UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CISCO SYSTEMS, INC.,
Petitioner,

v.

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

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Case IPR2017-00058
Patent 7,804,948 B2

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

SMITH, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

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 U.S. Patent No. 7,804,948 B2 (Ex. 1001, "the '948 patent"). Paper 2 ("Pet."). Patent Owner filed a Preliminary Response. Paper 5 ("Prelim. Resp."). Institution of an *inter partes* review may not be authorized by statute "unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108.

Upon consideration of the Petition and the Preliminary Response, we are persuaded Petitioner has demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of claims 1, 2, 5–10, 12, 18–26, 29, 30, 36, 37, 49–53, 65, and 66 of the '948 patent. Accordingly, we institute an *inter partes* review.

A. Related Matters

One or both parties identify, as matters involving or related to the '948 patent, the following:

Uniloc USA, Inc. v. Google, Inc., Case No. 2:16-cv-00566 (E.D. Tex.), filed March 28, 2016. Pet. 1.

Uniloc USA, Inc. v. Huawei Enterprise USA, Inc., Case No. 6:16-cv-00099 (E.D. Tex.), filed March 4, 2016. Pet. 1.

Uniloc USA, Inc. v. Cisco Systems, Inc., Case No. 6:15-cv-1175 (E.D. Tex.), filed Dec. 30, 2015. Pet. 1.

Uniloc USA, Inc. v. Avaya, Inc., Case No. 6:15-cv-01168 (E.D. Tex.), filed Dec. 28, 2015. Pet. 1.

Uniloc USA, Inc. v. ShoreTel, Inc., Case No. 6:15-cv-01169 (E.D. Tex.), filed Dec. 28, 2015. Pet. 1.

Uniloc USA, Inc. v. GENBAND US LLC, Case No. 6:15-cv-01169 (E.D. Tex.), filed April 30, 2015. Pet. 1.

Uniloc USA, Inc. v. Microsoft Corp., Case No. 2:14-cv-01040 (E.D. Tex.), filed Nov. 13, 2014. Pet. 1.

The '948 patent was also asserted against 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., and WhatsApp Inc., ooVoo, LLC, in civil actions related to lead case *Uniloc USA, Inc. et al. v. Avaya, Inc.*, Case No. 6:15-cv-01168, in the Eastern District of Texas. Patent Owner's Mandatory Notice, Paper 4.

B. 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 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 '948 patent is reproduced below.
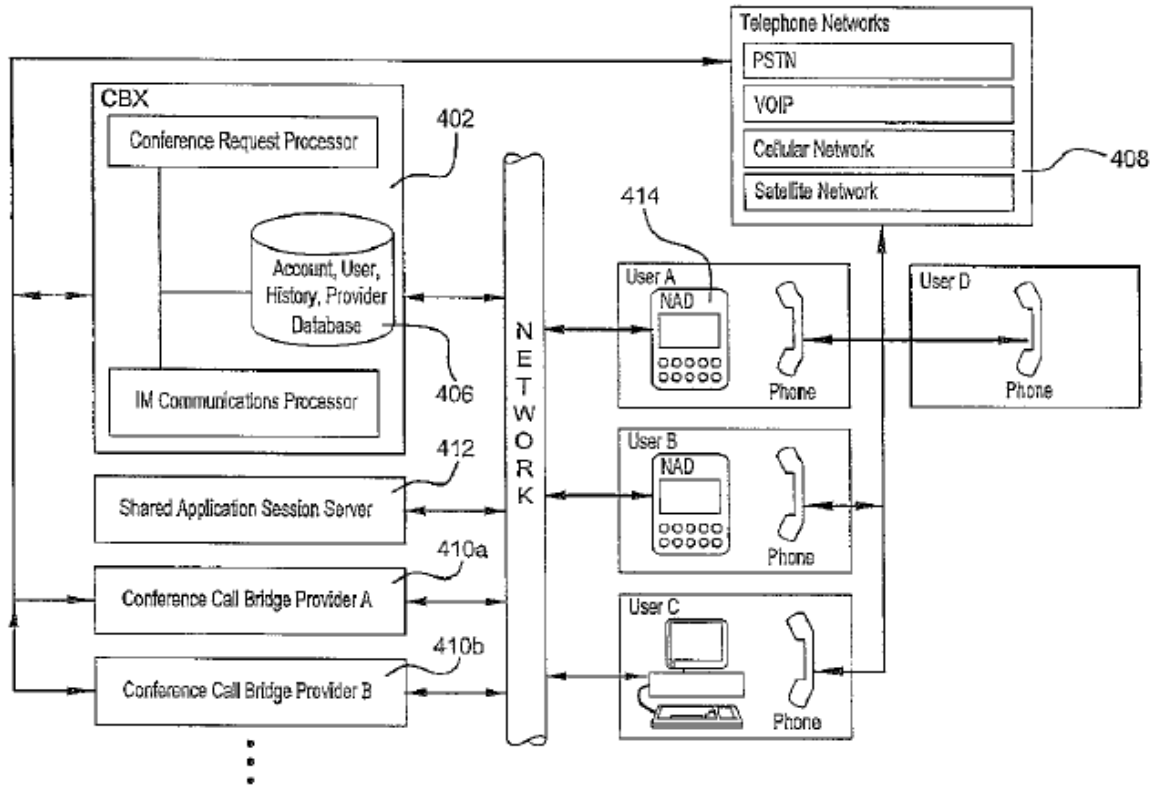

Figure 4 above shows a block diagram of a system for accomplishing the initiation of conference calls. Ex. 1001, 9:13–14. Conference call server 402 is connected to network 404. *Id.* at 9:14–15. Database 406, associated with conference call server 402, stores account information, user information, and 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

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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.

C. 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

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