

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC¹,
Petitioner,

v.

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

Case IPR2017-01685
Patent 7,804,948 B2

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

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.

I. INTRODUCTION

Petitioner 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 filed a Preliminary Response. Paper 8 (“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 1–4, 6–8, 18, 21, and 22 of the ’948 patent. Accordingly, we institute an *inter partes* review.

A. Related Matters

The ’948 patent is the subject of IPR2017-00058.

Both parties identify that the ’948 patent was asserted against Google, Inc., in *Uniloc USA, Inc. v Google, Inc.*, Case No. 2:16-cv-00566 (E.D. Tex.). Both parties also identify several other civil actions related to the ’948 patent.

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.

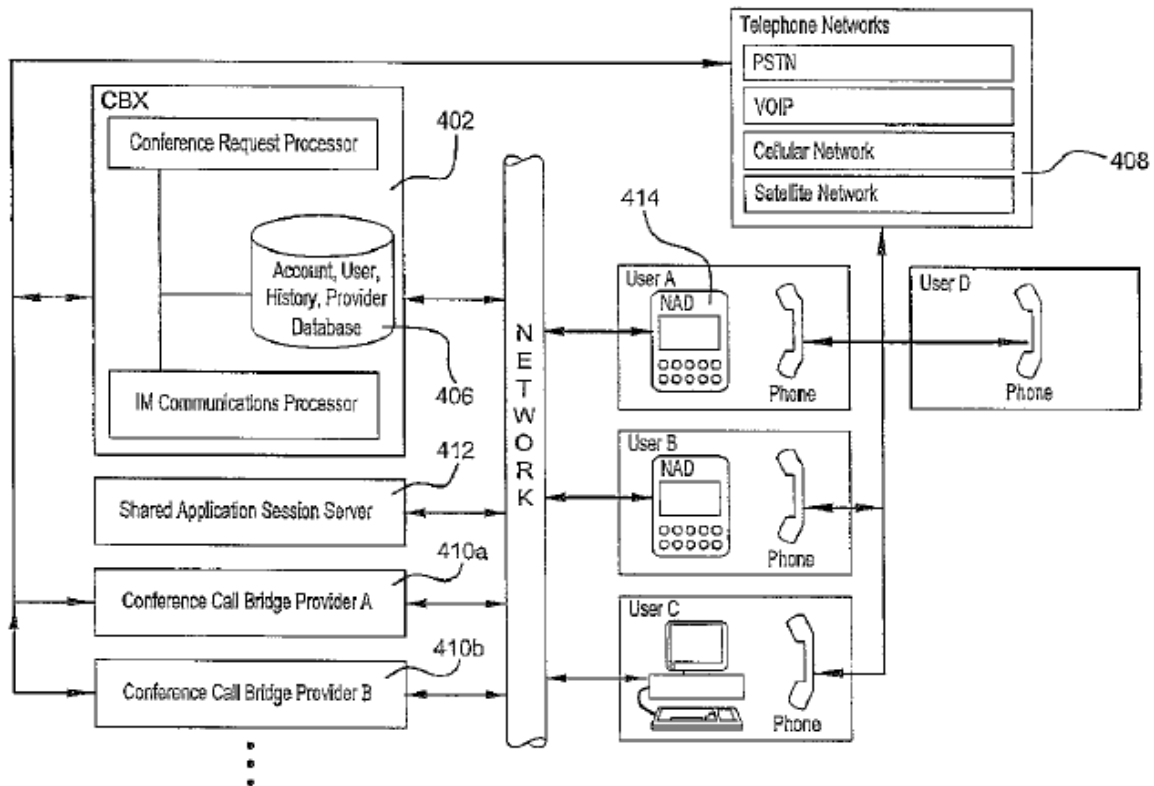


Figure 4 above shows a block diagram of a system for accomplishing the initiation of conference calls. Ex. 1001, 9:13–14. Conference call server 402 is connected to network 404. *Id.* at 9:14–15. Database 406, associated with conference call server 402, stores account information, user information, and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

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 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 messaging session with the conference call requester and with whom a conference call may be initiated;

generating a conference call request responsively to a single request by the conference call requester, said conference call request identifying each of the potential targets for said conference call request;

transmitting said conference call request from said network access device to said conference call server; and

automatically establishing a conference call connection to said conference call requester, said conference call connection initiated by said conference call server, said conference call connection further being connected to each of the potential targets.

Ex. 1001, 11:58–12:17.

D. References

Petitioner relies on the following references. Pet. 9–10.

| Reference | Title | Date | Ex. No. |
|------------------|--------------------|---------------------|----------------|
| Tanigawa | US 7,233,589 B2 | Filed Aug. 30, 2002 | Ex. 1014 |
| Liversidge | US 2002/0076025 A1 | Filed Dec. 18, 2000 | Ex. 1004 |

E. Asserted Ground of Unpatentability

Petitioner contends that claims 1–4, 6–8, 18, 21, and 22 of the '948 patent are unpatentable under 35 U.S.C. § 103 over Tanigawa and Liversidge.

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