

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 NOTICE OF APPEAL

Pursuant to 35 U.S.C. §§ 141 and 142, and 37 C.F.R. §§ 90.2 and 90.3, Patent Owner Zilkr Cloud Technologies, LLC (“Patent Owner”) hereby provides notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Final Written Decision entered September 18, 2024 (Paper 32) and from all underlying findings, orders, decisions, rulings, and opinions, including without limitation, the institution decision entered September 21, 2023 (Paper 11).

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Patent Owner states that the issues for appeal include, but are not limited to:

- the Patent Trial and Appeals Board (“Board”) determinations in the institution decision that there is a reasonable likelihood that claims 1, 2, 6-8, and 12-14 of U.S. Patent No. 9,210,254 (“the ’254 patent”) are unpatentable and the Board’s subsequent determination that claims 1, 2, 6-8, and 12-14 of the ’254 patent are unpatentable;
- the Board’s determination that claims 1, 2, 6-8, and 12-14 of the ’254 patent would have been obvious under 35 U.S.C. § 103 over Bodart¹, Banister², and Dharmarajan³;
- the Board’s claim constructions, failure to construe terms, and/or

¹ U.S. Patent Application Publication No. US 2007/0043687 A1.

² U.S. Patent No. 6,621,892 B1.

³ U.S. Patent No. 7,089,585 B1.

determination of the level of ordinary skill in the art at the time of the invention;

- the Board’s consideration and analysis of the expert testimony, prior art, and other evidence in the record;
- the Board’s factual findings, conclusions of law, or any other findings or determinations supporting or related to the aforementioned issues, as well as all other issues decided adversely to Patent Owner in any order, decision, ruling, or opinion.

Pursuant to 35 U.S.C. § 142 and 37 C.F.R. § 90.2(a), this Notice is being filed with the Director of the United States Patent and Trademark Office. Simultaneous with this submission, a copy of this Notice is being filed with the Patent Trial and Appeal Board. In addition, a copy of this Notice, along with the required docketing fees, is being filed with the Clerk’s office of the United States Court of Appeals for the Federal Circuit.

Dated: November 19, 2024

Respectfully submitted,

By: /Jeffrey Stephens/
Jeffrey Stephens
Reg. No. 56,254
Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Notice of Appeal was filed with the Director by electronic mail to the email address indicated on the United States Patent and Trademark Office's web page for the Office of the General Counsel: efileSO@uspto.gov (see <https://www.uspto.gov/about-us/organizational-offices/office-general-counsel>, last accessed Nov. 19, 2024).

A copy of the Notice of Appeal was also filed (1) with the Patent Trial and Appeal Board through the Board's electronic filing system, and (2) with the United States Court of Appeals for the Federal Circuit through the Court's CM/ECF filing system, along with any required fee.

The undersigned certifies that a copy of this Notice of Appeal was served on the below date via email on counsel of record for Petitioners:

Theodore M. Foster
ipr.theo.foster@haynesboone.com
David L. McCombs
david.mccombs.ipr@haynesboone.com
Eugene Goryunov
eugene.goryunov.ipr@haynesboone.com
Brett Bostrom
brett.bostrom.ipr@haynesboone.com

Dated: November 19, 2024

/Jeffrey Stephens/

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

ZILKR CLOUD TECHNOLOGIES, LLC,
Patent Owner.

IPR2023-00553
Patent 9,210,254 B2

Before KRISTEN L. DROESCH, KEVIN C. TROCK, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

We have authority to hear this *inter partes* review under 35 U.S.C. § 6. This Final Written Decision issues pursuant to 35 U.S.C. § 318(a) (2018) and 37 C.F.R. § 42.73 (2019). For the reasons discussed herein, we determine that Petitioner, Cisco Systems, Inc. (“Petitioner” or “Cisco”) has shown by a preponderance of the evidence that claims 1, 2, 6–8, and 12–14 (the “challenged claims”) of U.S. Patent No. 9,210,254 B2 (Ex. 1001, “the ’254 patent”) are unpatentable. *See* 35 U.S.C. § 316(e) (2018); 37 C.F.R. § 42.1(d) (2019).

II. BACKGROUND

A. Procedural History

Cisco filed a Petition, Paper 2 (“Pet.” or “Petition”), to institute an *inter partes* review of the challenged claims. Zilkr Cloud Technologies, LLC (“Patent Owner”) filed a Preliminary Response opposing institution. Paper 7 (“Prelim. Resp.”). Based on the record at that time, we issued a Decision granting *inter partes* review. Paper 11 (“Dec.”).

After institution, Patent Owner filed a Response (Paper 17, “PO Resp.” or “Resp.”), Petitioner filed a Reply (Paper 20, “Pet. Reply” or “Reply”), and Patent Owner filed a Corrected Sur-reply (Paper 27, “PO Sur-reply” or “Sur-reply”).

On June 14, 2024, an oral hearing was held. A transcript of the hearing is made part of the record. Paper 31.

B. Related Proceedings

According to the parties, the ’254 patent is or was the subject of the following actions: *Zilkr Cloud Technologies, LLC v. Cisco Systems, Inc.*, No. 2-22-cv-00166 (E.D. Tex.) filed May 20, 2022; *Zilkr Cloud*

Technologies, LLC v. RingCentral, Inc., 3-21-cv-02807 (N.D. Tex.) filed Nov. 11, 2021 and terminated Apr. 12, 2022. Pet. 82; Prelim. Resp. 2; Paper 3, 1.

C. Real Party in Interest

Petitioner identifies itself as the real party in interest. Pet. 82. Patent Owner identifies itself as the real party in interest. Paper 3, 1.

D. The '254 Patent (Ex. 1001)

The '254 patent is titled “Unified Services Platform Using A Telephone Number As A Common Subscriber Identifier,” which issued on December 8, 2015, from Application No. 14/087,768 filed on November 22, 2013, that claims priority from provisional application 61/888,856 filed on October 9, 2013. Ex. 1001, codes (10), (21), (22), (45), (65), 1:8–10. 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” for whom “the telephone number remains the universal identifier (ID) for communicating with the outside world.” *Id.* at 1:21–26. The '254 patent states that “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” that “often use

different types of IDs and have different rules and policies for managing and activating their services and applications.” *Id.* at 1:27–33.

To address this issue, the ’254 patent describes “creating a unified services platform using the telephone number as the common subscriber ID.” *Id.* at 1:40–42.

Figure 1 of the ’254 patent is reproduced below.

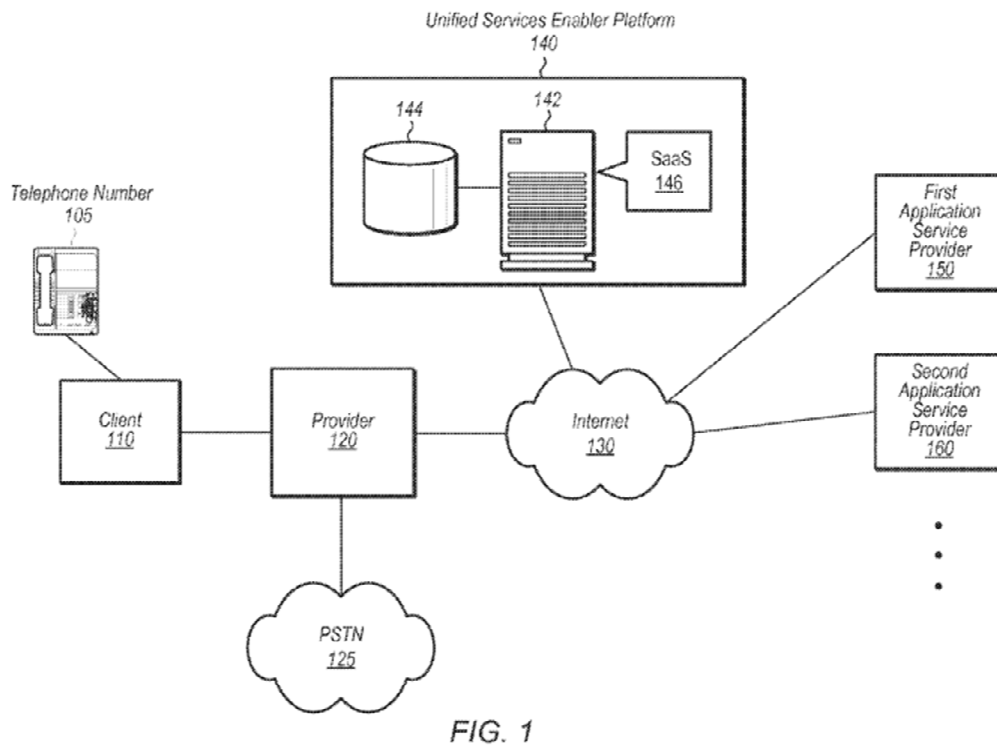


Figure 1 depicts an embodiment of an end user client connecting to a communications network. *Id.* at 2:1–2, 3:33–34. “Client 110 may subscribe to a standard telephone service provided by provider 120, and the telephone service may be associated with telephone number 105.” *Id.* at 3:35–37. “[C]lient 110 may request to add services and applications to the existing telephone service provided by provider 120.” *Id.* at 3:53–55. “Provider 120 may also be coupled to unified services enabler platform 140 via internet

130,” and “[u]nified services enabler platform 140 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.* at 4:14–18. The ’254 patent explains that “[u]nified 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.* at 4:32–35. The ’254 patent further explains that “[a]lthough unified services enabler platform 140 is shown as being separate from provider 120, in some embodiments, portions of platform 140 or the entirety of platform 140 may be integrated within provider 120.” *Id.* at 4:45–49.

E. Challenged Claims

Petitioner challenges claims 1, 2, 6–8, and 12–14 of the ’254 patent. Pet. 7. Claims 1, 7, and 13 are independent. Claim 1 is generally illustrative and reproduced below.

- [1.0]¹ 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 Numerical designation adopted by Petitioner. *See* Pet. 27–41.

- [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.

Ex. 1001, 15:42–65.

F. Evidence

Petitioner relies upon the following evidence:

(1) U.S. Patent Application Publication No. US 2007/0043687 A1, published February 22, 2007 (“Bodart”) (Ex. 1005);

(2) U.S. Patent No. 6,621,892 B1, issued September 16, 2003 (“Banister”) (Ex. 1006);

(3) U.S. Patent No. 7,089,585 B1, issued August 8, 2006 (“Dharmarajan”) (Ex. 1007); and

(4) U.S. Patent Application Publication No. US 2012/0016932 A1, published January 19, 2012 (“de Castro”) (Ex. 1008).

Petitioner also relies on the declarations of Henry Houh, Ph.D. (Exs. 1003, 1030). Patent Owner relies on the declaration of Vijay Madisetti, Ph.D. (Ex. 2006).

G. Asserted Grounds

Petitioner challenges the patentability of claims 1, 2, 6–8, and 12–14 of the '254 patent on the following grounds.²

Claims Challenged	35 U.S.C. §	References
1, 2, 6–8, 12–14	103	Bodart, Banister, Dharmarajan
1, 2, 6–8, 12–14	103	de Castro

Pet. 13.

III. ANALYSIS

A. Principles of Law

A claim is unpatentable under Section 103 “if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103 (2024). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103 effective March 16, 2013. Petitioner notes that “[t]he '254 patent claims priority to a provisional application filed October 9, 2013.” Pet. 11. Patent Owner concurs and does not contend that the challenged claims are entitled to a priority date earlier than October 9, 2013. PO Resp. 4. Thus, this decision refers to the post-AIA version of Section 103.

considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). At this stage, neither party has presented evidence on the fourth *Graham* factor.

The Supreme Court has made clear that we apply “an expansive and flexible approach” to the question of obviousness. *KSR*, 550 U.S. at 415. Whether a patent claiming the combination of prior art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417. Reaching this conclusion, however, requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness requires the additional showing that a person of ordinary skill would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention. *Id.*

B. Level of Ordinary Skill

In determining whether an invention would have been obvious, we consider the level of ordinary skill in the pertinent art. *See Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991).

Petitioner describes a person of ordinary skill in the art as a person having “a bachelor’s degree in electrical engineering, computer science, computer engineering, or equivalent, and two years of relevant experience in telecommunications and networking.” Pet. 11 (citing Ex. 1003 ¶ 22).

Patent Owner asserts that a person of ordinary skill in the art “would have a bachelor’s degree in electrical engineering, computer engineering,

and/or computer science and experience with computer software development, particularly for telecommunications related applications. Extensive experience and technical training may substitute for educational requirements, and advanced education may substitute for experience.” PO Resp. 20 (citing Ex. 2006 ¶ 43).

The parties’ descriptions of a person of ordinary skill in the art are quite similar and appear to be consistent with the subject matter of the ’254 patent and the asserted prior art. We therefore continue to use the same assessment that we adopted in our Institution Decision, as it is consistent with the ’254 patent and the asserted prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art itself may reflect an appropriate level of skill).

C. Claim Construction

In an *inter partes* review, the claims are construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 42.100(b) (2021). The words of a claim are generally given their ordinary and customary meaning as understood by a person of ordinary skill in the art when read in the context of the specification and prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005). “In construing the claims we look to the language of the claims, the specification, and the prosecution history. Extrinsic evidence may also be considered, if needed to assist in determining the meaning or scope of technical terms in the claims.” *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1216 (Fed. Cir. 1995) (internal citation omitted). “In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such

circumstances, it is improper to rely on extrinsic evidence. . . . In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper.”

Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed. Cir. 1996).

In addition, “the specification and prosecution history only compel departure from the plain meaning in two instances: lexicography and disavowal.” *GE Lighting Sols., LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1309 (Fed. Cir. 2014). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (in the context of an *inter partes* review, applying *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)).

In the Petition, Petitioner asserts that, “for the purposes of this proceeding, the terms of the Challenged Claims should be given their ordinary and customary meaning, and no terms require specific construction.” Pet. 12.

In its Response, Patent Owner states that it “does not propose a comprehensive construction, as it would not be necessary to resolve the controversy.” PO Resp. 20.

In its Reply, however, Petitioner contends that “many of [Patent Owner’s] arguments implicitly interpret the claims contrary to their plain and ordinary meaning, the ’254 patent, or both,” and “offers appropriate constructions” for these terms. With respect to Ground 1, Petitioner disputes Patent Owner’s position concerning the terms “utilized by” [1.3], “request to

provision” [1.4], and “activate” [1.7]. Pet. Reply 7– 11. With respect to Ground 2, Petitioner disputes Patent Owner’s position concerning the term “associated with” [1.3]. *Id.* at 11–12.

In its Sur-reply, Patent Owner provides arguments in response to Petitioner’s proposed constructions and contends that its arguments “do not attempt to import any particular limitations from embodiments of the claims, but rather illustrate the context of the claim terms and how the terms are used consistently throughout the Specification.” PO Sur-reply, 3.

All of the disputed claim terms are recited in claim 1. Claim 1 reads as follows, with the disputed terms emphasized.

- [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.

Ex. 1001, 15:42–65.

1. Ground 1

a. “utilized by” [1.3]

Limitation [1.3] recites in relevant part, “*wherein the server is utilized by a first provider to provide a first service to a first user.*”

Petitioner asserts that Patent Owner “implies a distorted understanding of what ‘*utilize[]*’ means.” Pet. Reply 9. According to Petitioner, Patent Owner “argues that the server hosting Bodart’s virtual assistant is ‘*utilized by*’ a user, but the telephone service provider providing the user with access to the virtual assistant’s services does not ‘*utilize[]*’ the server.” *Id.* at 10 (citing PO Resp. 24–25). “Following that logic,” Petitioner contends, “a telephone company would not ‘*utilize*’ any of the routers, switches, communication lines, servers, or machines that make up its physical infrastructure—because (allegedly) it is the company’s customer who ‘*utilize[s]*’ those components to communicate.” Pet. Reply 10 (citing Ex. 1030 ¶ 11). Petitioner contends that Patent Owner “identifies nothing in the ’254 specification supporting such an interpretation.” Pet. Reply 10.

Petitioner points out that Patent Owner “also suggests that Bodart’s server is ‘*utilized by*’ whomever ‘operate[s] or control[s] it.’” *Id.* (citing PO Resp. 28). Petitioner also points out that Patent Owner’s declarant, Dr. Madisetti, “testified that the provider must also be aware of the server’s activity for the server to be “*utilized by*” the provider.” Pet. Reply 10 (citing Ex. 1029, 93:17–94:3 (“first provider is unaware of any of this forwarding”)). Petitioner “disagrees that operation, control, or awareness is

the appropriate test to determine who or what ‘*utilize*’ a server.” Pet. Reply 10.

Petitioner argues that “[t]he ’254 patent uses the term ‘utilize’ to describe a variety of relationships, including ‘utilizing a telephone number’ as a common ID, ‘utiliz[ing]’ APIs to interface with a provider, and a user ‘utiliz[ing] a first provider to provide’ network connectivity.” Pet. Reply 10–11 (citing Ex. 1001, 5:62–64, 10:40–46, 11:35–37). According to Petitioner, “[n]one of these uses indicates any intent to offer an express definition.” Pet. Reply 11. Petitioner asserts that “[s]ince ‘*utilized by*’ is neither a term of art nor expressly defined by the applicants-as-lexicographers, the phrase should be given its ordinary meaning (e.g., ‘used by’).” *Id.* (citing Ex. 1030 ¶ 12).

In its Sur-reply, Patent Owner contends that “Petitioner has not considered whether an end user’s implementation of a server unknown to the provider is consistent with the term “utilized” as used in the ’254 Patent or its description of the telephone service provider’s relationship with the unified services platform.” PO Sur-reply 13. Patent Owner argues that “[i]n the ’254 Patent, the term ‘utilized’ is consistently used in the sense of knowing and intentional use, which is closer to Webster’s definition ‘to make use of’ (see Exhibit 1037 relied on by Petitioner) than it is to Petitioner’s proffered construction of ‘used by.’” *Id.* at 14. Patent Owner also argues that the ’254 patent’s use “of the term ‘utilize’ are not consistent with taking actions that may unknowingly result in use of something.” *Id.* Patent Owner further argues that “[u]tilized by’ requiring a knowing and intentional use is also consistent with the ’254 Patent’s consistent description of the first provider as either providing the unified services platform or being aware of it and cooperating in its use.” *Id.* Patent Owner

does not direct us to any evidence in the prosecution history to support its position.

Looking first at the claim language, limitation [1.3] recites in pertinent part, “*wherein the server is utilized by a first provider to provide a first service to a first user.*” Ex. 1001. There is nothing in limitation [1.3] to indicate that the term “*utilized*” requires a “knowing and intentional use” as Patent Owner contends. In addition to limitation [1.3], claim 1 recites a form of the term “utilize” on three other occasions, in limitation [1.6] (“*wherein the second ID is utilized by the second provider to identify the first user*”), limitation [1.7] (“*activate the second service with the second provider utilizing the second ID*”), and limitation [1.8] (“*interworking data necessary to utilize the second service*”). These additional uses of a form of the term “utilize” in claim 1 also do not indicate that the term “*utilize*” requires a “knowing and intentional use.”

With regard to the '254 patent specification, Patent Owner does not identify, and we do not discern, any special definition for the claim term “utilize” that would require “a knowing and intentional use” or compel a departure from its plain meaning. Indeed, the '254 patent specification appears to alternate between the word “use” and the word “utilize” interchangeably, sometimes within the same sentence. *See, e.g.*, Ex. 1001, 6:46–49 (emphasis added) (“The telephone number (555-111-1111) may be *used* as the central ID to associate services and applications that are *utilized* by the corresponding user”), *id.* at 13:36–40 (emphasis added) (“In other embodiments, the term ‘subscriber ID’ may be defined as the ID *used* to identify a given customer in a primary provider's network. In a further embodiment, a subscriber ID may be *utilized* by a primary provider for identifying a given user”).

We have also reviewed the prosecution history of the '254 patent. Patent Owner does not point to any evidence in the prosecution history that would support its position that the term “utilize” recited in limitation [1.3] requires “a knowing and intentional use,” and we are unable to discern any such evidence in the prosecution history. *See* PO Resp. 20–21, 22–31; PO Sur-reply 13–17; Ex. 1002.

After considering the '254 patent in its entirety, as well as the prosecution history and the other relevant evidence of record, we are not persuaded by Patent Owner’s arguments and evidence that the term “utilize” recited in limitation [1.3] requires “a knowing and intentional use,” as Patent Owner contends. Given the lack of an express definition for the term “utilize” in the '254 patent specification, as well as the specification’s interchangeable use of the terms “use” and “utilize,” and the lack of any evidence in the prosecution history that would support Patent Owner’s contention, we determine that a person of ordinary skill in the art considering the '254 patent in its entirety, as well as the prosecution history, would reasonably understand that the ordinary and customary meaning of the claim term “utilize” is “use” or “to use” and that such “use” is not limited to “a knowing and intentional use” as Patent Owner contends.

b. “request to provision” ([1.4])

Limitation [1.4] recites, “*wherein the server is configured to: receive a request to provision a second service for the first user*”

Petitioner asserts that “[Patent Owner] argues that ‘*request to provision*’ means a request to subscribe to a **new** service.” Pet. Reply 7 (citing PO Resp. 34). According to Petitioner, Patent Owner “merely cites to portions of the specification that are exemplary or optional.” Pet. Reply 7 (citing PO Resp. 33–35; Ex.1001, 3:35–37 (“...may subscribe...”), 6:49–52

(“...may provide...”), 6:52–55 (“...may be activated...”), 6:58–62 (“...may be generated...”), 6:62–66 (“...may then generate...”), 4:32–35 (“...may include...”), 3:65–4:13 (“...may require...may have...”); Ex. 1030 ¶ 8).

Petitioner also asserts that Patent Owner’s declarant, Dr. Madiseti, acknowledged during deposition that “provisioning” is not limited to “adding a new service.” Pet. Reply 7–8 (citing Ex. 1029, 60:13–18 (provisioning includes “deactivating some features”), 61:15–24 (provisioning includes “changing your subscription”). Petitioner argues that “[Patent Owner’s] only other evidence is a website definition for “provisioning” dated *after* institution of this proceeding.” Pet. Reply 8 (citing Ex. 2006, p.108). Petitioner asserts that “[Patent Owner] presents no argument or evidence that the website is an accepted authority or that its 2023 definition reflects the meaning of ‘provisioning’ in October 2013.” Pet. Reply 8. “Regardless,” Petitioner argues, “the website explains that ‘provisioning’ includes more than just service activation.” *Id.* (citing Ex. 2006, 108 (“from the submission . . . through the activation . . . and include[s] altering the state of an existing priority service”); Ex. 1030 ¶ 9).

Petitioner points out that dependent claim 4 recites “*wherein the unified storefront enables the first user to **subscribe** to one or more new services,*” and argues that “[u]nder the doctrine of claim differentiation, claim 4’s subscribing action is presumed to be distinct from claim 1’s “*request to provision.*” Pet. Reply 8. Petitioner points out that claims 10 and 16 recite similar limitations. According to Petitioner, “[t]hese claims confirm that a ‘*request to provision*’ is not the same as a request to subscribe to a *new* service.” *Id.*

Petitioner argues that “[w]hile no construction is necessary, if the Board construes ‘*request to provision,*’ the Board should construe it to

include a request to acquire, activate, deactivate, alter, or initiate.” *Id.* (citing Ex. 2006, 108).

Patent Owner contends that claim 1’s “‘request to provision’ involves a user request to add a new service, including by activating a new subscription or account for the new service.” PO Sur-reply 8–9 (citing PO Resp. 32). Patent Owner explains that “[t]his meaning stems in part from the context of the claim, in which, responsive to receiving the request to provision, the second service is ‘activate[d] with the second provider.’” PO Sur-reply 9. Patent Owner argues that its understanding is also supported by “the ’254 Patent [which] states that ‘[p]rovider 406 may provide telephone service to the user and present a storefront to the user to allow the user to select and add new services and applications to their existing service.’” PO Sur-reply 10 (citing Ex. 1001, 6:49–52). Patent Owner argues that “[t]he ’254 Patent repeatedly and consistently describes such a ‘request to add services and applications to the existing telephone service’ (Ex. 1001, 3:53–54), followed by activation of the new service with the provider and association of the second service with the first telephone number.” PO Sur-reply 10 (citing Ex. 1001, 6:58–62).

However, Patent Owner’s narrow asserted construction of “provision” as only “add[ing]” services and applications is contradicted by its own declarant. Patent Owner states that “Dr. Madisetti explained that provisioning can include deactivating some features because ‘[t]hat’s also a new type of subscription’ (Ex. 1029, 60:18) and that, ‘[a]t a high level,’ removing a service is provisioning because ‘[y]ou are changing your subscription.’” PO Sur-reply 11 (citing Ex. 1029, 61:23–24). This testimony that “provisioning” can include “changing” a subscription to a “new type of subscription” supports Petitioner’s asserted construction of

“altering” a subscription, not Patent Owner’s asserted construction of only “add[ing]” a subscription.

Patent Owner also argues that Petitioner “misapplies” its claim differentiation argument. PO Sur-reply 12. Patent Owner clarifies that its “position is not that a ‘request to provision’ is exactly coextensive with a request to subscribe to a new service. Rather, a ‘request to provision’ involves a user request to add a new service, *including by activating a new subscription or account for the new service.*” *Id.*

With respect to the recited language of claim 1, the step of “receiv[ing] a request to provision a second service for the first user” [1.4] is recited separately, and prior to, the step of “activat[ing] the second service with the second provider” [1.7]. A person of ordinary skill in the art reading claim 1 in its entirety would therefore understand that “a request to provision” a second service is a separate and distinct action from “activat[ing] the second service” with the second provider. Patent Owner concedes that a “request to provision” is not “coextensive with a request to subscribe to a new service,” but asserts that “a ‘request to provision’ involves a user request to add a new service.” PO Sur-reply 12.

Patent Owner cites to certain passages from the ’254 patent to support its position that the claim term “request to provision” involves a user request to add a new service. *See* PO Sur-reply 10–11. For example, Patent Owner points out that “the ’254 Patent states that ‘[p]rovider 406 may provide telephone service to the user and present a storefront to the user to allow the user to select and add new services and applications to their existing service.” *Id.* at 10 (quoting Ex. 1001, 6:49–52). Patent Owner then argues that “[t]he ’254 Patent repeatedly and consistently describes such a ‘request

to add services and applications to the existing telephone service’ (Ex. 1001, 3:53–54), followed by activation of the new service.” PO Sur-reply 10.

The ’254 patent, however, explains that “[u]nified 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.” Ex. 1001, 4:32–35 (emphasis added). The ’254 patent also explains that “client 110 may enter a portal for platform 140 in which a catalog of available applications and services are presented. Client 110 *may add new applications and services to their existing telephone number 105* through this portal, *as well as manage existing applications and services to which client 110 has already subscribed.*” *Id.* at 4:50–55 (emphasis added). A person of ordinary skill in the art reading the ’254 patent in its entirety would therefore reasonably understand that the unified services enabler platform may include software and/or hardware for configuring and provisioning a variety of services and applications, including adding new applications and services as well as managing existing applications and services to which a client has already subscribed.

Patent Owner attempts to distinguish “[a]dding these new services” from “managing existing applications and services to which client 110 has already subscribed.” PO Sur-reply 10–11 (citing Ex. 1001, 4:52–55). However, the ’254 patent simply explains that both options are available to client 110, and does not make the claimed distinction that Patent Owner asserts. *See* Ex. 1001, 4:52–55 (“Client 110 *may add* new applications and services to their existing telephone number 105 through this portal, *as well as manage* existing applications and services to which client 110 has already subscribed.”) (emphasis added).

We have also reviewed the prosecution history of the '254 patent. Patent Owner does not point to any evidence in the prosecution history that would support its position that the term “request to provision” recited in limitation [1.4] is limited to “a user request to add a new service,” and we are unable to discern any such evidence in the prosecution history. *See* PO Resp. 20–21, 31–36; PO Sur-reply 8–13, 17–19; Ex. 1002.

After considering the '254 patent in its entirety, as well as the prosecution history and the other relevant evidence of record, we are not persuaded by Patent Owner's arguments and evidence that the term “request to provision” recited in limitation [1.4] is limited to “a user request to add a new service,” as Patent Owner contends. Rather, for the reasons discussed above, we determine that a person of ordinary skill in the art considering the '254 patent in its entirety, as well as the prosecution history, would reasonably understand that the ordinary and customary meaning of the claim term “request to provision” includes a request to *add new applications and services, or manage existing applications and services to which a client has already subscribed*.

c. “activate” ([1.7])

Limitation [1.7] recites, “*activate the second service with the second provider utilizing the second ID as a user ID for the first user.*”

Petitioner asserts that Patent Owner argues that “to ‘activate’ a service” means to “create[e] a new subscription or account for the service.” Pet. Reply 9 (citing PO Resp. 35). Petitioner argues that Patent Owner “links this position to its failed arguments about a ‘*request to provision*,’ and so [Patent Owner's] construction here fails for the same reasons. Pet. Reply 9. According to Petitioner, Patent Owner “also argues that to ‘*activate*’ cannot encompass to ‘access’ because the '254 patent

specification uses both words without indicating that they “mean the same thing.” *Id.* (citing PO Resp. 39). “But,” Petitioner points out, “[Patent Owner] then says that ‘Provisioning includes activating,’ even though the claims use both ‘*provision*’ and ‘*activate*’ without indicating that they mean the same thing.” Pet. Reply 9 (citing PO Resp. 39–40).

Petitioner argues that Patent Owner

does not reconcile its inconsistent positions. The ’254 specification describes a process for “activating a service”—but the disclosed steps may be omitted and undisclosed steps may be added. Ex.1001, 10:4-11. The only potentially informative disclosure states that after a service is activated, “the provider...will deliver the requested service.” Ex.1001, 4:28-31. Thus, if the Board construes “*activate*,” the Board should construe “*activate*” to include performing an action that causes a provider to deliver or provide a requested service.

Pet. Reply 9 (citing Ex. 1030 ¶ 10).

Patent Owner asserts that “throughout the ’254 Patent, to “activate” a service involves creating a new subscription or account for the service, and the term “activate” is not used to refer to logging into or accessing an existing service through a particular platform.” PO Sur-reply 4 (citing PO Resp. 40–44).

To support its contention that “to ‘activate’ a service involves creating a new subscription or account for the service,” Patent Owner points to the ’254 patent’s description of the embodiment of Figure 11, where “activation data may be sent to the third party provider *so that an account is created for the customer by the third party provider* to use the SMS messaging application.” PO Sur-reply 6 (quoting Ex. 1001, 13:53–55). “This passage,” Patent Owners asserts, “directly links sending activation data to the provider with an account being created for the customer by the third party provider.” PO Sur-reply 6.

With respect to the language of limitation [1.7], it is helpful to consider limitations [1.4] – [1.8] together in order to understand the relationship among the limitations. Limitations [1.4] – [1.8] read as follows:

- [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.

Ex. 1001, 15:49–65.

Considering claim limitations [1.4] – [1.8] in this fuller context, it is apparent from the claim language that a server receives a request to provision a second service for a user where the second service is provided by a second provider. In response to receiving the request, a mapping is created from a first telephone number to a second identifier (ID), and *the second service is activated with the second provider* utilizing the second ID and associating the second service with the first telephone number. The language of claim 1, however, does not expressly indicate whether “activating” the second service is limited to creating a new subscription or account for the service, as Patent Owner contends.

Considering the '254 patent specification, Figure 1 is shown below.

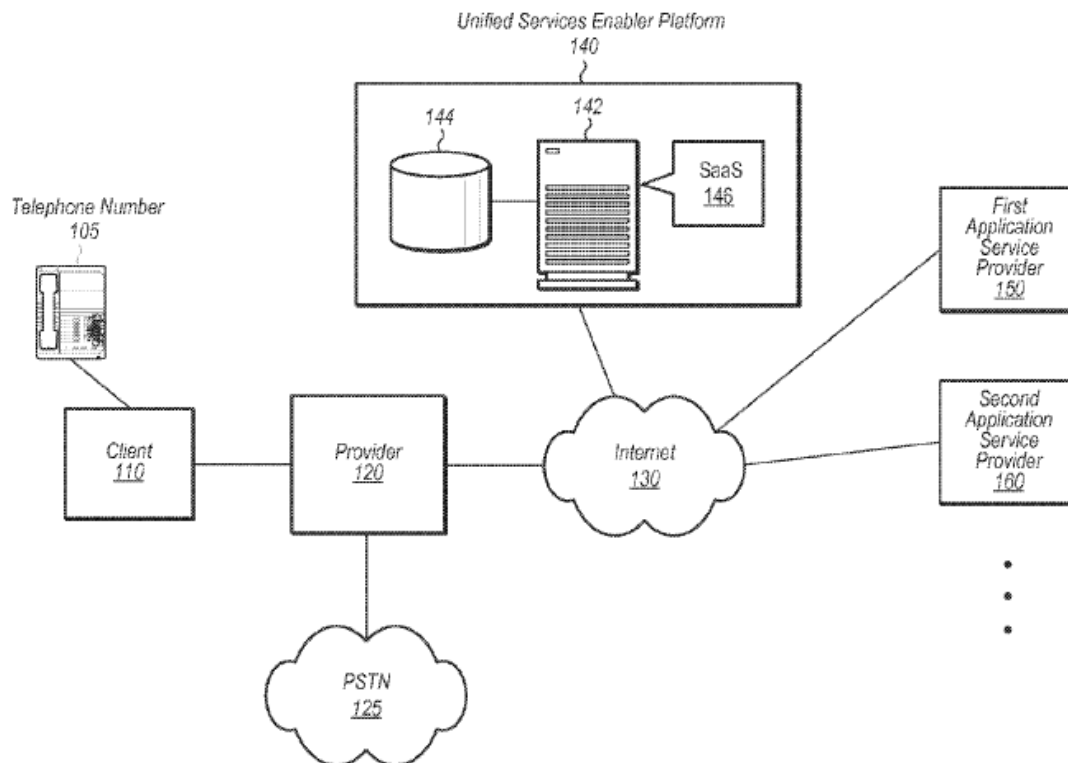


FIG. 1

Figure 1 illustrates an end user client connecting to a communications network, where “[c]lient 110 may subscribe to a standard telephone service provided by provider 120, and the telephone service may be associated with telephone number 105.” *Id.* at 3:33–37. “First application service provider 150 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. In addition, second application service provider 160 may be part of a second ecosystem with a second ID for each user and using a second API for selecting and activating apps.” *Id.* at 3:65–4:4.

The '254 patent specification describes the operation of unified services enabler platform 140, explaining that “[u]nified services enabler platform 140 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.* at 4:15–18. “[U]nified services enabler platform 140 *may activate services* using the appropriate API for the provider which will deliver the requested service.” *Id.* at 4:29–31 (emphasis added). “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.* at 4:32–35.

The ’254 patent specification then explains that “client 110 may enter a portal for [unified services enabler] platform 140 in which a catalog of available applications and services are presented. Client 110 *may add new applications and services* to their existing telephone number 105 through this portal, *as well as manage existing applications and services to which client 110 has already subscribed.*” *Id.* at 4:50–55 (emphasis added).

Here, the ’254 patent specification does not equate “activating” a second service to “creating a new subscription or account for the service” as Patent Owner contends claim 1 requires. Rather, the ’254 patent specification explains that unified services enabler platform 140 *may activate services* using the appropriate API for the provider and client 110 *may add new applications and services* to their existing telephone number, *as well as manage existing applications and services to which client 110 has already subscribed.*

While we agree that the recited phrase “*activate the second service*” [1.7] may include “creating a new subscription or account for the service,” (see, e.g., Ex. 1001, 13:53–55) (“activation data may be sent to the third party provider so that an account is created for the customer by the third party provider to use the SMS messaging application”), we disagree with

Patent Owner that “creating a new subscription or account for a service” is required. The ’254 patent specification describes embodiments where “unified services enabler platform 140 *may activate services* using the appropriate API for the provider which will deliver the requested service” and “client 110 *may add new applications and services . . . through this portal, as well as manage existing applications and services* to which client 110 has already subscribed.” Ex. 1001, 4:29–31, 50–55 (emphasis added).

Moreover, Dr. Madisetti has testified that “activate” as used in the ’254 patent “implements the subscription” for which the provisioning request was made. Ex. 1029, 63:5–12. As discussed above, Dr. Madisetti has also testified that “provisioning” may include “changing” a subscription to a “new type of subscription.” *Supra* §III(C)(1)(b). This testimony indicates that the ’254 patent describes that one may “activate” a change to a subscription. Thus, the record evidence indicates that “activate” is not limited to a “new” application or service.

After considering the ’254 patent in its entirety, as well as the prosecution history and the other relevant evidence of record, we are not persuaded by Patent Owner’s arguments and evidence that the phrase “*activate the second service*” recited in limitation [1.7] requires “creating a new subscription or account for the service,” as Patent Owner contends. Rather, for the above-discussed reasons, we determine that a person of ordinary skill in the art considering the ’254 patent in its entirety, as well as the prosecution history, would reasonably understand that the ordinary and customary meaning of the phrase “*activate the second service*” would include a request to add new applications and services, *or* manage existing applications and services to which a client has already subscribed.

2. *Ground 2*

a. *“associated with” ([1.3])*

Limitation [1.3] recites in relevant part “*wherein the telephone service is associated with a first telephone number.*”

According to Petitioner, Patent Owner argues that limitation [1.3]’s “*associated with a first telephone number*” requires “an **established** ‘association’ or link between the service and the telephone number,” and that “an **affirmative action**” must be taken “to establish an association.” Pet. Reply 11 (citing PO Resp. 53, 54). Petitioner asserts that Patent Owner “includes a string of quotes from the ’254 specification, alleging that they compel a specific interpretation.” Pet. Reply 11 (citing PO Resp. 53–55). Petitioner asserts that “[a]ll PO’s cited features, however, are optional or exemplary.” Pet. Reply 11. Petitioner argues that “[n]othing cited by [Patent Owner] suggests a mandatory feature. Interpreting the claims to require concepts described as optional would be incorrect.” *Id.* (citing *Sisvel Int’l S.A. v. Sierra Wireless, Inc.*, 81 F.4th 1231, 1236–37 (Fed. Cir. 2023) (declining to require features described as “permissive, not mandatory”).

Petitioner argues that “[s]ince “*associated with*” is neither a term of art nor expressly defined by the applicants-as-lexicographers, the phrase should be given its ordinary meaning (e.g., “related to” or “logically connected with”).” Pet. Reply 12 (citing Ex. 1030 ¶ 15).

In its Sur-reply, Patent Owner asserts that it “is not attempting to read optional features into the claims. Rather, [Patent Owner] shows why Petitioner’s implied interpretation of “associated” is not consistent with usage of the term in the ’254 Patent.” PO Sur-reply 15 (citing PO Resp. 53–57).

The term “associated with” is only disputed by Petitioner with respect to Ground 2. *See* Pet. Reply 11–12. Because we determine that the challenged claims are unpatentable under 35 U.S.C. § 103 as being obvious over Bodart, Banister, and Dharmarajan (Ground 1), we do not reach Petitioner’s alternative challenge based on deCastro (Ground 2), and therefore do not need to resolve Petitioner’s dispute over the term “associated with” in Ground 2. *See Boston Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App’x 984, 990 (Fed. Cir. Apr. 30, 2020) (non-precedential) (recognizing that “the Board need not address issues that are not necessary to the resolution of the proceeding” and that the Board has “discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims”); *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (in the context of an *inter partes* review, applying *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (only terms that are in controversy need be construed, and then only to the extent necessary to resolve the controversy)).

D. Relevant Prior Art

1. Bodart (Ex. 1005)

Bodart is a U.S. Patent Application Publication that published on February 22, 2007, more than one year before the earliest priority date of the ’254 patent. Ex. 1001, code (60); Ex. 1006, code (43).

Bodart relates to “personal productivity systems” that provide for “the integration of personal and public information to enable more productive individuals by automating routine tasks.” Ex. 1005 ¶ 1. Bodart’s systems provide users access to internet-based communications services such as

voicemail, text messaging, and voice attendants. *Id.* at code (57), ¶¶ 22, 25, 26, 44, 64, 72. Bodart describes a virtual assistant having “access to a user’s contacts, calendar, and location,” as well as “information about weather, traffic, and mass transit.” *Id.* at code (57). According to Bodart, access to this information “augment[s the virtual assistant’s] ability to make decisions on the user’s behalf.” *Id.* ¶ 20.

Bodart’s Figure 2 is shown below:

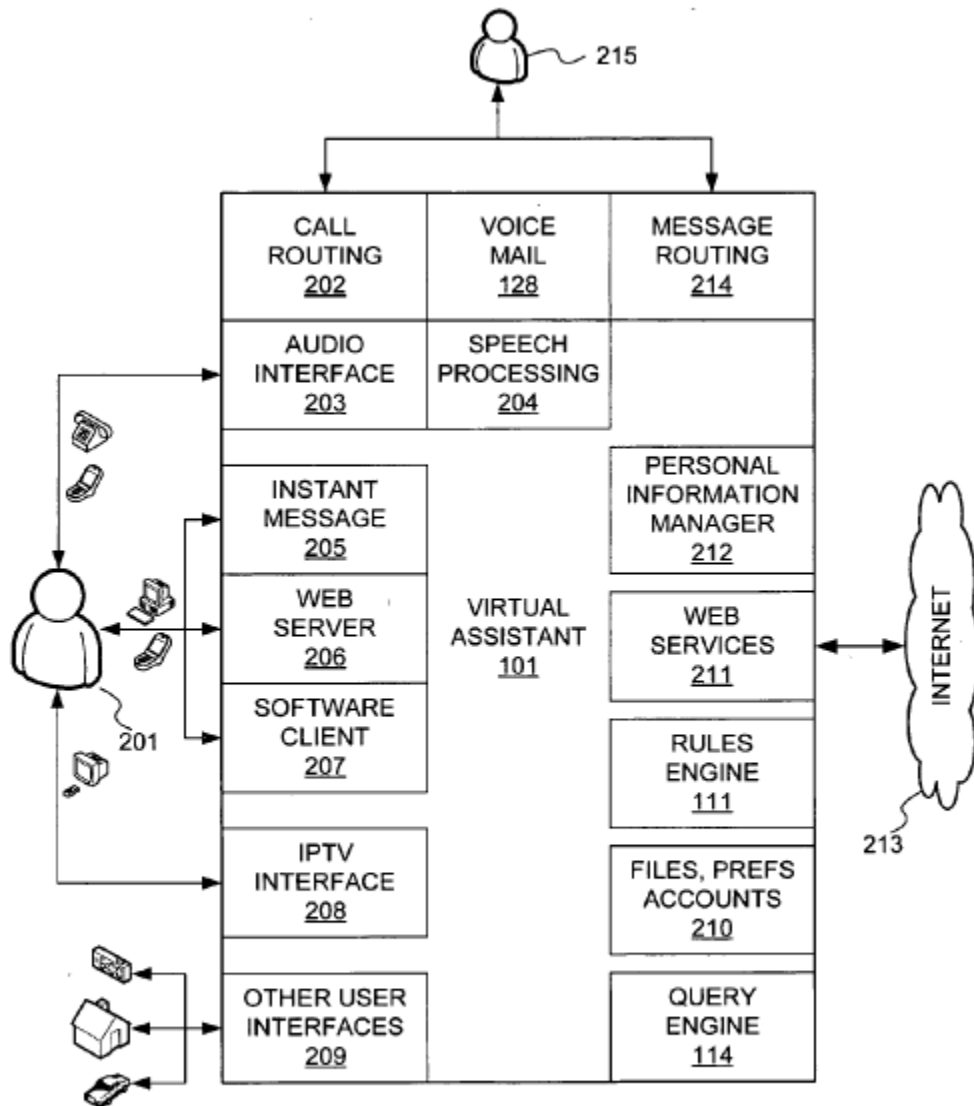


FIG. 2

Bodart's Figure 2, above, is a block diagram showing the various components of virtual assistant 101, user 201, contact 215, and Internet 213. Bodart explains that user 201 may interact with virtual assistant 101 through one of many interfaces, including, for example, "using an audio interface 203 using a conventional telephone, a cell phone, or even a microphone and speaker attached to a computer." *Id.* ¶ 33. Bodart also explains that "[a] visual interface may include those provided by instant messenger 205, web server 206, software client 207, or any other electronic interface. User 201 may interact using a computer, cell phone, or any other device which can receive and send commands." *Id.* ¶ 34.

Bodart also explains that "[v]irtual assistant 101 may include the ability to receive and direct calls and messages directed to user 201." *Id.* ¶ 44. "Such ability," explains Bodart, "includes call routing 202 where an incoming telephone call from contact 215 is routed based on the user's current status as well as whether or not the person making the call is recognized." *Id.* Similarly, "incoming messages including instant messages and/or SMS messages, and even email messages, may . . . be routed using message routing 214." *Id.*

Figure 6 of Bodart is shown below.

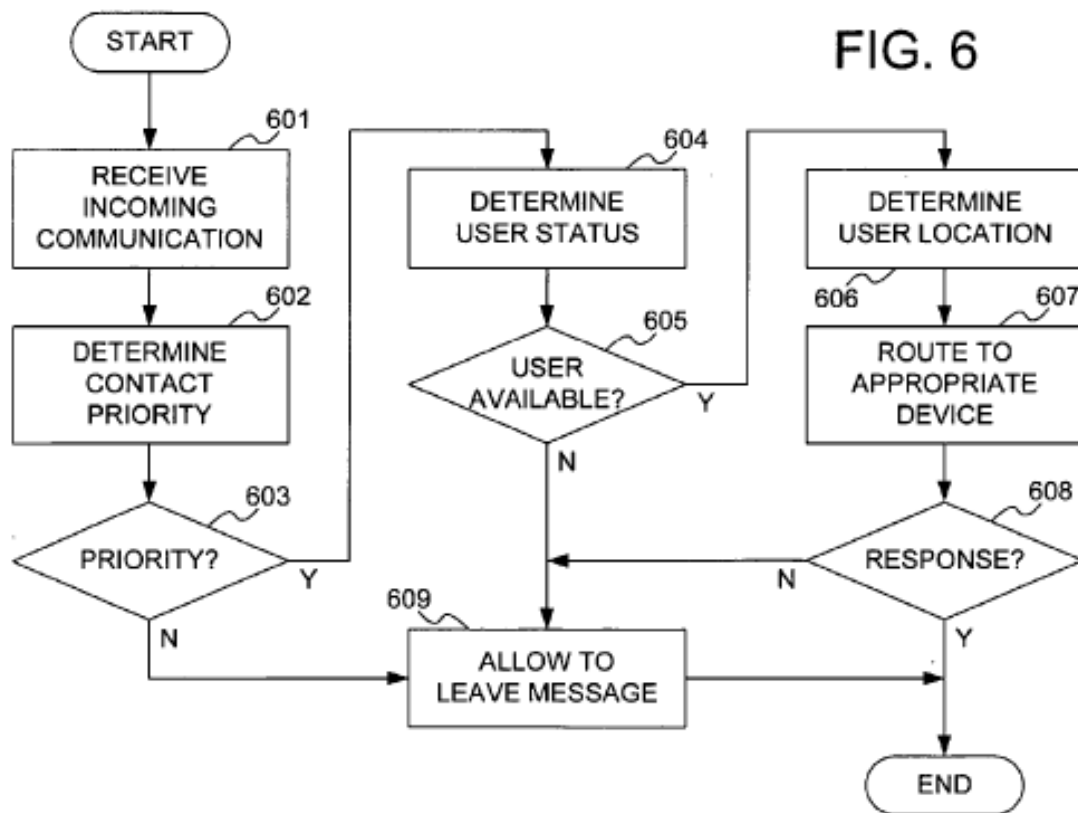


Figure 6 of Bodart is a flow chart illustrating a method with the steps for routing an incoming communication. At step 601, an incoming message is received. *Id.* ¶ 61. Bodart explains that, “to the extent that the address book of user 201 includes instant message contact information, the system described may be used for incoming electronic text messages as it can be with telephone calls.” *Id.* “At step 602, the incoming communication is recognized as a contact in an effort to determine the sender's priority.” *Id.*

2. Banister (Ex. 1006)

Banister is a U.S. Patent that issued on September 16, 2003, more than one year before the earliest priority date of the '254 patent. Ex. 1001, code (60); Ex. 1006, code (45).

Banister relates to a method for “converting an electronic mail message to audio for delivery via a telephone call.” Ex. 1006, 1:8–10.

Banister describes systems for making email messages accessible via telephone. *Id.* at code (57). Banister’s method includes “retrieving a telephone number associated with an intended recipient of the message . . . establishing a telephonic connection with the recipient and playing an audio form of the message text.” *Id.* at 1:51–57.

Banister explains that “an address specified by an originator of a message may be converted to a telephone number or used to look-up a telephone number when the message is received at electronic mail server 104.” *Id.* at 4:14–17. Banister also explains that the mail server may apply a set of rules “to determine if the prefix [of the email address to which the message is directed] includes or is mapped to a telephone number to which an audio form of the message can or should be delivered.” *Id.* at 7:9–11.

3. *Dharmarajan (Ex. 1007)*

Dharmarajan is a U.S. Patent that issued on August 8, 2006, more than one year before the earliest priority date of the ’254 patent. Ex. 1001, code (60); Ex. 1007, code (45).

Dharmarajan relates to “a method and system for authorizing a client computer to access a server computer system,” such as an instant messaging computer system. Ex. 1007, 1:7–11. Dharmarajan describes providing “instant messaging” to a user with an “instant messaging client application program . . . communicat[ing] through the Internet . . . with an instant message server application.” *Id.* at 4:43–52.

Figure 1 of Dharmarajan is shown below.

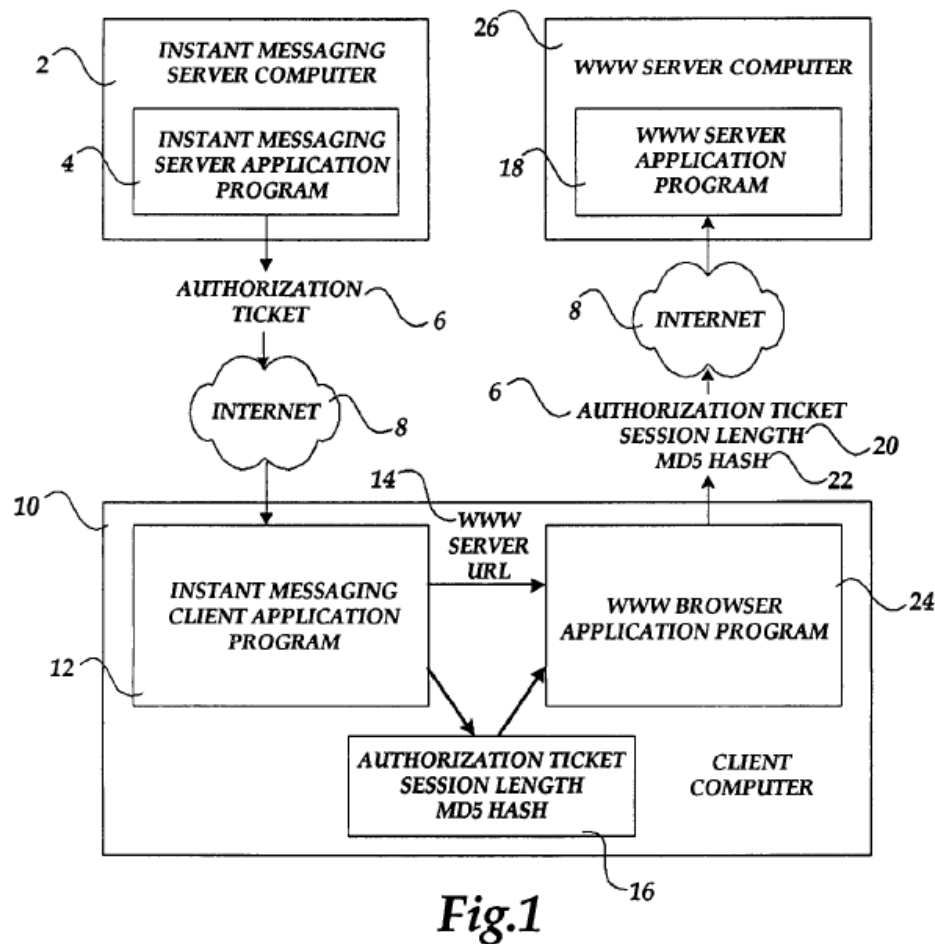


Figure 1 of Dharmarajan, above, is a block diagram illustrating a system architecture and general operation. Ex. 1007, 3:25–27. Dharmarajan describes a technique with which a client computer gains access to an instant messaging service. Client computer 10 executes an instant messaging client application program 12. Instant messaging client application program 12 communicates through Internet 8 with instant messaging server application 4 executing on instant messaging server computer 2. Together, instant messaging client application program 12 and instant messaging server application program 4 provide instant messaging capabilities to a user of the client computer 10. *Id.* at 4:43–52.

Dharmarajan explains that “when a user launches the instant messaging client, the user may be required to provide a username and password.” *Id.* at 1:33–35. Dharmarajan also describes a secure login procedure facilitated by an instant messaging client application program. “The secure login is typically initiated by a user of the instant messaging client application program. The login procedure may include the transmission of a username and password from the client computer to the instant messaging server computer in a secure fashion.” *Id.* at 9:47–51.

4. de Castro (Ex. 1008)

De Castro is a U.S. Patent Application Publication that published on January 19, 2012, more than one year before the earliest priority date of the ’254 patent. Ex. 1001, code (60); Ex. 1008, code (43). De Castro describes “a plurality of communication application servers 200” that “allow[] application clients 40 . . . to access the applications hosted in the communication application servers.” Ex. 1008 ¶ 115. Further, “a plurality of scripting engines 600” are used to “host and process the customers’ application scripts 610.” *Id.* ¶ 119.

Figure 14 of de Castro is shown below.

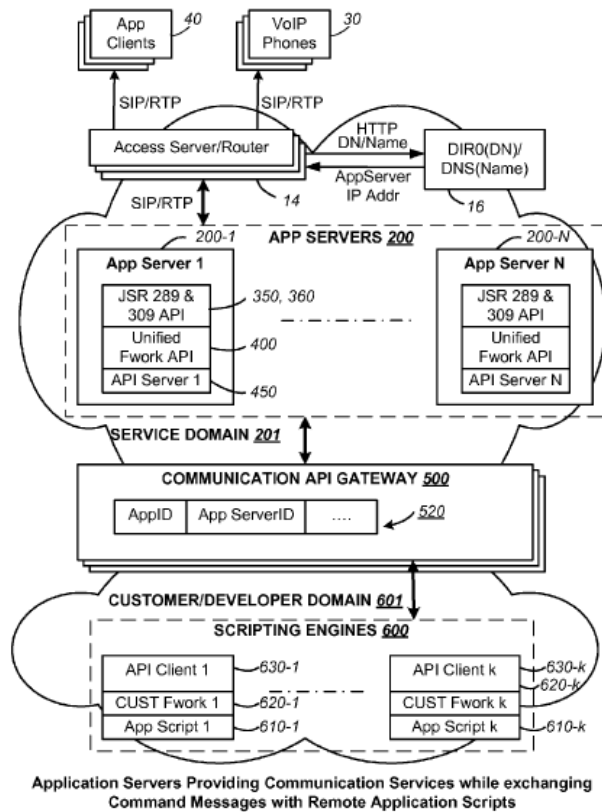


FIG. 14

Figure 14 of de Castro, above, illustrates the network architecture of de Castro with VoIP phones 30, application clients 40, application servers 200 as part of service domain 201, communication API gateway 500 and scripting engines 600 as part of customer/developer domain 601.

E. Obviousness Over Bodart, Banister, and Dharmarajan (Ground 1)

Petitioner contends that claims 1, 2, 6–8, and 12–14 are unpatentable under 35 U.S.C. § 103 as obvious over Bodart, Banister, and Dharmarajan. Pet. 15–50.

1. Rationale to Combine Bodart, Banister, and Dharmarajan

Petitioner contends that a person of ordinary skill in the art 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.” Pet. 19 (citing Ex. 1005 ¶¶ 28, 30; Ex. 1006,

1:7–8; Ex. 1007, 4:8–13; Ex. 1003 ¶¶ 47, 51, 55–56). Petitioner notes that “[e]ach of these references describes providing users access to telephony and internet-based communications services such as IM and email.” Pet. 19 (citing Ex. 1005, Abstr. ¶¶ 25, 64, 72; Ex. 1006, 1:8–11; Ex. 1007, 4:43–55; Ex. 1003 ¶ 56).

Petitioner asserts that a person of ordinary skill in the art “implementing Bodart’s email-reading functionality would have found it obvious to consider other references like Banister which provides implementation details that Bodart expects.” Pet. 20 (citing Ex. 1005 ¶ 2; Ex. 1006, Abstr., 3:35–50; Ex. 1003 ¶ 62). “For instance,” Petitioner points out, “Banister explains that reading emails via telephone involves looking up a telephone number from an email address.” Pet. 20 (citing Ex. 1006, 2:1–5). “Bodart,” Petitioner explains, “describes storing, in a user data module, ‘contact email addresses and phone numbers,’ as well as ‘user accounts, including email passwords, website passwords, and so forth.’” Pet. 20 (citing Ex. 1005 ¶¶ 21, 22). Petitioner argues that “[i]n view of Banister’s disclosure of maintaining lists of email addresses with associated telephone numbers, it would have been obvious to a [person of ordinary skill in the art] for Bodart’s user data module to store an association between the user’s email address and telephone number.” Pet 20–21 (citing Ex. 1003 ¶ 62).

Petitioner contends that

The combination of Bodart and Banister would be simply combining prior art elements according to known methods (computer programming) to yield predictable results (associating an email address with a telephone number in a database). Ex.1003, ¶63. The results of the combination would have been predictable because both Bodart and Banister describe reading emails to a user by phone, and because

Banister merely provides implementation details that Bodart expects. *See* Ex.1005, [0002]; Ex.1006, Abstract; Ex.1003, ¶¶62-63. Furthermore, storing telephone numbers and electronic addresses in databases was well-known in the art. Ex.1003, ¶64; Ex.1013, 6:55 – 7:3; Ex.1014, 11:8-17; Ex.1015, [0116]. The proposed combination would have been predictable and a POSITA would have a reasonable expectation of success, because the combination of Bodart’s email-by-telephone functionality with Banister’s implementation details would have been well-within the skill level of a POSITA.

Pet. 21 (citing Ex. 1003 ¶ 64).

Petitioner also contends that a person of ordinary skill in the art “implementing Bodart’s IM functionality to notify a user of an incoming call would have found it obvious to consider other references like Banister which provides implementation details for associating a recipient’s phone number with an electronic address.” Pet. 22–23 (citing Ex. 1003 ¶ 70). Petitioner argues that “[i]n view of Banister’s disclosure of storing addresses with associated telephone numbers, it would have been obvious to a [person of ordinary skill in the art] for Bodart’s user data module to store an association between the user’s IM username and telephone number.” Pet. 23 (citing Ex. 1003 ¶¶ 70–71). According to Petitioner, “[t]he combination of Bodart[’s user data module] and Banister[’s stored telephone numbers and associated addresses] would be simply combining prior art elements according to known methods (computer programming) to yield predictable results.” Pet. 21 (citing Ex. 1003 ¶ 63).

With respect to Dharmarajan, Petitioner argues that a person of ordinary skill in the art “implementing the IM functionality of Bodart’s virtual assistant would have found it obvious to consider other references like Dharmarajan for implementation details about accessing an IM service.” Pet. 25 (citing Ex. 1003 ¶ 77). According to Petitioner, “[i]t would have

been obvious to a [person of ordinary skill in the art] to store an IM username and password in Bodart’s user data module, which the virtual assistant would then use when accessing an IM service.” Pet. 25 (citing Ex. 1005 ¶ 34; Ex. 1007, 2:22–26; Ex. 1003 ¶ 77). Such a combination, Petitioner argues, “would be simply combining prior art elements (Bodart’s virtual assistant and Dharmarajan’s IM login procedure) according to known methods (computer programming) to yield predictable results (the virtual assistant accessing an IM service).” Pet. 25 (citing Ex. 1003 ¶ 78).

Petitioner contends that

[a]n exemplary combination of Bodart and Banister would be to configure the virtual assistant with a table or set of tables in the user data module that associate the user’s telephone number with the user’s electronic addresses. Ex.1003, ¶¶56, 63.

Further combining Dharmarajan with Bodart and Banister would include configuring the virtual assistant to login to an IM service or email service using login credentials (e.g., username, password) stored in the user data module. Ex.1003, ¶¶56, 77.

This combination would have been within the skill set of a POSITA, and a POSITA would have had a reasonable expectation of success in the combination. Ex.1003, ¶56.

Indeed, a POSITA would have appreciated that other implementations of the combination are possible, and that the specific implementation details would be a design choice.

Pet. 26–27 (citing Ex. 1003 ¶ 56).

Patent Owner’s Response does not contain a specific section directed to addressing Petitioner’s stated rationale to combine the asserted prior art. *See* PO Resp. iv–vi. However, in its analysis of limitation 1.3, Patent Owner appears to address certain aspects of Dr. Houh’s testimony concerning a rationale to combine. Here, Patent Owner argues that Dr. Houh

does not provide any reasoning or motivation to modify Bodart such that a telephone service provider would use Bodart’s virtual assistant to provide telephone service, or why one of

ordinary skill in the art would have a reasonable expectation of success in doing so. The Petition's lack of explanation for how to modify Bodart in this way, lack of reasoning or a motivation to modify Bodart in this way, and lack of explanation for a reasonable expectation of success, is fatal to the Petition, even if Dr. Houh's declaration could be interpreted to suggest this theory.

PO Resp. 26–27 (citing *TQ Delta, LLC v. Cisco Sys., Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019); *In re Van Os*, 844 F.3d 1359, 1361–1362 (Fed. Cir. 2017)).

We disagree with Patent Owner. Dr. Houh testifies that

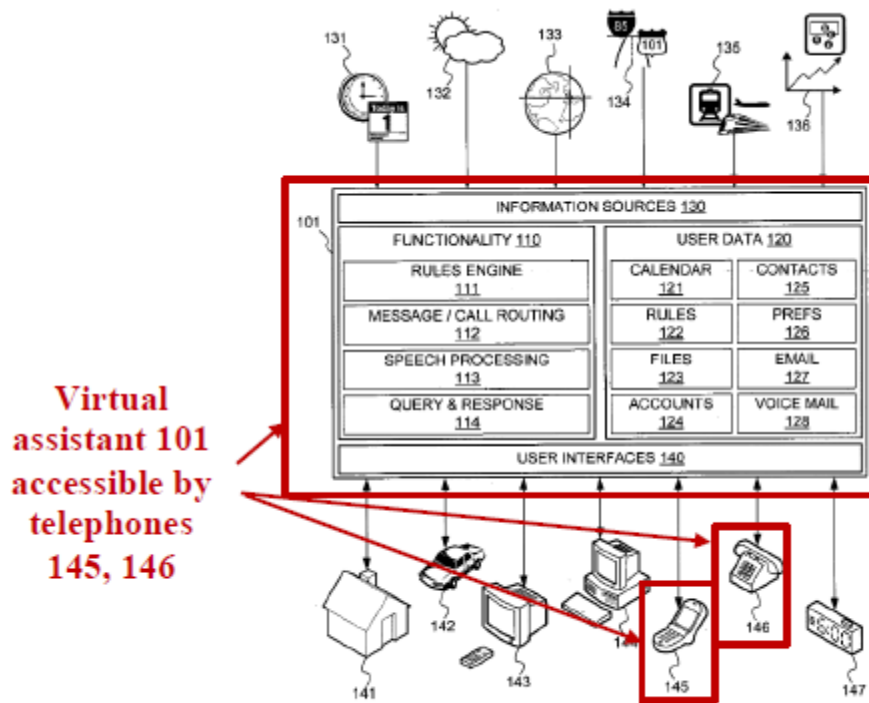
Bodart relates to “personal productivity systems” that provide for “the integration of personal and public information to enable more productive individuals by automating routine tasks.”

[Ex. 1005 ¶ 1]. Like the '254 patent, Bodart's systems provide users access to internet-based communications services such as voicemail, text messaging, and voice attendants. *See* [Ex. 1001], 4:14-15, 24-28, 11:37-40; [Ex. 1005, Abstract, ¶¶ 22, 25, 26, 44, 64, 72].

The virtual assistant includes “one or more user interfaces 140 which allow a user to interact with virtual assistant” including “cell phone 145” and “conventional telephone 146.” [Ex. 1005 ¶ 30].

Ex. 1003 ¶ 43.

Dr. Houh provides as annotated version of Bodart's Figure 1, shown below.



Bodart, Fig. 1 (annotated)

Bodart’s annotated Figure 1 depicts components of virtual assistant 101, including rules engine 111, message/call routing 112, and voice mail 125, that are accessible through user interfaces 140 via cell phone 145 and conventional telephone 146, among other devices.

Dr. Houh also testifies that

Bodart explains that “a remote user can call into his or her virtual assistant and provide voice commands.” [Ex. 1005 ¶ 26]. Further, “[v]irtual assistant 101 may include the ability to receive and direct calls and messages directed to user 201.” [Id. ¶ 44]. The functionalities that the virtual assistant 101 provides to users include routing incoming communications. [Id. ¶¶ 25, 44].

Ex. 1003 ¶ 44.

Dr. Houh further testifies that

[s]ome of the functionalities contemplated by Bodart for the virtual assistant include “having a user’s email read to her by phone” [Ex. 1005 ¶ 2] notifying a user by IM about an

incoming phone call [*id.* ¶ 60], and routing or forwarding incoming calls to the user based on the user's location [*id.* ¶ 59], the identity of the caller [*id.* ¶ 57], or the user's calendar information and scheduled appointments. [*Id.* ¶ 60].

Ex. 1003 ¶ 46.

Indeed, Bodart itself expressly discloses use of a web server to supply an interface from virtual assistant 101. Bodart's Figure 2 is shown below.

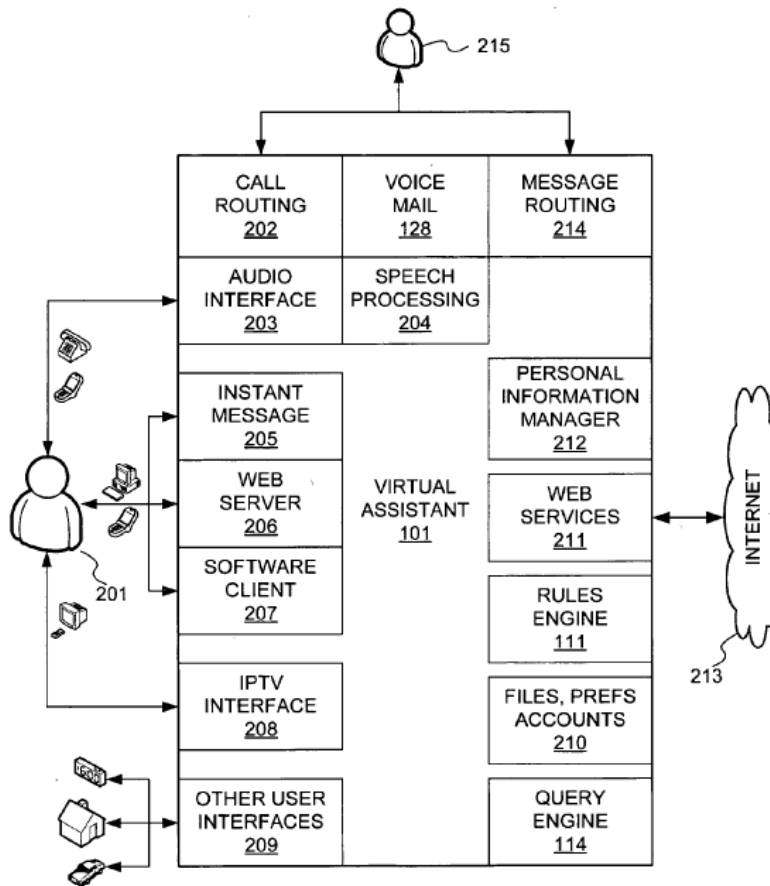


FIG. 2

Bodart's Figure 2 is a block diagram showing the various components of virtual assistant 101, as well as user 201, contact 215, and Internet 213. Bodart explains that "web server 206 may supply an interface from virtual assistant 101 to any computer, cell phone, or other electronic device having a web browser via a computer network such as the Internet." Ex. 1005 ¶ 35.

The Petition expressly asserts that Bodart’s “virtual assistant 101, which includes “*a server*” . . . is “*utilized*” to provide “*telephone service*” (e.g., receiving and directing telephone calls) to the user 201 (“*a first user*”). Pet. 31 (citing Ex.1005 ¶¶ 25, 44; Ex. 1003 ¶¶ 97–100). Bodart’s virtual assistant 101 clearly has telephone interfaces, and it receives, intercepts, directs, and initiates telephone calls. Ex. 1003 ¶¶ 43, 44, 98–100; Ex. 1005 ¶¶ 30, 44. Dr. Houh testifies that “[b]y providing the ability to receive, route, and initiate calls, the virtual assistant is ‘*utilized*’ to provide ‘*telephone service to the first user,*’ and that “it would have been obvious to [a person of ordinary skill in the art] that the telephone service would be provided by a telephone service provider.” Ex. 1003 ¶¶ 100–101. Dr. Houh further testifies that “[i]t was well-known that telephone companies or carriers provided telephone service for use by conventional, landline telephones,” and “[t]hus, it would have been obvious that the virtual assistant 101, which includes “*a server,*” is “*utilized by a first provider to provide a first service to a first user, wherein the first service is telephone service.*” Ex. 1003 ¶ 101.

Based upon the complete record, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that a person of ordinary skill in the art would have had a reasoned basis for combining the teachings of Bodart, Banister, and Dharmarajan in the manner proffered and would have had a reasonable expectation of success in that endeavor.

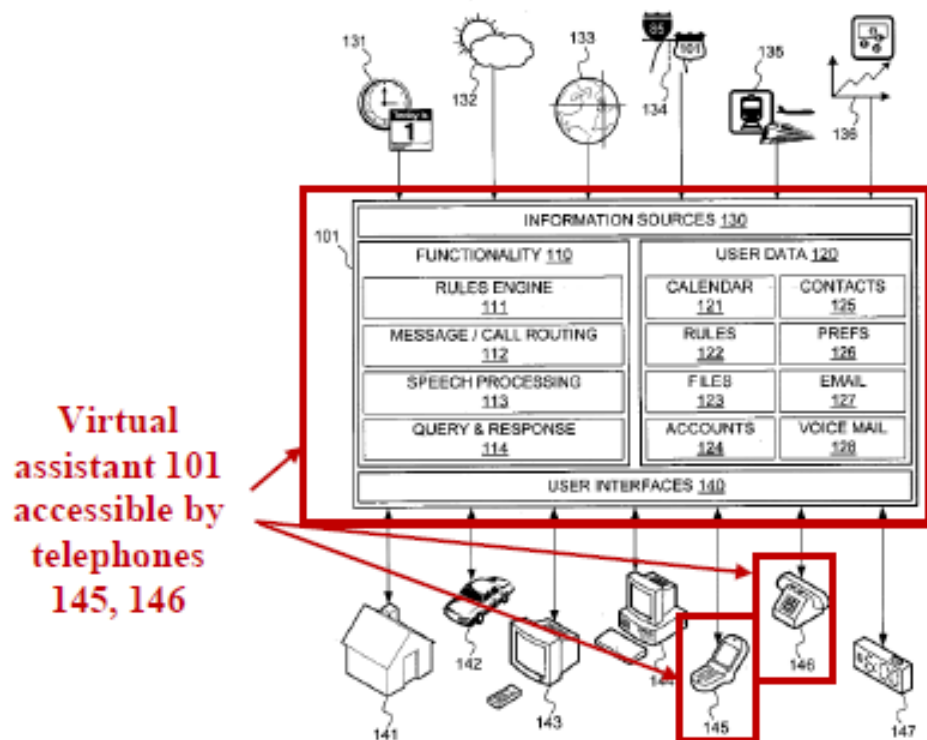
2. Claim 1 – Uncontested Limitations

For claim 1, Patent Owner does not contest Petitioner’s evidence and arguments with respect to limitations [1.0], [1.1], [1.2], and [1.5]. We review Petitioner’s evidence and arguments with respect to these uncontested limitations first.

a. [1.0] A telephone system, comprising:

Claim 1 recites the following preamble: “A telephone system, comprising.” Ex. 1001, 15:42.

With respect to the preamble, Petitioner asserts that “Bodart teaches a virtual assistant 101 (‘telephone system’) with communication functionalities ‘including, for example, the ability to initiate telephone calls and fax calls.’” Pet. 27 (citing Ex. 1005 ¶ 27) (emphasis omitted). Petitioner’s annotated Figure 1 from Bodart is shown below.



Ex.1005, Fig.1 (annotated); Ex.1003, ¶80.

Petitioner’s annotated Figure 1 from Bodart illustrates virtual assistant 101 accessible by “cell phone 145” and “conventional telephone 146.”

Pet. 27 (citing Ex. 1005 ¶ 30; Ex. 1003 ¶¶ 80–81). Dr. Houh testifies that

Fig.1 of Bodart shows that the virtual assistant 101 is accessible through a variety of interfaces, including “conventional telephone 146,” and “cell phone 145.” Bodart, [0030]. For

example, using speech processing functionality 113, “a remote user can **call into** his or her virtual assistant and provide voice commands.” Bodart, [0026]. Further, Bodart discloses that the virtual assistant 101 includes “Message / Call Routing 112” functionality which “may enable virtual assistant 101 to intercept **incoming telephone calls**.” Bodart, [0025]. Bodart explains that the virtual assistant 101 may have “the ability to initiate **telephone calls** and fax calls.” Bodart, [0027].

Ex. 1003 ¶ 81.

Patent Owner does not specifically contest Petitioner’s evidence and arguments directed to the preamble. *See* PO Resp. 21–47.

Based on the complete record, we find that Petitioner has established that Bodart’s description of a virtual assistant with communication functionality “including, for example, the ability to initiate telephone calls and fax calls,” meets the recited “*telephone system*” of the preamble.³

b. [1.1] a database

For this limitation, Petitioner asserts that “Bodart teaches that a ‘user data module may store data about a specific user,’ such as ‘calendar appointment information, contact information, rules information, and preferences information,’” and that “[v]irtual assistant 101 software further may include the ability to access user data 120.” Pet. 28 (citing Ex. 1005 ¶¶ 5, 20) (emphasis omitted). Petitioner also asserts that “Bodart further discloses looking up ‘phone numbers of contacts in the user’s database.’” Pet. 28 (citing Ex. 1005 ¶ 57) (emphasis omitted).

Petitioner also relies on Banister, which Petitioner asserts, “discloses storing ‘addresses with associated telephone numbers’ in a ‘database.’”

³ The issue of whether the preamble is limiting need not be resolved because Petitioner demonstrates that the preamble is satisfied by the prior art.

Pet. 29 (citing Ex. 1006, 2:1–5; Ex. 1003 ¶ 86). “Thus,” Petitioner concludes, “Bodart and Banister render obvious the virtual assistant (*‘telephone system’*) comprising *‘a database.’*” Pet. 29 (citing Ex. 1003 ¶¶ 84–87).

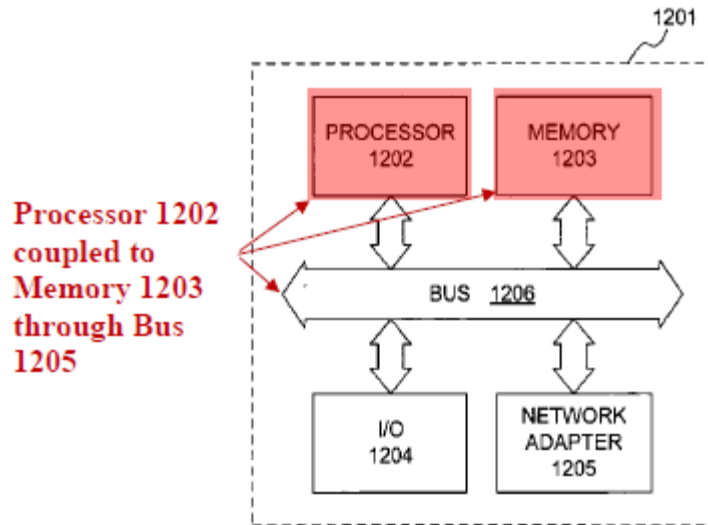
Dr. Houh testifies that “Bodart discloses that a “user data module may store data about a specific user,” such that “[t]he virtual assistant combines the user data and technical functionality ‘to assist the user and make the most accurate decisions possible.’” Ex. 1003 ¶ 85 (citing Ex. 1005 ¶¶ 5, 20) (emphasis omitted). Dr. Houh also testifies that “Banister discloses storing ‘addresses with associated telephone numbers’ in a ‘database,’” and that “Dharmarajan also contemplates a server computer having a ‘database containing [] information.’” Ex. 1003 ¶ 86 (citing Ex. 1006, 2:1–5; Ex. 1007, 2:59–61) (emphasis omitted).

Patent Owner does not specifically contest Petitioner’s evidence and arguments for this limitation. *See* PO Resp. 21–47.

Based on the complete record, we find that Petitioner has demonstrated that Bodart’s description of virtual assistant software that may include the ability to access user data and look up phone numbers of contacts in the user’s database, as well as Banister’s description of storing addresses with associated telephone numbers in a database, meets the recited limitation.

c. [1.2] a server coupled to the database

For this limitation, Petitioner asserts that “Bodart’s virtual assistant is implemented on device 1201” as illustrated in Petitioner’s annotated Figure 12 from Bodart shown below. Pet. 29–30 (citing Ex. 1005 ¶ 75).



Ex.1005, Fig.12 (annotated); Ex.1003, ¶91.

Petitioner’s annotated Figure 12 from Bodart, shown above, illustrates an operating environment where “[d]evice 1201 may be any sort of hardware minimally containing the components shown here,” including at least one processor 1202, memory 1203, input/output 1204, network adapter 1205, and bus 1206 to link the components. This includes desktop computers, laptop computers, servers . . . and so forth.” Pet. 30 (citing Ex. 1003 ¶¶ 94–96); *see also* Ex. 1005 ¶ 75, Fig. 12.

Petitioner asserts that

the virtual assistant (“*telephone system*”) accesses user data, which it would have been obvious to store in a *database*. [See Pet.] Section XI.D.5.[1.1]; Ex.1003, ¶86. Because Bodart describes that the virtual assistant may be implemented on the device 1201 (which may be a server), it would have been obvious to a POSITA for Bodart’s virtual assistant to be a server that is “*coupled to the database.*”

Pet. 30 (citing Ex. 1005 ¶¶ 20, 75; Ex. 1003 ¶¶ 94–96).

Patent Owner does not specifically contest Petitioner’s evidence and arguments for this limitation. *See* PO Resp. 21–47.

Based on the complete record, we find that Petitioner has demonstrated that Bodart's description of a virtual assistant with access to user data stored in a database, where the virtual assistant is implemented on a device that may be a server, meets the recited limitation.

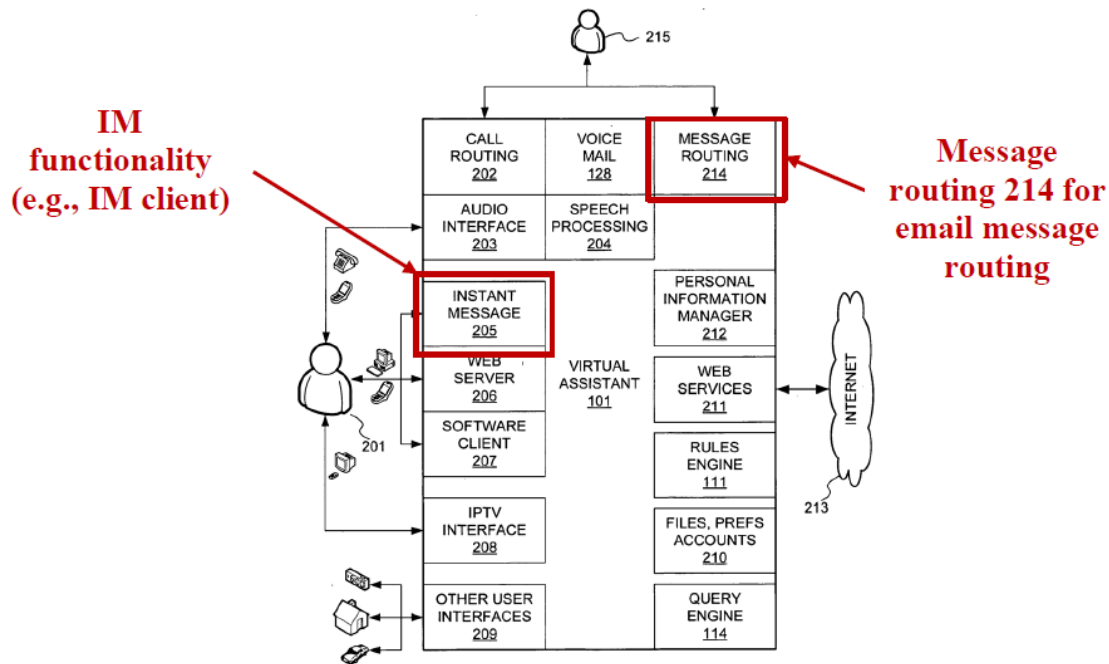
d. [1.5] wherein the second service is provided by a second provider, and wherein the second provider is different than the first provider

For this limitation, Petitioner asserts that Bodart "teaches that 'a user may be able to send messages using an instant message client such as America Online (AOL) Instant Messenger, Microsoft Network (MSN) Messenger, and so forth.'" Pet. 35 (citing Ex. 1005 ¶ 34). "Thus," Petitioner asserts, "Bodart teaches multiple examples of 'a second provider' (such as AOL or Microsoft) providing IM service ('second service')." Pet. 35 (citing Ex. 1005 ¶ 34; Ex. 1003 ¶¶ 117–118). Petitioner also argues that a person of ordinary skill in the art "would have found it obvious that AOL or Microsoft would be different from the telephone service provider ('first provider')." Pet. 35 (citing Ex. 1003 ¶¶ 116, 119).

Petitioner also provides an email example as a second service, asserting that "Bodart teaches using PIMs such as 'Microsoft Outlook.'" Pet. 35 (citing Ex. 1005 ¶ 40; Ex. 1003 ¶¶ 120–121). According to Petitioner, "[i]t would have been obvious to [a person of ordinary skill in the art] that Outlook would provide the email service, or alternatively, would access a well-known email service such as Gmail or Hotmail." Pet. 35 (citing Ex. 1005 ¶¶ 36, 40; Ex. 1007, 5:28–31; Ex. 1011, pp.1–2; Ex. 1003 ¶ 122). Petitioner asserts that "[i]t would also have been obvious to a [person of ordinary skill in the art] that the email service provider (e.g.,

Gmail) would be ‘*different than*’ the telephone service provider (‘*the first provider*’). Pet. 35 (citing Ex. 1005 ¶ 40; Ex. 1003 ¶ 122).

Dr. Houh points to Petitioner’s annotated Figure 2 from Bodart, shown below, testifying that Bodart “shows that the virtual assistant includes IM functionality 205,” and that “email messages [may be] routed using message routing 214.” Ex. 1003 ¶¶ 117, 120 (citing Ex. 1005 ¶¶ 34, 44).



Bodart, Fig. 2 (annotated)

Petitioner’s annotated Figure 2 from Bodart, above, depicts components of virtual assistant 215 including message routing 214 and instant message 205, both outlined in red.

Patent Owner does not specifically contest Petitioner’s evidence and arguments for this limitation. See PO Resp. 21–47.

Based on the complete record, we find that Petitioner has demonstrated that an instant messaging (IM) service or an email service associated with a virtual assistant as taught by Bodart, meets the recited limitation.

3. Claim 1 – Contested Limitations

Patent Owner contests Petitioner’s evidence and arguments with respect to limitations [1.3], [1.4], [1.6], [1.7], and [1.8]. We consider each of these contested limitations as follows.

- a. *[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*

For this limitation, Petitioner asserts that

Bodart teaches that “[v]irtual assistant 101 may include the ability to **receive and direct calls** and messages directed to **user 201**.” Ex.1005, [0044]. Thus, the virtual assistant 101, which includes “a server” as explained in [1.2], is “utilized” to provide “*telephone service*” (e.g., receiving and directing telephone calls) to the user 201 (“a first user”).

Pet. 31 (citing Ex. 1005 ¶¶ 25, 44; Ex. 1003 ¶¶ 97–100). Petitioner also asserts that a person of ordinary skill in the art

would have found it obvious that the telephone service would be provided to the user by a telephone service provider (“a first provider”). Ex.1016, p.2, col.2, ll.80-84; Ex.1017, p.1, col. 2, ll.4-6; Ex.1003, ¶101. For example, a POSITA would have been familiar with telephone carrier companies such as AT&T, Verizon, and Sprint, which were well-known telephone service providers.

Pet. 31 (citing Ex. 1015 ¶ 106; Ex. 1003 ¶ 101).

Petitioner further asserts that

Bodart’s disclosure of the user accessing the virtual assistant by telephone renders obvious that the “*telephone service is associated with a first telephone number*.” Ex.1005, [0026]; Ex.1003, ¶¶102-104. For instance, Bodart’s disclosure that the “user can call into his or her virtual assistant” renders obvious the virtual assistant having a telephone number. Ex.1005, [0026]; Ex.1003, ¶¶102-103. Further, Bodart’s disclosure that “[v]irtual assistant 101 may include the ability to **receive and direct calls** and messages directed to **user 201**” renders

obvious the user having a telephone number. Ex.1005, [0044]; Ex.1003, ¶¶102-103. Thus, the telephone service used to access the virtual assistant is “*associated with*” a telephone number for the user, a telephone number for the virtual assistant, or both.

Pet. 31–32 (citing Ex. 1005 ¶¶ 26, 44; Ex. 1003 ¶ 103).

Patent Owner argues that “[n]othing in the Petition or in Petitioner’s expert declaration shows that Bodart’s purported ‘server’ is ‘utilized by a first provider to provide a first service to a first user, wherein the first service is telephone service.’” PO Resp. 22 (citing Ex. 2006 ¶¶ 69–76). Patent Owner argues “[t]hat the virtual assistant can ‘receive and direct calls’ does not meet the claim limitations.” PO Resp. 22. Patent Owner also argues that a person of ordinary skill in the art would “understand that ‘intercepting’ and ‘forwarding calls’ is not providing a telephone service to a first user.” *Id.* at 22–23 (citing Ex. 2006 ¶ 76). Patent Owner further argues that “[t]he Petition contains carefully worded piecemeal assertions that fail to even allege that the prior art teaches limitation [1.3] as a whole,” and that “nowhere does the Petition even allege that it would have been obvious for the telephone service provider to utilize the virtual assistant to provide telephone services.” PO Resp. 23–24.

Patent Owner argues that a person of ordinary skill in the art “would understand that Bodart’s virtual assistant would initiate a call on behalf of the user using the user’s telephone without the telephone service provider utilizing the virtual assistant,” and “would further understand that providing a user the ability for Bodart’s virtual assistant to initiate calls with the user’s telephone and service, like ‘intercepting’ and ‘forwarding calls,’ is not providing a telephone service to a first user by a ‘telephone service provider.’” PO Resp. 24–25 (citing Ex. 2006 ¶ 79).

In its Reply, Petitioner argues that “[t]he claims do not require that the *server* be “provided,” “operate[d],” or “control[ed]” by a telephone service provider” as Patent Owner argues. Pet. Reply 12–13 (citing PO Resp. 28, 31). Petitioner argues that “[w]hile these actions would have been obvious, they are not necessary to find the claims obvious.” Pet. Reply 13 (citing Ex. 1030 ¶¶ 12, 17).

Petitioner asserts that “Bodart’s virtual assistant receives, intercepts, directs, and initiates calls through various telephone interfaces” (*see* Pet. 27, 31), and that “[i]t was known for telecommunications service providers to use servers as part of providing telephone services.” Pet. Reply 13 (citing Ex. 1030, ¶¶ 20–22; Ex. 1035 ¶¶ 32, 37, 39, 66–67, 119, 122, 127–143; Ex. 1036, Abstract, 3:6–22, 4:6–8, 4:57–5:2, 6:9–12, 6:32–35, 6:57–61, 7:9–14, 7:58–62, 8:19–20). “It would have been obvious,” Petitioner asserts, “for Bodart’s virtual assistant to send and respond to network commands to provide such telephone services to the user.” Pet. Reply 13 (citing Pet. 27, 31; Ex. 1003 ¶ 101; Ex. 1030 ¶¶ 18–19).

Petitioner explains that “calls to a user originate on a telephone service provider’s network,” and that “[t]hese calls are received by the server running Bodart’s virtual assistant and then routed to the user based on user-configured rules.” Pet. Reply 13 (citing Pet. 32; Ex. 1005 ¶ 25). Petitioner argues that “[t]he virtual assistant chooses whether to complete a call to the user, and so a POSITA would have understood that the virtual assistant is ‘*utilized by*’ the telephone service provider (at least by means of its routing rules) in providing ‘*telephone service*’ to the user.” Pet. Reply 13–14 (citing Pet. 31, 44; Ex. 1005 ¶ 57; Ex. 1030 ¶ 23).

In its Sur-reply, Patent Owner argues that a “telephone service provider merely providing signals to a user premises, where the user may or

may not be using any particular piece of equipment such as Bodart’s virtual assistant, is not the same as the service provider utilizing its own switches or other equipment to provide the telephone service.” PO Sur-reply 17. Patent Owner also argues that Petitioner raised a “new theory in its Reply that it would have been obvious for a telephone service provider to provide access to Bodart’s virtual assistant as a service is a late argument that could have been presented in its Petition.” *Id.*

We disagree with Patent Owner that Petitioner raises a “new theory” in its Reply. Petitioner raised this obviousness assertion in its Petition. Pet. 31 (citing Ex. 1003 ¶ 101). Dr. Houh testifies that “Bodart teaches that the virtual assistant may have ‘the ability to **initiate** telephone calls’” and that “the virtual assistant is accessible through a conventional telephone 146 and a cell phone 145.” Ex. 1003 ¶ 99. Dr. Houh also testifies that “[b]y providing the ability to receive, route, and initiate calls, the virtual assistant is ‘*utilized*’ to provide ‘*telephone service to the first user*,’ and that “it would have been obvious to a [person of ordinary skill in the art] that the telephone service would be provided by a telephone service provider (“*first provider*”).” *Id.* ¶¶ 100–101. Dr. Houh further testifies that the telephone service provider’s use of a virtual assistant server to provide telephone service to Bodart’s user is analogous to a telephone service provider’s historical use of landline telephones to provide telephone service to users. *Id.*

In response to Patent Owner’s arguments, Petitioner and Dr. Houh explain that “[t]elecommunications service providers would have used network components and infrastructure, including routers, switches, communication lines, servers, base stations, and terminal equipment, to provide communications services,” and that “[t]his would have been

background knowledge to [a person of ordinary skill in the art].” Ex. 1030 ¶ 11. Dr. Houh points out that “[t]he fact that telephone service users would have *also* used those components and infrastructure to use telephone service does not change this analysis,” and that the ’254 patent does not support “Patent Owner’s suggestion that Bodart’s server is not “*utilized by*” the telephone service provider merely because the virtual assistant user also uses Bodart’s server.” *Id.*

We are mindful of our finding that a person of ordinary skill in the art considering the ’254 patent in its entirety would reasonably understand that the claim term “utilize” means “use” or “to use” and that such “use” is not limited to “a knowing and intentional use” as Patent Owner contends.

Based on the complete record, we determine that Petitioner has established that the combined teachings of the asserted prior art as described in the Petition with respect to [1.3] satisfy the limitation “*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.*”

b. [1.4] *wherein the server is configured to: receive a request to provision a second service for the first user*

For this limitation, Petitioner asserts that the recited “*second service*” may be “either an [instant messaging] IM service or an email service.” Pet. 32 (citing Ex. 1003 ¶¶ 105–106, 107–111 (IM), 112–114 (email), 115).

With respect to instant messaging, Petitioner asserts that

Bodart teaches that “[t]he virtual assistant also has a rules engine enabling a user to create rules for **handling** incoming calls and **instant messages**.” Ex.1005, Abstract. Further, “a user may be able to **send messages** using an instant message client.” Ex.1005, [0025]. The handling of IMs (*e.g.*, through an IM client) teaches “*a second service.*”

Pet. 32 (citing Ex. 1003 ¶¶ 107–109).

Petitioner also asserts that “Dharmarajan teaches that ‘when a user launches [an] instant messaging client, the user may be required to **provide a username and password.**’” Pet. 32 (citing Ex. 1007, 1:33–35).

According to Petitioner, “[c]onfiguring Bodart’s virtual assistant by providing the username and password for accessing the IM service, per Dharmarajan, renders obvious a “*request to provision [the] second service for the first user.*” Pet. 32 (citing Ex. 1007, 1:33–35; Ex. 1003 ¶ 110).

Petitioner argues that “Bodart’s virtual assistant would ‘*receive [the] request to provision [the] second service,*’ because the virtual assistant would store the preferred IM application or platform, username, and password provided by the user.” Pet. 33 (citing Ex. 1003 ¶¶ 110–111).

With respect to email, Petitioner asserts that “Bodart teaches that a user, through the virtual assistant, can ‘search user files 123, **emails 127**, calendar 121 appointments, and so forth.’” Pet. 33 (citing Ex. 1005 ¶ 27; Ex. 1003 ¶ 112). Petitioner asserts that “Bodart teaches that ‘[a]ccounts 124 may also include . . . **email passwords,**’” and that “the virtual assistant may rely on a personal information manager (PIM) such as ‘**Microsoft Outlook**’ to access user data.” Pet. 34 (citing Ex. 1005 ¶¶ 22, 40; Ex. 1003 ¶¶ 112–113). Petitioner argues that “[t]he user configuring the user data module with the email account address and password, as well as the server protocol and server address, to the virtual assistant to enable the virtual assistant to login to the email service is a “*request to provision [the] second service.*” Pet. 34 (citing Ex. 1003 ¶¶ 31, 114).

Patent Owner argues that “Petitioner has not shown that storing a preferred IM platform, IM username, and IM password, or storing email server settings, an email address, and email password in Bodart’s virtual

assistant, would be ‘receiv[ing] a request to provision’ as recited in the Challenged Claims.” PO Resp. 32 (citing Ex. 2006 ¶ 90). Patent Owner argues that “a ‘request to provision’ in the ’254 Patent involves a user request to add a new service, including by activating a new subscription or account for the new service.” PO Resp. 32 (citing Ex. 2006 ¶¶ 90–101).

Patent Owner argues that “[t]he description in the ’254 Patent consistently refers to adding new services and applications to existing service by activating them via the unified services platform,” and that “[a] request to add a new service via the unified services enabler platform is a request to provision it.” PO Resp. 33–34 (citing Ex. 2006 ¶ 96). Patent Owner argues that because its arguments “with respect to limitation [1.7], to ‘activate’ a service in the ’254 Patent involves creating a new subscription or account for the service,” that this “understanding of the term ‘activate’ from the ’254 Patent reinforces that a ‘request to provision’ is a request to add a new service, including by activating a new subscription or account for the new service.” PO Resp. 35. According to Patent Owner, “[p]rovisioning requires adding a new service, not simply configuring a particular platform to access an existing service.” *Id.* at 36 (citing Ex. 2006 ¶ 100).

In its Reply, Petitioner responds to Patent Owner’s argument that a “*request to provision*” involves a user request to add a new service by arguing that “the virtual assistant’s ‘automating [of] routine tasks’ (involving IM and email messages) are new services made available by the user’s actions to configure the virtual assistant (those actions collectively being a ‘*request to provision*’).” Pet. Reply 18 (citing Ex. 1005 ¶ 1; Pet. 34; Ex. 1030, ¶ 32). Petitioner argues that “[t]he Petition references many new services offered by or through the virtual assistant, including ‘sending an IM to a user receiving a phone call,’ ‘having a user’s email read to her by

phone,’ and sending a text or IM message ‘to determine the user’s availability.’” Pet. Reply 18 (citing Pet. 36, 38, 42). Petitioner argues that “[l]istening to emails over a phone is plainly a new and different ‘service’ from seeing email text on a screen.” Pet. Reply 19 (citing Ex. 1030 ¶ 32).

In its Sur-reply, Patent Owner argues that Petitioner “presents a new theory,” in its Reply, “arguing that tasks Bodart[’s] virtual assistant may perform are ‘new services.’” PO Sur-reply 18 (citing Pet. Reply 18). Patent Owner argues that “Petitioner’s new theory does not explain how configuring Bodart’s virtual assistant to perform additional tasks includes adding a new service by activating a new subscription or account for the new service.” PO Sur-reply 18.

We disagree with Patent Owner because its arguments rely on the erroneous view that the recited claim language “*request to provision*” *requires* “a request to add a *new* service, including by activating a *new* subscription or account for the *new* service.” *See, e.g.*, PO Sur-reply 18 (“Receiving and storing login credentials is not a request to add a new service, including by activating a new subscription or account for the new service.”). Patent Owner’s arguments fail to take into account embodiments described in the ’254 patent where unified services enabler platform 140 may activate services using the appropriate API for the provider which will deliver the requested service and client 110 may enter a portal for platform 140 in which client 110 *may add new applications and services as well as manage existing applications and services to which client 110 has already subscribed*. *See* Ex. 1001, 4:29–31, 50–55. As we explain in Section III.C.1.b, a person of ordinary skill in the art considering the ’254 patent in its entirety would reasonably understand that the claim term “request to provision” includes a request to add *new* applications and services, *as well*

as manage existing applications and services to which a client has already subscribed.

Based on the complete record, we determine that Petitioner has established that the combined teachings of the asserted prior art as described in the Petition with respect to [1.4] satisfy the limitation “*wherein the server is configured to: receive a request to provision a second service for the first user.*”

c. [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

For this limitation, Petitioner asserts that “Bodart and Dharmarajan render obvious a user providing an IM username and password into the user data module.” Pet. 36 (citing *id.* at Pet. Section XI.D.[1.4]; Ex. 1003 ¶¶ 107–111). Petitioner asserts that “[t]he IM username (see Ex. 1007, 1:33–35) renders obvious a “*second ID [] utilized by the second provider to identify the first user.*” Pet. 36 (citing Ex. 1003 ¶¶ 123–124).

Petitioner explains that “Bodart describes functionalities of the virtual assistant that combine telephone service associated with a telephone number, and a second communication service associated with a different electronic ID.” Pet. 36. According to Petitioner, “Bodart teaches that, in response to an incoming phone call, the ‘virtual assistant 101 may **put [the call] on hold** and attempt to reach user 201 via phone or **instant message.**” Pet. 36 (citing Ex. 1005 ¶ 60). Petitioner asserts that “Bodart further teaches that the user data module may store user account information ‘including email passwords, website passwords, and so forth.’” Pet. 36 (citing Ex. 1005 ¶ 22; Ex. 1003 ¶¶ 125–126).

Petitioner asserts that “Bodart teaches the server sending an IM to a user receiving a phone call, but provides limited details on how this is done.” Pet. 36 (citing Ex. 1003 ¶¶ 126–127). Petitioner also asserts that “Banister and Dharmarajan provide implementation details for providing access to electronic communications by phone.” Pet. 36 (citing Ex. 1006, code (57); Ex. 1007, 1:33–38; Ex. 1003 ¶ 127). “For instance,” Petitioner explains, “Banister describes ‘converting a textual portion of an electronic mail message into audio and delivering the audio through a telephone call to a recipient.’” Pet. 36–37 (citing Ex. 1006, code (57)). According to Petitioner, Banister also “explains that ‘an [email] **address** specified by an originator of a message may be . . . used to **look-up a telephone number**.’” Pet. 37 (citing Ex. 1006, 4:14–17). Petitioner explains that “[t]o facilitate the look-up, a ‘mail server may maintain a list or **database of addresses with associated telephone numbers**.’” Pet. 37 (citing Ex. 1006, 2:1–5; *see also id.* at 7:8–10; Ex. 1003 ¶ 127). “Thus,” argues Petitioner, “Banister teaches ‘*a mapping from the first telephone number to*’ an email address.” Pet. 37 (citing Ex. 1003 ¶ 127). Petitioner notes that “[w]hile Banister primarily describes email messages, Dharmarajan explains that logging into an IM service involves an IM username and password.” Pet. 37 (citing Ex. 1007, 1:33–38; Ex. 1003 ¶¶ 31–32, 128).

According to Petitioner, a person of ordinary skill in the art implementing Bodart’s IM functionalities for notifying a user of an incoming call would have found it obvious to consider other references like Banister and Dharmarajan, which simply provide the implementation details that Bodart expects. Ex.1003, ¶128. In this regard, it would have been obvious to incorporate Banister’s database of telephone numbers mapped to electronic addresses to facilitate Bodart’s functionalities that involve two different types of communication identifiers (e.g.,

IM username and telephone number). Ex.1005, [0002]; Banister, Abstract; Dharmarajan, 1:33-38; Ex.1003, ¶128. The mapping between the user's telephone number and IM username would facilitate the virtual assistant notifying the user by IM about the incoming call. Ex.1005, [0060]; Ex.1003, ¶128. This renders obvious “*create a mapping from the first telephone number to a second identifier (ID).*” Ex.1003, ¶128. Further, it would be obvious to a POSITA for the virtual assistant to create the mapping between the telephone number and the IM username when the user configures the user data module with the IM login credentials (“*responsive to receiving the request*”).

Pet. 37–38 (citing Ex. 1003 ¶¶ 28–30, 129).

Petitioner also provides an email example for this limitation, relying on teachings from Bodart. See Pet. 38–39 (citing Pet. Section XI.D.5.[1.4]; Ex. 1003 ¶¶ 130–132).

Patent Owner argues that “[i]ncorporating 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.” PO Resp. 37 (citing Ex. 2006 ¶ 103). Patent Owner argues that “[t]here 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.” PO Resp. 37 (citing Ex. 1005 ¶ 57; Ex. 2006 ¶ 103).

Patent Owner also argues that a person of ordinary skill in the art “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.” PO Resp. 37 (citing Ex. 1005 ¶¶ 24, 57; Ex. 2006 ¶ 104). Patent Owner argues that “Petitioner has not shown that the ‘mapping’ or ‘associat[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." PO Resp. 37 (citing Ex. 2006 ¶ 104).

Patent Owner's argument that "[i]ncorporating 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" is based on Patent Owner's interpretation that the claim term "request to provision" *requires* a request to add a *new* service, including by activating a *new* subscription or account for the *new* service. *Id.* As we explain in Sections III.C.1.b and III.E.3.b, above, the recited term "request to provision" may also include managing existing applications and services to which a client has already subscribed. The Petition describes such a situation where it explains that "it would be obvious to a POSITA for the virtual assistant to create the mapping between the telephone number and the IM username when the user configures the user data module with the IM login credentials (*"responsive to receiving the request"*). Pet. 38 (citing Ex. 1003 ¶¶ 28–30, 129).

Further, we determine that Petitioner has sufficiently explained how mapping is done "responsive to" receiving a request to provision a second service. Petitioner explains that in the proposed combination, it would have been obvious to create the mapping "when the user configures the user data module with the IM login credentials"; i.e., responsive to provisioning the second service of "handling of IMs" that requires the user to provide credentials. Pet. 32, 38. In response to Patent Owner's argument that "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," Petitioner

explains that “Bodart’s virtual assistant would also use the callee’s telephone number (i.e., the number being called) to determine which of its configured users (1) to inform via IM that they received a call to their number or (2) to inform via phone call that they received an email.” PO Resp. 37; Pet. Reply 20–21 (citing Ex. 1005 ¶ 60; Ex. 1006, code (57), 4:14–17; Pet. 35–39).

Based on the complete record, we determine that Petitioner has established that the combined teachings of the asserted prior art as described in the Petition with respect to [1.6] satisfy the limitation “*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.*”

d. [1.7] activate the second service with the second provider utilizing the second ID as a user ID for the first user

For this limitation, Petitioner asserts that “Dharmarajan’s disclosure of the IM username (*see* Ex.1007, 1:33–35) teaches the ‘*second ID.*’” Pet. 40 (citing Pet. Sect. XI.D.5.[1.6]; Ex. 1003 ¶ 124). Petitioner points out that “Dharmarajan explains that a user may provide an IM username and password ‘to gain access to the server computer that provides the instant messaging service.’” Pet. 40 (citing Ex. 1007, 1:33–38; Ex. 1003 ¶ 136).

According to Petitioner,

[i]t would have been obvious to a [person of ordinary skill in the art] that Bodart’s virtual assistant would login to an IM service (‘*activate the second service*’) when the user configures the IM username and password (‘*responsive to receiving the request*’), for example, to confirm that the username and password are correct.

Pet. 40 (citing Ex. 1003 ¶¶ 31–32, 137). Petitioner asserts that “[g]aining access to the IM service would be an obvious part of the virtual assistant

‘handling incoming . . . instant messages’ and ‘send[ing] messages using an instant message client.’” Pet. 40 (citing Ex. 1005, code (57), ¶ 34; Ex. 1007, 9:57–61; Ex. 1003 ¶¶ 137–138). Petitioner argues that “[i]t would also have been obvious that the IM service provider would utilize the IM username as ‘a user ID’ for the user.” Pet. 40 (citing Ex. 1005 ¶ 34; Ex. 1003 ¶¶ 135, 138).

Petitioner also provides an email example for this limitation, relying on teachings from Bodart. *See* Pet. 40–41 (citing Pet. Section XI.D.5.[1.6]; Ex. 1003 ¶¶ 31–32, 135, 139–141; Ex. 1005 ¶ 40).

Patent Owner argues that

[l]ogging in to an existing service through a different platform does not “activate the second service with the second provider,” as the claim requires. Even if logging in could be considered some sort of “activation,” it would at most be made available within Bodart’s virtual assistant, and not “activate[d] . . . with the second provider,” as required by the claim.

PO Resp. 39 (citing Ex. 2006 ¶ 109).

Patent Owner argues that “Petitioner’s understanding of ‘activate’ to mean log in or access is not consistent with the description of the ’254 Patent.” PO Resp. 40 (citing Ex. 2006 ¶ 112). “As used throughout the ’254 Patent,” Patent Owner argues, “to ‘activate’ a service involves creating a new subscription or account for the service, and the term ‘activate’ is not used to refer to logging into or accessing an existing service through a particular platform.” PO Resp. 40. Patent Owner refers to embodiments described in connection with Figures 4 and 11 from the ’254 patent to support its argument that “activation” involves the purchase of a new application or a new subscription with an application provider. PO

Resp. 40–42 (citing Ex. 1001, 13:24–27, 44–47, 53–56, 14:3–6, 6:66–7:2, 7:2–9; Ex. 2006, ¶¶ 114, 116).

In its Reply, Petitioner argues that Patent Owner’s positions fail because of their dependence on its incorrect interpretations of the “*request to provision*” and “*activate*” claim terms. Pet. Reply 21. Petitioner argues that “while the user’s IM or email account might have already existed, the virtual assistant’s IM- or email-based services would not have been ‘*activate[d]*’ until the user provided their login credentials and the virtual assistant confirmed its access to those accounts.” Pet. Reply 21–22 (citing Pet. 39–41; Ex. 1003 ¶¶ 31–32; Ex. 1030 ¶ 36). Petitioner argues that a “service being ‘*activate[d]*’ involves the virtual assistant accessing the user’s IM or email account, which is provided by ‘*the second provider*,’ such as AOL, Microsoft, Gmail, or Hotmail.” Pet. Reply 22 (citing Pet. 35). “Thus,” Petitioner argues, “having the virtual assistant log into the second provider’s server to gain authenticated access to the service is activating the service ‘*with the second provider*.’” Pet. Reply 22 (citing Pet. 40–41; Ex. 1030 ¶ 37).

We disagree with Patent Owner because its arguments rely on the erroneous view that the recited claim language “activate the second service” involves “creating a new subscription or account for the service.” *See, e.g.*, PO Resp. 40 (“[a]s used throughout the ’254 Patent, to ‘activate’ a service involves creating a new subscription or account for the service”); PO Sur-reply 19 (“to ‘activate’ a service with a provider involves creating a new subscription or account with the provider for the service”). Patent Owner’s arguments fail to take into account embodiments described in the ’254 patent where unified services enabler platform 140 may activate services using the appropriate API for the provider which will deliver the requested service and

client 110 may enter a portal for platform 140 in which client 110 *may add new applications and services as well as manage existing applications and services to which client 110 has already subscribed*. See Ex. 1001, 4:29–31, 50–55. As we explain in Section III.C.1.c, a person of ordinary skill in the art considering the ’254 patent in its entirety would reasonably understand that the phrase “*activate the second service*” may include a request to add new applications and services, as well as manage existing applications and services to which a client has already subscribed.

Based on the complete record, we determine that Petitioner has established that the combined teachings of the asserted prior art as described in the Petition with respect to [1.7] satisfy the limitation “*activate the second service with the second provider utilizing the second ID as a user ID for the first user.*”

- e. [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*

For this limitation, Petitioner asserts that “Bodart discloses that ‘virtual assistant may put [a call] on hold and attempt to reach user 201 via . . . instant message.’” Pet. 41 (citing Ex. 1005 ¶ 60) (emphasis omitted). “Thus,” Petitioner argues, “Bodart teaches using IM service (*‘the second service’*) to reach the user when the virtual assistant intercepts a call to a telephone number associated with the user or virtual assistant (*‘the first telephone number’*).” Pet. 41 (*see also* Ex. 1003 ¶ 145). According to Petitioner, “Bodart teaches that these functionalities may be facilitated by a stored ‘set of rules . . . setting forth the logic used by virtual assistant to aid the user.’” Pet. 41 (citing Ex. 1005 ¶¶ 21, 57, 60). Petitioner argues that “[i]t would have been obvious to a [person of ordinary skill in the art] for the

virtual assistant to use stored rules associating the IM service with ‘*the first telephone number*’ to automate the IM functionality described above.”

Pet. 41–42 (citing Ex. 1005 ¶ 60; Ex. 1003 ¶¶ 142–145).

Petitioner asserts that “Bodart further explains that ‘a user may be able to send messages using an instant message client.’” Pet. 42 (citing Ex. 1005 ¶ 34). Petitioner points out that “Dharmarajan explains that an ‘instant messaging client’ performs a login ‘to gain access to the server computer that provides the instant messaging service.’” Pet. 42 (citing Ex. 1007, 1:35–38). According to Petitioner, “[i]t would have been obvious to a [person of ordinary skill in the art] that Bodart’s account information would include the name or address of the IM server computer (‘*routing and interworking data necessary to utilize the second service*’) for gaining access to the IM service.” Pet. 42 (citing Ex. 1005 ¶¶ 34, 60; Ex. 1003 ¶¶ 146–147). Petitioner asserts that “[t]he name or address of the IM server computer would be stored in the account information with the telephone number of the virtual assistant or user (‘*the first telephone number*’), and therefore would be ‘*associated with*’ the telephone number.” Pet. 42 (citing Ex. 1005 ¶ 22; Ex. 1003 ¶ 147).

Petitioner also provides an email example for this limitation, relying on teachings from Bodart. *See* Pet. 40–41 (citing Pet. Section XI.D.5.[1.6]; Ex. 1003 ¶¶ 31–32, 135, 139–141; Ex. 1005 ¶ 40).

Patent Owner argues that Bodart’s “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.” PO Resp. 45 (citing Ex. 1005 ¶¶ 57, 61–64; Ex. 2006 ¶ 122). Patent Owner argues that a person of ordinary skill in the art “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.” PO Resp. 46 (citing Ex. 2006 ¶ 123). “In other words,” Patent Owner argues, “it is the caller’s number that is ‘associated with routing and interworking’ and not the ‘first telephone number’ of the virtual assistant.” PO Resp. 46.

Patent Owner also argues that “the Petition fails to show that the alleged ‘associat[ing]’ happens ‘responsive to receiving the request’ to provision,” in part because according to Patent Owner, “the Petition appears to rely on executing rules” and “[e]xecuting such rules would not be ‘responsive to receiving the request’ to provision.” *Id.*

In its Reply, Petitioner argues that “it would have been obvious for the virtual assistant to use both the caller’s number and the called (user’s) number to determine which rule(s) to apply.” Pet. Reply 23 (citing Ex. 1030 ¶¶ 38–39). “For example, the user’s phone number (*‘the first telephone number’*) would be used to identify the user’s rules, and thus, the user’s phone number would be ‘associate[d] with’ the IM- or email based action (*‘second service’*).” Pet. Reply 23 (citing Pet. 32, 41–43). “In other words,” Petitioner argues, “Bodart’s rules associate the user’s telephone service (identified by a *‘first telephone number’*) with other communication modalities, and therefore ‘associate’ the user’s phone number ‘with the *second service.*’” Pet. Reply 23 (citing Ex. 1030 ¶ 39).

With respect to Patent Owner’s argument that “[e]xecuting such rules would not be ‘responsive to receiving the request’ to provision,” PO Resp. 46, Petitioner points out that as the Petitioner explains,

the stored rules themselves “associate” IM or email services with “*first telephone number.*” Pet., 41-43 (“obvious...for the virtual assistant to use stored rules associating the IM service with ‘*the first telephone number*’....”). Dr. Houh confirms that

“an association” is “embodied in the rule or set of rules stored in the user data module.” Ex.1003, ¶145. Bodart’s users create their own rules, so it would have been obvious for the rules to be configured as part of the same “*request*” process in which a user provides login credentials.

Pet. Reply 24 (citing Pet. 41–43; Ex. 1005 ¶ 24; Ex. 1030 ¶¶ 39–40).

We credit Dr. Houh’s testimony that Bodart’s rules for automating a virtual assistant’s functionalities using the name or address of an IM server computer stored in a user data module with the telephone number of the virtual assistant or user would satisfy the recited association between the “*second service*” and the “*first telephone number*.”

Based on the complete record, we determine that Petitioner has established that the combined teachings of the asserted prior art as described in the Petition with respect to [1.8] satisfy the limitation “*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.*”

4. Conclusion as to Independent Claim 1

Based on the complete record, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that the combined teachings of Bodart, Banister, and Dharmarajan satisfy the recited subject matter of claim 1 and that a person of ordinary skill in the art at the time of the invention would have combined the references in the manner proffered and would have had a reasonable expectation of success in that endeavor.

5. Independent Claims 7 and 13

Petitioner presents evidence and arguments that the combined teachings of Bodart, Banister, and Dharmarajan meet the recited limitations of independent claims 7 and 13. Petitioner provides a detailed explanation

of how the combined teachings of the asserted art meet each claim limitation as well as a rationale for combining the art in the manner proffered. *See* Pet. 46–47 (claim 7), 48–50 (claim 13). Dr. Houh provides supporting testimony for Petitioner’s positions. *See* Ex. 1003 ¶¶ 167–173, 177–187.

Patent Owner argues that Petitioner has not shown that the asserted prior art teaches or renders obvious these claims. *See* PO Resp. 47–49. With respect to claims 7 and 13, Patent Owner argues that a person of ordinary skill in the art “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.’” PO Resp. 48–49 (citing Ex. 2006 ¶ 76).

We have considered Petitioner’s evidence and arguments as well as Patent Owner’s evidence and arguments with respect to independent claims 7 and 13. We credit Dr. Houh’s testimony with respect to Bodart’s virtual assistant, in particular Dr. Houh’s testifies that

Bodart discloses that the “virtual assistant also has a rules engine enabling a user to create rules for **handling incoming calls** and ... rerouting calls based on their caller identification.” Bodart, Abstract. Further, “Message & call routing 112 may enable virtual assistant 101 to intercept **incoming telephone calls**.” Bodart [0025]. Further still, the “[v]irtual assistant 101 may include the ability to **receive and direct calls** and messages directed to **user 201**.” Bodart, [0044].

Additionally, Bodart teaches that the virtual assistant may have “the ability to **initiate** telephone calls.” Bodart, [0027]. Bodart discloses that the virtual assistant is accessible through a conventional telephone 146 and a cell phone 145.

Ex. 1003 ¶¶ 169, 183 (citing ¶¶ 98–99).

Based upon the complete record, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that the combined

teachings of the asserted art satisfy the recited limitations of independent claims 7 and 13, and that a person of ordinary skill in the art at the time of the invention would have combined the references in the manner proffered and would have had a reasonable expectation of success in that endeavor.

6. Dependent Claims 2, 6, 8, 12, and 14

Petitioner presents evidence and arguments that the combined teachings of Bodart, Banister, and Dharmarajan meet the recited limitations of dependent claims 2, 6, 8, 12, and 4. Petitioner provides a detailed explanation of how the combined teachings of the asserted art meet each claim limitation as well as a rationale for combining the art in the manner proffered. *See* Pet. 43–46 (claim 2), 46 (claim 6), 47–48 (claims 8 and 12), and 50 (claim 14). Dr. Houh provides supporting testimony for Petitioner’s positions. *See* Ex. 1003 ¶¶ 152–189.

Patent Owner relies on its arguments with respect to claims 1, 7, and 13 to argue that Petitioner has not shown that the asserted prior art teaches or renders obvious these claims. *See* PO Resp. 47–49.

We have considered Petitioner’s evidence and arguments as well as Patent Owner’s position with respect to dependent claims 2, 6, 8, 12, and 14. Based upon the complete record, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that the combined teachings of the asserted art satisfy the recited limitations of dependent claims 2, 6, 8, 12, and 14, and that a person of ordinary skill in the art at the time of the invention would have combined the references in the manner proffered and would have had a reasonable expectation of success in that endeavor.

F. Obviousness Over de Castro (Ground 2)

Petitioner contends that claims 1, 2, 6–8, and 12–14 are unpatentable under 35 U.S.C. § 103(a) as obvious over de Castro. Pet. 50–76. We have determined that these claims are unpatentable either over the combined teachings of Bodart, Banister, and Dharmarajan (Ground 1). *See* Section III.E. Accordingly, we need not address Petitioner’s alternative Ground 2 based on de Castro. *See Boston Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App’x 984, 990 (Fed. Cir. Apr. 30, 2020) (non-precedential) (recognizing that “the Board need not address issues that are not necessary to the resolution of the proceeding” and that the Board has “discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims”).

IV. CONCLUSION

For the foregoing reasons, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, 6–8, and 12–14 of U.S. Patent 9,210,254 B2 are unpatentable on the bases set forth in the following table.

Claim(s) Challenged	35 U.S.C. §	References	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1, 2, 6–8, 12–14	103	Bodart, Banister, Dharmarajan	1, 2, 6–8, 12–14	
1, 2, 6–8, 12–14	103	de Castro ⁴		
Overall Outcome			1, 2, 6–8, 12–14	

⁴ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this

V. ORDER

Upon consideration of the foregoing, it is

ORDERED that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, 6–8, and 12–14 of U.S. Patent 9,210,254 B2 are unpatentable; and

FURTHER ORDERED that because this is a Final Written Decision, any party to the proceeding seeking judicial review of this Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

Final Decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

⁴ Because each of these challenged claims is held unpatentable on other grounds, we do not reach Ground 2 in the Petition.

IPR2023-00553
Patent 9,210,254 B2

PETITIONER:

Theodore M. Foster
David L. McCombs
Eugene Goryunov
Samuel M. Drezdzon
Brett Bostrom
HAYNES AND BOONE, LLP
ipr.theo.foster@haynesboone.com
david.mccombs.ipr@haynesboone.com
eugene.goryunov.ipr@haynesboone.com
samuel.drezdzon.ipr@haynesboone.com
brett.bostrom.ipr@haynesboone.com

PATENT OWNER:

Bradley D. Liddle
Michael Pomeroy
Scott Breedlove
Howard L. Lim
Jeffrey Stephens
CARTER ARNETT PLLC
bliddle@carterarnett.com
mpomeroy@carterarnett.com
sbreedlove@carterarnett.com
hlim@carterarnett.com
jstephens@carterarnett.com