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Paper 8
Entered: January 10, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CLOUD9 TECHNOLOGIES LLC,
Petitioner,

v.

IPC SYSTEMS, INC.,
Patent Owner.

Case IPR2017-01615
Patent 8,189,566 B2

Before JENNIFER S. BISK, JEREMY J. CURCURI, and MIRIAM L. QUINN, *Administrative Patent Judges.*

CURCURI, *Administrative Patent Judge.*

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

Petitioner, as captioned above, filed a Petition to institute *inter partes* review of claims 1, 5–7, 11–13, 17, and 18 of Patent No. 8,189,566 B2 ("the '566 patent") pursuant to 35 U.S.C. §§ 311–319. Paper 1 ("Pet."). IPC Systems, Inc. ("Patent Owner") timely filed a Preliminary Response. Paper 7 ("Prelim. Resp."). We have authority under 35 U.S.C. § 314.

For the reasons that follow, we do not institute *inter partes* review.

I. BACKGROUND

A. RELATED MATTERS

Petitioner identifies that the '566 patent is the subject matter of a district court case filed in the U.S. District Court for the District of Delaware (Case No. 1:16-cv-00443-GMS). Pet. 1. Petitioner also identifies that the '566 patent has been involved in a covered business method patent review (CBM2017-00037). *Id.*

B. ASSERTED PRIOR ART AND GROUNDS

Petitioner identifies the following references as prior art to claims 1, 5–7, 11–13, 17, and 18 ("the challenged claims") of the '566 patent:

1) *Greene*: U.S. Patent No. 6,212,177 B1 (Exhibit 1005);
2) *SIP:* SIP: Session Initiation Protocol, RFC 3261 (Exhibit 1008); and
3) *Kammerer*: U.S. Publication No. 2004/0205175 A1 (Exhibit 1006).

Petitioner contends that the challenged claims are unpatentable under 35 U.S.C. § 103 based on the following specific grounds (Pet. 4):

References	Basis	Claims challenged
Greene and SIP	§ 103	1, 5–7, 11–13, 17, and 18
Greene, Kammerer, and SIP	§ 103	1, 5–7, 11–13, 17, and 18

C. THE '566 PATENT (EX. 1001)

The '566 patent is directed to telecommunication systems, and more particularly to key telephone systems and trading turrets. Ex. 1001, 1:14–16. The '566 patent describes a trading turret system as follows,

> A trading turret system is a specialized telephony switching system that allows a relatively small number of users to access a large number of external lines and provides enhanced communication features such as hoot-n-holler, push-to-talk, intercom, video and large-scale conferencing. These features are often utilized in the financial industry such as trading floor environments, as well as security/law enforcement, utilities, healthcare, and customer support (e.g., contact centers) environments.

Id. at 1:18–26. The patent describes that the advent of Voice over IP (VoIP) has allowed for VoIP turret devices to become "virtualized and remotely accessible" allowing trader mobility and use in disaster recovery planning. *Id.* at 1:54–62. "Soft-phones," or "soft-turrets," in those VoIP devices, however, rely on an external media bridge and require a hard turret to be dedicated to the remote trader. *Id.* at 2:8–16. The '566 patent describes a turret switching system connected to a private wire network and a phone connected to the public switched telephone network. *Id.* at 4:12–14. A personal computer running a soft-turret application renders a turret display on the PC. *Id.* at 4:23–26. This application subscribes to a Web server, which delivers line status change notifications to the soft-turret. *Id.* at

27–29. The turret switching system includes station cards that receive button presses from the soft-turret and bridges the left and right handset inside the media bridge, eliminating the need for an external media bridge or a dedicated hard-turret. *Id.* at 4:46–51. Figure 2 illustrates media bridge 216 as part of turret switching system 214. *Id.* at Fig. 2.

D. ILLUSTRATIVE CLAIMS

Challenged claims 1, 7, and 13 are independent and are reproduced below.

1. A communications system, comprising:

   a turret switching system constructed to communicate to a Web server, a turret device, and to a remote communications device via a first communications network, the Web server being constructed to communicate to a client device via a second communications network, and the client device constructed to control switching across a plurality of lines; and

   an interface having a button sheet corresponding to a plurality of line selectors and constructed to seize a corresponding line by causing the client device to communicate a predetermined message to the turret switching system over the second communications network.

7. A non-transitory computer-readable medium having stored thereon sequences of instructions, the sequences of instructions including instructions which when executed by a computer system causes the computer system to:

   communicate to a Web server, a turret device, and to a remote communications device via a first communications network;

   communicate to a client device via a second communications network;

   control switching across a plurality of lines; and

seize a corresponding line by causing the client device to communicate a predetermined message to a turret switching system over the second communications network.

13. A method for providing a software based trading turret, comprising the steps of:

communicating, by a turret switching device, to a Web server, a turret device, and a remote communications device, via a first communications network;

communicating, by the turret switching device, to a client device via a second communications network;

controlling switching across a plurality of lines, by the turret switching device; and

seizing a corresponding line by communicating a predetermined message to a turret switching system over the second communications network.

II. ANALYSIS

A. CLAIM INTERPRETATION

The '566 patent is not expired. The Board construes claims of unexpired patents using the broadest reasonable interpretation. *See Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard); 37 C.F.R. § 42.100(b). We note that Petitioner proposed specific claim constructions for the terms "predetermined message" and "trading turret." Pet. 12–13. Patent Owner does not dispute these claim constructions. Prelim. Resp. 6. We find Petitioner's constructions of terms reasonable, and adopt them as our own. That is, we construe "predetermined message" to include a message containing information identifying particular turret resources and functionality available on the turret to be performed (e.g., seize one or more

specific lines) that is delivered in a communication protocol understood by the turret switching system. We construe "trading turret" to include an advanced telephony system that can be used in the financial industry by traders, but can be used also in a variety of other industries.

B. Discretionary Non-Institution

Petitioner acknowledges that "Greene was applied by the Examiner in an anticipation rejection of the pending claims in the sole Office Action during the prosecution of the application that led to the '566 Patent." Pet. 20. Petitioner further acknowledges that "Kammerer was neither cited to the USTPO nor applied by the USPTO during the prosecution of the application that led to the '566 Patent." Pet. 20. Finally, Petitioner acknowledges that SIP was "acknowledged in the background section of the '566 Patent." Pet. 20.

Section 325(d) states that "[i]n determining whether to institute . . . the Director may take into account whether . . . the same or substantially the same prior art or arguments previously were presented to the Office." Thus, the threshold issue is whether the grounds identified in the Petition present the same or substantially the same prior art or arguments as those presented during examination.

When evaluating whether the same or substantially the same prior art or arguments previously were presented to the Office under section 325(d), we have considered some of the following non-exclusive factors:

1) The similarity of the asserted art and the prior art involved during examination;
2) The extent to which the asserted art was considered during examination, including whether the prior art was the basis for

rejection;

3) The cumulative nature of the asserted art and the prior art considered during examination;
4) Whether Petitioner has pointed out sufficiently how the Examiner erred in its consideration of the asserted prior art;
5) The extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art; and
6) The extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art.[1]

Each case is evaluated on its own facts. Our rules and procedures

[1] *See, e.g.*, *Palo Alto Networks v. Finjan*, Case IPR2015-01999, slip op. at 6–8 (PTAB Mar. 29, 2016) (Paper 7) (evaluating the similarities between the asserted art and the references relied on during examination and determining the extent arguments considered during examination); *Agrinomix v. Mitchell Ellis Prods.*, Case IPR2017-00525, slip op. at 11 (PTAB June 14, 2017) (Paper 8) (determining whether asserted prior art was before Examiner during prosecution); *Inogen v. Separation Design Group IP Holdings*, Case IPR2017-00300, slip op. at 31–33 (PTAB May 19, 2017) (Paper 8) (considering whether the asserted art is cumulative of any reference that previously was before the Office); *Dorco Co. v. The Gillette Co*., Case IPR2017-00500, slip op. at 18–19 (PTAB June 21, 2017) (Paper 7) (considering whether Petitioner identifies errors by the Office or explanation of why the Office should revisit the patentability issues considered by the Examiner, and also considering the overlap of arguments); *Hyundai Mobis Co. et al. v. Autoliv ASP*, Case IPR2014-01005, slip op. at 44–45 (PTAB Jan. 14, 2015) (Paper 10) (stating that Petitioner's challenge includes new arguments and new supporting evidence, such as expert testimony, shedding a different light on the prior art); *Prism Pharma v. Choongwae Pharma Corop.*, Case IPR2014-00315, slip op. at 12–13 (PTAB July 8, 2014) (Paper 14) (evaluating the overlap of the arguments in examination and the contentions presented by Petitioner).

"shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding." *See* 37 C.F.R § 42.1(b).

When considering all the above factors and the parties' arguments, we find that the Petition presents substantially the same prior art or arguments previously presented to the Office with regard to all the grounds.

Greene was considered during examination, and was the basis for the sole prior art-based rejection during examination of the claims in the '566 patent. The Examiner rejected original claims 1, 2, 7–9, 14–16, and 21 as anticipated by Greene, and objected to original claims 3–6, 10–13, and 17–20 for depending upon rejected base claims. *See* Ex. 1002, 54–55.

In the rejection based on Green, the Examiner found Green does not disclose certain subject matter of original claim 3: "seize a corresponding line by causing the client device to communicate a predetermined message to the turret switching system over the second communications network"; the subject matter of original claim 10: "seize a corresponding line by causing the client device to communicate a predetermined message to a turret switching system over the second communications network"; or the subject matter of original claim 17: "seizing a corresponding line by communicating a predetermined message to a turret switching system over the second communications network." *See* Ex. 1002, 55 (finding claims 3, 10, and 17 contain allowable subject matter); *see also* Ex. 1002, 29–31 (original claims 3, 10, and 17). In response to the rejection, original claim 1 was amended to incorporate the subject matter of original claim 3, original claim 8 was amended to incorporate the subject matter of original claim 10, and original claim 15 was amended to incorporate the subject matter of original claim 17. *See* Ex. 1002, 66–68. Amended claims 1, 8, and 15 as

well as original claims 2, 4–7, 9, 11–14, 16, and 18–21 were allowed. *See* Ex. 1002, 80. Accordingly, we find the Examiner considered Greene substantively and was aware of its contents during the examination of the claims of the '566 patent.

Petitioner asserts that Greene discloses issued claim 1's subject matter: "seize a corresponding line by causing the client device to communicate a predetermined message to the turret switching system over the second communications network." *See* Pet. 26–28, 53–55. According to Petitioner,

> it would be understood that, in order for the system to properly operate, a selection of a line via the line status display would cause the transmission of a data packet (e.g., a predetermined message) to be transmitted to the turret switching system (office switching network 10) to seize the corresponding line.

Pet. 28 (citing Ex, 1003 (Declaration of David Lucantoni, Ph.D.), ¶ 117).

However, in the Office Action, the Examiner found:

> Greene et al disclose a remote operator (applicant's client device), col. 1, line 45, who may place calls by clicking on his ringing screen or place calls to a remote party by clicking on his screen. By clicking on the screen to answer or place calls, the remote operator is controlling switching across a plurality of lines. Greene et al disclose turret devices 12 & 13, a web server 29 that connects to the client device 20 of the remote operator through the 2nd communications network 26, col. 2, lines 50–54.

Ex. 1002, 55.

Accordingly, we find the Examiner did consider Greene's disclosure of selection of a line via the line status display of Greene's Figure 2 when finding original claims 3, 10, and 17 contain allowable subject matter. And we have been presented with no persuasive reasoning showing Examiner

error that would warrant reconsidering Greene.

The instant Petition further relies on SIP and alternatively on Kammerer for disclosing the particulars of the "predetermined message" recited in the claims. *See* Pet. 29 ("the SIP INVITE message"), 55 ("Kammerer discloses the use of SIP as its preferred messaging format").

However, the '566 Patent discloses:

> With the introduction of Session Initiation Protocol ("SIP") based architectures, new features and interoperability with a wide variety of SIP enabled devices is possible. SIP is an application-layer control (i.e., signaling) protocol for creating, modifying, and terminating sessions such as Internet telephony calls with one or more participants and is defined in RFC-3261, "SIP: Session Initiation Protocol". SIP has been used in typical IP based networks as the predominant way of signaling between stations and telephony systems and as the trunking protocol between telephony systems. SIP also can be used in conjunction with other protocols such as Session Description Protocol "SDP" and Real-Time Protocol "RTP" to provide communications services.

'566 Patent, col. 1, ll. 41–53.

Thus, Session Initiation Protocol (SIP) was presented to the Examiner as admitted prior art. To the extent the SIP INVITE message may or may not disclose the particulars of the "predetermined message" recited in the claims, which we do not decide, we do not find that we should re-evaluate the applicability of such a particular "predetermined message" to the system disclosed in Greene. In short, Petitioner's arguments ask the Board to reconsider prior art that was presented to the Examiner, and to reconsider the Examiner's reasons for allowing the claims over that prior art. Accordingly, we decline to reconsider Greene in combination with SIP and/or Kammerer because Session Initiation Protocol (SIP) was presented to the Examiner.

Finally, we note that Petitioner has provided a declaration of David Lucantoni, Ph.D. to support the unpatentability challenges. The declaration asserts that the USPTO misinterpreted the claimed invention in its reasons for allowance. Ex 1003, ¶ 36; *see also* Pet. 11, FN4. However, we do not find this argument persuasive of Examiner error in consideration of Greene when we also consider the Examiner's specific findings in the Office Action discussed above. Although the declaration also provides explanations of Greene's disclosures and the SIP protocol, this alone does not overcome the circumstances presented here.

Patent Owner has argued persuasively that Greene and Session Initiation Protocol (SIP) were presented to the Examiner. *See, e.g.*, Prelim. Resp. 14–19. We have been shown no reason sufficient to warrant a reevaluation of Greene, whether alone or in combination with SIP and/or Kammerer, or in light of declaration evidence.

In summary, we recognize that Petitioner has an interest in the review of its unpatentability challenge, but we also recognize the need to assess the cumulativeness of challenges that raise the same or substantially the same arguments and prior art presented previously to the Office. Here, Greene was substantively considered and relied upon during examination to reject certain claims of the '566 patent. We find that the Examiner was aware of the contents of Greene in material respects, and that we have been shown no reason sufficient to reevaluate Greene, alone or in combination with SIP and/or Kammerer, with respect to any of the challenged claims. Consequently, we determine that the Petition presents the same or substantially the same prior art and arguments presented previously to the Office.

We exercise our discretion not to institute *inter partes* review with regard to all grounds.

III. CONCLUSION

For the foregoing reasons, we do not institute *inter partes* review of the ’566 patent.

IV. ORDER

After due consideration of the record before us, it is

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

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