

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

SECURE WEB CONFERENCE CORPORATION,
Patent Owner.

Case IPR2014-00745
Patent 6,856,687 B2

Before PHILLIP J. KAUFFMAN, JENNIFER S. BISK, and
BEVERLY M. BUNTING, *Administrative Patent Judges*.

KAUFFMAN, *Administrative Patent Judge*.

DECISION ON REHEARING

37 C.F.R. § 42.71(c)

I. INTRODUCTION

Petitioner, Microsoft Corporation, filed a Petition on May 9, 2014, requesting an *inter partes* review of claims 1 and 29 of U.S. Patent No. 6,856,687 B2 (Ex. 1001, “the ’687 patent”). Paper 1 (“Pet.”). Patent Owner, Secure Web Conference Corporation, filed a Preliminary Response on August 21, 2014. Paper 11 (“Prelim. Resp.”). The Board denied institution of an *inter partes* review. Paper 12 (“Decision” or “Dec.”). Petitioner filed a Request for Rehearing asking that the Board reconsider its decision not to institute. Paper 13 (“Req. Reh’g.”).

We grant Petitioner’s request insofar as we have reconsidered our decision on the ground challenged in the rehearing request, but we decline to modify our previous decision.

II. ANALYSIS

In our Decision, the Board denied each ground of unpatentability asserted by Petitioner. Dec. 1, 20-21. In this request for rehearing, Petitioner challenges only our determination with respect to the ground based upon modifying Morris to include encryption. Req. Reh’g. 1. In the Decision, we evaluated this assertion as a ground of unpatentability based upon Morris and Crowley. Dec. 13. For the reasons that follow, that was a mischaracterization.

In Section II.B.2, the Petition put forth the following ground of unpatentability, “[c]laims 1 and 29 are **rendered obvious** under § 103(a) by ’599 in view of Morris ’197 alone or in further view of Cox ’798.” Pet. 6-7; *see also* Pet. 41 (similarly stating the ground). The Decision interpreted this as assertion that the subject matter of claims 1 and 29 was obvious in view

of either Crowley and Morris, or Crowley, Morris and Cox. Dec. 11-15. Regarding obviousness based upon Crowley and Morris the Decision interpreted the Petition to present three alternatives: (1) Morris provides any element missing from Crowley, (2) substitution of Morris' polling technique for Crowley's, and (3) modifying Morris to include encryption as taught by Crowley. Dec. 11-13; *see also* Pet. 41-50 (similarly stating these alternatives).

Regarding the ground that is the subject of this rehearing request (i.e., modifying Morris to include encryption), the Petition states:

As is demonstrated in the claim charts, the only element of claims 1 and 29 that is not disclosed in Morris '197 alone is encryption/decryption, which would have been a common sense modification to Morris '197 if someone wanted to send secure communications with a portable device, which is a known goal prior to the '687 patent. Ex. 1002, Bristow Decl. ¶ 101. At any point in the over 10 years between the filing date of Morris '197 and the earliest possible filing date for the '687 patent, it would have been a simple and obvious modification to add encryption/decryption capabilities to Morris '197 to arrive at claims 1 and 29 of the '687 patent. *Id.* at ¶ 101.

Pet. 43-44; *see also* Ex. 1002 ¶ 101 (essentially repeating this portion of the Declaration).

In interpreting this assertion, the Decision states, “[a]lthough not explicit, Petitioner is asserting that it would have been obvious to modify Morris's device by adding encryption and decryption as disclosed by Crowley.” Dec. 13. A more accurate characterization is that Petitioner contends that because there was a known need for a portable communications encryption/ decryption device, it would have been common sense to modify Morris to include such capability.

A ground of unpatentability based upon obviousness over Morris alone was not properly presented in the Petition. *See* Pet. 6-7, 41. Thus, to the extent that Petitioner's assertion suggests that claims 1 and 29 are unpatentable over Morris alone, such a ground was not properly presented and will not be considered.

To the extent that this assertion was intended as a ground based upon Morris and Crowley, the claim chart identifies an encoding/decoding device in both Crowley and Cox (Pet. 46-47), and the Petition does not specify if the encryption to be added to Morris is found in Crowley or Cox (Pet. 43-44). Nor does the Petition provide a cogent explanation of how such device would be incorporated into Morris. Consequently, Petitioner has not explained sufficiently how claims 1 and 29 are unpatentable. *See* 37 C.F.R. 42.104(b)(4); 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.22(a)(2).

Petitioner's assertion suffers from a second shortcoming, in that Petitioner has not shown adequately that Morris's polling technique corresponds to selecting a configuration as claimed. As detailed in our Decision, independent claims 1 and 29 each require that the device for providing secure communications over a network includes a processor operable to execute code for selecting a configuration of a transmission port and a reception port from among the communication ports. Dec. 9. This selection must be dependent upon the presence of a network communication device or an input-output device in communication with the selected ports. *Id.*

Petitioner contends that Morris discloses a communication port for transfer of audio data (J5, J6, J7), a plurality of communication ports for

transfer of digital data (J1, J3, J8), and selecting a configuration as claimed. Pet. 44-45, 49-50 (citing Ex. 1002, 1:57-60; 2:13-19; Figs. 9A, 9B).

The cited portions of the body of the Specification do not support adequately the contention that Morris discloses selecting a configuration as claimed. *See* Pet. 49-50 (citing Ex. 1002, 1:57-60; 2:13-19). Specifically, Morris discloses that the control unit receives voice and data signals from a plurality of different input sources and routes (switches) these signals to different destinations. Ex. 1005 at 1:57-60. Morris does not explicitly disclose that this routing is done dependent upon the presence of a network communication device or an input-output device. *Id.* Rather, Morris discloses that this routing is dependent upon (1) activation of various switches by the operator, and (2) sense signals sent to the CPU by “various units comprising the communications system.” *Id.* at 2:14-19. Selection based upon activation of switches by the operator does not correspond to selection based upon the presence of an input-output or communication device. Further, Petitioner does not explain cogently how sense signals from various units of the communication system corresponds to selecting a transmission and reception port dependent upon the presence of an input-output or communications device.

The Petition also asserts that Figures 9A and 9B indicate “various selection decisions made based on presence of (a) input/output devices such as speaker phones and cellular phones and (b) network communications devices such as the cellular transceiver unit.” Pet. 49-50. Petitioner identifies Morris’s speaker phone (speaker phone 28) and cellular phone (cellular handset 20) as input/output devices and Morris’s cellular transceiver unit (cellular transmit/receive unit (TRU) 16) as a network

communication device.¹ *See* Pet. 49-50. Therefore, the question presented is whether Petitioner has shown adequately that Morris discloses selecting a configuration of a transmission port and a reception port from among the communication ports (J1, J3, J5-J8) dependent upon the presence of a network communication device (cellular transmit/receive unit (TRU) 16) or an input-output device (speaker phone 28 or cellular headset 20) in communication with the selected ports.

Significantly, Morris details the operation of the overall system as shown in Figures 9A and 9B (Ex. 1005 at 3:7-9; 7:47-9:26); however, Petitioner does not cite nor explain the relevance of this disclosure. *See* Pet. 48-50.

Regarding the operation of cellular transmit/receive unit (TRU) 16 and cellular headset 20, Morris does not disclose that the associated communication ports (J3 and J8, and J7, respectively) are selected depending on the presence of unit 16 or headset 20 in communication with an associated port. Rather, Morris discloses that when a user desires to send a voice call via the cellular system using the cellular handset 20 the operator turns on: the CU power switch (178), cellular headset 20, and TRU power, causing the proper sense signals to be sent to CPU 32 which then applies power to cellular handset 20. Ex. 1005, 8:34-43; Fig. 9A. Subsequently, voice signals from cellular headset 20 are then sent via TRU interface 40 to TRU 16 and radiated via antenna 18 to the external cellular system. *Id.* at 43-50; Fig. 9B. Therefore, selection is dependent on operator switch

¹ Parentheticals are to the corresponding nomenclature in Morris. *See* Ex. 1005, 3:17-23; Figs. 1, 2.

activation and not the presence of a device in communication with a port as claimed.

Regarding the operation of speaker phone 28, Morris discloses that when a user desires to place a voice call via landline, the operator activates the communications software program in computer 12 and dials the desired telephone number to include a code to tell the software it is a voice call (160). Ex. 1005, 7:62-8:2. If telephone-type headset 26 is not plugged in (is headset plugged in 162?), speaker phone 28 is used (use speaker phone 164). *Id.* at 8:2-5. Whether telephone-type headset 26 is plugged in or not, both headset 26 and the speaker phone 28 are operatively connected to J6. Therefore, the selection of the communication port (J6) does not depend on the presence of an input/output device (telephone-type headset 26).² *See* Prelim. Resp. 32 (addressing this shortcoming of the Petition).

Consequently, Petitioner has not established a reasonable likelihood of prevailing on the assertion that claims 1 and 29 are unpatentable over either Morris or Morris and Crowley.

III. ORDER

For the foregoing reasons, it is ORDERED that Petitioner's Request for Rehearing is *granted* to the extent that we reconsider our determination not to institute an *inter partes* review;

FURTHER ORDERED that Petitioner's Request for Rehearing is

² We note that Petitioner relies upon cellular headset 20, not telephone-type headset 26, as an input/output device. *See* Pet. 49-50.

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denied in all other respects.

PETITIONER:

Jeffrey I.D. Lewis
Ryan Mott
Patterson BelknapWebb & Tyler LLP
securewebipr@pbwt.com
rmott@pbwt.com

PATENT OWNER:

Brett Pinkus
Friedman Suder & Cooke
pinkus@fsclaw.com

Wayne Helge
Donald Jackson
Davidson, Berquist, Jackson & Gowdey, L.L.P.
whelge@dbjg.com
djackson@dbjg.com