

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, INC.,  
Patent Owner.

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IPR2021-00574  
Patent 8,391,298 B2

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

GIANNETTI, *Administrative Patent Judge*.

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

## 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, Estech Systems, Inc., filed a Preliminary Response (Paper 8, “Prelim. Resp.”).

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 grant the Petition and institute *inter partes* review of the challenged claims.

## 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 HEP in

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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). We discuss this case further, *infra*.

Patent Owner identifies itself, Estech Systems, Inc., as the real party-in-interest. Paper 6, 1.

### *B. Related Proceedings*

The parties identify numerous infringement litigations in the Eastern and Western Districts of Texas involving the '298 patent. Pet. 2–4; Paper 6, 1–3. 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

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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 99/005590 (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 also relies on the Declaration of Dr. Henry H. Houh (Ex.1006, “Houh Decl.”). At this stage, Patent Owner has not submitted an expert declaration.

*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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