

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,
ORACLE OTC SUBSIDIARY LLC,
YP INTERACTIVE LLC, and
YELLOWPAGES.COM LLC,
Petitioners,

v.

CLICK-TO-CALL TECHNOLOGIES LP,
Patent Owner.

Case IPR2013-00312
Patent 5,818,836

Before MICHAEL R. ZECHER, THOMAS L. GIANNETTI, and
TRENTON A. WARD, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. BACKGROUND

Oracle Corporation, Oracle OTC Subsidiary LLC, YP Interactive LLC,¹ and Yellowpages.com LLC (collectively, “Oracle”) filed a Petition requesting an *inter partes* review of claims 1, 2, 8, 12, 13, 15, 16, 18, 19, 22–24, and 26–30 of U.S. Patent No. 5,818,836 (Ex. 1001, “the ’836 patent”). Paper 1 (“Pet.”). Click-to-Call Technologies LP (“CTC”) timely filed a Preliminary Response. Paper 14 (“Prelim. Resp.”). Taking into account the information presented in Oracle’s Petition, as well as the arguments presented in CTC’s Preliminary Response, the Board determined that the information presented in the Petition demonstrated only that there was a reasonable likelihood that Oracle would prevail in challenging claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 as unpatentable under 35 U.S.C. §§ 102(e) and 103(a). Pursuant to 35 U.S.C. § 314, the Board instituted this proceeding on October 30, 2013, only as to these claims of the ’836 patent. Paper 26 (“Dec.”).

During this proceeding, CTC timely filed a Patent Owner Response (Paper 41, “PO Resp.”), and Oracle timely filed a Reply to the Patent Owner Response (Paper 43, “Pet. Reply”). An oral hearing was held on June 26, 2014. Paper 51 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the ’836 patent. For the

¹ During trial, Petitioners filed an updated mandatory notice indicating that Ingenio LLC, one of the original Petitioners in this proceeding, changed its name to YP Interactive LLC. Paper 49, 1; Ex. 1026.

Telephone stations 20 and 22 may be ordinary telephones, integrated services digital network telephones, or any device that can terminate an access line, play an audio signal, and transmit a received audio signal. *Id.* at 5:24–27. System 10 uses CSN 12 to establish a voice connection between telephone stations 20 and 22, as well as AVS 14. *Id.* at 4:65–67.

The '836 patent further discloses that each party has data terminal 24 or 26 associated therewith that is connected to ODS 18 via CDS 12 and PSN 16. Ex. 1001, 5:5–8. Data terminals 24 and 26 may be a personal computer with the ability to process and store data, display information, accept input via a keyboard, microphone, or writing tablet, and communicate with other devices via a serial port, modem, or local area network. *Id.* at 5:28–32. Each party may use its respective data terminals 24 or 26 to exchange messages through ODS 18 to request an anonymous voice connection, which, in turn, causes ODS 18 to generate a command that prompts AVS 14 to establish a telephone connection between the parties. *Id.* at 5:8–13.

The '836 patent discloses at least three different methods of creating an anonymous voice communication using system 10 illustrated in Figure 1: (1) standalone; (2) on-line; and (3) single party initiated. Ex. 1001, 9:45–47. With respect to the on-line method of establishing an anonymous voice communication, the parties initiate an anonymous voice call using ODS 18. *Id.* at 16:54–55. Each party may use its data terminal 24 or 26 to log on to ODS 18. *Id.* at 16:55–57. The parties may contact each other via ODS 18 using public chat, private chat, electronic mail, or newsgroups. Ex. 1001, 16:57–59. The parties can communicate via ODS 18 without revealing their identity to each other, i.e., they are identified by screen names, handles, or

subscriber identifications, which only the operator of ODS 18 can translate into the subscriber's identification. *Id.* at 16:59–64. According to the '836 patent, either party A or party B may initiate an anonymous voice communication using the on-line method. *Id.* at 16:65.

B. Illustrative Claim

Of the challenged claims, claims 1 and 12 are independent claims. Claims 2, 8, 22, 23, and 26 directly or indirectly depend from independent claim 1, and claims 13, 15, 16, 19, 29, and 30 directly or indirectly depend from independent claim 12. Independent claim 1 is illustrative of the '836 patent and is reproduced below:

1. A method for creating a voice connection over a circuit switched network between a first party and a second party using an on-line data service to initiate the connection, comprising the steps of:

a) establishing an electronic communication between the first party and the second party through the on-line data service between the first party and the second party, wherein the first party is anonymous to the second party prior to establishing a first electronic communication between the first party and the second party, wherein the establishing includes providing over the Internet, to a data terminal of the first party coupled to the Internet, information publicly accessible over the Internet, wherein the information publically accessible over the Internet is suitable for presentation within a graphical user interface of the data terminal of the first party, wherein the information publicly accessible over the Internet includes:

(1) first information characterizing a second party,

(2) second information representing a communication from the second party, and

(3) third information specifying a user-selectable element for display within the graphical user interface of the data terminal of the first party, wherein the user-selectable element is visually associated, within the graphical

user interface of the data terminal of the first party, with the first information and the second information, when the first information, second information and user-selectable element are presented within the graphical user interface of the data terminal of the first party; and

(b) following the establishment of an electronic communication between the first party and the second party through the on-line data service between the first party and the second party, and in response to receiving an indication of selection of the user-selectable element displayed within the graphical user interface of the data terminal of the first party, performing the steps of:

(1) requesting a voice communication between the first party and the second party through the on-line data service;

(2) transmitting a message from the on-line data service to a voice system requesting the voice connection between said first party and said second party;

(3) establishing a first telephone call for the first party;

(4) establishing a second telephone call for the second party; and

(5) connecting said first telephone call with said second telephone call.

Ex. 2001², 1:26–2:8 (brackets and emphases omitted).

C. Related Proceedings

Both parties indicate that the '836 patent was asserted in the following civil actions, each of which was filed in the United States District Court for the Western District of Texas: (1) *Click to Call Technologies LP v. Oracle Corporation*, No. 1:12-cv-00468-SS, filed on May 29, 2012; (2) *Click to Call Technologies LP v. eHarmony, Inc.*, No. 1:12-cv-00469-SS, filed on

² This citation is to Ex Parte Reexamination Certificate No. US 5,818,836 C1, which issued on December 30, 2008.

Challenged Claims	Basis	Reference(s)³
1, 2, 12, 13, 19, 22, 23, 26, 29, and 30	§ 102(e)	Dezonno
1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30	§ 103(a)	Dezonno
22 and 29	§ 103(a)	Dezonno and Mosaic Handbook

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, we construe a claim by applying the broadest reasonable interpretation in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012).

1. Claim Terms or Phrases Construed by Oracle

In its Petition, Oracle provides claim constructions for a number of claim terms or phrases recited in the '836 patent. Pet. 8–11 (citing Ex. 1009; Ex. 1010). CTC does not propose alternative claim constructions for these

³ For the grounds of unpatentability based solely on Dezonno, although Oracle includes dependent claims 18 and 24 in the statement of the grounds of unpatentability (Pet. 21), Oracle nonetheless does not include dependent claims 18 and 24 in the corresponding analysis (*see id.* at 21–31). Conversely, although Oracle omits dependent claims 22 and 29 in the statement of the grounds of unpatentability (*id.* at 21), Oracle nonetheless includes dependent claims 22 and 29 in the corresponding analysis (*id.* at 29, 31). We will treat the incorrect statement of the grounds of unpatentability as a typographical error and presume Oracle intended to assert that claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated under 35 U.S.C. § 102(e) by Dezonno, whereas claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable under 35 U.S.C. § 103(a) over Dezonno.

claim terms or phrases in either its Preliminary Response or Patent Owner Response. We adopted the claim constructions proposed by Oracle in our Decision to Institute (Dec. 10–13) and we discern no reason to alter those claim constructions for this Final Written Decision. For convenience, the claims constructions proposed by Oracle are reproduced in the table below.

Claim(s)	Claim Term or Phrase	Claim Construction
1 and 12	“party”	A person or group participating in an action.
1 and 12	“anonymous”	Identity is not revealed.
1 and 12	“voice system”	A system that can connect voice calls.
1 and 12	“data terminal”	A computing device capable of sending and/or receiving data.
1	“on-line data service”	A service provided by an on-line data system, such as electronic mail, chat, newsgroups, or access to information.
12	“on-line data system”	A computing device or distributed computing system with storage and communications capability that provides services on-line, such as electronic mail, chat, newsgroups, or access to information.
1 and 12	“information publicly accessible”	Information that is widely available and subject to minimal constraints, such as subscription, registration, or ability to access the on-line data service or system.

Claim(s)	Claim Term or Phrase	Claim Construction
1	“establishing [or establishment of] an electronic communication between the first party and the second party”	Transferring information electronically from one party to another party.
1 and 12	“second information representing a communication from the second party”	Information representing information transferred from the second party.
1	“requesting a voice communication between the first party and the second party through the on-line data service”	Requesting a voice communication using the on-line data service.
12	“connect command”	A command that directs the voice system to connect a first telephone call with a second telephone call.
1 and 12	“indication [or indicative] of selection of the user-selectable element”	Information indicating that the user-selectable element was selected.
12	“on-line data system that is coupled to the data terminal of each party”	A computing device or distributed computing system with storage and communications capability that provides services on-line, such as electronic mail, chat, newsgroup, or access to information, and is coupled to the data terminal of each party.

Claim(s)	Claim Term or Phrase	Claim Construction
1	“on-line data service between the first and the second party”	A service provided by an on-line data system, such as electronic mail, chat, newsgroup, or access to information.

2. “*First Information*” and “*Second Information*” (Claims 1 and 12)

In its Petition, Oracle contends that the claim terms “first information” and “second information” recited in independent claims 1 and 12 are not entitled to patentable weight because each claim term amounts to non-functional descriptive material that has no functional relationship to any substrate or other portions of the claims. Pet. 60. In its Preliminary Response, CTC contends that the “first information” and “second information” recited in independent claim 1 are entitled to patentable weight because they have a direct functional relationship to the claimed “establishing” step (a), as well as the claimed “performing” steps (b)(1)–(5). Prelim. Resp. 21–23. Similarly, CTC contends that “first information” and “second information” recited in independent claim 12 are entitled to patentable weight because they have a direct functional relationship to “the provision of the information publicly accessible,” which is structured through the claimed visual association of a user-selectable element with the first and second information. *Id.* at 23.

In the Decision to Institute, we determined that, because the claim terms “first information” and the “second information” have a functional relationship with other claimed features recited in independent claims 1 and 12, these claim terms limit the claimed invention functionally and, as a result, are entitled to patentable weight. Dec. 13–14. During trial, neither

Oracle nor CTC dispute our determination in that regard. We discern no reason to alter our claim construction of these claim terms for this Final Written Decision.

B. YP Interactive LLC Is Not Barred Under 35 U.S.C § 315(b) From Pursuing an Inter Partes Review of the '836 Patent

In the Decision to Institute, as well as a subsequent Decision on CTC's Request for Rehearing (Paper 40), we determined that one of the original Petitioners—namely, Ingenio LLC, which has since changed its name to YP Interactive LLC—is not barred from pursuing an *inter partes* review under 35 U.S.C. § 315(b). Dec. 15–18; Paper 40, 3–5. In its Patent Owner Response, CTC renews its argument that we erroneously interpreted § 315(b) because the legislative history associated with this statute dictates that the plain meaning of “served with a complaint alleging infringement of [a] patent” is conclusive and, therefore, our analysis of the issue in both the Decision to Institute and the Decision on CTC's Request for Rehearing erred in looking beyond the statutory language. PO Resp. 53–56. In its Reply, Oracle reiterates the position we took in both the Decision to Institute and the Decision on CTC's Request for Rehearing that there is no statutory bar against YP Interactive LLC because a voluntarily dismissal of a complaint without prejudice does not trigger a bar under § 315(b). Pet. Reply 15.

As stated in the Decision to Institute and the Decision on CTC's Request for Rehearing, both the Federal Rules of Civil Procedure and Federal Circuit precedent treat a dismissal without prejudice as something that, *de jure*, never existed. Dec. 16–17; Paper 40, 4. It is undisputed that the patent infringement suit filed by Inforocket against Keen—now YP Interactive LLC—on June 8, 2001, was dismissed without prejudice on

March 21, 2003. Ex. 1019, 1; Ex. 1017, 4; Ex. 1018, 8. We have determined that, because this patent infringement suit was dismissed without prejudice, Federal Circuit precedent interprets such a dismissal as leaving the parties in the same legal position as if the underlying complaint had never been served. *See Graves v. Principi*, 294 F.3d 1350, 1356 (Fed. Cir. 2002); *Bonneville Assoc., Ltd. P'ship v. Baram*, 165 F.3d 1360, 1364 (Fed. Cir. 1999). Accord 9 WRIGHT, MILLER, KANE, and MARCUS, FEDERAL PRAC. & PROC. CIV. § 2367 (3d. ed.). As a consequence, YP Interactive LLC is not barred from pursuing an *inter partes* review of the '836 patent under § 315(b).

C. Grounds of Unpatentability Based, in Whole or in Part, on Dezonno

In its Petition, Oracle presents the following grounds of unpatentability: (1) claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated under 35 U.S.C. § 102(e) by Dezonno; (2) claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable under 35 U.S.C. § 103(a) over Dezonno; and (3) claims 22 and 29 are unpatentable under 35 U.S.C. § 103(a) over the combination of Dezonno and Mosaic Handbook. Pet. 15–33. In support of these asserted grounds of unpatentability, Oracle relies upon claim charts to explain how Dezonno, either standing alone or in combination with Mosaic Handbook, discloses the claimed subject matter recited in each of these claims. *Id.* Oracle also presents the Declaration of Dr. Robert L. Stevenson (Ex. 1007 ¶¶ 11–17) to support its positions. *Id.*

In its Patent Owner Response, CTC does not challenge the contentions and supporting evidence presented by Oracle in its Petition, but instead attempts to antedate Dezonno. In particular, CTC contends that the invention embodied in these claims (“the claimed invention”) was conceived

prior to the earliest effective filing date of Dezonno—namely, April 21, 1995 (Ex. 1002, at [63]). PO Resp. 1–2. CTC further contends that the claimed invention was constructively reduced to practice on August 9, 1995, the filing date of the patent application that led to the '836 patent, as well as actually reduced to practice on August 15, 1995, the day before the ONE BBSCON conference. *Id.* at 2–3. According to CTC, the ONE BBSCON conference was a major industry conference where Mr. Stephen C. DuVal, the named inventor of the '836 patent (Ex. 1001, at [76]), planned to announce his purported invention. PO Resp. 1. In addition, CTC asserts that Mr. DuVal continually exercised reasonable diligence from April 20, 1995, through August 9, 1995 (“the critical period”). *Id.* at 5–8. As a consequence, CTC argues that Dezonno does not qualify as prior art under 35 U.S.C. § 102(e). *Id.* at 8

We begin our analysis with the principles of law that generally apply to antedating a reference, followed by a brief discussion of the parties contentions regarding conception, and then we turn to the parties contentions regarding whether there is sufficient evidence on this record to provide independent corroboration of Mr. DuVal’s testimony that he continually exercised reasonable diligence during the entire critical period.

1. Principles of Law

An inventor may antedate a reference if he was the first to conceive of a patentable invention, and then connects the conception of his invention with its reduction to practice by reasonable diligence on his part, such that conception and diligence are substantially one continuous act. *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996). An inventor’s testimony, standing alone, is insufficient to prove conception and diligence,

as some form of corroboration is required. *Mahurkar*, 79 F.3d at 1577; *Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993). A rule of reason applies to determine whether the inventor’s testimony has been corroborated. *Price*, 988 F.2d at 1194.

During the period in which reasonable diligence must be shown, there must be continuous exercise of reasonable diligence. *In re McIntosh*, 230 F.2d 615, 619 (CCPA 1956); *see also Burns v. Curtis*, 172 F.2d 588, 591 (CCPA 1949) (referring to “reasonably continuous activity”). A party alleging diligence must account for the entire critical period. *Griffith v. Kanamuru*, 816 F.2d 624, 626 (Fed. Cir. 1987); *Gould v. Schawlow*, 363 F.2d 908, 919 (CCPA 1966). Even a short period of unexplained inactivity is sufficient to defeat a claim of diligence. *Morway v. Bondi*, 203 F.2d 742, 749 (CCPA 1953); *Ireland v. Smith*, 97 F.2d 95, 99–100 (CCPA 1938). In *In re Mulder*, 716 F.2d 1542, 1542–46 (Fed. Cir. 1983), for example, the Federal Circuit affirmed a determination of lack of reasonable diligence, where the evidence of record was lacking for a two-day critical period. Likewise, in *Rieser v. Williams*, 255 F.2d 419, 424 (CCPA 1958), there was no showing of diligence where no activity was shown during the first thirteen days of the critical period.

A party alleging diligence must provide corroboration with evidence that is specific both as to facts and dates. *Gould*, 363 F.2d at 920; *Kendall v. Searles*, 173 F.2d 986, 993 (CCPA 1949). The rule of reason does not dispense with the need for corroboration of diligence that is specific as to dates and facts. *Gould*, 363 F.2d at 920; *Kendall*, 173 F.2d at 993; *see also Coleman v. Dines*, 754 F.2d 353, 360 (Fed. Cir. 1985) (“The rule of

reason . . . does not dispense with the requirement for some evidence of independent corroboration.”).

2. *Conception*

In its Patent Owner Response, CTC contends that the following documents collectively demonstrate that Mr. DuVal conceived of the claimed invention of the '836 patent before the earliest effective filing date of Dezonno—namely, April 21, 1995: (1) the October 1994 invention disclosure document filed with the Office (Ex. 2017, Attachment A); (2) the February 1995 PrivTel⁴ Business Plan produced by Mr. DuVal at the request of Mr. Brian Forrest (Ex. 2017, Attachment C); (3) the March 1995 invention disclosure document filed with the Office (Ex. 2017, Attachment B); and (4) the March 1995 letter Mr. DuVal sent to the law firm of Blakely, Sokoloff, Taylor, and Zafman LLP instructing them to prepare and file a patent application (Ex. 2017, Attachment O). PO Resp. 10–36. CTC further contends that these documents independently corroborate Mr. DuVal’s testimony that he conceived of the claimed invention of the '836 patent prior to April 21, 1995. *Id.*

In its Reply, Oracle contends that CTC has not established that Mr. DuVal conceived of the claimed invention of the '836 patent before April 21, 1995, because CTC does not demonstrate that distributing client software over the Internet, as required by independent claims 1 and 12, was either inherent or obvious in light of the March 1995 invention disclosure document. Pet. Reply 14. Oracle further argues that independent claims 1

⁴ Mr. DuVal testifies that he formed PrivTel on December 12, 1994, to demonstrate, produce, commercialize, and sell his claimed inventions. Ex. 2017 ¶ 7(C).

and 12 both require that the claimed user-selectable element, first information, and second information must be displayed at the same time. *Id.* at 15. Oracle asserts that, because the claimed user-selectable element is part of the client software, it is displayed when the software begins to run, i.e., before display of the claimed second information. *Id.*

Even if we were to agree with CTC that there is sufficient evidence to corroborate Mr. DuVal's testimony that he conceived of the claimed invention of the '836 patent prior to April 21, 1995, as we will discuss below, CTC does not provide sufficient evidence to corroborate Mr. DuVal's testimony that there was a continuous exercise of reasonable diligence during the entire critical period. Consequently, we need not reach and, therefore, do not address conception.

3. *Diligence*

To demonstrate diligence during the entire critical period, CTC relies upon the declarations of the following individuals: (1) Mr. DuVal (Ex. 2017); (2) Mr. Forrest (Ex. 2019); (3) Mr. Ben Yorks (Ex. 2021), a former partner at Blakely, Sokoloff, Taylor, and Zafman LLP who was hired by Mr. DuVal to draft and file the patent application that led to the '836 patent; (4) Mr. Bob Shinn (Ex. 2022), the former president and owner of SofTel, Inc. ("SofTel"); (5) Mr. Simon Clement (Ex. 2023), the former president of ProDesign, Inc. ("ProDesign"); and (6) Mr. Doug Martin (Ex. 2025), the former Chief Technology Officer and co-owner of Interactive Communication Services ("ICS"). PO Resp. 36–48. Of particular importance is the testimony of Mr. Yorks regarding his preparation in drafting and filing the patent application that led to the '836 patent, as well as the testimony of Mr. Shinn, Mr. Clement, and Mr. Martin,

each of whom represents one of the three software developers—namely, SofTel, ProDesign, and ICS—hired by Mr. DuVal to implement the claimed invention. *Id.* at 39–40. In its Reply, Oracle contends that CTC does not provide sufficient evidence to corroborate Mr. DuVal’s testimony that he was reasonably diligent during the entire critical period with respect to both constructively reducing the claimed invention to practice and actually reducing the claimed invention to practice. Pet. Reply. 5–13.

In our analysis below, we will explain how the aforementioned supporting evidence, taken as a whole, does not support CTC’s contention that there was a continuous exercise of reasonable diligence during the entire critical period. In particular, we will address how this evidence does not demonstrate that Mr. DuVal was diligent with respect to constructive reduction to practice, and then turn to how this evidence does not demonstrate that he was diligent with respect to actual reduction to practice.

a. CTC Does Not Demonstrate a Continuous Exercise of Reasonable Diligence With Respect to Constructive Reduction to Practice

As we explained previously, Mr. DuVal constructively reduced the claimed invention to practice when he filed the patent application that led to the ’836 patent on August 9, 1995. The earliest effective filing date of Dezonno is April 21, 1995. Ex. 1002, at [63]. To show diligence with respect to constructive reduction to practice during the entire critical period, CTC primarily relies upon the testimony of Mr. DuVal and Mr. Yorks.

Mr. DuVal testifies that, after Mr. Yorks prepared an initial draft of the patent application that led to the ’836 patent just prior to April 21, 1995, until at least May 2, 1995, he personally reviewed and revised the initial draft between May 2, 1995, and May 9, 1995. Ex. 2017 ¶ 8(D)(1)–(2); *see*

also Ex. 2024 ¶ 7 (William W. Schaal, a current partner at Blakely, Sokoloff, Taylor, and Zafman LLP, testifies that, at the direction of Mr. DuVal, he obtained an advisor letter and a draft patent application that was sent from his law firm to Mr. DuVal on May 2, 1995.). Mr. DuVal then testifies that “[f]rom at least May 9, 1995 until July 17, 1995, Mr. Yorks and I continued to make progress on the preparation of my patent application.” Ex. 2017 ¶ 8(D)(3). Mr. Yorks’s testimony regarding the preparation and review of the initial draft of the patent application that led to the ’836 patent is consistent with the timeline provided by Mr. DuVal. *Compare* Ex. 2021 ¶ 6 (H)–(J), *with* Ex. 2017 ¶ 8(D)(1)–(3) .

The testimony offered by Mr. DuVal and Mr. Yorks concerning the preparation and review of the draft patent application, however, is not specific as to facts and dates for the entire critical period during which diligence is required. *See Gould*, 363 F.2d at 920; *Kendall*, 173 F.2d at 993. Mr. DuVal and Mr. Yorks do not provide sufficient evidence to corroborate the work actually performed on the draft patent application that led to the ’836 patent between May 9, 1995, and July 17, 1995. Given the absence of specific details concerning the work that was done on the draft patent application, the testimony from Mr. DuVal and Mr. Yorks amounts to mere pleadings and is insufficient to establish diligence with respect to constructive reduction to practice during this time period. *See In re Harry*, 333 F.2d 920, 923 (CCPA 1964) (Statements that are unsupported by evidence or a showing of facts essentially amount to mere pleadings.). Moreover, during oral argument, counsel for CTC conceded that, if we were to focus exclusively on the activities either Mr. DuVal or Mr. Yorks engaged in to constructively reduce the claimed invention to practice, that, by itself,

would be insufficient to establish diligence during the entire critical period.
Tr. 35:17–36:9.

Based on the record before us, the testimony from Mr. DuVal and Mr. Yorks regarding constructive reduction to practice is not specific as to facts and dates for at least the time period between May 9, 1995, and July 17, 1995, and, as result, does not establish that Mr. DuVal was diligent during the entire critical period.

b. CTC Does Not Demonstrate a Continuous Exercise of Reasonable Diligence With Respect to Actual Reduction to Practice

As we explained previously, CTC contends that Mr. DuVal actually reduced the claimed invention to practice on August 15, 1995, the day before the ONE BBSCON conference was scheduled to begin in Tampa, Florida. The earliest effective filing date of Dezonno is April 21, 1995. Ex. 1002, at [63]. To show diligence during the entire critical period leading to this actual reduction to practice, CTC primarily relies upon the testimony of Mr. DuVal, as well as the testimony of Mr. Shinn, Mr. Clement, and Mr. Martin, regarding the work performed by the three software developers hired by Mr. DuVal to implement the claimed invention.

Mr. DuVal testifies that “[f]rom at least prior to April 21, 1995 until at least August 20, 1995, I was working full-time, approximately twelve hours a day, seven days a week, to execute on my company’s business plan, and particularly to meet my Diligence Goals.” Ex. 2017 ¶ 8(C). This testimony from Mr. DuVal regarding the work he performed to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required. *See Gould*, 363 F.2d at 920; *Kendall*, 173 F.2d at 993. Once again, Mr. DuVal’s statement amounts to a mere

conclusion and lacks sufficient detail to establish diligence with respect to actual reduction to practice during the entire critical period. *See Harry*, 333 F.2d at 923.

With respect to the three software developers hired by Mr. DuVal to implement the claimed invention, Mr. DuVal testifies that “[a]t a minimum, each . . . [of] ICS, SofTel and ProDesign, committed at least one full-time engineer to PrivTel’s development efforts to complete a working prototype of [the claimed invention] . . . in time for [the] ONE BBSCON [conference] on August 16–20, 1995.” Ex. 2017 ¶ 8(F) (citing Ex. 2022 ¶¶ 11–18; Ex. 2023 ¶ 18; Ex. 2025 ¶ 10). CTC, however, does not provide sufficient evidence to corroborate the testimony of Mr. DuVal regarding the work performed by the engineers employed by SofTel, ProDesign, and ICS to implement the claimed invention.

For instance, CTC does not provide test results, billing records, or other documentary evidence indicating that these engineers engaged in a continuous exercise of reasonable diligence during the entire critical period to implement the claimed invention. Absent such corroborating evidence, we are left to speculate whether the work performed by these engineers took several weeks or just a couple of days to complete. Even if we were to assume that the work took several weeks to complete, we cannot assess whether there are any diligence gaps during the critical period without sufficient evidence establishing what activities took place on particular dates. Conversely, if we were to assume that the work performed by these engineers only took a few days to complete, then there necessarily would be one or more large gaps in diligence during the critical period that are unaccounted for. Put simply, without sufficient evidence to substantiate

details of the work performed by the engineers employed by SofTel, ProDesign, and ICS to implement the claimed invention, CTC has failed to corroborate Mr. DuVal's testimony that these engineers performed reasonably continuous activities to reduce the claimed invention to practice.

In its Patent Owner Response, CTC focuses on certain activities performed by each software developer to implement the claimed invention and the respective payments made by PrivTel to each software developer for their services. PO Resp. 41–47. The analysis that follows focuses on the activities of each software developer and the corresponding payments received from PrivTel, particularly during the time period between May 15, 1995, and June 15, 1995.

i. ICS

Mr. DuVal testifies that he worked with ICS to develop a software development services agreement to build the claimed invention, which, in turn, was executed on or around May 15, 1995. Ex. 2017 ¶ 8(J)(2). Mr. DuVal further testifies that PrivTel made an initial payment of \$2,000 to ICS on May 15, 1995, after which ICS worked diligently to design the claimed invention, including the system architecture, communication protocols, and overall system design work. Ex. 2017 ¶ 8(J)(3). After ICS completed its design of the claimed invention, Mr. DuVal testified that PrivTel made another payment of \$6,400 to ICS on July 1, 1995. *Id.* Mr. Martin's testimony regarding the design of the claimed invention by ICS and corresponding payments for its services is consistent with the timeline provided by Mr. DuVal. *Compare* Ex. 2025 ¶ 10–15, *with* Ex. 2017 ¶ 8(J)(2)–(3).

In its Reply, Oracle contends that neither Mr. DuVal nor Mr. Martin identify the tasks or activities performed by ICS on a particular date between May 15, 1995, and July 1, 1995, nor do they provide documentary evidence that provides such information. Pet. Reply 9. Oracle further argues that there is no evidence of record indicating that ICS actually created a design of the claimed invention during this period, nor that ProDesign and SofTel waited for, or even subsequently used, the design allegedly created by ICS. *Id.* at 11.

The testimony that CTC relies upon to explain the activities performed by ICS to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required, particularly during the time period between May 15, 1995, and July 1, 1995. First, Mr. DuVal does not indicate that he has personal knowledge about the work performed by ICS during this time period. Therefore, his testimony is entitled to little weight. Second, Mr. Martin does not indicate whether it took ICS several weeks or just a few days to complete the design of the claimed invention. Third, CTC does not provide evidence that the design of the claimed invention allegedly created by ICS during this time period actually exists. Nor does CTC indicate that this alleged design was necessary for ProDesign and SofTel to complete the work they were hired to perform to implement the claimed invention. *See e.g.*, Ex. 2023, Attachment A; Ex. 2022, Attachment C. Absent underlying evidence to support the testimony from Mr. DuVal and Mr. Martin that ICS worked diligently to implement the claimed invention between May 15, 1995, and July 1, 1995, we are not persuaded that ICS performed reasonably

continuous activities to reduce the claimed invention to practice during this time period.

ii. ProDesign

Mr. DuVal testifies that on June 15, 1995, PrivTel paid ProDesign \$5,000 to begin its first design phase of the claimed invention. Ex. 2017 ¶ 8(N)(4). Mr. Clement, however, testifies that ProDesign did not enter into a contract with PrivTel to develop software for the claimed invention until June 26, 1995. Ex. 2023 ¶ 4. Mr. Clement further testifies that, “[e]ven before the contract was signed, [he] began working diligently on the software for [the claimed invention] because of the relatively short amount of time before Mr. DuVal planned to demonstrated [the claimed invention] at the upcoming ONE BBSCON conference in August.” *Id.* ¶ 11.

In its Reply, Oracle contends that Mr. Clements never corroborates that ProDesign actually performed work on the claimed invention between May 15, 1995, and June 15, 1995. Pet. Reply 8. Oracle also asserts that, in light of Mr. DuVal’s testimony, ProDesign began its work to implement the claimed invention no earlier than June 15, 1995, because that was the date PrivTel made its initial payment of \$5,000 to ProDesign. *Id.*

The testimony that CTC relies upon to explain the activities performed by ProDesign to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required, particularly during the time period between May 15, 1995, and June 15, 1995. Although Mr. Clements testifies that he began working diligently on the software for the claimed invention prior to entering into a contract with PrivTel on June 26, 1995, he does not explain adequately the activities he performed on particular dates. Even if we were to assume that

Mr. Clements began working diligently to implement the software for the claimed invention on June 15, 1995, the date PrivTel made its initial payment of \$5,000 to ProDesign, the time period between May 15, 1995, and June 15, 1995, still remains unaccounted for. Without some evidence that explains, in detail, the work performed by Mr. Clements on the software of the claimed invention between May 15, 1995, and June 15, 1995, we are not persuaded that ProDesign performed reasonably continuous activities to reduce the claimed invention to practice during this time period.

iii. SofTel

CTC indicates that, because SofTel was hired to develop a control system for the claimed invention that depends on some other subsystems, presumably developed by ICS and ProDesign, SofTel did not begin its work in earnest until July 1, 1995. PO Resp. 45 (citing Ex. 2017 ¶ 8(L)(1); Ex. 2022 ¶¶ 7–16). This is consistent with Mr. DuVal’s testimony that PrivTel paid SofTel \$3,000 on July 1, 1995, to begin designing the control system of the claimed invention. Ex. 2017 ¶ 8(L)(3).

In its Reply, Oracle contends that CTC admits in its Patent Owner Response that SofTel did not begin working to implement the claimed invention until July 1, 1995, and its admission in that regard is consistent with the testimony proffered by Mr. DuVal. Pet. Reply 8 (citing Ex. 2017 ¶ 8(L)(1)–(3)).

The testimony that CTC relies upon to explain the activities performed by SofTel to implement the claimed invention is not specific as to facts and dates for the entire critical period during which diligence is required, particularly during the time period between May 15, 1995, and July 1, 1995. Indeed, Mr. DuVal’s testimony that SofTel was awaiting the

overall system architecture designed by ICS before it began its work in earnest on July 1, 1995 (Ex. 2017 ¶ 8(L)(1); *see* Tr. 28:4–29:12) constitutes persuasive evidence that SofTel did not perform reasonably continuous activities to reduce the claimed invention to practice between May 15, 1995, and July 1, 1995.

Based on the record before us, the testimony from Mr. DuVal regarding actual reduction to practice, as well as the testimony of Mr. Shinn, Mr. Clement, and Mr. Martin regarding the work performed by the three software developers hired by Mr. DuVal to implement the claimed invention, is not sufficiently specific as to facts and dates for at least the time period between May 15, 1995, and June 15, 1995, to demonstrate that Mr. DuVal was diligent during the entire critical period.

4. Summary

Applying the rule of reason, the evidence relied upon by CTC to corroborate Mr. DuVal's testimony does not demonstrate a continuous exercise of reasonable diligence during the entire critical period with respect to either constructive reduction to practice or actual reduction to practice, particularly during the time period between May 15, 1995, and June 15, 1995. As a result, CTC has not antedated Dezonno, which, in turn, qualifies as prior art to the '836 patent under 35 U.S.C. § 102(e).

Upon reviewing the unchallenged contentions and supporting evidence presented by Oracle in its Petition for the grounds of unpatentability based, in whole or in part, on Dezonno (Pet. 15–33; Ex. 1007 ¶¶ 11–17), we are persuaded that Oracle presents sufficient evidence to support a finding that Dezonno, either standing alone or in combination with Mosaic Handbook, discloses the claimed subject matter recited in claims 1,

2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30. We also are persuaded that Oracle provides an articulated reason with a rational underpinning to combine the teachings of Dezonno and Mosaic Handbook. Pet. 32–33; Ex. 1007 ¶ 17. Therefore, based on the record before us, we conclude that Oracle has demonstrated by a preponderance of the evidence that: (1) claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated by Dezonno; (2) claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are obvious over Dezonno; and (3) claims 22 and 29 are obvious over the combination of Dezonno and Mosaic Handbook.

III. CONCLUSION

Oracle has demonstrated by a preponderance of the evidence that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent are unpatentable based on the grounds of unpatentability set forth in the table below.

Challenged Claims	Basis	Reference(s)
1, 2, 12, 13, 19, 22, 23, 26, 29, and 30	§ 102(e)	Dezonno
1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30	§ 103(a)	Dezonno
22 and 29	§ 103(a)	Dezonno and Mosaic Handbook

IV. ORDER

In consideration of the foregoing, it is ORDERED that Oracle has shown by a preponderance of the evidence that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent are unpatentable; and

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FURTHER ORDERED that, because this is a final written decision, parties to this proceeding seeking judicial review of our decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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