

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
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

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.”). After considering the Petition and Preliminary Response, we determine that Petitioner has not established a reasonable likelihood of prevailing with respect to any of the challenged claims of the ‘687 patent. *See* 35 U.S.C. § 314(a). Accordingly, we do not institute *inter partes* review of the ‘687 patent based on any of the asserted grounds.

A. *Related Proceedings*

Petitioner indicates that the ‘687 patent was asserted against Petitioner in *Secure Web Conference Corp. v. Microsoft Corp.*, Civil Action No. 2:13-cv-2642-JS-AKT (E.D.N.Y.). Pet. 1. Petitioner also identifies the following judicial proceedings that may affect, or be affected by, a decision in this proceeding: *Secure Web Conference Corp. v. Logitech, Inc.*, Civil Action No. 2:13-cv-3809-JS-AKT (E.D.N.Y.) and *Secure Web Conference Corp. v. Citrix Systems, Inc.*, Civil Action No. 2:13-cv-3810-JS-AKT (E.D.N.Y.). *Id.*

B. Prior Art Relied Upon

Petitioner relies upon the following prior art and declaration of Stephen D. Bristow (Ex. 1002) as its basis for challenging the claims of the ‘687 patent:

| | | | |
|------|---|--------------|---------------|
| 1003 | Crowley | US 5,410,599 | Apr. 25, 1995 |
| 1004 | Cox | US 5,594,798 | Jan. 14, 1997 |
| 1005 | Morris | US 4,991,197 | Feb. 5, 1991 |
| 1006 | International Telecommunication Union (ITU) - “H.323” | ITU-T H.323 | Aug. 3, 1998 |
| 1007 | International Telecommunication Union (ITU) - “H.235” | ITU-T H.235 | July 15, 1998 |

C. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds in challenging the patentability of claims 1 and 29 of the ‘687 patent. Pet. 6-7.

| Basis | Statutory Ground | Claims Challenged |
|---------------------------------------|-------------------------|--------------------------|
| Crowley | § 102 | 1, 29 |
| Crowley, Morris, and Cox ¹ | § 103 | 1, 29 |
| Cox and Morris | § 103 | 1, 29 |
| H.323 and H.235 | § 103 | 1, 29 |
| H.323, H.235, and Morris | § 103 | 1, 29 |

¹ This ground is explained in greater detail in section III.B, below.

D. The '687 Patent

The '687 patent is titled, "Portable Telecommunication Security Device," and relates to a telecommunications security device adapted for use with voice and data communications. Ex. 1001, 1:17-19. For example, a telecommunications system may be configured so that a first user at first location 55 and a second user at second location 55' each has a security device (10, 10') and a communication device, such as: telephone handset or headset (25, 25'), computer (40, 40'), and wireless communication device (50, 50') (e.g., a cellular telephone). *Id.* at 2:30-38, 47-50; Fig., 1. Figure 1 of the '687 patent follows:

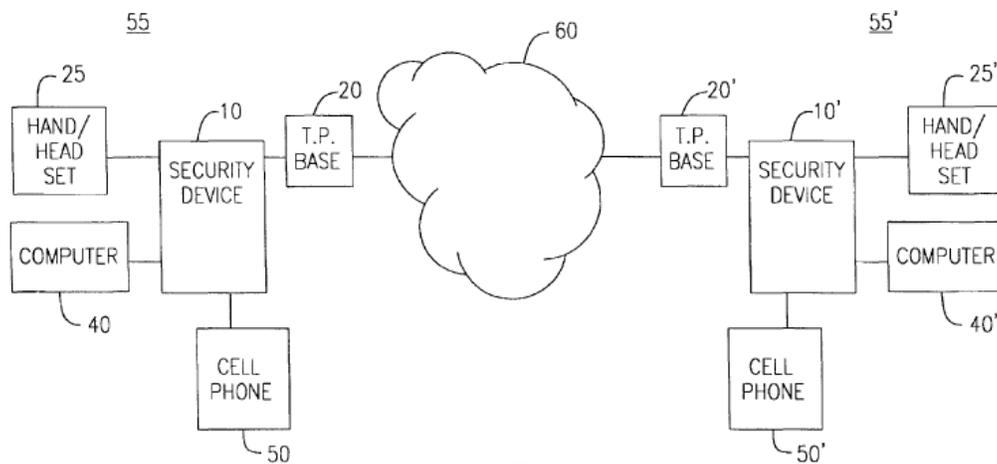


FIG. 1

Figure 1 is illustrates an overview of a communications system of the '687 patent. *Id.* at 63-64.

Security device 10 may include port 255 for receiving/transmitting audio data, port 280 for receiving/transmitting encrypted audio data, keypad 200, encryption/decryption device 220, vocoder 250 that converts audio to digital data, and microcontroller 210. *Id.* at 2:63-3:2; 3:41-44; 4:10-11, 27-29; Fig., 2b. Microcontroller 210 directs digitalized voice data to serial port 280 when the presence of a

wireless communication device is detected at serial data port 280 and when a wireless communication device is not detected at serial port 280, the digitized voice data is directed to port 245. *Id.* at 5:21-29.

The '687 patent contains claims 1-29, of which, claims 1 and 29 are challenged in this proceeding. Claims 1 and 29 are independent. Claim 29 is representative and follows:

29. A device for providing secure communications over a network comprising:
- a communication port for transfer of audio data;
 - a plurality of communication ports for transfer of digital data;
 - a keypad;
 - an encoding/decoding device;
 - a conversion device operable to convert between audio and digital data;
 - a processor, in communication with a memory, said keypad and said encoding/decoding device, operable to execute code for:
 - selecting a configuration of a transmission and a reception port from among said communication ports dependent upon the presence of a network communication device and an input/output device in communication with said selected ports;
 - providing data received from said selected reception port to said encryption/decryption device for encrypting; and
 - providing said encrypted data to said selected transmission port.

Ex. 1001, 10:58-12:6.

Independent claim 1 is similar to claim 29, and differs from claim 29 in two respects: one, claim 1 recites “at least one” communication port for transfer of audio data rather than “a” communication port, and two, claim 1 recites “at least one” communication port for transfer of digital data rather than “a plurality of” such ports. *Id.* at 8:58-9:14; 10:58-12:6.

II. CLAIM CONSTRUCTION

Our analysis necessitates construction of one claim term, namely, “said encryption device”

Petitioner contends that claim 29 is indefinite because the phrase “said encryption/decryption device” lacks an antecedent basis.² Pet 14. Petitioner’s assertion is not accompanied by a cogent supporting explanation. The lack of an antecedent basis for a term does not render a claim per se indefinite. *See Energizer Holdings Inc. v. United States ITC*, 435 F.3d 1366, 1370-71 (Fed. Cir 2006).

Before reciting the challenged phrase “said encryption/decryption device,” claim 29 recites that the device for providing secure communications over a network includes “an encoding/decoding device.”

The Specification describes that microcontroller 210 (processor) of security device 10' at site 55', in conjunction its encryption/decryption device 220, encodes information that is decoded at site 55. Ex. 1001 at 2:30-38; 6:29-34; Figs., 1, 2a.

² Claim 1 is similar in this respect.

Consequently, the ‘687 patent uses encoding and encryption as synonyms.

In light of this, a person of ordinary skill in the art would understand that “said encryption device” has antecedent basis in “an encoding/decoding device.”³

III. ANALYSIS

A. *Alleged Anticipation by Crowley*

Petitioner alleges that claims 1 and 29 are anticipated by Crowley. Pet. 32-41. As detailed below, Petitioner has not made an adequate showing with regard to at least the claimed keypad and processor that selects a configuration.

Keypad

Independent claims 1 and 29 each require that the device for providing secure communications over a network includes a keypad. Petitioner contends that Crowley’s V/DED (Voice and Data Encryption device) inherently includes a keypad. Pet. 35-36. Patent Owner contends that Crowley does not inherently disclose a keypad as claimed because entry of an appropriate encryption key may be accomplished in a manner other than with a keypad. Prelim. Resp. 17-19.

Crowley’s V/DED is a security module designed specifically for use with analog cellular and public switched telephone systems,

³ We note that a ground of unpatentability based upon indefiniteness under 35 U.S.C. § 112, second paragraph, may not be asserted in an *inter partes* review. See 37 C.F.R. § 42.104(b) (2).

computers, facsimiles machines, and other equipment. Ex. 1003 at 1:46-50. Until a user desires secure communications, Crowley's V/DED operates in "by-pass" mode (i.e., analog or digital signals go directly to the private switched telephone network or are transmitted over the cellular network without processing by the V/DED). *Id.* at 4:29; 6:28-32. When a user wants to engage secure communications, the security setup is invoked and keys for encryption are loaded in the encryption engine. *Id.* at 6:33-35. Crowley discloses that the security setup may be invoked in several ways, including the method cited by Petitioner, namely, for each party to know the appropriate encryption key for a given day and to enter that key in the V/DED. *Id.* at 6:33-7:1; Pet. 35-36; Ex. 1002 ¶ 92 (repeating the claim chart found in the body of the Petition).

As Patent Owner points out, there are methods for entry of an encryption key that do not involve a keypad (e.g., entry via transmission to the V/DED), so that Crowley's disclosure that a key is entered does not necessarily mean that a keypad is involved. Prelim. Resp. 17-19. Petitioner has not established adequately that a person of ordinary skill in the art would recognize that Crowley necessarily discloses a keypad.⁴ *See Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991); *see also In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981) (Inherency may not be established by probabilities or possibilities, and the mere fact that a certain thing may

⁴ Because Petitioner has not adequately established that Crowley does not disclose a keypad, Petitioner has also not adequately established that Crowley discloses a processor in communication with a keypad as required by claims 1 and 29.

result from a given set of circumstance is not sufficient for establishing inherency.).

Selecting a configuration

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. This selection must be dependent upon the presence of a network communication device or an input-output device in communication with the selected ports. In parity with the claim language, the Specification describes, by way of example, that security device 10 establishes various configurations (blocks 635, 640, 645, 66) by determining if a device is attached to the first and second serial ports (blocks 625, 630, 650). Ex. 1001 at 8:30-46; Fig., 6; *see also* Ex. 1001 5:21-32; Fig., 2*b* (microcontroller 210 establishes various configurations based upon presence of a communication device at various ports). The Specification clarifies that even though device 10 can operate to transmit and receive, the ports are referred to by their role in the transmitting mode. Ex. 1001 at 3:2-13. In other words, although the transmission port and reception port reverse functional roles when device 10 switches from transmitting to receiving mode, the ports retain their designation.

Petitioner contends that Crowley's V/DED is comprised of three modules: the Voice/Data Module (VDM), the Encryption and Control Module (EM), and the Modem Module (MM). Pet. 20, 36. Further, according to Petitioner, the EM includes Control Logic that

corresponds to a processor as claimed, and utilizes a public or proprietary polling technique (determining if another device is connected and has data to transmit) that corresponds to selecting a configuration of transmission and reception ports as claimed. Pet. 37-38 (citing Ex. 1003, 5:4-7; Fig., 4; Ex. 1002 ¶¶ 77-83).

Crowley's V/DED is a small portable device that may be used with a variety of equipment to send and receive encrypted data to a destination via either normal telephone lines, a private switched telephone network (PSTN), or a local area network. Ex. 1003 at 4:26-30. For example, as a transmitting device, V/DED 3 receives data (from one of: unmodified telephone communication equipment 1, computer 5, or facsimile machine 7), then encrypts that data, and subsequently transmits the data through a single outgoing line (e.g., a normal telephone line, PSTN, cellular telephone application, or local area network) to another V/DED 9. *Id.* at 4:35-40, 53-56; Fig., 1. The operation is reversed when the V/DED operates as a receiving device. *Id.* at 5:53-59; Fig., 1. That is, encrypted data is received from a single source, decrypted, and transmitted to one of the receiving devices (communication equipment 1, computer 5, or facsimile machine 7). *Id.*

Therefore, when Crowley's V/DED is transmitting, at most the polling technique could correspond to selecting a reception port as claimed by determining which device (communication equipment 1, computer 5, or facsimile machine 7) has data to transmit. Crowley does not select a transmission port on any basis; rather, Crowley utilizes a single transmission port. *See* Prelim. Resp. 25.

Accordingly, Petitioner has not demonstrated that Crowley discloses the keypad and processor that selects a configuration of claims 1 and 29. Accordingly, we determine that Petitioner has not established a reasonable likelihood of prevailing on the assertion that claims 1 and 29 are anticipated by Crowley.

B. Alleged Obviousness over Crowley, Morris, and Cox

Petitioner asserts that claims 1 and 29 “are **rendered obvious** under 103(a) by Crowley ’599 in view of Morris ’197 alone or in further view of Cox ’798.” Pet. 6-7. Based upon this, Petitioner asserts that claims 1 and 29 are unpatentable over: (1) Crowley and Morris, and (2) Crowley, Morris, and Cox.

1. Crowley and Morris

Petitioner presents alternative versions of the ground of unpatentability based upon Crowley and Morris.

a. Morris provides any element missing from Crowley

Petitioner contends that “to the extent that any feature of claims 1 and 29 are not expressly disclosed in Crowley ’599, the features are disclosed in Morris ’197 and Cox ’798.”⁵ Pet. 41. This assertion does not state with particularity the differences between the reference (Crowley) and the subject matter of the claims challenged. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (citing with approval the four part obviousness test of *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), that includes determining the differences

⁵ Here we address Crowley and Morris, and in Section III.B.2., we address Crowley, Morris, and Cox.

between the claims at issue and the prior art). Petitioner's general contention that if anything is missing from Crowley it may be found in Morris leaves us to speculate how the references are combined, and does not explain sufficiently how the claimed subject matter is unpatentable. *See* 37 C.F.R. § 42.104(b) (4); *see also* Prelim. Resp. 36-38 (pointing out the lack of detail in Petitioner's assertion).

b. Substitution of Morris's polling technique for Crowley's

Petitioner contends that it would have been obvious to substitute Morris's polling technique for Crowley's. Pet. 42, 48-50. Petitioner reasons that a person of ordinary skill would have been motivated to make such modification because Crowley and Morris each disclose a polling technique. Pet. 41-42; Ex. 1002 ¶ 98.

As detailed in section III.A above, Crowley does not disclose a processor that selects a configuration as required by claims 1 and 29. Petitioner does not utilize Morris to cure this deficiency in Crowley. Petitioner proposes to substitute Morris's polling technique with Crowley's polling technique for selecting a reception port. The resulting device selects a reception port but not a transmission port. Consequently, Petitioner's ground of unpatentability does not reach the subject matter of claims 1 and 29.

Beyond this shortcoming, Petitioner's rationale is unpersuasive. Petitioner asserts that it would have been obvious to substitute Morris's polling technique for Crowley because each discloses a polling technique. Pet. 41-42; Ex. 1002 ¶ 98. Petitioner does not identify any advantage gained by this modification. *Id.* Petitioner explains what is to be done (substitution of the polling techniques),

but fails to provide the requisite reason that a person of ordinary skill in the art would have chosen to do so. *See KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007).

c. Modification of Morris to add encryption

Petitioner contends that Morris discloses every element of the claimed subject matter except encryption, and that it would have been obvious to add encryption/decryption capability. Pet. 43 (citing Ex. 1002 ¶ 101). Although 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. Petitioner reasons that this modification would, "meet the need of maintaining security of valuable information through a portable 'security module' as stated in Crowley." Pet. 41; *see also* Pet 43 (similarly reasoning that modifying Morris would permit secure communications with a portable device). As stated above, Crowley's V/DED is a small portable device that may be used with a variety of equipment to send and receive encrypted data. *See* Ex. 1003 at 4:26-30. Because Crowley is already a portable device that secures valuable information, Petitioner's reasoning that the proposed modification creates a portable device that likewise secures valuable information, lacks an adequate rational underpinning.

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

2. *Crowley, Morris, and Cox*

Petitioner contends that “to the extent that any feature of claims 1 and 29 are not expressly disclosed in Crowley ’599, the features are disclosed in Morris ’197 and Cox ’798.” Pet. 41. Here, as in the ground of unpatentability based upon Crowley and Morris in Section III.B.1.a above, Petitioner’s general contention that if anything is missing from Crowley it can be found in Morris or Cox leaves us to speculate how the references are combined, and does not sufficiently explain how the claimed subject matter is unpatentable. *See* 37 C.F.R. § 42.104(b) (4); *see also* Prelim. Resp. 36-38 (pointing out the lack of detail in Petitioner’s assertion).

This ground of unpatentability also lacks a sufficient rationale. Petitioner reasons that a person of ordinary skill in the art would have been motivated to combine the features of Crowley and Cox because both are directed to solving the same need. Pet. 42 (presumably referring to the previously identified need of securing valuable information with a portable device at Pet. 41.). Petitioner’s contention that the references solve the same need is better characterized as a contention that the references are analogous art than as a rational underpinning for the proposed combination. *See In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379-80 (Fed. Cir. 2007) (holding that a reference may be reasonably pertinent as analogous art where the matter it deals with logically would have commended itself to the inventor’s attention). Petitioner has not articulated adequate reasoning based on a rational underpinning to explain why a person of ordinary skill in the art would have been led to modify Crowley in

view of Morris and Cox to reach the subject matter of independent claims 1 and 29.

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

C. Alleged Obviousness over Cox and Morris

Petitioner alleges that the subject matter of claims 1 and 29 would have been obvious over Cox and Morris. Pet. 51-52 (incorporating the claims chart at Pet. 44-50). Specifically, Petitioner contends that Cox discloses all the elements of claims 1 and 29 except multiple ports and port selection, and that Morris discloses all the elements of claims 1 and 29 except encryption and decryption. Pet. 51. Petitioner reasons that a person of ordinary skill in the art would have combined Cox and Morris because of the known need for a portable security device. *Id.* Further, according to Petitioner, a person of ordinary skill in the art would recognize that Morris's interface could be used in Cox's device. Pet. 51-52.

Cox discloses a secure telephone device (STD) for use between calling and called parties. Ex. 1004 at 1:40-43. The STD may, for example, be disposed between the headset and base of a telephone. *Id.* at 43-44; Fig., 1. Because Cox's STD is already a portable security device, Petitioner's reasoning that a person of ordinary skill in the art would have combined Cox and Morris to create a portable security device, lacks an adequate rational underpinning. Further, Petitioner's assertion that a person of ordinary skill in the art would

recognize that Morris's interface could be used in Cox's device, is an assertion that the modification is possible, and is not a reason why it would have been done. *See* Pet. 51-52.

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

D. Alleged Obviousness over H.323 and H.235

Petitioner contends that claims 1 and 29 would have been unpatentable over H.323 and H.235. Pet. 52-58. As detailed below, Petitioner has not made an adequate showing at least with regard to a processor operable to execute code to select a configuration as claimed and a processor in communication with a memory as claimed.

Operable to select a configuration

Petitioner contends that H.323 discloses a System Control Unit that corresponds to a processor as claimed. Pet. 56 (citing Ex. 1006 at 19; fig. 4). According to Petitioner, the System Control Unit includes H.245 Control Function. Regarding the ability of the System Control Unit of H.323 to execute code for selecting a configuration as claimed, Petitioner contends:

The H.245 Control Function and other elements within H.323 route the information or media streams between the input/output devices and network communication devices depending on the presence and need of the various devices. H.323 notes that the Control Channel carries "end-to-end control messages governing the operation of the H.323 entity, including capabilities exchange, opening and closing of logical channels,

mode preference requests, flow control messages and indications.” Ex. 1006, p. 19.

Pet. 56-57.⁶

Petitioner has not demonstrated adequately that H.323 discloses selecting a configuration as claimed. The portion of the reference cited by Petitioner does not mention explicitly selection of a port based upon the presence of a network communication or input/output device. The reference discloses that the Control Channel carries control messages governing operation of the H.323 entity including: capabilities exchange, opening and closing of logical channels, mode preference requests, flow control messages and indications. Ex. 1006 ¶ 6.2.8; *see also* ¶ 6.2.2 (listing similar capabilities). Petitioner has not explained adequately how this disclosure corresponds to the claimed step of selecting a configuration of a transmission and a reception port based upon the presence of a network communication device and an input/output device in communication with those ports.

In communication with a memory

Claims 1 and 29 require that the processor is in communication with a memory. Petitioner contends that the System Control Unit of H.323 corresponds to a processor as claimed, and inherently includes a memory. Pet. 56 (citing Ex. 1006, Fig., 4). Notably, Petitioner has not addressed the claim limitation in that claims 1 and 29 do not require that the processor include a memory; rather, what is required is that the processor be in communication with the memory. Further, Petitioner’s assertion that memory is inherent in H.323’s System

⁶ This portion of the Petition does not contain a citation to the Declaration of Mr. Bristow (Ex. 1002).

Control Unit simply cites to a figure. That figure does not depict a memory, nor has Petitioner explained cogently how this figure demonstrates that the processor is in communication with a memory. As such, Petitioner has not demonstrated adequately that H.323 necessarily discloses a processor that is in communication with memory as required by claims 1 and 29.

Consequently, we are not persuaded there is a reasonable likelihood that Petitioner would prevail in establishing that claims 1 and 29 are unpatentable over H.323 and H.235.

E. Alleged Obviousness over H.323, H.235, and Morris

Petitioner contends that it would have been obvious to modify the H.323 and H.235 combination to include network control as disclosed in Morris. Pet. 58-59. This ground of unpatentability, like the previous ground, relies upon Petitioner's assertion that the System Control Unit of H.323 corresponds to a processor as claimed and inherently includes a memory. *Id.* Petitioner does not rely upon Morris to overcome this shortcoming. *Id.* Therefore, this assertion is deficient for the reasons discussed above.

Consequently, we are not persuaded there is a reasonable likelihood that Petitioner would prevail in establishing that claims 1 and 29 are unpatentable over H.323, H.235, and Morris.

IV. CONCLUSION

Based on the arguments and evidence presented in the Petition, we conclude that Petitioner has not demonstrated a reasonable

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likelihood it will prevail in showing claims 1 and 29 of the '687 patent are unpatentable. We, therefore, do not institute an inter partes review on any of the asserted grounds as to any of the challenged claims.

V. ORDER

Accordingly, it is

ORDERED that the petition is *denied*; and

FURTHER ORDERED that *no inter partes* review of the '687 patent is instituted.

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