

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and INSTAGRAM, LLC,
Petitioner,

v.

VOXER IP LLC,
Patent Owner.

IPR2021-00399
Patent 10,109,028 B2

Before LYNNE E. PETTIGREW, MICHELLE N. ANKENBRAND, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

ANKENBRAND, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Facebook, Inc. and Instagram, LLC (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 5, and 12 of U.S. Patent No. 10,109,028 B2 (Ex. 1001, “the ’028 patent”). Paper 1 (“Pet.”). Voxer IP LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2020). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless the Director determines . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least [one] of the claims challenged in the petition.”

For the reasons set forth below, upon considering the Petition, Preliminary Response, and evidence of record, we determine the information presented in the Petition does not establish a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. Accordingly, we deny the Petition, and do not institute an *inter partes* review.

II. BACKGROUND

A. Related Matters

The parties identify the following district court proceeding related to the ’028 patent: *Voxer, Inc. v. Facebook, Inc.*, No. 1:20-cv-00655 (W.D. Tex.). Pet. 1; Paper 6, 1.

The parties also identify the following related matters: IPR2021-00112 and IPR2021-00113 (challenging U.S. Patent No. 10,511,557 B2),

IPR2021-0114 (challenging U.S. Patent 8,180,030 B2) and IPR2021-00115 (challenging U.S. Patent No. 10,142,270 B2). Pet. 1–2; Paper 6, 1.

B. Overview of the '028 Patent

The '028 patent describes a “communications software module that can be embedded in other software applications.” Ex. 1001, 1:15–17. The '028 patent explains that there are a wide variety of communication services available for mobile and computer devices and users typically access those services via a dedicated application. *Id.* at 1:21–29. According to the '028 patent, some communication service companies allow other parties to access their communication networks. *Id.* at 1:34–36. For example, the '028 patent explains that a retail outlet could have a website to market its products, but it could be desirable for a user to quickly and easily make a call through their computer to the retail outlet’s customer service representative. *Id.* at 1:38–43. The '028 patent explains that one communication service company provides hyperlinks for HTML code, such as a hyperlink that generates a button on a website. *Id.* at 1:44–49. Clicking the button launches the communication service, which is already on the user’s computer, to make a call to a designated recipient, such as a customer service representative. *Id.* at 1:49–55.

The '028 patent describes an embeddable communication software module that can be embedded in a software application to provide the software application with various communication features. *Id.* at 1:59–63.

We reproduce Figure 1 of the '028 patent below.

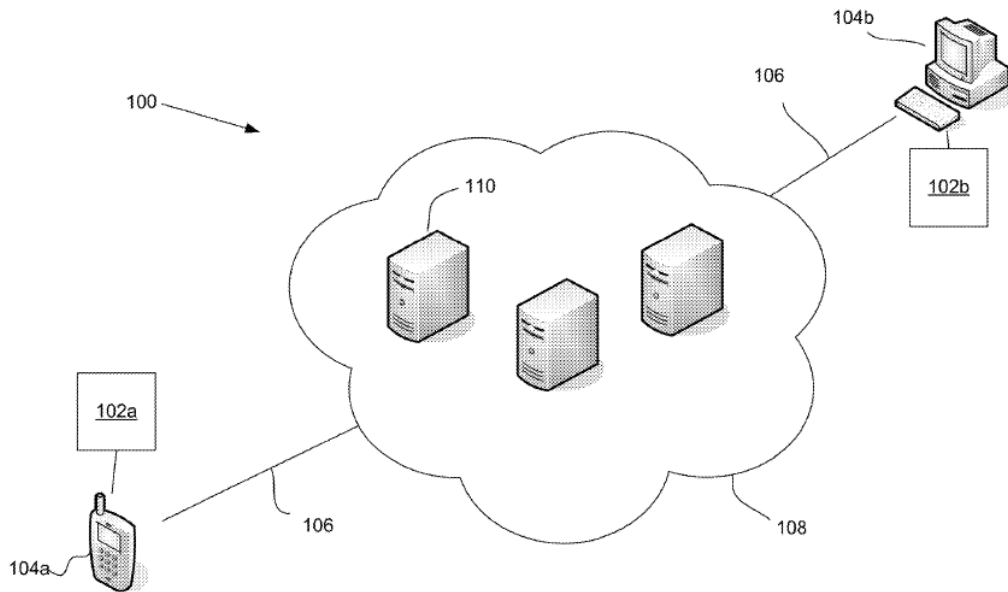


FIG. 1

Figure 1 is a diagram of telecommunications and media management system 100 that includes software applications 102a/102b that run on computing devices 104a/104b. *Id.* at 2:42–44, 3:53–57. The '028 patent explains the company that developed software applications 102a/102b may wish to enable users to communicate with one another over the internet, but the company does not have such a communication service. *Id.* at 3:57–62. In view of this, the company has embedded an embeddable software communications software module (not shown in Figure 1) into its software applications so devices 104a/104b and software applications 102a/102b may access telecommunication and media management system 100. *Id.* at 3:62–67. For instance, devices 104a/104b can use the embedded module and telecommunication and media management system 100 to communicate with one another via one or more networks 106 that connect devices 104a/104b to communication services network 108. *Id.* at 4:5–9.

We reproduce Figure 2A of the '028 patent below.

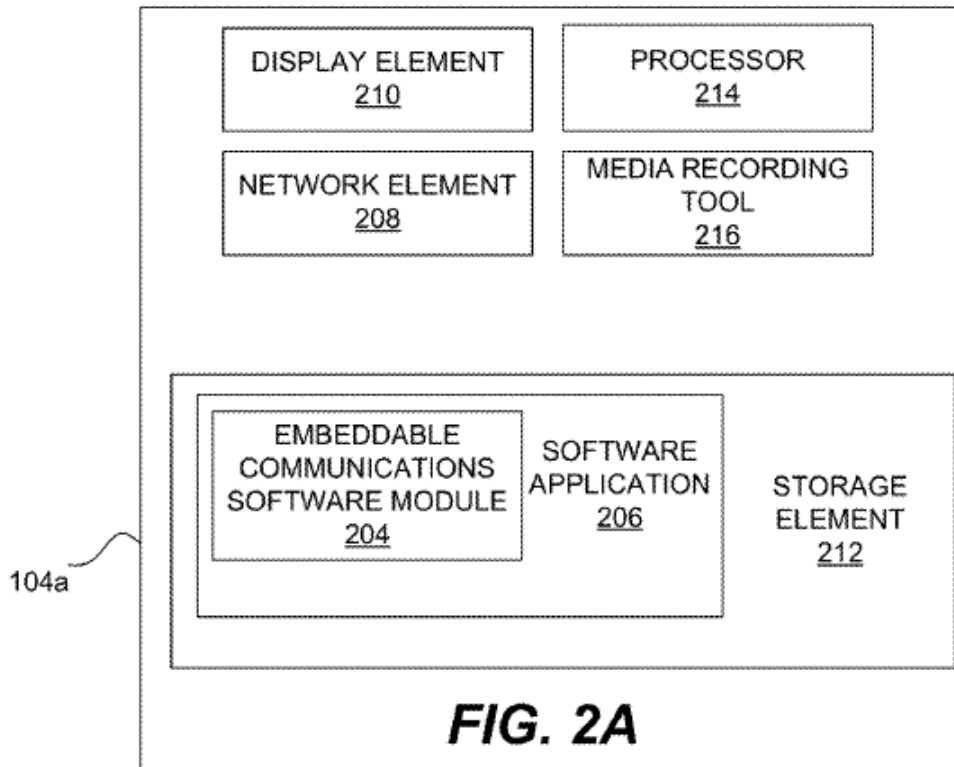


Figure 2A depicts device 104a with embeddable communications software module 204. *Id.* at 2:45–47, 4:40–42, 5:1–2. Device 104a includes network element 208, storage element 212, processor 214, media recording tool 216, and display element 210. *Id.* at 4:42–46. The '028 patent states that “[t]he software application **206** may be any suitable executable program” and “embeddable communications software module 204 is a distinct software module that manages some or all of device 104a’s communication features.” *Id.* at 4:60–61, 5:2–8. As a result, software application 206 can send commands to embeddable communications software module 204, which causes the latter to send, receive, process, or manage messages according to the commands. *Id.* at 5:11–14.

We reproduce Figure 2B of the '028 patent below.

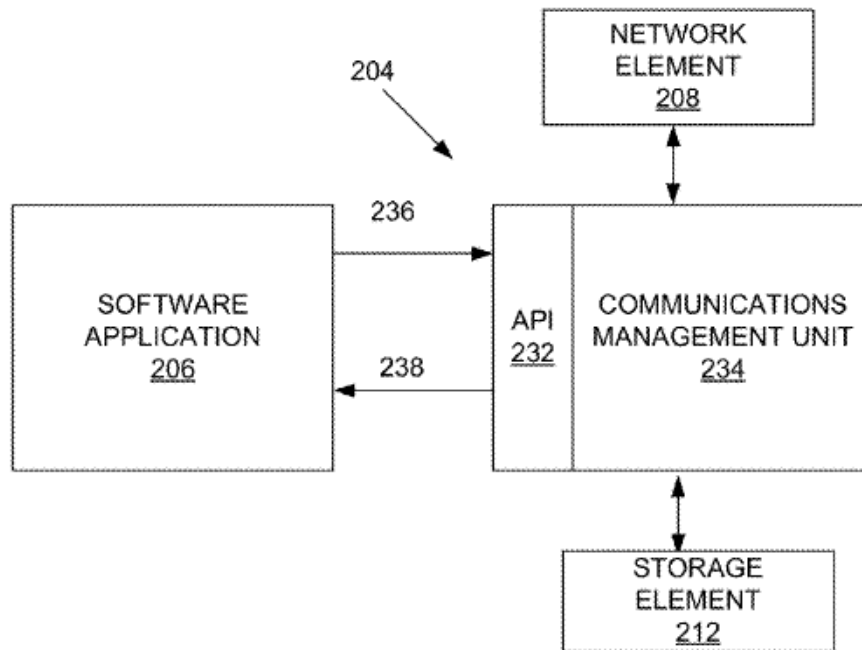


FIG. 2B

Figure 2B depicts software application 206 and embeddable communications software module 204. *Id.* at 2:48–51, 5:21–24.

Embeddable communications software module 204 and software application 206 interact with one another via application programming interface (API) 232¹ of embeddable communications software module 204. *Id.* at 5:21–26. Specifically, API 232 receives API inputs, commands, or calls from software application 206. *Id.* at 5:27–28. Embeddable communications software module 204 further includes communications management unit 234² that processes and executes the API commands or instructions. *Id.* at 5:37–39.

¹ The '028 patent's specification uses numeral 230 for the API, whereas Figure 2B uses numeral 232. For clarity purposes, we use numeral 232.

² The '028 patent's specification uses numeral 232 for the communications management unit, whereas Figure 2B uses numeral 234. For clarity, we use numeral 234.

The '028 patent further describes storing messages and progressive messaging. *Id.* at 3:20–22. For instance, a software application of a computing device may receive a message, such as an incoming voice call, and progressively store the message while it is being received. *Id.* at 3:22–26. “When a user is sending a message, such as an outgoing voice call, the device may also progressively transmit and store the message while it is being created.” *Id.* at 3:26–29. This enables a real time mode of operation, in which a user can receive and listen to calls in “(near) real time” because the message is progressively rendered as it is being progressively stored and received, and listen to calls in a time-shifted mode, in which a user can selectively render and review any stored message. *Id.* at 3:32–39.

C. Illustrative Claim

Petitioner challenges claims 1, 5, and 12 of the '028 patent. Claims 1 and 12 are independent claims. Claim 1 is illustrative of the claimed subject matter, and recites:

1. An embeddable communications software module that allows a software application to access a communications system providing both time delayed and near real time communication, the embeddable communications software module stored in a non-transitory tangible computer readable storage medium,

wherein the embeddable communications software module is arranged to:

provide an application programming interface (API) that allows the embeddable communications software module to receive API inputs from the software application, the embeddable communication software module and the software application communicating through the API;

receive an incoming message behavior policy from the software application, wherein the incoming message behavior

policy controls how the embeddable communications software module responds to incoming messages;
receive an incoming message from an remote communications device;
progressively store the incoming message as it is received;
in response to the received message, send a notification to the software application based on the incoming message behavior policy;
selectively render the incoming message in a near real time mode, wherein the near real time mode involves progressively rendering the incoming message as it is received;
selectively render the incoming message in a time-shifted mode, wherein the time shifted mode involves rendering the incoming message after the incoming message has been received and stored; and
determine whether to render the incoming message in the near real time mode or the time-shifted mode based at least in part on the incoming message behavior policy,
wherein the software application is separate from the communication system that is accessed through the embeddable communications software module.

Id. at 13:54–14:26.

D. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1, 5, and 12 are unpatentable based on the following grounds:

Claims Challenged	35 U.S.C. §	References/Basis
1, 5, 12	103 ³	Munje, ⁴ Rand ⁵
1, 5, 12	103	Bulthuis, ⁶ Pelttari ⁷

Pet. 3. Petitioner relies on the Declaration of Dr. Samrat Bhattacharjee (Ex. 1006) to support its asserted grounds of unpatentability. Patent Owner disputes that Petitioner’s asserted grounds render any of the challenged claims unpatentable. *See generally* Prelim. Resp.

III. DISCUSSION

A. Level of Ordinary Skill in the Art

Citing Dr. Bhattacharjee’s testimony, Petitioner contends that a person of ordinary skill in the art at the time of the invention “would have had at least a bachelor’s degree in computer science, computer engineering, or an equivalent degree, and 2–3 years of professional experience with distributed multimedia systems, with a working knowledge of computer networking and distributed systems generally and messaging and multimedia communication systems specifically.” Pet. 4 (citing Ex. 1006 ¶¶ 20–31). Patent Owner proposes that a person of ordinary skill in the art at the time of the invention:

would have [had] at least (1) a [Bachelor’s] degree in electrical or computer engineering or a related course of study with at least two years of work experience in industry in the areas of computer networking, multimedia processing, or a related area of work or (2) a Master’s degree in electrical or computer engineering or a

³ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Because the ’028 patent has an effective filing date after the effective date of the applicable AIA amendments, we refer to the AIA version of 35 U.S.C. § 103.

⁴ U.S. Patent App. Pub. No. 2006/0003740 A1, published Jan. 5, 2006 (Ex. 1002).

⁵ U.S. Patent No. 9,462,115 B2, issued Oct. 4, 2016 (Ex. 1003).

⁶ WO 03/015383 A2, published Feb. 20, 2003 (Ex. 1004).

⁷ WO 2010/136997 A1, published Dec. 2, 2010 (Ex. 1005).

related course of study, with at least one year of experience in industry in the areas of computer networking, multimedia processing, or a related area of work.

Prelim. Resp. 16. Patent Owner further states that “[t]he positions set forth in this preliminary response would be the same under either party’s proposal for the level of ordinary skill in the art.” *Id.* (citing Pet. 4).

To the extent necessary, and for purposes of this decision, we adopt Petitioner’s description of the level of ordinary skill in the art because it is consistent with the problems and solutions the ’028 patent identifies and the prior art. The parties’ positions on the level of ordinary skill in the art, however, are very similar, and our analysis would be the same under either party’s description.

B. Claim Construction

In an *inter partes* review, we construe claim terms according to the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc). 37 C.F.R. § 42.100(b) (2020). Under that standard, we construe claims “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.* Furthermore, we expressly construe the claims only to the extent necessary to determine whether to institute *inter partes* review. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Petitioner proposes constructions for the claim term “incoming message behavior policy” and the preambles of claims 1, 5, and 12. Pet. 20.

Petitioner proposes that we construe “incoming message behavior policy” as “received data indicating how the embeddable communications software module responds to incoming messages,” in accordance with the claim construction the district court adopted in the related litigation. *Id.* (citing Ex. 1008). Petitioner explains that the district court also concluded that the preambles of claims 1, 5, and 12 are limiting and construed the “embeddable communications software module” referenced in the preamble to have its plain and ordinary meaning. *Id.* (citing Ex. 1008).

Patent Owner agrees with Petitioner’s representations regarding the district court’s constructions, additionally noting that the district court determined that “embeddable communications software module” was not “subject to § 112 ¶ 6.” Prelim. Resp. 17–18 (citing Ex. 1008). Patent Owner further states that “[f]or purposes of this Response, Patent Owner has applied the plain meaning of all other claim terms.” *Id.* at 18.

For purposes of this decision, we adopt the district court’s construction of the preambles of claims 1, 5, and 12 as limiting. We need not construe the preambles further or construe any other claim term to resolve the parties’ disputes at this stage of the proceeding. *See Nidec*, 868 F.3d at 1017.

C. Asserted Obviousness over Munje and Rand

Petitioner contends that the subject matter of claims 1, 5, and 12 of the ’028 patent would have been obvious over Munje and Rand. Pet. 21–52. Petitioner relies on Dr. Bhattacharjee’s testimony in support of its showing. *Id.* (citing Ex. 1006). Patent Owner disagrees. Prelim. Resp. 28–43.

Before turning to the parties’ arguments, we provide a brief summary of the asserted references.

1. Munje (Ex. 1002)

Munje describes a “[m]ethod[] and apparatus for automatically recording Push-to-Talk (PTT) voice communications for replay in a mobile station.” Ex. 1002 ¶ 7. According to Munje:

[a] mobile station includes a wireless transceiver which operates with a wireless communication network; a processor; memory coupled to the processor; and a user interface which includes a Push-To-Talk (PTT) switch for transmitting a PTT voice communication through the wireless transceiver, a PTT replay switch for replaying a PTT voice communication previously received through the wireless transceiver which is stored in the memory, and a speaker for outputting audible voice signals.

Id.

Munje also discloses that the processor can record voice data of the PTT voice communication upon actuation of a PTT key message and halt recordation upon actuation of a PTT dekey message. *Id.* Upon actuation of a PTT replay switch, voice communications are retrieved from a memory and output at a speaker. *Id.* In addition, missed PTT communications “may be replayed by an end user.” *Id.* ¶ 8.

We reproduce Munje's Figure 2 below.

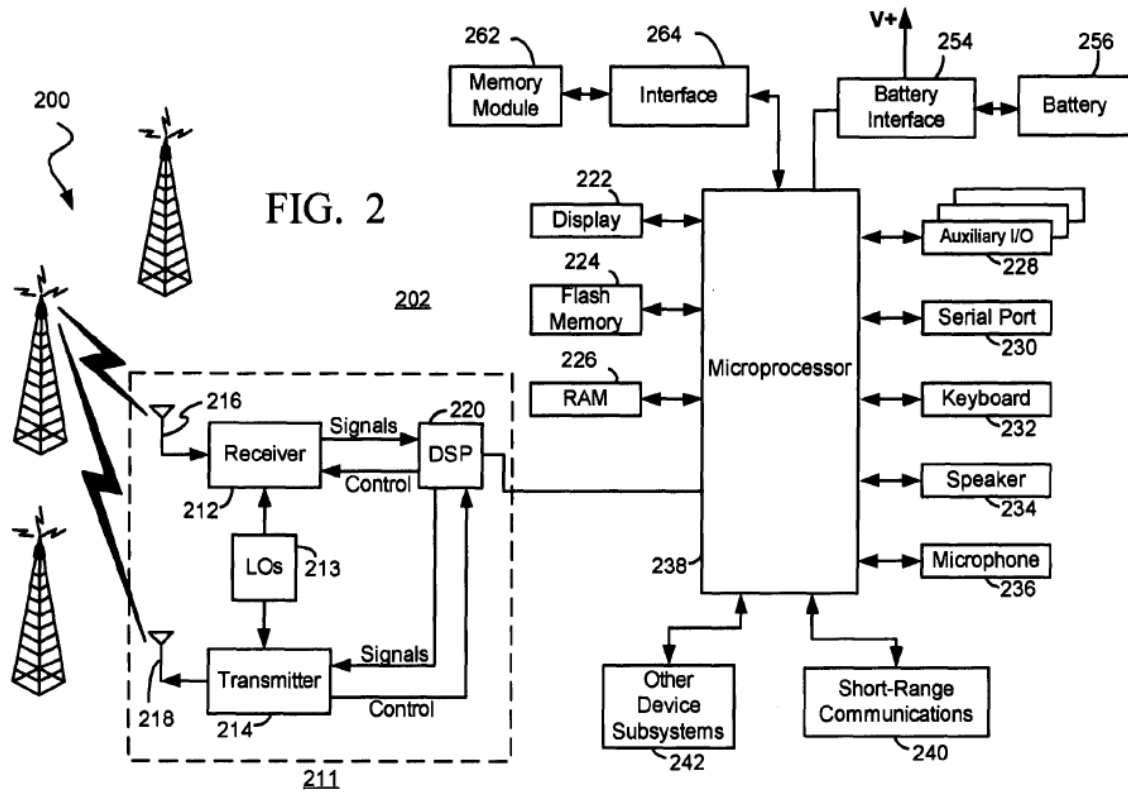


Figure 2 depicts a detailed block diagram of the pertinent components of a mobile station and a wireless communication network. *Id.* ¶¶ 10–11. Mobile station 202 includes communication subsystem 211, which may send and receive communication signals over a network, as well as process and encode incoming signals. *Id.* ¶¶ 33–34. Microprocessor 238 interacts with additional subsystems, including flash memory 224, random access memory (RAM) 226, and any other device subsystems generally 242. *Id.* ¶ 36.

We reproduce Munje's Figure 4 below.

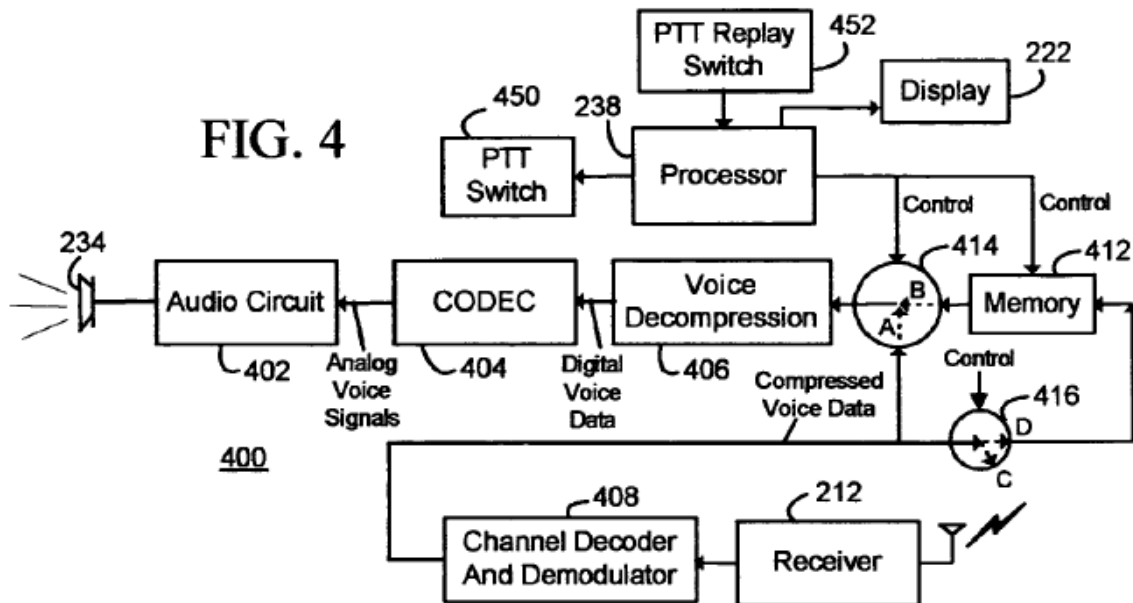


Figure 4 shows “a schematic block diagram of pertinent electrical components for the automatic recording of PTT voice communications for replay in the mobile station.” *Id.* ¶ 13. Electrical components 400 include processor 238, PTT communication switch 450 to initiate voice communications, PTT replay switch 452, and memory 412 used to store voice data of received voice communications. *Id.* ¶¶ 51, 53, 60.

2. Rand (Ex. 1003)

Rand “relates generally to telecommunications and more particularly to voice and audio communications.” Ex. 1003, 1:6–8. Rand describes several inefficiencies with electronic voice service: unscheduled calls can interrupt the recipient, traditional 2-way communication systems limit spontaneous discussion, existing communication systems are not unified, the need to interrupt audio from other applications to connect, the time needed to establish connections between parties, and the limitations on communications in public spaces where background music/noise is loud. *Id.* at 1:12–35.

To encourage spontaneous communication, Rand describes combining a number of features into a single, unified communications application aimed at addressing common problems traditional communication methods create. *Id.* at 2:25–28. We reproduce Rand’s Figure 9A below.

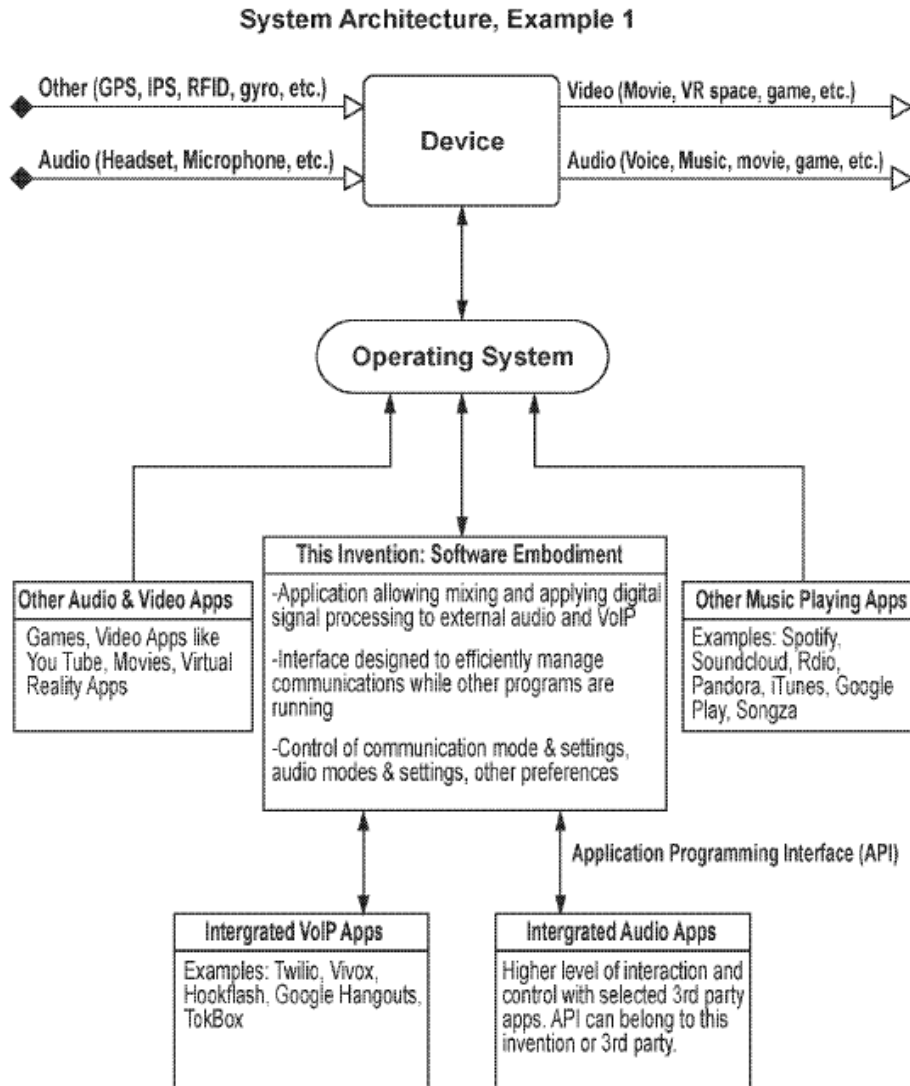


FIG. 9A

Figure 9A illustrates a relationship between a device, operating system, and a software application that serves as a software component of Rand’s invention (“the Application”). *Id.* at 8:22–25, 21:38–41. Rand discloses that

“[t]he Application could integrate with third party VoIP and Audio Apps through an Application Programming Interface (API), Software Development Kit (SDK), or other means,” whereas applications with a smaller degree of integration would communicate through the operating system. *Id.* at 21:41–46.

3. Claims 1, 5, and 12⁸

Petitioner contends that the combined teachings of Munje and Rand disclose each limitation of claims 1, 5, and 12. Pet. 21–52. Patent Owner argues that the combination of Munje and Rand fails to teach or suggest multiple limitations of claims 1 and 12, including “[a]n embeddable communications software module that allows a software application to access a communications system.” Prelim. Resp. 28–43. We focus our discussion on this limitation.

Claims 1 and 12 each recite “[a]n embeddable communications software module that allows a software application to access a communications system.” Ex. 1001, 13:54–56, 15:57–59. Petitioner contends that Munje alone discloses or suggests this limitation of claims 1 and 12. Pet. 21–28, 49. Petitioner relies on Rand for disclosing other limitations of claims 1, 5, and 12. *Id.* at 28–34, 44–50.

⁸ We discuss independent claim 1 and independent claim 12 together because both claims recite “[a]n embeddable communications software module that allows a software application to access a communications system.” *Compare* Ex. 1001, 13:54–56, *with id.* at 15:57–59; *see* Pet. 49 (Petitioner relying on its analysis for claim 1 to show that Munje discloses claim 12’s preamble); *see also, e.g.*, Prelim. Resp. 28–33 (addressing claims 1 and 12 together). Claim 5 depends from claim 1 and, therefore, includes the limitations of claim 1. Ex. 1001, 14:45–58.

Regarding the limitation at issue, Petitioner contends Munje discloses automatically recording Push-To-Talk (PTT) voice communications for replay in a mobile station and that this mobile station “can be implemented with **software modules**.” Pet. 21–22 (citing Ex. 1002 ¶¶ 4, 13, 51–55, Fig. 4; Ex. 1006 ¶ 88). According to Petitioner, Munje explains that its automatic record and replay method “‘may be embodied in a computer program product,’ which in turn includes multiple ‘computer instructions stored in a storage medium,’—a POSITA would have understood that this can constitute a **software module or modules**.” *Id.* at 22–24 (citing Ex. 1002 ¶¶ 66–78, claim 19, Fig. 6; Ex. 1006 ¶ 88). Petitioner contends that Munje discloses a communications software module that is embeddable because Munje teaches that its method “‘may be embodied in a computer program product’ which comprises various ‘computer instructions’ that are performed by ‘processors of the mobile station.’” *Id.* at 24 (citing Ex. 1002 ¶ 66, claim 19; Ex. 1006 ¶ 90).

Petitioner further argues that Munje’s “module is an embeddable software **communications** module because it sends, receives, records, stores, and otherwise enables communications” and because Munje additionally discloses a communications system. *Id.* at 24–25 (citing Ex. 1002 ¶¶ 7, 26, 35, 80, claims 10, 19; Ex. 1006 ¶¶ 89, 92). And Petitioner asserts that Munje teaches software applications that include a user interface and discloses various third party integrated software applications. *Id.* at 25–26 (citing Ex. 1002 ¶¶ 37–38, 58, 60, 68, claims 10, 19, 20, Figs. 6, 8; Ex. 1006 ¶¶ 93–94).

Petitioner also contends that Munje’s module allows a software application to access at least one communications system that provides time-delayed communication and at least one communication system that

provides near real-time communication. *Id.* at 26–27 (citing Ex. 1002 ¶¶ 54, 66, 68, claims 10, 19, 20, Figs. 2, 6; Ex. 1006 ¶¶ 95–97).

As noted above, Petitioner refers back to these arguments for claim 12’s corresponding limitation. *Id.* at 49.

Patent Owner responds that, even when combined, Munje and Rand fail to disclose an embeddable communications software module. Prelim. Resp. 28. Patent Owner asserts that “the claimed embeddable communications software module is not coextensive with the claimed software application” and that “citations or argument that tend to show the existence or operation of a software **application** do not necessarily show the existence or operation of a claimed embeddable communications software **module**.” *Id.* at 29–30 (citing Ex. 1001, 3:10–12, 3:62–67).

Patent Owner further contends that “the Petition fails to establish that Munje discloses an embeddable communications software module.” *Id.* at 30 (citing Pet. 21–28). Specifically, Patent Owner asserts that Petitioner does not sufficiently identify “what it contends are the particular claimed ‘embeddable communications software module’ and the particular claimed ‘software application’ in Munje.” *Id.* at 31 (citing Pet. 21–28). Patent Owner argues that Petitioner’s arguments fail to describe the structure or organization of a module, including how it would qualify as the claimed “embeddable communications software module.” *Id.* Patent Owner contends that “Petitioner cites to its expert declaration, but that material simply mirrors the content of the Petition with no additional explanation.” *Id.* (citing Ex. 1006 ¶¶ 86–98).

Patent Owner also asserts that Petitioner’s citation to Munje’s Figure 4 is unavailing because “[n]othing in Figure 4 relates to the internal organization of Munje’s software.” *Id.* at 31–32 (citing Ex. 1002 ¶ 13).

Patent Owner contends that Figure 6 likewise does not support Petitioner's arguments because it is a flowchart for a method of automatically recording PTT voice communications for replay with a mobile station. *Id.* at 32 (citing Ex. 1002 ¶ 15). Patent Owner also argues that Munje's paragraph 66 "simply confirms that Munje's techniques are implemented in a **software application**, not an **embeddable communications software module**." *Id.* (citing Ex. 1002 ¶ 66). According to Patent Owner, "Munje does not disclose an embeddable communications software module. Munje only describes the operation of a single relevant communications application running on a mobile device." *Id.* at 33.

On the record before us, we are not persuaded Petitioner shows sufficiently that Munje discloses or suggests "[a]n embeddable communications software module that allows a software application to access a communications system." Petitioner first cites Munje's disclosure of "automatically recording Push-To-Talk (PTT) voice communications for replay in a mobile station" described in Figure 4. Pet. 21–22 (citing Ex. 1002 ¶ 7, Fig. 4). We agree with Patent Owner, however, that Figure 4 schematically depicts electrical components for a mobile station, not an embeddable communications software module. Prelim. Resp. 29, 31–32 (citing Ex. 1002 ¶ 13).

Petitioner then argues that Munje discloses implementing the mobile station via software modules, citing the method Munje's Figure 6 depicts. *Id.* at 22–23 (citing Ex. 1006 ¶ 88). Petitioner argues that Munje discloses that this method "may be embodied in a computer program product," which in turn includes multiple "computer instructions stored in a storage medium," and one of ordinary skill in the art "would have understood that

this can constitute a **software module** or **modules.**” *Id.* at 23 (quoting Ex. 1002 ¶¶ 66–78, claim 19; Ex. 1006 ¶ 88).

Here again, we agree with Patent Owner that Munje’s Figure 6 “is a *flowchart* for describing a method of automatically recording PTT voice communications for replay in a mobile station” and does not relate to the internal organization of Munje’s software. Prelim. Resp. 32 (citing Ex. 1002 ¶ 15). Munje discloses that the method Figure 6 depicts “may be embodied in a computer program product which includes a storage medium (e.g. computer disk or memory) and computer instructions stored in the storage medium” and “[t]hese computer instructions are performed by one or more processors of the mobile station.” Ex. 1002 ¶ 66. Similarly, Munje’s claim 19 recites a computer program that comprises a storage medium and computer instructions stored in the storage medium. These disclosures relate to a computer program that can be stored on a storage medium and instructions of the program that mobile station processors may execute. Petitioner, however, does not sufficiently explain how this language discloses or suggests *a communications software module that is embeddable with a software application*, as the challenged claims require. The remaining paragraphs that Petitioner cites (i.e., Munje’s paragraphs 67–78) describe the steps Figure 6 depicts, or the method Figure 7 depicts, which relates to the replay of previously recorded voice communications, and do not support Petitioner’s position.

Petitioner also cites Munje’s paragraphs 37 and 38 to support its argument that Munje discloses various third-party and integrated software applications. Pet. 26. Paragraph 37 discloses that a mobile station’s microprocessor enables execution of the mobile station’s software. Paragraph 37 further teaches that “[a] predetermined set of applications

which control basic device operations, including at least data and voice communication applications, will normally be installed on mobile station **202** during its manufacture” and “[a] preferred application that may be loaded onto mobile station **202** may be a personal information manager (PIM) application having the ability to organize and manage data items relating to user such as, but not limited to e-mail, calendar events, voice mails, appointments, and task items.” These disclosures relate to software applications, such as those for communication functions, but Petitioner does not sufficiently explain how they suggest a communications software module that is embeddable with a software application, as claims 1, 5, and 12 recite.

Munje’s paragraph 38 discloses that “[t]he PIM application preferably has the ability to send and receive data items via the wireless network” and “[i]n a preferred embodiment, PIM data items are seamlessly integrated, synchronized, and updated via the wireless network, with the mobile station user’s corresponding data items stored and/or associated with a host computer system thereby creating a mirrored host computer on mobile station **202** with respect to such items.” This teaches that PIM data items are integrated seamlessly with a mobile station user’s corresponding data items. Petitioner’s arguments, however, do not explain how integrated data items equate to a communications software module that is embeddable with a software application.

Petitioner’s remaining arguments relate to software applications, the embeddable module’s operations, and the storage of the embeddable module, as recited in the preambles of claims 1 and 12. Pet. 24–28. These arguments, however, do not remedy the deficiencies we discuss above

because they do not adequately explain how Munje discloses or suggests the claimed embeddable communications software module.

Petitioner cites Dr. Bhattacharjee's declaration to support its arguments. Pet. 21 (citing Ex. 1006 ¶¶ 86–98). Dr. Bhattacharjee's arguments, however, mirror the arguments set forth in the Petition and do not provide further support for Petitioner's position that Munje discloses or suggests "[a]n embeddable communications software module that allows a software application to access a communications system." Thus, Petitioner fails to show how Munje discloses or suggests this limitation.

For all of the foregoing reasons, Petitioner fails to demonstrate a reasonable likelihood of prevailing in its assertion that the subject matter of claims 1 and 12 would have been obvious over the combination of Munje and Rand. Further, because claim 5 depends from claim 1, Petitioner also fails to demonstrate a reasonable likelihood of prevailing in its assertion that claim 5 would have been obvious over the combination of Munje and Rand.

D. Asserted Obviousness over Bulthuis and Pelttari

Petitioner contends that the subject matter of claims 1, 5, and 12 of the '028 patent would have been obvious over Bulthuis and Pelttari. Pet. 52–75. Petitioner relies on Dr. Bhattacharjee's testimony in support of its showing. *Id.* (citing Ex. 1006). Patent Owner disagrees. Prelim. Resp. 43–51.

Before turning to the parties' arguments, we provide a brief summary of the asserted references.

1. Bulthuis (Ex. 1004)

Bulthuis relates to recording real-time communications, particularly in the field of consumer electronics. Ex. 1:12–13. Bulthuis explains that automatically recording real-time communication in response to a user initiating or accepting a real-time communication permits the stored

communication to serve as a memory aid or permits the stored communication to be forwarded to additional individuals. *Id.* at 1:20–23. Bulthuis further discloses that its invention can be integrated with a communication device, such as a mobile phone. *Id.* at 2:5–6.

Bulthuis describes a consumer electronics communication device adapted to enable real-time communication and recording of the communication. *Id.* at 2:8–11. The device includes at least one user interface mechanism for providing real-time audio and/or visual information to a user and to receive real-time audio and/or visual information from the user. *Id.* at 2:11–13. The device may further include a user input to enable the user to select a portion of the real-time communication for recording. *Id.* at 2:13–15. For instance, a user may hold down a “record” key on the device to record a piece of information, such as when the user is discussing an issue via the device with another party. *Id.* at 2:15–20.

Bulthuis also discloses a module with storage for coupling with the communication device to enable recording of real time communications. *Id.* at 4:20–21. Bulthuis explains that the module is controllable via a device’s user interface. *Id.* at 4:23. A storage medium that a data processing device can read may carry software that detects initiation or acceptance of a live communication, records the live communication, and forwards the recording to a remote destination. *Id.* at 4:31–5:3.

2. Pelttari (Ex. 1005)

Pelttari “relates to communicating audio content over a network, and more specifically to audio content that is transmitted from a sending terminal and automatically received by one or more recipient communication terminals.” Ex. 1005 ¶ 2. Pelttari describes a recipient communication terminal that includes a receiver configured to automatically identify and

accept an incoming audio call over a telephone channel. *Id.* ¶ 12. The incoming call includes identification parameters relating to a category pertaining to the content of the call. *Id.* The terminal further includes a recording operatively coupled to the receiver and configured to automatically store the audio content in one or more content stores that are specific to the category of the content. *Id.*

For example, Pelttari discloses that identification parameters relating to the audio content category may be received in the form of Dual Tone Multi Frequency (DTMF) tones, which can be decoded to identify the category. *Id.* ¶ 44. If a terminal does not support the category, an alert may be produced or the audio content may be discarded or stored as an audio file. *Id.* Pelttari explains that one exemplary category is a voice message, in which case the audio content is stored in a voice message store. *Id.* Other categories are a media / music file, which has its audio content stored in a music store, and an advertisement, which has its audio content stored in an advertisement store. *Id.* Pelttari further describes identifying the category of audio content via an API. *Id.* ¶ 45.

Pelttari discloses that the logical units of its invention include software and hardware components and each logical unit “may comprise within itself one or more components which are implicitly understood.” *Id.* ¶ 40. Pelttari explains that such components may be operatively coupled to each other and configured to communicate with one another to perform a unit’s function. *Id.*

3. Claims 1, 5, and 12⁹

Petitioner contends that the combined teachings of Bulthuis and Pelttari disclose each limitation of claims 1, 5, and 12. Pet. 52–75. Patent Owner argues that Petitioner’s asserted combination of Bulthuis and Pelttari fails to teach or suggest multiple limitations of claims 1 and 12, including “[a]n embeddable communications software module that allows a software application to access a communications system.” Prelim. Resp. 43–51. We focus our discussion on this limitation.

As noted above with regard to the ground over Munje and Rand, claims 1 and 12 each recite “[a]n embeddable communications software module that allows a software application to access a communications system.” Ex. 1001, 13:54–56, 15:57–59. Petitioner contends that Bulthuis alone discloses or suggests this limitation of claims 1 and 12. Pet. 53–55, 72. Petitioner cites Pelttari for other limitations of claims 1, 5, and 12. *Id.* at 55–59, 62–64, 67–71, 73.

Petitioner argues that Bulthuis discloses the limitation in question because its “‘invention uses a *module* with a storage for coupling with the communication device for enabling recording of the real time communication,’ and this module (contained in the ‘consumer electronics communication device’) is **embeddable** as it ‘is *controllable* via a user-interface of the device.’” *Id.* at 53 (citing Ex. 1004, 2:8–9, 4:20–30, claim 18; Ex. 1006 ¶¶ 157–162). Petitioner asserts that Bulthuis also discloses software applications and user interfaces for interacting with a

⁹ As with Petitioner’s obviousness combination over Munje and Rand, we discuss claims 1, 5, and 12 together. *See* Pet. 72 (Petitioner relying on its analysis for claim 1 to show that Bulthuis discloses claim 12’s preamble); *see also, e.g.*, Prelim. Resp. 43–48 (addressing claims 1 and 12 together).

device. *Id.* at 54 (citing Ex. 1004, 2:8–20, 4:4–6, 7:16–17, 11:9–17, claim 18; Ex. 1006 ¶ 160).

Petitioner further contends that Bulthuis’s modules enable access to a communications system, Bulthuis provides both time delayed and near real time communication, and Bulthuis discloses storing its module in a non-transitory tangible computer readable storage medium. *Id.* at 53–55 (citing Ex. 1004, 2:9–11, 2:25–28, 3:10–11, 4:20–27, 4:31–5:3 5:15–17; Ex. 1006 ¶¶ 159, 161–162); *see id.* at 72 (claim 12).

Patent Owner responds that “Petitioner only identifies Bulthuis as disclosing an embeddable communications software module” but “Petitioner’s invalidity theory for this limitation is fatally flawed because Petitioner points to a *hardware* ‘module’ described in Bulthuis that *is used exclusively for data storage* as meeting this limitation.” Prelim. Resp. 44 (citing Pet. 53–55). Patent Owner contends that Bulthuis’s “‘module’ is an internal or external specialized storage hardware.” *Id.* at 44–46 (citing Ex. 1004, 2:25–29, 2:33–3:3, 4:20–30, 8:31–9:6, claim 15). Patent Owner argues that “[t]his is the only “module” of any sort disclosed in Bulthuis . . . [b]ut Bulthuis’ storage hardware module cannot meet the claim limitation.” *Id.* at 46 (citing Pet. 53–55).

Specifically, Patent Owner explains that “the claimed ‘embeddable communications software module’ is a *software* module, not a *hardware* module like in Bulthuis” and the portion of Bulthuis Petitioner cites (i.e., 4:31–5:3) “*describes the software application software running on the cell phone.*” *Id.* at 46–47 (citing Ex. 1001, 5:1–9; Pet. 55). Patent Owner also asserts that, even if Bulthuis’s hardware storage module runs the disclosed routines, “the code is described as being strictly limited to ‘detecting initiation or acceptance of a live communication by a user of a consumer

electronics communication device; and recording the live communication.”
Id. at 47–48 (citing Ex. 1004, 4:31–5:3).

Petitioner’s arguments are insufficient to explain how Bulthuis discloses or suggests the claimed embeddable communications software module. Bulthuis discloses that its “invention relates to a consumer electronics communication device.” Ex. 1004, 2:8–9. This disclosure only relates to a user’s device, not an embeddable communications software module.

In addition, Bulthuis teaches that its invention “uses a module with a storage for coupling with the communication device for enabling recording of the real time communication.” *Id.* at 4:20–21. Bulthuis further explains how the module can be coupled with a user’s device, how the module can be controlled by the user interface of the device, how the module can include at least one organizational mechanism for organizing recorded communications in a retrievable form, and that the module preferably includes an opt-out mechanism to stop recordings of particular communications. *Id.* at 4:21–30. We agree with Patent Owner that these disclosures relate to a hardware module for data storage, not an embeddable communications software module. Prelim. Resp. 44 (citing Pet. 53).

Bulthuis does describe a “communication,” and its claim 18 recites a software application that enables a programmable device, when executing the software application, to function as a device according to Bulthuis’s claims 1–9. Ex. 1004, 5:15–17, 14:1–2. These disclosures relate to communication functions and to software applications, but Petitioner does not sufficiently explain how they, or the other portions of Bulthuis Petitioner cites, disclose or suggest “[a]n embeddable communications software

module that allows a software application to access a communications system.”

Petitioner’s remaining arguments relate to software applications, the embeddable module’s operations, and storing the embeddable module, as the preambles of claims 1 and 12 recite. Pet. 54–55. These arguments, however, do not remedy the deficiencies we identify above by adequately explaining how Bulthuis discloses or suggests the claimed embeddable communications software module.

Petitioner cites Dr. Bhattacharjee’s declaration to support its arguments. Pet. 53 (citing Ex. 1006 ¶¶ 157–162). Similar to the arguments for the ground over Munje and Rand, Dr. Bhattacharjee’s arguments mirror the arguments set forth in the Petition and do not provide further support for Petitioner’s position that Bulthuis discloses or suggests “[a]n embeddable communications software module that allows a software application to access a communications system.” Thus, Petitioner fails to show how Bulthuis discloses or suggests this limitation.

For all of the foregoing reasons, Petitioner fails to demonstrate a reasonable likelihood of prevailing in its assertion that the subject matter of claims 1 and 12 would have been obvious over the combination of Bulthuis and Pelttari. Further, because claim 5 depends from claim 1, Petitioner also fails to demonstrate a reasonable likelihood of prevailing in its assertion that claim 5 would have been obvious over the combination of Bulthuis and Pelttari.

IV. CONCLUSION

Taking account of the information presented in the Petition and the Preliminary Response, and the evidence of record, we determine that

Petitioner fails to demonstrate a reasonable likelihood of prevailing at trial as to any challenged claim. Accordingly, we deny the Petition, and do not institute trial.

V. ORDER

Accordingly, it is

ORDERED that the Petition is *denied*, and no trial is instituted.

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