UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RINGCENTRAL, INC.,
Petitioner,
v.

ESTECH SYSTEMS IP, LLC,
Patent Owner.

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IPR2021-00574
Patent 8,391,298 B2

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Before THOMAS L. GIANNETTI, CHARLES J. BOUDREAU, and
JON M. JURGOVAN, *Administrative Patent Judges.*

GIANNETTI, *Administrative Patent Judge.*

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

RingCentral, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 1–12 and 17–19 ("the challenged claims") of U.S. Patent No. 8,391,298 B2 (Ex. 1001, "the '298 patent"). Patent Owner[1] filed a Preliminary Response (Paper 8, "Prelim. Resp.").

Pursuant to 35 U.S.C. § 314, we instituted this *inter partes* review as to all of the claims challenged and all grounds raised in the Petition. Paper 13 ("Institution Dec.").

Following institution, Patent Owner filed a Response. Paper 15 ("PO Resp."). Subsequently, Petitioner filed a Reply to Patent Owner's Response (Paper 18, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 19, "PO Sur-reply"). On July 12, 2022, we held a consolidated oral hearing with case IPR2021-00573, also involving Petitioner and Patent Owner. A transcript of the hearing is included in the record. Paper 28 ("Hearing Tr.").

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision, issued pursuant to 35 U.S.C. § 318(a). For the reasons we discuss below, we determine that Petitioner has proven by a preponderance of the evidence that all challenged claims of the '298 patent are unpatentable.

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[1] Estech Systems, Inc. was initially identified as the owner of the '298 patent. *See* Paper 3, 1. In Updated Mandatory Notices filed July 15, 2022, Estech Systems IP, LLC, is identified as the owner of the '298 patent pursuant to a November 18, 2021, assignment. *See* Paper 27, 1 & n.2. Estech Systems, Inc., is identified as the parent corporation of Estech Systems IP, LLC. *Id.* at 1 n.1. The caption of this case has been revised to reflect this change.

II. BACKGROUND

A. *Real Parties-in-Interest*

Petitioner identifies as real parties-in-interest itself (RingCentral, Inc.) and the following entity: Howard Midstream Energy Partners ("HEP"). Pet. 2. Petitioner states that it has agreed to defend and indemnify its customer HEP in Case No. 6:20-cv-00777, filed August 25, 2020. *Id.* That case is an action for patent infringement brought by Patent Owner against HEP in the United States District Court for the Western District of Texas (Waco Division).

Patent Owner identifies Estech Systems IP, LLC, and Estech Systems, Inc., as real parties-in-interest. Paper 27, 1.

B. *Related Proceedings*

The parties identify numerous infringement litigations in the Eastern and Western Districts of Texas involving the '298 patent, including the action against HEP referenced in the preceding section. Pet. 2–4; Paper 6, 1–3. According to the parties, summary judgment of non-infringement was granted in favor of HEP in that action on June 21, 2022. Hearing Tr. 6–7; Paper 27, 4. In addition, the '298 patent has been before the Board in a prior petition for *inter partes* review, in IPR2021-00329. That petition, filed by Cisco Systems, Inc., was denied by the Board on July 6, 2021. IPR2021-00329, Paper 13.

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.* 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. [preamble] An information handling system comprising:

  [1a] a first local area network ("LAN");

  [1b] a second LAN;

  [1c] a wide area network ("WAN") coupling the first LAN to the second LAN;

  [1d] a third LAN coupled to the first and second LANs via the WAN;

  [1e] a first telecommunications device coupled to the first LAN;

  [1f] a plurality of telecommunications extensions coupled to the second LAN;

  [1g] 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;

  [1h] 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

[1i] 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 (references in square brackets provided by Petitioner). Challenged claims 8 and 17 are independent claims similar to claim 1. Challenged claims 2–7 depend from claim 1, challenged claims 9–12 depend from claim 8, and challenged claims 18 and 19 depend from claim 17.

E. Prior Art and Other Evidence

Petitioner relies on the following prior art:

1. International Application WO 99/05590 (Ex. 1003, "Chang");

2. United States Patent No. 6,490,619 (Ex. 1004, "Byrne"); and

3. United States Patent No. 6,240,448 (Ex. 1005, "Imielinski").

Petitioner relies also on the Declaration of Dr. Henry H. Houh. Ex. 1006 ("Houh Decl."). Patent Owner relies on the Declaration of Vijay K. Madisetti, Ph.D. Ex. 2013 ("Madisetti Decl."). In addition, Petitioner has submitted a transcript of Dr. Madisetti's deposition. Ex. 1037 ("Madisetti Dep.").

F. The Asserted Grounds

Petitioner challenges claims 1–12 and 17–19 of the '298 patent on the following grounds (Pet. 7):

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