

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EPIC GAMES, INC.,
Petitioner,

v.

INGENIOSHARE, LLC,
Patent Owner.

Case IPR2022-00297
Patent 8,744,407 B2

Before JONI Y. CHANG, PATRICK M. BOUCHER, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

CHANG, *Administrative Patent Judge*.

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

Exhibit 2006

I. INTRODUCTION

Epic Games, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 2, 5, 7, 53, 54, 56, 57, and 59 (“the challenged claims”) of U.S. Patent No. 8,744,407 B2 (Ex. 1001, “the ’407 patent”). Paper 1 (“Pet.”). IngenioShare, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

Under 35 U.S.C. § 314(a), 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 stated below, we determine that Petitioner has not established a reasonable likelihood that it would prevail with respect to any of the challenged claims. We hereby decline to institute an *inter partes* review in this proceeding.

A. Related Matters

The parties indicate that the ’407 patent also is involved in *IngenioShare, LLC v. Epic Games, Inc.*, No 6:21-cv-00663-ADA (W.D. Tex.). Pet. 2; Paper 5, 2.

B. The ’407 Patent

The ’407 patent discloses a computer-implemented system and method to manage the communication of a user. Ex. 1001, code (57). The ’407 patent describes one approach to maintain confidentiality of the user’s location and status while maintaining real-time communication. Ex. 1001, 4:38–40. In particular, the ’407 patent discloses a system that digitally identifies the identities of the caller (or the person requesting to

communicate with the user or trying to send a message to the user) and the receiver or user. *Id.* at 4:38–44. After determining the identities, the system can establish connections between the caller and the user in real time. *Id.* at 4:46–47. However, the system does not have to disclose the phone numbers, electronic addresses, physical locations and/or other attributes of the caller and the user to each other. *Id.* at 4:50–52.

C. Illustrative Claims

Of the challenged claims, claims 1 and 53 are independent. Claims 2, 5, and 7 depend from claim 1. Claims 54, 56, 57, and 59 depend from claim 53. Claims 1 and 53 are reproduced below (with the corrections to claim 53 set forth in the Certificate of Correction (Ex. 1001, 15–16)):

1. [1.0] A non-transitory computer-implemented method to manage the communication of a user via a server based on a communication protocol, in view of *a person, using a first device, trying to electronically convey a message from the first device to a second device of the user*, the method comprising:

[1.1] *receiving, by the server, the message from the person using the first device;*

[1.2] identifying, by the server, the person attempting to electronically convey the message; and

[1.3] setting, by the server, a process for the message using one or more rules based on at least a status associated with the user and an access priority associated with the person, the access priority depending on the person,

[1.4] wherein the server is configured to have access to contact information of the person,

[1.5] wherein even if the process includes transmitting the message to the second device via contact information of the user, the server does not provide the contact information of the user to

the first device to inhibit the person from sending messages to the user without via the server, and

[1.6] wherein the access priority associated with the person is configured to be set by the server depending at least in part on the user reacting by accepting or not accepting a prior message from the person.

Ex. 1001, 6:60–7:17 (emphases and bracketed matters added, using the same element numbering as in Petitioner’s claim listing (Ex. 1028)).

53. [53.0] A server based on a communication protocol for managing the communication of a user, in view of *a person, using a first device, trying to electronically convey a message from the first device to a second device of the user*, the second device being a handheld communication device, the server comprising:

[53.1] at least one computing device; and

[53.2] at least one storage device,

[53.3] wherein the at least one *computing device is configured to receive the message from the person using the first device*;

[53.4] identify the person attempting to electronically convey the message; and

[53.5] set a process for the message using one or more rules based on at least a status associated with the user and an access priority associated with the person, the status depending at least in part on the current activity or location of the user, or the current time, and the access priority depending on the person,

[53.6] wherein the server is configured to have access to contact information of the person,

[53.7] wherein even if the process includes transmitting the message to the second device via contact information of the user, the server does not provide the contact information of the user to the first device to inhibit the person from sending messages to the user without via the server,

[53.8] wherein the server is configured to be aware of the availability of the user, and

[53.9] wherein the server is configured to send information to the person regarding the availability of the user.

Id. at 12:25–54, 15–16 (emphases and bracketed matters added, using the same element numbering as in Petitioner’s claim listing (Ex. 1028)).

D. Prior Art Relied Upon

Petitioner relies upon the references listed below. Pet. 4.

Name	Reference	Date	Exhibit No.
Furlong	U.S. Patent Pub. No. 2003/0028621 A1	Feb. 6, 2003	1007
Diacakis	U.S. Patent Pub. No. 2002/0116461 A1	Aug. 22, 2002	1008

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 5)¹:

Claims Challenged	35 U.S.C. §	References
53, 54, 56, 59	103(a)	Furlong
1, 2, 5, 7, 53, 54, 56, 58, 59	103(a)	Diacakis

¹ Because the claims at issue have a filing date prior to March 16, 2013, the effective date of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), we apply the pre-AIA version of 35 U.S.C. § 103 in this Decision.

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