

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,
v.

ESTECH SYSTEMS, INC.,
Patent Owner.

IPR2021-00329
Patent 8,391,298 B2

Before THOMAS L. GIANNETTI, JENNIFER MEYER CHAGNON, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

GIANNETTI, *Administrative Patent Judge*.

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

I. INTRODUCTION

Cisco Systems, Inc. (“Petitioner” or “Cisco”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–5 and 7–12 (“the challenged claims”) of U.S. Patent No. 8,391,298 B2 (Ex. 1001, “the ’298 patent”). Patent Owner, Estech Systems, Inc., filed a Corrected Preliminary Response (Paper 9, “Prelim. Resp.”).¹

The Board has authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary response “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.”

The Board, however, has discretion to deny a petition even when a petitioner meets that threshold. *Id.*; *see, e.g., Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential).

For the reasons that follow, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review.

¹ We authorized filing of a Corrected Preliminary Response providing page numbering omitted from the original preliminary response (Paper 8).

II. BACKGROUND

A. Real Parties-in-Interest

Petitioner identifies as real parties-in-interest itself (Cisco Systems, Inc.) and the following seven entities: BBVA USA; BOKF NA; PlainsCapital Bank; Target Corp.; Wells Fargo Bank; Wells Fargo Corp.; and Regions Financial Corporation. Pet. v. Referring to pending infringement litigations involving the '298 patent, Petitioner explains: "Petitioner has listed [as real parties-in-interest] every defendant who has been involved in, has directed, or has any control over, this Petition as RPIs." *Id.* at v n.1.

Patent Owner identifies itself, Estech Systems, Inc., as the real party-in-interest. Paper 3, 1.

B. Related Proceedings

The parties identify numerous infringement litigations in the Eastern and Western Districts of Texas involving the '298 patent. Pet. vi–vii; Paper 3, 1–3. These will be further discussed *infra*.

C. The '298 Patent

The '298 patent relates to Voice over IP (VoIP) systems. Ex. 1001, (57), 1:29–60. Such systems are used to transmit voice conversations over a data network using the Internet Protocol (IP). *Id.* at 1:29–31. The patent describes a VoIP system where a user can dial numbers stored in a series of lists. *Id.* at (57). The lists are stored in the system and displayed to the user of an IP telephone. *Id.*

This VoIP system provides an ability for a user to scroll through the list of names and phone numbers and then call a person once their name and phone number are displayed. *Id.* at (57). One embodiment allows a user to

scroll through phone listings on remote sites. *Id.* at 9:53–59. Once a particular name and phone number are found, the user can press a button key (e.g., on a keyboard) to commence a telephone conversation with the user having the selected name and phone number. *Id.* at 9:60–64.

D. Illustrative Claim

Claim 1 is illustrative of the challenged claims. Claim 1 recites:

1. An information handling system comprising:

a first local area network (“LAN”);

a second LAN;

a wide area network (“WAN”) coupling the first LAN to the second LAN;

a third LAN coupled to the first and second LANs via the WAN;

a first telecommunications device coupled to the first LAN;

a plurality of telecommunications extensions coupled to the second LAN;

the first LAN including first circuitry for enabling a user of the first telecommunications device to observe a list of the plurality of telecommunications extensions;

the first LAN including second circuitry for automatically calling one of the plurality of telecommunications extensions in response to the user selecting one of the plurality of telecommunications extensions from the observed list, wherein the list of the plurality of telecommunications extensions is stored in a server in the second LAN, and is accessed by the first circuitry across the WAN; and

a plurality of telecommunications extensions coupled to the third LAN, the first LAN including circuitry for enabling the user to select between observing the list of the plurality of telecommunications extensions coupled to the second LAN or

observing a list of the plurality of telecommunications extensions coupled to the third LAN.

Ex. 1001, 15:58–16:19.

E. Prior Art

Petitioner relies on the following prior art:

1. Ludwig et al., United States Patent No. 5,689,641 (Ex. 1006, “Ludwig”);
2. Reid, United States Patent No. 6,131,120 (Ex. 1007, “Reid”);
3. Guy et al., United States Patent No. 6,298,057 (Ex. 1008, “Guy”);
4. Wilson et al., United States Patent No. 6,829,231 (Ex. 1009, “Wilson”); and
5. Hori et al., United States Patent No. 6,845,096 (Ex. 1010, “Hori”).

F. The Asserted Grounds

Petitioner challenges claims 1–5 and 7–12 of the ’298 patent on the following grounds (Pet. 8):

Claims Challenged	35 U.S.C. §	References
1–5, 7–12	103(a) ²	Ludwig, Hori
1–5, 7–12	103(a)	Ludwig, Reid
1–5, 7–12	103(a)	Guy, Wilson, Hori

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. § 103. Because the ’298 patent was filed before March 16, 2013 (the effective date of the relevant amendments), the pre-AIA version of § 103 applies.

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