

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

BLIX INC.,
Patent Owner.

IPR2020-01635
Patent 9,749,284 B2

Before MICHELLE N. WORMMEESTER, JESSICA C. KAISER, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

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

On October 2, 2020, Apple Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–38 of U.S. Patent No. 9,749,284 B2, issued on August 29, 2017 (Ex. 1001, “the ’284 patent”). Paper 1 (“Pet.”). Blix Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). With our authorization (Paper 9), Petitioner filed a Preliminary Reply, to address issues of claim construction and discretionary denial under 35 U.S.C. § 325(d) (Paper 10 (“Prelim. Reply”)), Patent Owner filed a Preliminary Sur-reply (Paper 11 (“Sur-reply”)). Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we deny Petitioner’s request and do not institute an *inter partes* review of claims 1–38.

I. BACKGROUND

A. The ’284 Patent (Ex. 1001)

The ’284 patent relates to “controlled reciprocating communication,” and “controlled pre-interaction.” Ex. 1001, 1:16–20. Figure 1 of the ’284 patent is reproduced below.

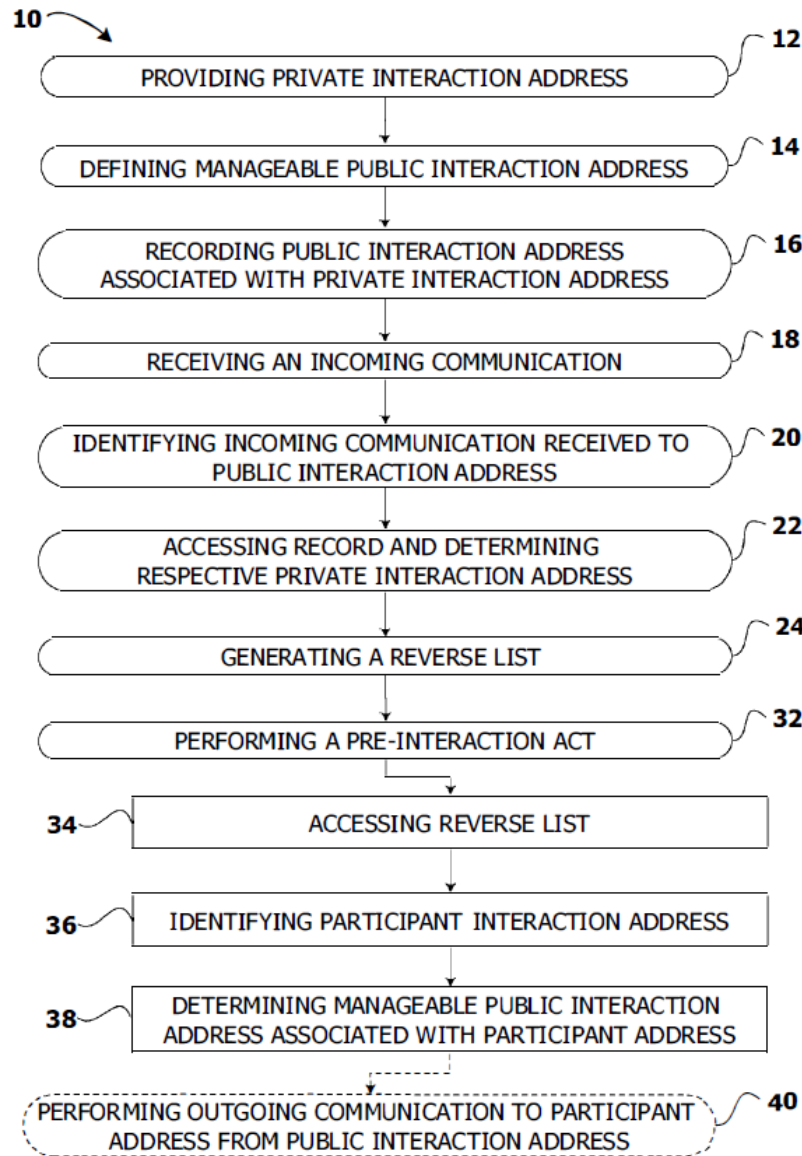


Figure 1 shows a high-level flow chart of “an embodiment of the method of performing controlled reciprocating communication.” *Id.* at 3:26–28.

In step 12, this process begins by providing “at least one private interaction address,” and defining “at least one manageable public interaction address.” *Id.* at 3:63–4:12.¹ Then, in step 16, “at least one

¹ In its “definitions” section, the ’284 patent states that an “interaction address” is “any string of alphanumeric and/or other characters, which is uniquely associated to a party of communication”; a “private interaction

private interaction address . . . is associated with at least one manageable public interaction address,” and “recorded.” *Id.* at 4:32–36. Upon receiving an incoming communication and/or attempted incoming communication in step 18, the system determines the private interaction address associated with the manageable public interaction address to which the incoming communication was directed and determines the private interaction address associated with that public interaction address in steps 20 and 22. *Id.* at 6:40–54.

In step 24, the system “generates at least one reverse list entry,” which comprises “at least one interaction address of a participant and at least one manageable public interaction address of the user of the system.” *Id.* at 7:17–22.² In step 32, the system performs a pre-interaction act which comprises the sub-steps of accessing the reverse list, identifying the interaction address of the participant in the reverse list, and determining the manageable public interaction address of the user, associated with the given interaction address of the participant in the reverse list. *Id.* at 8:60–9:3. At step 40, an outgoing communication can optionally be performed. *Id.* at 9:9–15.

address . . . is to be construed as an interaction address which the user wishes to controllably expose to participants”; and a “public interaction address” is “an interaction address which the user may distribute or publish, even uncontrollably.” *Id.* at 2:1–26.

² In the “definitions” section of the ’284 patent, a “reverse list entry is defined as any entry in a database, row and/or column in a table or any other type of record for this matter, listing at least one interaction address of a participant alongside a public interaction address of the user, as well as association therebetween.” *Id.* at 2:41–47.

B. Illustrative Claim

Of the challenged claims, claims 1, 17, and 27 are independent.

Claim 1 is illustrative and is reproduced below.

1. A method of performing controlled reciprocating communication, wherein said controlled reciprocating communication comprises an incoming and outgoing communications, between a first party and at least one second party, said method comprises:

- (a) providing at least one private interaction address of said first party;
- (b) defining at least one manageable public interaction address for said first party;
- (c) forming a record, wherein said manageable public interaction address is associated with said private interaction address for said first party;
- (d) receiving an incoming communication, said incoming communication comprises a communication from said second party to said first party; wherein said incoming communication is initiated by said second party to said manageable public interaction address of said first party;
- (e) identifying that said incoming communication was received to said manageable public interaction address;
- (f) accessing said record and performing at least one step selected from the group consisting of:
 - (I) determining said respective identity associated with said manageable public interaction address identified in said incoming communication, and
 - (II) determining said private interaction address of said first party associated at said record with said manageable public interaction address identified in said incoming communication;

said method is characterized by:

- (g) generating at least one reverse list entry, wherein an interaction address of said second party is associated at least with said manageable public interaction address of said first party;
- (h) performing a pre-interaction act, said pre-interaction act comprises:
 - (I) accessing said reverse list;

- (II) identifying said interaction address of said second party in said reverse list;
 - (III) determining that said manageable public interaction address of said first party is associated, at said reverse list, with said interaction address of said second party;
 - (i) performing an outgoing communication, said outgoing communication comprises a communication from said first party to said second party, said outgoing communication is initiated by said first party;
 - (j) said outgoing communication is characterized by that said outgoing communication, to said interaction address of said second party, is performed from said manageable public interaction address of said first party;
- wherein upon performing said outgoing communication, said second party is exposed merely to said manageable public interaction address of said first party;
- wherein said interaction address of said second party is obtainable from a third party or external services provider, wherein said at least one reverse list entry is formed by synchronizing said interaction address of said second party with said manageable public interaction address.

Ex. 1001, 21:19–22:11.

C. Related Proceedings

Petitioner and Patent Owner identify the following related litigation asserting the '284 patent: *Blix Inc. v. Apple Inc.*, 1-19-cv-01869 (D. Del.). Pet. 65; Paper 3, 1.

D. References

Petitioner relies on the following references:

1. “Leung” (US 2010/0020952 A1; published Jan. 28, 2010) (Ex. 1004);
2. “Klein” (US 8,594,298 B2; issued Nov. 26, 2013) (Ex. 1005);
3. “Rozenblit” (US 5,832,072, issued Nov. 3, 1998) (Ex. 1006);

4. “Trandal” (US 2013/0078971 A1, published Mar. 28, 2013)
(Ex. 1007); and

5. “Kirchhoff” (US 7,839,987 B1; issued Nov. 23, 2010)
(Ex. 1008).

Petitioner also relies on declaration testimony from Dr. Loren Terveen
(Ex. 1003, “Terveen Decl.”).

E. Grounds Asserted

Petitioner asserts that claims 1–38 would have been unpatentable on
the following grounds:

Claims Challenged	35 U.S.C. §	References
1–5, 7–10, 12–18, 21–30, 33–35, 37, 38	103	Leung ³
7, 8, 13, 21, 33	103	Leung, Klein
6, 11	103	Leung, Rozenblit
19, 31, 36	103	Leung, Trandal
20, 32	103	Leung, Kirchhoff

Pet. 9–10.

II. ANALYSIS

A. Legal Principles

A claim is unpatentable under 35 U.S.C. § 103(a) if “the differences
between the subject matter sought to be patented and the prior art are such
that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said
subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406
(2007). The question of obviousness is resolved on the basis of underlying
factual determinations, including: (1) the scope and content of the prior art;

³ Petitioner relies on Leung in view of the knowledge of a person of ordinary
skill in the art for this obviousness ground. Pet. 9.

(2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective evidence of obviousness or nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). An obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418.

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2016) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). Petitioner does not satisfy its burden of proving obviousness by employing “mere conclusory statements,” but “must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

B. Level of Ordinary Skill in the Art

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. Petitioner asserts a person of ordinary skill in the art “would have been a person having at least a bachelor’s degree in computer science, electrical engineering, computer engineering, or a related field, and at least two years of experience in telecommunications and/or computer-based communication, with additional

education substituting for experience and vice versa.” Pet. 3 (citing Ex. 1003 ¶¶ 21–23). Patent Owner asserts a person of ordinary skill in the art “would have been a person having at least a bachelor’s degree in computer science, electrical engineering, or a related field, at least two years of experience in telecommunications or computer networking, and would have been familiar with Internet Engineering Task Force (IETF) standards including RFC 3261 ‘Session Initiation Protocol’” of Exhibit 1014. Prelim. Resp. 10 (citing Ex. 2001 ¶ 29).

The parties’ proposed formulations differ slightly, but neither party explains how any differences would materially affect our analysis. We determine our analysis applies equally under either formulation.

C. Claim Construction

For *inter partes* reviews filed on or after November 13, 2018, we apply the same claim construction standard used by district courts and the ITC, both of which follow *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny. 83 Fed. Reg. 51340 (Oct. 11, 2018). Because the instant Petition was filed on July 17, 2020, we apply that standard here. Accordingly, we construe each challenged claim of the ’284 patent to generally have “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.” 37 C.F.R. § 42.100(b) (2020).

Although Petitioner contends no term requires explicit construction (Pet. 10), we determine we need to address the construction of “reverse list entry” to resolve the issues before us. Relevant to that term, claim 1 recites “generating at least one reverse list entry, wherein an interaction address of said second party is associated at least with said manageable public

interaction address of said first party.” Ex. 1001, 21:49–52. Claim 1 further recites performing a pre-interaction act which comprises “accessing said reverse list,” “identifying said interaction address of said second party in said reverse list,” and “determining that said manageable public interaction address of said first party is associated, at said reverse list, with said interaction address of said second party.” *Id.* at 21:53–61. Finally, claim 1 recites “wherein said at least one reverse list entry is formed by synchronizing said interaction address of said second party with said manageable public interaction address.” *Id.* at 22:9–11.

In the section of the specification titled “Definitions,” the ’284 patent states:

A reverse list, as referred to herein, is to be construed as including at least one reverse list entry. The reverse list entry is defined as any entry in a database, row and/or column in a table or any other type of record for this matter, listing at least one interaction address of a participant alongside a public interaction address of the user, as well as association therebetween.

Id. at 2:41–47. Although Petitioner quotes this portion of the specification (Pet. 21 (quoting Ex. 1001, 2:41–47)), Petitioner argues a “reverse list entry” is “a record that associates the second party’s interaction address with the public address of the first party” (*id.*). By characterizing the reverse list entry according only to its function, Petitioner does not give full effect to the specification’s definition which also requires “listing at least one interaction address of a participant alongside a public interaction address of the user, as well as association therebetween.” Ex. 1001, 2:41–47. Based on the intrinsic record of the ’284 patent, we construe “reverse list entry” as recited in claim 1 as any type of record listing an interaction address of the second

party alongside a manageable public interaction address of the first party as well as an association therebetween.

We determine we need not explicitly construe any other claim terms for purposes of this decision. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

D. Asserted Obviousness over Leung

1. Overview of Leung (Ex. 1004)

Leung “relates to the distribution of unique user identities in social networks to be used in public telephone networks, providing privacy protection for both calling and receiving parties, while simultaneously permitting verification of the calling party’s identity.” Ex. 1004 ¶ 2. Leung notes an “increasing adoption of online social networks by users from different backgrounds has increased the threats of identity theft and privacy intrusion.” *Id.* ¶ 3. Leung explains “to protect privacy, neither party wants to give out its real telephone number to the counterpart party, known only by a fictitious identity from an online social network,” but it “is also desirable for the receiving party to verify the identity of calling party before taking the call so that unwanted calls can be filtered.” *Id.* ¶ 9. Leung provides a way to “allow users of online social networks to communicate with the public switched telephone network with privacy protection and verification of identity.” *Id.* ¶ 11.

Leung describes:

When a community member wishes to communicate with another community member via telephone, the member will access the system using the advertised community phone number. The system will associate the identity of the caller to the member by means of caller ID. In cases where the caller ID is blocked or not available, the member ID can be collected by

an interactive voice response system. . . . The system then collects the member ID of the member with whom the caller wishes to communicate, again by means of the interactive voice response system. The system originates an outgoing call to one or more phone numbers associated with the member ID of the called party. The caller ID used to originate this call is not the same as the caller's phone number. The community accessed number is used instead, so that the receiving member can associate the call with the community. . . . When the receiving member answers the call, the system will announce the member ID, alias, or recorded message of the originating member. . . . If the receiving member decides to answer the call, the two calls, one incoming from the originating member and one outgoing to the receiving member, will be bridged and communication can commence thereafter.

Id. ¶ 18.

2. *Obviousness*

Petitioner contends that claims 1–5, 7–10, 12–18, 21–30, 33–35, 37, and 38 would have been obvious over Leung in combination with the knowledge of a person of ordinary skill in the art. Pet. 11–48. We have reviewed the information provided by Petitioner, including the relevant portions of the supporting Terveen Declaration (Ex. 1003), along with Patent Owner's arguments and evidence, and are persuaded, based on the current record, that Petitioner has not demonstrated a reasonable likelihood of prevailing on this obviousness challenge.

For purposes of this Decision, we focus on claim 1's limitation of "generating at least one reverse list entry, wherein an interaction address of said second party is associated at least with said manageable public interaction address of said first party." As discussed above, we construe "reverse list entry" consistently with the definition of that term in the specification as any type of record listing an interaction address of the

second party alongside a manageable public interaction address of the first party as well as an association therebetween.

Petitioner relies on Leung’s “accept call list” as teaching the recited “reverse list entry.” Pet. 21. Petitioner contends that, in Leung, a callee may save the incoming member ID of the second party to such an accept call list. *Id.* (citing Ex. 1004 ¶¶ 13, 18, 49). Petitioner notes that a callee’s accept call list is stored in that member’s member profile, which includes the callee’s member ID. *Id.* (citing Ex. 1004 ¶ 53). According to Petitioner, “[t]he member ID of the second party is thus associated with the member ID of the first party such that when the second party attempts to reach the first party, the server retrieves the callee’s accept call list, and confirms the second party’s member ID is included in the list (i.e., confirms there is an association between the second party’s member ID and the callee’s member ID).” *Id.* at 21–22.

Patent Owner contends that the recited “reverse list” must list “both the first and second parties’ addresses and an association therebetween.” Prelim. Resp. 20. Patent Owner contends that in Leung, the accept call list includes only second party addresses (member IDs from which the callee wishes to accept calls), and does not include first party (caller) addresses or any association between the member IDs of the two parties. *Id.* at 20–21 (citing Ex. 1004 ¶ 29; Ex. 2001 ¶ 59). We agree with Patent Owner. As discussed above, the ’284 patent makes clear that a “reverse list entry” includes an interaction address of the second party listed alongside a manageable public interaction address of the first party as well as an association therebetween. Ex. 1001, 2:41–47. Leung’s accept call list, on the other hand, is a list of member IDs (interaction addresses) of second

parties for which a first party will accept calls. Ex. 1004 ¶ 13 (“[T]he member profile can include lists of member IDs that the member is and is not willing to accept incoming calls from.”). Leung also teaches that a first party can save the member ID of the second party to the first party’s accept call list. *See id.* ¶¶ 8, 49, 53. Petitioner relies only on these disclosures as teaching “generating at least one reverse list entry,” and does not rely on the testimony of its declarant Dr. Terveen.⁴ *See* Pet. 21–22. Because Leung’s accept call list does not include the necessary components for a “reverse list entry” (i.e., both parties’ interaction addresses and the association between them), we determine Petitioner has not sufficiently shown Leung teaches this limitation of claim 1.

Petitioner relies on Leung’s accept call list as teaching similar limitations of independent claims 17 and 27. Pet. 36, 43. We do not find Petitioner’s contentions regarding these limitations sufficiently persuasive for the reasons discussed above. The remaining challenged claims depend,

⁴ We note that Dr. Terveen does not explicitly address the limitation of claim 1 we discuss above. *See* Ex. 1003 ¶¶ 40–48. He does mention the recited “reverse list” in other parts of his declaration, but those mentions do not alter our analysis. For example, in discussing the background of the ’284 patent, Dr. Terveen states a “reverse list” is “simply a record associating the second party’s interaction address with the public address of the first party.” *See id.* ¶ 35 (citing Ex. 1001, 6:25–8:59). We note, however, that Dr. Terveen cites the description of Figure 1 of the ’284 patent, but not the definition in the specification (Ex. 1001, 2:41–47). Further, in addressing “wherein said at least one reverse list entry is formed by synchronizing said interaction address of said second party with said manageable public interaction address,” as recited in claim 1, Dr. Terveen states that Leung’s accept call list teaches the claimed “reverse list entry,” but Dr. Terveen does not provide explanation other than citing to portions of Leung we discuss above. *See id.* ¶ 48 (citing Ex. 1004 ¶¶ 18, 49).

directly or indirectly, from claim 1, 17, or 27, and Petitioner does not rely on any of the additional references in the remaining grounds (or the knowledge of a person of ordinary skill in the art) to address the deficiency we discuss above.

III. CONCLUSION

We determine that Petitioner has not demonstrated a reasonable likelihood of prevailing on at least one claim in its challenges to claims 1–38 of the '284 patent.

IV. ORDER

Accordingly, it is:

ORDERED that the Petition is DENIED and no trial is instituted.

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