

*Google*

v.

*Uniloc*

Case IPR2017-01683  
(Patent 8,571,194)

Hearing Before Karl D. Easthom,  
Ken V. Barrett, and  
Jeffrey S. Smith,  
Minn Chung

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# Claim 1 of the '194 Patent

1. A non-transitory computer readable medium containing computer instructions configured to operate with electronic computer hardware to perform the following steps:
  - display, in an instant messaging (IM) chat window of a first party, an exchange of IM messages between the first party and at least one other party, the first party and the at least one other party being current participants to an IM session;
  - display for the first party an indication of whether the at least one other party is communicably connected to the IM session;
  - display for the first party an option to automatically initiate voice communication between the current participants of the IM session without requiring individual selection of potential members including the first party and the at least one other party and without requiring registration with a conference call server for establishing the voice communication by the potential members including the first party and the at least one other party; and
  - request, in response to selection of the option, voice communication between the first party and the at least one other party;wherein in response to the request, the voice communication is established between the first party and those of the at least one other party.

## Claim 16 of the '194 Patent

16. A non-transitory computer readable medium containing computer instructions configured to operate with an electronic hardware computer server to perform the following steps:  
exchange IM messages between a first party and at least one other party, the first party and the at least one other party being current participants to an IM session;  
send to the first party an indication of whether the at least one other party is communicably connected to the IM session;  
receive a request from the first party to establish voice communication amongst current participants of the IM session without requiring registration with a conference call server for establishing the voice communication by potential members including the first party and the at least one other party, the request lacking a specific identification of the at least one other party;  
determine, after reception of the request, the at least one other party from information associated with the IM session;  
wherein after determining the at least one party, the voice communication is established between the first party and those of the at least one other party.

**“without requiring registration with a conference call server”**

**As the intrinsic evidence reveals, and as the Office has previously determined, the claim language including the recitation “... without requiring registration with a conference call server ...” at least excludes:**

- 1. the registration required in the Hamberg reference cited by the Examiner;**
- 2. the analogous registration identified by the Examiner in the disclaimed embodiment from the '194 patent specification; and**
- 3. the cumulative registration in the Liversidge reference considered by the Examiner during prosecution, which contains the same disclosure as the Liversidge reference relied upon in the Petition.**

## (1) Hamberg successfully distinguished during prosecution from “without requiring registration” limitations

### **Applicant’s successful distinction of Hamberg during prosecution included the following remarks:**

Hamberg discloses a conference call established between a pre-defined group. A server sets up a conference call between the subscribers registered with the server as active in a subscriber group. (See the Abstract of Hamberg). More specifically, the conference call is set up between persons registered to the group at the conference call server which establishes the call. (See paragraph 25 Of Hamberg). [¶] . . . Hamburg thus requires an active registration of each subscriber with the group at the server establishing a conference call so that the conference call can be set up between the registered subscribers. [¶] In contrast, Applicant’s amended independent claim 103 [now Claim 1] displays an option for the first party to automatically initiate voice communication between the current participants of the IM session without requiring prior registration with a conference call server for establishing the voice communication by potential members. That is, current participants of the IM session (or other potential members) need not have registered, e.g., with the conference call server that establishes the conference call, in order to be potential members for the voice communication.

(IPR2017-01683, Response at 7, citing EX1018 at 83, 113-114 and EX2001 ¶33)

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