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Paper 34
Entered: March 13, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., and WHATSAPP INC.,
Petitioner,

v.

UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.,
Patent Owner.

Case IPR2016-01756
Patent 8,571,194 B2

Before KARL D. EASTHOM, KEN B. BARRETT, and JEFFREY S. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner filed a Petition for *inter partes* review of claims 1, 3–6, 8–11, and 13–15 of U.S. Patent No. 8,571,194 B2 (Ex. 1001, "the '194 patent"). Paper 1 ("Pet."). Patent Owner filed a Preliminary Response. Paper 8 ("Prelim. Resp."). We instituted trial for claims 1, 3–6, 8–11, and 13–15. Paper 9. Patent Owner filed a Response ("PO Resp."). Paper 22. Petitioner filed a Reply ("Reply"). Paper 25. The record includes a transcript of the oral hearing. Paper 33.

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision issues pursuant to 35 U.S.C. § 318(a). Petitioner has shown by a preponderance of the evidence that claims 1, 3–6, 8–11, and 13–15 of the '194 patent are unpatentable.

A. Related Matters

One or both parties identify, as matters involving or related to the '194 patent, the following:

Uniloc USA, Inc., Uniloc Luxembourg, S.A. v. Facebook, Inc., Case No. 6:16-cv-00223-JRG (E.D. Tex.), filed March 18, 2016. Ex. 1014.

Uniloc USA, Inc., Uniloc Luxembourg, S.A. v. WhatsApp, Inc., Case No. 6:16-cv-00225-JRG (E.D. Tex.), filed March 18, 2016. Ex. 1015.

The '194 patent is also the subject of IPR2017-00597 (instituted), IPR2017-01076 (terminated before institution), and IPR2017-01683 (instituted).

B. The '194 Patent

The '194 patent relates generally to a method for initiating a conference call between two or more users, and more particularly to initiating a voice conference call between two or more users using a central server to communicate parameters for the call and for initiating the call itself. Ex. 1001, 1:18–22. Conference calls are initiated via an instant messaging (IM) system to reduce the effort required to initiate and manage the call. *Id.*, Abstract. The system uses an IM connection between a requesting party and a conference call server to inform the conference call server of the desire to initiate the conference call. *Id.* The conference call server initiates the conference call by having involved parties called by a conference bridge, thus reducing the effort required by the parties to join the call. *Id.* Figure 4 of the '194 patent is reproduced below.

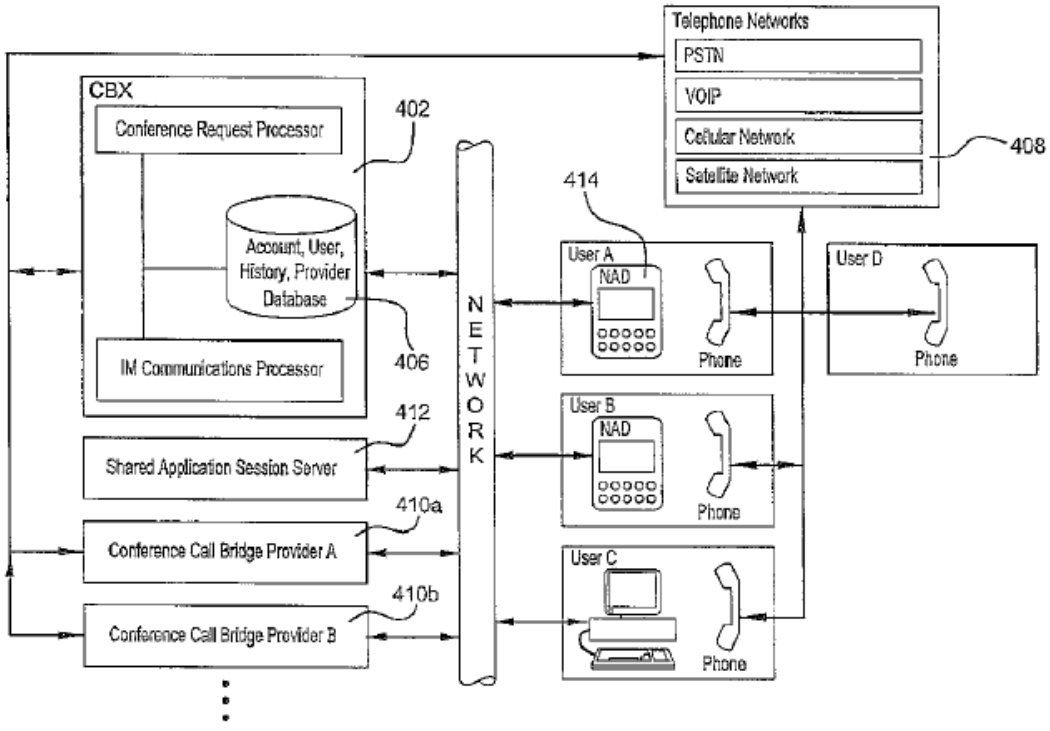

Figure 4 above shows a block diagram of a system for accomplishing the initiation of conference calls. Ex. 1001, 4:61–63. Conference call server 402 is connected to network 404. *Id.* at 9:22–23. Database 406, associated with conference call server 402, stores account information, user information, and call management information. *Id.* at 9:23–26. The conference call server can be connected directly to telephone network 408, or indirectly through third party conference bridge 410. *Id.* at 9:30–33. Shared application server 412 can also be connected to allow information generated during a shared application session to be accessed by the conference call server as required, such as to determine a list of parties involved in a shared application session. *Id.* at 9:34–38. The users connect to the system via network access device (NAD) 414, which may be any network communicable device having the appropriate IM software service access. *Id.* at 9:47–49.

A conference call requester provided with a NAD sends a conference call request to the conference call server using an instant messaging service. *Id.* at 6:30–39. When a conference call request is received by the conference server, the conference server generates a conference request message to the conference call targets. *Id.* at 7:15–21. The conference call targets respond via their instant messaging software. *Id.* at 7:21–24. The conference call server then generates a list of targets for the conference call and initiates the conference call. *Id.* at 7:24–26.

C. Illustrative Claim

Of the challenged claims, claims 1, 6, 11, and 16 of the ’194 patent are independent. Claim 1 is illustrative of the claimed subject matter:

> 1. A non-transitory computer readable medium containing computer instructions configured to operate with electronic computer hardware to perform the following steps:
>
> display, in an instant messaging (IM) chat window of a first party, an exchange of IM messages between the first party and at least one other party, the first party and the at least one other party being current participants to an IM session;
>
> display for the first party an indication of whether the at least one other party is communicably connected to the IM session;
>
> display for the first party an option to automatically initiate voice communication between the current participants of the IM session without requiring individual selection of potential members including the first party and the at least one other party and without requiring registration with a conference call server for establishing the voice communication by the potential members including the first party and the at least one other party; and
>
> request, in response to selection of the option, voice communication between the first party and the at least one other party;
>
> wherein in response to the request, the voice communication is established between the first party and those of the at least one other party.

Ex. 1001, 12:2–27.

D. References

Petitioner relies on the following references. Pet. 3.

Reference	**Title**	**Date**	**Ex. No.**
Wu	US 2002/0023131 A1	Feb. 21, 2002	Ex. 1003
Young	"Chapter 14 Instant Messaging," *Internet: The Complete Reference, Second Edition.*	2002	Ex. 1004

Reference	Title	Date	Ex. No.
	McGraw-Hill/Osborne. Pages 380-81.		
Glasser	US 6,519,639 B1	Feb. 11, 2003 (filed Jul. 21, 1999)	Ex. 1005
DeSimone	US 6,212,548 B1	Apr. 3, 2001	Ex. 1006
Howard	US 6,584,505 B1	June 24, 2003	Ex. 1007
Newton	*Newton's Telecom Dictionary*, 22nd edition. CMPBooks, 2006. Page 763.	2006	Ex. 1008

E. Asserted Grounds of Unpatentability

We instituted review of claims 1, 3–6, 8–11, and 13–15 of the '194 patent on the following specific grounds. Paper 9, 22.

References	Basis	Challenged Claims
Wu, Glasser, and DeSimone	§ 103(a)	1, 3, 4, 6, 8, 9, 11, 13, and 14
Wu, Glasser, DeSimone, and Young	§ 103(a)	5, 10, and 15
Wu, Glasser, DeSimone, and Howard	§ 103(a)	1, 3, 4, 6, 8, 9, 11, 13, and 14
Wu, Glasser, DeSimone, Howard, and Young	§ 103(a)	5, 10, and 15

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, we construe claim terms in an unexpired patent according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016)

(upholding the use of the broadest reasonable interpretation standard as the claim interpretation standard to be applied in *inter partes* reviews). Consistent with the broadest reasonable construction, claim terms are presumed to have their ordinary and customary meaning as understood by a person of ordinary skill in the art in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). An inventor may provide a meaning for a term that is different from its ordinary meaning by defining the term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

i. "registration"

Petitioner proposes construction of the claim term "registration" as "the process of supplying personal information needed to establish a subscriber account and get access into a network or a server." Pet. 9–11. Patent Owner contends "registration" is a known term of art and should not be limited to Petitioner's proposed construction. PO Resp. 15–28. Patent Owner appears to contend that "registration" should be construed to encompass "all forms of registration in general." PO Resp. 26. Specifically, Patent Owner appears to contend that the scope of "registration" encompasses a talk request that includes screen names and/or IP addresses. *See* PO Resp. 47–48 ("the host 604 authenticates the talk request to match the provided information (e.g., 'screen names and/or IP addresses') with those of valid subscribers.").

In reply, Petitioner contends that a conference request message identifying potential members to a voice conference is not a "registration" within the meaning of the claim term. *See* Reply 10–14 (discussing potential

members of a voice communication). Petitioner contends that the Specification of the '194 patent discloses a conference request message that identifies parties who are potential targets to a conference call (i.e., those targets in an IM session), and that the conference call server can parse the message to determine the addresses of the conference call targets. Reply 11–12 (citing Ex. 1009 ¶¶ 52–53; Ex. 1001, 6:44–51, 59–62); Ex. 1001, 6:14–16 ("As indicated by [Figure 1], *the core of the present invention is the use of instant messaging to trigger initiation of a host initiated conference call*.") (emphasis added). Petitioner contends that Applicant cited disclosed embodiments in paragraphs 22, 23, and 50–53 of Exhibit 1009 during prosecution as support for the claimed "without requiring registration." Reply 13 (citing Ex. 1010, 10). According to Petitioner, construing "registration" to encompass a conference request message that includes addresses of targets would exclude a preferred embodiment, and "is rarely, if ever correct and would require highly persuasive evidentiary support." Reply 13 (quoting *Epos Techs. Ltd. V. Pegasus Techs Ltd.*, 766 F.3d 1338, 1347 (Fed. Cir. 2014)).

During prosecution, with respect to the cited embodiments noted above, Applicant submitted to the Examiner that the

> embodiments [of] paragraphs 22, 23 and 50–53 clearly <u>do not require prior registration with a conference call server</u> by potential members of a voice communication. Indeed, the conference server may simply strip telephone numbers from the conference request message sent from the instant messaging service and establish the voice communication directly therefrom.

Ex. 1010, 10 (referring to paragraph numbers in the Patent Application Publication, Ex. 1009).

The portion of the issued patent's Specification corresponding to paragraph 52 of the published application states the following:

> When a conference call requester desires to initiate a conference call, the conference call requester may generate 106 a message (hereafter referred to as the "conference request message") to the conference server identifying parties who are potential participants ("potential targets") to a conference call. The potential call targets may be identified by an alias, such as a user name associated with the conference call targets in the conference call requester's NAD [(Network Access Device)]. Alternately, the information may be an alias identifying information associated with the potential targets *stored in the conference server*. Alternately, the potential targets may be identified by phone numbers or other addresses for the potential targets. Once the conference request message has been generated, the conference request message may be transmitted 108 from the NAD to the conference call server.

Ex. 1001, 6:44–58 (emphasis added); *accord* Ex. 1009 ¶ 52. Thus, a conference call request identifies potential participants to a conference call using information stored previously somewhere in the system (in the conference server or in the requester's NAD as disclosed above), with the information associated with the potential targets, such as an alias, a user name, a phone number, or another address for the potential targets. The Specification supports including some type of prior submission of information in several places. *See, e.g.*, Ex. 1001, Fig. 3B ("Conference Server takes conference request, looks up profile information for targets in this conference."), 6:14–16 ("As indicated by [Figure 1], *the core of the present invention is the use of instant messaging to trigger initiation of a host initiated conference call*.") (emphasis added).

In light of the Specification we construe "registration" as not encompassing a mere conference request message that identifies parties who

are potential targets to a conference call using information associated with the potential targets, such as an alias, a user name, a phone number, or another address for the potential targets. *See* Ex. 1010, 10; Ex. 1009 ¶¶ 52–53; Ex. 1001, 6:44–51, 59–62.[1]

ii. "conference call server"

Petitioner proposes the claim term "a conference call server" should be construed as "a server that establishes the conference call." Pet. 15 (emphasis omitted). Patent Owner contends the conference call server may indirectly establish a conference call using a physically separate component. Resp. 31–34. In particular, Patent Owner represents that "a conference call server" has been preliminarily construed by a District Court to encompass computer or software that initiates or requests initiation of a conference call. Resp. 33–34 (citing Exs. 2001, 2002). Petitioner contends that the Petition does not take a position on whether a conference call server can indirectly establish a conference call. Reply 15. We determine that, in light of the Specification and the language of the claim, the scope of "a conference call server" encompasses at least a computer or software that initiates or requests initiation of a conference call. *See* Ex. 1001, Figs. 3B; *see also* Ex. 1001, Fig. 3B (Step 330: "Conference Server takes conference request, looks up profile information for targets in this conference."), Fig. 4 (conference call server 402, which includes 406 "Account, User, History, Provider Database").

[1] As indicated, the above-discussed remarks by Patent Owner during prosecution support our construction. *See* Ex. 1010, 10.

iii. "without requiring . . . registration with a conference call server for establishing the voice communication by the potential members including the first party and the at least one other party"

Petitioner proposes the claim term "without requiring . . . registration with a conference call server for establishing the voice communication by potential members including the first party and the at least one other party," should be interpreted to mean, separate registration with a conference call server is not required to initiate voice communication between current participants of an instant message session. Pet. 13. Petitioner highlights that during a prior litigation involving the '194 patent not involving Petitioner, Patent Owner agreed to this construction. *Id.* (citing Ex. 1017, 2). Patent Owner argues that there is no need to separately construe this entire phrase, asserting that the construction of either "registration" or "conference call server" is dispositive. Resp. 36.

The Specification supports Petitioner's construction. For example, the Specification generally discloses allowing potential callers to make a call to targets during an IM session without requiring them to add registration information to the conference call server. *See supra* Section II.A.i–ii (construing "registration" and "conference call server"); Ex. 1001, Fig. 3A, Fig. 4, 6:14–16 ("As indicated by [Figure 1], *the core of the present invention is the use of instant messaging to trigger initiation of a host initiated conference call*.") (emphasis added), 6:44–58; *accord* Ex. 1009 ¶ 52.

We determine that the broadest reasonable interpretation of "without requiring . . . registration with a conference call server for establishing the voice communication by the potential members including the first party and

the at least one other party," read in light of the Specification of the '194 patent, encompasses "current participants of an IM session are not required to complete an additional or separate registration with a conference call server before establishing voice communication between current participants of the IM session."

We further determine that none of the other terms require express construction.

B. Asserted Obviousness Over Wu, Glasser, and DeSimone: Claims 1, 3, 4, 6, 8, 9, 11, 13, and 14

Petitioner, relying on the Declaration of David Klausner (Ex. 1002), challenges claims 1, 3, 4, 6, 8, 9, 11, 13, and 14 as obvious over the combination of Wu, Glasser, and DeSimone. Pet. 22–58.

1. Wu (Ex. 1003)

Wu relates generally to transferring data between subscribers of a communications system and more particularly to transferring audio data between subscribers of an instant messaging host. Ex. 1003 ¶ 2.

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Figure 7 of Wu is reproduced below.

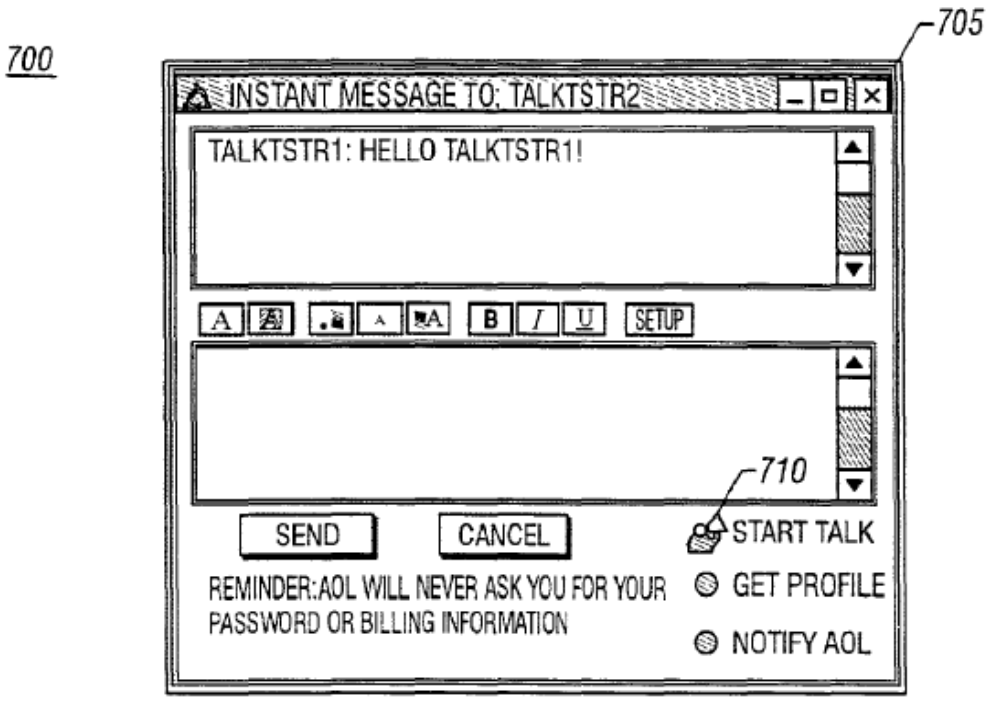

FIG. 7

Figure 7 above shows an example of a start talk user interface (UI) 700 including instant message box 705 having start talk button 710 for requesting a talk session. Ex. 1003 ¶ 85. Figure 7 shows a sender, TALKSTR1, sending an instant message to a recipient, TALKSTR2. If both the sender and recipient of an IM are talk enabled, the start talk UI having a functioning start talk button is displayed to both the sender and recipient. *Id.* ¶¶ 69, 71. The sender initiates a talk session by sending a talk request to the host. The talk request may contain the message type, the screen name, or the Internet protocol (IP) address of the sender and recipient, and a security number. *Id.* ¶ 71. The host authenticates the talk request, then sends the talk

request to the recipient. *Id.* ¶¶ 72–73. If the recipient accepts the talk request, the host establishes a talk session. *Id.* ¶ 74.

2. Glasser (Ex. 1005)

Glasser is related to monitoring user activity and reporting the same in a computer network. Ex. 1005, 1:7–10. If a user of computer A is typing a message, a message processor generates an activity message that is transmitted to computers B and C. *Id.* at 9:16–20; Fig. 3. Message processors in computers B and C process the activity message from computer A and display an activity indicator. *Id.* at 9:20–25.

3. DeSimone (Ex. 1006)

DeSimone relates to establishing and maintaining multiple simultaneous asynchronous message sessions between overlapping or non-overlapping sets of users in data communications contexts, such as Internet chat sessions. Ex. 1006, 1:10–15. The system has unique names for each participant visible to each participant. *Id.* at 5:51–54. Any participant can add a new participant, triggering a message to all other participants causing their view to be updated. *Id.* at 5:55–58.

4. Analysis of Claims 1, 3, 4, 6, 8, 9, 11, 13, and 14

a. Analysis of independent claims 1, 6, and 11

Petitioner contends "display, in an instant messaging (IM) chat window of a first party, an exchange of IM messages between the first party and at least one other party, the first party and the at least one other party being current participants to an IM session," as recited in independent claim 1, is taught by the combination of Wu and DeSimone. Pet. 24–29. Petitioner contends Wu describes displaying an instant messaging chat window 705 showing an exchanges of messages sent by first party

TALKTSTR1 to second party TALKTSTR2. Pet. 24–27 (citing Ex. 1003, Fig. 7; ¶¶ 4, 51, 52, 66, 71, 73). Petitioner contends DeSimone discloses "an exchange of IM messages between the first party and the at least one other party" as claimed in describing a string of messages between participants in a current IM session. Pet. 27–28 (citing Ex. 1006, Fig. 5A; 3:43–45).

Petitioner relies on testimony from Mr. Klausner, who testifies that displaying, in the IM chat window shown in Figure 7 of Wu, the two-way exchange of IM messages between a first party and a second party disclosed and suggested by DeSimone, yields the predictable result of Wu's IM chat window showing chat messages sent by both parties in the IM session. Pet. 28 (citing Ex. 1002 ¶¶ 78–80). We credit this testimony, and determine that the combination of Wu and DeSimone teaches displaying an exchange of messages between a first party and a second party in an IM session. Petitioner persuasively adds that displaying such an exchange in a window would have been obvious to ensure participants predictably would be able to see the results of the exchange. *See* Pet. 27–28.

Petitioner persuasively contends "display for the first party an indication of whether the at least one other party is communicably connected to the IM session," as recited in independent claims 1, 6, and 11, is taught by the combination of Wu, Glasser, and DeSimone. Pet. 29–37. Petitioner contends Glasser describes activity messages indicating what other participants are currently doing. Pet. 29–32 (citing Ex. 1005, Fig. 3; 7:13–14, 8:8–16, 9:16–25), Pet. 56.

Petitioner relies on testimony from Mr. Klausner, who testifies that displaying the activity messages of Glasser in the IM chat window of Wu yields the predictable result of displaying an activity indicator reflecting the

other party's current activity or status. Pet. 32 (citing Ex. 1002 ¶ 85). Mr. Klausner testifies that a benefit of this combination is improving the user experience for IM participants by notifying them of the activity of the other participant. *Id.* (citing Ex. 1002 ¶¶ 85–87).

Petitioner persuasively contends that DeSimone discloses "display for the first party an indication of whether the at least one other party is communicably connected to the IM session," as recited in independent claims 1, 6, and 11, in describing a list of other parties who are currently participating in an IM session, an indicator to show that "Dave" is added to the IM session, and an indicator to show that "Mike" is dropped from the session. Pet. 33–35 (citing Ex. 1006, Figs. 5A, 6A; 5:55–62, 12:44–48, 13:28–30, 14:46–48), Pet. 54, 56.

Petitioner relies on testimony from Mr. Klausner, who testifies that displaying the presence notification feature of DeSimone in the IM chat window of Wu yields the predictable result of displaying an indicator listing the other parties to the IM session who are connected to the IM session. Pet. 35–36 (citing Ex. 1002 ¶ 93). Petitioner persuasively argues (citing Ex. 1002 ¶ 93) that a benefit of this combination is enhancing the first party's experience by providing a visual indicator of whether other parties to the IM session are available to communicate. Pet. 36.

Petitioner relies on testimony from Dr. Klausner to contend persuasively that the addition of DeSimone to the combination of Wu and Glasser would provide the benefit of allowing the first party to determine whether the other party is still communicably connected to the IM session, even when the other party is not typing a message. Pet. 37 (citing Ex. 1002 ¶ 95). We credit the testimony of Dr. Klausner, and determine that the

combination of Wu, Glasser, and DeSimone teaches displaying an indication of another party's current activity or status in an IM chat window.

Petitioner persuasively contends "display for the first party an option to automatically initiate voice communication between the current participants of the IM session," as recited in independent claims 1, 6, and 11, is disclosed by Wu in describing a start talk button for requesting a talk session displayed in an instant message box. Pet. 37–39 (citing Ex. 1003, Fig. 7; ¶¶ 65–74, 79). We find that the start talk button disclosed in Figure 7 and paragraphs 65–74 and 79 of Wu describe this limitation.

Independent claim 1 recites "without requiring individual selection of potential members including the first party and the at least one other party." Each of independent claims 6 and 11 recites a similar limitation. Petitioner persuasively contends this limitation is disclosed by Wu in describing that a first party presses the start talk button to automatically initiate voice communication without having to select the other party. Pet. 39–40 (citing Ex. 1003, ¶¶ 71–74).

Patent Owner contends that Wu teaches away from this limitation, because Wu discloses that the sender must individually select potential members. PO Resp. 62 (citing Ex. 1003 ¶ 66; Ex. 2003 ¶¶ 89–92). Petitioner persuasively replies that the "without requiring individual selection" recited in claim 1 modifies the claimed "display . . . an option to automatically initiate voice communication." Reply 23–25. According to Petitioner, Paragraph 66 of Wu discloses individual selection for initiating instant messaging, not to automatically initiate voice communication. Reply 25–26 (citing Ex. 1025 ¶ 20; Ex. 1003 ¶ 66).

Further, Mr. Klausner testifies that "the first party presses the 'START TALK' button in Wu and voice communication is automatically initiated without having to select the other party with whom voice communication will be established." Ex. 1002 ¶ 102 (citing Ex. 1003 ¶¶ 71–74). We credit this uncontroverted testimony and determine that Wu teaches "without requiring individual selection of potential members."

Independent claim 1 recites "without requiring registration with a conference call server for establishing the voice communication by the potential members including the first party and the at least one other party." Each of independent claims 6 and 11 recite a similar limitation. Petitioner persuasively contends this limitation is disclosed by Wu in describing an IM host complex separate from a login server. Pet. 40–48 (citing Ex. 1003, Figs. 3, 5, 7; ¶¶ 31–34, 40, 50–54). Petitioner relies on testimony from Mr. Klausner, who credibly testifies that because the login server completes the registration process, there is no need for separate registration by the potential members. Pet. 45–48 (citing Ex. 1002 ¶¶ 111–113, 115, 116).

Patent Owner contends that the authentication steps shown in Figure 6 of Wu teach away from automatically initiating voice communication without registration with a conference call server. PO. Resp. 43–62. Patent Owner contends that because Figure 6 of Wu teaches registration, Wu cannot be properly modified to remove the registration process. PO. Resp. 43–49. In particular, Patent Owner contends that the authenticate text message step 610, and the authenticate talk request step 650, are each a subscriber registration process. PO Resp. 45. According to Patent Owner, the "host 604 may authenticate the talk request by, for example, using a

reverse look-up table to match the screen names and/or IP addresses with those of valid subscribers." PO Resp. 47 (quoting Ex. 1003 ¶ 72).

Petitioner responds that the claimed registration by the potential members is not the same as Wu's authentication by the server. Reply 10. According to Petitioner, the authentication steps 610 and 650 do not require the user to reenter username and password information. Reply 9–10 (citing Ex. 1002 ¶¶ 111–116; Ex. 1025 ¶ 36). Petitioner further contends that there is no material difference between the conference request message disclosed by the '194 patent and the talk request message of Wu. Reply 12 (citing Ex. 1001, 6:44–51; Ex. 1003 ¶ 71; *see* Ex. 1025 ¶ 42). Further, Petitioner contends construing "registration" to mean a talk request message containing a screen name would exclude a preferred embodiment of the '194 patent. Reply 12–13.

We agree with Petitioner. As discussed in our construction of "registration," the scope of registration does not encompass a conference request message that contains a screen name, such as the talk request disclosed by Wu.

Patent Owner contends that because the subscriber's personal information is necessary to establish a subscriber account and get access to the talk request service, the authentication in step 650 of Wu constitutes a registration. PO Resp. 48. According to Patent Owner, the requirement that subscribers register with the host expressly teaches away from "an option to automatically initiate voice communication between the current participants of the IM session . . . without requiring registration with a conference call server." PO Resp. 49 (emphasis omitted).

Petitioner contends that Wu discloses that the host 604 of Figure 6 has attributes comparable to those of host device 335 and 535. Reply 5 (citing Ex. 1003 ¶ 60). We find that Figure 6 of Wu shows a flow chart of a communication method, rather than a diagram of a communication system. *See* Ex. 1003 ¶¶ 11–12. Host 535, shown in Figure 5 of Wu, can implement the communication method of Figure 6. *Id*. Host 535 includes a login server, IM server 5902, profile server 5912, database 5914, and domain server 5904. We find that Wu does not disclose which server of host 535 stores subscription information, and also does not disclose which server uses the reverse look-up table to match screen names and/or IP addresses with those of valid subscribers. *See* Ex. 1003 ¶ 72. Because Wu does not disclose or state that a conference call server stores the subscription information, Wu teaches or at least suggests "without requiring" subscription "with a conference call server" within the meaning of claim 1. *See* Pet. 46, 40–48 (providing persuasive reasons, including the architecture and use of Wu's login server, why "[o]ne of ordinary skill in the art would have found it obvious that other servers in the system (including the 'conference call server') need not separately require that members enter registration information").

In other words, in addition to arguing Wu discloses the limitation, Petitioner, relying on testimony of Mr. Klausner, contends that one of ordinary skill in the art would have found it obvious to have users enter registration information with the login server rather than a conference call server, for the benefits of avoiding unnecessary repeating the registering, and also for increasing system security by handling registration information at the login server. Pet. 46–47 (citing Ex. 1002 ¶¶ 113, 116; Ex. 1003, Fig.

7). We credit this testimony and determine that to the extent Wu requires users to subscribe at a server, Wu discloses or at least suggests subscribing with a server other than the conference call server.

We additionally find, under an alternative rationale, that Wu does not require that the current participants of the IM session provide subscription information. *See* Ex. 1003 ¶ 72. Rather, in Wu, the host uses existing subscription information from a reverse look-up table when performing the authentication of steps 610 and 650. *See* Ex. 1003 ¶¶ 67, 72. The claim does not exclude the conference call server obtaining registration data from someone or someplace other than the current participants of the IM session. Given that the scope of this limitation encompasses the conference call server receiving subscription data from someone or someplace other than the current participants of the IM session, we determine that Wu discloses the limitation, and that the authentication steps of Wu, which use subscription data provided in a reverse look-up table, do not detract from teaching this limitation.

Patent Owner also contends that Wu discloses that its host operates as a functional whole that includes both the login server and an IM host complex. PO Resp. 52–53. According to Patent Owner, because the Specification of the '194 patent contemplates the claimed "conference call server" establishing voice communication using a distributed system, the entire host system of Wu, including the login server and the IM server, is a conference call server. PO Resp. 51–54. To support this contention, Patent Owner relies on Wu's description of Figure 6, which discloses that host 604 executes all steps of procedure 600. PO Resp. 53 (citing Ex. 2003 ¶¶ 102, 109–110).

Petitioner contends that the login server of Wu has no role in initiating or establishing voice communication, either directly or indirectly. Reply 15 (citing Ex. 1002 ¶¶ 107–111). Petitioner emphasizes that the login server of Wu breaks the connection with the client after login authorization is completed, allowing the client to connect directly with the IM server. Reply 6 (citing Ex. 1003 ¶ 51; Ex. 1002 ¶¶ 110–111). Petitioner also emphasizes that the login process of Wu occurs before the claimed option to initiate voice communication is displayed for the first party. Reply 8 (citing Ex. 1025 ¶ 30; Ex. 2003 ¶ 40).

We determine that, because the login server of Wu breaks the connection with the client system if the login server determines the user is authorized to access the host complex, the login server of Wu does not initiate or establish voice communication, either directly or indirectly, and is therefore not a conference call server within the scope of claim 1. Ex. 1003 ¶ 51. We further determine that, because the subscriber identification and password are provided to the login server of Wu before a connection with an IM server is authorized and established, the subscriber identification and password are not provided to the login server by current participants of the IM session within the scope of claim 1. Ex. 1003 ¶ 51.

Patent Owner also contends that Wu does not disclose which server within the IM host complex establishes the talk session. PO Resp. 54–56. In particular, Patent Owner contends that Wu's description of the procedure to transfer audio data does not reference the IM host complex 590, but rather, refers to host 604 as implementing all steps. PO Resp. 55–56 (citing Ex. 1003, Fig. 6; Ex. 2003 ¶¶ 72–87). Patent Owner appears to contend that because Wu refers to host 604 as performing login and also performing

voice communication, Wu discloses registration with a conference call server. *Id*.

However, as discussed above, Petitioner contends that Wu discloses the host 604 has attributes comparable to those described with respect to host device 335 and 535. Reply 5 (citing Ex. 1003 ¶ 60, Figs. 3 and 5). We agree with Petitioner. Wu describes Figure 6 as "a flow chart of a communications method that may be implemented by the systems of FIGS. 1–5". Ex. 1003 ¶ 12. The system of Figure 5 of Wu relied on in the Petition, which implements the communications method of Figure 6, discloses a login server that does not initiate or establish a conference call, because the connection with the login server is broken after login is completed. Pet. 43–46 (citing Ex. 1003 ¶ 51).

Patent Owner contends that the authentication steps 610 and 650 shown in Figure 6 of Wu (1) require registration necessary to establish the talk session, and (2) are performed by the login server. PO Resp. 56–61. However, as discussed above, Wu does not disclose a conference call server stores subscription information or performs authentication. *See* Ex. 1003 ¶¶ 67, 72. Wu also discloses the reverse look-up table provides the subscription information needed to authenticate, as opposed to current members of an IM session providing it. *Id.*

Patent Owner contends that because Wu teaches away from "without requiring registration with a conference call server," Wu cannot be combined or modified in any manner that removes the registration process. PO Resp. 61–62. However, as discussed above, even though Wu discloses requiring a user to login to a login server, and to be a valid subscriber, Wu does not disclose that a separate registration with a conference call server is

required to initiate voice communication between current participants of an instant message session.

Further, Mr. Klausner testifies that "Wu discloses that the only server with which potential members might have to register is the login server, which is not 'a conference call server' because it has no role in initiating or establishing voice communication with potential members." Ex. 1002 ¶ 108. Mr. Klausner continues:

> Moreover, Wu does not require that potential members register with any other component of the system, including with IM host complex 590 or any of its associated servers, which provide the instant messaging functionality. ([Ex. 1003] ¶ 52). Therefore, Wu discloses that voice communication may be initiated without requiring registration with a conference call server for establishing the voice communication by the potential members.

Id. at ¶ 109. Mr. Klausner testifies that a person of ordinary skill would have found it obvious that other parts of the distributed system of Wu, including the conference call server, would not separately require that members enter registration information, because doing so could (a) annoy users by requiring them to perform the registration step again, and (b) reduce security by requiring subsystems aside from the login server to receive and handle critical registration information. *Id.* at ¶ 113.

We credit this testimony and determine that Wu discloses or suggests, and does not teach away from, "without requiring registration with a conference call server for establishing the voice communication by the potential members including the first party and the at least one other party" as claimed.

Petitioner also contends "request, in response to selection of the option, voice communication between the first party and the at least one

other party" as recited in independent claims 1, 6, and 11, is disclosed by Wu in describing a talk request to a recipient. Pet. 48–49 (citing Ex. 1003, ¶¶ 71, 72, 74). We are persuaded that Petitioner has sufficiently established that Wu teaches this limitation.

Petitioner further contends "wherein in response to the request, the voice communication is established between the first party and those of the at least one other party" as recited in independent claims 1, 6, 11, is disclosed by Wu in describing establishing a talk session between the parties. Pet. 50 (citing Ex. 1003 ¶ 74). We find that establishing a talk session between parties as disclosed by paragraph 74 of Wu describes this limitation.

We determine that Petitioner has articulated sufficient reasoning to support its conclusion that independent claims 1, 6, and 11 would have been obvious. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). In addition to the summary above, we adopt Petitioner's showing as our own. *See* Pet. 22–50. Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of the evidence that the combination of Wu, Glasser, and DeSimone renders claims 1, 6, and 11 unpatentable for obviousness.

b. Analysis of dependent claims 4, 9, and 14

Petitioner relies on testimony of Mr. Klausner to contend "display of a click-on icon that allows for a single step selection of the option" as recited in dependent claims 3, 8, and 13, is disclosed by Wu in describing a start talk button. Pet. 50–51 (citing Ex. 1002 ¶¶ 132–134), Pet. 55. We credit this testimony and determine the Petition and supporting evidence show by a

preponderance of the evidence that claims 3, 8, and 13 would have been obvious over the combination of Wu, Glasser, and DeSimone.

Petitioner contends "wherein said display an exchange of IM and said display for the first party comprise display within a common browser or application window" as recited in dependent claims 4, 9, and 14, is disclosed by DeSimone in describing the list of current participants in an IM session appearing in the same application window as the IM session. Pet. 51–52 (citing Ex. 1006, Figs. 5A, 6A), Pet. 56.

Petitioner relies on testimony of Mr. Klausner, who testifies that placing the indication taught by DeSimone and Glasser, and the start talk option button taught by Wu, in the same application or browser window as the exchange of IM messages, would have provided the benefit of presenting information elements relating to a common subject in a common window. Pet. 52–53 (citing Ex. 1002 ¶¶ 138–39).

We determine that Petitioner has articulated sufficient reasoning to support its conclusion that placing an indication and a start talk option button in the same application or browser window as the exchange of IM messages as taught by the combination of Wu, Glasser, and DeSimone would have been obvious. We determine the Petition and supporting evidence establish by a preponderance of evidence that claims 4, 9, and 14 would have been obvious over the combination of Wu, Glasser, and DeSimone.

C. Asserted Obviousness Over Wu, Glasser, DeSimone, and Young: Claims 5, 10, and 15

1. Young (Ex. 1004)

Young discloses aspects of instant messaging systems, including America Online (AOL) Instant Messenger and Yahoo Messenger. Ex. 1004, 330. Young discloses that instant messaging systems can support audio and video conferencing. *Id.* at 365–67.

2. Analysis of claims 5, 10, and 15

Petitioner contends "wherein the voice communication includes audio and video" as recited in claims 5, 10, and 15 is disclosed by Young in describing that a first party clicks a webcam button on an Instant Message window, and other people in the instant message conversation see a dialog box inviting them to the webcam. Pet. 58–59 (citing Ex. 1004, p. 367). Petitioner contends that if the other people accept the invitation, they see a window showing a webcam video of the inviting party. *Id.*

Petitioner relies on testimony of Mr. Klausner to contend that adapting the instant messaging system of Wu to include the videoconferencing features described in Young yields the predictable result of the instant messaging and voice communication system of Wu, including the ability to exchange video during conversations and conferences. Pet. 59–61 (citing Ex. 1002 ¶¶ 142–143).

We credit this testimony, which is uncontroverted, and determine that the combination of Wu and Young teaches an instant messaging system that supports voice and video conferencing. We determine the Petition and supporting evidence establish by a preponderance of evidence that claims 5, 10, and 15 would have been obvious over the combination of Wu, Glasser, DeSimone, and Young.

D. Asserted Obviousness Over Wu, Glasser, DeSimone, and Howard: Claims 1, 3, 4, 6, 8, 9, 11, 13, and 14

1. Howard (Ex. 1007)

Howard relates to authentication of a user through an authentication server prior to granting access to an affiliate server. Ex. 1007, 1:9–11. An authentication server determines whether a user attempting to gain access to a network server was already authenticated by the authentication server. *Id.*, Abstract. If so, the network server is notified that the user is authenticated. *Id.* If not, then login information is retrieved from the user and compared to authentication information maintained by the authentication server. *Id.* If the retrieved login information matches the authentication information, then the network server is notified that the user is authenticated. *Id.*

2. Analysis of claims 1, 3, 4, 6, 8, 9, 11, 13, and 14

Petitioner relies on the same mapping of prior art, and the same arguments, as the proposed obviousness of claims 1, 3, 4, 6, 8, 9, 11, 13, and 14 over Wu, Glasser, and DeSimone, with the addition of Howard (Ex. 1007) as an alternative disclosure of "without requiring registration with a conference call server . . . by the potential members" as recited in independent claims 1, 6, and 11. Pet. 61.

Petitioner persuasively contends "without requiring registration with a conference call server . . . by the potential members" as recited in independent claims 1, 6, and 11 is disclosed by Howard in describing a centralized authentication server that stores user registration information, and an affiliate server that a client computer seeks to access. Pet. 64–65 (citing Ex. 1007, 1:22–30, 1:52–56, 2:16–21). Petitioner persuasively contends the user of Howard only registers with the authentication server,

and thereafter does not have to separately register or login to the affiliate server. Pet. 65–67 (citing Ex. 1007, Fig. 1; 5:44–63, 8:38–43, 9:64–10:4).

Petitioner relies on testimony from Mr. Klausner to contend persuasively that a person of ordinary skill in the art would have adapted the teachings Howard, which provide a centralized registration server that works across multiple affiliate servers, to include the IM servers of Wu, for the benefit of improving user experience by applying the single sign-on techniques of Howard to the IM system of Wu. Pet. 67–69 (citing Ex. 1002 ¶¶ 125–126).

Patent Owner contends that the registering server of Howard satisfies the requirements of a conference call server, because it indirectly requests initiation of voice communication. PO Resp. 66. Patent Owner also contends that the disclosure of Howard does not mention instant messaging or voice communication between users. PO Resp. 67.

Petitioner persuasively responds that Howard discloses registration with an authentication server as a one-time process. Reply 18 (citing Ex. 1007, 5:44–49). Petitioner also responds persuasively that Howard discloses that after registering and logging into the authentication server, the user can visit any affiliate server without requiring any additional information and without re-entering user information already contained in the user profile. Reply 18–19 (citing Ex. 1007 5:57–63). Petitioner further persuasively contends that the authentication server of Howard has no involvement in establishing voice communications. Pet. 19 (citing PO Resp. 67).

Mr. Klausner credibly testifies that Howard discloses the following:

> After registering and logging into the authentication server, the user can visit any affiliate server (i.e., affiliate servers that are also registered with the same authentication server) without

> requiring any additional authentication and without re-entering user information that is already contained in the user profile.

Ex. 1002 ¶ 121 (citing Ex. 1007, 5:44–63) (emphasis omitted). Mr. Klausner also credibly testifies that Howard's techniques are applicable to any type of web server that accesses a centralized authentication system to authenticate a user, such as the IM servers disclosed in Wu. *Id.* ¶ 125 (citing Ex. 1007, 9:45–48).

Mr. Klausner further credibly testifies that Howard teaches the benefit of providing a single user profile to multiple affiliate servers without requiring repeated entry of information by the user (i.e. entering user information at each new Web site visited). *Id.* ¶ 126 (citing Ex. 1007, 9:64–10:1). According to Mr. Klausner, a person of ordinary skill in the art would have been encouraged by these statements to improve the user's experience by applying the single sign-on techniques of Howard to the instant messaging system of Wu. *Id.*

In light of Patent Owner's contention that Howard does not mention voice communication, we determine that the authentication server of Howard does not request initiation of voice communication, either directly or indirectly, and is therefore not a conference call server within the meaning of claim 1. PO Resp. 67. We further determine that users who provide authentication information to the authentication server of Howard, prior to gaining access to a network server, such as the IM server of Wu, would not be "current members of an IM session" within the scope of claim 1, because such users have not yet gained access to the IM server. *See* Ex. 1007, Abstract.

Based on the foregoing discussion and the record, Petitioner has shown by a preponderance of evidence that the combination of Wu, Glasser,

DeSimone, and Howard renders claims 1, 3, 4, 6, 8, 9, 11, 13, and 14 unpatentable for obviousness.

E. Asserted Obviousness Over Wu, Glasser, DeSimone, Howard, and Young: Claims 5, 10, and 15

Petitioner relies on the same mapping of prior art, and the same arguments, as the proposed obviousness of claims 5, 10, and 15, over Wu, Glasser, DeSimone, and Young, with the exception of adding Howard (Ex. 1007) as an alternative disclosure of "without requiring registration with a conference call server . . . by the potential members" recited in independent claims 1, 6, and 11, as discussed above. Pet. 69.

Petitioner persuasively contends "wherein the voice communication includes audio and video" as recited in claims 5, 10, and 15, is disclosed by Young in describing that a first party clicks a webcam button on an Instant Message window, and other people in the instant message conversation see a dialog box inviting them to the webcam. Pet. 58–59 (citing Ex. 1004, p. 367). Petitioner persuasively contends that if the other people accept the invitation, they see a window showing a webcam video of the inviting party. *Id.*

Petitioner relies on the credible testimony of Mr. Klausner to contend persuasively that adapting the instant messaging system of Wu to include the videoconferencing features described in Young yields the predictable result of the instant messaging and voice communication system of Wu, including the ability to exchange video during conversations and conferences. Pet. 59–61 (citing Ex. 1002 ¶¶ 142–143).

We credit this testimony and determine that Petitioner has articulated sufficient reasoning to support its conclusion that the combination of Wu

and Young teaches an instant messaging system that supports voice and video conferencing. *See* Pet. 58–69. We determine the Petition and supporting evidence establish by a preponderance of evidence that claims 5, 10, and 15 would have been obvious over the combination of Wu, Glasser, DeSimone, Howard, and Young.

III. CONCLUSION

On this record, Petitioner has shown by a preponderance of evidence that claims 1, 3–6, 8–11, and 13–15 of the '194 patent are unpatentable.

IV. ORDER

Accordingly, it is

ORDERED

1. Claims 1, 3, 4, 6, 8, 9, 11, 13, and 14 of the '194 patent are unpatentable under 35 U.S.C. § 103 over Wu, Glasser, and DeSimone;

2. Claims 5, 10, and 15 of the '194 patent are unpatentable under 35 U.S.C. § 103 over Wu, Glasser, DeSimone, and Young;

3. Claims 1, 3, 4, 6, 8, 9, 11, 13, and 14 of the '194 patent are unpatentable under 35 U.S.C. § 103 over Wu, Glasser, DeSimone, and Howard; and

4. Claims 5, 10, and 15 of the '194 patent are unpatentable under 35 U.S.C. § 103 over Wu, Glasser, DeSimone, Howard, and Young; and

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

IPR2016-01756
Patent 8,571,194 B2

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., and WHATSAPP INC.,
Petitioner,

v.

UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.,
Patent Owner.

Case IPR2016-01756
Patent 8,571,194 B2

Before KARL D. EASTHOM, KEN B. BARRETT, and JEFFREY S. SMITH, *Administrative Patent Judges.*

SMITH, *Administrative Patent Judge*.

DECISION
On Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Patent Owner, Uniloc Luxembourg S.A., filed a Request for Rehearing (Paper 35, "Req. Reh'g") of our Final Written Decision ("FWD") dated March 13, 2018, which held that claims 1, 3–6, 8–11, and 13–15 of U.S. Patent No. 8,571,194 B2 (Ex. 1001, "the '194 patent") are unpatentable.

In its Request, Patent Owner argues that the FWD misapprehends the significance of the prosecution history when considering the teachings of Wu (Ex. 1013), and overlooks the fact that Howard (Ex. 1007) was considered by the Examiner and is cumulative to Wu. Req. Reh'g 9–10.

For the reasons set forth below, Patent Owner's Request for Rehearing is denied.

II. STANDARD OF REVIEW

Section 37 C.F.R. § 42.71(d) states the following:

> A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

III. DISCUSSION

Patent Owner contends that the FWD misapprehended the fact that Patent Owner disclaimed the embodiment of Paragraph 56 of the Published Application (Ex. 1009) of the '194 patent ("Paragraph 56"), because "the Examiner found [the embodiment of Paragraph 56] invalidating under *Hamberg*." Req. Reh'g 9–10 (citing the Hearing Transcript (Paper 33)). Patent Owner's challenge does not meet the standard set forth for a Request

for Rehearing, which requires a party to "identify . . . the place where each matter was previously addressed in a motion, an opposition, or a reply." 37 C.F.R. § 42.71(d). As Patent Owner did not address this issue in a motion, an opposition, or a reply, the Board could not have misapprehended Patent Owner's argument.

Even if we consider Patent Owner's contention that Patent Owner disclaimed the embodiment of Paragraph 56 because, according to Patent Owner, the Examiner found this embodiment invalidating under Hamberg, we find this contention unpersuasive.

"[T]he PTO is under no obligation to accept a claim construction proffered as a prosecution history disclaimer, which generally only binds the patent owner." *Tempo Lighting, Inc. v. Tivoli*, LLC, 742 F.3d 973, 978 (Fed. Cir. 2014). Assuming *arguendo* that the doctrine of prosecution history disclaimer applies to this *inter partes* review, the purported disavowal of claim scope must be unambiguous, clear, and unmistakable to one of ordinary skill in the art. *Elbex Video, Ltd. v. Sensormatic Elecs. Corp.*, 508 F.3d 1366, 1371 (Fed. Cir. 2007) (citations omitted). On the record before us, we conclude that the prosecution history does not evidence such an unambiguous, clear, and unmistakable disavowal.

After a final rejection, the applicant amended claim 103 to modify the subject negative limitation such that the recited "display" step was performed "without requiring . . . prior registration." *See* Ex. 1011, 1–2. The Examiner refused to enter the amendment because of a lack of written description support in the specification. Contrary to Patent Owner's argument, the Examiner did not find the embodiment of Paragraph 56 "invalidating" under Hamberg. Rather, the Examiner found that the

limitation "without requiring . . . prior registration" was not described or supported in the specification, because Paragraph 56 of the specification "plainly describes prior registration." Ex. 1011, 2. Notably, the Examiner also found that the specification, at paragraph 57, "further describes a verification process via the use of information *pre-stored in the conference call server* and prompting the users with the pre-stored information to determine if it is correct; this pre-stored information also plainly describes some type of registration had to have taken place." *Id.* (emphasis added). Thus, the Examiner pointed out that the specification of the '194 patent disclosed embodiments where there was prior registration and where that prior registration was on a conference call server.

In response to the Examiner's written description concern, the applicant further amended the claim such that the recited "display" step did not require "prior registration with a conference call server for establishing the voice communication." *See* Ex. 1010, 2–3. The applicant argued that this amendment found support in other paragraphs of the specification, asserting that those other paragraphs disclose collecting information from sources other than by way of prior registration with a conference call server. *Id.* at 9–10. The applicant argued that "these paragraphs [56 and 57] (and other portions of Applicant's specification) are directed to alternative embodiments." Ex. 1010, 10 (underlining in original). After addressing the Examiner's written description concerns, the applicant argued the claim, as-amended, was distinguishable over Hamberg because that reference discloses registration at a conference call server. *Id.* 10–11.

At most, the applicant's arguments found in the prosecution history highlight that the claim was amended to include a phrase directed to not

requiring registration *with a conference call server*—language found in the issued claim that is the subject of this proceeding. Regardless as to what the applicant meant by the characterization of specification paragraphs 56 and 57 as describing "alternative embodiments," the arguments in the prosecution history merely shed light on the meaning of language of the claim as issued and we determine that one of ordinary skill would not understand the applicant to have made a clear and unmistakable disavowal of any subject matter beyond that already reflected in the language of the claim, which we considered in evaluating Petitioner's challenges. In light of this, we are not persuaded that we "misapprehend[ed] the significance of this prosecution history" as Patent Owner asserts. Req. Reh'g 9.

Even if we accept Patent Owner's disclaimer argument, this argument appears based on the premise that Wu's teaching of authenticating, or checking to see if a user is registered as a subscriber, teaches what Patent Owner contends is the disclaimed embodiment of Paragraph 56. *See* Req. Reh'g 10. Patent Owner's argument that "both *Hamberg* and the '194 Patent disclose an embodiment under which the server checks *stored* information to determine if a potential user is a subscriber" is unpersuasive. *See* Req. Reh'g 10. Hamberg discloses only one server, which is a conference call server. *See* Ex. 1024, Fig. 1; Ex. 1010, 10. Similarly, Paragraph 56 discloses that the conference call server determines whether a user is a subscriber. *See* Ex. 1009 ¶ 56. Thus, to the extent that Hamberg and the '194 Patent disclose a server checking whether a user is a subscriber, the server is a conference call server. *See* Ex. 1024, Fig. 1; Ex. 1009 ¶ 56.

In contrast, in our FWD, we determined that "to the extent Wu requires users to subscribe at a server, Wu discloses or at least suggests

subscribing with a server *other than the conference call server*." FWD 21 (emphasis added). In particular, we determined that the login server of Wu contemplates the registration process, therefore, there is no need for separate registration with a conference call server. FWD 18–19. We determined that "Wu does not disclose a conference call server stores subscription information or performs authentication." FWD 23.

Patent Owner additionally contends that the Board overlooked the fact that Howard was considered by the Examiner during prosecution and is cumulative to Wu. Req. Reh'g 10 (citing PO Resp. 39–40). The cited pages of Patent Owner's Reply, which are found under the heading "Overview of Howard" rather than in an argument for patentability, does not mention Wu explicitly or compare Howard to Wu. *See* PO Resp. 39–40. We could not have overlooked an argument not made.

As to Patent Owner's contention that Howard was considered by the Examiner, we were not and are not persuaded. Patent Owner argues that Howard "should be rejected as cumulative" because the Examiner signed and dated an Information Disclosure Statement ("IDS") that includes Howard. PO Resp. 39–40. However, Patent Owner neither identifies, on those pages, that with which Howard allegedly is "cumulative" nor how the fact that Howard appears on an IDS impacts an analysis of patentability. To the extent that Patent Owner is making a belated argument for a discretionary denial of institution under 35 U.S.C. § 325(d),[1] we are not

[1] "In determining whether to institute or order a proceeding . . ., the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d).

persuaded that we should exercise such discretion. Patent Owner does not point to any substantive discussion of Howard by the Examiner or a consideration by the Examiner of the same or substantially the same analysis of Howard presented in the Petition. *See* Pet. 39–40; 35 U.S.C. § 325(d).

IV. CONCLUSION

For the foregoing reasons, Patent Owner did not show that the Board misapprehend or overlooked any arguments or evidence presented by Patent Owner in determining that claims 1, 3–6, 8–11, and 13–15 of US Patent No. 8,571,194 B2 (Ex. 1001, "the '194 patent") are unpatentable.

V. ORDER

Accordingly, it is

ORDERED that the Request for Rehearing is denied.

IPR2016-01756
Patent 8,571,194 B2

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