UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

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Case IPR2017-01685
Patent 7,804,948 B2

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Before KEN B. BARRETT, JEFFREY S. SMITH, and MINN CHUNG,
Administrative Patent Judges.

SMITH, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner[1] filed a Petition for *inter partes* review of claims 1–4, 6–8, 18, 21, and 22 of U.S. Patent No. 7,804,948 B2 (Ex. 1001, "the '948 patent"). Paper 1 ("Pet."). Patent Owner[2] filed a Preliminary Response. Paper 8 ("Prelim. Resp."). On January 16, 2018, we instituted an *inter partes* review of all the challenged claims. Paper 10. Patent Owner filed a Response to the Petition, Paper 13 ("PO Resp."), and Petitioner filed a Reply, Paper 15 ("Pet. Reply"). An oral hearing was held on October 16, 2018, and a transcript of the hearing is included in the record. Paper 23 ("Tr.").

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). For the reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–4, 6–8, 18, 21, and 22 of the '948 patent are unpatentable.

A. Related Matters

The '948 patent is also the subject of IPR2017-00058.[3]

The parties identify several U.S. District Court cases and Patent Trial and Appeal Board cases as matters involving or related to the '948 patent, including *Uniloc USA, Inc. v. Google, Inc.*, Case No. 2:16-cv-00566 (E.D.

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[1] Petitioner indicates "Google Inc. converted from a corporation to a limited liability company and changed its name to Google LLC on September 30, 2017." Paper 7, 2.

[2] Patent Owner's Mandatory Notice filed on July 20, 2017, identified Uniloc Luxembourg S.A. as the Patent Owner. Paper 5. More recently, Patent Owner filed an Updated Mandatory Notice identifying Uniloc 2017 LLC as the Patent Owner. Paper 17.

[3] Cisco Systems, Inc. (Petitioner) v. Uniloc 2017 LLC (Patent Owner). In a Final Written Decision, all challenged claims were held unpatenable.

Tex.). Pet. 2, 63–65; Paper 5.

Additionally, Patent Owner identifies as related matters IPR2017-01683 (Patent 8,571,194 B2) and IPR2017-01684 (Patent 7,853,000 B2), which involve the same parties as the present proceeding. PO Resp. 1–2. Oral arguments in those two *inter partes* review were heard along with those in the present proceeding. *See* Tr. 3:3–4.

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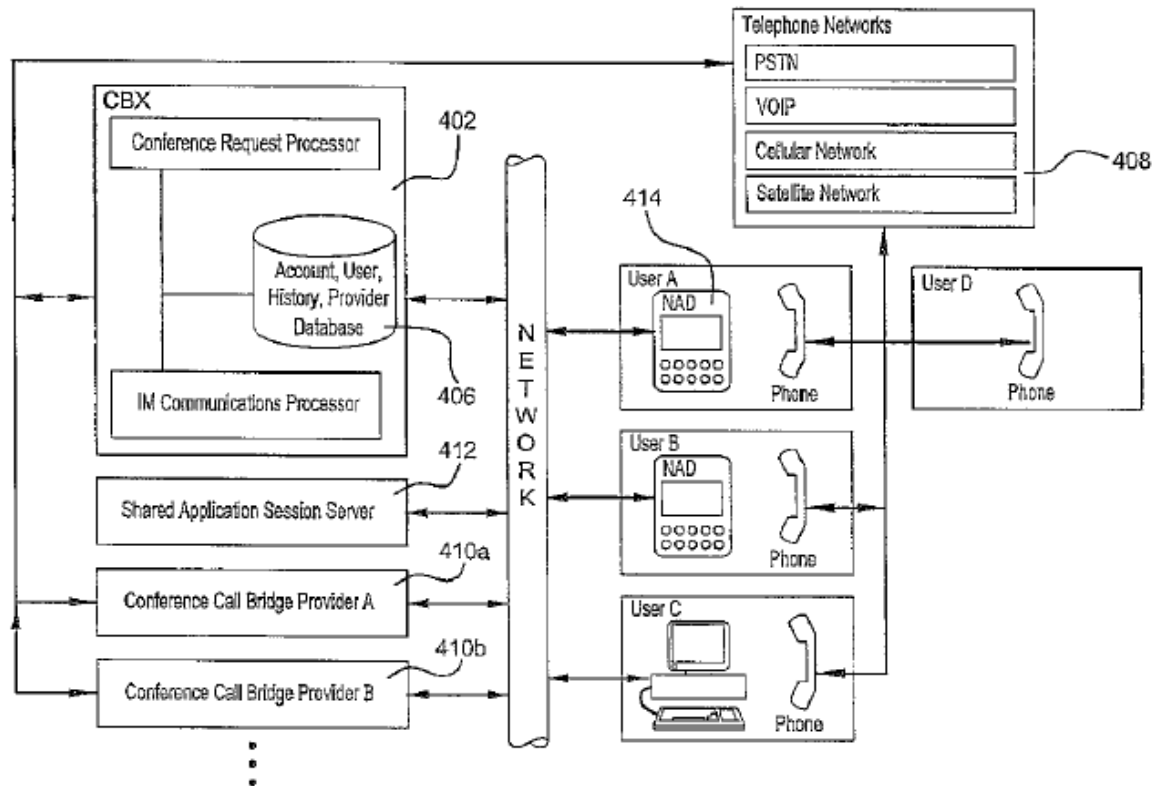
Figure 4 above shows a block diagram of a system for accomplishing the initiation of conference calls. Ex. 1001, 9:13–14. Conference call server 402 is connected to network 404. *Id.* at 9:14–15. Database 406, associated with conference call server 402, stores account information, user information, and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

For example, 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

Claim 1 of the challenged claims of the '948 patent is the only independent claim. Claim 1 follows:

> 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

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