

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, LLC,  
Petitioner,

v.

K.MIZRA LLC,  
Patent Owner.

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IPR2022-00166  
Patent 7,394,423 B2

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Before MITCHELL G. WEATHERLY, NATHAN A. ENGELS, and  
JASON W. MELVIN, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. BACKGROUND

Unified Patents, LLC (“Petitioner”) filed a petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–34 (the “challenged claims”) of U.S. Patent No. 7,394,423 B2 (Ex. 1001, “the ’423 patent”). 35 U.S.C. § 311. K.Mizra LLC (“Patent Owner”) timely filed a Preliminary Response.

Paper 6 (“Prelim. Resp.”). We may institute an *inter partes* review when “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). Because we conclude that Petitioner is reasonably likely to prevail with respect to at least one of the challenged claims, we institute *inter partes* review of all challenged claims.

Petitioner challenges the patentability of claims as follows:

<b>Claims challenged</b>	<b>35 U.S.C. §</b>	<b>References</b>
1–5, 8, 11–15, 23–28, 31, 34	103	McCalmont, <sup>1</sup> Chang <sup>2</sup>
6, 16, 29	103	McCalmont, Chang, Masumoto <sup>3</sup>
7, 17–19, 22, 30	103	McCalmont, Chang, Zonoun <sup>4</sup>
9, 10, 32, 33	103	McCalmont, Chang, Vanacore <sup>5</sup>
20, 21	103	McCalmont, Chang, Zonoun, Vanacore
1–5, 8, 11–15, 23–28, 31, 34	103	Hanson, <sup>6</sup> McCalmont
6, 16, 29	103	Hanson, McCalmont, Masumoto
7, 17–19, 22, 30	103	Hanson, McCalmont, Zonoun
9, 10, 32, 33	103	Hanson, McCalmont, Vanacore
20, 21	103	Hanson, McCalmont, Zonoun, Vanacore

<sup>1</sup> U.S. Patent No. 6,771,742 B2 (Ex. 1004, “McCalmont”).

<sup>2</sup> U.S. Patent No. 7,286,648 B1 (Ex. 1006, “Chang”).

<sup>3</sup> U.S. Patent No. 5,210,540 (Ex. 1007, “Masumoto”).

<sup>4</sup> International Publication WO 2002/33897 A2 (Ex. 1008, “Zonoun”).

<sup>5</sup> U.S. Patent No. 5,249,223 (Ex. 1009, “Vanacore”).

<sup>6</sup> U.S. Patent No. 6,868,074 B1 (Ex. 1005, “Hanson”).

Generally, Patent Owner contends that the Petition should be denied in its entirety. On April 24, 2018, the Supreme Court held that, under 35 U.S.C. § 314, the Office may not institute review of fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). For the reasons expressed below, we determine that Petitioner has demonstrated a reasonable likelihood of establishing that at least claim 1 is unpatentable. In accordance with the *SAS* decision and Office guidance,<sup>7</sup> we institute an *inter partes* review of all challenged claims of the '423 patent on all grounds alleged by Petitioner.

#### B. RELATED PROCEEDINGS

The parties identify as a related proceeding the co-pending district court proceeding of *K.Mizra LLC v. General Motors LLC*, No. 2-21-cv-00244 (E.D. Tex.) (the “Related Litigation”). Pet. 79; Paper 4, 2.

#### C. THE '423 PATENT

The '423 patent relates to systems and methods for “initiating and handling an emergency IP request using an IP enabled device having GPS capability.” Ex. 1001, code (57). One embodiment of the system is illustrated in Figure 1, reproduced below.

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<sup>7</sup> “Guidance on the impact of *SAS* on AIA trial proceedings” (Apr. 26, 2018), accessible at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial> (last accessed Oct. 2, 2018) (“At this time, if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition,” and “for pending trials . . . the panel may issue an order supplementing the institution decision to institute on all challenges raised in the petition.”).

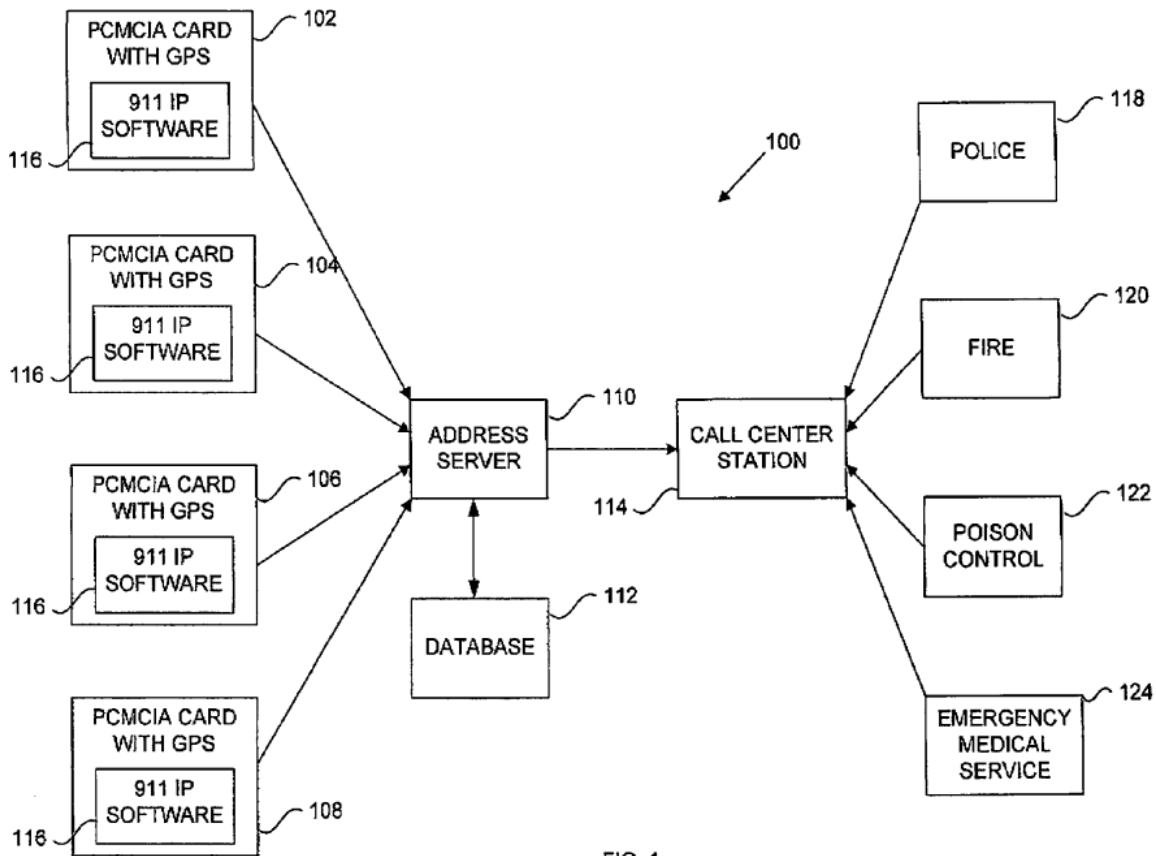


FIG. 1

Figure 1 schematically illustrates an IP-based 911 system 100. *Id.* at 3:45–46.

System 100 includes a plurality of IP-enabled devices 102, 104, 106, and 108, which also include Global Positioning System (“GPS”) location hardware. For example, device 102 obtains global positioning data, and sends an emergency IP request to server 110 if an emergency criterion is satisfied. *Id.* at 4:3–14. Server 110 obtains local emergency services data based on the global positioning data, dials the call center 114 (e.g., an emergency services operator) based on the local emergency services data and passes an emergency call to call center 114. *Id.* at 4:17–23.

Claims 1, 12, and 23 are the independent claims among the challenged claims, and claim 1, which is representative, recites:

1. [1P] A computer program for handling an emergency Internet Protocol request from an Internet Protocol enabled device having Global Positioning Systems capability, the computer program comprising:

[1A] a code segment for monitoring software on the Internet Protocol enabled device for at least one of: a collision, heat, smoke, and vital signs;

[1B] a code segment for receiving the emergency Internet Protocol request containing global positioning data for the Internet Protocol enabled device, wherein the receiving is based on the monitored software;

[1C] a code segment for obtaining local emergency services data based on the global positioning data;

[1D] a code segment for dialing a call center station based on the local emergency services data; and

[1E] a code segment for passing an emergency call from the Internet Protocol enabled device to the call center station.

*Id.* at 5:26–43 (we adopt Petitioner’s numbered and bracketed labels for specific limitations to ease discussion).

## II. DISCRETIONARY DENIAL UNDER § 314(A)

Patent Owner informs us that the Related Litigation “has been settled,” Prelim. Resp. 2, and we have noted that the Related Litigation has been dismissed with prejudice, Ex. 3001. Petitioner was not a party to the Related Litigation. *See* Ex. 3001 (identifying Patent Owner and General Motors LLC as the parties in the Related Litigation). Based on this development, Patent Owner argues that we should exercise discretion under § 314(a) and deny the Petition because “no other active disputes regarding the ‘423 Patent” exist and “none are currently contemplated.” Prelim. Resp. 2. Patent Owner reasons that “institution will only lead to unnecessary proceedings and waste the resources of both parties and the

Board.” *Id.* Patent Owner further contends that the “strain on the Board’s resources” is especially unnecessary because we would be scheduled to enter a Final Written Decision “only months before the patent would expire anyway” on October 21, 2023. *Id.* at 2–3 (citing *Facebook, Inc. v. EveryMD.com, LLC*, Case IPR2018-00050, Paper 19 (PTAB Oct. 9, 2018) “*Facebook*”).<sup>8</sup> Patent Owner concludes that, because “[n]o good reason exists to proceed with the instant Petition, . . . the Board should dismiss the Petition in its entirety.” *Id.* at 3.

We decline to exercise discretion under § 314(a) to deny the Petition. Initially, we note that Patent Owner does not rely upon or discuss *General Plastic Industries Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, Paper 19 (Sept. 6, 2017) (precedential) or *Apple Inc. v. Fintiv, Inc.*, Case IPR2020-00019, Paper 11 (March 20, 2020) (precedential), which present two analytical frameworks under which the Board typically determines whether discretionary denial may be appropriate. *See generally* Prelim. Resp. Rather, Patent Owner presents a novel rationale for discretionary denial under § 314(a), namely, that “no good reason exists to proceed” for a variety of reasons, none of which is persuasive for the reasons expressed below.

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<sup>8</sup> We find that the *Facebook* decision does not support discretionarily denying the Petition. In *Facebook*, the Board terminated the trial and vacated its institution decision because addressing claims proposed in a motion to amend would have been futile. *Facebook* at 9. The original claims had been finally adjudicated to be invalid as directed to ineligible subject matter under 35 U.S.C. § 101. *Id.* at 2–3. The Board reasoned that, even if the proposed claims were found to be patentable, the claims would never take effect because a certificate pursuant to 35 U.S.C. § 318(d) would not issue until after the expiration of the patent. *Id.* at 7–8.

We disagree with Patent Owner’s contention that no “active disputes regarding the ‘423 Patent” exist “and none are currently contemplated.” The filing of the Petition initiates an “active dispute” regarding the ’423 patent, which currently remains pending.

We disagree with Patent Owner’s contention that instituting a trial would “waste the resources of both parties” for two reasons. First, Patent Owner provides no evidence that it is authorized to speak for Petitioner on whether a trial would waste Petitioner’s resources. Second, Petitioner has not indicated that institution of trial would waste its resources. To the contrary, we infer from the filing of the Petition that Petitioner wishes to expend resources on an *inter partes* review of the ’423 patent.

As for whether the approaching expiration of the ’423 patent results in the Board wasting resources by instituting *inter partes* review, we note that a patent owner is entitled to sue to recover damages for patent infringement occurring up to “six years prior to the filing of the complaint or counterclaim for infringement.” 35 U.S.C. § 286. Thus, for a few years after we would be scheduled to enter a Final Written Decision, Patent Owner would remain entitled to seek damages for infringement of the ’423 patent. *Id.* We, therefore, disagree that the expiration of the ’423 patent on October 21, 2023, renders it “unnecessary” to expend the Board’s resources on a trial.

For all these reasons, we are not persuaded to deny the Petition by exercising discretion under § 314(a).

### III. ANALYSIS

#### A. CLAIM INTERPRETATION

For petitions such as this one that are filed after November 13, 2018, we interpret claims in the same manner used in a civil action under

35 U.S.C. § 282(b) “including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2019). When applying that standard, we interpret the claim language as it would be understood by one of ordinary skill in the art in light of the specification. *Wasica Finance GmbH v. Continental Automotive Sys., Inc.*, 853 F.3d 1272, 1279–80 (Fed. Cir. 2017). Thus, we give claim terms their ordinary and customary meaning as understood by an ordinarily skilled artisan. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Petitioner argues that we should interpret “at least one of: a collision, heat, smoke, and vital signs” as recited in claim 1 such that “at least one of” applies to the entire list of four items that follows the phrase rather than each item in the list. Pet. 6–8. That is, Petitioner contends that the claimed “computer program” need only have a “code segment for monitoring” for any one of “a collision, heat, smoke, and vital signs” rather than at least one of each of the listed items. *Id.*

Claim 1 also recites a “computer program” comprising five “code segment[s] for” performing various functions. Ex. 1001, 5:26–43. Petitioner, with support from testimony by Mr. Anthony Wechselberger, argues that “code segment for” does not invoke interpretation under 35 U.S.C. § 112, ¶ 6 because “code” is commonly understood as referring to “written computer instructions (i.e. software)” and “code segment” is the



portion (i.e. segment) of the software performing the function.” Pet. 9; Ex. 1003 ¶ 35. Petitioner concludes that we should, therefore, interpret each “code segment for” as merely referring to “software for” performing the function recited in each of the five respective limitations. *Id.* at 9.

Patent Owner does not interpret expressly any of these terms (*see generally* Prelim. Resp.). Solely for the purpose of deciding whether to institute *inter partes* review, we adopt Petitioner’s proposed interpretations of both phrases discussed above. Our adoption of Petitioner’s proposed interpretations of both phrases does not constitute an opinion that they are correct, and we encourage the parties to address claim interpretation expressly during the trial.<sup>9</sup>

#### B. LEGAL STANDARDS

Petitioner challenges the patentability of claims 1–34 on the grounds that the claims are obvious in light of various references. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), reaffirmed the framework for determining obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The *KSR* Court summarized the four factual inquiries set forth in *Graham* that we apply in determining whether a claim is reasonably likely to be unpatentable as obvious under 35 U.S.C. § 103(a) as follows: (1) determining the scope and content of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, (3) resolving the level of ordinary skill in the pertinent art, and (4) considering objective evidence indicating obviousness or

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<sup>9</sup> *See, e.g., Dyfan, LLC v. Target Corp.*, 28 F.4th 1360, 1368 (Fed. Cir. 2022) (addressing whether “code . . . configured to” should be interpreted as a means-plus-function limitation).

nonobviousness. *KSR*, 550 U.S. at 406. With these standards in mind, we address Petitioner's first challenge below.

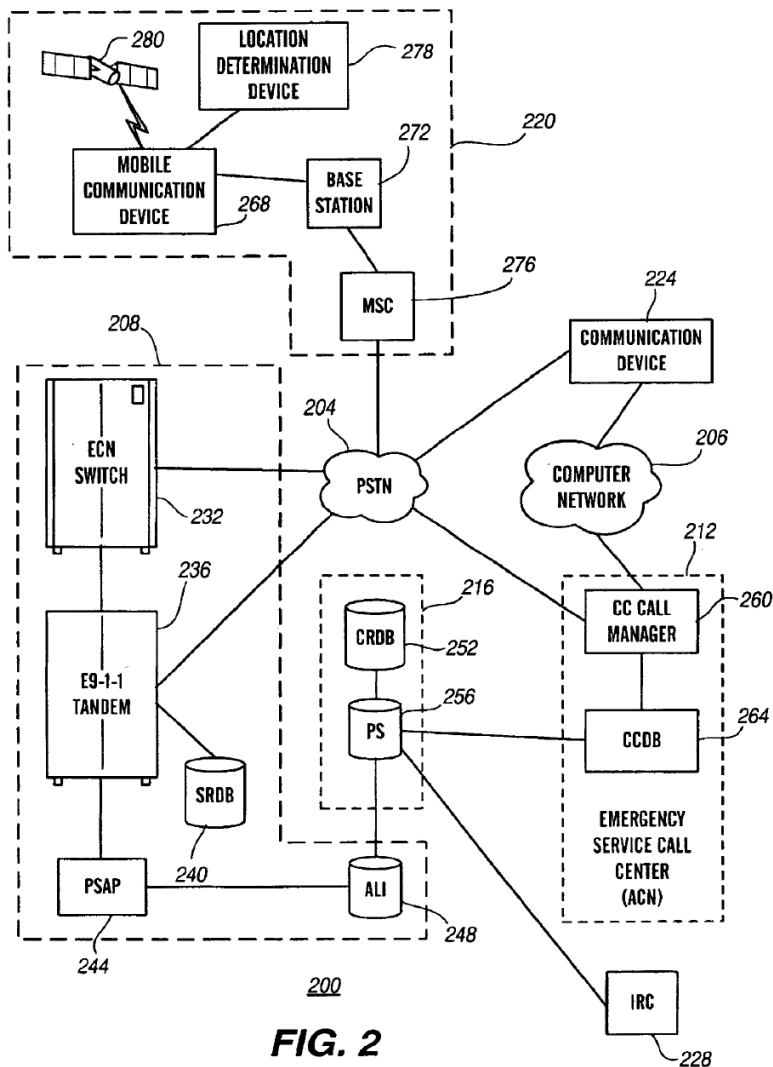
C. GROUND 1, CLAIMS 1–5, 8, 11–15, 23–28, 31, AND 34:  
OBVIOUSNESS IN VIEW OF MCCALMONT AND CHANG

Petitioner argues that the combined teachings of McCalmont and Chang render claims 1–5, 8, 11–15, 23–28, 31, and 34 unpatentable as obvious. Pet. 10–43. Patent Owner does not proffer counter arguments or submit evidence opposing the merits of Petitioner's arguments relating to this ground or any other. *See generally*, Prelim. Resp. (arguing only that we should discretionarily deny the Petition). Because Petitioner's arguments are currently undisputed, we address only claim 1 as challenged over McCalmont and Chang.

1. Overview of the Combination

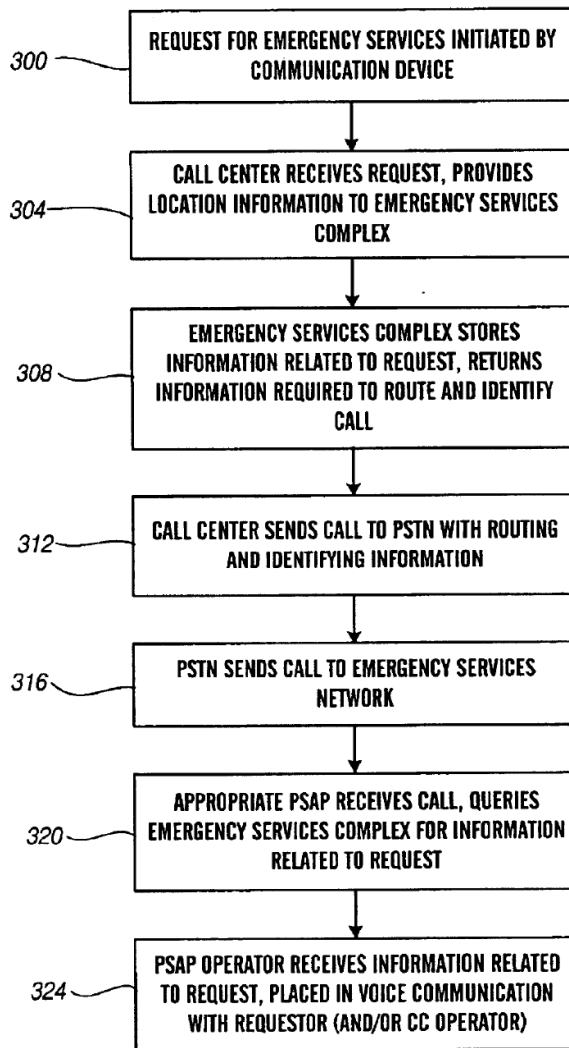
a. McCalmont

Petitioner contends that McCalmont is prior art under 35 U.S.C. § 102(e). Pet. 1. McCalmont “relates to the routing of emergency services calls from call centers to public safety answering points, and to the provision of data in connection with such calls.” Ex. 1004, 1:15–19. McCalmont’s network, illustrated in Figure 2 (reproduced at right), includes mobile device 268 and communication device 224, either of which can



communicate with emergency service call center 212. The “emergency service communication device 224 may include a premises alarm, a personal alarm, a VoIP telephone, or another communication device capable of initiating or conveying a request for emergency services to an emergency service call center 212.” *Id.* at 7:8–12. Mobile communication device 268 includes a GPS receiver capable of receiving signals from GPS satellites 280. *Id.* at 11:8–10.

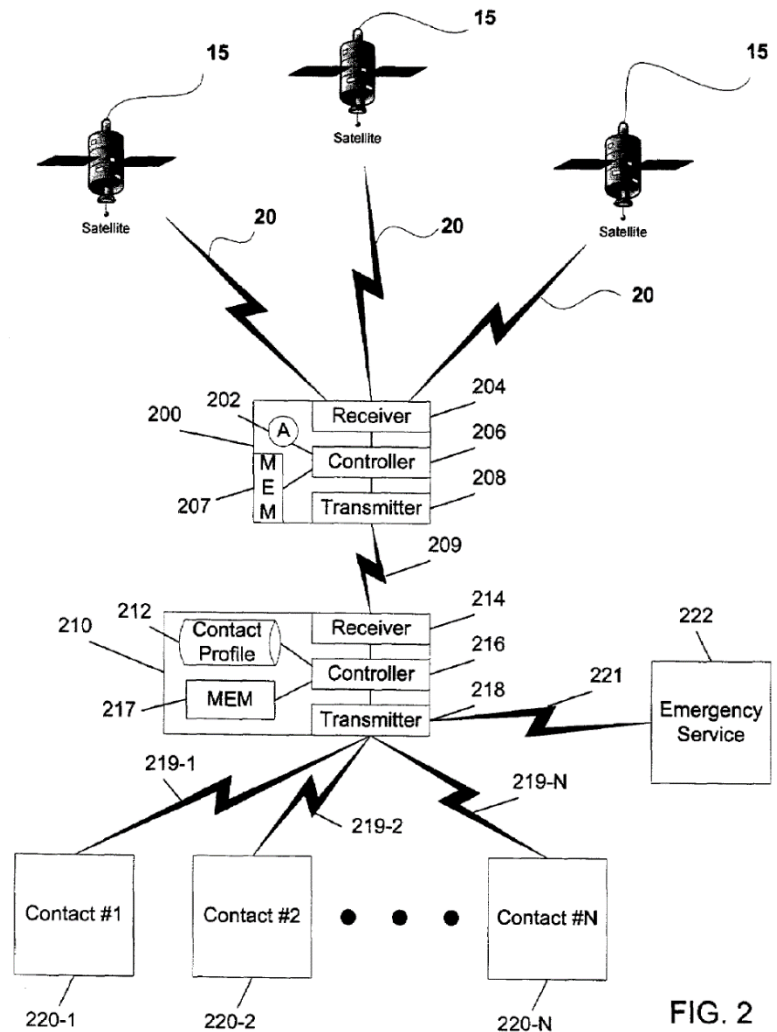
The operation of McCalmont's network is illustrated in its Figure 3 (reproduced at right), which is a flow chart depicting in overview the delivery of an emergency services call and data to a public safety answering point ("PSAP"). *Id.* at 6:54-56. An emergency services request 300 is initiated by, for example, communication device 224 to call manager 260 which, at step 304, provides call information (including location) to emergency services complex 216. *Id.* at 12:16-18, 12:40-42. At step 308, emergency services complex 216 returns a routing number and an identifier for accessing stored information to the call center. *Id.* at 13:15-24. At steps 312, 316, and 320, the call is routed to a PSAP, using the routing number as the called number. *Id.* at 13:25-55.



**FIG. 3**

b. Chang

Petitioner contends that Chang is prior art under 35 U.S.C. § 102(e). Pet. 1. Users of Chang’s system “who are in danger can activate a device, which can trigger a notification to the appropriate emergency service for that area, as well as to the telephone numbers, pager numbers, email addresses, etc., of a predefined list of emergency contacts.” Ex. 1006, 1:54–58. Chang’s Figure 2 (reproduced at right) is a block diagram of the system. *Id.* at 2:17–18. The system includes base station 210 coupled to remote device 200. *Id.* at 4:60–63. In operation, when remote device 200 “detects the occurrence of a triggering event,” it “transmits a location signal to the base station.” *Id.* at 7:3–20.



c. Motive to Combine

Petitioner recognizes that, although McCalmont describes its mobile communication device 268 as being GPS-enabled, McCalmont provides fewer details about the “architecture” of its communications device 224, which may be a VoIP telephone among other types of devices. Pet. 13. We

note that McCalmont does not appear to expressly describe its communication device as being GPS-enabled. *See* Ex. 1004, Fig. 2 (illustrating GPS only with mobile communication device 268). However, Petitioner argues that an ordinarily skilled artisan would have been motivated to seek information from references in the same field as McCalmont, like Chang, for such details. *Id.* at 13–14 (citing Ex. 1003 ¶ 55).

Petitioner argues that an ordinarily skilled artisan would have been motivated to include Chang’s GPS receiver 204 in McCalmont’s communication device 224. *Id.* (citing Ex. 1003 ¶¶ 56–58). McCalmont describes using GPS-based locator services in connection with its mobile communication device 268, Ex. 1004, 11:8–10, and Petitioner notes that McCalmont suggests that “[f]or a VoIP connection, the **location of the caller is critical** for determining the appropriate PSAP for getting help to the caller,” Pet. 14 (quoting with emphasis Ex. 1004, 4:31–33). Petitioner also notes that an ordinarily skilled artisan would have been aware of the FCC’s mandate in 1996 requiring that mobile callers could be located within a specified accuracy, which could be provided via the GPS. Pet. 14 (citing Ex. 1003 ¶ 57; Ex. 1013, 1). Petitioner contends that an ordinarily skilled artisan would have been motivated to incorporate similar GPS-based location features in IP-enabled communication devices. *Id.* (citing Ex. 1003 ¶ 58; Ex. 1005, 1:22–26; Ex. 1014, 46).

Petitioner also argues that an ordinarily skilled artisan would have been motivated to use Chang’s activation device/event trigger and remote device controller in McCalmont’s communication device 224. *Id.* (citing Ex. 1003 ¶ 59). McCalmont indicates that its communication devices are

capable of monitoring for emergency events like a collision, Ex. 1004, 12:20–36, or the activation of a premises alarm, *id.* at 12:26–35. Petitioner contends that an ordinarily skilled artisan would have understood that a sensor (e.g., collision sensor, smoke and/or heat sensor, vital signs sensor) would have been used to detect such events. Pet. 15 (citing Ex. 1003 ¶ 59 (citing Ex. 1017, 6:2–22; Ex. 1018, code (57); Ex. 1019, 3:1–24)).

Petitioner argues that an ordinarily skilled artisan would have incorporated Chang’s activation device/event trigger into McCalmont’s device 224 “to achieve a fully operational emergency monitoring device.” *Id.* (citing Ex. 1003 ¶ 59; Ex. 1006, 5:28–32).

Petitioner argues that combining teachings from McCalmont and Chang as it suggests merely combines known elements using known methods to yield predictable results. *Id.* (citing Ex. 1003 ¶ 60). Petitioner also contends that an ordinarily skilled artisan would have expected success in combining the teachings of McCalmont and Chang because Chang’s remote device controller could have been executed on a processor in McCalmont’s device 224 and existing portable devices integrated GPS receivers and event sensors/triggers. *Id.* (citing Ex. 1003 ¶ 60 (citing Ex. 1017, 6:2–22; Ex. 1018, code (57); Ex. 1019, 3:1–24)).

Based on our review of the current record, we find that Petitioner has demonstrated a reasonable likelihood that an ordinarily skilled artisan would have been motivated to combine teachings of McCalmont and Chang as described above.

## *2. Preamble IP*

The preamble of claim 1 recites: “[a] computer program for handling an emergency Internet Protocol request from an Internet Protocol enabled

device having Global Positioning Systems capability.” Ex. 1001, 5:26–29. Petitioner contends that McCalmont as modified by Chang teaches the limitations recited in the preamble of claim 1. Pet. 16–19. Petitioner contends that McCalmont’s communication device 224 constitutes the claimed Internet Protocol enabled device. *Id.* at 16–17 (citing Ex. 1004, 7:8–13, 11:49–52, Fig. 2; Ex. 1003 ¶¶ 64, 67). Petitioner contends that Chang describes a communication device with GPS capability in the form of device 200 with its GPS receiver 204. *Id.* at 17–18 (citing Ex. 1006, 1:59–64, 4:60–67, Fig. 2). Petitioner also contends that McCalmont at least suggests and Chang expressly describes a “computer program for handling an emergency . . . request.” *Id.* at 18–19 (citing Ex. 1006, 5:28–32, 5:52–55; Ex. 1003 ¶¶ 69, 70).

Based on our review of Petitioner’s undisputed argument and evidence, Petitioner demonstrates a reasonable likelihood of establishing that an ordinarily skilled artisan would have incorporated Chang’s GPS capability into McCalmont’s IP-based communication device 224 to meet the limitations recited in the preamble.

### *3. Limitation 1A*

Limitation 1A recites: “a code segment for monitoring software on the Internet Protocol enabled device for at least one of: a collision, heat, smoke, and vital signs.” Ex. 1001, 5:30–32. Petitioner contends that McCalmont as modified by Chang teaches limitation 1A. Pet. 19–22. More specifically, Petitioner contends that both McCalmont and Chang describe detecting a collision using their respective communication devices. *Id.* at 19 (citing Ex. 1004, 12:16–39; Ex. 1006, 5:12–15, 5:20–21, 7:3–9). Petitioner also contends that its proposed combination of McCalmont and Chang includes a



code segment for monitoring software on an IP-enabled device as recited in limitation 1A. *Id.* at 19–20 (citing Ex. 1003 ¶¶ 72–75). If limitation 1A were interpreted to require that the IP-enabled device includes software for monitoring all four of the events recited in limitation 1A, Petitioner argues that it would have been obvious for an ordinarily skilled artisan in view of McCalmont and Chang to include such software. *Id.* at 21–22. For the purposes of deciding whether to institute *inter partes* review, we adopt Petitioner’s proposed interpretation of limitation 1A as requiring software that monitors for any one of the recited events. *See* Part III.A above. Accordingly, we express no opinion on this aspect of Petitioner’s argument.

Based on our review of Petitioner’s undisputed argument and evidence, Petitioner demonstrates a reasonable likelihood of establishing that an ordinarily skilled artisan would have considered it obvious to combine teachings of McCalmont and Chang to meet limitation 1A.

#### 4. Limitation 1B

Limitation 1B recites: “a code segment for receiving the emergency Internet Protocol request containing global positioning data for the Internet Protocol enabled device, wherein the receiving is based on the monitored software.” Ex. 1001, 5:33–36. Petitioner contends that McCalmont as modified by Chang teaches limitation 1B. Pet. 22–26. Petitioner contends that the McCalmont device 224 sends an emergency request using the Internet Protocol. *Id.* at 23 (citing Ex. 1004, 9:63–10:3, 11:49–52, 12:16–19, Figs. 2, 3; Ex. 1003 ¶¶ 86–88). Petitioner also contends that McCalmont suggests sending GPS data via McCalmont’s device 224 because McCalmont recognizes that for a “VOIP connection, the location of the caller is critical” and McCalmont’s GPS-enabled mobile communication

device 268 sends such GPS data with its emergency requests. *Id.* at 24 (citing Ex. 1004, 4:31–33, 10:21–26, 14:45–48; Ex. 1003 ¶ 89). Petitioner alternatively argues that McCalmont’s device 224 as modified to include Chang’s GPS receiver sends global positioning data as part of this emergency request. *Id.* at 24–25 (citing Ex. 1006, 7:28–32; Ex. 1003 ¶¶ 89–92).

Based on our review of Petitioner’s undisputed argument and evidence, Petitioner demonstrates a reasonable likelihood of establishing that an ordinarily skilled artisan would have considered it obvious to combine teachings of McCalmont and Chang to meet limitation 1B.

#### 5. *Limitation 1C*

Limitation 1C recites: “a code segment for obtaining local emergency services data based on the global positioning data.” Ex. 1001, 5:37–38. Petitioner contends that McCalmont as modified by Chang teaches limitation 1C. Pet. 27–28. Petitioner contends that McCalmont expressly describes a call manager (or call center) that uses received location information (GPS-based for mobile device 268) to find the correct emergency service provider (i.e., “local emergency services data”). *Id.* (citing Ex. 1004, 12:40–60, 14:15–20, 15:15–19, Fig. 3; Ex. 1003 ¶¶ 95–98). Petitioner also contends that it would have been obvious to an ordinarily skilled artisan to implement this functionality in software running in a call center. *Id.* at 28 (cross-referencing Petitioner’s showing relating to preamble based on teachings of McCalmont and Chang, and citing Ex. 1003 ¶ 98).

Based on our review of Petitioner’s undisputed argument and evidence, Petitioner demonstrates a reasonable likelihood of establishing that

an ordinarily skilled artisan would have considered it obvious to combine teachings of McCalmont and Chang to meet limitation 1C.

*6. Limitation 1D*

Limitation 1D recites: “a code segment for dialing a call center station based on the local emergency services data.” Ex. 1001, 5:39–40. Petitioner contends that McCalmont describes limitation 1D. Pet. 28–29. Petitioner contends that McCalmont expressly describes dialing a call center (i.e., a PSAP) based upon “local emergency services data” (i.e., an emergency services routing number (“ESRN”)). *Id.* (citing Ex. 1004, 13:27–32, 15:45–49; Ex. 1003 ¶¶ 99–101).

Based on our review of Petitioner’s undisputed argument and evidence, Petitioner demonstrates a reasonable likelihood of establishing that McCalmont describes limitation 1D.

*7. Limitation 1E*

Limitation 1E recites: “a code segment for passing an emergency call from the Internet Protocol enabled device to the call center station.” Ex. 1001, 5:41–43. Petitioner contends that McCalmont as modified by Chang teaches limitation 1E. Pet. 29–30. Petitioner contends that McCalmont expressly describes calling the PSAP (i.e., the “call center station”) using the ESRN. Petitioner also contends that it would have been obvious to an ordinarily skilled artisan to implement this functionality in software running in a call center. *Id.* at 30 (cross-referencing Petitioner’s showing relating to preamble based on teachings of McCalmont and Chang, and citing Ex. 1003 ¶ 103).

Based on our review of Petitioner’s undisputed argument and evidence, Petitioner demonstrates a reasonable likelihood of establishing that

an ordinarily skilled artisan would have considered it obvious to combine teachings of McCalmont and Chang to meet limitation 1E.

#### IV. CONCLUSION

For the reasons expressed above, we determine that Petitioner has demonstrated a reasonable likelihood of showing that the combined teachings of McCalmont and Chang render claim 1 of the '423 patent unpatentable as obvious. In accordance with the Court's decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018) and Office guidance, we institute an *inter partes* review of all challenged claims of the '423 patent on all grounds asserted by Petitioner.

This Decision does not reflect a final determination on the patentability of any claim. We further note that the burden remains on Petitioner to prove unpatentability of each challenged claim. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

#### V. ORDER

For the reasons given, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of claims 1–34 of the '423 patent is instituted with respect to the all grounds of unpatentability alleged in the Petition commencing on the entry date of this Order; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is given of the institution of a trial.

IPR2022-00166  
Patent 7,394,423 B2

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