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.
_____

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.
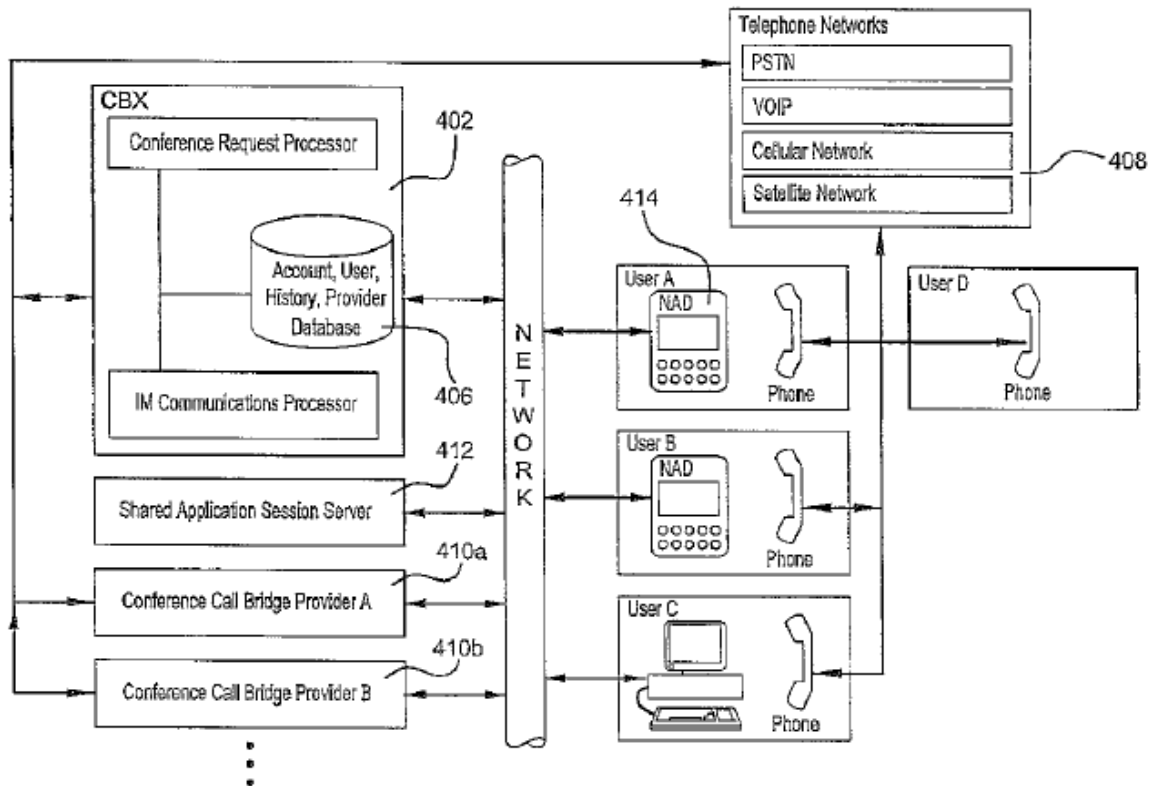


Figure 4 above shows a block diagram of a system for accomplishing the initiation of conference calls. Ex. 1001, 9:13–14. Conference call server 402 is connected to network 404. *Id.* at 9:14–15. Database 406, associated with conference call server 402, stores account information, user information, and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

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