NOTICE

Pursuant to the Patent Trial and Appeal Board (PTAB) Standard Operating Procedure 2, the PTAB designates the Decision on Institution in *Oracle Corp. v. Click-to-Call Techs. LP*, IPR2013-00312, Paper 26 (PTAB Oct. 30, 2013) **Precedential only as to Section III.A.**

Patent Trial and Appeal Board
Precedential
Standard Operating Procedure 2

UNITED STATES PATENT AND TRADEMARK OFFICE
_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

ORACLE CORPORATION,
ORACLE OTC SUBSIDIARY LLC,
INGENIO LLC, and
YELLOWPAGES.COM LLC
Petitioners

v.

CLICK-TO-CALL TECHNOLOGIES LP
Patent Owner
_____

Case IPR2013-00312
US Patent No. 5,818,836
_____

Before MICHAEL R. ZECHER, THOMAS L. GIANNETTI, and
TRENTON A. WARD, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

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

I. INTRODUCTION

Oracle Corporation, Oracle OTC Subsidiary LLC, Ingenio, LLC, and Yellowpages.com LLC ("Petitioners") filed a petition ("Pet.") requesting *inter partes* review of claims 1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, and 26-30 of U.S. Patent No. 5,818,836 ("the '836 patent"). Paper 1. Click-to-Call Technologies LP ("Patent Owner") filed a preliminary response ("Prelim. Resp."). Paper 14. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides:

> THRESHOLD—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.

For the reasons set forth below, we conclude that the information presented in the petition establishes that there is a reasonable likelihood that Petitioners will prevail in challenging claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 as unpatentable. However, we conclude that the information presented in the petition does not establish that there is a reasonable likelihood that Petitioners will prevail in challenging claims 18, 24, 27, and 28 as unpatentable. Pursuant to 35 U.S.C. § 314, we hereby authorize an *inter partes* review to be instituted only as to claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent.

A.   Related Matters

Petitioners indicate that the '836 patent was asserted in the following civil actions, each of which was filed in the U.S. District Court for the Western District of Texas: (1) *Click to Call Technologies LP v. Oracle Corporation, Oracle OTC Subsidiary LLC, Dell Inc.; Carnival Cruise Lines; The Harford Financial Services Group, Inc.; BMO Harris Bank N.A.; Allstate Insurance Company; Esurance Insurance Services, Inc.; HSBC Finance Corporation; and Macy's Inc.*, Civil Action No. 1:12-cv-00468-SS, filed on May 29, 2012; (2) *Click to Call Technologies LP v. eHarmony, Inc.*, Civil Action No. 1:12-cv-00469-SS, filed on May 30, 2012; and (3) *Click to Call Technologies LP v. AT&T, Inc.; YP Holdings LLC; Ingenio, Inc.; Yellowpages.com LLC; Ether, a division of Ingenio, Inc.; and Ingenio, Inc., doing business as Keen*, Civil Action 1:12-cv-00465-SS, filed on May 29, 2012. Pet. 1-2.

B. The Invention of the '836 Patent (Ex. 1001)

The invention of the '836 patent generally relates to a method and system for establishing anonymous telephone communications. Ex. 1001, 1:8-9. Figure 1 of the '836 patent illustrates an anonymous voice communication system 10. Ex. 1001, 4:35, 54-56. Figure 1 is reproduced below:
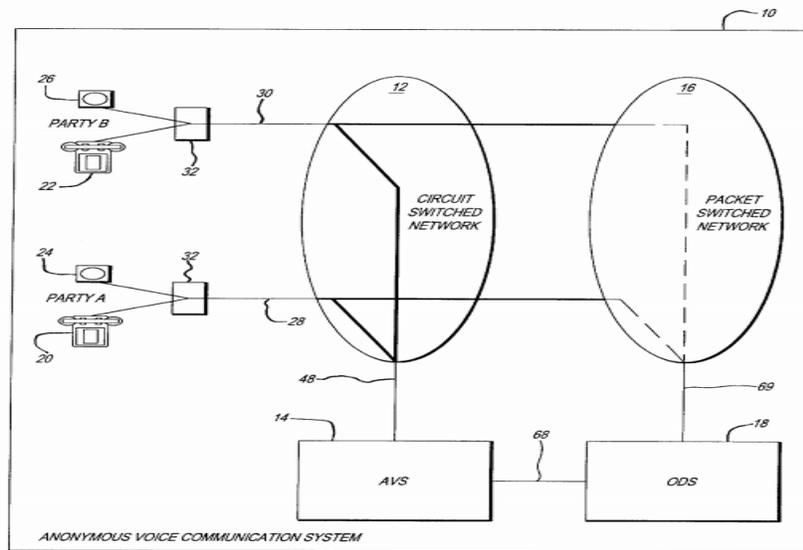
FIG. 1

Figure 1 of the '836 patent indicates that system 10 uses a circuit switched network ("CSN") 12 and an anonymous voice system ("AVS") 14 to establish anonymous voice communication between party A and party B. Ex. 1001, 4:56-59. In another embodiment, system 10 uses a packet switched network ("PSN") 16 and an on-line data system ("ODS") 18 to initiate an anonymous voice communication between party A and party B. Ex. 1001, 4:59-63.

The '836 patent discloses that each party has a telephone station 20, 22 associated therewith that is connected to CSN 12. Ex. 1001, 4:64-65. Telephone stations 20, 22 may be ordinary telephones, integrated services digital network telephones, or any device that can terminate an access line, play an audio signal, and transmit a received audio signal. Ex. 1001, 5:24-27. System 10 uses CSN 12 to establish a voice connection between the

4

respective telephone stations 20, 22 of each party and AVS 14. Ex. 1001, 4:65-67.

The '836 patent further discloses that each party may have a data terminal 24, 26 associated therewith that is connected to ODS 18 via CDS 12 and PSN 16. Ex. 1001, 5:5-8. The data terminals may be a personal computer with the ability to process and store data, display information, accept input via a keyboard, microphone, or writing tablet, and communicate with other devices via a serial port, modem, or local area network. Ex. 1001, 5:28-32. Each party may use its respective data terminals 24, 26 to exchange messages through ODS 18 to request an anonymous voice connection, which, in turn, causes ODS 18 to generate a command that prompts AVS 14 to establish a telephone connection between the parties. Ex. 1001, 5:8-13.

The '836 patent discloses at least three different methods of creating anonymous voice communication using system 10 illustrated in Figure 1: (1) standalone; (2) on-line; and (3) single party initiated. Ex. 1001, 9:45-47. With respect to the on-line method of establishing an anonymous voice communication, the parties initiate an anonymous voice call using ODS 18. Ex. 1001, 16:54-55. Both parties use their data terminals 24, 26 to log on to ODS 18. Ex. 1001, 16:55-57. The parties may contact each other via ODS 18 using public chat, private chat, electronic mail, or newsgroups. Ex. 1001, 16:57-59. The parties can communicate via ODS 18 without revealing their identity to each other, i.e., they are identified by screen names, handles, or subscriber identifications, which only the operator of ODS 18 can translate

into the subscriber's identification. Ex. 1001, 16:59-64. According to the '836 patent, either party A or party B may initiate an anonymous voice communication using the on-line method. Ex. 1001, 16:65.

C. Illustrative Claim

Claims 1 and 12 are independent claims. Claims 2, 8, 22-24, 26, and 27 directly or indirectly depend from independent claim 1, and claims 13, 15, 16, 18, 19, and 28-30 directly or indirectly depend from independent claim 12. Independent claim 1 is illustrative of the invention of the '836 patent and is reproduced below:

> 1.   A method for creating a voice connection over a circuit switched network between a first party and a second party using an on-line data service to initiate the connection, comprising the steps of:
>
> a)   establishing an electronic communication between the first party and the second party through the on-line data service between the first party and the second party, wherein the first party is anonymous to the second party prior to establishing a first electronic communication between the first party and the second party, wherein the establishing includes providing over the Internet, to a data terminal of the first party coupled to the Internet, information publicly accessible over the Internet, wherein the information public[ly] accessible over the Internet is suitable for presentation within a graphical user interface of the data terminal of the first party, wherein the information publicly accessible over the Internet includes:
>
> (1)   first information characterizing a second party,
>
> (2)   second information representing a communication from the second party, and

(3) third information specifying a user-selectable element for display within the graphical user interface of the data terminal of the first party, wherein the user-selectable element is visually associated, within the graphical user interface of the data terminal of the first party, with the first information and the second information, when the first information, second information and user-selectable element are presented within the graphical user interface of the data terminal of the first party; and

(b) following the establishment of an electronic communication between the first party and the second party through the on-line data service between the first party and the second party, and in response to receiving an indication of selection of the user-selectable element displayed within the graphical user interface of the data terminal of the first party, performing the steps of:

(1) requesting a voice communication between the first party and the second party through the on-line data service;

(2) transmitting a message from the on-line data service to a voice system requesting the voice connection between said first party and said second party;

(3) establishing a first telephone call for the first party;

(4) establishing a second telephone call for the second party; and

(5) connecting said first telephone call with said second telephone call.

Ex. 1001—Ex parte Reexamination Certificate, 1:26-2:8 (brackets and emphasis omitted).

D. Prior Art Relied Upon

Petitioners rely upon the following prior art references:

Dezonno   US 5,991,394   Nov. 23, 1999   Ex. 1002

7

		(effectively filed Apr. 21, 1995)	
Dozier	US 5,870,552	Feb. 9, 1999	Ex. 1003
		(filed Mar. 28, 1995)	
Freeman	US 5,428,608	June 27, 1995	Ex. 1005
		(filed Dec. 30, 1993)	
Blinken	US 4,796,293	Jan. 3, 1989	Ex. 1016
		(filed Dec. 18, 1987)	

DALE DOUGHERTY & RICHARD KOMAN, THE MOSAIC HANDBOOK FOR MICROSOFT WINDOWS 17-39 (1994) (Ex. 1004) ("Mosaic Handbook").

Peter H. Lewis, "*Attention Shoppers: Internet Is Open,*" N.Y. Times, Aug. 12, 1994 (Ex. 1006) ("Attention Shoppers").

CYBERSPACE FIRST STEPS 177-79, 273-301 (Michael Benedikt ed., 1992) (Ex. 1012) ("Cyberspace").

ED KROL, THE WHOLE INTERNET USER'S GUIDE & CATALOG 259, 322 (1992) (Ex. 1013) ("Whole Internet").

E. Alleged Grounds of Unpatentability

Petitioners challenge claims 1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, and 26-30 of the '836 patent based on the alleged grounds of unpatentability set forth in the table below.

Reference(s)	Basis	Claims Challenged
Dezonno	§102(e)	1, 2, 12, 13, 19, 22, 23, 26, 29, and 30[1]
Dezonno	§103(a)	1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30[2]
Dezonno and Mosaic Handbook	§103(a)	22 and 29
Freeman and Attention Shoppers	§103(a)	1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, and 26-30
Freeman, Attention Shoppers, and Blinken	§103(a)	8, 15, and 16
Freeman, Cyberspace, and Whole Internet	§103(a)	1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, 26, 29, and 30

---

[1] While Petitioners include dependent claims 18 and 24 in the statement of the ground of unpatentability (Pet. 21), Petitioners nonetheless do not include dependent claims 18 and 24 in the corresponding analysis (*see id.* at 21-31). Conversely, while Petitioners omit dependent claims 22 and 29 in the statement of the ground of unpatentability (*id.* at 21), Petitioners nonetheless include dependent claims 22 and 29 in the corresponding analysis (*id.* at 31). We will treat the incorrect statement of the ground of unpatentability as a typographical error and presume Petitioners intended to assert that claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated under 35 U.S.C. § 102(e) by Dezonno.

[2] *See supra* n. 1.

II. CLAIM CONSTRUCTION

Consistent with the statute and legislative history of the Leahy-Smith America Invents Act, Pub. L. 112-29, 125 Stat. 284, 329 (2011), the Board construes claims by applying the broadest reasonable interpretation in light of the specification. 37 C.F.R. § 42.100(b); *see also* Office Patent Trial Practice Guide, 77 *Fed. Reg*. 48756, 48766 (Aug. 14, 2012). There is a "heavy presumption" that a claim term carries its ordinary and customary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

A. Claim Terms or Phrases

Petitioners propose claim constructions for a number of claim terms or phrases recited in the '836 patent that are not disputed by the Patent Owner. Pet. 8-11 (citing to Ex. 1009; Ex. 1010). The claim constructions proposed by the Petitioners are set forth in the table below.

Claim(s)	Claim Terms or Phrases	Petitioners' Proposed Claim Construction
1 and 12	"party"	A person or group participating in an action.
1 and 12	"anonymous"	Identity is not revealed.
1 and 12	"voice system"	A system that can connect voice calls.
1 and 12	"data terminal"	A computing device capable of sending and/or receiving data.

1	"on-line data service"	A service provided by an on-line data system, such as electronic mail, chat, newsgroups, or access to information.
12	"on-line data system"	A computing device or distributed computing system with storage and communications capability that provides services on-line, such as electronic mail, chat, newsgroups, or access to information.
1 and 12	"information publicly accessible"	Information that is widely available and subject to minimal constraints, such as subscription, registration, or ability to access the on-line data service or system.
1	"establishing [or establishment of] an electronic communication between the first party and the second party"	Transferring information electronically from one party to another party.
1 and 12	"second information representing a communication from the second party"	Information representing information transferred from the second party.

1	"requesting a voice communication between the first party and the second party through the on-line data service"	Requesting a voice communication using the on-line data service.
12	"connect command"	A command that directs the voice system to connect a first telephone call with a second telephone call.
1 and 12	"indication [or indicative] of selection of the user-selectable element"	Information indicating that the user-selectable element was selected.
12	"on-line data system that is coupled to the data terminal of each party"	A computing device or distributed computing system with storage and communications capability that provides services on-line, such as electronic mail, chat, newsgroup, or access to information, and is coupled to the data terminal of each party.
1	"on-line data service between the first and the second party"	A service provided by an on-line data system, such as electronic mail, chat, newsgroup, or access to information.

Based on our review of the specification of the '836 patent, we determine that the claim constructions proposed by Petitioners for the

12

aforementioned claim terms or phrases are consistent with their ordinary and customary meaning, as would be understood by one with ordinary skill in the art, and that there is nothing in the specification of the '836 patent to suggest that any other claim constructions are appropriate.

B. *"First information" and "second information" (Claims 1 and 12)*

Petitioners contend that the claim terms "first information" and "second information" recited in independent claims 1 and 12 are not entitled to patentable weight because each such claim term amounts to non-functional descriptive material that has no functional relationship to any substrate or other portions of the claims. Pet. 60. In response, Patent Owner contends that the "first information" and "second information" recited in independent claim 1 are entitled to patentable weight because they have a direct functional relationship to the "establishing" step (a), as well as the "performing" steps (b)(1)-(5), all of which are recited in independent claim 1. Prelim. Resp. 21-23. Similarly, Patent Owner contends that "first information" and "second information" recited in independent claim 12 are entitled to patentable weight because they have a direct functional relationship to "the provision of the information publicly accessible," which is structured through the visual association of a user-selectable element with the first and second information recited in independent claim 12. *Id*. at 23.

Contrary to Petitioners' argument, the claim terms "first information" and "second information" further limit the claimed invention functionally. With respect to independent claim 1, the claim terms "first information" and "second information" are related functionally to "the establishment of an

13

electronic communication between the first party and the second party." That is, "the establishment of an electronic communication between the first party and the second party" cannot occur until the "first information" and "second information" are associated visually with "the user-selectable element." Moreover, the "performing" steps (b)(1)-(5) that establish a "voice communication between the first party and the second party" cannot occur until after "the establishment of an electronic communication between the first party and the second party."

With respect to independent claim 12, the claim terms "first information" and "second information" are related functionally to "the on-line data system . . . generat[ing] a connect command." That is, "the on-line data system" cannot "generate[] a connect command" until the "first information" and "second information" are associated visually with "the user-selectable element." Moreover, the "voice system" cannot "connect[] a first telephone call of the first party with a second telephone call of the second party" until "the on-line data system generates a connect command." Given the functional relationship that the "first information" and the "second information" have with other claimed features recited in independent claims 1 and 12, these claim terms limit the claimed invention functionally and, as a result, are entitled to patentable weight.

III. ANALYSIS

A. *Statutory Bar Pursuant to 35 U.S.C. § 315(b)*

Patent Owner contends that one of the Petitioners—namely

Ingenio, LLC—was served with a complaint alleging infringement of the

'836 patent in a civil action filed in the U.S. District Court for the Southern

District of New York on June 8, 2001. Prelim. Resp. 3-4, 7. Patent Owner

argues that service of the complaint in that infringement suit occurred more

than one year before the petition in this proceeding was filed on May 28,

2013. *Id*. Therefore, Patent Owner argues that the petition in this

proceeding should be denied because Ingenio, LLC is barred from pursuing

an *inter partes* review for the '836 patent pursuant to 35 U.S.C. § 315(b).

Id.

The following timeline was provided by Patent Owner and is helpful

in determining whether Ingenio, LLC is barred from filing an *inter partes*

review of the '836 patent: (1) in 2001, the inventor of the '836 patent—

Stephen C. DuVal—granted an exclusive license to Inforocket; (2) on June

8, 2001, Inforocket sued Keen for infringement of the '836 patent (Ex. 2002;

Ex. 2003); (3) in early 2003, Keen acquired Inforocket as its wholly-owned

subsidiary and, thereafter, Inforocket dismissed the infringement suit against

Keen; (4) later in 2003, Keen changed its name to Ingenio, Inc. (Ex. 2004 at

§§ 3.13, 3.15; Ex. 2005; and Ex. 2006, n. 29); (5) on May 29, 2012, Click-

to-Call Technologies LP asserted the '836 patent against multiple parties,

including Ingenio, LLC (Ex. 2007); (6) in the infringement suit filed on May

29, 2012, Ingenio admitted that the correct name of Ingenio, Inc. is actually

Ingenio, LLC (*see* Ex. 2007 at 4). Prelim. Resp. 4-7. Petitioners have admitted that the timeline provided by Patent Owner is, in fact, correct. Paper 16 at 2-3.

In additional briefing requested by the Board, both Petitioners and Patent Owner provided more factual evidence regarding the dismissal of the infringement suit between Inforocket and Keen that occurred in early 2003. Petitioners indicate that Inforocket dismissed its infringement suit against Keen without prejudice on March 21, 2003. Paper 17 at 2 (citing to Ex. 1019). Patent Owner also acknowledges that Inforocket and Keen voluntarily agreed to dismiss the infringement suit without prejudice. Paper 20 at 1 (citing to Ex. 1017 at 4; Ex. 1018 at 8).

We begin our analysis by noting that whether Petitioners are barred from pursuing an *inter partes* review pursuant to 35 U.S.C. § 315(b) is a threshold issue. 35 U.S.C. § 315(b) provides that:

> An inter partes review may not be instituted if the petition
> requesting the proceeding is filed more than one year after the
> date on which the petitioner, real party in interest, or privy of
> the petitioner is served with a complaint alleging infringement
> of the patent.

The statute requires that the service date of the complaint be more than one year before the petition was filed—in this case more than one year before May 28, 2013. Patent Owner has not established that service of the complaint in the infringement suit brought by Inforocket against Keen bars Ingenio, LLC from pursuing an *inter partes* review for the '836 patent.

With respect to the requirement of service, we note that the infringement suit brought by Inforocket against Keen—now Ingenio, LLC—was dismissed voluntarily without prejudice on March 21, 2003, pursuant to a joint stipulation under Fed. R. Civ. P. 41(a). Ex. 1019; *see also* Ex. 1017 at 4; Ex. 1018 at 8. The Federal Circuit consistently has interpreted the effect of such dismissals as leaving the parties as though the action had never been brought. *Graves v. Principi*, 294 F.3d 1350, 1356 (Fed. Cir. 2002) ("The dismissal of an action without prejudice leaves the parties as though the action had never been brought"); *Bonneville Assoc., Ltd. Partnership v. Baram*, 165 F.3d 1360, 1364 (Fed. Cir. 1999) ("The rule in the federal courts is that '[t]he effect of a voluntary dismissal without prejudice pursuant to Rule 41(a) is to render the proceedings a nullity and leave the parties as if the action had never been brought.'") (citations and internal quotes omitted). *Accord* 9 WRIGHT, MILLER, KANE, and MARCUS, FEDERAL PRAC. & PROC. CIV. § 2367 (3d. ed.) ("[A]s numerous federal courts have made clear, a voluntary dismissal without prejudice under Rule 41(a) leaves the situation as if the action never had been filed.") (footnote omitted). Accordingly, the dismissal of the infringement suit brought by Inforocket against Keen—now Ingenio, LLC—nullifies the effect of the service of the complaint and, as a consequence, does not bar Ingenio, LLC or any of the other Petitioners from pursuing an *inter partes* review of the '836 patent.

In the additional briefing requested by the Board, Petitioners and Patent Owner also raised the following issues: (1) whether a statutory bar

pursuant to 35 U.S.C. § 315(b) should be determined on a "petitioner-by-petitioner" basis; and (2) whether the patent at issue in the infringement suit brought by Inforocket against Keen is the same patent at issue in this proceeding. Paper 17 at 4-6; Paper 20 at 3-5. The current situation does not require us to assess the merits of these issues because, as we discussed above, neither Ingenio, LLC nor any of the other Petitioners is barred from pursuing an *inter partes* review of the '836 patent.

B. 35 U.S.C. § 103(a) Grounds of Unpatentability
Based in Whole or in Part on Dezonno

Petitioners contend that: (1) claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 are anticipated under 35 U.S.C. § 102(e) by Dezonno; (2) claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable under 35 U.S.C. § 103(a) over Dezonno; and (3) claims 22 and 29 are unpatentable under 35 U.S.C. § 103(a) over the combination of Dezonno and Mosaic Handbook. Pet. 15-33. In particular, Petitioners rely upon claim charts to explain how Dezonno, either standing alone or in combination with Mosaic Handbook, allegedly describes the claimed subject matter, as well as the Declaration of Robert L. Stevenson (Ex. 1007) to support its positions. *Id*. We are persuaded by Petitioners' claim charts and supporting evidence.

We begin our analysis with a general discussion of Dezonno, the argument presented by Patent Owner that is directed to whether Dezonno qualifies as prior art to the '836 patent, and then we turn to the position taken by Petitioners with respect to the date of conception of the invention of the '836 patent.

18

1. *Dezonno (Ex. 1002)*

Dezonno was filed on February 5, 1998, but claims priority to U.S. Patent Application No. 08/426,533, filed on April 21, 1995. Dezonno generally relates to establishing voice communications between a computer user and an agent of a business via a computer network, such as the Internet. Ex. 1002, 1:8-13. The computer user transmits a call request over the computer network to a telephone switching system associated with the business agent. Ex. 1002, 1:13-16. In response to the call request, the telephone switching system calls the computer user and connects the business agent to the computer user when the computer user answers the call. Ex. 1002, 1:16-19.

Figure 2 of Dezonno illustrates an exemplary home page that is used for advertisement purposes by a business on the Internet. Ex. 1002, 3:15-16, 64-65. Figure 2 is reproduced below:
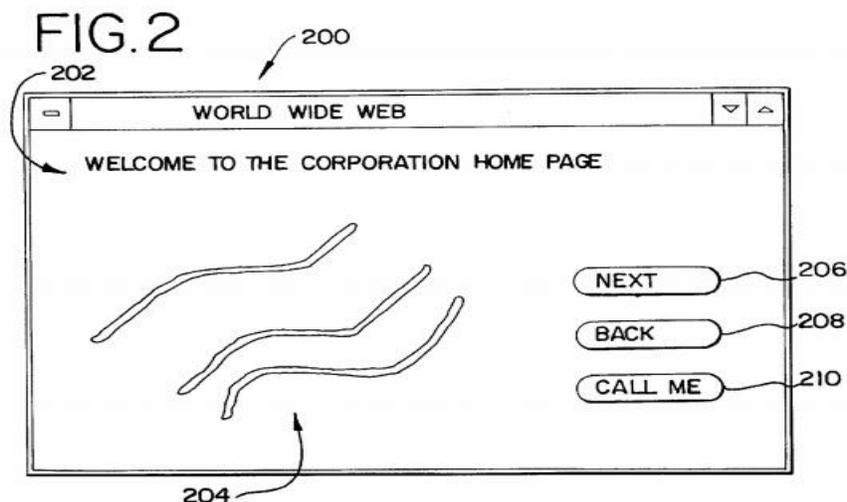

FIG.2

WORLD WIDE WEB

WELCOME TO THE CORPORATION HOME PAGE

NEXT 206
BACK 208
CALL ME 210

Figure 2 of Dezonno indicates that business home page 200 includes a text portion 202 describing a product or service. Ex. 1002, 3:67-4:2. The "next" and "back" buttons 206, 208 transfer a computer user 102 (illustrated in Figure 1) to the next home page or the previous home page, respectively. Ex. 1002, 4:2-4. If the computer user 102 wants to establish voice communications with the business to order a product or to ask a question, the computer user 102 selects the "call me" button 210. Ex. 1002, 4:7-10.

After selecting the "call me" button 210, the computer user 102 is transferred to a return call screen 300. Ex. 1002, 4:10-11. Figure 3 of Dezonno illustrates an exemplary return call screen 300 used by the computer user 102 to request a return call from the business. Ex. 1002, 3:17-18. Figure 3 is reproduced below:
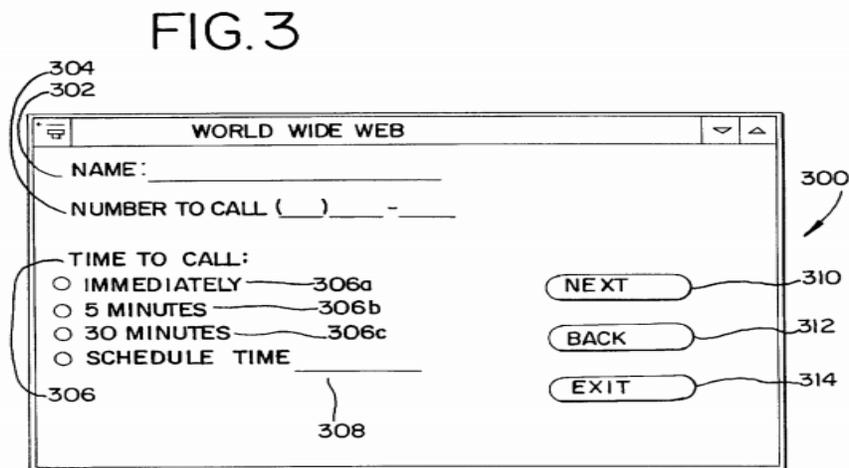

Figure 3 of Dezonno indicates that the computer user 102 enters his/her name 302, telephone number to call 304, and a time to call 306, 308 in their respective fields. Ex. 1002, 4:11-13, 17-22. Alternatively, the name and telephone number of the computer user 102 may be kept on file and

automatically entered in the appropriate fields. Ex. 1002, 4:13-16. After filling in the requested information, the computer user 102 selects the "next" button 310, which, in turn, sends a call request to the telephone switching system 112 (illustrated in Figure 1). Ex. 1002, 4:22-24. In one embodiment, Dezonno discloses that the communication system simultaneously transmits information to an agent 104 (illustrated in Figure 1) while connecting the agent 104 with the computer user 102. Ex. 1002, 5:43-46.

2. *Patent Owner's Contentions*

Patent Owner contends that Dezonno does not qualify as prior art under 35 U.S.C. § 102(e) because the invention of the '836 patent was conceived prior to the effective filing date of Dezonno, i.e., April 21, 1995. Prelim. Resp. 11. Patent Owner directs our attention to the invention disclosure document (Ex. 1008) filed on October 18, 1994, as well as two additional invention disclosure documents (Ex. 2010, Ex. 2011) filed on March 8, 1995, and May 10, 1995, respectively. *Id.* at 12-13. Patent Owner argues that the invention disclosure document (Ex. 1008) filed October 18, 1994, in combination with the invention disclosure document (Ex. 2010) filed on March 8, 1995, corroborates conception of the invention of the '836 patent prior to April 21, 1995, and, as a result, disqualifies Dezonno as prior art. *Id.* at 13-14 (citing to Ex. 2010, pp. 102, 115).

3. *Petitioners' Contentions*

Petitioners take the position that the '836 patent is not entitled to claim priority to a date of invention that is earlier than the filing date of Dezonno's parent patent application—U.S. Patent Application No.

08/426,533, filed on April 21, 1995. Pet. 17-18. In particular, Petitioners
contend that while Patent Owner filed an invention disclosure document (Ex.
1008) on October 18, 1994, which allegedly establishes a date of conception
for the claimed invention prior to the effective filing date of Dezonno, i.e.,
April 21, 1995, that invention disclosure document does not disclose
requesting voice communication or generating a connect command in
response to receiving an indication of selection of any user-selectable
element, as is required by independent claims 1 and 12. *Id*. at 18-20.
Therefore, Petitioners argue that the invention disclosure document (Ex.
1008) cannot provide corroboration for a date of conception for independent
claims 1 and 12 of the '836 patent as of October 18, 1994. *Id*. at 20.

4. Analysis

Even assuming that Patent Owner can establish conception of the
invention of the '836 patent prior to the effective filing date of Dezonno, i.e.,
April 21, 1995, Patent Owner has not presented sufficient or credible
evidence to establish diligence in reduction to practice from April 20, 1995,
to the filing date of the '836 patent, i.e., August 9, 1995. To establish
diligence, a patent applicant must be specific as to date and facts. *Kendall v.
Searles*, 173 F.2d 986, 993 (CCPA 1949). Moreover, a patent applicant
must provide such dates and facts for the entire period during which
diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919 (CCPA 1966).

While Patent Owner indicates its intent is to submit a declaration
pursuant to 37 C.F.R. § 1.131(a) that establishes diligence during the entire
critical period, i.e., April 20, 1995 through August 9, 1995 (Prelim. Resp.

11-12), such a declaration is not before us. Given the absence in the record of adequate supporting evidence, we are unable at this stage to conclude that Patent Owner will be able to establish diligence for the entire critical period during which diligence is required. Therefore, on this record, we are not persuaded by Patent Owner's argument that Dezonno does not qualify as prior art to the claims of the '836 patent.

In addition, the claim charts and supporting evidence presented by Petitioners to explain how Dezonno, either standing alone or in combination with Mosaic Handbook, describes the claimed subject matter recited in claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 have merit and are otherwise unrebutted. Based on the record before us, Petitioners have demonstrated a reasonable likelihood of prevailing on their assertion that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable based in whole or in part on Dezonno.

C. 35 U.S.C. § 103(a) Grounds of Unpatentability Based in Part on Freeman

Petitioners contend that: (1) claims 1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, and 26-30 are unpatentable under 35 U.S.C. § 103(a) over the combination of Freeman and Attention Shoppers; (2) claims 8, 15, and 16 are unpatentable under 35 U.S.C. § 103(a) over the combination of Freeman, Attention Shoppers, and Blinken; and (3) claims 1, 2, 8, 12, 13, 15, 16, 18, 19, 22-24, 26, 29, and 30 are unpatentable under 35 U.S.C. § 103(a) over the combination of Freeman, Cyberspace, and Whole Internet. Pet. 33-60. In particular, Petitioners rely upon claim charts to explain how the combination

of prior art references allegedly teaches the claimed subject matter, as well as the Declaration of Mr. Stevenson (Ex. 1007) to support their positions. *Id*. We have considered Petitioners' analysis and supporting evidence, as well as Patent Owner's arguments, but are not persuaded that Freeman teaches the following claim limitations: (1) "establishing a first telephone call for the first party," "establishing a second telephone call for the second party," and "connecting said first telephone call with said second telephone call," as recited in independent claim 1; and (2) "[the] voice system . . . connects a first telephone call of the first party with a second telephone call of the second party in response to the connect command," as recited in independent claim 12.

We begin our analysis with a general discussion of Freeman, the positions taken by Petitioners with respect to how Freeman allegedly teaches the aforementioned claim limitations recited in independent claims 1 and 12, and then we turn to the arguments presented by Patent Owner that are directed towards whether Freeman teaches those claim limitations.

1. Freeman

Freeman generally relates to providing simultaneous voice and data ("SVD") communications using an SVD modem. Ex. 1005, 1:6-8. Figure 6 of Freeman illustrates a process by which a user, who is using a data channel to engage in an application, automatically adds voice communication over a voice channel with the person best suited to help him/her. Ex. 1005, 4:58-64, 12:52-59. Figure 6 is reproduced below:

FIG. 6

```
                    ( START )
                        │
                        ▼         603
              ┌──────────────────┐
              │  USER  LOGS  IN  │
              └──────────────────┘
                        │              605
                        ▼
        ┌──────────────────────────────────┐
        │ USER  CONNECTS  TO  SVD  APPLICATION │
        └──────────────────────────────────┘
                        │                        611
                        ▼
  ┌────────────────────────────────────────────────┐
  │ USER  INTERACTS  WITH  APPLICATION  TILL  HE  NEEDS  HELP │
  └────────────────────────────────────────────────┘
                        │                613
                        ▼
        ┌──────────────────────────────────┐
        │  USER  SIGNALS  FOR  VOICE  ASSIST  │
        └──────────────────────────────────┘
                        │                  615
                        ▼
      ┌────────────────────────────────────────┐
      │ APPLICATION  DETERMINES  CONTEXT  IN  WHICH │
      │        USER  HAS  REQUESTED  HELP        │
      └────────────────────────────────────────┘
                        │                  616
                        ▼
      ┌────────────────────────────────────────┐
      │ APPLICATION  RETRIEVES  DISTINATION  ADDRESS │
      │ OF  BEST  PERSON  TO  HELP  GIVEN  THE  CONTEXT │
      └────────────────────────────────────────┘
                        │                  617
                        ▼
      ┌────────────────────────────────────────┐
      │   APPLICATION  INSTRUCTS  CONTROLLER  TO   │
      │  CONNECT  USER'S  VOICE  CHANNEL  TO  THE  │
      │     RETRIEVED  DESTINATION  ADDRESS     │
      └────────────────────────────────────────┘
                        │                  618
                        ▼
      ┌────────────────────────────────────────┐
      │ CONTROLLER  CONNECTS  USER  TO  DESTINATION │
      │     ADDRESS  OVER  VOICE  CHANNEL      │
      └────────────────────────────────────────┘
                        │          621
                        ▼
                    (  END  )
```
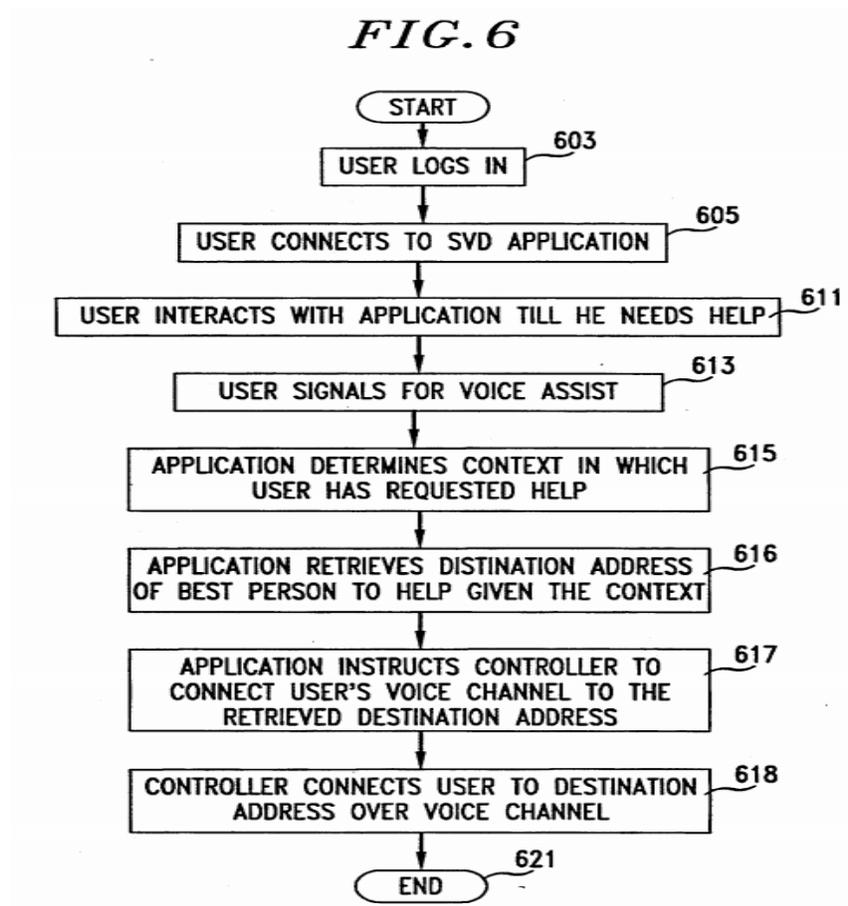
Figure 6 of Freeman indicates that the process begins in step 601, where a user of the application initiates a call to an SVD modem in one of the SVD modem pools. Ex. 1005, 12:60-63. At step 603, the user logs in. Ex. 1005, 12:63-64. At step 605, the user selects a particular application and connects thereto over a data channel. Ex. 1005, 12:64-66. At step 611, the user communicates and interacts with the selected application via the data channel until the user encounters something in the application for which he or she needs help. Ex. 1005, 13:1-4. At step 613, the user requests help

through the application by signaling for voice assistance. Ex. 1005, 13:11-13.

At step 615, the application recognizes the help command and determines the context in which the help was sought, i.e., the activity of the application in which the user currently is engaged. Ex. 1005, 13:18-21. Given the context of the request, the application then retrieves the destination address, e.g., telephone number, of the person best suited to help the user. Ex. 1005, 13:24-27. At step 617, the application instructs the controller associated with the SVD modem pool through which the requesting user is connected to establish a voice connection with the retrieved destination address through a CSN. Ex. 1005, 13:35-40. At step 619, the user is connected to the destination address over a voice channel and alerted to the existence of the voice connection. Ex. 1005, 13:45-48. At step 621, the process ends. Ex. 1005, 13:48-49.

2. Petitioners' Contentions

Petitioners take the position that Freeman's disclosure of retrieving the telephone number for the person best suited to help the user, and instructing an adjunct controller to establish a voice connection with that telephone number, amounts to "establishing a first telephone call for the first party," as recited in independent claim 1. Pet. 40 (citing to Ex. 1005, 13:29-40). In addition, Petitioners take the position that Freeman's disclosure of connecting the user to the retrieved telephone number over a voice channel constitutes both "establishing a second telephone call for the second party" and "connecting said first telephone call with said second telephone call," as

recited in independent claim 1. *Id.* (citing to Ex. 1005, 13:45-47).

Petitioners explain that because "the user's voice channel is connected to a telephone, it is clear that a call is placed to the user's telephone and that this call is connected to the phone call to the identified representative in order to allow the user to talk to the identified representative." *Id.* Petitioners rely upon the same position to support their assertion that Freeman teaches "[the] voice system . . . connects a first telephone call of the first party with a second telephone call of the second party in response to the connect command," as recited in independent claim 12. Pet. 44 ("*See* the evidence and information cited from claim limitations 1.f-1.j[.]").

3. *Patent Owner's Contentions*

In response, Patent Owner contends that a single telephone call is made from the user to the telephone number of the person best suited to help the user. Pet. 18. In other words, Patent Owner argues that, because two separate and distinct telephone calls are not established, Freeman does not connect a first telephone call with a second telephone call, as required by independent claim 1. *Id.* at 18-19. Patent Owner relies upon essentially the same arguments presented against the disputed claim limitations recited in independent claim 1 to rebut Petitioners' position that Freeman teaches "[the] voice system . . . connects a first telephone call of the first party with a second telephone call of the second party in response to the connect command," as recited in independent claim 12. *Id.* at 19-20.

4. Analysis

As discussed above, Freeman discloses that, depending on the context of the user's request, the application retrieves the telephone number of a person best suited to help the user. Ex. 1005, 13:24-27. Next, Freeman indicates that the application instructs the adjunct controller to establish a voice connection with the retrieved telephone number through a CSN. Ex. 1005, 13:35-40. After a voice connection is established between the user and the retrieved telephone number, Freeman discloses that the user is alerted to the existence of the voice connection. Ex. 1005, 13:45-48.

Based on these cited disclosures, we agree with Patent Owner that Freeman establishes a single voice connection, i.e., telephone call, between the user and the person best suited to help the user. There is no indication that Freeman's SVD system establishes a first telephone call with the user, establishes a second telephone call with the person best suited to help the user, and then bridges the connection between the first and second telephone calls. As such, we are not persuaded that Petitioners have presented sufficient evidence to support a finding that Freeman teaches the following claim limitations: (1) "establishing a first telephone call for the first party," "establishing a second telephone call for the second party," and "connecting said first telephone call with said second telephone call," as recited in independent claim 1; and (2) "[the] voice system . . . connects a first telephone call of the first party with a second telephone call of the second party in response to the connect command," as recited in independent claim 12.

Based on the record before us, Petitioners have not demonstrated a reasonable likelihood of prevailing on their assertion that independent claims 1 and 12 are unpatentable based in part on Freeman. Claims 2, 8, 22-24, 26, and 27 directly or indirectly depend from independent claim 1, and claims 13, 15, 16, 18, 19, and 28-30 directly or indirectly depend from independent claim 12. For the same reasons discussed above with respect to independent claims 1 and 12, Petitioners have not demonstrated a reasonable likelihood of prevailing on their assertion that dependent claims 2, 8, 13, 15, 16, 18, 19, 22-24, and 26-30 are unpatentable based in part on Freeman.

IV. CONCLUSIONS

For the foregoing reasons, we conclude that the information presented in the petition establishes that there is a reasonable likelihood that Petitioners would prevail in showing that claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 are unpatentable. However, we conclude that the information presented in the petition does not establish that there is a reasonable likelihood that Petitioners will prevail in challenging claims 18, 24, 27, and 28 as unpatentable.

V. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted only as to claims 1, 2, 8, 12, 13, 15, 16, 19, 22,

29

23, 26, 29, and 30 of the '836 patent for the following grounds of unpatentability:

    A.   Claims 1, 2, 12, 13, 19, 22, 23, 26, 29, and 30 as anticipated under 35 U.S.C. § 102(e) by Dezonno;

    B.   Claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 as unpatentable under 35 U.S.C. § 103(a) over Dezonno; and

    C.   Claims 22 and 29 as unpatentable under 35 U.S.C. § 103(a) over the combination of Dezonno and Mosaic Handbook;

FURTHER ORDERED that no other grounds of unpatentability are authorized for the *inter partes* review as to claims 1, 2, 8, 12, 13, 15, 16, 19, 22, 23, 26, 29, and 30 of the '836 patent;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial. The trial will commence on the entry date of this decision; and

FURTHER ORDERED that an initial conference call with the Board is scheduled for 2PM on November 14, 2013. The parties are directed to the Office Trial Practice Guide, 77 *Fed. Reg.* 48756, 48765-66 (Aug. 14, 2012) for guidance in preparing for the initial conference call, and should come prepared to discuss any proposed changes to the Scheduling Order entered herewith and any motions the parties anticipate filing during the trial.

For PETITIONERS:

James M. Heintz
DLA Piper LLP (US)
Oracle-IPRP@dlapiper.com

Mitchell G. Stockwell
Kilpatrick Townsend & Stockton LLP
mstockwell@kilpatricktownsend.com

For PATENT OWNER:

Craig J. Yudell
Eustace P. Isidore
Yudell Isidore Ng Russell PLLC
Yudell@yudellisidore.com
Isidore@yudellisidore.com