the invention”:



System 100 “includes an electronic mail gateway or server 104 that receives electronic mail messages from electronic mail originators such as originators 102a, 102b, 102c,” a “text-to-audio converter 106 for converting the text of all or part of an electronic mail message to audio form, and one or more call processors (e.g., call processor 108),” which “use[] a telephone number provided by server 104 to set up a call to a recipient” and “then play[] the audio information received from electronic mail server 104 and/or text-to audio converter 106 to the recipient.” *Id.*, 3:36-50, 5:51-56.

According to Banister, “messages received at the system for conversion to audio and delivery via a telephone call may include addresses in the form of prefix@domain.” *Id.*, 6:50-53. The system of Banister “may use the prefix to search

a list or database of registered accounts or users.” *Id.*, 6:65-66. “The telephone number derived from the prefix of the message address or located by searching a database for the prefix is passed to a call processor . . . [and used] to set up a call to the addressee.” *Id.*, 7:50-54. “The call processor builds and places a telephone call to the message addressee using the telephone number received from the mail server.” *Id.*, 8:8-10. When the call is answered by the message addressee, the “call processor plays an audio message including any or all of an identity of the originator of the electronic mail message, the subject of the message, the body of the message and an audio attachment.” *Id.*, 8:29-32.

C. Dharmarajan (Ex. 1007)

Dharmarajan, entitled “Method and System for Authorizing a Client Computer to Access a Server Computer,” was filed on August 29, 2000, and issued on August 8, 2008. Ex. 1007 at 1. Dharmarajan is directed to “a method and system for providing authorization to access to a second computer system based upon previously provided authorization to access to a first computer system that does not require a user to provide login information more than once.” *Id.*, 2:1-8.

Figure 1 below depicts “an illustrative operating environment for an embodiment of the present invention” and includes “a client computer 10, an instant messaging server computer 2, and a Web server computer 26 are each connected to the Internet 8”:

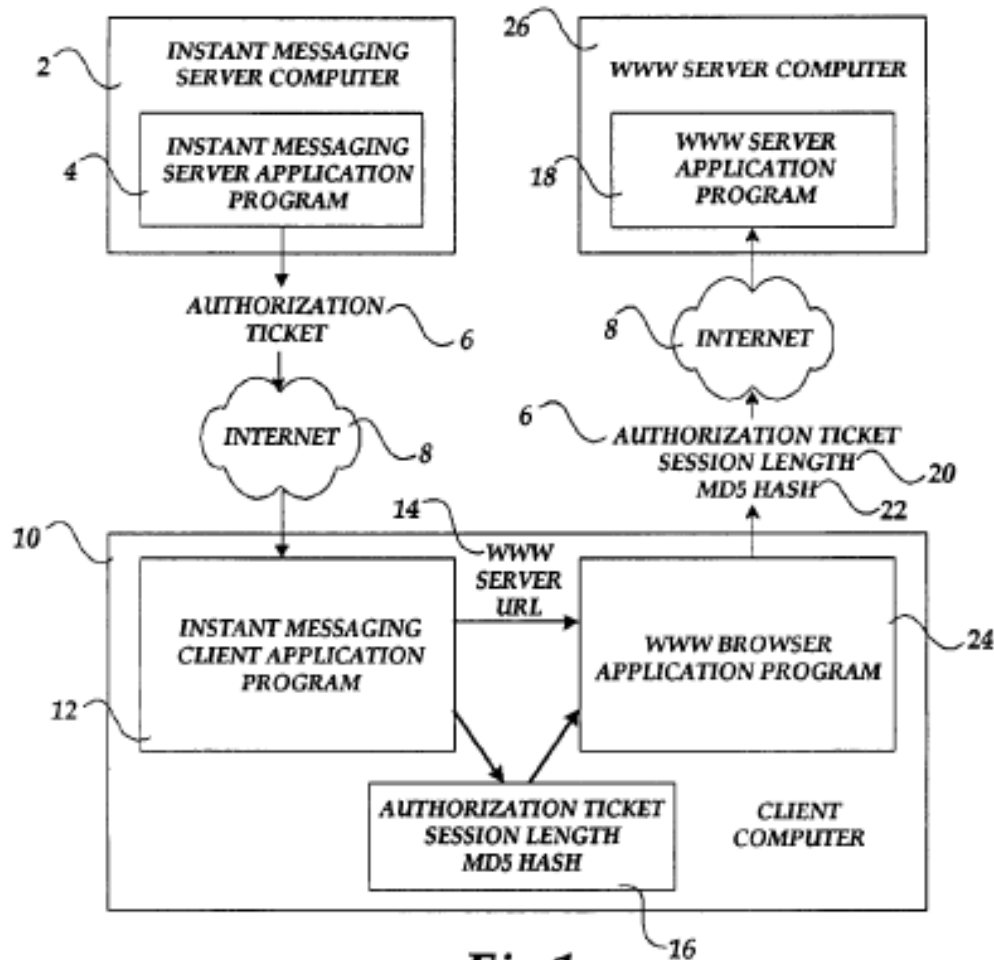


Fig.1

Id., 4:14-19; Fig. 1. The client computer 10 executes an instant messaging client application program 12, which communicates through the Internet 8 with an instant messaging server application 4 executing on the instant messaging server computer 2.” *Id.*, 4:44-52. “The client computer 10 also executes a Web browser application program 24, such as Internet Explorer.” *Id.*, 4:56-58.

The instant messaging client application program 12 utilizes “a sophisticated secure login mechanism” to gain access to the instant messaging server application

program 4, in which “the instant messaging server application program 4 transmits an encrypted authentication ticket 6 to the client computer 10 when authorization is provided to the client computer 10 to access the instant messaging server computer 2.” *Id.*, 5:4-12. The authentication ticket 6, which “contains a time stamp indicating the time at which the authentication ticket was created and transmitted to the client computer 10, . . . is stored by the client computer 10 for subsequent use in accessing the Web server computer 26.” *Id.*, 5:12-16.

To allow a user of the instant messaging server application program 4 to “quickly gain access” to a Web-based application, such as to access “their Web-based e-mail account with the HotMail service,” the “instant messaging client application program 12 may provide a menu item, button, or other user interface item for quickly accessing the Web server computer 26.” *Id.*, 5:24-34. In response to the selection of this user interface item, “the client computer 10 may gain authorization to access to the Web server computer 26 based upon the previously provided authorization to access the instant messaging server computer 2 . . . by first determining the session length of the communications session with the instant messaging server computer 2 . . . [and] then concatenate[ing] the authorization ticket received from the instant messaging server computer 2, the session length, and a shared secret stored at the client computer 10.” *Id.*, 5:39-46. “The shared secret comprises a secret such as a user login, e-mail address or password, that is shared

between the client computer and the Web server computer.” *Id.*, 5:46-49. A hash function is applied to the concatenated data “to determine a unique hash value,” and “[t]he authorization ticket, session length, and hash value are then stored in a file 16 on the client computer 10 in a location that is accessible to the Web browser application program 24.” *Id.*, 5:49-54.

“The instant messaging client application program 12 causes the Web browser application program 24 to be executed on the client computer and provides a Uniform Resource Locator (‘URL’) corresponding to the Web server computer 26.” *Id.*, 5:55-59. It “also causes the Web browser application program 24 to post the file 16 containing the authorization ticket, session length, and hash value to the Web server application program 18 as a part of a request for authorization to access the Web server computer 26.” *Id.*, 5:59-64.

D. de Castro (Ex. 1008)

de Castro, entitled “System and Method for Telephony and Communication Services with Message-Base API,” was filed on July 20, 2011, and published on January 19, 2012. Ex. 1008 at 1. de Castro is directed to a communication application server with a unified framework for call control and media control, which “supports a unified API having class objects and functions conforming to a telephony object model.” *Id.*, [0038]. In particular, the method and system of de Castro enables an application script to pass commands to the communication

application server to operate it, which “allows application scripts to be processed remotely by appropriate scripting engines.” *Id.*

Figure 14 below illustrates de Castro’s network architecture, comprising a service domain 201 and a customer/developer domain 601:

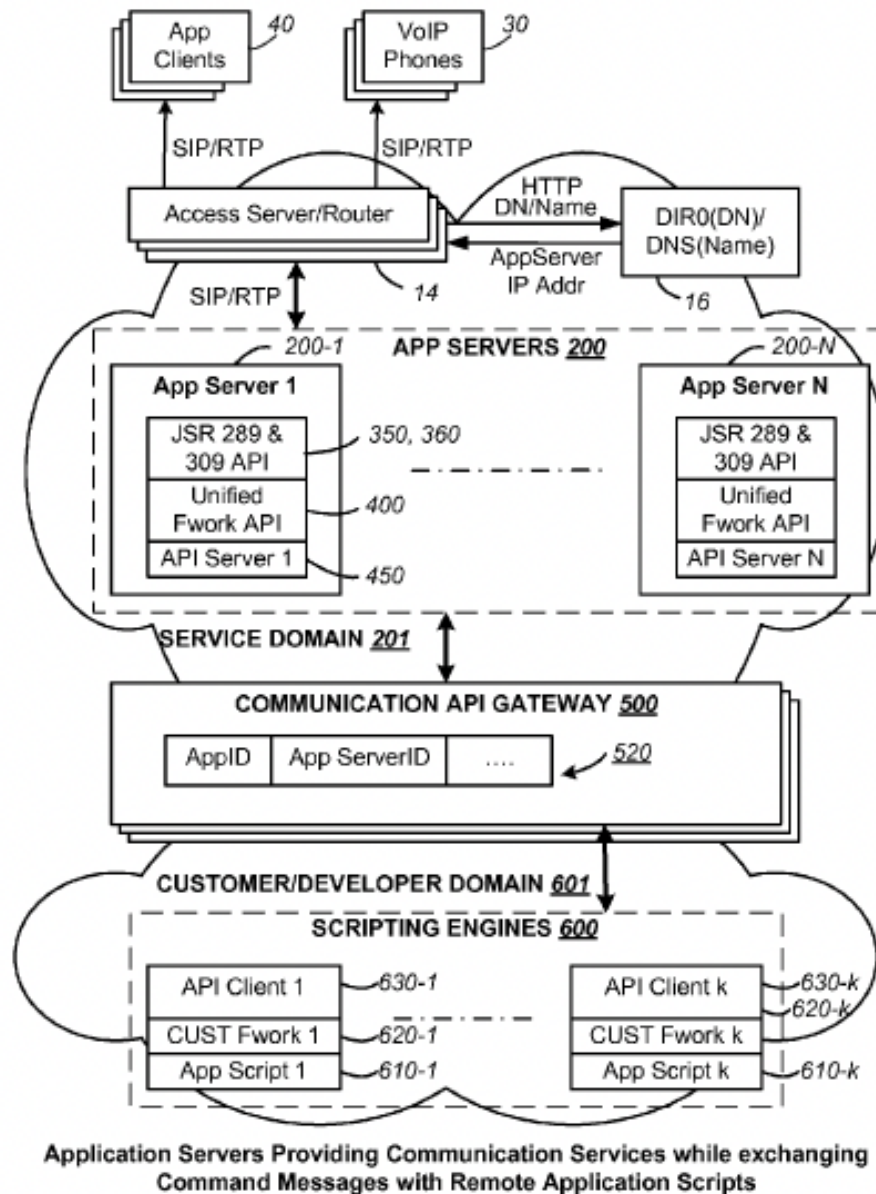


FIG. 14

Id., Fig. 14. The service domain includes a plurality of communication application servers 200 (App Server 1 to App Server N), which “provide telephony and communication services to applications and allows application clients 40 such as, for example, VoIP phones to access the applications hosted in the communication application servers.” *Id.*, [0115].

Application clients, such as VoIP phones 30, are “able to access a specific communication application by calling a dialed number or an URL.” *Id.*, [0116]. “The call is routed by an access server/router 14 into the IP network 10 to one of the communication application servers 200, such as App server 1,” “by looking up a directory service DIR016 with the IP address/dialed number in order to return the address of the communication application server executing the specific communication application.” *Id.*

“Each communication application server 200 comprises a virtual machine for executing codes with access to the unified communication API of the unified communication framework 400,” which is a “further abstraction of a basic call control API and media control API.” *Id.*, [0117]. In the customer/developer domain 601 is a plurality of scripting engines 600 “for the customers to host and process the customers application scripts 610.” *Id.*, [0119]. “For example, a customer 1 has the scripting engines 600 host and process[es] an application script such as App Script 1 610-1.” *Id.* An API client 630, such as API client 1 630-1, interprets the App Script

and “renders it in terms of the commands of the finite set defined at the API server 450 of the communication application server 200.” *Id.* The API client 630 then packages the commands as messages in accordance with the messaging API protocol to be sent to a connected communication application server 200, such as App server 1 200-1. *Id.* One or more communication API gateway 500 “is deployed on the network to serve as a messaging broker between the plurality of customers with application scripts in the customer/developer domain 601 and the group of communication application servers 200 in the service domain 201.” *Id.*, [0120].

V. STANDARDS

A. Institution of an IPR

Under 35 U.S.C. § 314(a), Petitioner carries the burden of showing a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the Petition. Petitioner must prove unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375-77 (Fed. Cir. 2016).

B. Petitions Based on Obviousness

A petition based on obviousness, which all grounds raised by Petitioner are, must “meaningfully” address the first two *Graham* factors: (i) the scope and content of the prior art, and (ii) any differences between the claimed subject matter and the prior art. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966). It is

not the Board's (or Patent Owner's) role to "sift through the information" provided with a petition to identify the differences between a challenged claim and the prior art. *Google Inc. & Twitter, Inc., Petitioners, v. Everymd.com LLC., Pat. Owner.*, No. IPR2014-00347, 2014 WL 2175007, at *11 (P.T.A.B. May 22, 2014).

To assert obviousness by combining prior art references, Petitioner must prove that: (1) a motivation to combine the references exists; and (2) a POSITA would have had a reasonable expectation of success in combining the references. *Apotex Inc. v. Wyeth LLC*, IPR2014-00115, Paper 94 at 11 (P.T.A.B. Apr. 20, 2015) ("A party that petitions the Board for a determination of obviousness must show that 'a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had reasonable expectation of success in doing so.'").

The requirement for proving reasonable expectation of success refers to achieving what is claimed in the patent-at-issue. *Intelligent Bio-Sys. V. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) ("[O]ne must have a motivation to combine accompanied by a reasonable expectation of achieving what is claimed in the patent-at-issue."). An articulated reason with a rational underpinning to combine specific teachings in the references in a particular manner to arrive at the claimed invention is required for a showing of obviousness. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007).

Objective indicia of non-obviousness cannot be ignored. *Fox Factory, Inc. v. SRAM, LLC*, IPR2016-01876, Paper 59, at * 9 (P.T.A.B. Apr. 2, 2018) (“Objective evidence of non-obviousness may often be the most probative and cogent evidence in the record and may often establish that an invention appearing to have been obvious in light of the prior art was not.”); *NuVasive, Inc. v. Iancu*, 752 F. App'x 985, 996 (Fed. Cir. 2018) (“On remand, the Board should reevaluate *NuVasive*’s objective evidence of non-obviousness such as long-felt need . . .”). A necessary safeguard and, like here, a required aspect of a petition based exclusively on obviousness, is a forthright discussion of the objective indicia of non-obviousness. *Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1354-55 (Fed. Cir. 2013) (“Failure to give proper consideration to such evidence, as in this case, can be fatal . . .”). Tellingly, Petitioner makes no attempt to address any indicia of non-obviousness.

C. Claim Construction

In an *inter partes* review filed on or after November 13, 2018, claim terms are construed based on their ordinary and customary meaning. 37 C.F.R. § 42.100(b). Patent Owner submits that the Board need not expressly construe any claim term in a particular manner to arrive at the conclusion that the Petition is substantively deficient.

Although Patent Owner provides arguments below on the scope of certain claim terms, Patent Owner does not propose a comprehensive construction, as it

would not be necessary to resolve the controversy and deny the Petition. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 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’”) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)); *see also* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340, 51,353 (Oct. 11, 2018) (Final Rule) (“Moreover, it also may not be necessary to determine the exact outer boundary of claim scope because only those terms that are in controversy need be construed, and only to the extent necessary to resolve the controversy (e.g., whether the claim reads on a prior art reference).” (citing *Nidec*)).

If trial is instituted, however, and to the extent deemed necessary to resolve any dispute, Patent Owner reserves the right to propose more specific constructions of one or more claim terms.

VI. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner defines a POSITA as having “a bachelor’s degree in electrical engineering, computer science, computer engineering, or equivalent, and two years of relevant experience in telecommunications and networking,” but that “[l]ack of professional experience can be remedied by additional education, and vice versa.” Pet. at 11-12. Because the proposed level of ordinary skill does not affect the ultimate

analysis, Patent Owner takes no position with respect to Petitioner's proposed level of ordinary skill in the art.

VII. PETITIONER'S PROPOSED OBVIOUSNESS CHALLENGES

Ground	'254 Patent Claims	Type	Reference(s)
1	1-2, 6-8, and 12-14 ¹	§ 103	Bodart in view of Banister and Dharmarajan
2	1-2, 6-8, and 12-14	§ 103	de Castro

VIII. GROUND 1: PETITIONER FAILED TO SHOW THAT BODART IN VIEW OF BANISTER AND DHARMARAJAN RENDERS OBVIOUS CLAIMS 1-2, 6-8, AND 12-14

Petitioner relies on the combination of Bodart in view of Banister and Dharmarajan to purportedly render obvious the Challenged Claims of the '254 Patent in Ground 1. But, as discussed below, Petitioner has not established a reasonable likelihood of success that its combination renders obvious any of the Challenged Claims. For these and the reasons stated below, Ground 1 fails.

¹ Petitioner identifies claims 1, 2-6, and 12-14 in Section XIB of its Petition, but argues throughout its Petition that the Challenged Claims include claims 1-2, 6-8, and 12-14 for both Ground 1 and Ground 2.

A. Petitioner Failed to Show That the Combination of Bodart, Banister, and Dharmarajan Renders Obvious the Challenged Claims.

Bodart, Banister, and Dharmarajan propose different solutions to different problems, Petitioner has not shown that any of these references discloses a server that is “utilized by” a telephone service provider or “provid[es] a first service to a first user by a first [telephone] provider,” and Petitioner’s combined system does not **arrive at the Challenged Claims**. For these and the reasons stated below, Ground 1 fails.

1. Petitioner Has Not Shown a Motivation to Combine

The ’254 Patent is directed to integrating advanced services and applications with an existing telephone service provider. Ex. 1001, 1:34-36. To do so, the ’254 Patent permits a telephone customer to “request to provision [additional] service[s]” or applications through a server that is “utilized by” the telephone service provider. *Id.*, 15:44-46. “Responsive to receiving the request to provision,” the system of the ’254 Patent (1) **creates a mapping** from the user’s telephone number to a second identifier that is used by the requested service or application, (2) **activates** the service or application using the second identifier, and (3) **associates** the service or application with the user’s telephone number **such that the telephone number is associated with routing and interworking necessary to utilize the second service**. *Id.*, 15:54-65. When the telephone user subsequently requests to **utilize** the

service or application, the system will (1) retrieve the mapping, (2) translate the telephone number to the second identifier, and (3) use the second identifier to initiate the second service or application. *See, e.g., id.*, Fig. 7. As the '254 Patent explains, “[t]hese techniques allow the telephone number of [the user] to become the common ID” that is “used by a middleware layer to allow the functionality of the third-party applications to work with each other and to work on the primary provider's network.” *Id.*, 12:49-61. All the Challenged Claims are directed to receiving a request to provision a second service and not merely utilizing one. Ex. 2002, Akl Decl., ¶ 36.

(a) A POSITA Would Not Be Motivated to Combine Bodart, Banister, and Dharmarajan Because the Problems Each Sought to Solve Are Far Too Attenuated from the Challenged Claims

As its title confirms, Bodart relates to a personal “virtual assistant” that purports to facilitate the productivity of an individual. Ex. 1005, [0001]. Petitioner has not shown that Bodart’s “virtual assistant” either is a “telephone service provider” or is “utilized by”² a telephone service provider, which as Petitioner explains, includes telephone carrier companies “such as AT&T, Verizon and Sprint.” Pet. at 31; Ex. 2002, Akl Decl., ¶¶ 54-55. Petitioner also has not shown that

² Petitioner appears to recognize this discrepancy because it argues that the server “is ‘utilized’ to provide ‘telephone service,’” and not that the server is “utilized by” a first provider. Pet. at 31.

Bodart teaches “provid[ing] a first service to a first user by a first provider.” Ex. 2002, Akl Decl., ¶¶ 54-55. That Bodart “can intercept incoming telephone calls, instant messages, and other real time communication requests” for an individual user does not show otherwise because those functions are handled by the virtual assistant and not a telephone service provider, such as “AT&T, Verizon, and Sprint” (Pet. at 31). Ex. 2002, Akl Decl., ¶ 55. Bodart is not concerned with providing additional applications to users of a telephone service provider and then associating a user’s telephone number with the additional applications for the purpose of routing and interworking. Ex. 2002, Akl Decl., ¶ 56.

Rather, Bodart is focused on increasing productivity of a single user, and a POSITA would understand from Bodart’s disclosures that Bodart’s personal “virtual assistant” already knows the user’s telephone number and thus there would be no reason, and it would be inefficient, to store the user’s telephone number together with login credentials of either an IM or email application. Ex. 2002, Akl Decl., ¶ 56. For example, Bodart’s virtual assistant would necessarily know the user’s telephone number because it is already configured to “intercept” and “forward” calls to that number. Ex. 1005, [0057], [0060]; Ex. 2002, Akl Decl., ¶ 56.

A POSITA would also understand from Bodart’s disclosures that the user-set rules determine how to route calls, IMs, and emails based on the caller’s contact information, and not on the virtual user’s telephone number (i.e., not the “first

telephone number”). Ex. 2002, AkI Decl., ¶ 57; Ex. 1005, [0024], [0057]. For example, Bodart’s disclosures teach that a user may configure a rule to send a text message to the user if a call to the user’s telephone number is intercepted from a certain contact. Ex. 2002, AkI Decl., ¶ 57; Ex. 1005, [0057] (“If the contact 215 is recognized, then virtual assistant 101 may forward the call appropriately (according to predefined rules).”). A POSITA would understand that the user-set rule associated with the “certain contact” is what establishes the routing and interworking of a call, including whether a call is forwarded and/or how the user is notified, such as by IM or email. Ex. 2002, AkI Decl., ¶ 57.

Petitioner also has not shown that the system of Banister is a “telephone service provider,” as Petitioner defines that term (Pet. at 31), is “utilized by” a telephone service provider, or “provide[s] a first service to a first user by a first provider.” Ex. 2002, AkI Decl., ¶ 58. Instead, the system of Banister receives emails, maps the email recipients to phone numbers, and presumably utilizes the telephone services provider to establish a connection and play an audio form of an email message to the email recipients. Ex. 2002, AkI Decl., ¶ 58. In other words, it is the email address (and not the phone number) that determines whether calls to one or more email recipients will be placed. Ex. 2002, AkI Decl., ¶ 58.

A POSITA would not look to modify Bodart’s virtual assistant with Banister’s database of email addresses with associated telephone numbers to arrive at the

Challenged Claims, especially because, *inter alia*, (1) Bodart and Banister are incompatible, and (2) Petitioner has not shown, *inter alia*, that Bodart associates the user's telephone with a second service for purposes of routing and interworking such that there would even be a need for Banister's database. Ex. 2002, Akl Decl., ¶ 59. As explained above, the user-set rules in Bodart determine, based on the caller's contact information, how a call is handled and routed. Ex. 2002, Akl Decl., ¶ 57.

Dharmarajan is directed to a method and system for providing access for a client computer to a second server system based upon previously provided authorization to access a first server system. Ex. 1007, 2:1-8. Dharmarajan is also not a telephone service provider, "such as AT&T, Verizon, and Sprint" (Pet. at 31), nor is it "utilized by" one. Ex. 2002, Akl Decl., ¶ 62.

Dharmarajan's system consists of a client computer that executes "an instant messaging client application program" with a "sophisticated secure login mechanism" to gain access to the instant messaging server application. *Id.*, 5:4-7. As part of the "secure login," the client application receives an "authentication ticket" that it stores on the client computer. *Id.*, 5:7-12. To launch another application, such as Web-based email, the user of the client computer selects an option from an interface on the IM client application. *Id.*, 5:24-34. The IM client application uses the "authentication ticket" it received to gain access to the Web server computer. *Id.*, 5:39-54. Because the problem addressed in Dharmarajan is so far attenuated from

the personal “virtual assistant” in Bodart and even further attenuated from the inventions recited in the Challenged Claims, a POSITA would not be motivated to combine Dharmarajan with Bodart. Ex. 2002, Akl Decl., ¶ 64.

(b) Petitioner’s reasons to combine lack merit

According to Petitioner, “[a] POSITA considering the teachings of Bodart would have also considered the teachings of Banister and Dharmarajan, as they are analogous and pertinent to the same field of endeavor,” which Petitioner claims is “providing users access to telephony and internet-based communications services such as IM and email.” Pet. at 9. But as discussed above, each of the three references are not analogous or pertinent to the same field of endeavor. Ex. 2002, Akl Decl., ¶ 53. Petitioner has not shown that any of these references is utilized by a telephone service provider. Ex. 2002, Akl Decl., ¶¶ 54-55, 58, 62. Indeed, it would be impractical for a telephone service provider, such as AT&T to “utilize” Bodart’s personal virtual assistant, especially when there is no reason to do so to “intercept” phone calls and instant messages on behalf of an individual user. Ex. 2002, Akl Decl., ¶ 56. There is also no reason for a telephone service provider to utilize Banister’s system of receiving emails and converting them to audio. Ex. 2002, Akl Decl., ¶ 58. If anything, Banister’s system is utilizing the telephone service and not the other way around. Ex. 2002, Akl Decl., ¶ 58. And Dhamarajan has nothing to do

with telephone service providers or providing a telephone user with additional services. Ex. 2002, Akl Decl., ¶ 62.

i. No reason to combine Bodart and Banister

Petitioner claims that a POSITA implementing Bodart’s personal “virtual assistant” would have been motivated to combine Banister’s “disclosure of maintaining lists of email addresses with associated telephone number” to provide the “email-reading functionality” discussed in the Background section of Bodart. Pet. at 20 (citing Ex. 1005, [0002]). Petitioner also argues that a POSITA would have been motivated to combine Banister’s telephone lookup functionality based on Bodart’s disclosure that, in response to an incoming call, the virtual assistant may “put contact 215 on hold and attempt to reach user 201 via . . . instant message.” Pet. at 22 (citing Ex. 1005, [0060]).

A POSITA would not be motivated to combine Banister with Bodart to arrive at the inventions recited in the Challenged Claims for several reasons. Ex. 2002, Akl Decl., ¶¶ 59-61. For one thing, a POSITA would understand that there would be no need to either (1) obtain the virtual assistant user’s telephone number either by parsing the recipient’s email address or looking up the phone number in a database or (2) associate and store the user’s IM/email username and phone number. Ex. 2002, Akl Decl., ¶¶ 60-61. Unlike the system of Banister, a POSITA would understand that Bodart’s virtual assistant is utilized by a single user and already knows the single

user's telephone number so that it can "forward a call" and "intercept a call." Ex. 1005, [0057], [0060]; Ex. 2002, Akl Decl., ¶ 60. And, as Petitioner acknowledges, the telephone number of the user is already associated with the virtual assistant. Pet. at 41. In contrast, the telephone number lookup in Banister is necessary because Banister's system is directed to multiple users. Ex. 2002, Akl Decl., ¶ 60.

Moreover, combining Banister's database or its functionality would be both unnecessary and inefficient because Bodart explains that "call routing" is handled by rules set up by the user or by default rules:

Virtual assistant 101 attempts to recognize contact 215 using caller ID (or some other system) and comparing the incoming number with the phone numbers of contacts in the user's database. If contact 215 is not recognized, then virtual assistant 101 may by default forward the contact to voicemail to leave a message 503. Alternatively, user 201 may set up rules to process the call differently, perhaps forwarding unrecognized callers to her secretary. If the contact 215 is recognized, then virtual assistant 101 may forward the call appropriately (according to predefined rules).

Ex. 1005, [0057]; *see also* Ex. 2002, Akl Decl., ¶ 61. And Bodart explains that the routing is based on the incoming phone number and not the virtual assistant user's telephone number. Ex. 2002, Akl Decl., ¶ 61. In other words, associating the virtual

assistant's (already known) telephone number with IM/email credentials would not arrive at the Challenged Claims because, *inter alia*, it is the caller's contact information that drives the decision of how to handle the incoming call and not the user's telephone number. Ex. 1005, [0057]; Ex. 2002, Akl Decl., ¶ 61.

ii. No reason to combine Bodart and Dharmarajan

Petitioner argues that it would have been obvious to combine Dharmarajan with Bodart because Dharmarajan discloses that “when a user launches the instant messaging client, the user may be required to provide a username and password,” and Bodart teaches “storing user accounts, including ‘email passwords [and] website passwords.’” Pet. at 24-25. Petitioner relies on this combination for the limitation “wherein the server is configured to: receive a request to provision a second service for the first user.” Pet. at 32. Petitioner claims that “[t]he user configuring the virtual assistant with a preferred IM application or platform, an IM username, and a password to enable the virtual assistant to login to the IM service is a ‘request to provision [the] second service,’” and that the virtual assistant “receives” this request because it “store[s] the preferred IM application or platform, username, and password provided by the user.” Pet. at 33.

A POSITA would not be motivated to combine Dharmarajan with Bodart to arrive at the inventions recited in the Challenged Claims for several reasons. Ex. 2002, Akl Decl., ¶¶ 62-64. For one, a POSITA would not look to Dharmarajan,

which discloses a technique in which a first server computer provides an authorization ticket that the client computer can use to access a second server, to modify Bodart, which discloses a personal “virtual assistant.” Ex. 2002, Akl Decl., ¶ 62. Bodart and Dharmarajan are incompatible. Ex. 2002, Akl Decl., ¶ 62.

Moreover, Petitioner has not shown that saving a user’s IM username and password is “provisioning.” Ex. 2002, Akl Decl., ¶¶ 65-66. The Challenged Claims require that, “responsive to receiving the request,” the “server” that is “utilized by a telephone service provider” (which Petitioner has not shown) (1) creates a mapping from the first telephone number to the second identifier, (2) activates the second service, and (3) associates the second service with the first telephone number. *See, e.g.*, Ex. 1001, cl. 1.

Petitioner has not shown that its combined system “creates a mapping,” “activates the second service,” or “associates the second service with the first telephone number,” “in response to” receiving a request to provision a second service. Ex. 2002, Akl Decl., ¶¶ 65-66. This is so because, as discussed above, even if Bodart stored the virtual user’s telephone number together with the IM username and password, this would not meet at least the “associating” limitation found in all the Challenged Claims because it is the user-set rule associated with caller’s contact information that establishes the routing and interworking to handle the incoming call and not the user’s telephone number. Ex. 1005, [0057]; Ex. 2002, Akl Decl., ¶ 66.

2. Petitioner Has Not Shown a Reasonable Expectation of Success in Reconfiguring Bodart with Banister and/or Dharmarajan.

Petitioner argues that the “result of the combination [of Bodart and Banister] would be a stored association between IM usernames and telephone numbers in the user data module.” Pet. at 23. But storing the virtual user’s telephone number together with the IM/email username and password does not meet the “provisioning” requirement at least because (1) Petitioner has not shown that the “mapping” or “associate[ing]” limitations occur in response to a request to provision and (2) it is the caller’s contact information that drives the decision of how to handle the incoming call and not the user’s telephone number. Ex. 1005, [0057]; Ex. 2002, Akl Decl., ¶ 66. Thus, Petitioner has not shown a reasonable expectation of success in reconfiguring Bodart with Banister and/or Dharmarajan to arrive at the Challenged Claims.

B. Petitioner Has Not Shown That Bodart in View of Banister and Dharmarajan Renders Obvious Claim 1

As discussed in Section VIII.A (incorporated by reference herein), Petitioner has not articulated any meaningful motivation to combine or a reasonable expectation of success to arrive at the Challenged Claims. For this and the reasons below, Ground 1 fails.

1. Claim Element [1.3]: “wherein the server is utilized by a first provider to provide a first service to a first user, wherein the first service is telephone service, and wherein the telephone service is associated with a first telephone number”

Patent Owner incorporates by reference herein Section VIII.A. Petitioner argues that Bodart’s virtual assistant 101 “includes a ‘server’ [that is] ‘utilized’ to provide ‘telephone service’ (e.g., receiving and directing telephone calls) to the user 201 (‘a first user’).” Pet. at 31. Petitioner also argues that the telephone service provider (“a first provider”) is a telephone carrier company, “such as AT&T, Verizon, and Sprint, which were well known telephone service providers.” *Id.* But the claims require that the “server” is utilized by a first provider. See, e.g., Ex. 1001, cl. 1.

Nothing in the Petition or in Petitioner’s expert declaration shows that Bodart’s purported “server” is “utilized by” a telephone carrier company, “such as AT&T, Verizon, and Sprint.” Ex. 2002, Akl Decl., ¶¶ 54-55. Petitioner appears to recognize this discrepancy because it argues that the server “is ‘utilized’ to provide ‘telephone service,’” and not that the server is “utilized by” a first provider. Pet. at 31. That the virtual assistant can “receive and direct calls” does not change this. Ex. 2002, Akl Decl., ¶ 55. Indeed, it would be impractical for a telephone service provider, such as “AT&T, Verizon, and Sprint” to “utilize” Bodart’s personal virtual assistant, especially when a POSITA would understand that there is no reason to do so to “intercept” and “forward” phone calls and instant messages on behalf of

individual users. Ex. 2002, AkI Decl., ¶ 56. A POSITA would further understand that “intercepting” and “forwarding calls” is not providing a telephone service to a first user by a “telephone service provider.” Ex. 2002, AkI Decl., ¶ 55.

For at least these reasons, Petitioner has not shown that Bodart teaches or renders obvious limitation [1.3].

2. Claim Element [1.4]: “wherein the server is configured to: “receive a request to provision a second service for the first user,”

As discussed in Sections VIII.A and VIII.B.1 (incorporated by reference herein), Petitioner has not shown that a POSITA would be motivated to combine Bodart and Dharmarajan or that Bodart teaches or renders obvious a “server” that is “utilized by a first provider.” For this reason alone, Petitioner cannot show “wherein the server is configured to: “receive a request to provision a second service for the first user,” and thus Ground 1 fails.

Moreover, Petitioner has not shown that Bodart in view of Dharmarajan teaches or renders obvious the “request to provision a second service.” According to Petitioner, the “request to provision” occurs when the user reconfigures Bodart’s personal virtual assistant “with a preferred IM platform, an IM username, and a password” based on combining Dharmarajan’s disclosure of providing an IM username and password upon login, or when the user configures the virtual assistant’s user data module with email server settings based on the knowledge of a

POSITA (Pet. at 33), so that the virtual assistant can “handle IMs” (Pet. at 32) and “access” and “search” emails (Pet. at 34).

Petitioner has not shown that either saving login information and contact information, such as a telephone number, or using saved login information and contract information to “access” or “search” emails, is a “request to provision” as recited in the Challenged Claims. Ex. 2002, Akl Decl., ¶ 65. The “request to provision” requires the subsequent steps of: (1) creating a mapping; (2) activating the service; and (3) associating the second service with the first telephone number, which Petitioner has not shown occurs, let alone occurs in response to, the purported storing login information and telephone numbers. Ex. 2002, Akl Decl., ¶ 65.

A POSITA would understand from Bodart’s disclosures that the user-set rules determine how to route calls, IMs, and emails based on the caller’s contact information, and not on the virtual user’s telephone number. Ex. 2002, Akl Decl., ¶ 61; Ex. 1005, [0024], [0057]. In other words, Petitioner has not shown that the “mapping” or “associate[ing]” limitations occur in response to saving login information together with the virtual assistant user’s telephone number because it is the caller’s contact information that drives the decision of how to handle the incoming call in Bodart and not the user’s telephone number. Ex. 2002, Akl Decl., ¶¶ 65-67.

3. Claim Element [1.5]: “wherein the second service is provided by a second provider, and wherein the second provider is different than the first provider;”

As discussed in Sections VIII.A and VIII.B.1-2 (incorporated by reference herein), Petitioner has not shown motivation to combine Bodart and Dharmarajan or that Bodart and/or Bodart in view of Dharmarajan teaches or renders obvious (1) a “server” that is “utilized by a first provider to provide a first service to a first user, wherein the first service is telephone service” and/or (2) “wherein the server is configured to: receive a request to provision a second service for the first user.” For these reasons alone, Petitioner cannot show “wherein the second service is provided by a second provider, and wherein the second provider is different than the first provider.”

4. Claim Element [1.6]: “responsive to receiving the request: create a mapping from the first telephone number to a second identifier (ID), wherein the second ID is utilized by the second provider to identify the first user;”

Patent Owner incorporates by reference herein Sections VIII.A and VIII.B.1-2.

According to Petitioner, “it would have been obvious to incorporate Banister’s database of telephone numbers mapped to electronic addresses to facilitate Bodart’s two different types of communication identifiers (e.g., IM username and telephone number)” to “facilitate the virtual assistant notifying the user by IM about [an] incoming call.” Pet. at 36-37. Incorporating Banister’s database into Bodart’s virtual

assistant does not show that any “mapping” is done “**responsive to**” receiving a request to provision a second service as required by the Challenged Claims. Ex. 2002, Akl Decl., ¶¶ 59-61. As explained in Section VIII.A, there would be no need to include Banister’s database because Bodart explains that “call routing” is handled by rules set up by the user or by default rules and is based on the caller’s telephone number. Ex. 1005, [0057]; Ex. 2002, Akl Decl., ¶ 61.

Petitioner also argues that Bodart’s virtual assistant can “create a mapping” from the virtual assistant’s telephone number “when the user configures the virtual assistant with email account information.” Pet. at 39. But, as discussed above, a POSITA would understand that the virtual assistant already knows the user’s telephone number (Ex. 2002, Akl Decl., ¶ 56), and the user-set rules determine how to route IM and emails (Ex. 1005, [0024]).

5. Claim Element [1.7]: responsive to receiving the request: “activate the second service with the second provider utilizing the second ID as a user ID for the first user; and”

As discussed in Sections VIII.A and VIII.B.1-2 (incorporated by reference herein), Petitioner has not shown motivation to combine Bodart and Banister and/or Dharmarajan or that Bodart and/or Bodart in view of Banister and/or Dharmarajan teaches or renders obvious (1) a “server” that is “utilized by a first provider to provide a first service to a first user, wherein the first service is telephone service” and/or (2) “wherein the server is configured to: receive a request to provision a

second service for the first user.” For these reasons alone, Petitioner cannot show that the “server” is configured to, responsive to receiving the request: “activate the second service with the second provider utilizing the second ID as a user ID for the first user.”

6. **Claim Element [1.8]: responsive to receiving the request: “associate the second service with the first telephone number, wherein the first telephone number is associated with routing and interworking data necessary to utilize the second service.”**

Patent Owner incorporates by reference herein Sections VIII.A and VIII.B.1-2.

Petitioner argues that it would have been obvious for Bodart’s virtual assistant to use stored rules associating the IM service with “the first telephone number” in order send an IM to the user when the virtual assistant “intercepts a call to a telephone number associated with the user.” Pet. at 41. Petitioner also argues that the “virtual assistant 101 may attempt to send a text or email to user 201 to determine the user’s availability to take a particular call.” Pet. at 42.

But as explained in Section VIII.A, the handling of an incoming call to the virtual assistant is based on user-set rules and is determined by the caller’s number—not the telephone number of the virtual assistant user. Ex. 1005, [0057], [0061-0064]; Ex. 2002, Akl Decl., ¶ 61. A POSITA would understand that the virtual assistant already knows the telephone number of the virtual assistant user because it

can “intercept” calls to that number and handle them according to the user-set rules. Ex. 2002, Ak1 Decl., ¶ 56. In other words, it is the **caller’s number** that is “associated with routing and interworking” and **not the “first telephone number”** of the virtual assistant. Ex. 2002, Ak1 Decl., ¶ 56.

C. Petitioner Has Not Shown That Bodart in View of Banister and Dharmarajan Renders Obvious Dependent Claims 2 and 6

For the reasons discussed in Sections VIII.A and VIII.B (incorporated by reference herein), Petitioner has not shown that Bodart in view of Banister and/or Dharmarajan teaches or renders obvious claims 2 and 6, which depend from claim 1.

D. Petitioner Has Not Shown That Bodart in View of Banister and Dharmarajan Renders Obvious Independent Claim 7

Petitioner states that limitations [7.1]-[7.5] are purportedly rendered obvious “for the same reasons discussed above” with reference to limitations [1.2]-[1.8]. Pet. at 46-47. Petitioner argues that limitation [7.0] is met because Bodart teaches “[s]ystems and methods for assisting a user with a variety of tasks.” Pet. at 47.

Unlike independent claim 1, independent claim 7 does not recite a “server.” However, claim 7 requires “provid[ing] a first service to a first user by a first provider, wherein the first service is telephone service.” Ex. 1001, cl. 7. And, according to Petitioner, “a first provider” is a “telephone carrier company[], such as “AT&T, Verizon, and Sprint.” Pet. at 31. A POSITA would understand that Bodart’s virtual assistant’s ability to “forward” and “intercept” calls is not a “telephone

service” that is provided by “a first provider,” such as “AT&T, Verizon, and Sprint.” Ex. 2002, Akl Decl., ¶ 56.

For these and the reasons discussed in Sections VIII.A and VIII.B (incorporated by reference herein), Petitioner has not shown that Bodart in view of Banister and/or Dharmarajan teaches or renders obvious claim 7.

E. Petitioner Has Not Shown That Bodart in View of Banister and Dharmarajan Renders Obvious Dependent Claims 8 and 12

For the reasons discussed in Sections VIII.A and VIII.B (incorporated by reference herein), Petitioner has not shown that Bodart in view of Banister and/or Dharmarajan teaches or renders obvious claims 8 and 12, which depend from claim 7.

F. Petitioner Has Not Shown That Bodart in View of Banister and Dharmarajan Renders Obvious Independent Claim 13

Petitioner states that limitations [13.1]-[13.5] are purportedly rendered obvious “for the same reasons discussed above” with reference to limitations [1.2]-[1.8]. Pet. at 48. Petitioner argues that limitation [13.0] is met because Bodart describes a “‘virtual assistant 101,’ which may be implemented as ‘software.’” Pet. at 47.

Unlike independent claim 1, independent claim 13 does not recite a “server.” However, claim 13 requires “program instructions” that are operable to “provide a first service to a first user by a first provider, wherein the first service is telephone

service.” Ex. 1001, cl. 13. And, according to Petitioner, “a first provider” is a “telephone carrier company[y], such as “AT&T, Verizon, and Sprint.” Pet. at 31. A POSITA would understand that Bodart’s virtual assistant’s ability to “forward” and “intercept” calls is not a “telephone service” that is provided by “a first provider,” such as “AT&T, Verizon, and Sprint.” Ex. 2002, Akl Decl., ¶ 56.

For these and the reasons discussed in Sections VIII.A and VIII.B (incorporated by reference herein), Petitioner has not shown that Bodart in view of Banister and/or Dharmarajan teaches or renders obvious claim 13.

G. Petitioner Has Not Shown That Bodart in View of Banister and Dharmarajan Renders Obvious Dependent Claim 14

For the reasons discussed in Sections VIII.A and VIII.B (incorporated by reference herein), Petitioner has not shown that Bodart in view of Banister and/or Dharmarajan teaches or renders obvious claim 14, which depends from claim 13.

IX. GROUND 2: PETITIONER HAS FAILED TO SHOW THAT DE CASTRO RENDERS OBVIOUS CLAIMS 1-2, 6-8, AND 12-14

Petitioner relies on de Castro to render obvious the Challenged Claims of the ’254 Patent in Ground 2. For the reasons discussed below, Petitioner has not established a reasonable likelihood of success that de Castro renders obvious any of the Challenged Claims. Ground 2 thus fails.

A. Claim 1

1. **Claim Element [1.3]: “wherein the server is utilized by a first provider to provide a first service to a first user, wherein the first service is telephone service, and wherein the telephone service is associated with a first telephone number”**

Petitioner argues that “customer 1” is the “first provider” because it has “the scripting engines 600 host and process an application script such as App Script 1 610-1” (Pet. at 57 (citing Ex. 1008, [0119])), and “App Server-1 (‘server’) provides ‘application clients 40’ (‘a first user’) with access to the application of app script 1 (‘the server . . . provide[s] a first service to a first user’)” (*id.*). Petitioner further argues that de Castro’s disclosure of “providing a telephony-enabled service via a message-based API interface” purportedly shows that the “first service is [a] telephone service.” Pet. at 60. None of Petitioner’s arguments has merit.

The “telephony-enabled service” referenced in [0002] refers to de Castro’s system as a whole and does not relate specifically to “customer 1” or “App Script 1 610-1.” And consistent with Petitioner’s arguments in Ground 1, a POSITA would understand that neither de Castro’s “telephony-enabled service” as a whole nor the “customer 1” is a telephone service provider, “such as AT&T, Verizon, and Sprint.” Pet. at 31; *see also* Ex. 2002, Akl Decl., ¶ 70. Rather, a POSITA would understand that the “telephony-enabled service” provides third-party call and media control between any numbers of clients, and the application script directs how the call/media is to be handled by issuing commands “for invoking the class objects relative to a

call.” Ex. 1008, [0135]. Ex. 2002, Akl Decl., ¶ 70. Issuing or executing commands for invoking class objects relative to a call is not a “telephone service.” Ex. 2002, Akl Decl., ¶ 70.

A POSITA would further understand that “customer 1” is not a “provider,” let alone the “first provider” that provides the “telephone service” recited in the Challenged Claims. Ex. 2002, Akl Decl., ¶ 71. Rather, “customer 1” is an application developer who codes application scripts with the user’s preferred programming languages and protocols for purposes of issuing commands for invoking and manipulating the class objects relative to a call. Ex. 1008, [0037]; [0041] (“A customer using the communication services can code the application script in a preferred programming language using a custom framework providing a set of customer-specific libraries”), [0135]; Ex. 2002, Akl Decl., ¶ 71.

A POSITA would further understand that the App Script 1 is not a “telephone service”/“first service” provided to a first user because it is not “associated with the first telephone number.” Ex. 2002, Akl Decl., ¶ 72 According to Petitioner, the “first telephone number” is purportedly either “the dialed number or the dialing-user’s number.” Pet. at 60. But de Castro explicitly teaches that a user is “able to access a **specific communication application by calling a dialed number or a URL,**” and “[t]he routing [**to a specific communication application server only, and not to a specific app script**] is performed by looking up a directory service DIR0 16 with

the **IP address/dialed number** in order to return the address of the communication application server executing the specific communication application.” Ex. 1008, [0116]; Ex. 2002, Akl Decl., ¶ 73.

Components of the API gateway determine **through mediation** the pairing of the communication application and the scripting engine (and associated app scripts) based on several factors, such as “the property and status associated with each communication application server 200 and the properties and status associated with each API client[] 630.” Ex. 1008, [0129], [0130]. Ex. 2002, Akl Decl., ¶ 74. A POSITA would understand from these disclosures that neither the “dialing-user’s number” nor the “dialed number” is associated with the selection of any specific application script, and thus neither is the “first telephone number” recited in the Challenged Claims. Ex. 2002, Akl Decl., ¶ 74. And because the pairing of the communication application and the scripting engine is determined through mediation (**and not from any telephone number**), a POSITA would understand that App Server 1 is not “utilized by” customer 1. Ex. 2002, Akl Decl., ¶ 74.

Finally, Petitioner’s argues that de Castro’s disclosure of utilizing the XMPP protocol/Rayo protocol, and specifically de Castro’s disclosure of including the caller’s telephone number for an incoming call event, in the exchange of messaging between the scripting engine and the application server renders obvious “wherein the telephone service is associated with a first telephone number. Pet. at 60-61. This

argument lacks merit.

The bidirectional messaging using the XMPP protocol facilitates the exchange of messaging between the application scripts and the communication application server so that “application scripting is decoupled from the operation of the communication application server, which only needs to focus on providing basic communication services. Ex. 1008, [0040], [0041]; Ex. 2002, Akl Decl., ¶ 76. In other words, the use of the XMPP protocol is simply an attempt to shield the third-party scripting engines from the low-level telephony protocol used by the communication application servers. Ex. 2002, Akl Decl., ¶ 76.

More specifically, the use of the XMPP protocol allows third party scripting engines to perform scripting “in a preferred programming language using a custom framework,” and the resulting execution codes exchanged between the scripting engine and the communication application server need only “be expressed in terms of the finite set of commands and sent as [XMPP/Rayo] messages to operate the communication application server.” Ex. 1008, [0041]; Ex. 2002, Akl Decl., ¶ 77. The call/media control messages from the scripting engine necessarily need to include information about incoming call events, including the “dialing-user’s number” and the “dialed number,” to issue commands “for invoking and manipulating the class objects relative to a call.” Ex. 1008, [0135]; Ex. 2002, Akl Decl., ¶ 78. But, as explained above, these “command messages” do not affect the

routing of a call or the selection of a particular application script, such as App Script l or App Script k, because, *inter alia*, the API gateway determines the pairing of the communication application and the scripting engine through mediation and not based on either the caller's or the callee's telephone number. Ex. 2002, Akl Decl., ¶ 78.

For at least these reasons, Petitioner has not shown that de Castro teaches or renders obvious limitation [1.3].

2. Claim Element [1.4]: “wherein the server is configured to: receive a request to provision a second service for the first user,”

Petitioner argues that “App Script l is the “first service” and “App Script k” is the “second service,” and that the “request to provision” limitation is purportedly met when “one of the application servers 200 (‘server’) receiv[es], from an application client (‘first user’), a call to access one of the communication applications.” Pet. at 61.

As discussed in Section IX.A.1 (incorporated by reference herein), Petitioner has not shown that de Castro teaches or renders obvious (1) a “first service,” (2) “the telephone service is associated with the first service,” and/or (3) that any particular “app script” is selected by or associated with either the caller's or callee's phone

number. For this reason alone, Petitioner has not shown that de Castro teaches limitation [1.4].

Moreover, that the “App servers 200 receive a routed call” does not teach “a request to provision a second service for the first user” or “provide a client access to [a specific] App Script.” Pet. at 62. As discussed above, “[t]he routing [**to a specific communication application server only, and not to a specific app script**] is performed by looking up a directory service DIR0 16 with the **IP address/dialed number** in order to return the address of the communication application server executing the specific communication application.” Ex. 1008, [0116]; Ex. 2002, Akl Decl., ¶ 73. And, components of the API gateway determine **through mediation** the pairing of the communication application and the scripting engine (and associated app scripts) based on several factors, such as “the property and status associated with each communication application server 200 and the properties and status associated with each API client[] 630.” Ex. 1008, [0129], [0130]. Ex. 2002, Akl Decl., ¶ 74.

For at least these reasons, Petitioner has not shown that “a call from a client 40” is “a request to provision a second service for the first user.”

3. Claim Element [1.5]: “wherein the second service is provided by a second provider, and wherein the second provider is different than the first provider;”

As discussed in Section IX.A.2 (incorporated by reference herein), Petitioner has not shown that de Castro teaches or renders obvious “wherein the server is

configured to: receive a request to provision a second service for the first user.” For this reason alone, Petitioner has not shown that de Castro teaches limitation [1.5].

4. Claim Element [1.6]: “responsive to receiving the request: create a mapping from the first telephone number to a second identifier (ID), wherein the second ID is utilized by the second provider to identify the first user;”

As discussed in Section IX.A.2 (incorporated by reference herein), Petitioner has not shown that de Castro teaches or renders obvious “wherein the server is configured to: receive a request to provision a second service for the first user.” Thus, Petitioner cannot show that any purported “mapping” is done “responsive to receiving the request.” For at least these reasons, Petitioner has not shown that de Castro teaches or renders obvious limitation [1.6].

5. Claim Element [1.7]: responsive to receiving the request: “activate the second service with the second provider utilizing the second ID as a user ID for the first user; and”

As discussed in Section IX.A.2 (incorporated by reference herein), Petitioner has not shown that de Castro teaches or renders obvious “wherein the server is configured to: receive a request to provision a second service for the first user.” Thus, Petitioner cannot show that any purported “activating” is done “responsive to receiving the request.” For at least these reasons, Petitioner has not shown that de Castro teaches or renders obvious limitation [1.7].

6. **Claim Element [1.8]: responsive to receiving the request: “associate the second service with the first telephone number, wherein the first telephone number is associated with routing and interworking data necessary to utilize the second service.”**

As discussed in Section IX.A.2 (incorporated by reference herein), Petitioner has not shown that de Castro teaches or renders obvious “wherein the server is configured to: receive a request to provision a second service for the first user.” Thus, Petitioner cannot show that any purported “associating” is done “responsive to receiving the request.”

Petitioner’s argument that storing the caller’s phone number with the JID in the call ID registry purportedly renders obvious “wherein the first number is associated with routing and interworking data necessary to utilize the second service” lacks merit. Pet. at 68. As discussed above, “[t]he routing [**to a specific communication application server only, and not to a specific app script**] is performed by looking up a directory service DIR0 16 with the **IP address/dialed number** in order to return the address of the communication application server executing the specific communication application.” Ex. 1008, [0116]; Ex. 2002, Akl Decl., ¶ 73. And, components of the API gateway determine **through mediation** the pairing of the communication application and the scripting engine (and associated app scripts) based on several factors, such as “the property and status associated with each communication application server 200 and the properties and status associated

with each API client[] 630.” Ex. 1008, [0129], [0130]. Ex. 2002, Akl Decl., ¶ 74. Thus, Petitioner has not shown that either the “client’s phone number” or the JID is associated with “a request to provision,” or the “routing and interworking” necessary to utilize any app script. Ex. 2002, Akl Decl., ¶¶ 74, 76-79.

Rather, the call ID registry is used locally by the communication application server to register received calls. Ex. 1008, [0124]. de Castro explains that “[a]s command messages from the API clients 630 are received by the application server 200, they are identified with a call actor and queued in an associated message queue 272, which are then applied to the call in order.” *Id.* The API server parses out the command in each message for execution in turn on the associate call actor. *Id.* In other words, the JID allows the Rayo server (e.g., App Server 1) and the Rayo client (e.g., Scripting Engine 600-1) to associate the call/media control commands with a particular call when exchanging internal messaging. Ex. 2002, Akl Decl., ¶ 79. But, as explained above, the “routing and interworking” to “utilize” a particular app script is done through mediation by the API gateway and is not based on either the JID or the “client’s phone number.” Ex. 2002, Akl Decl., ¶ 79.

For at least these reasons, Petitioner has not shown that de Castro teaches or renders obvious limitation [1.8].

B. Petitioner Has Not Shown That de Castro Renders Obvious Dependent Claims 2 and 6

For the reasons discussed in Section IX.A (incorporated by reference herein), Petitioner has not shown that de Castro teaches or renders obvious claims 2 and 6, which both depend from claim 1.

C. Petitioner Has Not Shown That de Castro Renders Obvious Independent Claim 7

Petitioner states that limitations [7.1]-[7.5] are purportedly rendered obvious “for the same reasons discussed above” with reference to limitations [1.2]-[1.8] with the exception of claim 7’s preamble [7.0]. Pet. at 72-73. Petitioner argues that limitation [7.0] is met because de Castro “discloses that a server performs the method of Fig. 20 to provide services to clients or users.” Pet. at 73. For the same reasons discussed in Section IX.A (incorporated by reference herein), Petitioner has not shown that de Castro teaches or renders obvious claim 7.

D. Petitioner Has Not Shown That de Castro Renders Obvious Dependent Claims 8 and 12

For the reasons discussed in Section IX.A (incorporated by reference herein), Petitioner has not shown that de Castro teaches or renders obvious claims 8 and 12, which both depend from claim 7.

E. Petitioner Has Not Shown That de Castro Renders Obvious Independent Claim 13

Petitioner states that limitations [13.1]-[13.5] are purportedly rendered

obvious “for the same reasons discussed above” with reference to limitations [1.2]-[1.8] with the exception of claim 13’s preamble [13.0]. Pet. at 74-75. Petitioner argues that limitation [13.0] is met because “[i]t would have been obvious to a POSITA that de Castro’s App server would include a “non-transitory computer readable storage medium comprising program instructions.” Pet. at 75. For the same reasons discussed in Section IX.A (incorporated by reference herein), Petitioner has not shown that de Castro teaches or renders obvious claim 13.

F. Petitioner Has Not Shown That de Castro Renders Obvious Dependent Claim 14

For the reasons discussed in Section IX.A (incorporated by reference herein), Petitioner has not shown that deCastro teaches or renders obvious claim 14, which depends from claim 13.

X. THE BOARD SHOULD DENY INSTITUTION OF THIS PETITION UNDER 35 U.S.C. § 314(a)

Under § 314(a), the Director has discretion to deny institution. *NHK Spring Co. v. Intri-Plex Technologies, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential). *Fintiv* sets forth six non-exclusive factors for determining “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Apple*

Inc. v. Fintiv Inc., IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020)

(precedential). These factors include:

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 grounds raised in the Petition.

Id.

According to the Memorandum from Director Vidal dated June 21, 2022, “compelling, meritorious challenges will be allowed to proceed at the PTAB even where district court litigation is proceeding in parallel. Compelling, meritorious challenges are those in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Ex. 1027 at 4. Moreover, “[w]hen a petitioner stipulates not to pursue in

a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition, it mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB.” *Id.* at 7 (citation omitted).

Here, the *Fintiv* factors favor denial of institution of this Petition, and Petitioner has not presented compelling evidence of unpatentability. Nor has Petitioner provided a sufficient stipulation that it will not pursue in the Texas litigation “any grounds that could have reasonably been raised in the petition.” *Id.* (emphasis added).

As such, the Board should deny institution of this Petition under § 314(a).

A. Factor 1 is Neutral as No Court Has Granted a Stay and No Evidence Exists That a Stay May Be Granted

Regarding Factor 1, the parallel district court proceeding has not been stayed and no evidence exists that a stay may be granted if trial is instituted. The parallel district court proceeding includes three other U.S. patents besides the ’254 Patent. Petitioner has never moved for a stay. The issues raised in the Petition are already presented, and are already being litigated, in the United States District Court for the Eastern District of Texas in Case No. 2:19-CV-225-JRG (“Texas litigation”). Factor 1 is thus neutral at best. *See, e.g., Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, No. IPR2020-00123, 2020 WL 2511247, at *3 (P.T.A.B. May 15, 2020)

(finding factor 1 to be neutral where “there is little evidence to suggest that the district court will grant a stay, should another one be requested”).

B. Factors 2 and 5 Weigh in Favor of Denying Institution

As to factors 2 and 5, Petitioner is the defendant in the Texas litigation (Pet. at 79, 82), the *Markman* hearing is set to take place on July 14, 2023,³ and jury selection is scheduled to begin January 22, 2024 (Ex. 1024). The final written decision in this case is expected around September 29, 2024. Thus, the district court’s trial is scheduled to precede the Board’s anticipated final written decision on the same asserted art by more than eight months.

This timing is similar to that in *NHK* where the Board noted a six-month difference between a scheduled trial date and the deadline for the Board’s written decision. *NHK*, IPR2018-00752, Paper 8 at 20; *see also GlobalFoundries Inc. v. UNM Rainforest Innovations*, IPR2020-00984, Paper 11, at *11-16 (PTAB Dec. 9, 2020) (finding that a scheduled trial date four months before the statutory deadline for a final written decision was a factor weighing in favor of discretionary denial); *NanoCollect Biomedical, Inc. v. Cytonome/ST, LLC*, IPR2020-00551, Paper 19, at *16 (PTAB Aug. 27, 2020) (same); *Intel Corp. v. LLC*, No. IPR2020-00583,

³ The district court reset the claim construction hearing from July 13, 2023, to July 14, 2023, on May 16, 2023.

2021 WL 531706, at *2 (P.T.A.B. Feb. 11, 2021) (“Thus, at this time, it appears likely that trial will occur many months before any final written decision would likely issue in this proceeding. Therefore, we maintain our finding that *Fintiv* Factor 2 (proximity of the court's trial date to the Board's projected statutory deadline for a final written decision) weighs in favor of exercising our discretion to deny institution pursuant to 35 U.S.C. § 314(a).”).

Just like in *NHK*, instituting trial under the facts and circumstances here would be an inefficient use of Board resources. *See NHK*, IPR2018-00752, Paper 8 at 20 (finding under similar circumstances that institution “would not be consistent with ‘an objective of the AIA . . . to provide an effective and efficient alternative to district court litigation’”).

Petitioner’s contention that Factor 2 “weighs slightly against discretionary denial, or at the very least is neutral” based on the median time-to-trial statistics for the Eastern District of Texas lacks merit. Pet. at 77-78. The Memorandum from Director Vidal dated June 21, 2022, instructs only that “the proximity to trial should not alone outweigh” other factors. Ex. 1027 at 8. As shown herein, other factors besides Factor 2 weigh in favor of denial, such as Factors 3, 4, 5, and 6, and no factors favor declining to exercise the Board’s discretion to deny institution. Moreover, based on the median time-to-trial in the Eastern District of Texas (24.5 months), trial would take place around June 4, 2024 (May 20, 2022 + 24.5 months).

Trial would thus still occur more than three months prior to the expected September 29, 2024, final written decision.

Factors 2 and 5 thus weigh in favor of denying institution.

C. Factor 3 Weighs in Favor of Denying Institution, as the Parties and the District Court in the Eastern District of Texas Litigation Have Already Invested Significant Time and Resources

By the time the Board’s institution decision is likely to issue in late September 2023, the Parties and the district court will have already expended considerable time and resources. For example, the district court will have already conducted the July 14, 2023, claim construction hearing, and fact discovery will have been completed on September 5, 2023. Ex. 1024 at 3; *see also Google LLC v. Personalized Media Commc’ns, LLC*, No. IPR2020-00720, 2020 WL 6530766, at *2 (P.T.A.B. Nov. 5, 2020) (recognizing that “*Fintiv* holds that a district court’s investment in issuing a claim construction order weighs toward, not against, exercising discretion to deny institution”). Expert discovery is expected to be completed on October 10, 2023, just a few days after the expected institution decision, and the deadline to file dispositive motions follows shortly thereafter on October 16, 2023. Ex. 1024 at 3.

Based on the significant time and resources the parties have already expended and will likely have expended by the time of the expected decision on institution, Factor 3 weighs in favor of denying institution.

D. Factor 4 Weighs in Favor of Denying Institution Given the Overlap in Arguments Presented in the Petition and in the Texas Litigation and Because Petitioner has not Adequately Mitigated Concerns of Potentially Conflicting Decisions and Duplication of Efforts

As to factor 4, Petitioner presents overlapping arguments in the Texas litigation and in the Petition. Petitioner's invalidity contentions in the Texas litigation contain similar proposed grounds for invalidity as are presented in the Petition for the Challenged Claims. Compare Pet. at 13 (asserting claims 1-2, 6-8, and 12-14 are unpatentable as obvious by Bodart in view of Banister and Dharmarajan) with Ex. 2003 (asserting claims 1-2, 6-8, and 12-14 are unpatentable as anticipated and/or obvious based on Bodart "alone and/or in combination with other references"); *see also* Pet. at 13 (asserting claims 1-2, 6-8, and 12-14 are unpatentable as obvious over de Castro) with Ex. 2004 (asserting claims 1-2, 6-8, and 12-14 are unpatentable as anticipated and/or obvious over de Castro).

Despite this overlap, Petitioner claims "[t]here will be no overlap of prior art issues" and purports to stipulate that "if the Board institutes trial, Petitioner will cease asserting in the co-pending litigation the combination of references on which trial is instituted for the claims, to the extent Petitioner even asserts the same combination in the district court." Pet. at 79. Petitioner's "stipulation" is insufficient to alleviate any concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB because Petitioner fails to stipulate that it

will not pursue “any grounds that could have reasonably been raised in the petition.”⁴ Ex. 1027 at 7 (emphasis added); *see also Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020- 01019, Paper 12 at 19 (stating that a “Sotera” stipulation “ensures that an *inter partes* review is a ‘true alternative’ to the district court proceeding”); *Roku, Inc. v. IOENGINE, LLC*, IPR2022-01551 (P.T.A.B. May 5, 2023), Paper 10 at 17-18 (exercising discretion to deny institution based on, *inter alia*, “the late state of the parallel district court proceeding” and petitioner’s failure to submit a *Sotera*-type stipulation “that would make discretionary denial inappropriate”).

Factor 4 thus weighs in favor of denying institution.

E. Factor 6 Weighs Against Institution as Petitioner Has Not Shown a Reasonable Likelihood That It Would Prevail on Ground 1 and/or Ground 2

Factor 6 considers other circumstances that impact the Board’s exercise of discretion. According to Petitioner, Factor 6 weighs against denial “[i]n view of the striking similarities between the ’254 patent claims and both the Bodart and de Castro primary prior art references.” Pet. at 80. But as shown above, Petitioner has failed to show a reasonable likelihood that it would prevail on either Ground 1 or Ground 2.

Thus, to the extent Factor 6 takes into account the merits of Petitioner’s

⁴ Even if it did, Factors 2, 3, 5, and 6 would still favor denial.

claims, Factor 6 weighs in favor of denial.

XI. CONCLUSION

For the reasons stated above, Patent Owner respectfully asks the Board to deny institution of IPR2023-00553.

Dated: June 29, 2023

Respectfully submitted,

/Theresa M. Dawson/

Pro hac vice pending

CERTIFICATE OF WORD COUNT UNDER 37 C.F.R. § 42.24(b)(1)

I, the undersigned, do hereby certify that the foregoing Patent Owner Preliminary Response, including footnotes, contains no more than 14,000 words, as measured by the Word Count function of Microsoft Word as specified by 37 C.F.R. § 42.24(b)(1).

/Theresa M. Dawson/

CERTIFICATE OF SERVICE

I hereby certify that on this 29th day of June 2023, a true and correct copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE was served by electronic mail upon the following counsel of record for Petitioners:

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