

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC, SAMSUNG ELECTRONICS CO. LTD.,
AND SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

MULTIMODAL MEDIA LLC,
Patent Owner.

IPR2024-00063
Patent 9,185,227 B2

Before WILLIAM V. SAINDON, ARTHUR M. PESLAK, and
SCOTT RAEVSKY, *Administrative Patent Judges*.

SAINDON, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Google LLC, Samsung Electronics Co. Ltd., and Samsung Electronics America, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–6, 8–15, and 17–19 (“the challenged claims”) of U.S. Patent No. 9,185,227 B2 (Ex. 1001, “the ’227 patent”). Multimodal Media LLC (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review under 35 U.S.C. § 314(b) and 37 C.F.R. § 42.4(a). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons provided below, we determine that Petitioner has satisfied the threshold requirement set forth in 35 U.S.C. § 314(a). Because Petitioner has demonstrated a reasonable likelihood that at least one claim of the ’227 patent is unpatentable, we institute an *inter partes* review. 37 C.F.R. § 42.108(a).

Our findings of fact, conclusions of law, and reasoning discussed below are based on the evidentiary record developed thus far, and made for the sole purpose of determining whether the Petition meets the threshold for initiating review. This decision to institute trial is not a final decision as to the patentability of any challenged claim or the construction of any claim limitation.

B. Real Parties in Interest

The parties identify only themselves as the real parties in interest.
Pet. 2; Paper 6, 2 (Patent Owner's Mandatory Notices).

C. Related Matters

The parties identify the following matters in which the '227 patent has been asserted:

Multimodal Media LLC v. Samsung Electronics Co. Ltd., et al., 2:22-CV-00462 (E.D. Tex.)

Multimodal Media LLC v. TCL Technology Group Corporation et al., 2:22-cv-00463 (E.D. Tex.)

Pet. 2; Paper 6, 2.

D. Prior Art and Asserted Grounds

Petitioner's grounds rely on the following prior art references:

Name	Reference	Exhibit No.
Prikowitsch	WO 2010/139478 A1, pub. Dec. 9, 2010	1011
Roujinsky	WO 2008/050325 A1, pub. May 2, 2008	1012
Sar-Shalom	US PG Pub. 2004/0267884 A1, pub. Dec 30, 2004	1013

Petitioner asserts that the challenged claims would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 5, 8–12, 15, 17–19	103	Prikowitsch
3, 4, 9, 13, 14, 18	103	Prikowitsch, Roujinsky
1, 2, 6, 8–12, 17–19	103	Sar-Shalom
3–5, 13–15	103	Sar-Shalom, Roujinsky

E. Background and Overview of the '227 Patent

The '227 patent notes that, for example, a caller may wish to leave a voicemail when a called party is unavailable, but the called party has not set up their voicemail system. Ex. 1001, 1:15–53. The '227 patent allows a caller to leave a voicemail or other message with the called party using a system that is not reliant on the called party having set up such a system, leaving the calling party in control of what to do next. *Id.* at 1:54–63, 2:34–43. Leaving a voicemail or other message, or otherwise taking an action as a consequence of an incomplete call, is called a “call completion action.” *See, e.g., id.* at 1:54–53, 3:4–18. As set out in the abstract to the '227 patent:

A method and a system for completing an incomplete call made by a calling party to a called party, provide a call completion application on a calling party device. The call completion application detects an incomplete call, which is a call that is not connected to a called party device or a short duration call that does not enable an intended communication to occur between the calling party and the called party. The call completion application determines one or more call completion actions, for example, setting a reminder, transmitting media data, etc., to be performed to complete the incomplete call, for example, based on user selections, a duration of the incomplete call, user configuration of the call completion application on the calling party device, etc. The call completion application triggers execution of the determined call completion actions based on one or more action execution criteria for completing the incomplete call.

Id., Abstract.

F. Challenged Claims

Claims 1–6, 8–15, and 17–19 are challenged. Claims 1 and 11 are independent. Claim 1 is reproduced below.

1. A computer implemented method for completing an incomplete call made by a calling party to a called party, comprising:

providing a call completion application executable by at least one processor on a calling party device;

detecting said incomplete call made by said calling party to said called party, by said call completion application on said calling party device, wherein said incomplete call is a call that is not connected to a called party device due to occurrence of one or more of a plurality of events;

receiving one or more of a plurality of call completion actions to be performed by said call completion application on said calling party device to complete said detected incomplete call, wherein said plurality of call completion actions are selected according to one or more responses provided by said calling party through a graphical user interface of said calling party device, wherein said call completion actions comprise setting a reminder to call back said called party at a configurable time, recording media data on said calling party device, transmitting said media data to a called party device, transmitting a missed call alert to said called party device, transmitting a notification of said detected incomplete call to said called party device, transmitting a notification on availability of said called party, transmitting said media data to a social networking platform, transmitting an automated message requesting said called party to call back said calling party when available, and any combination thereof; and

triggering execution of said received one or more of said call completion actions by said call completion application on said calling party device based on one or more of action execution criteria for said completion of detected incomplete call.

II. DISCRETIONARY ANALYSIS

Patent Owner argues that we should deny institution under *Fintiv* based on the related district court matters identified above. Prelim. Resp.

16–23; *see Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 11–12 (PTAB Mar. 20, 2020) (precedential) (holding that PTAB has discretion to deny institution in certain circumstances where there are parallel district court proceedings). Our analysis under *Fintiv* is guided by the USPTO Director’s Memorandum issued on June 21, 2022, titled “Interim Procedure for Discretionary Denials in AIA Post Grant Proceedings with Parallel District Court Litigation” (“Director’s Memo”). Pursuant to the Director’s Memo, we “will not discretionarily deny institution . . . where a petitioner presents a [*Sotera*] stipulation.” Director’s Memo at 3 (citing *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A)). Because Petitioner has offered a stipulation like in *Sotera*, i.e., to “not pursue as to the challenged claims any ground raised or that could have been reasonably raised in the IPR” (Ex. 1055, 2), we do not discretionarily deny institution under *Fintiv*.

As to Patent Owner’s allegation that Petitioner should not be able to file a stipulation after the Preliminary Response (Prelim. Resp. 22–23), we determine that Petitioner’s filing of its *Sotera* stipulation at the time it did is proper. *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 (PTAB Sept. 7, 2022) (precedential) (holding the Board may only consider stipulations offered before a decision on institution).

III. MERITS ANALYSIS

A. Legal Standards Used in the Merits Analysis

“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with

particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

A claim is unpatentable under 35 U.S.C. § 103 if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious . . . to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective evidence of non-obviousness, i.e., secondary considerations. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Petitioner asserts that a person of ordinary skill in the art:

would have had a bachelor’s degree in electrical engineering, computer science, computer engineering, or a related field, and two-three years of experience with multimedia and Internet-related communications technologies, or the equivalent, with additional education substituting for experience and vice versa.

Pet. 7.

Patent Owner agrees with Petitioner’s proposed level of skill at this time. Prelim. Resp. 4. We adopt Petitioner’s definition for purposes of this Decision, which appears consistent with the level of disclosure provided in the ’227 patent and the prior art cited.

C. Claim Construction

Both of the parties propose a claim construction for the term “call completion application” found throughout the claims. The call completion application is central to claim 1. Claim 1 specifies that the call completion application is executable on the calling party device, that it detects an incomplete call, that it receives a call completion action¹ from the calling user, and that it executes that action. We will present both of the parties’ constructions, and then offer our analysis of this term.

Petitioner proposes that a “call completion application” should be construed as “a software module that completes an incomplete call made by a calling party that is independent of a preconfigured call completion service, such as voicemail, that is on the called device.” Pet. 9. Petitioner asserts that its proposed construction is consistent with the specification, which states that the call completion application is “independent of a preconfigured call completion service on the called party’s network or a called party device.” *Id.* (citing Ex. 1001, 1:63–62). Petitioner points out that, in the specification, a “call completion service” could be a voicemail service on the called device. *Id.* (citing Ex. 1001, 1:24–43).

Patent Owner proposes that, if “call completion application” is to be construed at all, it should be construed as “a software module that completes an incomplete call made by a calling party without any dependence on the underlying network or called party device.” Prelim. Resp. 4–5. Patent

¹ A call completion service is traditionally best exemplified by a voicemail system. Ex. 1001, 1:20–23, 44–45. A “call completion action” includes actions such as setting a reminder to call back the called party, recording and transmitting text or voice messages to the called party, transmitting a missed call alert to the called party, etc. *See, e.g., id.* at 1:53–62, 3:7–34.

Owner points out that, in the specification, the '227 patent requires that the “*calling party device*, rather than a service associated with the called party device or the network server, ‘determines one or more of multiple call completion actions to be performed to complete the detected incomplete call.’” *Id.* (citing Ex. 1001, 3:4–7). Patent Owner also quotes language in the specification that states, “furthermore, the method and the system disclosed herein implement a call completion service without any dependence on the underlying network to support call completion for the called party.” *Id.* at 5 (citing Ex. 1001, 2:26–38).

We first turn to the specification for context. The '227 patent alleges that there was a problem with conventional call completion systems such as voicemail. Ex. 1001, 1:43–53. According to the '227 patent, those systems require the called party to, for example, be reachable and have set up a voicemail system. *Id.* The calling party has no control over whether the called party is reachable or sets up its voicemail system, potentially limiting the calling party’s options for satisfactorily resolving an incomplete call. *Id.* The '227 patent allows the calling party to choose what type of call completion actions are undertaken, such as to set up a reminder to re-call the person, or to transmit a voice message or text message to the called party using a system that does not rely on the called party to be available or have a preconfigured call completion service such as voicemail. *Id.* at 1:54–62.

Before a calling party can perform a call completion action in response to an incomplete call, there must necessarily be an incomplete call. Accordingly, there must be some way for the system to know that an incomplete call has occurred. In the '227 patent, the exemplary embodiment states that the calling party device is installed as an application on a cell

phone. *Id.* at 15:51–55. In the embodiment, the call completion application determines whether a call is complete by receiving call status information through the interface provided by the cell phone’s operating system. *Id.* at 15:55–17:8. Thus, while the application in this exemplary embodiment does not detect the incomplete call directly by receiving messages from the network, it detects the incomplete call indirectly from the network by receiving messages from the phone’s operating system, which would have received messages from the network. *See also id.* at 12:56–13:33 (describing how the devices are connected through a network and that the network notifies the calling party device of an unanswered call), 14:32–38 (“[T]he call detection module 202a . . . in communication with a software application and the [cellular] network 205 . . . detect[s] an incomplete call.”).

The call completion actions are executed by the call completion application on the calling device. Call completion occurs “without any dependence on the underlying network to support call completion for the called party.” Ex. 1001, 2:34–37. Notably, however, in the context of the ’227 patent, this independence is with respect to the *choice* of how to complete the call. We do not find any disclosure in the ’227 patent suggesting the claimed invention operates in isolation from the underlying networks—either in determining whether a call is incomplete (as previously discussed) or in carrying out the call completion action (*see, e.g., id.* at 11:36–41 (“the call completion application determines the call completion action to be executed, including a mode of transmission of a media message from the calling party device to the called party device via a network”), 13:34–14:20 (explaining ways to deliver messages to the called party using a network)). Instead, it is the choice of call completion action that does not

rely on the network; that is, it is the user that gets to choose how to complete the call and the call completion application facilitates the user's choice. *See, e.g., id.* at 11:36–41 (“the call completion application determines the call completion action to be executed, including a mode of transmission of a media message from the calling party device to the called party device via a network”).

In summary, we determine that adoption of either party's proposed construction does not provide a meaningful difference at this time; both appear to cover the same idea. Indeed, given that the claims already state that the call completion application detects an incomplete call, receives a call completion action, and triggers execution of the call completion action, we see no reason to construe “call completion application” to require anything beyond what is already in the claims. On this record, we see no support in the claims or specification to hold that a “call completion application” can be read as operating without reliance on a network in some way.² Instead, after the call completion application becomes aware of an incomplete call, the application receives a choice from a user and triggers execution of that choice, and in accordance with the '227 patent

² To the extent Patent Owner's proposed construction is seeking to preclude a network in the *performance* of the call completion application, then we would not agree with that construction. The call completion application is always dependent on the infrastructure of a communication network; as should be clear from our analysis above, the '227 patent is focused on independence from the call completion services provided by the called party's network. Notwithstanding the choice of call completion action being independent of the call completion services provided by the called party's network, the call completion action still must rely on the network to provide the infrastructure to carry out certain actions.

specification, it is that choice that is not premised on a limitation imposed by the called party's network. Ex. 1001, 1:54–62 (“a system that complete[s] an incomplete call . . . *independent of a preconfigured call completion service* on the called party's network”) (emphasis added), 2:39–43 (“the system . . . enables transmission of a voice message by a calling party to a called party when a network component or a called party device is not configured to offer a call completion option to the calling party to leave a voice message”).

We do not explicitly provide a claim construction of any claim limitation in this Decision at this time because the issue of whether Petitioner has shown a reasonable likelihood can be resolved without explicitly construing the claim. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms. . . that are in controversy, and only to the extent necessary to resolve the controversy.’”) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). However, our analysis places the parties on notice of the potential scope of the claims.

D. Asserted Obviousness Grounds

Petitioner asserts that claims 1, 2, 5, 8–12, 15, and 17–19 would have been obvious over Prikowitsch. Pet. 16–37. Petitioner also asserts that claims 3, 4, 9, 13, 14, and 18 would have been obvious in view of Prikowitsch and Roujinsky (*id.* at 37–42); that claims 1, 2, 6, 8–12, and 17–19 would have been obvious in view of Sar-Shalom (*id.* at 42–56); and that claims 3–5 and 13–15 would have been obvious in view of Sar-Shalom and Roujinsky (*id.* at 56–68). Patent Owner offers challenges to the Prikowitsch (Prelim. Resp. 8–12) and Sar-Shalom (*id.* at 12–16) grounds.

The dispute between the parties focuses on certain limitations of claim 1. Claim 1 is directed to a method for completing an incomplete call, involving a “call completion application.” The call completion application, which is on the calling party’s device, detects an incomplete call. The call completion application then receives an action to be taken by the caller to “complete” the incomplete call (e.g., reminder to call again, sending a text message) and performs that action.

1. Prikowitsch Ground

According to Petitioner, Prikowitsch teaches a call control method that allows a calling party to customize and define actions to react to reported call statuses, such as when the called party is busy or offline. Pet. 16 (citing Ex. 1011, 1:22–2:2, 4:13–15). Petitioner asserts that the call application on the calling party’s device allows the calling party to complete an incomplete call by, for example, sending a text or voice message to the called party device. *Id.* at 16–17 (citing Ex. 1011, 4:30–32, 7:4–15); *see also id.* at 17–26 (further details).

Patent Owner argues that Petitioner has failed to show that Prikowitsch describes the alleged call completion application as detecting an incomplete call. Prelim. Resp. 9. In particular, Patent Owner argues that Prikowitsch relies on the network server to notify it that a call has not been completed. *Id.*; *see also id.* at 9–12 (further details).

Based on our claim construction analysis above, Patent Owner’s argument is unavailing under either claim construction. Under Petitioner’s construction, regardless of how the calling party’s phone becomes aware of the incomplete call, the software in Prikowitsch “*completes* an incomplete call . . . independent of a preconfigured call completion service, such as

voicemail, that is on the called device.” Pet. 9 (emphasis added). Similarly, under Patent Owner’s construction, Prikowitsch “*completes* an incomplete call . . . without any dependence on the underlying network or called party device.” Prelim. Resp. 4 (emphasis added). As we explained in our claim construction section above, the claim is directed to a call *completion* application; at some level it must always rely on the calling party’s network in order to detect an incomplete call, and the claims do not require that the detection occurs without receiving feedback from the calling party’s network.

Having reviewed the Petition and Preliminary Response, we determine that Petitioner has established a reasonable likelihood in showing that the subject matter of claim 1 of the ’227 patent is unpatentable over Prikowitsch.

2. *Sar-Shalom Ground*

According to Petitioner, Sar-Shalom teaches an automatic messaging client launcher that initiates the communication device’s messaging client to perform or complete selected tasks or processes when the called party is unavailable. Pet. 42–43 (citing Ex. 1013, Abstract, ¶ 25); *see also id.* at 43–52 (further details). Patent Owner argues that Petitioner does not consistently define Sar-Shalom’s call completion application. Prelim. Resp. 12–14.

Patent Owner's argument is not persuasive on this record. According to Patent Owner, claim 1 requires three functions from the call completion application: (1) detect the incomplete call; (2) receive the call completion action; and (3) execute the call completion actions. Prelim. Resp. 12. Patent Owner's issue with the Petition appears to stem from the fact that Figure 1 of Sar-Shalom teaches each of these functions in a different box in a functional diagram:

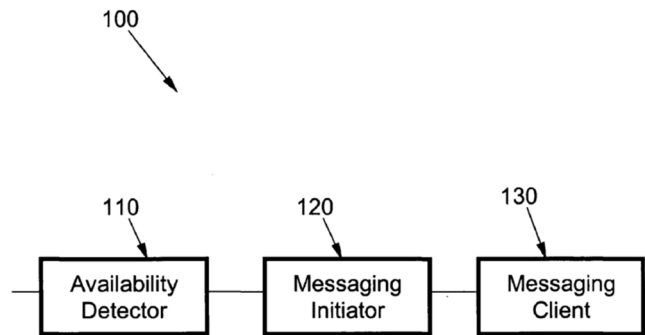


FIG. 1

Figure 1 of Sar-Shalom depicts a simplified block diagram of an automatic messaging client launcher 100 for a communication device. Ex. 1013 ¶¶ 28, 36. Automatic messaging client launcher 100 includes an availability detector 110, a messaging indicator initiator 120, and a messaging client 130. *Id.* ¶ 36. According to Sar-Shalom, automatic messaging client launcher 100 may be an independent component of the communication device, or may be integrated into the messaging client 130. *Id.*

Regardless of where the three software components in Sar-Shalom reside physically, these are all part of the automatic client launcher 100. We see no requirement in the claim as to how the software code is compiled, only that it is located in a way to allow execution by the client device. Further, we see no issue at this time with the way Petitioner has mapped

these limitations to Sar-Shalom. Patent Owner calls out Petitioner for using inconsistent terminology when mapping the “automatic messaging client launcher” in Sar-Shalom as well as an “automatic caller launcher” to the “call completion application” of claim 1. Prelim. Resp. 13–14. However, at this time, the argument appears to be one of form over substance. Although Petitioner uses the phrase “automatic caller launcher” when discussing the call completion application limitation, this appears to be a clerical error. *See* Pet. 43–45. We do not find an “automatic caller launcher” in Sar-Shalom. Instead, reading Petitioner’s analysis as a whole, we are interpreting Petitioner to be using the phrase “automatic caller launcher” as if they meant to say “automatic messaging client launcher,” which Petitioner uses in the rest of its analysis. The phrases are similar, and the citations appear to line up with the same paragraphs and the same teachings. *Compare* Pet. 43–45 with *id.* at 42–43, 45–52. With this understanding, we do not find Petitioner’s position to be unclear at this time. Similarly, we do not see any indication that Petitioner is impermissibly mixing and matching embodiments.

Having reviewed the Petition and Preliminary Response, we determine that Petitioner has established a reasonable likelihood in showing that the subject matter of claim 1 of the ’227 patent is unpatentable under Sar-Shalom.

3. *Merits Conclusion*

Petitioner has established a reasonable likelihood of success with respect to the Prikowitsch and Sar-Shalom grounds on claim 1. We have addressed already each of Patent Owner’s arguments; Patent Owner does not

make specific arguments with respect to the other claims and grounds at this time.

IV. CONCLUSION

For the reasons given above, we determine that Petitioner has established a reasonable likelihood of success in showing that claim 1 would have been obvious in view of Prikowitsch or Sar-Shalom. Accordingly, we institute *inter partes* review on all challenged claims and grounds. 37 C.F.R. § 42.108(a) (“When instituting . . . review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that an *inter partes* review of claims 1–6, 8–15, and 17–19 of the ’227 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), the *inter partes* review of the ’227 patent commences on the entry date of this Decision, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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