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571-272-7822

Paper 13
Entered: March 9, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELESIGN CORPORATION,
Petitioner,

v.

TWILIO INC.,
Patent Owner.

Case IPR2017-01977
Patent 8,755,376 B2

Before ROBERT J. WEINSCHENK, KIMBERLY McGRAW, and SCOTT C. MOORE, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

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I. INTRODUCTION

TeleSign Corporation ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 1–3, 5, 14, 16, 17, and 19 of U.S. Patent No. 8,755,376 B2 (Ex. 1001, "the '376 patent"). Twilio Inc. ("Patent Owner") filed a Preliminary Response (Paper 10, "Prelim. Resp.") to the Petition. An *inter partes* review may not be instituted 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).

For the reasons set forth below, Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of claims 1–3, 5, 14, 16, 17, and 19 of the '376 patent. Accordingly, we institute an *inter partes* review as to claims 1–3, 5, 14, 16, 17, and 19 of the '376 patent on the grounds specified below.

A. *Related Proceedings*

The parties indicate that the '376 patent is the subject of the following district court case: *Twilio Inc. v. TeleSign Corporation*, No. 5:16-cv-06925 (N.D. Cal.). Pet. 66; Paper 4, 1. Patent Owner also indicates that the following petitions for *inter partes* review are related to this case:

Case No.	**Involved U.S. Patent No.**
IPR2017-01976	U.S. Patent No. 8,837,465
IPR2017-01978	U.S. Patent No. 8,306,021

Paper 4, 1.

B. *The '376 Patent*

The '376 patent relates to "processing telephony sessions." Ex. 1001, 1:22–24. The '376 patent explains that deploying telephony services "requires developers to train in new languages, tools, and development

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environments," and, thus, involves "significant upfront and ongoing investment." *Id.* at 1:35–54. To address this problem, the '376 patent describes a method and system for processing telephony sessions that "enables web developers to use their existing skills and tools with the esoteric world of telephony, making telephony application development as easy as web programming." *Id.* at 1:61–2:3. For example, the method and system of the '376 patent "use the familiar web site visitor model to interact with a web developer's application, with each step of the phone call analogous to a traditional page view." *Id.* at 2:3–6.

C. *Illustrative Claim*

Claim 1 is independent and is reproduced below.

1. A method comprising:

operating a telephony network and internet connected system cooperatively with a plurality of application programming Interface (API) resources, wherein operating the system comprises:

initiating a telephony session,

communicating with an application server to receive an application response,

converting the application response into executable operations to process the telephony session,

creating at least one informational API resource; and

exposing the plurality of API resources through a representational state transfer (REST) API that comprises:

receiving a REST API request that specifies an API resource URI,[1] and

responding to the API request according to the request and the specified resource URI.

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[1] URI stands for Universal Resource Identifier. Ex. 1001, 2:61–62.

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Ex. 1001, 18:29–45.

D. *Evidence of Record*

Petitioner submits the following references and declaration (Pet. 5–6):

Reference or Declaration	Exhibit No.
Maes et al., U.S. Patent No. 6,801,604 B2 (filed June 25, 2002, issued Oct. 5, 2004) ("Maes")	Ex. 1003
Ransom et al., U.S. Patent Application Publication No. 2003/0204756 A1 (filed Jan. 9, 2003, published Oct. 30, 2003) ("Ransom")	Ex. 1004
Jiang et al., U.S. Patent No. 7,092,370 B2 (filed Aug. 16, 2001, issued Aug. 15, 2006) ("Jiang")	Ex. 1005
European Telecommunications Standards Institute, ETSI ES 202 391-4 V1.2.1 (2006) ("ETSI 391-4")	Ex. 1006
European Telecommunications Standards Institute, ETSI ES 202 391-7 V1.2.1 (2006) ("ETSI 391-7")	Ex. 1007
European Telecommunications Standards Institute, ETSI ES 202 391-2 V1.2.1 (2006) ("ETSI 391-2")	Ex. 1008
Declaration of Dr. Seth Nielson ("Nielson Declaration")	Ex. 1009

E. *Asserted Grounds of Unpatentability*

Petitioner asserts that the challenged claims are unpatentable on the following grounds (Pet. 5–6):

Claim(s)	Basis	References
1–3, 14, 16, and 19	35 U.S.C. § 103(a)	Maes and Ransom
5 and 17	35 U.S.C. § 103(a)	Maes, Ransom, and Jiang
1–3, 5, 14, and 16	35 U.S.C. § 103(a)	ETSI 391-4 and Ransom
17	35 U.S.C. § 103(a)	ETSI 391-4, Ransom, and ETSI 391-7
19	35 U.S.C. § 103(a)	ETSI 391-4, Ransom, and ETSI 391-2

II. ANALYSIS

A. *Claim Construction*

The claims of an unexpired patent are interpreted using the broadest reasonable interpretation in light of the specification of the patent in which

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they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–45 (2016). Petitioner proposes that "[a]ll claim terms should be given their broadest reasonable construction in light of the specification," but Petitioner does not propose express constructions for any claim terms. Pet. 8–9. Patent Owner argues that "Petitioner knew that the terms 'URI' and 'REST' were important in both the District Court and in this proceeding," but Petitioner failed to address any claim construction issues relating to those terms. Prelim. Resp. 3–8. Patent Owner, however, does not propose express constructions for any claim terms either. *See id.* On this record and for purposes of this Decision, we determine that no claim terms require express construction to resolve the parties' disputes regarding the asserted grounds of unpatentability in this case. *See infra* Section II.B; *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) ("[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.").

B. *Asserted Grounds of Unpatentability*

1. *Obviousness of Claims 1–3, 14, 16 and 19 over Maes and Ransom*

Petitioner argues that claims 1–3, 14, 16, and 19 would have been obvious over Maes and Ransom. Pet. 5–6. We have reviewed the parties' assertions and supporting evidence. For the reasons discussed below, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 1–3, 14, 16, and 19 would have been obvious over Maes and Ransom.

a. *Claim 1*

Claim 1 recites "operating a telephony network and internet connected system cooperatively with a plurality of application programming Interface

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