

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EPIC GAMES, INC.,
Petitioner,

v.

INGENIOSHARE, LLC,
Patent Owner.

IPR2022-00294
Patent 10,492,038 B2

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

Opinion of the Board filed by *Administrative Patent Judge* AMUNDSON.

Opinion Dissenting filed by *Administrative Patent Judge* CHANG.

AMUNDSON, *Administrative Patent Judge*.

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

I. INTRODUCTION

Epic Games, Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 7–12, 22–24, and 33–67 in U.S. Patent No. 10,492,038 B2 (Exhibit 1001, “the ’038 patent”) under 35 U.S.C. §§ 311–319. Paper 1 (“Pet.”). IngenioShare, LLC (“Patent Owner”) filed a Preliminary Response. Paper 10 (“Prelim. Resp.”).

Under 37 C.F.R. § 42.4(a), we have authority to determine whether to institute an *inter partes* review. We may institute an *inter partes* review only if “the information presented in the petition filed under section 311 and any response filed under section 313 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.” 35 U.S.C. § 314(a) (2018). The “reasonable likelihood” standard is “a higher standard than mere notice pleading” but “lower than the ‘preponderance’ standard to prevail in a final written decision.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential).

Based on the current record and for the reasons explained below, Petitioner has shown that there is a reasonable likelihood that it would prevail with respect to at least one of the challenged claims. Thus, we institute an *inter partes* review of claims 7–12, 22–24, and 33–67 in the ’038 patent on all challenges included in the Petition.

II. BACKGROUND

A. Real Parties in Interest

Petitioner identifies itself as the real party in interest. Pet. 2. Patent Owner identifies itself as the real party in interest. Paper 8, 2. The parties do not raise any issue about real parties in interest.

B. Related Matters

Petitioner and Patent Owner identify the following civil action where Patent Owner has asserted the '038 patent and other patents against Petitioner: *IngenioShare, LLC v. Epic Games, Inc.*, No. 6:21-cv-00663-ADA (W.D. Tex. filed June 25, 2021) (“the Texas case”). Pet. 2; Prelim. Resp. 2; Paper 8, 2.

Patent Owner identifies the following Board proceedings as related matters:

- *Epic Games, Inc. v. IngenioShare, LLC*, IPR2022-00202 (U.S. Patent No. 10,142,810 B2);
- *Epic Games, Inc. v. IngenioShare, LLC*, IPR2022-00291 (U.S. Patent No. 10,708,727 B2);
- *Epic Games, Inc. v. IngenioShare, LLC*, IPR2022-00295 (U.S. Patent No. 10,492,038 B2); and
- *Epic Games, Inc. v. IngenioShare, LLC*, IPR2022-00297 (U.S. Patent No. 8,744,407 B2).

Paper 8, 2–3.

C. The '038 Patent (Exhibit 1001)

The '038 patent, titled “Method and Apparatus to Manage Messaging Providing Different Communication Modes Depending on One Identifier and Not Requiring to Disclose Contact Information,” issued on November 26, 2019, from an application filed on September 14, 2017. Ex. 1001, codes (22), (45), (54). The patent identifies that application as the last in a series of continuation and continuation-in-part applications that started with an application filed on December 7, 2004. *Id.* at 1:10–41, code (63).

The '038 patent explains that an individual may (1) employ numerous modes of communication, such as desk phone, cell phone, email, and instant messaging, and (2) “have more than one phone number and multiple electronic mail addresses.” Ex. 1001, 1:59–64. The patent states that “there is still a need to help manage the numerous modes of communication.” *Id.* at 2:1–3. The patent discloses “systems and methods to manage electronic communications.” *Id.* at code (57); *see id.* at 3:52–5:63.

For example, the '038 patent discloses a communications apparatus that:

- (1) “provides different communication modes to a first user, with messages eligible to be received by a second user based on any of the modes, depending on an identifier associated with the second user”;
- (2) “receives an indication from the first user to select a communication mode for a message for the second user”;
and
- (3) “receive[s] contact information associated with the second user to allow the second user to participate, with the contact information not provided to the first user even when the message is received by the second user, and with the contact information being distinct from the identifier.”

Ex. 1001, code (57).

The '038 patent explains that a “user receives the message through a handheld device, such as a cellular phone,” or the “message is electronically conveyed” to the user “based on Internet protocol through a website.”

Ex. 1001, 2:54–57. If the “message is electronically conveyed” to the user through a “central network server, such as a web server based on Internet protocol,” a “portal or gateway” may “provide general Internet access.” *Id.*

at 7:9–15. For instance, the portal or gateway may “allow[] the user to receive communications from numerous sources through different modes.”
Id. at 4:22–24.

Figure 7 in the '038 patent (reproduced below) depicts steps in a process for responding to an incoming call:

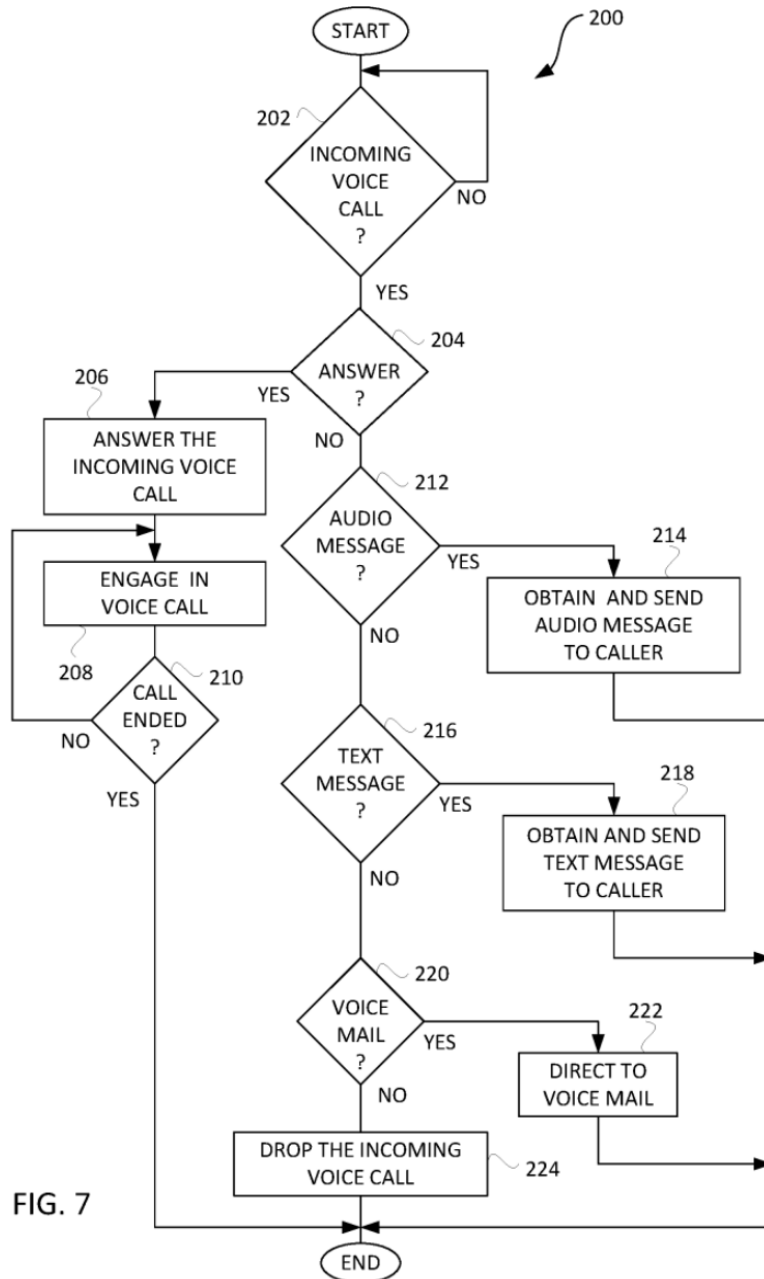


FIG. 7

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