

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TWILIO INC.,
Petitioner,

v.

TELESIGN CORPORATION,
Patent Owner.

Case IPR2016-00450
Patent 8,462,920 B2

Before SALLY C. MEDLEY, JUSTIN T. ARBES, and
KIMBERLY McGRAW, *Administrative Patent Judges*.

McGRAW, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, Twilio Inc., filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–10, 13, and 17–22 of U.S. Patent No. 8,462,920 B2 (Ex. 1001, “the ’920 patent”). *See* 35 U.S.C. § 311. Patent Owner, TeleSign Corp., filed a Preliminary Response (Paper 7 “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . 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 that follow, we do not institute an *inter partes* review of the ’920 patent.

A. *Related Proceedings*

Petitioner identifies the co-pending petition for *inter partes* review in IPR2016-00360 (US 7,945,034 B2) as a related matter. Pet. 2. Patent Owner states Petitioner also identified the Petition in this proceeding as a related matter in the co-pending petition for *inter partes* review in IPR2016-00451 (US 8,687,038 B2, “the ’038 patent”). Prelim. Resp. 2. Patent Owner states that it does not foresee that the decision with respect to the instant Petition will affect, or be affected by, these other Petitions. *Id.*

The parties also state the ’920 patent is asserted in the following lawsuit: *TeleSign Corp. v. Twilio Inc.*, No. 2:15-cv-03240 (C.D. Cal.). *Id.*; Pet. 2.

B. The '920 Patent (Ex. 1001)

The '920 patent, entitled “Registration, Verification and Notification System,” relates generally to a process for verifying the identity of an online registrant. Ex. 1001, 1:6–7, 2:7–8. The process uses registration information to notify the registrant of events that are established either by the registrant or by the business through which the registrant has registered. *Id.* at 2:8–10. The '920 patent explains that to prevent fraud or identity theft, either the business or individual may wish to be alerted to certain events. *Id.* at 1:40–42. For example, “a consumer may wish to be notified every time a withdrawal [of] more than one thousand dollars is requested from his checking account.” *Id.* at 1:42–45. “A business may wish to notify a consumer when more than five transactions post to a consumer’s account within twenty-four hours.” *Id.* at 1:45–47. The '920 patent explains that when credit cards or account numbers are stolen, the accounts can be quickly drained of cash or credit over a short period of time. *Id.* at 1:48–50. This can be avoided by notifying the account owner of these acts or even seeking his or her authorization before permitting such transactions to occur. *Id.* at 1:50–53. The '920 patent further states that there are other instances when notification can be helpful, such as when automatic deposits occur. *Id.* at 1:54–57. Alternatively, there are instances “not financially based in which the notification could benefit both the consumer as well as the business.” *Id.* at 1:57–59. “For example, the consumer may want to be alerted to new information, updated sports scores, etc.” *Id.* at 1:60–61.

“Upon the occurrence of a previously established notification event, the registrant is notified by establishing a connection with the registrant, typically by contacting the registrant through a telephonic connection with

the registrant via at least one registrant telephone number provided by the registrant during the registration process.” *Id.* at 2:49–55.

C. Claims

Petitioner challenges independent claim 1 and dependent claims 2–10, 13, and 17–22, which depend directly or indirectly from claim 1. Claim 1, with brackets added, is reproduced below.

1. A verification and notification process, comprising:

[a] receiving information responsive to at least part of a registration form that is presented to the registrant on a web-site, the received information including at least one registrant electronic contact;

[b] verifying a received registrant electronic contact, wherein verifying the received registrant electronic contact includes:

establishing a first telephonic connection with the registrant using the received registrant electronic contact;

communicating a first communicated verification code to the registrant through the first telephonic connection; and

receiving a first submitted verification code after it is entered by the registrant via the web-site and verifying the received registrant electronic contact if the first submitted verification code is the same as the first communicated verification code;

[c] establishing a notification event associated with the registrant;

[d] identifying an occurrence of the established notification event; and

[e] after identifying the occurrence of the established notification event, re-verifying the registrant electronic contact, wherein re-verifying includes:

establishing a second telephonic connection with the registrant using the verified registrant electronic contact;

communicating a second communicated verification code to the registrant through the second telephonic connection;

receiving a second submitted verification code that is entered by the registrant via the web-site; and

re-verifying the registrant electronic contact if the second submitted verification code is the same as the second communicated verification code.

D. Asserted Grounds of Unpatentability

Petitioner argues that the challenged claims are unpatentable based upon the following grounds:

Reference(s)	Basis	Challenged Claim(s)
Bennett ¹	§ 103	1-10, 13, 17-22
Bennett and Thoursie ²	§ 103	1-10, 13, 17-22
Bennett and Rolfe ³	§ 103	4, 5
Bennett, Thoursie, and Rolfe	§ 103	4, 5
Bennett and Woodhill ⁴	§ 103	13

¹ U.S. Patent No. 8,781,975 B2, filed May 23, 2005, issued July 15, 2014 (Ex. 1005, "Bennett").

² U.S. Patent No. 8,302,175 B2, filed April 20, 2005, issued Oct. 30, 2012 (Ex. 1008, "Thoursie").

³ U.S. Patent Application No. 2003/0221125, published Nov. 27, 2003 (Ex. 1006, "Rolfe").

⁴ U.S. Patent No. 6,934,858 B2, filed Dec. 13, 2000, issued Aug. 23, 2005 (Ex. 1010, "Woodhill").

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