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Paper 17
Entered: April 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

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

Case IPR2017-00058
Patent 7,804,948 B2

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

SMITH, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision issues pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine Petitioner has shown by a preponderance of the evidence that claims 1, 2, 5–10, 12, 18–26, 29, 30, 36, 37, 49–53, 65, and 66 of U.S. Patent No. 7,804,948 B2 (Ex. 1001, "the '948 patent") are unpatentable.

A. Procedural History

Petitioner filed a Petition for *inter partes* review of claims 1, 2, 5–10, 12, 18–26, 29, 30, 36, 37, 49–53, 65, and 66 of the '948 patent. Paper 2 ("Pet."). Patent Owner filed a Preliminary Response. Paper 5 ("Prelim. Resp."). Pursuant to 37 C.F.R. §§ 42.4(a) and 42.108 and 35 U.S.C. § 314(a), the Board instituted an *inter partes* review of (1) claims 1, 2, 5, 6, 8, 12, 18, 19, 21–25, 29, 30, 49–51, 65, and 66 as unpatentable under 35 U.S.C. § 103 over Hamberg[1] and Lamb[2]; (2) claims 7, 9, 10, 26, 36, 37, 52, and 53 as unpatentable under 35 U.S.C. § 103 over Hamberg, Lamb, and Ludwig[3]; and (3) claim 20 as unpatentable under 35 U.S.C. § 103 over Hamberg, Lamb, and Vassilovski[4]. *See* Paper 6 ("Dec. on Inst.").

After institution, Patent Owner filed a Response (Paper 9, "PO Resp."), to which Petitioner filed a Reply (Paper 12, "Reply"). An oral argument occurred on January 18, 2018. Paper 16 ("Tr.").

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[1] WO 02/21816 A1, published March 14, 2002 (Ex. 1005).
[2] US 6,747,970 B1, issued June 8, 2004, filed March 21, 2000 (Ex. 1006).
[3] US 6,237,025 B1, issued May 22, 2001 (Ex. 1007).
[4] US 2003/0086411 A1, published May 8, 2003, filed November 2, 2001 (Ex. 1008).

B. Related Matters

Petitioner identifies the following matters involving or related to the '948 patent: *Uniloc USA, Inc. v. Google, Inc.*, Case No. 2:16-cv-00566 (E.D. Tex.), filed March 28, 2016; *Uniloc USA, Inc. v. Huawei Enterprise USA, Inc.*, Case No. 6:16-cv-00099 (E.D. Tex.), filed March 4, 2016; *Uniloc USA, Inc. v. Cisco Systems, Inc.*, Case No. 6:15-cv-1175 (E.D. Tex.), filed Dec. 30, 2015; *Uniloc USA, Inc. v. Avaya, Inc.*, Case No. 6:15-cv-01168 (E.D. Tex.), filed Dec. 28, 2015; *Uniloc USA, Inc. v. ShoreTel, Inc.*, Case No. 6:15-cv-01169 (E.D. Tex.), filed Dec. 28, 2015; *Uniloc USA, Inc. v. GENBAND US LLC*, Case No. 6:15-cv-01169 (E.D. Tex.), filed April 30, 2015; *Uniloc USA, Inc. v. Microsoft Corp.*, Case No. 2:14-cv-01040 (E.D. Tex.), filed Nov. 13, 2014. Pet. 1.

Patent Owner describes the '948 patent as being asserted against the following parties in civil actions related to lead case *Uniloc USA, Inc. v. Avaya, Inc.*, Case No. 6:15-cv-01168, in the Eastern District of Texas: Cisco Systems, Inc., Huawei Device USA, Inc., NEC Corporation of America, Shoretel, Inc., Unify, Inc., Tangome, Inc. d/b/a Tango, Facebook, Inc., Viber Media S.a.r.l., WhatsApp Inc., and ooVoo, LLC. Paper 4 (Patent Owner's Mandatory Notice).

C. The '948 Patent

The '948 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, 1:13–17. Conference calls are initiated via an instant messaging (IM) system to reduce the effort required to initiate and manage

the call. *Id.* at 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 initiate[s] 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 '948 patent is reproduced below.

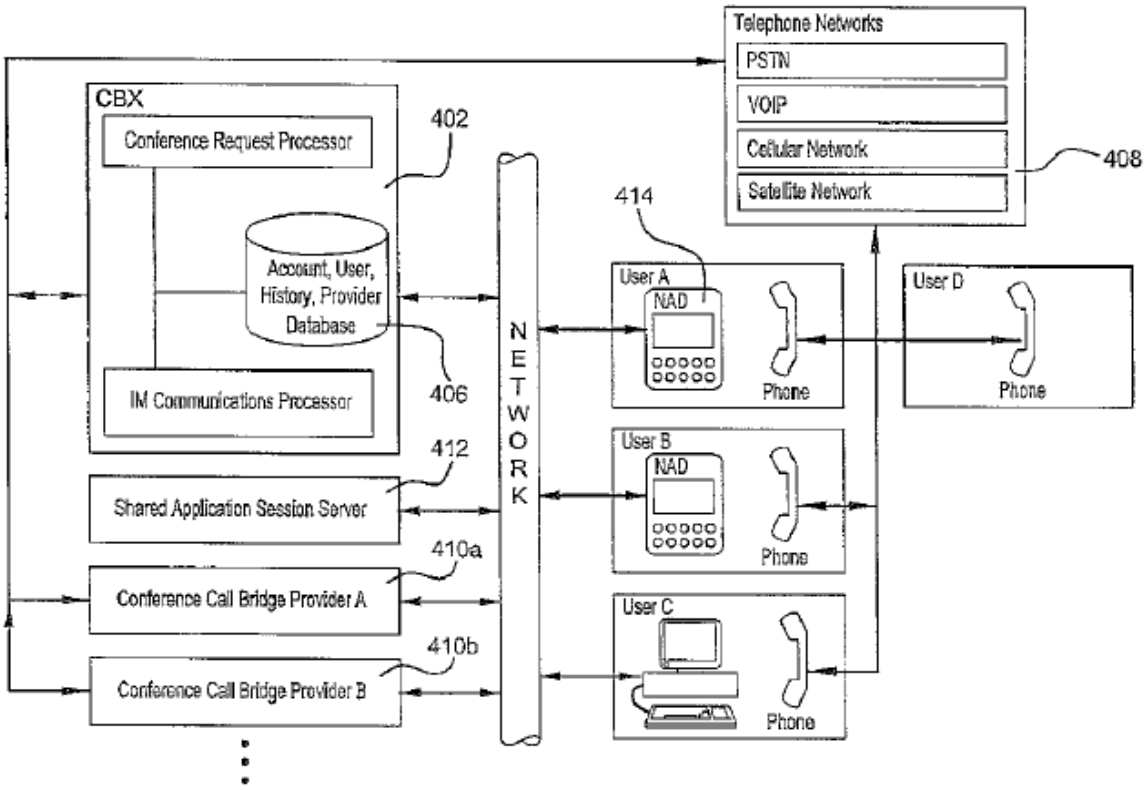


Figure 4 above shows a block diagram of a system for accomplishing the initiation of conference calls. Ex. 1001, 9:13–14. Conference call server 402 is connected to network 404. *Id.* at 9:14–15. Database 406, associated with conference call server 402, stores account information, user information, and call management information. *Id.* at 9:15–18. The conference call server can be connected directly to telephone network 408, or indirectly through third party conference bridge 410. *Id.* at 9:22–25.

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 9:26–30. 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 9:39–41.

During an IM session involving User A, User B, and User C, a conference call requester (User A) requests a conference call through User A's NAD. *Id.* at 7:27–34. The IM service in communication with User A's NAD is aware of the IM session, and determines the list of conference call targets from the list of parties presently in the IM session. *Id.* at 7:34–38. The conference call server sends a conference call invitation to User B and User C. *Id.* at 7:64–66. If User B and User C accept the conference call invitation, the conference call server prompts User B and User C, via the IM functionality, to verify their phone numbers for the conference call. *Id.* at 7:66–8:10. The conference call server then initiates a conference call bridge between the conference requester and the targets. *Id.* at 8:11–12.

D. Illustrative Claim

Claims 1, 23, and 51 of the challenged claims of the '948 patent are independent. Claim 1 is illustrative of the claimed subject matter:

> 1. A method for initiating a conference call, comprising the steps of:
>
> providing a conference call requester with a network access device, said network access device communicating via an instant messaging service, said instant messaging service being adapted to communicate conference call request information with a conference call server;

> establishing a communications connection from said network access device to the conference call server;
>
> presenting said conference call requester with a display showing a plurality of potential targets then being connected to said instant messaging service and participating in a given instant messaging session with the conference call requester and with whom a conference call may be initiated;
>
> generating a conference call request responsively to a single request by the conference call requester, said conference call request identifying each of the potential targets for said conference call request;
>
> transmitting said conference call request from said network access device to said conference call server; and
>
> automatically establishing a conference call connection to said conference call requester, said conference call connection initiated by said conference call server, said conference call connection further being connected to each of the potential targets.

Ex. 1001, 11:58–12:17.

II. ANALYSIS

A. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966). The level of ordinary skill in the art may be reflected by the prior art of record. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

Petitioner's expert, Dr. Henry Houh, testifies that a person of ordinary skill in the art has a bachelor's degree in Computer or Electrical Engineering, Computer Science, or equivalent training in computer-based

collaboration or telecommunications services, and approximately five years of experience working in computer-based collaboration or telecommunications services. Ex. 1003 ¶ 44. Dr. Houh also testifies that there are likely a range of educational backgrounds in the pertinent technology field. Ex. 1003 ¶ 42. Patent Owner's expert, Dr. Val DiEuliis, testifies that a person of ordinary skill in that art has a bachelor's degree in Electrical Engineering or Computer Science, or an equivalent degree or experience, and at least two years of experience in computer programming and software development, including development of software for communication with other computers over a network. Ex. 2001 ¶ 43.

Although there is some difference between the ranges of approximately five years of experience and at least two years of experience, there is also an overlap between approximately five years and at least two years. For example, someone with approximately five years of experience would also have at least two years of experience. Dr. DiEuliis, when asked whether a person ordinary skill in the art could have five years of experience in computer programming software development, answered "certainly, of course, yes." Ex. 1017, 68:14–21. Further, both experts appear to agree on the skills possessed by a person of ordinary skill. For example, Dr. Houh testifies that a person of ordinary skill does not "need to be taught how to write computer programs or functions." Ex. 2002, 129:20–130:4. Dr. DiEuliis testifies that a person of ordinary skill "would be able to program in JAVA." Ex. 1017, 65:25–66:10.

We discern no material dispute arising from the two experts' definitions. Both definitions are consistent with the level of ordinary skill

reflected in the prior art references of record. We adopt Dr. Houh's definition of the person of ordinary skill in the art.

B. 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).

Petitioner proposes constructions of the claim terms "network access device" (recited in all claims), "address" (recited in claim 18), "automatic number identifier" (recited in claim 19), and "VoIP address" (recited in claim 20). Pet. 6–9. Patent Owner does not present any claim constructions in its Patent Owner Response. PO Resp. 13 (arguing "the parties' present disputes make it unnecessary to construe the terms Petitioner proposes"). On the other hand, Patent Owner also states "[t]he Petition at least implicitly injects a dispute over the proper construction for 'generating a conference

call request responsively to a single request by the conference call requester', as recited in each challenged claim." *Id.* at 14.

We address Patent Owner's arguments regarding the "generating" clause below. Neither party has identified any other dispositive term for construction. We determine no terms need an explicit construction to resolve a controversy in the instant case. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (only those terms which are in controversy need to be construed and only to the extent necessary to resolve the controversy).

C. Asserted Obviousness Over Hamberg and Lamb: Claims 1, 2, 5, 6, 8, 12, 18, 19, 21–25, 29, 30, 49–51, 65, and 66

Petitioner, relying on the Declaration of Dr. Henry Houh (Ex. 1003), challenges claims 1, 2, 5, 6, 8, 12, 18, 19, 21–25, 29, 30, 49–51, 65, and 66 as obvious over the combination of Hamberg and Lamb. Pet. 11–60.

1. Hamberg (Ex. 1005)

Hamberg relates to setting up a conference call in digital communications systems. Ex. 1005, 1:3–4. Figure 1 of Hamberg is reproduced below.

FIG. 1

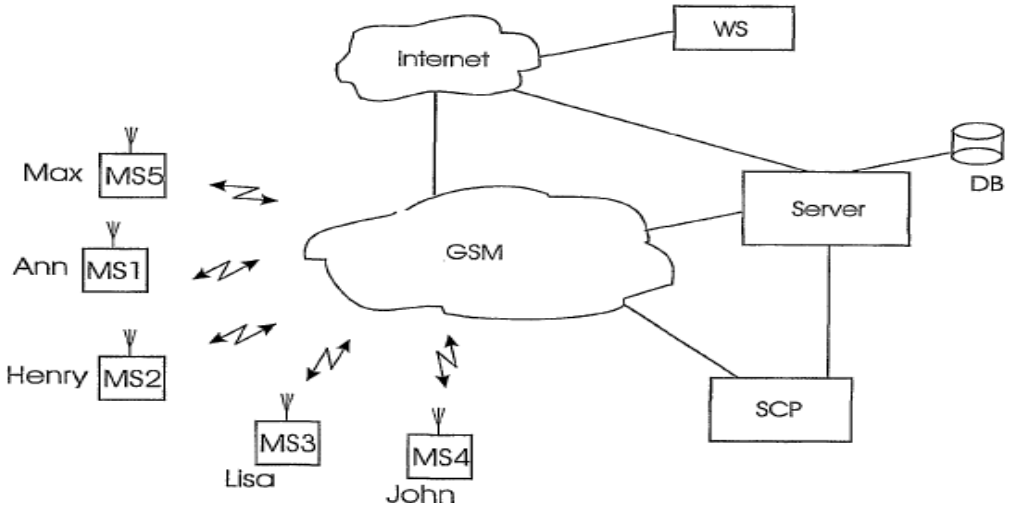


Figure 1 above shows a general communication system. *Id.* at 2:18. Five subscribers, Ann, Henry, Lisa, John, and Max have corresponding mobile stations MS1, MS2, MS3, MS4, and MS5, connected to a communications system, such as a Global System for Mobile Communications (GSM). *Id.* at 2:19–22. The mobile stations can be equipped with an instant message service. *Id.* at 2:25–30. The GSM system can be connected directly to the Internet and to a quick message server. *Id.* at 2:34–3:4. The quick message server can also be connected to an intelligent network service control point (SCP), in which case the quick message server can initiate a conference call in the GSM network. *Id.* at 3:4–8. A database DB represents a database residing in the quick message server. *Id.* at 3:16–17. Figure 2 of Hamberg is reproduced below.

FIG. 2

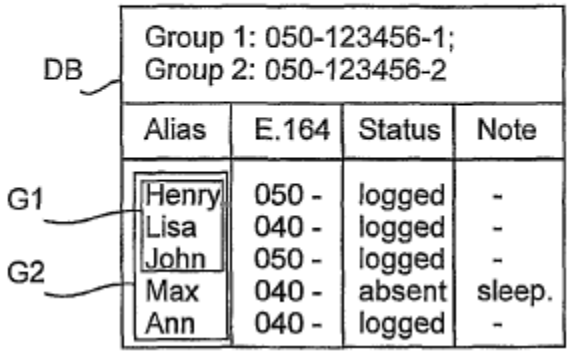
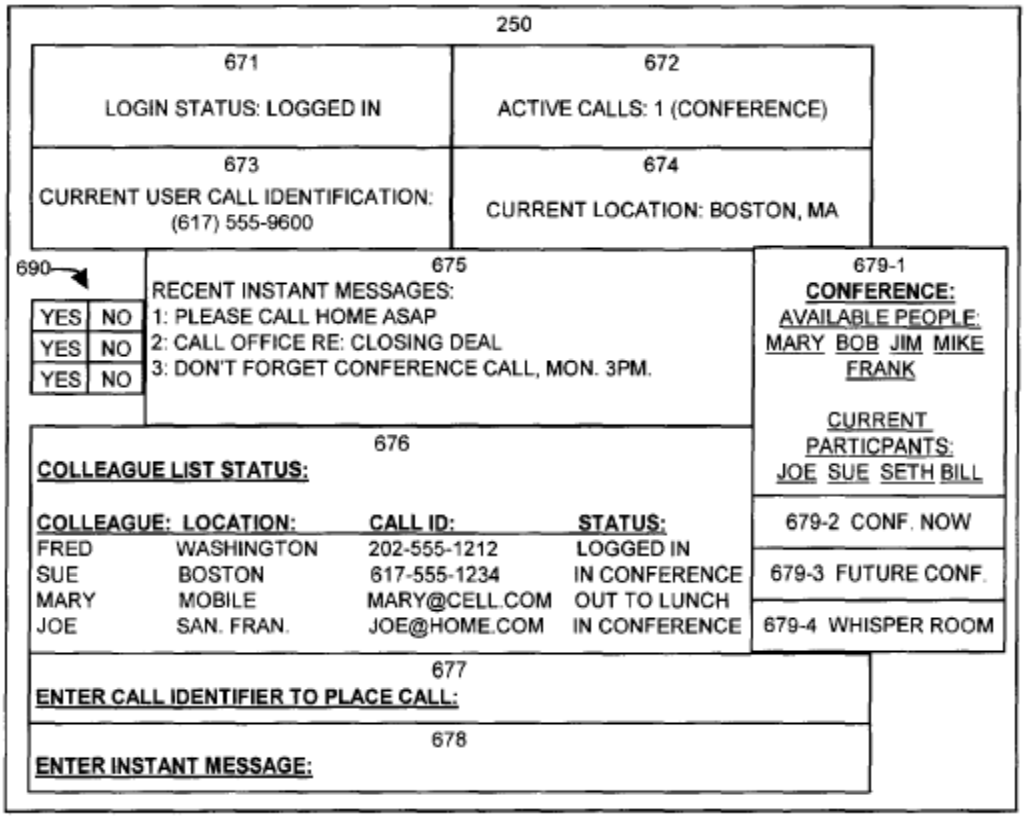


Figure 2 above shows an example of a more detailed structure of the database DB. *Id.* at 3:18–19. Henry, Lisa, and John have registered into chat group 1, and Henry, Lisa, John, Max, and Ann have registered into chat group 2. *Id.* at 3:19–21. Henry, Lisa, John, and Ann have sent an activating LOGIN message to the second group's telephone number shown in Figure 2, so they are in active chat status. *Id.* at 4:10–12. Max has set his status to absent, to indicate he does not want to participate in a conference call, but text messages can be sent to him. *Id.* at 4:12–15.

2. Lamb (Ex. 1006)

Lamb is related to providing advanced telecommunications services using a connectionless network host for service implementation, while using connection-based network equipment for transport of at least a portion of a telecommunications session. Ex. 1006, 1:10–16. A telecommunications system uses hosting agents that operate on behalf of users in a hosting server to control call connections. *Id.* at Abstract. A conference now feature of a user interface allows a user to create a conference call at the current moment. *Id.* at 60:37–41; Fig. 12. Figure 12 is reproduced below



USER CLIENT INTERFACE

Figure 12 above shows client interface 250 with colleague list status information field 676 that lists each colleague along with status and other information. Ex. 1006, 59:22–26. Conference selection area 679-1 through 679-4 allows the user to schedule, view, and control conference calls. Ex. 1006, 59:32–35. The "CONF. NOW" feature 679-2 of interface 250 allows the user to create a conference at the current moment. Ex. 1006, 60:37–39.

Figure 9 is reproduced below.

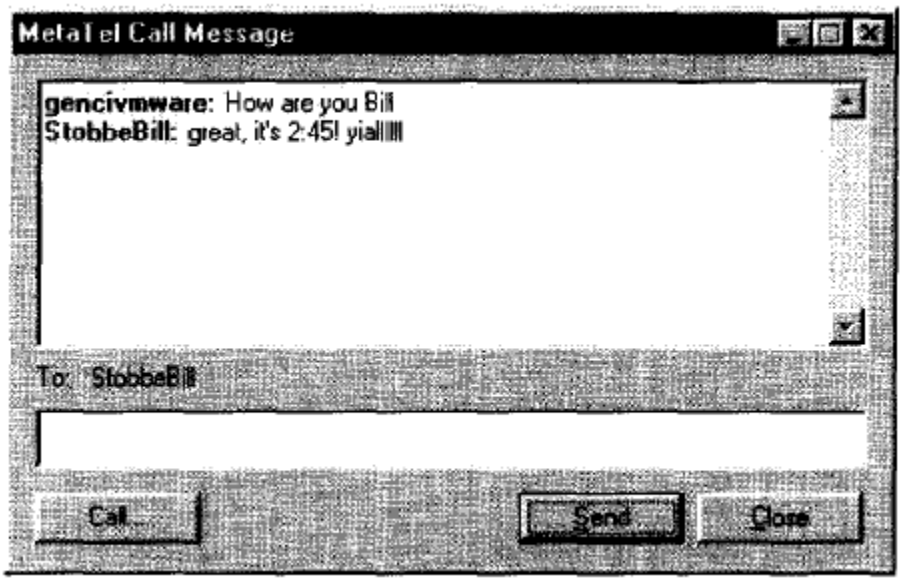


Figure 9

Figure 9 above shows a user interface with a "Send a Message" box that includes a message sent from one user to another user, and a "Call" button that may be used to initiate a phone call to the recipient of the message. Ex. 1006, cols. 83–86. The call button can be used to make a group conference call. Ex. 1006, cols. 109–110. For example, a MetaTel client user interface allows a user to see availability of colleagues, send messages, and place phone calls instantly. Ex. 1006, cols. 109–110, Fig. 25. Lamb discloses "[t]here is no simpler way to make a group call: you can immediately check on the availability of a group of colleagues, send them a quick message to check their willingness to talk, and press a Call button to set up an instant conference call!" *Id.*

3. Analysis of Claims 1, 2, 5, 6, 8, 12, 18, 19, 21–25, 29, 30, 49–51, 65, and 66

a. Independent Claims 1, 23, and 51

"providing a conference call requester . . ."

Petitioner contends "providing a conference call requester with a network access device," as recited in independent claim 1, is disclosed by Hamberg in describing subscribers provided with mobile stations connected to a GSM system. Pet. 20–21 (citing Ex. 1005, Fig. 1, 2:19–22, 4:29–32). We determine Hamberg's description of subscribers provided with mobile stations connected to a GSM system discloses "providing a conference call requester with a network access device" as claimed. Ex. 1005, Fig 1, 2:19–22, 4:29–32.

Petitioner contends "said network access device communicating via an instant messaging system," as recited in claim 1 is disclosed by Hamberg in describing mobile stations equipped with an instant message service. *Id.* at 21–22 (citing Ex. 1005, 2:25–33, 3:11–12). We determine Hamberg's description of mobile stations equipped with an instant message service discloses "said network access device communicating via an instant messaging system" as claimed. Ex. 1005, 2:25–33, 3:11–12.

Petitioner contends "said instant messaging service being adapted to communicate conference call request information with a conference call server," as recited in claim 1, is disclosed by Hamberg in describing a CALL ALIAS message sent to the server, where the ALIAS represents the names of the group members that the sender of the message wants to call. Pet. 22–24 (citing Ex. 1005, 4:27–32, 6:1–2, 6–7). We determine Hamberg's description of a CALL ALIAS message sent to the server, where the ALIAS represents the names of the group members that the sender of the message

wants to call, discloses "said instant messaging service being adapted to communicate conference call request information with a conference call server," as claimed. Ex. 1005, 4:27–32, 6:1–2, 6–7.

"establishing a communications connection . . ."

Petitioner contends "establishing a communications connection from said network access device to the conference call server," as recited in claim 1 is disclosed by Hamberg in describing a LOGIN message sent from the mobile station to the quick message server to indicate whether a subscriber's status is set to logged or absent during the group chat session. Pet. 24–25 (citing Ex. 1005, 4:10–13). We determine Hamberg's description of a LOGIN message sent from the mobile station to the quick message server discloses "establishing a communications connection from said network access device to the conference call server," as claimed. Ex. 1005, 4:10–13.

"presenting said conference call requester . . ."

Petitioner contends "presenting said conference call requester with a display showing a plurality of potential targets then being connected to said instant messaging service," as recited in claim 1 is taught by the combination of Hamberg and Lamb. Petitioner contends Hamberg describes a database including a user name, telephone number, status data such as logged or absent, and notable matters, for each group member. Pet. 25–26 (citing Ex. 1005, Fig. 2, 4:10–19, 5:19–22). According to Petitioner, the list of users who have registered with the group using the LOGIN message describes "a plurality of potential targets then being connected to said instant messaging service." *Id.* (emphasis omitted). Petitioner contends Lamb discloses "presenting said conference call requester with a display showing a plurality of targets then being connected to said instant messaging service," as recited

in claim 1, in describing displaying status information in a user agent interface using a web browser, email, PDA, or an interface as shown in Figure 12. *Id.* at 26–29 (citing Ex. 1006, Figs. 9 and 12, 59:3–7, 59:22–35, 60:25–26, 64:15–17).

We determine Hamberg's disclosure of a list of users who have registered with the group using the LOGIN message discloses "a plurality of potential targets then being connected to said instant messaging service." Ex. 1005, Fig. 2, 4:10–19, 5:19–22. We determine Lamb's disclosure of displaying status information in a user agent interface using a web browser, email, PDA, or an interface as shown in Figure 12 discloses "presenting said conference call requester with a display showing a plurality of targets then being connected to said instant messaging service." Ex. 1006, Fig. 12, 59:3–7, 59:22–35, 60:25–26, 64:15–17.

Petitioner relies on testimony from Dr. Houh and contends that incorporating Lamb's display of status information into Hamberg's mobile stations and workstations would have made it easier for Hamberg's users to communicate with each other. Pet. 29 (citing Ex. 1003, pp. 49–50). According to Petitioner, Hamberg's stations would benefit from a display of chat group members, such as members in G1 or G2, along with the members' status information, because a conference call requester would know which members are available for a conference call, and avoid attempting to initiate a call with members who are not available, for whom a conference call would be an unwanted disturbance, or those who are not connected to the instant messaging service. *Id.* (citing Ex. 1003, pp. 49–50).

Dr. Houh testifies that

> [a] POSITA would have been motivated to incorporate Lamb's display that includes status information into Hamberg's mobile stations and workstations to facilitate communication between Hamberg's group members. Hamberg's stations would benefit from a display that displays chat group members, such as members in group G1 or group G2, along with the members' status information. For example, by looking at a display displaying that information, a conference call requester would know which group members are available for a conference call. As such, when a conference call requester views the status information for group G2, a conference call requester would know that Max would not be available for a conference call, and that the conference call could be initiated with Henry, Lisa, John, and Ann. Thus, the conference call requester could avoid attempting to initiate a call with members who are not available, such as those who do not want to participate, those for whom a conference call would be an unwanted disturbance, or those who are registered into the chat group but are not connected to the instant messaging service.

Ex. 1003, pp. 49–50. We rely on this testimony and determine that incorporating Lamb's display of status information into Hamberg's mobile stations and workstations would have provided the benefit of allowing the conference call requester to know which members are available for a conference call, and avoid attempting to initiate a call with members who are not available, for whom a conference call would be an unwanted disturbance, or those who are not connected to the instant messaging service.

Petitioner contends "[presenting said conference call requester with a display showing a plurality of potential targets then being connected to said instant messaging service and] participating in a given instant messaging session with the conference call requester and with whom a conference call may be initiated," as recited in claim 1, is taught by the combination of Hamberg and Lamb. Pet. 29–33.

Petitioner contends Hamberg describes that when the members of the group G1 communicate with each other, only the members of the group are allowed to participate. *Id.* at 30 (citing Ex. 1005, 4:23–24). According to Petitioner, in Hamberg's group G1, Henry, Lisa, and John are the members participating in a given instant messaging session with the conference call requester, and with whom a conference call may be initiated. *Id.* (citing Ex. 1003, pp. 50–51). Also according to Petitioner, in group G2 of Hamberg, members Henry, Lisa, John, and Ann are participating in a given instant messaging session with the conference call requester, and with whom a conference call may be initiated. *Id.* Petitioner contends Hamberg describes that Max's status of absent in group G2 indicates text messages can be sent to him, but since he is not in active status, he does not want to take part in a conference call. *Id.* (citing Ex. 1005, 4:10–15).

We determine that Hamberg discloses that when members of group G1 communicate with each other, only members of group G1 are allowed to participate. Ex. 1005, Fig. 2, 4:23–24. We determine that Hamberg discloses that when members of group G2 communicate with each other, only the members of group G2 are entitled to participate. Ex. 1005, Fig. 2, 4:25–26. We determine that a member who sets his status to "absent" can receive text messages, but does not want to take part in a possible conference call set up from the chat, and is absent from the instant messaging session. Ex. 1005, 4:10–15. We determine that information on Max's absence, and its cause, may be transmitted to other group members. Ex. 1005, 4:15–19. We determine that Hamberg's description of the active members of group G1 (Henry, Lisa, and John), and the active members of group G2, Henry, Lisa, John, and Ann, each disclose members "participating

in a given instant messaging session with the conference call requester and with whom a conference call may be initiated."

Petitioner contends Lamb discloses a client user interface displaying messages from an instant messaging session between two users, and also displaying a call button to initiate a phone call. Pet. 31–32 (citing 1006, Fig. 9, 64:15–17). Petitioner contends that although the client interface of Figure 9 shows only two participants in the instant messaging session, Lamb also contemplates a user pressing the call button to set up an instant conference call with a group of colleagues. *Id.* at 32 (citing Ex. 1006, cols. 109 and 110, Fig. 25).

We determine Lamb discloses a client user interface displaying an instant messaging session between two users and also displaying a call button to initiate a phone call. Ex. 1006, Fig. 9, 64:15–17. We determine Lamb also discloses a user interface that allows a user to immediately check on the availability of a group of colleagues, send call messages, and place phone calls instantly by pressing a call button to set up an instant conference call. Ex. 1006, Fig. 25, cols. 109 and 110.

Petitioner relies on testimony of Dr. Houh to contend incorporating Lamb's display of potential targets into Hamberg's mobile stations and workstations allows a group member who initiates a conference call to see which group members are available for a conference call, and avoid attempting to initiate a call with group members who are not present in the instant messaging session or who have indicated they do not wish to participate in the conference call. Pet. 32–33 (citing Ex. 1003, p. 53).

Dr. Houh testifies that

> Hamberg's mobile stations and workstations would benefit from a display that displays chat group members of group G1 or G2 that are participating in the respective instant messaging sessions because the group member who initiates the conference call would be able to see which group members are available for a conference call by the group member's presence in the instant messaging session. For example, the conference call requester of group G2 would be able to see that Henry, Lisa, and Ann are available for a conference call, while Max is not available and may initiate a conference call where Max is not an essential party. Alternatively, when Max is an essential party to the conference call, the conference call requester may not initiate a conference call with other members of group G2 because Max is not available. Thus, the conference call requester could avoid attempting to initiate a call with group members who are not present in the instant messaging session and do not wish to participate in the conference call, or avoid making a conference call altogether when the group member notices that one or more group members who are essential to the conference call are not available for a conference call.

Ex. 1003, p. 53. We credit Dr. Houh's testimony and determine that incorporating Lamb's display of potential targets into Hamberg's mobile stations and workstations would allow a group member who wants to initiate a conference call to see which group members are available for a conference call, and avoid attempting to call those who are not available.

Patent Owner, relying on the Declaration of Dr. Val DiEuliis (Ex. 2001), contends that a person of ordinary skill would not display Lamb's presence information in the mobile stations of Hamberg. PO Resp. 46–48. According to Dr. DiEuliis, changing the text-based interface of Hamberg into a graphical user interface of Lamb would require time and effort, and would change Hamberg's principle of operation from text-based to graphical. Ex. 2001 ¶¶ 98–100.

However, during his deposition, Dr. DiEuliis testifies Hamberg discloses "mobile stations that have an internet browser," and further testifies mobile stations that have an internet browser usually have a graphical user interface, because "that is the norm for internet browsers." Ex. 1017, 233:9–23. Dr. DiEuliis also concedes the graphical interface in Lamb could have been implemented in JAVA. *See* Ex. 1017, 235:15–20. Dr. DiEuliis testifies that a person of ordinary skill in the art "would be able to program in JAVA." Ex. 1017, 66:8–14.

During his deposition, Dr. Houh testifies that the prior art "doesn't need to talk about how to do software programming." Ex. 2002, 129:16–18. According to Dr. Houh, a person of ordinary skill "has a degree in computer science and five years of experience. They don't need to be taught to write computer programs or functions . . . you don't have to include a programming manual . . . to say that it discloses writing a software program." Ex. 2002, 129:19–130:4.

We rely on the above-noted testimony of Dr. DiEuliis and Dr. Houh and determine that combining Hamberg's mobile station that has an internet browser with Lamb's graphical user interface would not change Hamberg's principle of operation, because, as Dr. DiEuliis testifies, "that is the norm for internet browsers," Ex. 1017, 233:9–23. We rely on the testimony of Dr. DiEuliis and Dr. Houh and determine that implementing the graphical user interface of Lamb in the mobile station of Hamberg using software programming such as JAVA would be within the level of ordinary skill.

In addition, as quoted above, Dr. Houh credibly explains that one of ordinary skill would have recognized that the combination of Hamberg and Lamb would provide several benefits, and, therefore, the ordinary artisan

would have had a reason to make the combination even if some additional time and effort would be required to do so. For example, a call requester would be able to determine when to make a call in a more efficient manner, by noting the availability and nonavailability of members. Ex. 1003, p. 53.

"generating a conference call request . . ."

Petitioner contends "generating a conference call request responsively to a single request by the conference call requester," as recited in claim 1 is taught by the combination of Hamberg and Lamb. Pet. 33–36.

Petitioner contends Hamberg describes a CALL ALIAS message used to initiate a conference call, and also describes that the group member who sends the CALL ALIAS message is a conference call requester. Pet. 33 (citing Ex. 1005, 3:4–8). According to Petitioner, the CALL ALIAS message describes a conference call request. *Id*. We determine Hamberg's description of a CALL ALIAS message used to initiate a conference call discloses "a conference call request." Ex. 1005, 3:4–8, 4:27–32. We determine that the sender of the CALL ALIAS message is a conference call requester. Ex. 1005, 4:27–32.

Petitioner contends Lamb's client interface includes a call button that, when pressed, triggers a setup of an instant conference call. Pet. 33 (citing Ex. 1006, 109–110). Petitioner also contends the conference now button of Lamb allows the user to create a conference at the current moment. *Id.* (citing Ex. 1006, Fig. 12, 60:37–39). According to Petitioner, pressing either the call button or the conference now button of Lamb describes a single request by the conference call requester. *Id.* We determine that Lamb's description of a call button that, when pressed, triggers setup of an instant conference call, discloses "a single request by the conference call

requester." Ex. 1006, Fig. 25, cols. 109–110. We determine that Lamb's disclosure of a conference now button that allows a user to create a conference at the current moment also discloses "a single request by the conference call requester." Ex. 1006, Fig. 12, 60:37–39.

Petitioner relies on testimony of Dr. Houh to contend incorporating the call button or the conference now button of Lamb into the user interface of Hamberg to generate a CALL ALIAS message provides the benefit of informing the user that the conference calling feature is available, relieves the user from needing to remember the correct command word for initiating a conference call, and reduces the effort required of a user to initiate a conference call. Pet. 33–34 (citing Ex. 1003, pp. 54–56). Petitioner also relies on Dr. Houh's testimony to contend that the mobile station would include only those members that were shown as active to the call requester in the CALL ALIAS message. Pet. 35–36 (citing Ex. 1003, pp. 54–56). Thus, according to Petitioner, the conference call participants would include only those group members that the call requester was expecting, that is, those group members shown as active to the call requester. *Id*.

We determine that Dr. Houh provides an articulated reason with a rational underpinning for a person of ordinary skill in the art to incorporate the call button or conference now button of Lamb into the user interface of Hamberg, namely, to inform the user of the conference call feature, to relieve the user of remembering the command for initiating a conference call, and to reduce effort for initiating a conference call. Ex. 1003, pp. 54–56. Specifically, Dr. Houh provides persuasive testimony that a person of ordinary skill in the art would have understood that combining the known call button taught by Lamb with the known user interface taught by

Hamberg would predictably yield the benefits of informing the user of the conference call feature, relieving the user of remembering the command, and reducing effort for initiating a conference call. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416 (2007) ("The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results").

We determine that Dr. Houh provides an articulated reason with a rational underpinning for a person of ordinary skill in the art to generate the CALL ALIAS message of Hamberg in response to a call requester pressing the call button or conference now button of Lamb. Specifically, Dr. Houh provides persuasive testimony that a person of ordinary skill in the art would have understood that the conference call requester would expect the conference call to include only the group members displayed by the user interface as active, and that generating a CALL ALIAS message listing only those group members displayed as active would predictably yield this result. *See* Ex. 1003, pp. 54–56.

Patent Owner contends the principle of operation changes

Patent Owner contends that Petitioner's proposed modification of pressing a call button to generate a CALL ALIAS message would change the principle operation of Hamberg's CALL ALIAS message. PO Resp. 20–21. In particular, Patent Owner contends that requiring the user's mobile station to define whom the user wishes to include or exclude in the conference call would require the system of Hamberg to read the user's mind to determine whom to include in the message. PO Resp. 22.

Dr. Houh testifies that, in using the call button or conference now button of Lamb to improve the user interface of Hamberg, a person of

ordinary skill would have recognized that the call button should generate a CALL ALIAS message that includes only those group members displayed as active on the conference call requester's device. Ex. 1003, pp. 55–56. According to Dr. Houh, including only those participants displayed as active to the requester provides the benefit that "the conference call participants will be only those group members that the conference call requester was expecting, [and] avoids the possibility of potentially unexpected conference call participants, which might lead the user to believe that the system had malfunctioned." Ex. 1003, p. 56.

Relying on Dr. Houh's testimony, we find using the call button of Lamb in the user interface of Hamberg to generate a CALL ALIAS message would not require the mobile device to read the conference call requester's mind. We rely on Dr. Houh's testimony and determine that the mobile device, when generating a CALL ALIAS message, would include only those group members that the conference call requester was expecting, that is, those group members displayed as active to the conference call requester.

According to Patent Owner, the combination of Hamberg and Lamb does not teach a mobile station automatically composing the CALL ALIAS message. PO Resp. 23. Patent Owner contends that Dr. Houh does not provide a legal or factual basis in speculating that Hamberg's mobile stations could be modified to automatically compose a CALL ALIAS message based on which user names are locally displayed as having an active status rather than an absent status. PO Resp. 22–23.

We find Hamberg discloses a server using status information stored locally at the server to determine which users are active, and setting up a call for all active members. Ex. 1005, Fig. 5, 6:7–23; *see* Ex. 1003, 55–56. We

also find Hamberg discloses transmitting status information to mobile stations. Ex. 1005, 4:15–19. We find Lamb discloses displaying a user interface on a client device, including status information of other users. Ex. 1006, Fig. 12 and 25, 59:22–36, 60:20–26, cols. 109–110. We also find that Lamb discloses implementing telecommunication functions using programming languages such as JAVA, C, and C++. Ex. 1006, 42:14–16.

Dr. Houh testifies that a person of ordinary skill could easily modify Hamberg's mobile station to retrieve status information from the server and display such status information on the mobile station using the teachings of Lamb. Ex. 1003, 32–33. Dr. Houh testifies that a person of ordinary skill in the art, in response to a user pressing a call button, would cause the mobile station to determine active members using locally stored status information, and include the names of the active members as ALIAS information in a CALL message. Ex. 1003, 55–56. According to Dr. Houh, a person of ordinary skill would be able to implement the call functions of Hamberg and Lamb by writing software programming to cause the mobile device to automatically generate the CALL ALIAS message with the appropriate names (i.e., the members displayed as active by the mobile device) in response to a user pressing a call button. Ex. 2002, 129:4–130:10.

Given the teachings of Hamberg and Lamb, and Dr. Houh's testimony, we determine that a person of ordinary skill would have been able to write software programming to implement the combined functions of Hamberg and Lamb, namely, in response to a user pressing a call button at a mobile station as taught by Lamb, determine users having active status using locally stored status information as taught by Hamberg, and include such names in a CALL ALIAS message as taught by Hamberg.

Patent Owner contends Hamberg teaches away

Patent Owner contends that using the call button of Lamb to generate the CALL ALIAS message of Hamberg teaches away from the user-customizable aspect of the CALL ALIAS message. PO Resp. 25. In particular, Patent Owner contends Hamberg teaches the purpose of the CALL ALIAS message is to enable a user to selectively define whom to include or exclude in a conference call. PO Resp. 21, 26.

Petitioner contends that the combination provides another way to create a CALL ALIAS message, but does not preclude a user from manually entering a CALL ALIAS message. Reply 16; Pet. 34. We agree with Petitioner and determine that using a call button to generate a CALL ALIAS message does not preclude a user from manually entering a CALL ALIAS message. *See* Ex. 1005, 4:27–32.

Patent Owner contends that the motivation to combine the call button of Lamb with the CALL ALIAS message of Hamberg relies on speculation. PO Resp. 26–28. In particular, Patent Owner contends that Dr. Houh is speculating in testifying that the status information displayed to a user on the mobile station may be inaccurate due to a delay in receiving updates from the server. *Id*. Patent Owner also contends that even if Dr. Houh is correct in testifying that the status information on the mobile station may be inaccurate, a person of ordinary skill would rely on accurate status information from the server, rather than inaccurate information from the mobile station, by using a CALL message to initiate a call. *Id*. According to Patent Owner, the CALL message of Hamberg would lead a person of ordinary skill in a direction divergent from automatically composing a CALL ALIAS message based on obsolete information. PO Resp. 28.

Petitioner contends that using the CALL message could cause the user to perceive the system as malfunctioning. Reply 16–17. In particular, Petitioner contends that the status information at the server may be different than the status information displayed to the user. *Id*. A user, expecting the conference call to include only those members displayed to the user as active, would be surprised that the server unexpectedly excluded a group member displayed to the user as active, or included a group member displayed as inactive, and would perceive the system as malfunctioning. *Id*. According to Petitioner, a person of ordinary skill would not choose a design option that causes the system to appear to malfunction. *Id*.

Dr. Houh testifies that "such unexpected behavior would be avoided when a mobile station uses the status information on its display to generate and send a CALL ALIAS message listing only the active members at the time the call is requested." Ex. 1003, 55–56. According to Dr. Houh, this avoids the possibility of a user believing the system had malfunctioned. *Id*. Dr. Houh's testimony provides a reason why a person of ordinary skill would want the system to use status information displayed to a user rather than status information stored at the server, namely so that a user does not perceive the system as malfunctioning. Ex. 1003, p. 55. We rely on this testimony and determine that a user who can design the mobile device to generate either the CALL message or the CALL ALIAS message in response to pressing a call button, would choose the CALL ALIAS message, to avoid the possibility of a user believing the system malfunctioned.

Patent Owner contends the Petition relies on hindsight

Patent Owner contends that the Petition points to two unrelated user requests in disparate references and relies exclusively on hindsight

speculation in attempting to address the interrelationship between the "single request by the conference call requester" and the responsively-generated "conference call request." PO Resp. 28–29. Patent Owner contends that this claim language cannot be rendered obvious by two disassociated features of disparate references that are both specifically generated by user input, nor by conclusory opinions of Dr. Houh concerning what would have been common knowledge. PO Resp. 30.

Dr. Houh testifies that the CALL message of Hamberg and the call button or conference now button of Lamb describe related techniques for minimizing user effort when initiating a conference call from an instant messaging session. Ex. 1003, 34. According to Dr. Houh, the call button of Lamb provides a simple mechanism for a group member to generate and send the CALL message of Hamberg. Ex. 1003, 34–35. Dr. Houh further testifies that the CALL message can include additional ALIAS information identifying the desired conference call participants. Ex. 1003, 41. Dr. Houh testifies that a person of ordinary skill, in response to a user pressing a call button at a mobile station as taught by Lamb, would determine the names of users having active status using locally stored status information as taught by Hamberg, and include such names in a CALL ALIAS message as taught by Hamberg. *See* Ex. 2002, 129:16–130:23; Ex. 1003, 54–56.

We rely on Dr. Houh's testimony and determine that the CALL message of Hamberg and the call button of Lamb are related techniques for achieving the benefit of minimizing user effort when initiating a conference call. We rely on Dr. Houh's testimony and determine that the call button of Lamb provides a simple mechanism to generate and send Hamberg's CALL message, including ALIAS information. We rely on Dr. Houh's testimony

and determine that the Petition provides an articulated reason for a mobile station, in response to a user pressing a call button, to determine the names of active participants using local status information, and to include the names as ALIAS information in the CALL message.

Patent Owner contends the prior art does not teach a single request

Patent Owner contends the call button or conference now button of Lamb, and the CALL ALIAS message of Hamberg, each require user input, which results in multiple requests by the conference call requester. PO Resp. 31. According to Patent Owner, Petitioner's contention that the CALL ALIAS message may be automatically composed by the mobile station without user input, is speculation. PO Resp. 31–32.

Dr. Houh testifies that pressing the call button or conference now button of Lamb teaches a single request by the conference call requester. Ex. 1003, 54. Dr. Houh further testifies that one of ordinary skill would cause the mobile station to respond to a click of a call button by determining members displayed as active, and including the active members as ALIAS information in a CALL message. Ex. 1003, 55. We rely on this testimony and determine that a user clicking a call button, and in response, a mobile station determining members displayed as active, and including the active members as ALIAS information in a CALL message, teaches "the single request by the conference call requester" as claimed.

Further, as discussed above, Dr. Houh testifies that a person of ordinary skill would be able to implement the call functions of Hamberg and Lamb by writing software programming to cause the mobile station, in response to a user pressing a call button, to automatically determine and include the names of active members in the CALL ALIAS message. *See* Ex.

2002, 129:4–130:10. Given the teachings of Hamberg and Lamb, and Dr. Houh's testimony, we determine that the Petition shows that a person of ordinary skill would have modified the combination of Hamberg and Lamb to cause the system, in response to a user pressing a call button at a mobile station as taught by Lamb, to determine users having active status using locally stored status information as taught by Hamberg, and include such names in a CALL ALIAS message as taught by Hamberg.

Patent Owner contends the CALL ALIAS message does not identify each of the potential targets

Patent Owner contends that, in group G2 of Hamberg, all members are participating in a chat session, even though Max's status is absent. PO Resp. 34. According to Patent Owner, identifying only the group members having a status of active in the CALL ALIAS message would not identify Max, who is still participating in the chat session. PO Resp. 34–35 (citing Ex. 1003, p. 51; Ex. 2002, 81:2–7).

Petitioner contends that claim 1 requires "each of the potential targets" to be, *inter alia*, "participating in a given instant messaging session." Reply 21 (citing Ex. 1001, 12:2–6). According to Petitioner, Max may be "connected to said instant messaging service" as claimed, but is not "participating in a given instant messaging session," because he is absent and not responding. Reply 21–22.

Hamberg discloses that "[i]n Figure 2 . . . Max has set his status to 'absent.' This status is defined so that text messages can be sent to him, but . . . he does not want to take part in a possible conference call . . . ." Ex. 1005, 4:10–15. Figure 2 also makes a note of "sleep" for Max, implying that Max is absent because he is sleeping. Ex. 1005, Fig. 2. Dr. Houh testifies

that Max is not a participant "with whom [a] conference call can be initiated" as claimed, because Max's status is set to absent, which indicates that "text messages can be sent to him, [but] since he is not in an active status, he does not want to take part in a possible conference call." Ex. 1003, p. 51 (citing Ex. 1005, 4:13–15). Patent Owner's declarant Dr. DiEuliis also testifies that Max is not participating in the instant messaging session. Ex. 1017, 167:24–168:4. We rely on this testimony and determine that Max, listed as "absent" and noted as "sleep," is not "participating in a given instant messaging session" as claimed. We determine that a CALL ALIAS message identifying all active group members identifies "each of the potential targets" as recited in claim 1.

Petitioner further contends that Hamberg contemplates an embodiment where all users of a group are active, and that in this embodiment, the CALL ALIAS message identifies "each of the potential targets." Reply 22. Figure 2 of Hamberg shows all members of group G1 registered with a status of "logged," or active. Ex. 1005, Fig. 2; 4:12, 4:21. "[A] prior art product that sometimes, but not always, embodies a claimed method nonetheless teaches that aspect of the invention." *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1326 (Fed. Cir. 2003). We determine that when all members of a group are active, a CALL ALIAS message identifying all active members identifies "each of the potential targets" as recited in claim 1.

Patent Owner contends that Lamb's call button does not render obvious "a single conference call request . . . identifying each of the potential targets"

Patent Owner contends that the call button of Lamb only enables a user to telephone individuals one at a time. PO Resp. 37. According to Patent Owner, the call button shown in Figure 9 of Lamb only discloses a text message thread between two people. PO Resp. 38–39 (citing Ex. 1006, Fig. 9). Patent Owner contends that Figure 25 of Lamb requires a user to check on availability of colleagues, send them a quick message to check on their willingness to talk, and press the call button to set up an instant conference call. PO Resp. 39–41 (citing Ex. 1006, Fig. 25, p. 67). According to Patent Owner, Lamb requires multiple requests, and the requester may select people who are not currently in a chat session. *Id*. at 41.

Petitioner contends that Patent Owner's argument confuses the two separate "requests" recited in the claims. Reply 23. Petitioner contends that the Petition relies on the CALL ALIAS message to teach the "conference call request" that identifies "each of the potential targets," and on Lamb to teach a call button, that, when pressed, is "a single request by the conference call requester" as claimed. Reply 23–26 (citing Pet. 36).

Claim 1 recites "generating a conference call request responsively to a single request by the conference call requester." Dr. Houh testifies that Lamb discloses a client interface with a call button. Ex. 1003, p. 52 (citing Ex. 1006, Fig. 9, 64:17–18, cols. 85–86). Dr. Houh testifies that Lamb contemplates instant messaging sessions with a group of colleagues, one of whom presses the call button to set up an instant conference call. Ex. 1003,

p. 53 (citing Ex. 1006, cols. 109–110). Dr. Houh testifies that pressing the call button of Lamb to set up an instant conference call discloses "a single request by the conference call requester" as claimed. Ex. 1003, p. 54 (citing Ex. 1006, cols. 109–110). Dr. Houh testifies that the CALL ALIAS message of Hamberg discloses "a conference call request" as claimed. Ex. 1003, p. 54 (citing Ex. 1005, 3:4–8).

We rely on this testimony and determine that pressing a call button to set up an instant conference call with a group of colleagues as disclosed by Lamb teaches "a single request by the conference call requester." We rely on this testimony and determine that the CALL ALIAS message of Hamberg teaches a "conference call request identifying each of the potential targets" as claimed. We determine that generating Hamberg's CALL ALIAS message responsively to a user clicking Lamb's call button teaches "generating a conference call request responsively to a single request by the conference call requester" as recited in claim 1.

Patent Owner contends Lamb's conference now feature requires more than a single request

Patent Owner contends that the conference now feature requires a user to select which participants to include in the conference call. PO Resp. 42. In particular, Patent Owner contends Lamb discloses a client interface with a conference now feature and selectable participants. PO Resp. 42–43 (citing Ex. 1006, Fig. 12, 60:18–36).

Petitioner contends Lamb's conference now button "allows the user of interface 250 to create a conference at the current moment." Reply 26 (citing Pet. 33; Ex. 1006, 60:39). Dr. Houh testifies that the conference now button of Lamb initiates a call with multiple users. Ex. 1003, p. 54 (citing

Ex. 1006, 60:37–43). We rely on this testimony and determine that Lamb's conference now button, which allows a user to create a conference at the current moment, teaches "a single request by the conference call requester." We determine that generating Hamberg's CALL ALIAS message responsively to a user clicking Lamb's conference now button teaches "generating a conference call request responsively to a single request by the conference call requester" as recited in claim 1. Ex. 1003, pp. 54–56.

"transmitting said conference call request . . ."

Petitioner contends "transmitting said conference call request from said network access device to said conference call server," as recited in claim 1, is disclosed by Hamberg in describing transmitting a CALL message, such as a CALL ALIAS message, from a mobile station to the quick message server. Pet. 37 (citing Ex. 1005, 6:1–2; Ex. 1003, pp. 57–58). Hamberg discloses that "a group member sends to the address of the server, for instance E.164, a short message CALL" in order to set up a conference call between persons registered to the quick message group. Ex. 1005, 5:34–6:2. Dr. Houh testifies that in Hamberg, the CALL message is transmitted from the mobile station to the quick message server, which is part of the conference call server. Ex. 1003, p. 57. Dr. Houh testifies that the CALL message sent to the server can be a CALL ALIAS message. *Id*. at p. 58.

We determine that Hamberg's disclosure of transmitting a CALL message including ALIAS information from a mobile station to the quick message server discloses "transmitting said conference call request from said network access device to said conference call server." Ex. 1005, Fig. 5, 4:27–32, 5:34–6:2; Ex. 1003, pp. 57–58.

"automatically establishing a conference call connection . . ."

Petitioner contends "automatically establishing a conference call connection to said conference call requestor," as recited in claim 1, is taught by the combination of Hamberg and Lamb. Pet. 37–40.

Petitioner contends Hamberg describes the server triggering, in the intelligent network service control point (SCP), a service to direct the GSM network to connect a speech connection for the called subscriber, then complete call set-up for all other active members of the group. Pet. 37–38 (citing Ex. 1005, 6:15–21). Dr. Houh testifies that Hamberg initiates a conference call by the quick message server and the SCP. Ex. 1003, pp. 58–60 (citing Ex. 1005, Fig. 5, 5:34–6:23). We rely on this testimony and determine that Hamberg discloses "automatically establishing a conference call connection to said conference call requestor" as claimed. Ex. 1003, pp. 58–60; Ex. 1005, Fig. 5, 5:34–6:23.

Petitioner contends Lamb describes a user agent pre-programmed via invite processing rules to automatically establish a call connection. Pet. 39 (citing Ex. 1006, Fig. 5A; 54:35–37). Petitioner relies on testimony from Dr. Houh to contend including Lamb's invite processing rules in Hamberg's quick message server would allow each user to control whether the server should automatically establish a call connection, or prompt the user first for an accept or denial of the call connection. Pet. 39 (citing Ex. 1003, pp. 60–61). Dr. Houh testifies that Lamb discloses use of invite processing rules to permit automatic establishment of a call connection. Ex. 1003, pp. 60–61 (citing Ex. 1006, Fig. 5A, 54:35–39, 50:52–51:10). We rely on this testimony and determine that Lamb's disclosure of using invite processing rules to permit automatically establishing a call connection describes

"automatically establishing a conference call connection to said conference call requestor."

Petitioner contends "said conference call connection initiated by said conference call server, said conference call connection further being connected to each of the potential targets," as recited in claim 1 is disclosed by Hamberg in describing the quick message server and SCP setting up individual calls between the quick message server and each active group member, then connecting the individual calls into a conference call. Pet. 40–41 (citing Ex. 1005, 6:19–23). Dr. Houh testifies that Hamberg discloses the quick message server and SCP setting up individual calls between the server and each active group member and connecting the individual calls into a conference call. Ex. 1003, pp. 61–62 (citing Ex. 1005, 6:24–33). We rely on this testimony and determine Hamberg's disclosure of setting up individual calls between the server and each active group member, and connecting the calls into a conference call describes "said conference call connection initiated by said conference call server, said conference call connection further being connected to each of the potential targets."

Patent Owner contends that Hamberg, even if modified as proposed by the Petition, does not teach "automatically establishing a conference call connection to . . . each of the potential targets" as claimed, because the CALL ALIAS message would exclude Max, who set his status to absent. PO Resp. 44–46. According to Patent Owner, the claim defines the "potential targets" as those who are "connected to said instant messaging service and participating in a given instant messaging session with the conference call requester and with whom a conference call may be initiate." PO Resp. 45. Patent Owner contends that Max is connected to the instant

messaging server and is participating in the chat session. PO Resp. 45. According to Patent Owner, the combination of Hamberg and Lamb does not teach "automatically establishing a conference call connection . . . to each of the potential targets" as claimed. PO Resp. 46.

Dr. Houh testifies that Max is not a participant "with whom [a] conference call can be initiated" as claimed, because Max's status is set to absent, which indicates that "text messages can be sent to him, [but] since he is not in an active status, he does not want to take part in a possible conference call." Ex. 1003, p. 51 (citing Ex. 1005, 4:13–15). Dr. Houh's testimony addresses why members of a group who have a status set to absent are not participants "with whom a conference call may be established," and therefore are not "potential targets" as claimed. Dr. Houh's testimony is supported by Figure 2 of Houh, which includes a note for Max of "sleep," which suggests that Max would not participate in either the chat session or a conference call, because Max is sleeping. Dr. Houh's testimony is also supported by Patent Owner's declarant Dr. DiEuliis, who, when answering the question is "Max participating in an instant messaging session," testifies that "No, I don't – I don't think he is, no." Ex. 1017, 167:24–168:4.

We rely on this testimony and determine that a user having a status of "absent" is not participating in an instant messaging session with the conference call requester. We rely on this testimony and determine that a user having a status of "absent," because he does not want to participate in a conference call, is not a person with whom a conference call may be established. Further, as discussed above, Hamberg discloses an embodiment where all users of a group have a status of "active." *See* Ex. 1005, Fig. 2. We determine that when all members of a group have a status set to "active,"

a CALL ALIAS message identifying all active members identifies "each of the potential targets" as recited in claim 1. We rely on this testimony and determine that Hamberg discloses "automatically establishing a conference call connection . . . to each of the potential targets" as claimed.

We credit Dr. Houh's testimony and determine Petitioner has articulated reasons to combine and modify the teachings of the references. We determine the Petition and supporting evidence show by a preponderance of the evidence that the combination of Hamberg and Lamb would have rendered claim 1 obvious. .

Claim 23 recites limitations similar to those that claim 1 recites. Similar to its showing with respect to claim 1, Petitioner contends that Hamberg discloses or teaches the limitations of claim 23 or that the combination of Hamberg and Lamb would have rendered claim 23 obvious. *See* Pet. 49–55.

As an example, claim 23 recites "receiving said generated call request at said conference call server." According to Petitioner, the CALL ALIAS message is transmitted to the quick message server, which (together with the SCP) is *said conference call server*. Pet. 52. Petitioner contends it would have been obvious to a POSITA that the quick message server and SCP receive the CALL ALIAS message that is transmitted. *Id.*

Claim 23 also recites "parsing said conference call request to determine parameters associated with a requested conference call." Petitioner contends Lamb describes a user interface that includes a call identifier entry field where a user specifies a name, URL, phone number, email address or other identifier for persons or entities with which to establish call connections. Pet. 53 (citing Ex. 1006, 59:27–28, 43–44).

Petitioner also contends Lamb's server includes an agent that can parse this information and determine a telephony device associated with this information. *Id.* (citing Ex. 1006, 59:47–48).

Petitioner relies on testimony of Dr. Houh and contends a person of ordinary skill in the art would have used Lamb's parsing technique to interpret Hamberg's ALIAS information for the benefit of providing great flexibility to the user, because a conference call participant can be identified using a variety of different kinds of information. Pet. 53–54 (citing Ex. 1003, pp. 76–77).

Claim 23 also recites "automatically initiating a conference call in accordance with parameters associated with the requested conference call between the conference call requester and each of the potential targets." Petitioner contends Hamberg discloses this limitation in describing initiating a conference call in accordance with ALIAS values. Pet. 54–55 (citing Ex. 1005, 4:30–32, 6:26–27).

We credit Dr. Houh's testimony and determine the Petition and supporting evidence show by a preponderance of the evidence that the combination of Hamberg and Lamb would have rendered claim 23 obvious.

Petitioner's showing with respect to claim 51 also relies on Dr. Houh's testimony and tracks its showing with respect to claims 1 and 23. *See* Pet. 57–59.

We credit Dr. Houh's testimony and determine the Petition and supporting evidence show by a preponderance of the evidence that the combination of Hamberg and Lamb would have rendered claim 51 obvious.

b. Dependent Claims 2, 5, 6, 8, 12, 18, 19, 21, 22, 24, 25, 29, 30, 49, 50, 65, and 66

Petitioner argues the combination of Hamberg and Lamb teaches the limitations of dependent claims 2, 5, 6, 8, 12, 18, 19, 21, 22, 24, 25, 29, 30, 49, 50, 65, and 66. Pet. 41–60.

Claim 2 recites "said instant messaging service comprises a software client active on said network access device." Claim 30 recites a similar limitation. Petitioner contends the combination of Hamberg and Lamb renders this limitation obvious. *Id.* at 41. Petitioner contends Hamberg discloses an instant messaging service. *Id.* (citing Ex. 1005, 2:29–33). Petitioner contends Lamb discloses a user agent interface can be programs written in software. *Id.* (citing Ex. 1006, 25:11–12). Petitioner contends Lamb describes the user client interface includes a Yahoo Instant Messaging Interface. *Id.* (citing Ex. 1006, 64:1–5). Petitioner relies on testimony of Dr. Houh to contend a person of ordinary skill in the art would have implemented Hamberg's instant messaging service in software as disclosed by Lamb for the benefit of making development of new advanced telecommunications services much easier. *Id.* at 41–42 (citing Ex. 1003, pp. 63–64).

We credit Dr. Houh's testimony and determine the Petition and supporting evidence show by a preponderance of the evidence that the combination of Hamberg and Lamb would have rendered claims 2 and 30 obvious.

Claim 5 recites "said conference call connection utilizes a publicly switched telephone network." Claim 25 recites a similar limitation. Petitioner contends the combination of Hamberg and Lamb renders this limitation obvious. Pet. 42–43. Petitioner contends Hamberg describes

connecting mobile stations to a GSM network using a service control point. Pet. 42 (citing Ex. 1005, 2:19–22, 3:4–8). Petitioner contends Lamb describes sending and receiving calls using public switched telephone network (PSTN) based devices as well as computer devices such as VoIP. Pet. 42 (citing Ex. 1006, 13:33–34). Petitioner relies on testimony of Dr. Houh to contend providing Hamberg's conference call system with the ability to call users via the publicly switched telephone network gives users the benefit of participating in a conference call using any standard telephone. Pet. 43 (citing Ex. 1003, pp. 64–65).

We credit Dr. Houh's testimony and determine the Petition and supporting evidence show by a preponderance of the evidence that the combination of Hamberg and Lamb would have rendered claims 5 and 25 obvious.

Claim 6 recites "said conference call connection utilizes a voice over internet protocol communications path." Claim 24 recites a similar limitation. Petitioner contends Hamberg discloses this limitation in describing that a subscriber using the workstation participates by means of an Internet protocol (IP) telephone in the operation of the group. Pet. 43 (citing Ex. 1005, 3:11–12).

Claim 8 recites "said conference call connection utilizes a cellular communications path." Claim 29 recites a similar limitation. Petitioner contends Hamberg discloses this limitation in describing mobile stations that communicate via a GSM system. Pet. 44 (citing Ex. 1005, 2:22).

Claim 12 recites "determining whether at least one potential target to a conference call is available for said conference call dependant [sic] upon the presence of an IM presence for said at least one potential target."

Petitioner contends the combination of Hamberg and Lamb renders this limitation obvious. Pet. 44.

Petitioner contends Hamberg discloses status information for a group member includes a status of absent, indicating that the group member is not in active status and does not want to take part in a conference call set up from the chat. Pet. 44 (citing Ex. 1005, 4:13–15). Petitioner contends Lamb discloses a user programming his or her agent to set aside a time in which he or she is not to be disturbed, so that any incoming calls for the user will be rejected. Pet. 44–45 (citing Ex. 1006, 33:30–32, 51:35–38). Petitioner relies on testimony of Dr. Houh to contend that a person of ordinary skill in the art would use the status information of absent disclosed by Hamberg to not include that person when initiating a conference call for the group for the benefit of not disturbing such users with unwanted telephone call. Pet. 45 (citing Ex. 1003, pp. 67–68).

We credit Dr. Houh's testimony and determine that the Petition and supporting evidence show by a preponderance of the evidence that the combination of Hamberg and Lamb would have rendered claim 12 obvious.

Claim 18 recites "said conference call request comprises addresses for a plurality of potential targets." Petitioner contends the combination of Hamberg and Lamb renders this limitation obvious. Pet. 45. Petitioner contends Hamberg discloses that the ALIAS represents the names of group members. Pet. 45–46 (citing Ex. 1005, 4:30). Petitioner contends Lamb discloses a call signaling message indicating the call destination identifier, such as a name, a phone number, or an email address. Pet. 46 (citing Ex. 1006, 13:53–54, 20:23–24, 59:27–31). Petitioner relies on testimony of Dr. Houh to contend the ALIAS of Hamberg can represent an address such as a

phone number instead of a name as taught by Lamb for the benefit of providing flexibility for a user to specify the telephone number of a desired conference call participant. Pet. 46–47 (citing Ex. 1003, pp. 69–71).

We credit Dr. Houh's testimony and determine that the Petition and supporting evidence show by a preponderance of the evidence that the combination of Hamberg and Lamb would have rendered claim 18 obvious.

Claim 19 recites "at least one address comprises an automatic number identifier." Petitioner contends Lamb discloses this limitation in describing identifying desired participants in a conference call by a phone number. Pet. 47 (citing Ex. 1006, 20:18–19).

Claim 21 recites "said network access device comprises a capability for communicating audio information via an Internet protocol connection." Claims 49 and 65 recite a similar limitation. Petitioner contends Hamberg discloses this limitation in describing a workstation that includes an IP telephone (Internet protocol, Voice over IP). Pet. 48 (citing Ex. 1005, 3:11–12).

Claim 22 recites "said network access device comprises a capability for communicating audio and visual information via an Internet protocol connection." Claims 50 and 66 recite a similar limitation. Petitioner contends the combination of Hamberg and Lamb renders this limitation obvious. Pet. 48. Petitioner contends Lamb describes providing video data that can be transmitted over an IP network. Pet. 48–49 (citing Ex. 1006, 1:34–35, 4:12–13, 53:44–46). Petitioner relies on testimony from Dr. Houh to contend that using the workstation and IP telephone of Hamberg to communicate the video and textual data of Lamb, results in the user being

able to see as well as hear other call participants, or to conduct a presentation during the conference call. Pet. 49 (citing Ex. 1003, pp. 72–73).

We credit Dr. Houh's testimony and determine Petitioner has articulated a reason to support its showing of obviousness. We determine the Petition and supporting evidence show by a preponderance of the evidence that the combination of Hamberg and Lamb would have rendered claims 22, 50, and 66 obvious.

In summary, we credit Dr. Houh's testimony and determine that Petitioner has articulated reasons to combine and modify the teachings of the references. We determine the Petition and supporting evidence show by a preponderance of the evidence that the combination of Hamberg and Lamb renders claims 2, 5, 6, 8, 12, 18, 19, 21, 22, 24, 25, 29, 30, 49, 50, 65, and 66 obvious.

D. Asserted Obviousness Over Hamberg, Lamb, and Ludwig: Claims 7, 9, 10, 26, 36, 37, 52, and 53

Petitioner argues the combination of Hamberg, Lamb, and Ludwig would have rendered obvious dependent claims 7, 9, 10, 26, 36, 37, 52, and 53. Pet. 60–68.

1. Ludwig (Ex. 1007)

Ludwig relates to computer-based systems for enhancing collaboration between individuals who are separated by distance or time. Ex. 1007, 1:12–14. A multimedia collaboration system facilitates distributed collaboration such as real-time audio and video teleconferencing and data conferencing. *Id.* at Abstract, 4:49–67. The system architecture permits audio and video capabilities to be superimposed onto existing

personal computers and workstations and their interconnecting LANs and WANs. *Id.* at Abstract.

2. Analysis of Dependent Claims 7, 9, 10, 26, 36, 37, 52, and 53

Claim 7 recites "wherein said conference call connection provides for video data transmission." Claim 26 recites a similar limitation. Petitioner contends the combination of Hamberg, Lamb, and Ludwig renders this limitation obvious. Pet. 62. Petitioner contends the combination of Hamberg and Lamb teaches a conference call connection initiated via a CALL message and a call or conference now button as discussed in Petitioner's analysis of claim 1. *Id.* Petitioner contends Ludwig teaches a user can click a call button to initiate a video conference call. *Id.* (citing Ex. 1007, 19:14–17; Fig. 2A). Petitioner relies on testimony of Dr. Houh to contend extending the systems of Hamberg and Lamb to include video conferencing as taught by Ludwig provides the benefit of improving the conferencing experience by allowing participants to communicate using visual cues such as eye contact and body language, which provides additional information over and above spoken words, thus reducing the chance for misunderstanding. *Id.* (citing Ex. 1003, pp. 86–87).

Claim 9 recites "said network access device further comprises an application sharing capability." Claims 36 and 52 recite a similar limitation. Petitioner contends the combination of Hamberg, Lamb, and Ludwig renders this limitation obvious. *Id.* at 63. Petitioner contends Ludwig describes application sharing software installed on a workstation. *Id.* at 63–64 (citing Ex. 1007, 9:21–24, 14:66–15:5, 36:37–47; Figs. 20, 36). Petitioner relies on testimony of Dr. Houh to contend combining the application sharing software of Ludwig with the mobile stations and workstations of Hamberg

provides the benefit of facilitating the exchange of information that is more easily viewed on-screen than explained verbally during a conference call. *Id.* at 65 (citing Ex. 1003, p. 91).

Claim 10 recites "said application sharing capability comprises an application sharing client installed on said network access device." Claim 53 recites a similar limitation. Petitioner contends Ludwig describes this limitation in disclosing application sharing software on a collaborative multimedia workstation that communicates with server software modules. Pet. 66 (citing Ex. 1007, 20:16–19). Petitioner also contends that using Ludwig's application sharing capabilities would have improved the effectiveness of Hamberg's and Lamb's combined collaboration system. Pet. 66.

We credit Dr. Houh's testimony and determine that Petitioner has articulated reasons to combine and modify the teachings of the references. We determine the Petition and supporting evidence show by a preponderance of the evidence that the combination of Hamberg, Lamb, and Ludwig would have rendered claims 7, 9, 10, 26, 36, 37, 52, and 53 obvious.

E. Asserted Obviousness Over Hamberg, Lamb, and Vassilovski: Claim 20

Petitioner argues the combination of Hamberg and Lamb would have rendered obvious dependent claim 20. Pet. 68–71.

1. Vassilovski

Vassilovski relates to providing quality of service assurance over non-wireless portions of a wireless VoIP system, and to locating and connecting to destination devices outside of a serving cell site. Ex. 1008 ¶ 1. For intrasystem calls, a Session Initiation Protocol (SIP) server routes VoIP packets directly between the originating and destination devices. *Id.* at

Abstract. For intersystem calls, the SIP server instantiates a circuit-switched call to the requested destination using a local modem bank connected to the PSTN. *Id.*

2. Analysis of Dependent Claim 20

Claim 20 recites "at least one address comprises a VoIP address." Petitioner contends the combination of Hamberg, Lamb, and Vassilovski renders this claim obvious. Pet. 70. Petitioner contends Vassilovski describes using the SIP address to issue a VoIP call request to the destination device. Pet. 71 (citing Ex. 1008 ¶ 10). Petitioner relies on testimony from Dr. Houh to contend incorporating the SIP address of Vassilovski into Hamberg's CALL message provides the benefit of easily combining conversational multimedia services with other categories of service, and offering seamless service capabilities between fixed and mobile networks. Pet. 70 (citing Ex. 1003 ¶ 88).

We credit Dr. Houh's testimony and determine Petitioner has articulated a reason to support its obviousness challenge. We determine the Petition and supporting evidence show by a preponderance of the evidence that the combination of Hamberg, Lamb, and Vassilovski would have rendered claim 20 obvious.

III. CONCLUSION

For the foregoing reasons, we determine after considering the record evidence and arguments that Petitioner shows by a preponderance of evidence that claims 1, 2, 5–10, 12, 18–26, 29, 30, 36, 37, 49–53, 65, and 66 of the '948 patent are unpatentable.

IV. ORDER

Accordingly, it is ORDERED that

1. Claims 1, 2, 5, 6, 8, 12, 18, 19, 21–25, 29, 30, 49–51, 65, and 66 of the '948 patent are unpatentable under 35 U.S.C. § 103 over Hamberg and Lamb;

2. Claims 7, 9, 10, 26, 36, 37, 52, and 53 of the '948 patent are unpatentable under 35 U.S.C. § 103 over Hamberg, Lamb, and Ludwig; and

3. Claim 20 of the '948 patent is unpatentable under 35 U.S.C. § 103 over Hamberg, Lamb, and Vassilovski.

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.

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