

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,

Petitioner,

v.

DAMAKA, INC.,

Patent Owner.

Patent No. 9,578,092

Filing Date: October 19, 2016

Issue Date: February 21, 2017

Inventors: Sivakumar Chaturvedi, Satish Gundabathula, and Rashmi Hiremath

Title: SYSTEM AND METHOD FOR PROVIDING
ADDITIONAL FUNCTIONALITY TO EXISTING SOFTWARE IN AN
INTEGRATED MANNER

PATENT OWNER'S PRELIMINARY RESPONSE

Case No. IPR2026-00208

TABLE OF CONTENTS

	Page(s)
I. INTRODUCTION	1
II. CLAIM CONSTRUCTION	1
III. LEVEL OF ORDINARY SKILL IN THE ART	2
IV. THE PETITION SHOULD BE DENIED	2
A. The Petition is Defective Because Petitioner Presents Inconsistent Claim Construction Positions With No Explanation.....	4
B. Ground 1: Petitioner’s combination does not render obvious claims 1-5, 7-10, 12-20, and 22-29	7
1. Claim 1	7
2. Claim 7	9
3. Claim 12	13
4. Claim 22	13
V. GROUND 2: THE ADDITION OF LUDWIG DOES NOT CURE THE DEFICIENCIES OF GROUND 1	13
VI. CONCLUSION.....	14

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple, Inc. v. Contentguard Holdings, Inc.</i> , IPR2015-00355, Decision Denying Institution of Inter Partes Review, Paper 9 (P.T.A.B. June 26, 2015).....	2
<i>Broadcom Corp. v. Emulex Corp.</i> , 732 F.3d 1325 (Fed. Cir. 2013)	4
<i>Carbyne, Inc. v. Tritech Software Sys.</i> , IPR2025-00959, Paper 20 (Director Feb. 19, 2026).....	5, 6
<i>Graham v. John Deere Co. of Kansas City</i> , 383 U.S. 1 (1966).....	2
<i>Innogenetics, N.V. v. Abbott Lab 'ys.</i> , 512 F.3d 1363 (Fed. Cir. 2008)	4
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	3
<i>KSR Int'l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	2
<i>LBT IP I LLC v. Apple Inc.</i> , No. 2022-1613, 2023 WL 3914920 (Fed. Cir. June 9, 2023).....	4
<i>Los Angeles Biomedical Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.</i> , 849 F.3d 1049 (Fed. Cir. 2017)	3
<i>Pers. Web Techs., LLC v. Apple, Inc.</i> , 848 F.3d 987 (Fed. Cir. 2017)	3
<i>Pers. Web Techs., LLC v. Apple, Inc.</i> , 917 F.3d 1376 (Fed. Cir. 2019)	4

<i>Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.</i> , IPR2025-00632, Paper 20 (P.T.A.B. Nov. 3, 2025).....	5, 6
<i>Stratoflex, Inc. v. Aeroquip Corp.</i> , 713 F.2d 1530 (Fed. Cir. 1983)	2
<i>Tesla, Inc. v. Intell. Ventures II LLC</i> , IPR2025-00340, Paper 18 (P.T.A.B. Nov. 5, 2025).....	5, 6
<i>In re Van Os</i> , 844 F.3d 1359 (Fed. Cir. 2017)	4
Statutes	
35 U.S.C. § 112(b)	4
35 U.S.C. § 112(f).....	5
Other Authorities	
37 C.F.R. § 42.104(b)(3).....	1, 5
37 C.F.R. § 42.104(b)(4).....	9

LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Docket Control Order (Dkt. 41) in <i>Damaka, Inc. v. Cisco Sys., Inc.</i> , Case No. 2:25-cv-00593-RWS-RSP, December 5, 2025
2002	Complaint for Patent Infringement (Dkt. 1) in <i>Damaka, Inc. v. Cisco Sys., Inc.</i> , Case No. 2:25-cv-00593-RWS-RSP, May 30, 2025
2003	Defendant Cisco Systems, Inc.’s Invalidity and Subject Matter Eligibility Contentions in <i>Damaka, Inc. v. Cisco Sys., Inc.</i> , Case No. 2:25-cv-00593-RWS-RSP, dated January 15, 2026
2004	Declaration of Siva Chaturvedi, dated March 19, 2026
2005	Webpage capture, Cisco Careers, <i>available at</i> https://careers.cisco.com/global/en/search-results?keywords=WebEx (captured March 19, 2026)

I. INTRODUCTION

On January 13, 2026, Cisco Systems, Inc. (“Petitioner”) submitted a Petition (Paper 2, “Petition” or “Pet.”) to institute *inter partes* review (“IPR”) of U.S. Patent No. 9,578,092 (Ex. 1001, the “’092 Patent”), challenging Claims 1-30 (the “Challenged Claims”). The Petition asserts that: (i) Claims 1-5, 7-10, 12- 20, and 22-29 are rendered obvious over United States Patent Application Publication No. US 2011/0249077 to Abuan (“Abuan” or Ex. 1005), United States Patent Application Publication No. US 2012/0092438 to Guzman Suarez (“Guzman” or Ex. 1006); and United States Patent Application Publication No. US 2013/0019297 to Lawson (“Lawson” or Ex. 1007); and (ii) Claims 6, 11, 21, and 30 are rendered obvious over United States Patent No. US 5,689,641 to Ludwig (“Ludwig” or Ex. 1008) in addition to Abuan, Guzman and Lawson. The Board should deny the Petition for at least the reasons described briefly below.

II. CLAIM CONSTRUCTION

As noted below, the Petition fails to comply with 37 C.F.R. § 42.104(b)(3) because it does not set out “[h]ow the challenged claim[s] are to be construed.” In the District Court Litigation, Petitioner identified multiple terms as allegedly indefinite, but in this proceeding it argues that no construction is necessary without explanation for the inconsistency. Patent Owner believes that claim construction is not required to deny the Petition. Pet. at 17.

III. LEVEL OF ORDINARY SKILL IN THE ART

For the purposes of this Preliminary Response only, Patent Owner utilizes Petitioner's proposed level of skill in the art: "a bachelor's degree in computer science, computer engineering, or an equivalent, and three years of professional experience relating to computer programming. Lack of professional experience can be remedied by additional education, and vice versa." Pet. at 12 (citations omitted).

IV. THE PETITION SHOULD BE DENIED

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) so-called secondary considerations where in evidence. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18 (1966); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983).

The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. See *Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00355, Decision Denying

Institution of Inter Partes Review, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior art references disclose all the elements recited in the Challenged Claims and a relevant, skilled artisan not only could have made, but would have been motivated to combine all the prior art references in the way the patent claims and reasonably expected success. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness determination must consider whether a person of ordinary skill in the art would have the motivation to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Rsch. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual finding as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a person of skill in the art would have had a reasonable expectation of success from such a combination). This combinability determination, as supported by an

articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been obvious.” *In re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references” *Innogenetics, N.V. v. Abbott Lab’ys.*, 512 F.3d 1363, 1373 (Fed. Cir. 2008).

To demonstrate inherent obviousness, an inherent limitation must necessarily be present in the combination of references. *See Pers. Web Techs., LLC v. Apple, Inc.*, 917 F.3d 1376 (Fed. Cir. 2019); *LBT IP I LLC v. Apple Inc.*, No. 2022-1613, 2023 WL 3914920, at *3 (Fed. Cir. June 9, 2023). It is not enough to merely show that it is likely to be present. *Id.*

A. The Petition is Defective Because Petitioner Presents Inconsistent Claim Construction Positions With No Explanation

The Petition alleges that “no terms require express construction” in this Proceeding. However, Petitioner argues in the District Court Litigation that **21** individual claim terms “are indefinite under 35 U.S.C. § 112(b) for failure to inform, with reasonable certainty, those skilled in the art about the scope of the invention.”

Ex. 2003, 60, 61-62. Indeed, the Petitioner argues that numerous terms are “§112(f) nonce terms lacking corresponding structure” but makes no such argument in this proceeding. *Id.* The Petition therefore fails to comply with 37 C.F.R. § 42.104(b)(3) and is defective.

Petitioner provides no explanation for these inconsistent positions. *Compare* Pet. at 17 *with* Ex. 2003, 60, 61-62. By doing so, “Petitioner has engaged in the same inconsistency *Tesla* discourages; namely, arguing indefiniteness in district court and plain and ordinary meaning in this proceeding.” *Carbyne, Inc. v. Tritech Software Sys.*, IPR2025-00959, Paper 20 at 4 (Director Feb. 19, 2026). As the Director stated, “this approach ‘detracts from[] the Office’s goal of ‘providing greater predictability and certainty in the patent system.’” *Id.*

The Director has repeatedly held that such inconsistency, left unexplained, is an independent ground for denying institution. In *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, IPR2025-00632, Paper 20 (P.T.A.B. Nov. 3, 2025) (precedential), the Director held that “when a petitioner takes alternative positions before the Board and a district court, that petitioner should, at a minimum, explain why alternative positions are warranted.” *Id.* at 3-4. In *Tesla, Inc. v. Intell. Ventures II LLC*, IPR2025-00340, Paper 18 (P.T.A.B. Nov. 5, 2025) (informative), the Director applied *Revvo* to deny institution where petitioner argued in district court

that a claim limitation was indefinite while simultaneously telling the Board that “no claim term requires express construction.” *Id.* at 3.

Most recently, in *Carbyne, Inc.*, IPR2025-00959, Paper 20, the Director applied *Revvo* and *Tesla* to a fact pattern that is materially identical to this one. In *Carbyne*, the petitioner argued in District Court that claim terms reciting certain “modules” were indefinite because they should be construed as means-plus-function terms lacking corresponding structure, while arguing before the Board that the same terms required only plain and ordinary meaning. *Id.* at 2-3. The petitioner there — like Petitioner here — attempted to explain away the inconsistency by reframing its District Court position as merely challenging improper functional claiming rather than proposing specific means-plus-function constructions. *Id.* at 4. The Director rejected that explanation: “Petitioner has engaged in the same inconsistency Tesla discourages; namely, arguing indefiniteness in district court and plain and ordinary meaning in this proceeding. . . . [T]his approach ‘detracts from[] the Office’s goal of providing greater predictability and certainty in the patent system.’” *Id.* (quoting *Tesla*, IPR2025-00340, Paper 18 at 4). The Director accordingly granted Director Review, vacated the institution decision, and denied the petition. *Id.* at 4-5.

Petitioner’s inconsistent claim construction positions, offered with no explanation, alone justify denial of institution. *Id.*

B. Ground 1: Petitioner’s combination does not render obvious claims 1-5, 7-10, 12-20, and 22-29

1. Claim 1

The Board should separately decline institution because the Petitioner fails to set forth how the combination renders obvious the limitation “determine that the AN service requires access to a resource that is external to the data processing system.”¹

The Petitioner identifies Abuan’s “video conference server 715” as the resource external to the data processing system. Pet. at 38. Petitioner admits that Abuan does not itself disclose any determining functionality. *Id.* at 39. Indeed, Petitioner tacitly admits that none of the cited art explicitly discloses **determining** whether the A/V requires access to a remote resource.

Instead, Petitioner relies on statements from references—not part of the combination—that logging into servers was known at the time of the invention. *Id.* at 39 (citing “Material Fact #2”); *see also* Pet. at 20 (quoting Ex. 1043, Ex. 1021,

¹ Patent Owner agrees with Petitioner that the reference to “AN” is a printing error and should read “A/V.” Pet. at 38 n.1. For example, the original claims included with the application correctly recite “determine that the A/V service requires access to a resource that is external to the data processing system.” Ex. 1002, 1152.

Ex. 1022, Ex. 1023). But those references are unrelated to video conferencing and do not establish that a POSITA would simply add a login to Abuan.

To avoid that issue, Petitioner focuses on adding Guzman to Abuan. *Id.* at 39-40. In particular, Petitioner relies on Guzman’s “account setup and verification module” and Guzman’s auto-login process. *Id.*, (citing Ex. 1006, [0230], [0056]-[0057]. Guzman’s auto-login process “determines (at 370) whether the previously entered user name and password are valid.” Ex. 1006, [0057]. In some embodiments, the Guzman system verifies the user name and password locally. *Id.* In others, it accesses a remote server that stores login information for numerous users at different locations. *Id.*

Petitioner raises two scenarios to infer a determining step in Guzman, neither of which are supported. In the first, Petitioner states that Guzman, silently, discloses determining on login whether to verify credentials locally or from a remote server. Pet. at 40. But Guzman makes no such decision. As noted above, Guzman discloses different embodiments; some of which store user information locally, and some which store user information on a server. *See* Ex. 1006, [0074] (“As described above, some embodiments store this information locally with the application, while other embodiments contact a remote server to validate the login information.”).

Guzman does not disclose or suggest any embodiments that themselves determine whether to store/verify the information locally.

Petitioner's second scenario also lacks support. In that scenario, Guzman's application would be modified to confirm that the user entered some value in the username and password fields. Pet. at 40-41. If one or both were blank, Petitioner argues, then "it would be obvious for the video conferencing application to determine that contacting the remote server was unnecessary to confirm that the provided password (i.e., no password at all) was invalid." *Id.*

Guzman makes no such disclosure. Instead, Petitioner manufactures one through its expert's declaration. *Id.* But the expert cites to *no* support and merely parrots the exact statement from the Petition. *Compare* Ex. 1003 ¶ 99 *with* Pet. at 40-41. The expert's unsupported testimony on this critical point is entitled to no weight.

Petitioner provides no other argument or basis to render this limitation obvious. Accordingly, the Petitioner fails to identify how "claim is unpatentable" and the Board should deny institution. 37 C.F.R. § 42.104(b)(4).

2. Claim 7

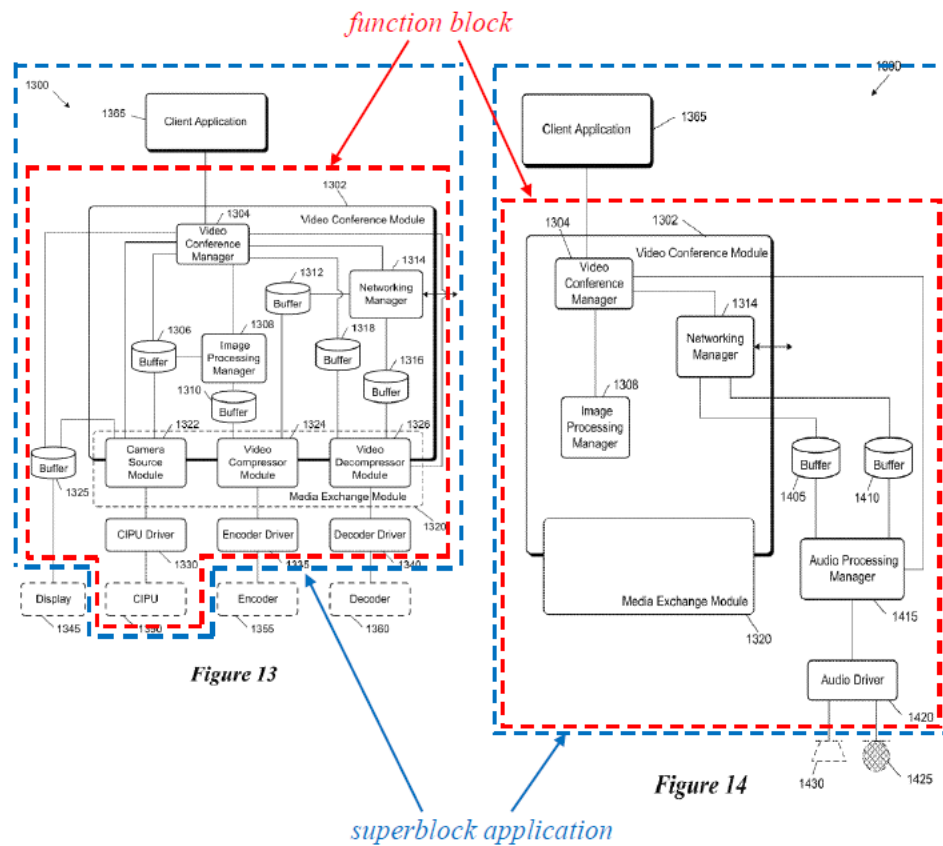
Claim 7 requires a "function block operative when executed by the processor to: notify the superblock application that the communication session is being

requested.” Petitioner’s combination does not disclose or render obvious this limitation.

Again, Petitioner can provide no disclosure of this limitation in any of its references. Pet. at 56-59. Instead, Petitioner relies on its expert’s declaration to manufacture a hindsight-based modification to Abuan. In the modification, after Abuan’s client application instructs the video conference manager to start a call, the video conference manager would notify the application that it is waiting for a response. *Id.* at 56-57. A POSITA would not make this modification.

Petitioner relies on Abuan’s UI showing a “hold state” to support its theory. *Id.* at 57. But Abuan is clear that its application enters the hold state as soon as the request for a video conference is made. Ex. 1005, [0120] (“The third stage 820 displays the UI 805 after the device 800 has started the video conference process with the selection of the Video Conference option 854.”). Abuan does not suggest, or even provide for, the video conference manager to inform the client application that it has requested the video conference. Indeed, there is no need for such a response, other than a hindsight-based motivation to meet the claims.

In Petitioner’s combination, the video conference manager (part of Petitioner’s function block) is itself part of the Abuan client application (Petitioner’s superblock application). Petitioner illustrates the relationship:



Ex.1005, Figs. 13 and 14 (annotated); Ex.1003, ¶76.

Pet. at 35.

When seeking to start a conference, “the video conference client 710 sends (at operation 2) a video conference request, which indicates the device 720 as the recipient based on input from the user, to the video conference server 715.” Ex. 1005, [0111]. At that point, the hold state is entered. *Id.*, [0120]. The client application **already knows** that the request has been made because the video conference manager is part of the client application, and the instruction from the client application is what makes the request. There is no need for the video conference manager to notify the

client application, because the act of calling the video conference functionality itself provides the necessary information to enter the hold state. *Id.*, [0111], [0120].

Petitioner fails to provide a motivation for its modification. First, it simply states in conclusory fashion that “the video conference manager . . . would have been an obvious way to notify the client application . . . about the status of the video conference request from the client application.” Pet. at 58. As noted above, there is no use for such notification because the client application already knows the request has been issued.

Second, Petitioner argues that “a user interface of a client application displaying a notification when a module, triggered by an event, informed the client application about the event was a routine and expected design in event-driven systems—common in mobile video conferencing.” *Id.* Petitioner then states:

[A] POSITA would have understood that the *transition from second stage 815 to third stage 820 was triggered by an event*, such as the user’s selection of the Video Conference option 854 on the user interface of the client application 1365. . . . In response, a functional module, such as the video conference manager, *informed the client application about the event*

Pet. at 58 (emphasis added).

In other words, according to Petitioner, the selection of the Video Conference Option on the user interface *of the client application* is an event that the video

conference manager would tell the *client application* about. There is no utility in informing the client application of an event that the client application itself generated.

Accordingly, a POSITA would not be motivated to modify Abuan to render this limitation obvious.

3. Claim 12

Petitioner asserts that Claim 12 “recites substantially the same functionality as claim 7 in the form of a method claim.” Pet. at 64. Petitioner further explicitly relies on its analysis of Claim 7. *Id.* For the same reasons as discussed above as to Claim 7, Petitioner’s combination does not render Claim 12 obvious.

4. Claim 22

Petitioner asserts that Claim 22 “recites substantially the same functionality as claim 1 in the form of a method claim.” Pet. at 69. Petitioner further explicitly relies on its analysis of Claim 1. *Id.*, 69-70. For the same reasons as discussed above as to Claim 1, Petitioner’s combination does not render Claim 22 obvious.

V. GROUND 2: THE ADDITION OF LUDWIG DOES NOT CURE THE DEFICIENCIES OF GROUND 1

Ground 2 is directed solely to dependent Claims 6, 11, and 21. Pet. at 18. Petitioner explicitly relies on its Ground 1 theories as disclosing or rendering

obvious the independent claims from which these claims depend. *Id.* at 77.
Accordingly, the Ground 2 combination does not render any claims obvious.

VI. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition in its entirety.

Respectfully submitted,

Dated: April 20, 2026

By: /Jacob Ostling /
Jacob Ostling (Reg. No. 77,624)
Lead Counsel for Patent Owner
Fabricant, Rubino & Lambrianakos LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796

CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S PRELIMINARY RESPONSE has 2,753 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

Respectfully submitted,

April 20, 2026

By: /Jacob Ostling /
Jacob Ostling (Reg. No. 77,624)
Lead Counsel for Patent Owner
Fabricant, Rubino & Lambrianakos LLP
411 Theodore Fremd Avenue,
Suite 206 South
Rye, New York 10580
Tel. 212-257-5797
Fax. 212-257-5796

CERTIFICATE OF SERVICE

A copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE
has been served on Petitioner's counsel of record as follows:

Theodore M. Foster
Email: ipr.theo.foster@haynesboone.com
Calmann J. Clements
Email: calmann.clements.ipr@haynesboone.com
David L. McCombs
Email: David.mccombs.ipr@haynesboone.com
Brett Bostrom
Email: brett.bostrom.ipr@haynesboone.com
Dagim Tilahun
Email: dagim.tilahun.ipr@haynesboone.com
Matthew Beck
Email: matthew.beck.ipr@haynesboone.com
HAYNES AND BOONE, LLP
2801 N. Harwood Avenue, Suite 2300
Dallas, Texas 75201

Attorneys for Cisco Systems, Inc.

April 20, 2026

By: /Jacob Ostling /
Jacob Ostling (Reg. No.77,624)
Lead Counsel for Patent Owner