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Paper 13
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

YMAX CORPORATION,
Petitioner,

v.

FOCAL IP, LLC,
Patent Owner.

Case IPR2016-01256
Patent 8,155,298 B2

Before SALLY C. MEDLEY, JONI Y. CHANG, and
BARBARA A. PARVIS, *Administrative Patent Judges.*

CHANG, *Administrative Patent Judge.*

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

I. INTRODUCTION

YMax Corporation ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1 and 20 of U.S. Patent No. 8,155,298 B2 (Ex. 1001, "the '298 patent") and a Declaration of Tal Lavian, Ph.D. (Ex. 1002). Paper 1 ("Pet."). Focal IP, LLC ("Patent Owner") filed a Preliminary Response and a Declaration of Mr. Regis J. Bates Jr. (Ex. 2001). Paper 7 ("Prelim. Resp."). Pursuant to our prior authorization, Petitioner filed a Reply to the Preliminary Response. Paper 11 ("Reply").

For the reasons that follow, we institute an *inter partes* review pursuant to 35 U.S.C. § 314, as to claims 1 and 20 of the '298 patent.

A. Related Matters

The parties indicate that the '298 patent is involved in *Patent Asset Licensing LLC v. Bright House Networks, LLC*, No. 3:15-cv-00742-J-32MCR (M.D. Fla.), and identify other related proceedings. Pet. 1–2; Paper 4, 2–3. There are other petitions challenging the '298 patent (IPR2016-01259 and IPR2016-0163) and two related patents: (1) U.S. Patent No. 7,764,777 B2 ("the '298 patent"), which issued from a divisional application of the '298 patent's parent application; and (2) U.S. Patent No. 8,457,113 B2 ("the '133 patent"), which issued from a continuation application of the '298 patent.

B. The '298 Patent

The '298 patent is directed to a system for allowing a subscriber to select telephone service features. Ex. 1001, 1:20–23. Figure 1 of the '298 patent is reproduced below (with annotations).

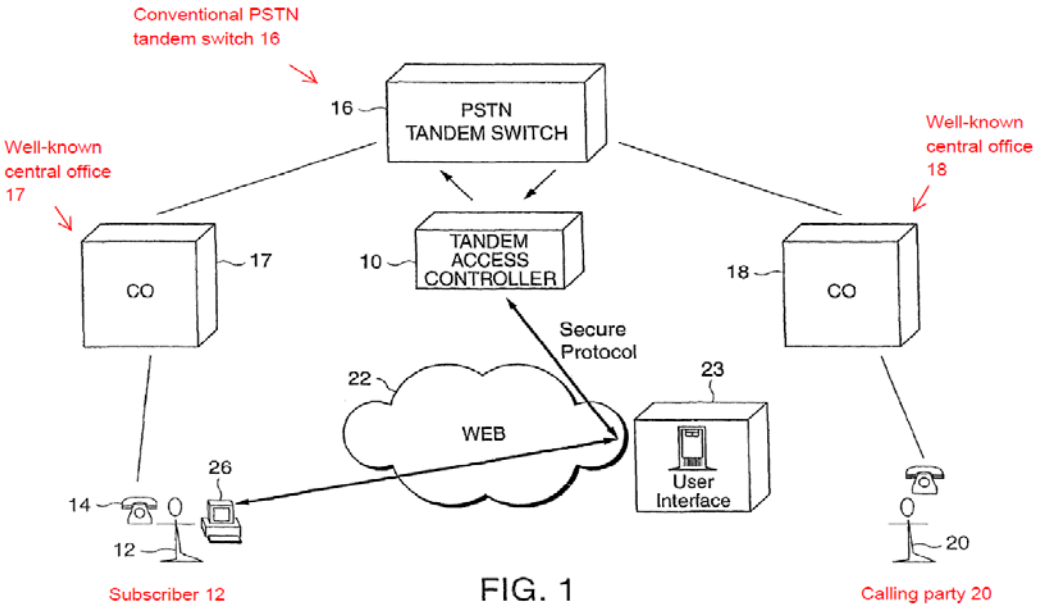

FIG. 1

Annotated Figure 1 illustrates tandem access controller 10 connected to conventional Public Service Telephone Network (PSTN) tandem switch 16. *Id.* at 4:60–64. According to the '298 patent, "[d]etails of the operation of the existing phone network," including directing of phone calls by "existing" PSTN tandem switch 16 to central offices 17, 18 are further described in a publication incorporated by reference, as well as "numerous books describing the PSTN." *Id.* at 4:60–5:4.

The call flow in the network illustrated in Figure 1 with tandem access controller 10 remains the same as that in a conventional network, "except

that additional 3rd-party features are applied to the call." *Id*. More specifically, in the network illustrated in Figure 1, a call from calling party 20 to subscriber's phone 14 is directed to tandem access controller 10, which places a second call, subject to 3rd party control information to subscriber 12. *Id*. at 5:5–20. The second call is placed "to the subscriber's 'private' phone number," without terminating the first call. *Id*. When subscriber 12 answers the call, tandem access controller 10 connects the first call to the second call so as to connect calling party 20 to subscriber 12. *Id*.

Figure 1 also shows web server 23 within World Wide Web 22, which is connected to tandem access controller 10. *Id*. at Fig. 1. Subscriber 12 specifies 3rd-party call control features via web server 23 and these features are then relayed via World Wide Web 22 to tandem access controller 10. *Id*. at 5:33–41.

C. Illustrative Claim

Petitioner challenges independent claims 1 and 20 of the '298 patent in this proceeding. Claim 1 is reproduced below.

> 1. A method for providing user control selections for routing of one or more communications between users of one or more communications networks, wherein the users either 1) initiate a communication, 2) receive a communication, or 3) control a communication, the user control selections provided by a user via access to a web server of a web-enabled processing system connected to operate at least in part with the one or more communication networks, wherein at least one of the communication networks is a network comprising edge switches for routing calls from and to users within a local geographic area and *switching facilities* for routing calls to other edge switches

or other switching facilities local or in other geographic areas, the web server of web-enabled processing system facilitating direct access by a user for providing user control selections to the at least one of the switching facilities, the user having a communications device with which to communicate with the web server of the web-enabled processing system, the method comprising the steps of:

facilitating access by authorized users to the web-enabled processing system, via the web server, the web-enabled processing system coupled to at least one of the switching facilities of the network, the web-enabled processing system configured to route a communication from a specific one of the users to an intended recipient of the users;

executing control criteria, via the web-enabled processing system, to control the routing of the one or more communications via the web-enabled processing system, the control criteria predetermined by the users control selections via the web server before the control criteria are executed via the web-enabled processing system,

wherein the *web-enabled processing system* is configured to perform the following operations to execute the control criteria:

first, receive a message indicating a communication request from a user initiating a communication for an intended recipient user, wherein the message request is transmitted using a [signaling] protocol of the at least one communication network;

second, validate and acknowledge said communications request without first forwarding said request to a terminating edge switch within the geographic area of the intended recipient of the users;

third, determine the control criteria for access to the intended recipient of the users;

fourth, facilitate selection of a routing path over the at least one communication network in accordance with the control criteria for the intended recipient user;

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