Trials@uspto.gov
571-272-7822

Paper No. 30
Entered: June 26, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIVEPERSON, INC.,
Petitioner,

v.

24/7 CUSTOMER, INC.,
Patent Owner.

Case IPR2017-00609
Patent 6,970,553 B1

Before CHRISTOPHER L. CRUMBLEY, ROBERT J. WEINSCHENK, and JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

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

LivePerson, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–3 and 33–35 of U.S. Patent No. 6,970,553 B1 (Ex. 1001, "the '553 patent"). Patent Owner 24/7 Customer, Inc. ("Patent Owner") filed a Preliminary Response. Paper 9 ("PO Prelim. Resp."). We instituted review of only claims 1 and 33. Paper 12 ("Institution Decision" or "Inst."). Our scheduling order cautioned Patent Owner that "any arguments for patentability not raised in the response will be deemed waived." Paper 13, 6. Patent Owner did not file a Response to the Petition; we therefore advised the parties to inform the Board "if there is any reason the Board should not proceed to issue final written decisions without additional briefing or an oral argument." Paper 22, 2.

On May 3, 2018, we expanded the scope of this proceeding to include review of all challenged claims and all grounds presented in the Petition. Paper 25; *see* United States Patent and Trademark Office, *Guidance on the impact of SAS on AIA trial proceedings*, PATENT TRIAL AND APPEAL BOARD TRIALS (April 26, 2018), https://go.usa.gov/xQ93y. Although presented with the opportunity to do so, the parties did not request further briefing or a hearing on the challenges added to this proceeding. Paper 26.

I. BACKGROUND

A. RELATED PROCEEDINGS

The parties assert the '553 patent and patents related to it are involved in *24/7 Customer, Inc. v. LivePerson, Inc.*, 3:15-CV-05585-JST (N.D. Cal.) and *24/7 Customer, Inc. v. LivePerson, Inc.*, 3:15-CV-02897-JST (N.D. Cal.). *See* Pet. 2; Paper 8, 2. The following petitions for *inter partes* review are related to this case:

Case No.	Involved Patent
IPR2017-00610	U.S. Patent No. 9,077,084
IPR2017-00612	U.S. Patent No. 7,751,552
IPR2017-00613	U.S. Patent No. 7,027,586
IPR2017-00614	U.S. Patent No. 6,975,719
IPR2017-00615	U.S. Patent No. 7,245,715
IPR2017-00616	U.S. Patent No. 6,798,876

B. THE '553 PATENT

The '553 patent is directed to a phone system with an integrated chat client service. Ex. 1001, Abstract. The Specification describes a need for a "mechanism by which a called party can keep his/her side of the conversation private from others who may be present in the room." *Id.* at 1:63–65. When a calling party places a call, the call processing system queries the network to determine whether the called party has an accessible chat client on their computer. *Id.* at 3:63–4:8. If they do, the system prompts the calling party, notifying them that the called party has an accessible chat client, and confirming that the calling party would like to send a chat invitation to the called party. *Id.* at 4:18–22. If the called party chooses to accept the invitation to chat, a chat session between the two parties may be arranged. *Id.* at 4:26–36.

C. CHALLENGED CLAIMS

Petitioner challenges claims 1–3 and 33–35. Independent claim 1 is reproduced below.

> 1. A method for converting a voice call attempt to an alternate medium for a real-time communication session, comprising:

receiving a telephone call request;

checking for accessibility of a called party chat client associated with a called party; and

prompting a calling party to choose whether or not to electronically chat with the called party in an electronic chat session when the called party chat client is accessible, wherein the electronic chat session is enabled between a calling party chat client and the called party chat client that are logged into respective electronic chat servers.

Ex. 1001, 11:36–48.

Claim 2 depends from claim 1 and adds "sending an invitation to the called party, inviting initiation of a chat session with the calling party when the calling party chooses to chat." *Id.* at 11:49–52.

Claim 3 depends from claim 2 and adds "connecting a voice call when the calling party chooses not to chat." *Id.* at 11:53–55.

Claims 33–35 parallel claims 1–3, except that they recite a computer-readable medium that has a program that performs the claimed method steps recited in claims 1–3. *See id.* at 14:1–22.

D. Reviewed Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability. Pet. 4.

Reference(s)	Basis	Claims
Truetken[1]	§ 102(e)[2]	1–3 and 33–35

[1] U.S. Patent No. 6,493,324 B1, Dec. 10, 2002 (Ex. 1002, "Truetken").

[2] Although Petitioner characterizes this ground as one based on obviousness, in substance, Petitioner asserts Truetken anticipates the challenged claims. *See* Pet. 16 (asserting that Truetken "discloses, and at a minimum renders obvious, the alleged invention claimed by each of the Challenged Claims"); *id.* at 17–28 (not identifying any potential differences between claimed subject matter and Truetken). We therefore treat Petitioner's challenge as one based on anticipation, not obviousness.

Reference(s)	Basis	Claims
Truetken and Hansen[3]	§ 103(a)	1–3 and 33–35

E. LEGAL PRINCIPLES

1. *Burden of proof*

In an *inter partes* review, the petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to the patent owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must support its challenge by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). Accordingly, all of our findings and conclusions are based on a preponderance of the evidence.

2. *Anticipation*

A patent claim is unpatentable under 35 U.S.C. § 102 if "the four corners of a single, prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation." *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). "A single prior art reference may anticipate without disclosing a feature of the claimed invention if such feature is necessarily present, or inherent, in that reference." *Allergan, Inc. v. Apotex Inc.*, 754 F.3d 952, 958 (Fed. Cir. 2014) (citing *Schering Corp. v. Geneva Pharm.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003)). We analyze the ground based on anticipation in accordance with the above-stated principles.

[3] U.S. Patent No. 5,940,475, Aug. 17, 1999 (Ex. 1003, "Hansen").

DOCKET ALARM

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.