

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 Owners.

Case IPR2017-00058
Patent 7,805,948

PATENT OWNER PRELIMINARY RESPONSE
PURSUANT TO 37 C.F.R. § 42.107(a)

Table of Contents

I. INTRODUCTION.....3

II. BACKGROUND OF THE '948 PATENT.....4

A. Overview of System and Method for Initiating a Conference Call4

B. The '948 Patent Claims.....6

C. Prosecution History of the '948 Patent.....7

D. Petitioner Oversimplifies the Patented Technology7

III. INSTITUTION SHOULD BE DENIED BECAUSE PETITIONER FAILS TO ESTABLISH A REASONABLE LIKELIHOOD THAT AT LEAST ONE OF THE CHALLENGED CLAIMS IS UNPATENTABLE7

A. Claim Construction8

1. “instant messaging” (all challenged claims)10

2. “VOIP address” (Claim 20).....11

B. Brief Summary of Cited References12

1. Overview of Hamberg (Ex. 1005).....12

2. Overview of Lamb (Ex. 1006)13

C. Teachings Away from Missing Limitations Prevent a Finding of Obviousness15

1. Overview of Applicable Law15

2. The proposed combination fails to disclose and teaches away from “generating a conference call request responsively to a single request by the conference call requester”17

3. The proposed combination fails to disclose and teaches away from “said conference call request identifying each of the potential targets for said conference call request”22

4. The proposed combination fails to disclose and teaches away from “said conference call connection further being connected to each of the potential targets”24

5. The Challenged Dependent Claims are not rendered Obvious25

IV. CONCLUSION.....26

I. INTRODUCTION

Pursuant to 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a), Uniloc Luxembourg S.A. (“Patent Owner”) submits this Preliminary Response to the Petition for *Inter Partes* Review (“the Petition”) of U.S. Patent 7,804,948 (“the '948 Patent”) filed by Cisco Systems, Inc. (“Petitioner”).

Petitioner has failed to prove that there is a reasonable likelihood that at least one of the claims challenged in the Petition is unpatentable. *See* 37 C.F.R. § 42.108(c). For several different reasons, Petitioner fails to meet this standard for any of the challenged claims. As non-exhaustive examples, Petitioner: (1) relies on a primary reference that expressly teaches away from the very limitations for which it is cited; (2) relies on a combination that changes the principle operation of the primary reference; and (3) fails to “specify where each element of the claim is found in the prior art patents or printed publications relied upon.” 37 C.F.R. § 42.104(b)(4). In view of the reasons presented herein, the Board should reject the Petition in its entirety.¹

¹ Should the Board institute proceedings in this matter, Patent Owner does not concede the legitimacy of any arguments in the Petition that are not specifically addressed herein. Patent Owner expressly reserves the right to rebut any such arguments in its Patent Owner Response.

II. BACKGROUND OF THE '948 PATENT

A. Overview of System and Method for Initiating a Conference Call

In general, the '948 Patent discloses and claims various embodiments for “initiating conference calls via an instant messaging system to reduce the effort required to initiate and manage the call.” Ex. 1001 at Abstract.

As explained in the Background section of the '948 Patent, certain disclosed embodiments address “the problem of integrating telephony products into software.” Ex. 1001 at 2:33-34. Certain technologies, such as private branch exchange or “PBX,” were encumbered by multiple deficiencies. *Id.* at 2:33-47. For example, passing the correct telephony commands to the PBX was problematic because “no two PBX’s are alike.” *Id.* Further PBX technology often required “system integrators” and had reduced scalability opportunity. *Id.*

Particular systems inefficiently required all users who wanted to join a conference call to dial in to a central number and enter a passcode, which inhibited setting up spontaneous conference calls and is subject to serious security risks. *Id.* at 2:40-58. Other systems enabling host-initiated calls were also inefficient, for example, in that they typically required someone (such as the host) to separately join each participant to the call, such as by taking the time to dial or otherwise separately

identify each conference participants. *Id.* 2:49-3:20. The above nonlimiting examples are among the various technological problems that certain embodiments of the '948 Patent overcome.

As disclosed in the specification of the '948 Patent, particular embodiments make novel use of instant messaging technology to trigger initiation of a host-initiated conference call. In the embodiment described with reference to Figure 1, for example, when a “conference call requester” desires to initiate a conference call, a network access device or “NAD” may efficiently respond to a single request by a “conference call requester” by generating and sending a “conference request message” that automatically identifies each of a plurality of potential targets. *See, e.g., id.* at 7:27-41; 9:48-67. The “conference request message” may identify multiple parties who are potential participants or “targets” to a conference call. *Id.*

In certain instances, the identification of the parties and the initiation of the conference call may be automatic and at least partially based, for example, on a determination of the availability of the conference call targets, even if those targets are not registered with a conference call server. *See, e.g., Id.* at Figure 2 and accompanying description; 7:34-38 (“The [Instant Messaging or] IM service in communication with User A’s NAD could be implemented to be aware of the ongoing

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.