

IPR2022-00294
Patent 10,492,038 B2

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

CHANG, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the majority's determination that Petitioner has shown that there is a reasonable likelihood that it would prevail with respect to at least one of the challenged claims. For the reasons stated below, I find that Petitioner has not shown sufficiently that Diacakis teaches or suggests the negative limitations that require the users to communicate without disclosing their contact information, as recited in the challenged claims.

The preamble⁷ of claim 7 recites “communications of a plurality of users . . . without requiring the plurality of users to disclose their contact information to each other.” Ex. 1001, 21:52–59.

Limitation 7.8 of claim 7 recites:

wherein even when *the first message is received by the second user* via the electronic device associated with the second user depending on the identifier associated with the second user, *the contact information associated with the second user is not provided via the network-based portal to the first user via an electronic device associated with the first user.*

Id. at 22:34–40 (emphases added). Claims 38 and 46 also recite similar negative limitations. *See, e.g., id.* at 26:48–54, 28:23–34. Claims 8–12, 22–24 depend from claim 7; claims 39–45 depend from claim 38; and claims 47–67 depend from claim 46. By virtue of their dependency, the challenged dependent claims also require these negative limitations.

For these negative limitations, Petitioner argues that “Diacakis’ users do not see others’ contact information (*e.g.*, telephone number or email address) simply by communicating.” Pet. 29–30. According to Petitioner, Diacakis discloses that an individual (second user) may specify who sees the individual’s availability information and “separately may ‘control what contact information observers are allowed to view.’” *Id.* at 38, 47–48 (quoting Ex. 1007 ¶ 7), 55–58; *see id.* at 29 (citing Ex. 1007 ¶¶ 7, 47).

Petitioner also argues that the P&A management system “obviates the need for the first user to receive the second user’s contact information” because

⁷ My analysis includes the preamble of claim 7 because, for Limitation 7.8 discussed below, Petitioner relies upon the same arguments in connection with the preamble of claim 7, and I disagree with the Majority’s determination that Petitioner has established sufficiently for purposes of institution that Diacakis teaches the preamble of claim 7.

the system “relate[s] the various entries for an individual and merge[s] them together as one entry.” *Id.* at 38 (alterations by Petitioner) (quoting Ex. 1007 ¶ 59). Petitioner further argues that the P&A management system “allow[s] subscribers to contact individuals without having to be concerned about different communication devices, their addresses and capabilities.” *Id.* at 39 (alteration by Petitioner) (quoting Ex. 1007 ¶ 62); *see id.* at 30. According to Petitioner, a subscriber may “refer to a single indicator and use that information to initiate point-to-point contact” with an individual. *Id.* at 39 (citing Ex. 1003 ¶¶ 248–249; Ex. 1007 ¶¶ 62, 64); *see id.* at 30 (citing Ex. 1007 ¶ 62).

I am not persuaded by Petitioner’s arguments that the users in Diacakis communicate without disclosing their contact information. Diacakis makes it clear that the user interface (relied upon by Petitioner to teach the claimed “network-based portal”) provides the contact information of each individual to the subscriber. Notably, Diacakis expressly discloses that “indicator module 110 may receive availability information from one or more P&A management servers 12 and *merge the contact information for each individual* into a single indicator, as described . . . in connection with FIG. 8, for *display by the user interface 112.*” Ex. 1007 ¶ 64; *see also id.* ¶ 65 (“[I]ndicator module 110 may relate the *various addresses* for a given individual and merge them into a single indicator for each of the individuals, as illustrated in FIG. 8.”), ¶ 66 (“[F]or individual k for which the client subscribes to *contact information*, the indicator module 110 may determine whether *an address for each data content type . . . has been transmitted from the P&A management server 12.*”) (emphases added).

Figure 8 of Diacakis is reproduced below with Petitioner's annotations. Pet. 37.

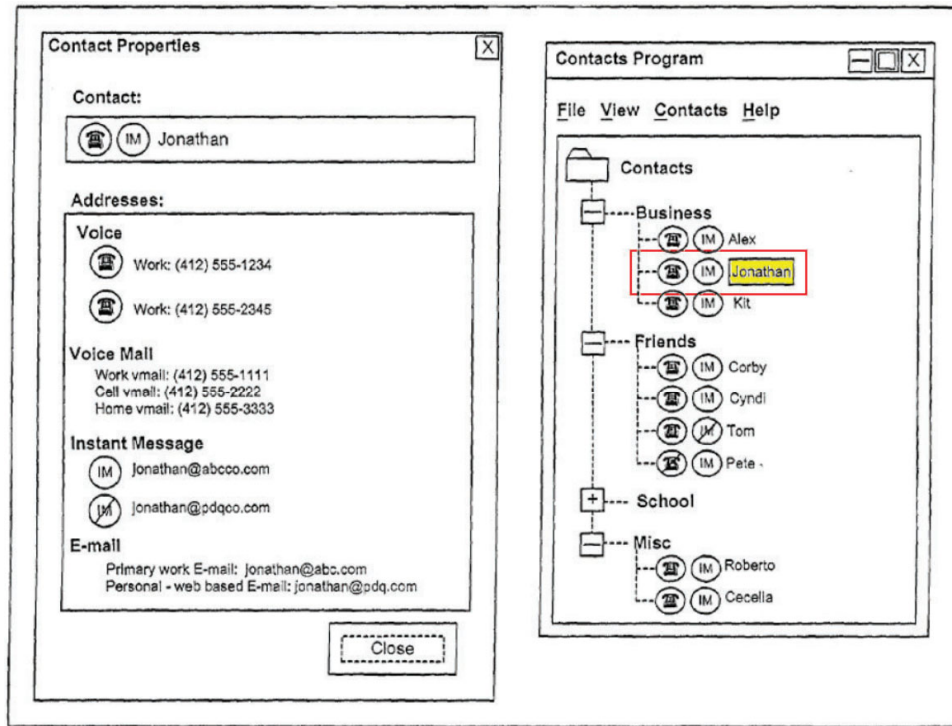


Fig. 8

Annotated Figure 8 of Diacakis above depicts a screen shot of the information that may be displayed to a subscriber at client terminal 22, showing a list of individuals in “Contact Program” window on the right side and the presence and availability (“P&A”) contact information (e.g., telephone numbers, IM addresses, and e-mail addresses) regarding the highlighted individual (e.g., Jonathan) in the “Contact Properties” window on the left side. Ex. 1007 ¶ 56, Fig. 8. “As illustrated, the subscriber may navigate the list of names in the right-hand window (‘Contact Program’) to access the P&A information regarding the highlighted individual in the left-hand window (‘Contact Properties’).” *Id.*

Therefore, Diacakis makes it clear that the users are required to disclose their contact information to each other and the contact information

associated with the second user (e.g., Jonathan) is provided via the “network-based portal” (the “Contact Properties” window on the left side shown in Figure 8). Accordingly, Diacakis does not support Petitioner’s arguments that the users in Diacakis communicate without disclosing their contact information.

In addition, I am not persuaded by Petitioner’s argument that Diacakis discloses that an individual (second user) may specify who sees the individual’s availability information and “separately may ‘control what contact information observers are allowed to view.’” Pet. 38, 47–48 (quoting Ex. 1007 ¶ 7), 55–58; *see id.* at 29 (citing Ex. 1007 ¶¶ 7, 47); Ex. 1003 ¶ 248 (citing Ex. 1007 ¶¶ 6, 7, 47). The challenged claims require “*communications of a plurality of user . . . without requiring the plurality of users to disclose their contact information to each other,*” and “*even when the first message is received by the second user . . . the contact information associated with the second user is not provided via the network-based portal to the first user.*” *See, e.g.,* Ex. 1001, 21:52–59, 22:34–40 (emphases added). The portions of Diacakis relied upon by Petitioner and Dr. Almeroth do not disclose any communication or message (first message) from the “blocked” person (first user) to the individual (second user). Ex. 1007 ¶¶ 6, 7, 47. Indeed, Petitioner and Dr. Almeroth admit that a “blocked” person (who is not allowed to view the individual’s contact information) is not allowed to communicate with the individual. Pet. 45 (“Diacakis makes clear that the *second user* blocks the first user from reaching the second user using the network-based portal.”) (citing Ex. 1007 ¶ 32); Ex. 1003 ¶ 257 (citing Ex. 1007 ¶ 32, Fig. 2). Therefore, the “blocked” person in Diacakis is not the claimed “user” or the claimed “first

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