In the Matter of

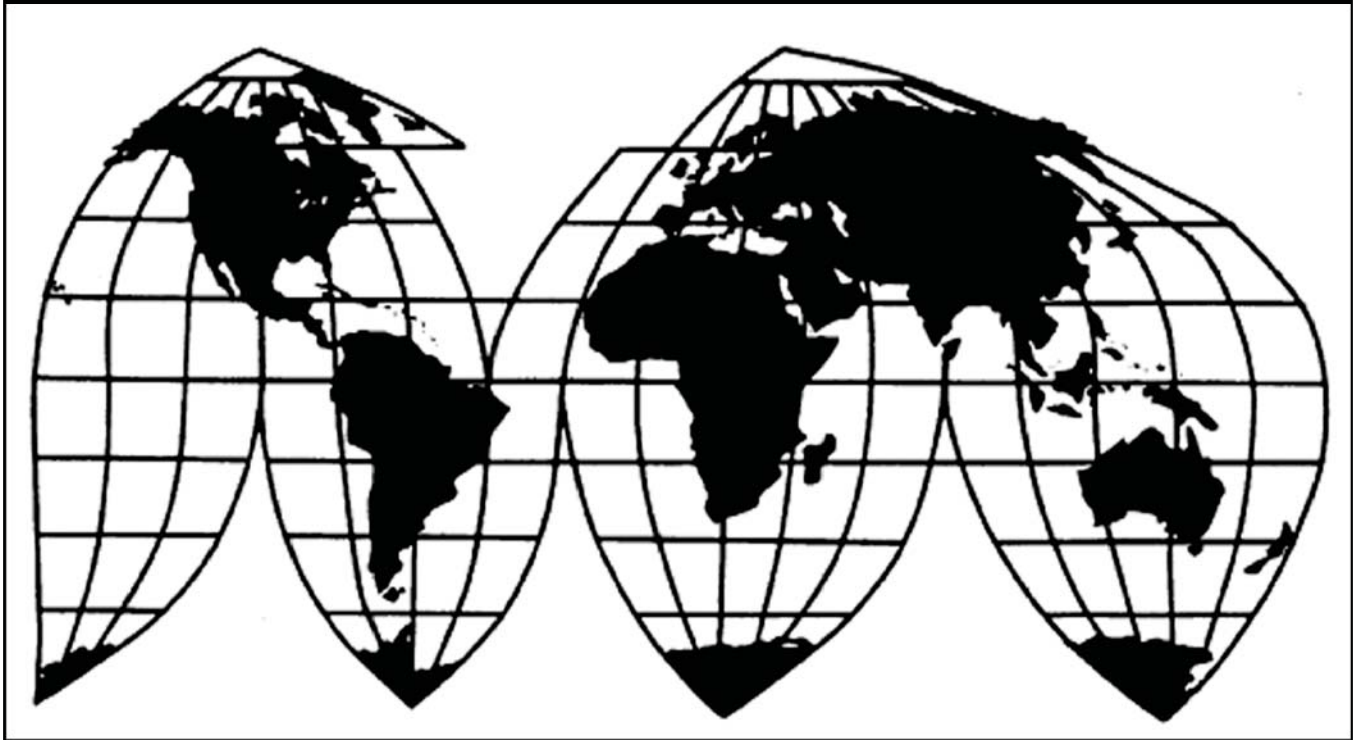# Certain Unified Communications Systems, Products Used with Such Systems, and Components Thereof

Investigation No. 337-TA-598

U.S. International Trade Commission

Washington, DC 20436

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In the Matter of

Certain Unified Communications Systems, Products Used with Such Systems, and Components Thereof

Investigation No. 337-TA-598

In the Matter of

CERTAIN UNIFIED COMMUNICATIONS SYSTEMS, PRODUCTS USED WITH SUCH SYSTEMS, AND COMPONENTS THEREOF

Investigation No. 337-TA-598

NOTICE OF COMMISSION DECISION TO REVERSE-IN-PART AND MODIFY-IN-PART A FINAL INITIAL DETERMINATION FINDING A VIOLATION OF SECTION 337 AND TERMINATION OF THE INVESTIGATION WITH A FINDING OF NO VIOLATION

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to reverse-in-part and modify-in-part a final initial determination ("ID") of the presiding administrative law judge ("ALJ"). The Commission has determined that there is no violation of section 337 in the above-captioned investigation.

FOR FURTHER INFORMATION CONTACT: Clint Gerdine, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-5468. Copies of non-confidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at *http://www.usitc.gov.* The public record for this investigation may be viewed on the Commission's electronic docket (EDIS) at *http://edis.usitc.gov.* Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on March 26, 2007, based on a complaint filed by Microsoft Corporation ("Microsoft") of Redmond, Washington. 72 *Fed. Reg.* 14138-9. The complaint, as amended and supplemented, alleges violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, in the

importation into the United States, the sale for importation, and the sale within the United States after importation of certain unified communications systems, products used with such systems, and components thereof by reason of infringement of certain claims of U.S. Patent Nos. 6,421,439 ("the '439 patent"); 6,430,289; 6,263,064 ("the '064 patent"); and 6,728,357. The complaint further alleges the existence of a domestic industry. The Commission's notice of investigation named Alcatel-Lucent ("ALE") of Paris, France as the only respondent.

On April 20, 2007, Microsoft moved to amend the complaint to: 1) substitute Alcatel Business Systems for Alcatel-Lucent as respondent in this investigation, and 2) add allegations of infringement of claims 8, 28, 38, and 48 of the '439 patent, and claim 20 of the '064 patent. Respondent and the Commission investigative attorney ("IA") did not oppose the motion.

On May 17 and September 20, 2007, respectively, the Commission determined not to review IDs, issued by the presiding ALJ, granting Microsoft's motions to amend the complaint and to terminate the investigation in part based on Microsoft's withdrawal of certain claims. On October 23 and October 26, 2007, respectively, the Commission determined not to review IDs, issued by the presiding ALJ, granting Microsoft's motion to terminate the investigation in part based on Microsoft's withdrawal of certain claims and granting ALE's motion to amend the complaint.

On January 28, 2008, the ALJ issued his final ID and recommended determinations on remedy and bonding. The ALJ found a violation of section 337 based on his findings that the respondent's accused products infringe claims 1 and 28 of the '439 patent, and that those claims were not proven invalid and that the domestic industry and importation requirements of section 337 were met as to those claims. On February 11, 2008, all parties, including the IA, filed petitions for review of the final ID. On February 19, 2008, all parties filed responses to the petitions for review.

On March 14, 2008, the Commission determined to review-in-part the final ID. Particularly, the Commission determined to review: 1) the ALJ's construction of the claim term "current activity of subscribers on the computer network;" 2) the ALJ's determination that ALE's OXE system directly and indirectly infringes the '439 patent; 3) the ALJ's determination that ALE's OXO system does not infringe the '439 patent; 4) the ALJ's determination that claims 1 and 28 of the '439 patent are not invalid in view of U.S. Patent No. 6,041,114 ("the '114 patent") or U.S. Patent No. 5,652,789 ("the '789 patent"); 5) the ALJ's determination that claim 38 of the '439 patent is invalid in view of the '114 patent; and 6) the ALJ's determination that claim 38 is not invalid in view of the '789 patent.

With respect to violation, the Commission requested written submissions from the parties relating to the following issues:

> 1) the ALJ's finding that the "current activity of the user on the computer network" as found in the '439 patent "can consist of both user-selected indicators based on user activity (e.g., 'conditional

processing' as per the '439 specification) and the transfer of data between the computer and telephone networks while the user is engaged in a VoIP phone call" (ID at 47), and the implications of this finding for the infringement and invalidity analyses;

2) what is the exact demarcation between the '439 patent claim terms "telephone network" and "computer network" as it relates to claim construction, invalidity using the '114 and '789 patents, and the infringement analysis for a Voice-over-IP (VoIP) communication system;

3) whether the PBX and telecommute server of the '114 patent, functioning together, can be considered to disclose the "network access port" and "controller" limitations of claim 1 of the '439 patent to anticipate this claim;

4) to what extent, if any, does anticipation of claims 1 and 28 of the '439 patent depend on a finding that the claim limitations are inherently disclosed by the '114 and '789 patents; and

5) please comment on Microsoft's argument that the ALJ, when construing the term "current activity" to mean "either the status of the user or subscriber at the present time or the most recent status of a user or subscriber," did so in a manner inconsistent with Federal Circuit precedent. Complainant Microsoft's Contingent Petition for Review at 9. In addressing this argument, please address Free Motion Fitness, Inc. v. Cybex Int'l, Inc., 423 F.3d 1343 (Fed. Cir. 2005) ("[u]nder Phillips, the rule that 'a court will give a claim term the full range of its ordinary meaning,' . . . does not mean that the term will presumptively receive its broadest dictionary definition or the aggregate of multiple dictionary definitions . . .")) and Impax Labs, Inc. v. Aventis Pharms, Inc. 468 F.3d 1368, 1374 (Fed. Cir. 2006) ("claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term its broadest reasonable construction consistent with the specification").

73 *Fed. Reg.* 15005-07.

Further, the Commission requested written submissions on the issues of remedy, the public interest, and bonding. *Id.*

On March 24 and March 31, 2008, respectively, the complainant Microsoft, the respondent ALE, and the IA filed briefs and reply briefs on the issues for which the Commission requested written submissions.

Having reviewed the record in this investigation, including the final ID and the parties' written submissions, the Commission has determined to reverse-in-part and modify-in-part the ID. Particularly, the Commission has modified the ALJ's claim construction of the term "current activity of the user on the computer network" in claims 1, 28, and 38 of the '439 patent to be "the current status of the user on the computer network" where "current status" includes "either the status of a user or subscriber at the present time or the most recent status of a user or subscriber." Further, the Commission has reversed the ALJ's ruling of infringement of the '439 patent by ALE's OXE system and determined that this system does not infringe claims 1, 28, and 38 under at least the Commission's modified claim construction of "current activity of the user on the computer network." The Commission has also affirmed the ALJ's ruling of non-infringement of the '439 patent by ALE's OXO system. In addition, the Commission has reversed the ALJ's finding that claims 1 and 28 are not invalid in view of the '114 patent or the '789 patent, reversed the ALJ's finding that claim 38 is not invalid in view of the '789 patent, and affirmed the ALJ's finding that claim 38 is invalid in view of the '114 patent. Particularly, the Commission has determined that claims 1, 28, and 38 are invalid in view of the '114 patent, and are also invalid in view of the '789 patent.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), and in sections 210.45, and 210.50 of the Commission's Rules of Practice and Procedure (19 C.F.R.§§ 210.45, 210.50).

By order of the Commission.

Marilyn R. Abbott
Secretary to the Commission

Issued: May 19, 2008

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CERTAIN UNIFIED COMMUNICATIONS SYSTEMS,   337-TA-598
PRODUCTS USED WITH SUCH SYSTEMS, AND
COMPONENTS THEREOF SAME

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **NOTICE OF COMMISSION DECISION TO REVERSE-IN-PART AND MODIFY-IN-PART A FINAL INITIAL DETERMINATION FINDING A VIOLATION OF SECTION 337 AND TERMINATION OF THE INVESTIGATION WITH A FINDING OF NO VIOLATION** has been served by hand upon the Commission Investigative Attorney, David O. Lloyd, Esq., and the following parties as indicated, on May 20, 2008   .

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UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C. 20436

In the Matter of

CERTAIN UNIFIED COMMUNICATIONS SYSTEMS, PRODUCTS USED WITH SUCH SYSTEMS, AND COMPONENTS THEREOF

Investigation No. 337-TA-598

COMMISSION OPINION

I. SUMMARY

On January 20, 2008, the presiding administrative law judge ("ALJ") issued his final initial determination ("ID") in the above-captioned investigation, finding a violation of section 337 by respondent's accused products. The Commission determined to review the ALJ's determination with respect to U.S. Patent No. 6,421, 439 ("the '439 patent"), but not the ALJ's determination with respect to U.S. Patent Nos. 6,430,289 ("the '289 patent"); 6,263,064 ("the '064 patent"); and 6,728,357 ("the '357 patent"). On review, the Commission reverses the ALJ's determination of violation with respect to claims 1 and 28 of the '439 patent and affirms his determination of no violation with respect to claim 38 of the '439 patent.

II. BACKGROUND

The Commission instituted this investigation on March 26, 2007, based on a complaint filed by Microsoft Corporation ("Microsoft") of Redmond, Washington. 72 *Fed. Reg.* 14138-9 (Mar. 26, 2007). The complaint, as amended and supplemented, alleges violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain unified communications systems, products used with such systems, and components thereof by reason of infringement of certain claims of the the '439 patent, the '289 patent, the '064 patent, and the '357 patent. The complaint further alleges the existence of a domestic industry. The Commission's notice of investigation named Alcatel-Lucent ("ALE") of Paris, France as the only respondent.

On January 28, 2008, the ALJ issued his final ID on violation and recommended determinations on remedy and bonding. The ALJ found a violation of section 337 based on his findings that respondent's accused products infringe claims 1 and 28 of the '439 patent, that those claims are not proven invalid, and that the domestic industry and importation requirements of section 337 were met as to those claims. He also found no violation with respect to claim 38 of the '439 patent and the asserted claims of the '289 patent, the '064 patent, and '357 patent. On February 11, 2008, all parties, including the Commission investigative attorney ("IA"), filed petitions for review of the final ID. On February 19, 2008, all parties filed responses to the petitions for review.

On March 14, 2008, the Commission determined to review-in-part the ID. Particularly, the Commission determined to review: 1) the ALJ's construction of the claim term "current activity of the user on the computer network;" 2) the ALJ's determination that ALE's OXE system directly and indirectly infringes the '439 patent; 3) the ALJ's determination that ALE's

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OXO system does not infringe the '439 patent; 4) the ALJ's determination that claims 1 and 28 of the '439 patent are not invalid in view of U.S. Patent No. 6,041,114 ("the '114 patent" or "the Chestnut patent") or U.S. Patent No. 5,652,789 ("the '789 patent" or "the Miner patent"); 5) the ALJ's determination that claim 38 of the '439 patent is invalid in view of the Chestnut patent; and 6) the ALJ's determination that claim 38 is not invalid in view of the Miner patent. The Commission determined not to review the ALJ's other determinations including domestic industry and unenforceability relating to the '439 patent; claim construction, infringement, and invalidity relating to the '289 patent, the '064 patent, and '357 patent; and his order denying ALE's motion for sanctions.

With respect to violation, the Commission requested written submissions from the parties relating to the following issues:

> 1) the ALJ's finding that the "current activity of the user on the computer network" as found in the '439 patent "can consist of both user-selected indicators based on user activity (*e.g.*, 'conditional processing' as per the '439 specification) and the transfer of data between the computer and telephone networks while the user is engaged in a VoIP phone call" (ID at 47), and the implications of this finding for the infringement and invalidity analyses;

> 2) what is the exact demarcation between the '439 patent claim terms "telephone network" and "computer network" as it relates to claim construction, invalidity using the '114 and '789 patents, and the infringement analysis for a Voice-over-IP (VoIP) communication system;

> 3) whether the PBX and telecommute server of the '114 patent, functioning together, can be considered to disclose the "network access port" and "controller" limitations of claim 1 of the '439 patent to anticipate this claim;

> 4) to what extent, if any, does anticipation of claims 1 and 28 of the '439 patent depend on a finding that the claim limitations are inherently disclosed by the '114 and '789 patents; and

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5) please comment on Microsoft's argument that the ALJ, when construing the term "current activity" to mean "either the status of the user or subscriber at the present time or the most recent status of a user or subscriber," did so in a manner inconsistent with Federal Circuit precedent. Complainant Microsoft's Contingent Petition for Review at 9. In addressing this argument, please address *Free Motion Fitness, Inc. v. Cybex Int'l, Inc.*, 423 F.3d 1343 (Fed. Cir. 2005) ("[u]nder *Phillips*, the rule that 'a court will give a claim term the full range of its ordinary meaning,' . . . does not mean that the term will presumptively receive its broadest dictionary definition or the aggregate of multiple dictionary definitions . . .") and *Impax Labs, Inc. v. Aventis Pharms, Inc.*, 468 F.3d 1368, 1374 (Fed. Cir. 2006) ("claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term its broadest reasonable construction consistent with the specification").

73 *Fed. Reg.* 15006 (Mar. 20, 2008). Further, the Commission requested written submissions on the issues of remedy, the public interest, and bonding. *Id.*

On March 24 and March 31, 2008, respectively, complainant Microsoft, respondent ALE, and the IA filed briefs and reply briefs on the issues for which the Commission had requested written submissions including the issues of remedy, the public interest, and bonding.

A. Patents at Issue

This investigation pertains to computer telephony and unified messaging communications services which integrate the computer and telephone networks to provide a variety of communications services (*e.g.*, phone, fax, internet) and options for a user of the services. Particularly, the asserted claims of the '439 patent, the only patent relevant to the Commission's review, pertain to the processing of a telephone call based on the activity of the user (called party) or a subscriber (calling party) on a computer network.

The '439 patent is entitled "System and Method for User Affiliation in a Telephone Network." The patent is directed to a telecommunications system that combines telephone and computer network technology (*i.e.*, the telephone network and the internet) to provide user-selectable call processing options for a user of the telephone and computer networks, based on the user or calling party's activity on the computer network. The '439 patent is based on an application filed on March 24, 1999. The '439 patent issued on July 16, 2002, to Stephen Mitchell Liffick and was assigned to Microsoft. *See* JX-1. The '439 patent has 51 claims, but only claims 1, 28, and 38 are asserted in the investigation.

B.   Products at Issue

Microsoft contends that claims 1, 28, and 38 of the '439 patent are infringed, directly, contributorily, and by inducement, by the OmniPCX Enterprise ("OXE") and OmniPCX Office IP-PBX ("OXO"), computer telephony communication systems that ALE currently produces.

The OXE and OXO systems each comprise a combination of products. The OXE system includes the following: 1) an OmniPCX Enterprise communication server ("OXE" IP-PBX), 2) an OmniTouch Unified Communication ("OTUC") software suite, 3) a 4980 softphone application ("My Softphone"), and 4) OTUC servers. The OXO system includes the following: 1) an OmniPCX Office IP-PBX ("OXO" IP-PBX) and 2) PIMPhony software ("PIMPhony") that runs and operates on a personal computer and optionally a Telephone Application Programming Interface ("TAPI") server. *See* ID at 132, CX-603C, CDX-18, 19. Softphone and Pimphony applications are collectively referred to as personal computer phone ("PC phone") applications. The IP designation refers to "internet protocol" which is the standard communications protocol followed for communications over the internet. The PBX designation

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refers to a "private branch exchange" which is a private telephone switch, usually owned or controlled by a private business, that is linked to the public switched telephone network ("PSTN") to provide communication services for the private business. *See* ID at 15. In both systems, the PBX includes a call server and a computer supported telephony application ("CSTA") module contained within.

The OXE system uses various "My Softphone" software applications (*e.g.*, MyAssistant, MyPhone), and the OXO systems uses the PIMPhony software, to provide telephone service for a user on the computer network. Both of the accused systems operate to provide voice-over-IP ("VoIP") communication services to users who can make and receive calls using the PC phone applications while on the computer network, and usually a local area network ("LAN") computer system to communicate with other computer users with PC phone applications. The computer network interconnects with the telephone network (*i.e.*, PSTN) to communicate with conventional telephone users. Also, both systems include the capability of having incoming calls routed or forwarded to another user device other than the PC phone, *e.g.*, cellphone, personal digital assistant ("PDA"), conventional telephone.

Using the computer software applications, users can set the PC phone with incoming call processing options similar to those of the conventional telephone, *e.g.*, call forwarding, do not disturb, with either accused system. During operation, an incoming call is received by the PBX, *e.g.*, call server and CSTA module contained within, and either a combination of the CSTA module and the OTUC server for the OXE system using the OTUC software, or a combination of the CSTA module, optional TAPI server, and the user PC for the OXO system. Data structures, stored on the OTUC server or the user PC, in the accused systems are accessed to find call processing criteria (*e.g.*, call forwarding, do not disturb, conditional call processing

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criteria based on the calling party, time of day) to route/process the incoming call in accordance with the user-selected call processing option.

III. DISCUSSION

For the reasons set forth below, we have determined to reverse-in-part and modify-in-part the final ID and to find no violation of section 337 by either of ALE's accused products. Also, we adopt the ALJ's findings from the final ID that are not inconsistent with our opinion.

A. Claim Construction: "current activity of the user on the computer network"

We determined to review the ALJ's construction of the limitation "current activity of the user on the computer network" found in claims 1, 28, and 38 of the '439 patent. *See* the '439 patent, col. 14, ll. 25-26.

1. *Initial Determination*

The ID construed the phrase "current activity of the user on the computer network" to mean "the current status of the user on the computer network." *See* ID at 47-50. Although the parties had stipulated to a particular meaning of this phrase, the ALJ found that the agreed-upon term "current status" was nonetheless in dispute. *See* ID at 27-28. The ALJ thus decided to construe the term "current status" to mean "either the status of a user or subscriber at the present time or the most recent status of a user or subscriber," and where the "status" of a user "can consist of both user-selected indicators based on user activity, *e.g.*, 'conditional processing' as per the '439 specification, and the transfer of data between the computer and telephone networks while the user is engaged in a VoIP phone call." *See* ID at 47-50.

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It is not clear whether the ALJ's interpretation of "status" was a reference to status "on the computer network." The ALJ acknowledged that the specification discloses that the system can determine whether a subscriber is currently active on the Internet, but that it *"does not teach processing a call based on this activity." Id.* at 48 (*citing* the '439 patent, col. 7, l. 61 to col. 8, l. 2) (emphasis added). He said also that it discloses that a user can create specific conditions for processing based on the user's current status, but the specification *never explicitly discloses* whether the "user's current status" includes the user's status "on a computer network." *Id.* (*citing* the '439 patent, col. 8, ll. 46-48) (emphasis added).

The ALJ faced the same difficulty with respect to the prosecution history, noting that "[a]lthough the applicant explains that the '439 patent application is patentable because it can, among other things, filter calls based on the status of a subscriber or user and not simply based on a fixed set of rules, the applicant's remarks *do not add anything* to enlighten the proper construction of the phrase 'current activity.'" *See* ID at 48-50 (emphasis added). Therefore, due to the absence of any relevant information concerning this term in the intrinsic evidence, the ID relied on the dictionary meaning to construe "current status" (or "current activity") as "the status of a user or subscriber at the present time or the most recent status of a user or subscriber." *Id.*

2. *Parties' Arguments*

ALE challenges the ALJ's interpretation of "status," which includes "both user-selected indicators based on user activity (*e.g.*, 'conditional processing') and the transfer of data between the computer and telephone networks while the user is engaged in a VoIP phone call," because it effectively reads out an essential limitation of the relevant claimed feature (*e.g.*, "on the computer network") - a limitation that was added to obtain allowance of the claim in response to a PTO rejection. Particularly, ALE argues that there is a significant distinction between

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processing incoming calls based upon rules that are stored on a computer, as the ALJ appeared to construe the claimed feature, and processing calls according to rules that are conditioned upon a user's current activity on a computer network. Also, ALE contends that the ALJ relied upon portions of the '439 patent specification that do not describe the claimed function to erroneously construe the relevant feature as simply processing incoming calls based upon rules that are stored on a computer.

Microsoft contends that the ALJ's construction gave full meaning to the term "status" by covering two embodiments disclosed in the '439 patent: (i) one based on the conditional status of the user (*i.e.*, user's status as "do not disturb"), and (ii) the other based on the user's activity on a computer network that can be monitored (*i.e.*, user's status as "busy" based on the data transfer during a VoIP call). *See* ID at 44-45 (*citing* the '439 patent, col. 1, l. 65 to col. 2, l. 7; col. 7, l. 57 to col. 9, l. 24). From this disclosure, Microsoft contends that the ALJ correctly determined that "status" must cover certain "user selected-indicators" such as conditional processing (*e.g.*, "time of day, current availability of the user, work status, or the like") and that these conditional status indicators are not the only type of "status" disclosed in the '439 patent. Particularly, Microsoft contends that the ALJ recognized that a dynamic type of "status" is disclosed where the ongoing "internet activity [that] a user wishes to monitor" can be used by the system to filter calls. *See* the '439 patent, col. 7, ll. 61-62. Microsoft argues that this dynamic and real-time form of "status" does not depend on a contingent triggering event (such as time of day), but relies on the user's activity on the internet or the computer network as a proxy for the user's own status on the computer network such as the user engaging in a VoIP call from his computer over the network.

The IA contends that the ALJ was correct, and consistent with the specification, by

finding that "conditional processing" satisfies the "current activity" limitation, but that the ALJ's

finding that a "VoIP phone call" satisfies this limitation is ambiguous since it does not clarify

whether a VoIP phone call is "activity of the user on the computer network." Particularly, the IA

submits that the '439 patent does not describe VoIP phone calls as a form of activity on the

computer network, and although a computer may be "active" when engaged in a VoIP phone

call, that "activity" is activity on the telephone network by definition.

3.   *Analysis*

The plain language of claims 1, 28, and 38 requires that incoming calls be filtered

according to "current activity of the user on the computer network."[1] Therefore, no permissible

construction can read out the critical limitation "on the computer network." *See Innova/Pure*

Water, Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111, 1119 (Fed. Cir. 2004) ("While

not an absolute rule, all claim terms are presumed to have meaning in a claim."); *see also Flex-*

Rest, LLC v. Steelcase, Inc., 455 F.3d 1351, 1361 (Fed. Cir. 2006) (stating that it is part of "basic

patent law doctrine that every limitation of a claim is material").

The language of the claims further differentiates between a "computer network" on the

one hand and a "telephone network" on the other. And as previously mentioned, the ALJ found

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[1] The full claim phrase in the '439 patent is "filter the incoming call according to current
activity of subscribers on the computer network or according to current activity of the user on
the computer network." *See* the '439 patent, col. 14, ll. 23-26. Microsoft does not assert that the
"current activity of subscribers on the computer network" limitation is met by the accused
products, and therefore we do not discuss this part of the limitation, but it is noted in our
discussion regarding infringement.

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that the specification fails to shed much light on the term "current activity of the user on the computer network."

The prosecution history for the '439 patent also indicates that the claimed computer and telephone networks are significantly distinct. During prosecution, the patentee asserted the novelty of routing calls based on the current activity of the user on the computer network, and even further, emphasized the feature of automatically changing how an incoming call is routed based on changes in the current activity of the user on the computer network, without the user having to manually change the incoming call processing criteria. *See* JX-5 (MSAL 00695). Particularly, in response to a rejection based on a prior art reference (Brennan), the patentee stated:

> Thus, Brennan teaches that the user requirements or the caller lists *do not change unless the user expressly changes* the user requirements or unless the user specifically requests a system operator to make the changes to the user requirements.

> * * * *

> In contrast to Brennan, claim 1 as amended recites that one or more lists used in filtering an incoming call *change according to current activity of the subscribers* (*e.g.*, persons making the calls), or *according to current activity of the user* (*e.g.*, intended recipient of the call) . . . the current activity of the subscriber and/or the user does *not* typically occur on the telephone network. Instead the current activity of the subscriber and/or the user usually occurs *on a computer network. The ability to process an incoming call on a telephone network according to activity on a computer network is not taught or suggested by Brennan. Id.* (emphasis added).

Therefore, the prosecution history strongly indicates that the term "current activity of the user on the computer network," which was specifically added as part of the amendment to

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overcome the PTO rejection based on Brennan, means something quite special and unique, *viz.*,

the ability to process an incoming call based on the user's activity on the computer network, as

opposed to activity on the telephone network.

ALE and Microsoft have agreed that whether "activity" constitutes activity on the

telephone network or the computer network depends upon the type of data that is communicated

during the activity, *i.e.*, telephony information for the telephone network, and digital data for the

computer network, and not based on the actual physical network over which the data is

transferred. *See* ID at 26 (referring to agreed-upon claim constructions for "telephone network"

and "computer network"); *see also* Hyde-Thomson, Tr. 1642-43; Chang, Tr. 1024:7-18, ALE's

Pre-Hearing Br. at 91-92; August 23, 2007 Deposition Tr. of Chang at 40; July 11, 2007 Chang

Opening Expert Report at 9-10. We find that the parties' agreed-upon claim constructions (*e.g.*,

telephone network, computer network, the controller) and the experts' testimony are not

inconsistent with the '439 patent specification.[2]

Specifically Microsoft's expert Chang testified that "[w]hen the packets . . . carry voice

data, the LAN (local area network) becomes a telephone network." *See* Chang, Tr. 1024. Also,

ALE's expert, Hyde-Thomson, testified that:

> . . . but all of those are transactions over the telephone
> network. These are SIP [session initiation protocol]
> messages sent [using the OXE or the OTUC] concerning

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[2] Consistent with the record including the '439 patent, the final ID, and both parties' expert testimony, the Commission notes that the claimed function of the controller "to receive the incoming call" necessarily includes receiving telephony information where the received information may include non-voice data such as call setup data (or signaling), and the claimed "controller," performing this recited function, is still part of the telephone network. *See* the '439 patent, FIG. 2, col. 4, 1. 66 to col. 5, 1. 21; col. 6, 11. 55-65; *see also* ID at 26, 88; Hyde-Thomson, Tr. at 1642-43; August 23, 2007 Deposition Tr. of Chang at 40; July 11, 2007 Chang Opening Expert Report at 9-10.

setting up phone calls or letting [the user] know there is a call waiting . . . [t]his is all standard telephony things. This is what happens in a PBX with hard telephones. And that fact that it is now running over the LAN just means that the telephone network has been extended over the local area network as an overlay on top of the basic Ethernet infrastructure of the local area network . . . it is still telephony data [without the messages including voice information]. It is about data setting up phone calls.

See Hyde-Thomson, Tr. 1642-43. Therefore, a phone call over a traditional computer network (*e.g.*, LAN) is considered a telephone call on a telephone network based on the data that is carried. Similarly, a VoIP phone call constitutes activity on the telephone network.

Given the narrow claim construction that the prosecution history requires and the constructions of "telephone network" and "computer network" agreed upon by the parties' experts, we determine that the proper claim construction of "current activity of the user on the computer network" cannot include "engaged in a VoIP phone call." As noted above, the specification makes no mention of VoIP phone calls.

We also disagree with the IA's and Microsoft's contention that "conditional processing" should be part of the relevant claim feature. The language "conditional processing" in the specification referenced by the ALJ, the IA, and Microsoft bears no relation to the current status of the user on the computer network since these "lists" are simply names of other subscribers and are not lists containing data on current activity of the user, *i.e.*, the person receiving the incoming call, on the computer network. *See* the '439 patent, col. 8, ll. 6-34. Further, other instances of "conditional processing" referenced by Microsoft and the IA relate solely to other factors (*e.g.*, time of day, identity of the caller), again bearing no relation to the current activity of a user on the computer network. *See* ID at 47; *see also* the '439 patent, col. 9, ll. 45-55.

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Microsoft cites a portion of the specification that states that the user, via an Internet controller 152, may access a forward list "to determine which Internet subscribers contained within the forward list are currently active on the Internet 134." However, this portion of the specification has nothing to do with processing an incoming call according to the user's or subscriber's current activity on a computer network as required by the claim limitation. *See* the '439 patent, col. 7, l. 63 - col. 8, l. 1. Rather, these lists solely refer to names of subscribers that may be used by the user for "conditional processing" (*e.g.*, time of day, day of week), but not for linking the current activity of these names (subscribers) on the computer network to call-processing rules for handling an incoming call.

Microsoft also refers to the portion of the specification that states "the central office switch 116 will access the Internet 134 in real-time and review data in the affiliation list 150 to thereby process incoming calls for the user in accordance with the rules present in the affiliation list," as support for the ALJ's claim construction. *See* the '439 patent, col. 9:20-24. These lists, however, contain only names - the names of subscribers that are allowed, that are blocked from monitoring the user's activity, have the user's activity forwarded to them, or whose activity is forwarded. Nowhere in the specification is the connection made between these lists and the processing of an incoming call in accordance with the user's or subscriber's current activity on the computer network. *See* ID at 48 (ALJ found that specification contains no reference to processing a call based on current activity of the user on the computer network).

Further, by stating that "the 'status' of a user can include the transfer of data between the computer and telephone networks while the user is engaged in a VoIP phone call," the ALJ appears to have construed the term in view of the accused product, a procedure that is expressly prohibited by the Federal Circuit. *See NeoMagic Corp. v. Trident Microsystems, Inc.*, 287 F.3d

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1062, 1074 (Fed. Cir. 2002) ("It is well settled that claims may not be construed by reference to the accused device."), *citing SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1118 (Fed. Cir. 1985) (*en banc*) ("A claim is construed in the light of the claim language, the other claims, the prior art, the prosecution history, and the specification, not in light of the accused device."). Because the specification and the prosecution history do not refer to VoIP phone calls, the term could only have entered the claim construction from the accused product.

Finally, we disagree with Microsoft's argument that the ALJ's construction for the term "current," *i.e.*, either at the present time or the most recent, was overly broad. We find that, in the absence of intrinsic evidence as to its meaning, the ALJ properly looked to a dictionary definition to find the plain and ordinary meaning of the claim term. *See* ID at 49-50 (*citing* Merriam-Webster's Ninth New Collegiate Dictionary 316 (1984); Merriam-Webster's Online Dictionary (www.m-w.com)). The ALJ properly chose the most reasonable claim construction not inconsistent with the intrinsic evidence. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*).

In addition, there is nothing in the portions of the specification that Microsoft cites that would limit "current" to a particular meaning, and no relevant testimony from Microsoft's expert to the contrary, and therefore we find it was entirely appropriate for the ALJ to consult a dictionary and apply the most reasonable definition of "current." *Id.*; *see Phillips*, 415 F.3d at 1322-23 (stating that "judges are free to consult dictionaries and technical treatises 'at any time in order to understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents'").

Accordingly, the Commission has determined to construe the limitation "current activity of the user on the computer network" to mean "the current status of the user on the computer network" where "current status" includes "either the status of a user or subscriber at the present time or the most recent status of a user or subscriber." We decline to adopt the portion of the ALJ's claim construction that found that the "status" of a user can "consist of both user selected indicators based on user activity, e.g., 'conditional processing' as per the '439 specification, and the transfer of data between the computer and telephone networks while the user is engaged in a VoIP phone call."

B.   Infringement: "current activity of the user on the computer network"

We determined to review the ALJ's infringement determinations relating to both ALE's OXE and OXO systems.

1.   *Initial Determination*

The ALJ determined that ALE's OXE system infringes, both directly and indirectly, claims 1 and 28 of the '439 patent.[3] *See* ID at 133-65. The ALJ's determination of direct infringement was based on his finding that the accused OXE system satisfies the disputed claim limitation of "wherein some of the one or more lists are used to filter the incoming call according to current activity of . . . the user [called party] on the computer network" as he had construed that limitation. *Id.* at 42-50, 138-45. The ALJ relied heavily on expert testimony to make his determination. *Id.* at 138-45; *see* CDX-42, 161; Chang, Tr. at 499-500, 597-99, 1102-05; Hyde-

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[3] The ALJ found that the accused OXE system satisfied all limitations of asserted claim 38 of the '439 patent, but ultimately found no violation with respect to that claim because he determined that claim 38 is invalid as anticipated by the Chestnut patent. ID at 100, 166.

Thomson, Tr. at 1690-92.

After considering complainant's and respondent's expert testimony, the ALJ found that the MyAssistant software for the OXE system allows the user (called party) to setup a variety of call routing preferences for an incoming VoIP call. *See* ID at 139-43. These call routing options include the following: 1) an "all callers" routing state allowing the user to route calls to a particular destination (*e.g.*, office phone, mobile phone, home phone) when available for incoming calls, 2) a "VIP screening rules" routing state allowing the user to filter incoming calls based on a variety of factors (*e.g.*, caller ID, time of day, day of the week), 3) a "do not disturb" or "vacation" routing state allowing the user to route calls to a particular destination (*e.g.*, voice mail, other phone number) when not available including allowing certain subscribers to bypass the 'do not disturb' state, and 4) a "busy" routing state allowing the user to route calls to a particular destination when the user's PC phone is busy. *Id.*; *see also* RX-101C (ABS00009644-51).

Even though the ALJ had found that the '439 specification contains nothing relevant concerning the "current activity" term, the ALJ reviewed the "summary of the invention" portion of the specification regarding conditional criteria that may be set by a user (*e.g.*, time of day, day of the week, caller ID) to determine that "the user assigns a 'status' to various subscribers . . . the '439 patent discloses a flow chart showing how several 'lists' of callers are checked in order to properly route a call." *Id.* at 144-45. Based on expert testimony and the language in the specification noted above, the ALJ found that the ALE's accused OXE system satisfied "current activity of the user on the computer network" limitation. *Id.*

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In addition to direct infringement, the ALJ found that ALE indirectly infringed the '439 patent. *See* ID at 194-99. Regarding contributory infringement, the ALJ acknowledged that ALE's OXE system has significant non-infringing uses as a PBX, and becomes infringing only with the addition of the OTUC server/software. *Id.* However, based on the record evidence, the ID found that the OTUC software is never sold without the OXE hardware (*e.g.*, CSTA call server and PBX). *Id.* Because ALE sells and advertises the complete OXE system with OTUC server/software as an integrated solution for incoming call processing, and because it admitted that it sells the accused OXE system after importation, the ALJ found that ALE contributorily infringes claims 1 and 28 of the '439 patent. *Id.*

Regarding induced infringement, the ALJ found, based on the record evidence, that ALE "had distributed user guides and other public materials to its customers and resellers explaining how to use the accused systems." *Id.* Further, the ALJ found that these public materials and user guides include content relating to the infringing functionality of the accused OXE systems. *Id.*; *see also* RX-126. Based on this record evidence, the ALJ found that ALE induced others to infringe claims 1 and 28 of the '439 patent by using its accused OXE system products. *Id.*

2.   *Parties' Arguments*

ALE argues that the ALJ improperly found that the processing rules in the accused OXE system that are unrelated to "current activity of the user on the computer network" still satisfied this limitation. Also, ALE argues that none of the rules that the ALJ found to infringe this limitation – *e.g.*, time of day, day of the week, "do not disturb," – are conditioned upon a user's current activity on the computer network. According to ALE, these are all examples of the type of "user-selectable criteria" that are not conditioned upon a user's current activity on the computer network.

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Further, ALE submits that "engaged in a VoIP phone call" does not constitute "current activity of the user on the computer network" consistent with the ALJ's proper finding, relating to the OXO system, that phone status is not the same as a user's status on the computer network and that call routing is always the same regardless of what type of phone is used, *e.g.*, standard digital phone or a VoIP softphone. On this basis, ALE contends that this call routing does not meet the limitation of call routing or filtering based on a user's activity on the computer network.

Microsoft asserts that the record shows that the PC softphone software for the OXE system allows the user to set call processing rules that will filter an incoming call based on any number of "conditional processing" statuses (*e.g.*, identity of the caller, time of day or day of the week, other routing options such as "do not disturb"). Particularly, Microsoft contends that the OTUC server in the OXE system undertakes a number of software-based steps to set and store these incoming call-processing rules, and thereby is queried by the system for call routing instructions when any incoming call arrives. Based on this system operation, Microsoft contends that the ALJ correctly found that the OXE system met at least the first part of the "status" claim construction - the conditional processing status - by filtering calls based on a "do not disturb" status, which the user can set via the PC softphone software and the OTUC server. Particularly, Microsoft asserts that, based on the routing rule and the status thus stored on the OTUC server, the OXE will query the OTUC server upon receiving an incoming call and will process the call according to this status.

In addition, Microsoft submits that OXE system also practices the second type of status covered by the ALJ's claim construction - "engaged in a VoIP call." Particularly, Microsoft argues that the OXE system's filtering of incoming calls when a user is busy on a VoIP call also

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practices the second type of status covered by the ID's claim construction, *i.e.*, "the transfer of data between the computer and telephone networks while the user is engaged in a VoIP phone call." Microsoft asserts that VoIP phone calls involve computer activity such as a PC softphone application and software programs involved in capturing the user's voice, compressing the voice information using various standards, and digitizing the voice. While performing these tasks in the OXE system, Microsoft contends that the user's computer actively monitors and responds to various inputs from the user's keyboard and mouse, allowing the user to perform other tasks - such as sending instant messages - while engaged in a VoIP call. Therefore, Microsoft contends, a VoIP call constitutes current activity of the user on the computer network to satisfy the second part of the ALJ's claim construction for "status."

The IA contends that the "conditional processing" of the OXE system satisfies the relevant claim limitation as these routing methods are described in the '439 patent specification. Further, the IA argues that both parties' experts agreed that such statuses are entered into and stored by the computer network, not the telephone network, *i.e.*, they are stored in the OTUC server or sometimes in the computer memory in the OXE PBX.

3.   *Analysis*

The Commission finds that the OXE system's use of the OTUC software suite to route incoming calls does not directly infringe the '439 patent because its system does not meet the claim limitation of "current activity of the user [called party] on the computer network." As a basis for finding this element satisfied, the ALJ erroneously focused on the OXE's call-processing states unrelated to status on the computer network.

The accused OXE system processes an incoming VoIP call in a manner similar to how a conventional telephone network handles an incoming telephone call. A traditional telephone

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user can set the status of his phone using the keypad and telephone software to process incoming calls in a particular manner; a PC phone user in the OXE system can do the same thing for his softphone using the keyboard, mouse, and PC phone software. The user can set the PC phone to vacation status or "do not disturb," for example, to forward calls to another destination. *See* RX-101C (ABS00009644-51), RX-109C (ABS00132543-51); *see also* August 28, 2007 Deposition Tr. of Hyde-Thomson at 56; Hyde-Thomson, Tr. at 56, 1340-43, 1401-08, 1708-16. ALE's expert testified that "the OXE PBX has an internal register which keeps track of the state of each phone line as either busy, and therefore, not available to take an incoming call . . . [the phone extensions] happen to be implemented as softphones. But they could equally easily be implemented as hardware phones." *See* Hyde-Thomson, Tr. at 1341, 1403.

All of OXE's user-selected, incoming-call-processing states can be stored on the OTUC computer server but nevertheless relate only to the status of the user's phone extension and not the status of the user on the computer network. ALE's expert testified that "the OTUC (incoming call processing) rules don't take account of whether or not users are actually active on their computers or the current status of the user's computer in any sense other than whether they're actually on a telephone call . . . it doesn't make use of any other information than the state of the telephone extension." Hyde-Thomson, Tr. at 1405. While the status of the user's phone extension may be set using the computer network in the OXE system, it is still the status of the phone extension to which the incoming call processing routine responds in order to route the call to the user-selected destination. Simply put, incoming VoIP phone calls in the OXE system are not routed in response to the user's current activity "on the computer network," but rather the user's activity "on the telephone network." This is a crucial distinction, especially in

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view of the intrinsic record and the claim construction for the network limitations agreed upon by the parties.

The ALJ's infringement analysis focused on the term "status," essentially overlooking status "on the computer network." The ALJ observed that "a call can be routed by the OXE system based on the time of day, day of the week, a 'do not disturb' status, or even whether a subscriber is on a list of callers who can bypass the 'do not disturb' state." ID at 143. He then compared these statuses with the '439 patent, noting that the '439 patent described several of them. ID at 144. Nowhere did the ALJ's analysis show that these various statuses relate to the "current status of the user on the computer network" limitation. Although the OXE system *stores* user-selectable criteria for call processing on the computer network, it does not *process* an incoming call according to the user's activity on the computer network. Thus, we find no record evidence that the user's activity or status "on the computer network" in the accused OXE system directs how an incoming call is processed, and thus we find that the OXE system does not meet this claim limitation.

We disagree with Microsoft's contention that the "computer activity" associated with a VoIP phone call, *e.g.*, using the softphone software, digital compression and conversion of voice, transforms this call into activity on the computer network. This alleged "computer activity" (associated control signaling and digital processing) is present when any phone call is made over a computer network. We regard the claim limitation as referring to something other than standard VoIP phone call processing. *See* RX-101C, 109C. We disagree with Microsoft's contention that other activity that the user may be engaged in while on a VoIP phone call, such as checking email using the mouse or keyboard, satisfies the limitation "current activity of the

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user on the computer network" since there is no record evidence that the OXE system routes

calls to a user based on this additional user activity while engaged in a VoIP phone call.

Accordingly, we find that the OXE system does not infringe the '439 patent.

Turning to ALE's other system, the ALJ found that the accused OXO system does not

infringe because its call processing criteria is stored on the CSTA module or the user's PC. He

contrasted this with the OXE system, which uses the OTUC server and associated software. *See*

ID at 145-47. The ALJ apparently viewed the specialized client-server architecture of the OXE

system as inherently involving activity "on the computer network," but we do not. Regardless of

the particular architecture used, in order to infringe, a system must filter calls based on user

activity on the computer network and not just the status of the user's PC phone extension. In

both accused systems, the call is routed based on the status of the user's phone extension, thus

leaving the claim limitation "current activity of the user on the computer network" unsatisfied.

Also, although not specifically discussed herein, we further find that the claim limitation

"current activity of *subscribers* on the computer network" is not met by ALE's accused products.

The record provides no indication that the accused systems process an incoming call based on

subscribers' (calling parties') current activity on the computer network. *See* ID at 138-47.

Based on the foregoing, the Commission reverses the ALJ's determination that ALE's

OXE system directly infringes the '439 patent. Also, the Commission affirms the ALJ's

determination that ALE's OXO system does not infringe the '439 patent.

This determination is not dependent on our modified claim construction, as we find that

ALE's OXE system is not infringing under the ALJ's original claim construction either. Even

under his construction, the limitation "on the computer network" is present in the plain language

of the claim. Thus, while he defined "status" broadly to cover "conditional processing" or

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"engaged in a VoIP phone call," the "on the computer network" language narrows the relevant claimed feature (*e.g.*, "current activity of the user on the computer network") so that it cannot be satisfied by the accused OXE or OXO systems.

Since the Commission has determined that there is no direct infringement by either system, we also determine that there is no indirect infringement of either system since direct infringement is a condition precedent for indirect infringement. *See Glenayre Elecs., Inc. v. Jackson*, 443 F.3d 851, 858 (Fed. Cir. 2006).

C. Invalidity

1. Chestnut Patent

We determined to review the ALJ's validity determinations of claims 1, 28, and 38 of the '439 patent in view of the Chestnut patent. The ALJ determined that claims 1 and 28 of the '439 patent were not shown to be invalid, but that claim 38 was shown to be invalid as anticipated by the Chestnut patent. *See* ID at 68-100.

The Chestnut patent discloses a method for controlling call forwarding using a computer connected to a data network and a telephone network. Chestnut patent, col. 2, ll. 34-37. A telecommute server programmed with user call routing preferences, in combination with the PBX, operates preferably to intercept and route incoming calls according to which specific PC the user is currently logged on in order to forward calls to a user telephone co-located (associated) with that PC (*e.g.*, forward calls to home phone extension in response to user being logged on at home PC). *Id.* at col. 3, ll. 61-67; col. 4, ll. 48-67; col. 5, ll. 13-17. The telecommute server uses a record stored in memory to forward incoming calls to the appropriate phone extension associated with the logged-on user PC. *Id.*

The Chestnut patent also is directed towards improving on and providing access to computer telephony integration ("CTI") applications in the field of invention. *Id.* at col. 1, ll. 39-67; col. 2, ll. 14-24. These CTI applications facilitate incoming and outgoing call handling and control, and are used to seamlessly interface the caller, called party, and information on a host computer for a variety of applications. *Id.* Applications include delivery to a software application of "caller ID", automatic number identification ("ANI"), dialed number identification services ("DNIS"), and interactive voice response ("IVR") dialed digits, such as a customer's account number. *Id.* The Chestnut invention closely integrates a company's LAN (local area network) with its telephone network, thereby making CTI application functions available to local and remote employees, and controls call forwarding based upon user activity on an associated computer terminal. *Id.* at col. 2, ll. 14-31.

We adopt the ALJ's findings that Chestnut discloses several of the elements of claim 1 of the '439 patent, including a "data structure contained within a computer network to store user-selectable criteria for call processing" and "one or more lists [that] are used to filter the incoming call according to . . . current activity of the user on the computer network." ID at 70-78. In this section we set out the reasons why we find that Chestnut discloses the remaining elements of claim 1 so as to anticipate that claim. We also discuss how Chestnut discloses a "computer program product" for implementing the call forwarding system, as required by claim 28.

a. Claim 1: "computer network access port used by the telephone network to access the data structure" limitation

Claim 1 requires a "computer network access port used by the telephone network to access the data structure such that the telephone network has access to one or more lists over the computer network access port." The ALJ found that although the Chestnut patent did disclose a

"computer network access port," it had not been proven by clear and convincing evidence that the Chestnut patent also "discloses a telephone network that accesses the data structure and one or more lists over a computer network access port as required by claim 1." ID at 84.

The ALJ found that the "computer network access port" feature was not disclosed by the Chestnut patent's description of CTI applications that interface the caller, the called party, and information on a host computer to facilitate incoming and outgoing call handling, nor its description of the PBX and the telecommute server operating in combination to route incoming calls based on whether the user is logged on to his PC. *See* ID at 78-84. The ALJ agreed, however, with ALE and the IA that the software stack within the telecommute server could serve as a "computer network access port." He viewed the telecommute server as the component that accesses the data structure containing the incoming call processing criteria. However, he found that the telecommute server is part of the "computer network," unlike the PBX, which is part of the "telephone network." *Id.* at 83-84. The ALJ found, therefore, that Chestnut did not satisfy the portion of the claim limitation requiring the *telephone network* to access the data structure using the network access port. *Id.*

We disagree with the ALJ's conclusion that Chestnut shows that the telecommute server is exclusively on the computer network. Rather, we find that Chestnut discloses that the telecommute server exists on both the telephone and computer networks.

The specification explains that the telecommute server straddles and connects the two networks: "FIG. 1 shows the telecommute server 2 connected to a computer network 8 and a private telephone switch (private branch exchange (PBX)) 4 which in turn is connected to a Publicly Switched Telephone Network (PSTN) 6." Chestnut patent, FIG. 1; col. 4, ll. 36-39. Also, the specification states that: (1) "[t]he present invention closely integrates a company's

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LAN with its telephone network," *id.* at col. 2, ll. 25-26; and (2) "[t]he present invention,

referred to as a telecommute server, is a method for controlling call forwarding using a computer

connected to a data network and a telephone network," *id.* at col. 2, ll. 24-37. The record

supports the ALJ's finding (ID at 83) that the telecommute server contains a port connecting the

two networks. ALE's expert confirmed how the telecommute server operated as a bridge

between the telephone and computer networks:

> [the telecommute] server is a combination of software and hardware running
> in . . . probably a computer . . . which has on one side an interface to the
> telephone network, on the other side an interface to the computer network.
>
> * * * *
>
> the computer network access port will be a part of the software stack inside
> the telecommute server or possibly the actual physical hardware of the
> ethernet port of the telecommute server.
>
> * * * *
>
> by definition a computer telephony integration is a system which integrates on
> the one side, the telephone network, and on the other side, the computer
> network . . . [a]nd within that system, there will be [] a divisioning, maybe a
> hardware port or a software division between the two networks.
>
> * * * *
>
> in the case here [] with Chestnut, it is fairly clear that on one side of the
> telecommute server, it is connected to the private telephone switch over
> telephony. And on the other, it is connected to the LAN or the WAN [wide
> area network].

Hyde-Thomson, Tr. at 1419-21, 1667-68. We find this testimony and the Chestnut patent

specification, including those portions quoted above, to establish the existence of the computer

network access port within the telecommute server. *See also* Chestnut patent, col. 1, ll. 41-53; col. 3, ll. 64-65; col. 4, ll. 48-57; col. 5, ll. 41-45.

We also find that Chestnut discloses that the telecommute server receives a call, accesses its database, and then instructs the PBX on how to route the call. The ALJ specifically recognized that the Chestnut telecommute server does indeed "receive" or "accept" the incoming call. The ALJ agreed with ALE's expert that "accepting an incoming call is a key capability of the telecommute server . . . [b]asically all it does is accept incoming calls, route them to appropriate extensions." *Id.* at 1426; *see also* ID at 96-97 (relating to the ALJ's invalidity analysis concerning claim 38).

The telecommute server accesses its stored data to determine how the call should be routed: "[t]he telecommute server 2 selects the telephone number to which incoming calls should be forwarded based upon a record stored in memory," Chestnut patent at FIG. 1; col. 4, ll. 64-66; and "[t]he telecommute server 2 may either have the call forwarding preferences preprogrammed into it or the forwarding preferences may be entered by the called party," *id.* at FIG. 1, col. 5, 13-17.

The telecommute server checks to see if and where the called party is logged on to the network: "Before the PBX sends the call to the called party office extension 10, the telecommute server 2 checks the computer network 8 to see if the called party is logged on." *Id.* at FIG. 1; col. 4, ll. 50-53.

Because it receives the call and instructs the PBX on how to process the call, a person of ordinary skill in the art would understand that the telecommute server, along with the PBX, is a part of the telephone network. *See* Hyde-Thomson, Tr. at 1420. Because it is also clear, as described just above, that the telecommute server obtains information (*e.g.*, user-selectable call

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forwarding preferences) from memory via the computer network access port, Chestnut discloses that the *telephone network* has access to the lists of the database via the computer network access port as claimed.

Although it does not use the exact words of the '439 patent, we find that Chestnut provides sufficient disclosure, as supported by expert testimony, that its telecommute server functions as an interface between the telephone and computer networks so that one of ordinary skill in the art, together with his or her own knowledge, would understand that the Chestnut patent discloses the limitation of claim 1 of the '439 patent of a "computer network access port used by the telephone network to access the data structure."

b.   Claim 1: "controller" limitation

The ALJ also found that the Chestnut patent did not disclose the "controller" contained in the claim 1 limitation "a controller to receive the incoming call designated for the user telephone . . . the controller accessing the user-selectable criteria . . ." *See* ID at 84-90. He noted that the parties agreed to construe this limitation as "hardware or software that accesses the user-selectable criteria in one or more lists of the data structure via the computer network access port and thereby applying the user-selectable criteria to the incoming call." *See* ID at 26.

The ALJ found that "none of the embodiments described in the Chestnut patent explicitly discloses that the telecommute server includes a controller." ID at 87. He also found that, even if one assumed that the controller were present in the telecommute server, then Chestnut must disclose that the controller both (1) receives the incoming call and (2) accesses the user-selectable criteria in the one or more lists of the data structure via the computer network access port. ID at 88. Finding no such operations disclosed in the Chestnut patent, the ALJ concluded

that the controller limitation is not found within the telecommute server, and thus that the limitation is not disclosed by Chestnut.

On review, the Commission finds that Chestnut in fact discloses the "controller" limitation. As a starting point, the Chestnut patent describes the telecommute server as "controlling call forwarding" and as connected to a data network and a telephone network. *E.g.*, Chestnut patent, FIG. 1, col. 2, ll. 34-37. Moreover, the Chestnut patent discloses that the telecommute server functions as a controller. Although it expresses the claimed feature in different words, Chestnut discloses both that the telecommute server receives an incoming call designated for a user telephone, and that, when processing the incoming call in accordance with the user-selectable criteria, it accesses the data structure on the computer network via a computer network access port.

With respect to the receipt of an incoming call designated for a user telephone, Chestnut states that the telecommute server "intercepts incoming calls which would be forwarded to voice mail." *Id.* at col. 3, ll. 64-66. In terms of processing the call in accordance with the user-selectable criteria, Chestnut discloses that the telecommute server "intercepts an incoming call to check if the called party is logged onto the computer network 8," "checks the computer network 8 to see if the called party is logged on," and "selects the telephone number to which incoming calls should be forwarded based upon a record stored in memory." *Id.* at FIG. 1; col. 4, ll. 50-53, 64-66; col. 5, ll. 40-42. And as described above, we find that the telecommute server obtains information (*e.g.*, user-selectable call forwarding preferences) from memory via the computer network access port, and in this way Chestnut discloses that the telecommute server accesses the user-selectable criteria in the one or more lists of the data structure over the computer network access port as claimed.

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In summary, in order to control call forwarding, the Chestnut telecommute server receives the incoming call, including all relevant call setup signaling, checks where the user is currently logged on, accesses its database memory for the forwarding number or other user-selectable preferences via the computer network access port, and instructs the PBX to forward the call to the telephone associated with the computer terminal at which the user is currently logged on. *See also* Hyde-Thomson, Tr. at 1426:5-10 (ALE's expert testified that "the controller is within that telecommute server . . . it consists of the hardware of the telecommute server and the software running on the processor of the telecommute server that controls the computer telephony system.").

Microsoft argues that Chestnut's disclosure that it "intercepts" the call does not necessarily mean it "receives" the call. However, we find that a person of ordinary skill in the art would understand that the telecommute server "receives" incoming calls. It would be illogical to direct call forwarding without "receiving" the incoming call, *i.e.*, possessing all relevant call setup signaling in order to manage how the call should be processed or forwarded, in accordance with the entirety of the Chestnut disclosure. Therefore, we view Chestnut as disclosing a telecommute server that receives an incoming call for call processing.

Microsoft, *citing Koito Mfg. Co., Ltd. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1152 (Fed. Cir. 2004), claims that ALE's expert testimony was insufficient to show by clear and convincing evidence that a person of ordinary skill in the art would view Chestnut as having disclosed each element of claim 1. We find this expert testimony to be probative. Moreover, contrary to Microsoft's argument, *Koito* does not stand for the proposition that anticipation must be supported by specific expert testimony relating each claim limitation to a prior art element. Rather, *Koito* stands only for the proposition that if expert testimony is used to support an

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anticipation argument, then it must specifically relate the prior art to the claimed elements rather than just generally to the reference. *See Koito*, 381 F.3d at 1151-52.

Again, although it does not use the exact words of the '439 patent, we find that Chestnut provides sufficient disclosure that its telecommute server is essentially a call forwarding controller so that one of ordinary skill in the art, together with his or her own knowledge, would understand that the Chestnut patent discloses the "controller" limitation of claim 1 of the '439 patent.

Accordingly, we find that the telecommute server satisfies all elements of claim 1 of the '439 patent and as such anticipates that claim by clear and convincing evidence.

c.   **Claim 28: "computer program product" limitation**

Claim 28 recites a software implementation of the call processing system recited in claim 1. The ALJ found that the Chestnut patent did not disclose a software implementation, despite the disclosure of the CTI applications, and therefore found claim 28 not invalid in view of Chestnut. *See* ID at 90-94. Particularly, the ALJ found that a "computer program product" is not expressly disclosed by the Chestnut patent, even though he had previously acknowledged that the "network access port" is satisfied by software within the telecommute server. *Id.* at 83-84, 93-94.

We find that the Chestnut telecommute server satisfies the software implementation (*i.e.*, "computer program product" limitation) of claim 28. Chestnut performs the following functions: 1) describes the telecommute server as providing CTI applications (*e.g.*, software applications) as part of its integration of the telephone and LAN (computer) networks; 2) states that the present invention is "a method for controlling call forwarding using a *computer* connected to a data network and a telephone network" (emphasis added); and 3) states that "the telecommute

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server may . . . have the call forwarding preferences preprogrammed into it or . . . may be entered by the [user] when he/she logs onto or off the computer network." *See* Chestnut patent, FIG. 1, col. 2, ll. 20-37, col. 5, ll. 13-15. ALE's expert confirmed that this language from Chestnut shows the telecommute server to operate by means of a computer program running on hardware components to execute computer readable instructions. *See* Hyde-Thomson, Tr. at 1420-25.

One of ordinary skill in the art understands that a computer operates using software programs and Chestnut discloses a computer program running on hardware components (*i.e.*, the telecommute server) to execute computer readable instructions. *See* Chestnut patent, col. 4, ll. 48-64, col. 5, ll. 1-21, col. 6, ll. 34-42; *see also* Hyde-Thomson, Tr. at 1424-25. As the ALJ acknowledged, Chestnut discloses a software stack and ethernet port in the telecommute server that may satisfy the "network access port" feature to link the telephone and computer network. *See* ID at 83-84.

Therefore, we find that one of ordinary skill in the art would read these portions of the Chestnut specification as expressly describing the claimed invention and as such the Chestnut reference anticipates claim 28 by clear and convincing evidence.

d.   Conclusion

The Commission reverses the ALJ's finding that claims 1 and 28 are not invalid as anticipated by the Chestnut patent, and affirms his finding, for the reasons given by the ALJ, that claim 38 is invalid as anticipated by Chestnut. Also, we adopt the ALJ's findings that other limitations, not discussed herein, of claims 1 and 28 are disclosed by Chestnut - *e.g.*, "data structure," "current activity of the user on the computer network."

Microsoft's alternative, proposed construction for "current," as part of the "current activity of the user on the computer network" feature, does not affect our invalidity analysis because Chestnut discloses that calls are routed based on where the user is presently logged on. *See* Chestnut, FIG. 1, col. 2, ll. 34-67; col. 4, ll. 50-67. Chestnut states that the "call is forwarded based upon whether or not the called party is logged onto the data network . . . forwarded call is directed to a telephone line associated with the terminal from which the called party is logged on." *See* Chestnut, FIG. 1, col. 2, ll. 34-67; col. 4, ll. 50-67. Also, Chestnut states that "[l]ogging on to the data network may cause more than one phone line to be forwarded . . . logging on from a computer at home may cause voice phone calls to be forwarded . . ." *See* Chestnut, FIG. 1, col. 2, ll. 34-67; col. 4, ll. 50-67. These portions of the Chestnut patent describe forwarding a call in response to the real-time act of "logging on" by a user, and not solely based on any last known status or location, as Microsoft contends.

Even though Chestnut may not use the same exact words as the '439 patent, we find that it discloses all relevant aspects of the claimed invention to one of ordinary skill in the art (*i.e.,* one possessing a B.S. degree in electrical engineering involving computer science with a minimum of three years in designing and implementing computer telephony systems) and thus anticipates claims 1, 28, and 38. *See Helifix Ltd. v. Blok-Lok, Ltd.,* 208 F.3d 1339, 1346 (Fed. Cir. 2000); *see also In re Graves,* 69 F.3d 1147, 1152 (Fed. Cir. 1995) (*citing In re LeGrice,* 301 F.2d 929, 936 (CCPA 1962) ("A reference anticipates a claim if it discloses the claimed invention 'such that a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention.*'") (emphasis in original). Accordingly, we find that claims 1, 28, and 38 have been proven invalid by clear and convincing evidence as anticipated by Chestnut.

2.   Miner Patent

We determined to review the ALJ's validity determination of claims 1, 28, and 38 of the

'439 patent in view of the Miner patent. *See* ID at 100-09. The ALJ determined that claims 1,

28, and 38 are not invalid as anticipated by the Miner patent. *Id.*

The Miner patent is directed to a method and system implemented by a computer-based

electronic assistant ("EA") to receive and manage incoming calls to a subscriber[4] (called party)

including the steps of receiving an incoming call to the subscriber from a caller, establishing a

first connection between the EA and the caller, establishing a second connection between the EA

and the subscriber, electronically notifying the subscriber of the incoming call, and a plurality of

other steps. Miner Patent (RX-3), Abstract. The Miner system may consist of a computer

including memory and a plurality of interface cards and ports. *Id.* at FIGs. 2-5, col. 9, ll. 23-67.

Particularly, the EA, after receiving an incoming call, performs call processing

operations including a first step of checking the subscriber's status. *Id.* at col. 7, ll. 51-67. If the

subscriber currently has a connection established with his EA, and he has not enabled a "do not

disturb" function, then his status is available and the system will attempt to locate the subscriber

if the subscriber is accepting all calls or calls from the particular calling party. *Id.* at col. 7, ll.

51-67. As a first step in locating the subscriber, the system may determine if the subscriber is

already connected to the system by being logged into his PC. *Id.* at col. 8, ll. 25-39. If the

subscriber is logged into his PC, then the system may send a visual message to the workstation

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[4] The Miner patent utilizes the term "subscriber" for the called party instead of "user" as the '439 patent does. For our purposes here in the invalidity analysis, the term "user" from the '439 patent and the term "subscriber" from the '789 patent have the same meaning: the called party.

notifying the subscriber of the call and identifying the caller. In response, the subscriber may accept the call, ask the system to place the caller on hold, or ask the system to take a message. *Id.* Further, if the system does not locate the subscriber, or the subscriber does not accept the call or does not respond within a predetermined period of time, it notifies the caller that it was unable to locate the subscriber and offers the caller the option of leaving voice mail. *Id.* at col. 8, ll. 60-67.

a. Claim 1: "data structure" limitation

Claim 1 requires "a data structure contained within a computer network to store user-selectable criteria for call processing." The ID does not appear to include any particular findings on whether the "data structure" limitation of claim 1 is disclosed by Miner. The Commission, however, finds that Miner expressly discloses this limitation.

The specification describes the basic hardware components used to implement the invention of the Miner patent: Figure 2 shows one embodiment of the system consists of "a high-performance 486 computer" with interface cards which "include network cards to connect with standard digital telephone lines." *Id.* at FIG. 2 and col. 9, ll. 23-45. ALE's expert testified that the Miner patent discloses that the EA may be implemented using a computer having significant disk space and memory (*e.g.*, 2 GB of disk space and 32 MB of memory), and fixed and removable storage. *See* Hyde-Thomson, Tr. at 1431-41; *see also* Miner patent, FIGs. 2-5, col. 9, ll. 23-67; col. 11, l. 21 to col. 12, l. 44.

The specification further explains that the EA uses this memory to store pieces of information called "objects" or "items." *Id.* at col. 5, ll. 29-46. Among other things, the items stored may include the subscriber's schedule which enables the subscriber to input "when and where he can be reached and his availability at those times." *Id.* at col. 5, ll. 47-57. When the

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system receives an incoming call, the EA checks the subscriber's schedule to determine his availability which may indicate that the subscriber is accepting no calls, all calls or only important calls. *Id.* at col. 7, ll. 63-65. In setting his availability, the subscriber provides instructions to the EA on how to process the calls. *Id.* at col. 7, l. 66 - col. 8, l. 24; col. 32, ll. 54-64.

We find that the portions of the specification referred to above, along with the testimony of Mr. Hyde Thompson, establish that the Miner patent discloses the claimed "data structure within the computer network to store user-selectable criteria for call processing."

b. Claims 1, 28, and 38: "current activity of the user on the computer network" limitation

Claim 1 further requires that "the data structure store [] the user-selectable criteria in one or more lists that are used in filtering an incoming call .... according to the current activity of the user on the computer network."[5] The ALJ reviewed numerous passages from the Miner patent and concluded that it does not disclose this limitation. *See* ID at 100-09. The ALJ agreed with ALE and the IA that Miner's disclosure of a process for checking to see if the subscriber is "logged on" to a computer could satisfy "current activity (or status) of the user on the computer network" limitation. However, the ALJ did not view Miner as disclosing any type of call processing based on the user's status or activity on the computer network as is required by this limitation. *See* ID at 105-09; Miner patent, col. 8, ll. 25-35. The ALJ further found that the Miner patent "does not disclose any user-selectable criteria conditioned on the status of the user as being logged onto his computer." *See* ID at 105.

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[5] Claims 28 and 38 require close variation of this limitation contained in claim 1. The ALJ addressed the limitation for all three claims simultaneously and we do the same here.

The record supports the ALJ's finding that whether a user is logged onto his computer is the "current status of the user on the computer network." ID at 107. The Commission, however, disagrees with the ALJ's conclusion that Miner does not disclose call processing based upon the user's status as being logged onto his computer or user-selectable criteria conditioned on the current status of the user on the computer network as required by claims 1, 28, and 38.

The Miner patent contains the following two passages:

> *Once the assistant either recognizes the caller either through a match with a stored vocalization or through the caller's phone number or labels the caller as unknown, it then attempts to locate the subscriber. It does this by carrying out a sequence of operations the first of which is to check the subscriber's status. If the subscriber currently has a connection established with his assistant (and he has not enabled a do not disturb function), then his status is available.* If the subscriber is not connected, then the assistant may check a secondary information source (such as a cellular network) to determine the subscriber's availability. Finally, the assistant will check the subscriber's schedule. *The subscriber can set his availability to indicate that he is accepting all calls, he is accepting no calls, or he is accepting only important calls.*

Miner patent, col. 7, ll. 51-65 (emphasis added).

> *As a first step in locating the subscriber, the system determines whether the subscriber is already connected to the system, either through another call or through some other communications medium (e.g. logged into his computer).* If the subscriber is on another call being handled by the system, the system briefly interrupts that call to notify the subscriber that he has a call waiting and it identifies the name of the caller. If the caller is also logged onto the system through his computer, the system may also send a visual message to the workstation notifying the subscriber of the call and identifying the caller.

Id. at col. 8, ll. 25-35 (emphasis added). The ALJ looked separately at each of these portions of the Miner specification, among others, and determined that none of them independently satisfied the "current activity of the user on the computer network" limitation. In particular, the ALJ criticized

the first passage as disclosing only that "a user's status will be determined depending on whether the user currently has a connection established with his assistant" not that "the 'connection' discussed in the above quoted passage refers to the user's connection with the computer network." ID at 104. The ALJ found that the second passage indicates "the '789 patent will check to see if a user is logged into his computer," but does not discuss processing the call in any way according to whether the user is logged onto his computer." *Id.* at 103. According to the ALJ, although the EA will send a visual message to the user's computer about the caller, such activity does not amount to call processing "because there is no disclosure that the system does anything with the actual incoming call." *See* ID at 103. Nor did the ALJ find anything in the second passage "that discloses any user-selectable criteria conditioned on the status of the user as being logged onto his computer." *Id.* It does not appear that the ALJ analyzed these two passages when read together.

Viewed together, the Commission finds that the Miner patent discloses the processing of incoming calls based upon whether the user is "connected to the system," either through a phone connection or "through some other communications medium (*e.g., being logged onto his computer*"). Miner patent, col. 8, ll. 25-28 (emphasis added). When the Miner system receives a call, it attempts to locate the subscriber first by checking the subscriber's status as the Miner specification discloses that "[i]f the subscriber currently has a connection established with his assistant . . . then his status is available." *Id.* at col. 7, ll. 53-56. The Miner patent, however, does not define that the subscriber may be "connected" (either over the computer network or the telephone network) until the second passage quoted above from the '789 specification. *Id.* at col. 8, ll. 25-28. The Commission further finds that once a connection (*e.g.*, subscriber is logged onto his computer) has been detected, the Miner system, in response to that connection, will then filter the call based upon subscriber-selected preferences stored in the computer. *Id.* at col. 7, l. 65 - col.

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8, l. 24. Particularly, Miner discloses that the subscriber may "set his availability to indicate that he is accepting all calls, accepting no calls, or he is accepting only important calls." *Id.* at col. 7, ll. 56-59, 63-65. Thus the relevant call processing that Miner discloses is not the visual notification sent to a subscriber about a call, but rather the filtering of calls which occurs based upon how the subscriber has defined his availability in accordance with his current activity on the computer network (*e.g.*, logged into his computer).

Our interpretation of incoming call processing is consistent with the '439 patent. The '439 patent repeatedly describes incoming "call processing" as occurring when call completion to the destination telephone is interrupted in order to access the data structure for the user-selectable criteria to determine how to handle the incoming call, in accordance with the user's current activity on the computer network. *See* the '439 patent, FIGs. 2-4, col. 5, ll. 22-27; col. 6, ll. 23-28, 55-65; col. 9, ll. 7-11; col. 11, ll. 22-24.

Accordingly, we find that the Miner system does disclose the "current activity of the user on the computer" limitation as required by claims 1, 28, and 38 of the '439 patent.

c.   Claim 1: the "controller" limitation

As previously discussed, claim 1 of the '439 patent claims "a controller to receive the incoming call designated for the user telephone and to process the incoming call in accordance with the user-selectable criteria." In evaluating whether the Miner patent discloses other limitations of claim 1, the ALJ assumed for purposes of argument that Miner discloses such a controller, in the form of an electronic assistant (EA). ID at 109. The ALJ did not make an express finding, however, as to whether Miner in fact discloses the controller limitation. *See* ID at 108-09, and generally at 100-109.

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We find that Miner does disclose the controller limitation. The EA of Miner is a combination of hardware and software, an integrated computer/telephone network solution, and a system implemented as software programs running on a computer with appropriate hardware cards. *See* Hyde-Thomson, Tr. at 1431-41. The Miner patent discloses that "[w]hen a caller calls into the system in an attempt to reach a particular subscriber, . . . the system answers the call." Miner patent, col. 7, ll.18-21. It also discloses that the inventive method is "implemented by a computer-based electronic assistant to receive and manage incoming calls to a subscriber including the steps of receiving an incoming call to the subscriber . . ." Miner patent, Abstract.

More particularly, Miner discloses that: (1) the EA is implemented by a computer, *see* Miner patent, FIG. 2, col. 9, ll. 23-67 ("The system consists of a high-performance 486 computer . . ."); (2) the EA answers an incoming call designated for the subscriber telephone, *see* FIG. 5, col. 7, ll. 9-21 ("The system handles an incoming call to a subscriber . . . the system answers the call."); (3) the EA checks the stored subscriber's preferences to determine how to handle the call including checking the subscriber's status by determining if the subscriber is connected via the computer network (*e.g.*, logged into his computer) and checking to see how the subscriber has set his availability (*e.g.*, accepting no calls, only important calls, or all calls)[6], *see* FIGs. 2-5, 24A, 26; Abstract, col. 7, l. 1 to col. 8, l. 67; col. 32, ll. 46-64; col. 35, l. 1 to col. 36, l. 67; and (4) the EA

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[6] Portions of Miner disclosing the claimed feature of "accessing the user-selectable criteria . . . of the data structure via the computer network access port" include the following: "[t]he electronic assistant 10 works in an office containing the subscriber's objects, which are called 'items.' An item is a piece of information that the electronic assistant stores in a database . . .," Miner patent, col. 5, ll. 31-34; "[t]he system consists of a high-performance 486 computer . . . [i]nterface cards 44 . . . interface cards are special-purpose cards to support many different forms of connectivity and communication . . [t]hey include network cards to connect with standard digital telephone lines . . .," *id.* at FIG. 2, col. 9, ll. 24-38; and "the system can establish connections to a Wide Area Network (WAN) or a Local Area Network (LAN) 104 through an ethernet card 106," *id.* FIG. 5, col. 11, l. 21 to col. 12, l. 17.

performs further call processing including routing of the incoming call in response to the subscriber's pre-selected preferences and the subscriber's commands, *see* Abstract, col. 7, l. 51 to col. 8, l. 63; col. 32, ll. 46-64. As ALE's expert testified, "[t]his whole system that's being described in this patent is a hardware and software that accesses the user-selectable criteria in one or more lists of the data structure by the computer network access port, thereby applying the user-selectable criteria to the incoming call which is the agreed definition of the term 'controller.'" Hyde-Thomson, Tr. at 1439-41; *see* Miner patent, Abstract, FIGs. 2-5, cols. 5-9; col. 11, ll. 21 to col. 12, l. 44.

For these reasons, we find that Miner discloses the "controller" limitation of claim 1.

d. Claim 1: "computer network access port used by the telephone network to access the data structure"

As discussed previously, claim 1 recites a "computer network access port used by the telephone network to access the data structure such that the telephone network has access to one or more lists over the computer network access port." In analyzing whether Miner discloses the limitations of this claim language, the ALJ assumed that the EA of Miner is a controller and that the EA "access[es] a data structure containing user-based criteria on a computer network via a computer access port . . . ." ID at 109. Even making those assumptions, however, he found the limitation not satisfied because, in his view, there was no showing in Miner that "said controller is a portion of the telephone network, as required by the claims of the '439 patent." ID at 109. Although the ALJ did not elaborate, his conclusion follows the reasoning he provided when finding the same limitation not disclosed by the Chestnut patent (discussed above). In essence, the ALJ found that unless the EA in Miner is shown to constitute a portion of the telephone network, then there is no evidence of a "computer network access port used *by the telephone network* to access the data structure." *See* ID at 109 (emphasis added). *Compare* ID at 84-85 (discussing the Chestnut patent).

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We find that the EA in Miner, like the telecommute server in Chestnut, constitutes a portion of the telephone network, and thus that the limitation addressed by the ALJ is satisfied. As noted above, the EA of Miner is a combination of hardware and software, an integrated computer/telephone network solution, and a system implemented as software programs running on a computer with appropriate hardware cards. *See* Hyde-Thomson, Tr. at 1431-41. More specifically, the Miner EA receives and processes telephone calls, and, in one embodiment, it engages in a two-way voice exchange of telephone information with the caller. Miner patent, col. 3, ll. 6-11; col. 7, ll. 9-50. When the EA is receiving, processing, or exchanging telephone information, at least the portion of the EA performing those functions constitutes part of the "telephone network," which the parties agreed in defining as a "network for carrying telephone information." ID at 26 (parties agreeing on definition); Chang, Tr. at 1880. Accordingly, we find that the EA of Miner constitutes a portion of the telephone network, and thus that Miner discloses the limitation "a computer network access port used by the telephone network to access the data structure."

We also address the limitations that the ALJ assumed, for purposes of argument, to be disclosed by Miner.

Specifically, we find that Miner discloses a "computer network access port" that functions as the interface by which the telephone network accesses the data structure. The portions of the record cited above in relation to Miner's disclosure of the "controller" limitation illustrate the basic functioning of the controller (see above). In particular, ALE's expert testified that "[t]his whole system that's being described in this patent is a hardware and software that *accesses* the user-selectable criteria in one or more lists of the *data structure* by the *computer network access port*, thereby applying the user-selectable criteria to the incoming call which is the agreed definition of

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the term "controller." Hyde-Thomson, Tr. at 1439-41 (emphasis added); *see* Miner patent at Abstract, FIGs. 2-5, cols. 5-9; col. 11, ll 21 to col. 12, l. 44. ALE's expert specifically testified that Miner teaches a plurality of interface cards and ports to interface with a variety of different communication networks, *e.g.*, telephone networks, computer networks (WANs and LANs), wireless networks, etc. *See* Hyde-Thomson, Tr. at 1438; *see also* Miner patent, FIGs. 2-5, col. 9, ll. 23-67; col. 11, l. 21 to col. 12, l. 44. These portions of the Miner specification disclose the "computer network access port" limitation, as by definition, in accordance with the '439 patent, any bridge between the telephone and computer networks functions as a "network access port" providing access between the telephone and computer networks. *See* the '439 patent, FIG. 2, col. 5, ll. 37-52; col. 6, ll. 55-65; col. 7, ll. 13-15, 25-27, 44-50; col. 12, ll. 41-44.

e. Claim 28: "computer program product" limitation

As appeared to be acknowledged by the ALJ, the Miner EA is implemented by a computer including storage and "access ports" to satisfy the "computer program product" limitation of claim 28. *See* Miner patent, FIGs. 2-5; Abstract; col. 9, ll. 23-67; *see also* ID at 109.

f. Conclusion

The Commission reverses the ALJ's finding that claims 1, 28, and 38 are not invalid as anticipated by the Miner patent. Again, although Miner may not use the same exact words as the '439 patent, we find that it discloses all relevant aspects of the pertinent limitations "computer program product," "data structure," "network access port," "controller," and "current activity of the user on the computer network;" namely receiving an incoming call, accessing call processing criteria stored on the computer network, and routing the call accordingly based on the user's current activity on the computer network, all using a computer readable medium executed by a computer.

Accordingly, we find that Miner discloses all limitations of claims 1, 28, and 38 to one of ordinary skill in the art, and therefore that claims 1, 28, and 38 have been proven invalid by clear and convincing evidence as anticipated by Miner.

IV.   CONCLUSION

In view of our findings that the asserted claims of the '439 patent are not infringed and are invalid, we terminate the investigation with a finding of no violation of section 337.

By order of the Commission.
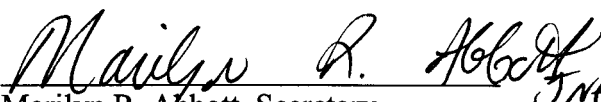
Marilyn R. Abbott
Secretary to the Commission

Issued: June 23, 2008

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **COMMISSION OPINION** has
been served by hand upon the Commission Investigative Attorney, David O. Lloyd, Esq.,
and the following parties as indicated, on ____June 23, 2008_____ .

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UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of)	
)	
CERTAIN UNIFIED COMMUNICATIONS)	Investigation No. 337-TA-598
SYSTEMS, PRODUCTS USED WITH)	
SUCH SYSTEMS, AND COMPONENTS)	
THEREOF)	

<u>Final Initial and Recommended Determinations</u>

This is the administrative law judge's Final Initial Determination under Commission rule 210.42. The administrative law judge, after a review of the record developed, finds <u>inter alia</u> that there is jurisdiction and that there is a violation of section 337 of the Tariff Act of 1930, as amended.

This is also the administrative law judge's Recommended Determination on remedy and bonding, pursuant to Commission rules 210.36(a) and 210.42(a)(1)(ii). The administrative law judge recommends the issuance of a limited exclusion order barring entry into the United States of infringing unified communication system, products used with such systems and components thereof, the issuance of a cease and desist order, and that a bond be set in the amount of 100 percent of entered value during the Presidential review period.

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ABBREVIATIONS

CBr	Complainant's Post-hearing Brief
CDX	Complainant's Demonstrative Exhibit
CPFF	Complainant's Proposed Finding
CORFF	Complainant's Objection To Respondents' Proposed Finding
COSFF	Complainant's Objection To Staff's Proposed Finding
CRBr	Complainant's Post-hearing Reply Brief
CRRFF	Complainant's Proposed Rebuttal Finding to RFF
CRSFF	Complainant's Proposed Rebuttal Findings to SFF
CX	Complainant's Exhibit
JX	Joint Exhibit
RBr	Respondent's Post-hearing Brief
RDX	Respondent's Demonstrative Exhibit
RX	Respondent's Exhibit
RFF	Respondent's Proposed Finding
ROCPFF	Respondent's Objection To Complainant's Proposed Finding
RRBr	Respondent's Post-hearing Reply Brief
RRCPFF	Respondent's Proposed Rebuttal Finding To CFF
SBr	Staff's Post-hearing Brief
SFF	Staff's Proposed Finding
SRRFF	Staff's Proposed Rebuttal Finding to RFF
SRBr	Staff's Post-hearing Reply Brief

SRCFF   Staff's Proposed Rebuttal Finding To CFF

Tr.   Transcript Of Pre-hearing Conference and Hearing

OPINION

I.   Procedural History

On February 16, 2007, Microsoft Corporation (Microsoft) filed a complaint accusing

respondent "Alcatel Lucent" of violating Section 337 in the importation, sale for importation,

and sale after importation into the United States of certain unified communications systems,

products used with such systems, and components thereof, by reason of infringement of claims 1

and 3 of U.S. Patent No. 6,421,439 (the '439 patent), claims 1-20 of U.S. Patent No. 6,430,289

(the '289 patent), claims 1, 3-5, 7-9, and 11-13 of U.S. Patent No. 6,263,064 (the '064 patent)

and claims 1, 2, 4, 6, 8, and 17 of U.S. Patent No. 6,728,357 (the '357 patent). (72 Fed. Reg.

14138 (March 26, 2007).) On March 20 the Commission issued the Notice of Investigation. (Id.)

The Commission's Notice of Investigation was published in the Federal Register on March 26,

2007. (Id.) Order No. 3, which issued on April 24, 2007, set a target date of April 28, 2008

which meant that any final initial determination on violation should be filed by January 28, 2008.

On April 19, 2007, Microsoft moved to amend the complaint and notice of investigation

to substitute Alcatel Business Systems (ABS) as the respondent and to add claims 8, 28, 38, and

48 of the '439 patent and claim 20 of the '064 patent. On April 26, 2007, Order No. 4 granted

the motion. (Commission Decision Not to Review, May 17, 2007.)

On August 17, 2007, Microsoft moved for summary determination as to the economic

prong of the domestic industry requirement. On September 5, 2007, Order No. 9 granted said

motion. (Commission Decision Not to Review, Sept. 20, 2007.)

On August 22, 2007, the parties filed a stipulation relating to importation of the accused

products (JX-9) to which the administrative law judge gave effect by issuing Order No. 8 on

August 23, 2007.

On August 23, 2007, Microsoft moved to terminate the investigation as to claim 8 of the '439 patent, claims 2, 4-5, and 11-20 of the '289 patent, claims 1, 4-5, 7, and 13 of the '064 patent, and claims 1, 2, 8, and 17 of the '357 patent. On September 6, 2007, Order No. 10 granted said motion terminating said claims from the investigation. (Commission Decision Not To Review, Sept. 20, 2007.)

A letter dated October 5, 2007 by the private parties to the administrative law judge was included with Order No. 18 which issued on October 5. Said letter included certain stipulations for streamlining the issues for the hearing. Also in said letter claims 3 and 48 of the '439 patent, claims 3, 6 and 8-10 of the '289 patent, claim 9 of the '064 patent and claim 4 of the '357 patent were withdrawn. Said Order No. 18 terminated the investigation as to those claims. (Commission Notice Not To Review, Oct. 23, 2007.)

On October 12, 2007, ABS filed an unopposed Motion to Amend the Complaint and Notice of Investigation to reflect a corporate name change from ABS to Alcatel-Lucent Enterprise (ALE). Said motion was granted on October 15, 2007 thru issuance of Order No. 19 (Commission Decision Not To Review, (Oct. 26, 2007.)

An evidentiary hearing was conducted on October 9, 10, 11, 12, and 15, 2007. In issue at the evidentiary hearing, inter alia, was whether the importation into the United States, the sale for importation, or the sale within the United States after importation by respondent of certain unified communication systems, products used with such systems, and components thereof involved infringement of claims 1, 28 and 38 of the '439 patent (JX-1), claims 1 and 7 of the '289 patent, (JX-2), claims 3, 8, 11, 12 and 20 of the '064 patent (JX-3) and claim 6 of the '357 patent (JX-4) and whether an industry in the United States exists, with respect to each of said

patents, as required by subsection (a)(2) of Section 337. Posthearing submissions have been filed.[1]

The matter is now ready for a final decision.

The Final Initial and Recommended Determinations are based on the record compiled at the hearing and the exhibits admitted into evidence. The administrative law judge has also taken into account his observation of the witnesses who appeared before him during the hearing. Proposed findings of fact submitted by the parties not herein adopted, in the form submitted or in substance, are rejected as either not supported by the evidence or as involving immaterial matters and/or as irrelevant. Certain findings of fact included herein have references to supporting evidence in the record. Such references are intended to serve as guides to the testimony and exhibits supporting the finding of fact. They do not necessarily represent complete summaries of the evidence supporting said findings.

II.   Jurisdiction Including Parties And Importation

The private parties in this investigation are Microsoft and ALE. See FF 1-4. The Commission has subject matter jurisdiction over this investigation because Microsoft has alleged violation by ALE of Section 337 in connection with the importation of certain ALE products, pursuant to 19 U.S.C. § 1337. Amgen, Inc. v. U.S. Int'l Trade Comm'n, 902 F.2d 1532, 1536 (Fed. Cir. 1990). Moreover, the parties have further stipulated to the importation of certain ALE products. (JX-9.) In addition, the Commission has personal jurisdiction over ALE in this

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[1] Referring to a telephone call by the attorney adviser, complainant, as stated in a letter dated December 19, 2007 to the Secretary, submitted a corrected rebuttal to ALE's proposed findings of fact, and corrected posthearing reply brief to correct certain inadvertent clerical errors contained in Microsoft's rebuttal to ALE's proposed findings of fact and Microsoft's posthearing reply brief, respectively, which were both filed on November 13, 2007.

investigation because ALE has participated fully in said investigation, including participation in discovery and motion practice. See Certain Audible Alarm Devices For Divers, Inv. No. 337-TA-365, Initial Determination, 1995 ITC LEXIS 66, *3 (Feb. 2, 1995) ("The Commission has personal jurisdiction over respondent IHK because IHK participated fully in discovery and the hearing.")

III.   Patents Including Claims In Issue

The field of art for the '439 and '289 patents, referred to by the parties as the "Liffick Patents," is computer telephony. (Hyde-Thomson, Tr. at 1219.)[2] The field of art for the '064 and '357 patents, referred to by the parties as the "O'Neal Patents," is unified messaging. (Hyde-Thomson, Tr. at 1222.) (SFF 15, 16 (undisputed).)

A.   The Liffick '439 And '289 Patents

On March 24 and April 13, 1999, Stephen Liffick filed the applications that would ultimately issue as the '439 and '289 patents, respectively. (JX-1; JX-2.) The '439 patent is entitled "System and Method for User Affiliation in a Telephone Network," and issued on July 16, 2002. (JX-1, cover.) The '439 patent has been assigned to Microsoft. (Id.). Claims 1, 28 and 38 are in issue. They read:

> 1.   In an environment where subscribers call a user over a telephone network, wherein a user telephone is coupled with the telephone network, a system for processing an incoming call from a subscriber to a user in the telephone network according to user specifications, the system comprising:
>
> a data structure contained within a computer network to store user-selectable criteria for call processing, wherein the data

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[2] Henry Hyde-Thomson was qualified as respondent's expert, and Jack Chang was qualified as complainant's expert. See FF 5, 6.

structure stores the user selectable criteria in one or more lists that are used in filtering an incoming call and wherein some of the one or more lists are used to filter the incoming call according to current activity of subscribers on the computer network or according to current activity of the user on the computer network;

a computer network access port used by the telephone network to access the data structure such that the telephone network has access to the one or more lists over the computer network access port; and

a controller to receive the incoming call designated for the user telephone and to process the incoming call in accordance with the user-selectable criteria, the controller accessing the user-selectable criteria in the one or more lists of the data structure via the computer network access port and thereby applying the user-selectable criteria to the incoming call.

(JX-1 at 14:13-37.)

28.   In a system where subscribers call a user over a telephone network, wherein a user telephone is coupled with the telephone network, a computer program product for implementing a method for processing a call from a subscriber to a user over a telephone network, the computer program product comprising:

a computer readable medium having computer executable instructions for performing the method, the method comprising:

accepting an incoming call designated for the user telephone;

accessing a data structure contained within a computer network that is independent of the telephone network to retrieve user-selectable criteria for call processing stored within the data structure, wherein some of the user-selectable criteria is conditioned on current activity of subscribers on the computer network or according to current activity of the user on the computer network; and

processing the incoming call in accordance with the user-selectable criteria.

(JX-1 at 16:53-17:6.)

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38. In a system including a telephone network and a computer network where an originating telephone connects with a user telephone over the telephone network, a method for processing a call from the originating telephone to the user telephone according to user specifications, the method comprising:

accepting an incoming call designated for the user telephone from an originating telephone of a subscriber;

accessing a data structure contained within a computer network that is independent of the telephone network to retrieve user-selectable criteria for call processing stored within the data structure, wherein some of the user-selectable criteria is conditioned on current activity of subscribers on the computer network or according to current activity of the user on the computer network; and

processing the incoming call of the subscriber in accordance with the user-selectable criteria.

(JX-1 at 18:1-18.)

The '289 patent is entitled "System and Method for Computerized Status Monitor and Use in a Telephone Network," and issued on August 6, 2002. (JX-1, cover). The '289 patent is assigned to Microsoft. (Id.). Claims 1 and 7 are in issue. They read:

1. In a system that includes a telephone network and a computer network with one or more users, wherein each user is connected through a user computer the computer network and is logically connected through the computer network to the telephone network, a method of determining when to establish telephone communication between two parties, at least one of whom is a user connected to said computer network comprising:

at the computer network, receiving information from the telephone network that a first party from whom a call is originating desires to establish telephone communication with a second party;

at the computer network, monitoring activity of a user computer connected to the computer network and associated with the second party;

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at the computer network, storing a set of pre-determined rules for determining when the second party is available to take a call from the first party;

at the computer network, using the set of pre-determined rules to process i) the information received from the telephone network regarding the call being originated by the first party, and ii) information regarding the monitored activity of the user computer of the second party, to determined when the second party is available to take the call originated by the first party; and

using the information processed at the computer network to facilitate connecting the call originated by the first party through the telephone network to the second party.

(JX-2 at 18:36-65.)

7. In a system that includes a telephone network and a computer network with one or more users, and wherein each user is connected through a user computer to the computer network and is logically connected through the computer network to the telephone network, a computer program product comprising:

a computer readable medium for carrying computer executable instructions for implementing at the computer network a method of determining when to establish telephone communication between two parties, at least one of whom is a user connected to said computer network, and wherein said method comprises:

at the computer network, receiving information from the telephone network that a first party from whom a call is originating desires to establish telephone communication with a second party;

at the computer network, monitoring activity of a user computer connected to the computer network and associated with the second party;

at the computer network, storing a set of predetermined rules for determining when a second party is available to take a call from the first party; and

at the computer network, using the set of predetermined rules to process i) the information received from the telephone network

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regarding the call being originated by the first party, and ii)
information regarding the monitored activity of the user computer
of the second party, to determine when the second party is
available to take the call originated by the first party.

(JX-2 at 19:20-48.)

B.   The O'Neal '064 And '357 Patents

The '064 patent, the application of which was filed on January 29, 1999, is entitled

"Centralized Communication Control Center for Visually and Audibly Updating Communication

Options Associated with Communication Services of a Unified Messaging System and Methods

Therefor," and issued on July 17, 2001, to named inventors Stephen O'Neal and John Jiang.

(JX-3, cover.) The '064 patent is assigned to Microsoft. (See JX-32C.) Claim 3, which depends

on claim 1, as well as claims 8, 11, 12 and 20 are in issue. Said claims read:

> 1.   A computer-implemented control center for permitting a subscriber
> of a plurality of communication services of a unified messaging
> system to customize communication options pertaining to said
> plurality of communication services through either a
> telephony-centric network using a telephone or a data-centric
> network using a display terminal, said computer-implemented
> control center comprising:
>
> a subscriber communication profile database, said subscriber
> communication profile database having therein an account
> pertaining to said subscriber, said account including said
> communication options for said subscriber, said communication
> options including parameters associated with individual ones of
> said plurality of said communication services and routings among
> said plurality of communication services;
>
> a computer server coupled to exchange data with said subscriber
> communication profile database, said computer server being
> configured to generate a single graphical menu for displaying said
> communication options for each of said communication services at
> the same time, and to visually display said single graphical menu
> on said display terminal when said subscriber employs said display

terminal to access said computer-implemented control center
through said data-centric network, said computer server also being
configured to receive from said subscriber via said display terminal
and said data-centric network a first change to said communication
options and to update said first change to said account in said
subscriber communication profile database, wherein said single
graphical menu comprises at least a first display area for showing a
first communication service and a first communication option
associated with said first communication service, and a second
display area for showing a second communication service and a
second communication option associated with said second
communication service, the first display area and the second
display area being displayed at the same time in said single
graphical menu, and wherein the first communication option
includes a first enable option for enabling or disabling the first
communication service, and wherein the second communication
option includes a second enable option for enabling or disabling
the second communication service; and

a telephony server coupled to exchange data with said
communication profile database, said telephony server being
configured to audibly represent said communication options to said
telephone when said subscriber employs said telephone to access
said computer-implemented control center, said telephony server
also being configured to receive from said subscriber via said
telephone a second change to said communication option and to
update said second change to said account in said subscriber
communication profile database.

(JX-3 at 18:22-19:9.)

3.   The computer-implemented control center of claim 1 wherein said
      plurality of communication services include a call forwarding
      service configured to permit said subscriber to specify whether a
      call received at a telephone number associated with said account be
      forwarded to a forwarding telephone number, said communication
      options including a call forwarding enable option and said
      forwarding telephone number.

(JX-3 at 19:22-29.)

8.   The computer-implemented control center of claim 1 wherein the
      first communication option includes a first routing option, and

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wherein the second communication option includes a second routing option.

(JX-3 at 19:59-62.)

11. The computer-implemented control center of claim 1 wherein said plurality of communication services comprise an e-mail service configured to permit said subscriber to receive and transmit e-mails through said data centric network, and a voice telephone service configured to permit said subscriber to receive and transmit voice calls through said telephony-centric network.

(JX-3 at 20:5-11.)

12. The computer-implemented control center of claim 11 wherein said plurality of communication services include a facsimile service configured to permit said subscriber to receive at said unified messaging system a facsimile through said telephony-centric network and said telephony server, said communication options including a facsimile receiving enable option associated with said facsimile service.

(JX-3 at 20:12-18.)

20. A computer-implemented control center for permitting a subscriber of a plurality of communication services of a unified messaging system to customize communication options pertaining to said plurality of communication services through either a telephony-centric network using a telephone or a data-centric network using a display terminal, said computer-implemented control center comprising:

a subscriber communication profile database, said subscriber communication profile database having therein an account pertaining to said subscriber, said account including said communication options for said subscriber, said communication options including parameters associated with individual ones of said plurality of said communication services and routings among said plurality of communication services;

a computer server coupled to exchange data with said subscriber communication profile database, said computer server being configured to generate a single graphical menu for displaying said

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communication options for each of said communication services at the same time, and to visually display said single graphical menu on said display terminal when said subscriber employs said display terminal to access said computer-implemented control center through said data-centric network, said computer server also being configured to receive from said subscriber via said display terminal and said data-centric network a first change to said communication options and to update said first change to said account in said subscriber communication profile database, wherein said single graphical menu comprises at least a first display area for showing a first communication service, and a first communication option associated with said first communication service, and a second display area for showing a second communication service, and a second communication option associated with said second communication service, the first display area and the second display area being displayed at the same time in said single graphical menu, and wherein the first communication service and the second communication service are selected from a call forwarding service, a follow me service, an alternate number service, a message alert service, a fax receiving service or a paging service,

a telephony server coupled to exchange data with said communication profile database, said telephony server being configured to audibly represent said communication options to said telephone when said subscriber employs said telephone to access said computer-implemented control center, said telephony server also being configured to receive from said subscriber via said telephone a second change to said communication options and to update said second change to said account in said subscriber communication profile database.

(JX-3 at 22:43-24:14.)

The '357 patent is entitled "Centralized Communication Control Center and Methods Therefor," and issued on April 27, 2004, to named inventors Stephen C. O'Neal and John Jiang. (JX-4, cover). The '357 patent derives from application no. 09/907,051, filed on July 17, 2001, which is a continuation of application no. 09/239,585, filed on January 29, 1999 which application issued as the '064 patent. (Id.). The '357 patent is assigned to Microsoft. (Id.)

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Claim 6 of the '357 patent, which depends on claim 1 (not in issue per se) of said patent,

is in issue. Said claims read:

1. A computer-implemented method for permitting a subscriber of a plurality of communication services of a unified messaging system to customize communication options pertaining to said plurality of communication services, said communication options include parameters associated with individual ones of said plurality of said communication services and routings among said plurality of communication services, said plurality of communication services comprising a voice telephone service through a telephony-centric network and an e-mail service through a data-centric network, said communications options being accessible via display terminals coupled to said data-centric network and via telephones coupled to said telephony-centric network, said method comprising:

   providing a subscriber communication profile database, said subscriber communication profile database having therein an account pertaining to said subscriber, said account including said communication options for said subscriber;

   generating a single graphical menu for displaying said communication options for each of said communication services at the same time, wherein said single graphical menu comprises at least a first display area for showing a first communication service and a first communication option associated with said first communication service, and a second display area for showing a second communication service and a second communication option associated with said second communication service, the first display area and the second display area being displayed at the same time in said single graphical menu, and wherein the first communication option included a first enable option for enabling or disabling the first communication service, and wherein the second communication option includes a second enable option for enabling or disabling the second communication service;

   visually displaying said single graphical menu on one of said display terminals, using a computer server coupled to exchange data with said subscriber communication profile database, when said subscriber employs said one of said display terminals to access said computer-implemented control center;

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providing a telephony server coupled to exchange data with said communication profile database;

audibly representing said communication options to one of said telephones, using said telephony server, when said subscriber employs said one of said telephones to access said computer-implemented control center;

receiving from said subscriber via said one of said display terminals at said computer server a first change to at least one of said communication options, said first change to said communication options pertains to either said voice telephone service or said e-mail service; and

updating said first change to said account in said subscriber communication profile database, thereby resulting in a first updated subscriber communication profile database, wherein subsequent messages to said subscriber at said unified messaging system, including said voice telephone service, are handled in accordance with said first updated subscriber communication profile database.

(JX-4 at 18:12-19:6.)

6.   The computer-implemented method of claim 1 wherein said plurality of communication services include a call forwarding service configured to permit said subscriber to specify whether a call received at a telephone number associated with said account be forwarded to a forwarding telephone number, said communication options including a call forwarding enable option and said forwarding telephone number.

(JX-4 at 19:43-50.)

IV.   Background Technology

Computer telephony (the field of art for the Liffick Patents) overlaps with unified messaging, (the field of art for the O'Neal Patents) but is broader. (Chang, Tr. at 411.) Computer telephony, refers to the integration of computer technology and telephone technology. (Chang, Tr. at 408). (SFF 17, 18 (undisputed).)

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Newton's Telecom Dictionary states: "Computer telephony adds computer intelligence to the making, receiving, and managing of telephone calls. Harry Newton coined the term in 1992. Computer telephony has two basic goals: to make making and receiving phone calls easier, i.e. to enhance one's personal productivity and second, to please corporate customers who call in or who are called for information, service, help, etc." (SX-20, at 191.) Newton's Telecom Dictionary further states:

> Integrated Messaging. Also called Unified Messaging. Integrated messaging is one of may benefits of running your telephony via a local area network. Here's the scenario: Voice, fax, electronic mail, image and video. All on one screen. You arrive in the morning. Turn on your PC. It logs onto your LAN and its various servers. In seconds, it gives you a screen listing all your messages – voice mail, electronic mail, fax mail, reports, compound documents .... Anything and everything that came in for you. Each is one line. Each line tells you whom it's from. What it is. How big it is. How urgent. Skip down. Click. Your PC loads up the application. Your LAN hunts down the message. Bingo, it's on screen. If it contains voice – maybe it's a voice mail or compound document with voice in it – it rings your phone and plays the voice to you. Or, if you have sound card, it can play the voice through your own PC. If it's an image it may hunt down (also called launch) an imaging application which can open the image you have received, letting you see it. Ditto, if it's a video message. Messages are deluging us. To stop them is to stop progress, Run your eye down the list, one line per entry. Pick the key ones. Junk the junk ones. Postpone the others.
>
> It gets better. You're out. Dial in on a gateway with your laptop. Skim your messages. Dial in on a phone. Punch in some buttons. Hear your voice mail messages. Or if you're not on your laptop, have your e-mail read to you. Better, have your fax server OCR your faxes and image mail and have it read them to you. A LAN server is the perfect repository for messages. It can search for them, assemble them, process them, store them, convert them, compress them, shape them, shuffle them, interpret them. Integrated messaging essentially applies intelligence and order to the messages deluging you each day.

(SX-20, at 405.) (SPFF 19, 21 (undisputed).)

The parties have agreed that the construction of the term "unified messaging system" means "system that allows messages of a data-centric network and a telephony-centric network to

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be received, stored, retrieved, and forwarded without regard to communication devices or networks employed for the transmission of the message." (Chang, Tr. at 571:18-25; CDX-126.) The meaning of unified messaging was understood in the field for many years prior to the applications for the patents at issue here. (See SX-19, at 548; (SPFF 22 (undisputed).) The problems of integrating telephone and computer networks came about because traditionally telephone and computer technologies worked independently of each other and although they shared the same physical infrastructure, they failed to work well together logically. (Chang, Tr. at 427:15-24; CDX-2.) In 2007, IBM published a white paper addressing some of the challenges still faced by the convergence of telephone and computer networks. (Chang, Tr. at 427:4-14; CDX-2; CX-454; CFFF 34, 35 (undisputed).)

A PSTN (public switched telephone network)[3] is a traditional telephone network that connects up telephones at home, businesses, and consists of a number of local telephone exchanges along with international and long distance exchanges. (Chang, Tr. at 428:9-17; CDX-3.) A cellular network is a mobile phone network that most people in the field of art consider to be part of the telephone network. (Chang, Tr. at 428:18-25; CDX-3.) (CPFF 36, 37 (undisputed).)

A PBX is a telephone switching system that is usually privately controlled by a business. (JX-29C (Tidwell Depo.) at 79:13-16.) It is a combination of hardware and software. (JX-29C (Tidwell Depo.) at 80:2-4.) and is connected to the PSTN. (Chang, Tr. at 428:4-16, 429:9-10; CDX-3.) (CPFF 38-40 (undisputed).)

At a high-level, a computer network, as it exists today and as it existed at the time of the

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[3] See JX-1 at 1:45.

inventions in issue, generally consists of a computer server and a computer terminal. (Chang, Tr. at 429:22-2; CDX-4.) The way computers communicate is through digital data, typically in binaries [zeros and ones] and the computers communicate by exchanging packets (sometimes called cell or frames in the industry) back and forth. (Chang, Tr. at 430:2-7, 21-23; CDX-4.) Typically, a packet contains three major components: a packet has a header, a trailer, and a data payload in the middle. (Chang, Tr. at 430:8-20; CDX-4.) The header of a packet typically contains addressing information about the packet's destination. (Chang, Tr. at 430:8-20; CDX-4.) The trailer of a packet typically provides information about integrity of the data. (Chang, Tr. at 430:8-20; CDX-4; CPFF 41, 42, 44-46 (undisputed).)

The actual data that is being transferred back and forth between various computing devices is called a data payload and is located in the middle of the packet. (Chang, Tr. at 430:8-20; CDX-4.) Sending a message a packet at a time over the network is much like sending a letter page by page in individual envelopes, instead of having the pages stapled together and sending all the pages of the letter at one time. (Chang, Tr. at 429:22-430:23; CDX-4; CPFF 47, 48 (undisputed).)

Computers communicate using certain protocols. (Chang, Tr. at 430:24-431:1; CDX-4.) A protocol typically refers to an agreement between two computing devices to communicate and allows two separate computing devices to share and exchange information. (Chang, Tr. at 431:1-12; CDX-4.) Computers must understand, or support, the same protocols to communicate successfully. (Chang, Tr. at 430:24-432:8.) Protocols are a very important way for various computing devices to communicate with each other. (Chang, Tr. at 431:23-432:1; CDX-4; CPFF 49-52 (undisputed).)

With the adoption of digital transmission over larger portions of the PSTN, the physical infrastructure carrying telephone conversations was able to transmit many different types of data, including computer data, image data and video. (Chang, Tr. at 432:14-434:14; CDX-5.) DSL (digital subscriber loop) is a way for a telephone conversation and the computer session to take place at the same time via the same physical wire. (Chang, Tr. at 433:18-25; CDX-5.) DSL transmits digital data in the frequency band from 25 kilohertz all the way to 1 megahertz, uses that frequency band to transfer computer data, uses the same wire to transmit voice information in the 0 to kilohertz voice band, and as a result, allows a voice conversation and the computer data transmission to take place at the same time. (Chang, Tr. at 434:1-10; CDX-5; CPFF 58, 59 (undisputed).)

An example in which a computer and the telephone networks share the same physical infrastructure is when two computers are connected to the computer network and yet they are engaged in a telephone conversation from one computer to another computer using a technology referred to as Voice over IP ["VoIP"]. (Chang, Tr. at 434:23-435:12, 435:23-25; CDX-6; CPFF 61 (undisputed).)

CDX-6 illustrates another example in which the computer and telephone networks share the same physical infrastructure. This slide illustrates two computers, labeled PC 2 on the left-hand side of the diagram and another computer that's labeled PC B on the right-hand side of the diagram. PC 2 and PC B are connected to the computer network and yet they are engaged in a telephone conversation from one PC to another using a technology referred to as Voice over IP ("VoIP"). (Chang, Tr. at 434:23-435:12, 435:23-25; CDX-6; CPFF 63 (undisputed).)

VoIP technology was available in 1999 and would have been within the knowledge of

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one of ordinary skill. (Chang, Tr. at 1017:16-23; Hyde-Thomson, Tr. at 1645:1-1646:6.) When a packet of a VoIP call arrives at the destination, the packet is de-assembled and it is converted back to analog voice format. (Chang, Tr. at 435:14-22; CDX-6; CPFF 70, 71 (undisputed).)

A telephone user interface (TUI) allows a user to interact with a unified messaging or other system through a series of voice prompts, and be able to set certain options and configurations or listen to existing options and services by voice or key-press commands. (Chang, Tr. at 581:19-582:2; JX-3 ('064 patent) at 14:65-67 (describing a "telephone interface if the subscriber wishes to review and/or change the communication options using a telephone connected to the telephony-centric network. The communication options may be presented in a sound format and the subscriber may be offered an option menu to review and/or change any communication option setting"); CPFF 76 (undisputed).)

A graphical user interface (GUI) is a graphical representation of the user interface for a unified messaging or other system, which allows the user to enter, through a display area, various options and settings on the computer. (Chang, Tr. at 582:3-9; JX-3 ('064 patent) at 11:37-50 (describing Fig. 3's graphical "user-interface for an exemplary computer-implemented control center, representing the visual display panel for displaying the communication options pertaining to a particular subscriber on a computer display screen. Through computer-implemented control center 302, the user may quickly and conveniently review the communication option settings associated with the various services and make changes thereto").) (CPFF 77 (undisputed).)

V.   Person Of Ordinary Skill In The Art

With respect to the Liffick and O'Neal patents, a person of ordinary skill in the art would have a Bachelor's degree in electrical engineering involving computer science with a minimum

of three years of experience in designing and implementing computer telephony systems. (Chang, Tr. at 407, 410.)

VI.   Claim Construction

Claim interpretation is a question of law. <u>Markman v. Westview Instruments, Inc.</u>,52 F.3d 967, 979 (Fed. Cir. 1995) (<u>en banc</u>), <u>aff'd</u>, 517 U.S. 370 (1996) (<u>Markman</u>); <u>see</u> <u>Cybor Corp. v. FAS Techs., Inc.</u>, 138 F.3d 1448, 1455 (Fed. Cir. 1998). In construing claims, a court should look to intrinsic evidence consisting of the language of the claims, the specification and the prosecution history as it "is the most significant source of the legally operative meaning of disputed claim language." <u>Vitronics Corp. v. Conceptronic, Inc.</u>, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (<u>Vitronics</u>); <u>see</u> <u>Bell Atl. Network Servs., Inc. v. Covad Commc'n. Group, Inc.</u>, 262 F.3d 1258, 1267 (Fed. Cir. 2001).

The claims themselves "provide substantial guidance as to the meaning of particular claim terms." <u>Phillips v. AWH Corp.</u>, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (<u>Phillips</u>), <u>citing</u> <u>Vitronics</u>, 90 F.3d at 1582. It is essential to consider a claim as a whole when construing each term, because the context in which a term is used in a claim "can be highly instructive." <u>Id.</u> In construing claims, the administrative law judge should first look "to the words of the claims themselves . . . to define the scope of the patented invention." <u>Vitronics.</u>, 90 F.3d at 1582; <u>see</u> <u>generally</u> <u>Phillips</u>, 415 F.3d at 1312-13. Claim terms "are generally given their ordinary and accustomed meaning." <u>Vitronics</u>, 90 F.3d at 1582.

In <u>Pause Technology, Inc. v. TIVD, Inc.</u>, 419 F.3d 1326 (Fed. Cir. 2005) the court stated:

> . . . in clarifying the meaning of claim terms, courts are free to use
> words that do not appear in the claim so long as "the resulting
> claim interpretation . . . accord[s] with the words chosen by the

> patentee to stake out the boundary of the claimed property." Cf.
> Renishaw PLC v. Marposs Societá per Azioni, 158 F.3d 1243,
> 1248 (Fed. Cir. 1998) (noting that "[w]ithout any claim term
> susceptible to clarification . . . there is no legitimate way to narrow
> the property right").

Id. at 1333. Also, claim terms are presumed to be used consistently throughout the patent, such that the usage of the term in one claim can often illuminate the meaning of the same term in other claims. Research Plastics, Inc. v. Federal Packaging Corp. 421 F.3d 1290, 1295 (Fed. Cir. 2005) (Research Plastics).

The ordinary meaning of a claim term may be determined by reviewing a variety of sources, which may include the claims themselves, dictionaries and treatises, and the written description, the drawings and the prosecution history. Ferguson Beauregard/Logic Controls v. Mega Sys., LLC, 350 F.3d 1327, 1338 (Fed. Cir. 2003). The use of a dictionary, however, may extend patent protection beyond what should properly be afforded by a patent. Also, there is no guarantee that a term is used in the same way in a treatise as it would be by a patentee. Phillips, 415 F.3d at 1322. Moreover, the presumption of ordinary meaning will be "rebutted if the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." ACTV, Inc. v. Walt Disney Co., 346 F.3d 1082, 1091 (Fed. Cir. 2003).

The presence of a specific limitation in a dependent claim raises a presumption that the limitation is not present in the independent claim. Phillips, 415 F.3d at 1315. This presumption is especially strong when the only difference between the independent and dependant claims is the limitation in dispute. SunRace Roots Enter. Co., Ltd. v. SRAM Corp., 336 F.3d 1298, 1303 (Fed. Cir. 2003). Moreover, "claim differentiation takes on relevance in the context of a claim

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construction that would render additional, or different, language in another independent claim superfluous." AllVoice Computing PLC v. Nuance Commc'ns, Inc., 504 F.3d 1236, 2007 U.S. App. LEXIS 23949, at *23 (Fed. Cir. 2007). In addition a claim construction that gives meaning to all the terms of a claim is preferred over one that does not do so. See Merck & Co. v. Teva Pharms. USA, Inc., 395 F.3d 1364, 1372 (Fed. Cir.), cert. denied, 546 U.S. 972 (2005) (Merck); Alza Corp. v. Mylan Labs. Inc., 391 F.3d 1365, 1370 (Fed. Cir. 2004) (Alza) (affirming the district court's rejection of both parties' claim construction where those constructions meant that "the inclusion of the word 'base' in the claims would be redundant"). Differences between the claims are helpful in understanding the meaning of claim terms. Phillips, 415 F.3d at 1314.

The preamble of a claim may be significant in interpreting a claim. Thus, "a claim preamble has the import that the claim as a whole suggests for it." Bell Commc'ns Research, Inc. v. Vitalink Commc'ns Corp., 55 F.3d 615, 620, 34 U.S.P.Q.2d 1816, 1820 (Fed. Cir. 1995). If said preamble, when read in the context of an entire claim, recites limitations of the claim, or if the claim preamble is "necessary to give life, meaning, and vitality" to the claim, then the claim preamble should be construed as if in the balance of the claim. Kropa v. Robie, 187 F.2d 150, 152 (CCPA 1951) (Kropa); see also Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997) (Rowe); Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257 (Fed. Cir. 1989) (Corning Glass). Indeed, when discussing the "claim" in such a circumstance, there is no meaningful distinction to be drawn between the claim preamble and the rest of the claim, for only together do they comprise the "claim." If, however, the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention's limitations, but rather merely states, for

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example, the purpose or intended use of the invention, then the preamble may have no significance to claim construction because it cannot be said to constitute or explain a claim limitation. See Rowe, 112 F.3d at 478; Corning Glass, 868 F.2d at 1257; Kropa, 187 F.2d at 152. In Pitney Bowes Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1306 (Fed. Cir. 1999) (Pitney Bowes), the preamble statement that the patent claimed a method of or apparatus for "producing on a photoreceptor an image of generated shapes made up of spots" was not merely a statement describing the invention's intended field of use. Instead, the Court found that said statement was intimately meshed with the ensuing language in the claim; and that, for example, both independent claims concluded with the clause "whereby the appearance of smoothed edges are given to the generated shapes." Id. Because this was the first appearance in the claim body of the term "generated shapes," the Court found that the term could only be understood in the context of the preamble statement "producing on a photoreceptor an image of generated shapes made up of spots." Id. Similarly, the Court found that the term "spots" was initially used in the preamble to refer to the elements that made up the image of generated shapes that were produced on the photoreceptor; that the term "spots" then appeared twice in each of the independent claims; and that the claim term "spots" referred to the components that together made up the images of generated shapes on the photoreceptor and was only discernible from the claim preamble. Id. The Court concluded that in such a case, it was essential that the preamble and the remainder of the claim be construed as one unified and internally consistent recitation of the claimed invention. Id.

The specification of a patent "acts as a dictionary" both "when it expressly defines terms used in the claims" and "when it defines terms by implication." Vitronics, 90 F.3d at 1582. For example, the specification "may define claim terms by implication such that the meaning may be

found in or ascertained by a reading of the patent documents." Phillips, 415 F.3d at 1323, quoting Iredto Access, Inc. v. Echostar Satellite Corp., 383 F.3d 1295, 1300 (Fed. Cir. 2004). Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. Phillips, 415 F.3d at 1314.

A patentee may deviate from the conventional meaning of a particular claim term by making the intended meaning of a particular claim term clear (1) in the specification or (2) during the patent's prosecution history. Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 889 (Fed. Cir. 1984). If using a definition that is contrary to the definition given by those of ordinary skill in the art, however, the patentee's specification must communicate a deliberate and clear preference for the alternate definition. Kumar v. Ovonic Battery Co., Inc., 351 F.3d 1364, 1368 (Fed. Cir. 2003), citing Apple Computers, Inc. v. Articulate Sys., Inc., 234 F.3d 14,21 n.5 (Fed. Cir. 2000). In ascribing an alternative definition than the ordinary meaning, the intrinsic evidence must "clearly set forth" or "clearly redefine" a claim term so as to put one reasonably skilled in the art on notice that the patentee intended to so redefine the claim term. Bell Atl. Network Servs., Inc. v. Covad Communs. Group, Inc., 262 F.3d 1258, 1268 (Fed. Cir. 2001).

The prosecution history, including "the prior art cited," is "part of the 'intrinsic evidence.'" Phillips, 415 F3d at 1317. The prosecution history "provides evidence of how the inventor and the PTO understood the patent." Id. Thus, the prosecution history can often inform the meaning of the claim language by demonstrating how an inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would be otherwise. Vitronics, 90 F.3d at 1582-83; see also Chimie v.

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PPG Indus., Inc., 402 F.3d 1371, 1384 (Fed. Cir. 2005) ("The purpose of consulting the prosecution history in construing a claim is to exclude any interpretation that was disclaimed during prosecution"), quoting ZMI Corp. v. Cardiac Resuscitator Corp., 844 F.2d 1576, 1580 (Fed. Cir. 1988); Southwall Techs., Inc. v. Cardinal IG Co., F.3d 1570, 1576 (Fed. Cir. 1995); see also Verizon Servs. Corp. v. Vonage Holdings Corp., 503 F.3d 1295, 1306 (Fed. Cir. 2007), citing Microsoft Corp. v. Multi-tech Sys., Inc., 357 F.3d 1340, 1350 (Fed. Cir. 2004) ("We have held that a statement made by the patentee during prosecution history of a patent in the same family as the patent-in-suit can operate as a disclaimer.") The prosecution history includes any reexamination of the patent. Intermatic Inc. v. Lamson & Sessions Co., 273 F.3d 1355, 1367 (Fed. Cir. 2001).

In addition to the intrinsic evidence, the administrative law judge may consider extrinsic evidence when interpreting the claims. Extrinsic evidence consists of all evidence external to the patent and the prosecution history, including inventor testimony and expert testimony. This extrinsic evidence may be helpful in explaining scientific principles, the meaning of technical terms, and terms of art. See Vitronics, 90 F.3d at 1583; Markman, 52 F.3d at 980. However, "[e]xtrinsic evidence is to be used for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims." Markman, 52 F.3d at 981. Also, the Federal Circuit has viewed extrinsic evidence in general as less reliable than the patent and its prosecution history in determining how to read claim terms. Phillips, 415 F.3d at 1318. In addition, while extrinsic evidence may be useful, it is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence. Phillips, 415 F.3d at 1319.

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In <u>Nystrom v. Trex Company</u> 424 F.3d 1136 (Fed. Cir. 2005), the Court stated:

> . . . as explained in <u>Phillips</u>, Nystrom is not entitled to a claim construction divorced from the context of the written description and prosecution history. The written description and prosecution history consistently use the term "board" to refer to wood decking materials cut from a log. Nystrom argues repeatedly that there is no disavowal of scope of the written description or prosecution history. Nystrom's argument is misplaced. <u>Phillips</u>, 415 F.3d at 1321 ("The problem is that if the district court starts with the broad dictionary definition in every case and fails to fully appreciate how the specification implicitly limits that definition, the error will systematically cause the construction of the claim to be unduly expansive."). What <u>Phillips</u> now counsels is that in the absence of something in the written description and/or prosecution history to provide explicit or implicit notice to the public– i.e., those of ordinary skill in the art– that the inventor intended a disputed term to cover more than the ordinary and customary meaning revealed by the context of the intrinsic record, it is improper to read the term to encompass a broader definition simply because it may be found in a dictionary, treatise, or other extrinsic source. Id.

<u>Id.</u> at 1144, 1145. In <u>Free Motion Fitness Inc. v. Cybex Int'l Inc.</u> 423 F.3d 1343 (Fed. Cir. 2005), the Court concluded that:

> under <u>Phillips</u>, the rule that "a court will give a claim term the full range of its ordinary meaning", <u>Rexnord Corp. v. Laitram Corp.</u>, 274 F.3d 1336, 1342 (Fed.Cir. 2001), does not mean that the term will presumptively receive its broadest dictionary definition or the aggregate of multiple dictionary definitions. <u>Phillips</u>, 415 F.3d at 1320-1322. Rather, in those circumstances, where references to dictionaries is appropriate, the task is to scrutinize the intrinsic evidence in order to determine the most appropriate definition.

<u>Id.</u> at 1348, 1349. In <u>Network Commerce, Inc. v. Microsoft Corp.</u> 422 F.3d 1353 (Fed. Cir. 2005), the Court concluded:

> As we recently reaffirmed in <u>Phillips</u>, "conclusory, unsupported assertions by experts as to the definition of a claim term are not useful to a court." <u>Phillips</u>, 415 F.3d at 1318. Here [expert] Coombs does not support his conclusion [the "download

component" need not contain the boot program] with any references to industry publications or other independent sources. Moreover, expert testimony at odds with the intrinsic evidence must be disregarded. Id. ("[A] court should discount any expert testimony that is clearly at odds with the claim construction mandated by . . . the written record of the patent." (internal quotations and citation omitted). That is the case here.

Id. at 1361.

Patent claims should be construed so as to maintain their validity. However, that maxim is limited to cases in which a court concludes, after applying all the available tools of claim construction, that the claim is still ambiguous. Phillips, 415 F.3d at 1327. If the only reasonable interpretation renders the claim invalid, then the claim should be found invalid. See, e.g., Rhine v. Casio, Inc., 183 F.3d 1342, 1345 (Fed. Cir. 1999).

A.   The Liffick '289 And '439 Patents

The parties have agreed upon the following claim construction for purposes of this investigation:

Claim Term	Agreed Upon Construction
telephone network ('439 and '289 patents)	network for carrying telephony information
computer network ('439 and '289 patents)	network for carrying digital data
current activity of the user on the computer network ('439 patent)	current status of the user on the computer network
the controller accessing the user-selectable criteria in the one or more lists of the data structure via the computer network access port ('439 patent)	hardware or software that accesses the user-selectable criteria in one or more lists of the data structure via the computer network access port and thereby applying the user-selectable criteria to the incoming call

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(See Order No. 18 (attached letter dated October 5, 2007).)

According to complainant, the disputed claim terms in the Liffick '439 and '289 patents that need construction by the administrative law judge are:

"independent" (claims 28 and 38 of the '439 patent);

"activity of a user computer" (claims 1 and 7 of the '289 patent).

(CBr at 29-30.)

Respondent argued that only one claim construction issue remains regarding asserted claims 28 and 38 of the '439 patent which is the meaning of the term "independent." (RBr at 11.) It is argued that the "lone claim construction issue" with regard to the '289 patent involves the claim limitation "monitoring activity of a user computer" (RRBr at 8.)

The staff argued that the only dispute as to any claim construction of asserted claims 28 and 38 of the '439 patent appears to be the construction of the limitation calling for "assessing a data structure contained within a computer network that is independent of the telephone network." (SRBr at 5-6.) The staff further argued that the private parties appear to agree that the only issue still in dispute with respect to the asserted claims of the '289 patent is the language calling for "monitoring the activity of a user computer connected to the computer network" and then routing calls "based on the monitored activity of the user computer." (SRBr at 8.)

The administrative law judge does not understand the representations of each of the complainant, respondent and the staff that only one claim construction issue remains regarding the asserted claims of the '439 patents. Thus, while the parties represented that the claim phrase "current activity of the user on the computer network" in asserted claims 1, 28 and 38 of the '439 patent has an agreed upon construction of "current status of the user on the computer network,"

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the parties in the infringement and domestic industry portions of their post hearing submissions have put in dispute the phrase "status of a user on the computer network." The parties have also put into issue, in the validity portions of said post hearing submissions, the claim phrase "current activity" by disputing the definition of the agreed-upon construction of "current status." Thus, the administrative law judge construes, infra, the claim phrase "current activity of the user on the computer network" in light of the parties' stipulated construction.

1.   Claimed Phrase Involving "activity of a user computer"

Complainant argued that its proposed construction for the term "activity" found in each of claims 1 and 2 of the '289 patent is "status" whereas ALE's proposed construction limits "activity" to only two states, viz. "active or idle." (CBr at 32.) It is argued that the dispute is not over whether "activity" means "status" but whether "activity" is limited to only two states, viz. "active or idle" in the context of the '289 patent. (CBr at 18.)

Respondent argued that the specification of the '289 patent supports its construction that monitoring activity of a user's computer requires determining whether the computer is active or idle and that Microsoft's proposed construction rewrites the claims in issue and results in a system that does not solve the basic problem the inventor sought to solve in the '289 patent (RBr at 6, 7.)

The staff argued that the phrase "monitoring activity of a user computer connected to the computer network" should be construed to mean determining whether the user computer is "active or idle." (SBr at 25.)

The first consideration in construing claims is the language of the claims themselves. Referring to said claims in issue, each of the asserted claims 1 and 7 of the '289 patent explicitly

refers to the activity of a user computer and not to the status or activity of a user. Thus claim 1

reads in part:

> In a system that includes a telephone network and a computer
> network with one or more users, wherein each user is connected
> through a user computer the computer network and is logically
> connected through the computer network to the telephone
> network, a method of determining when to establish telephone
> communication between two parties, at least one of whom is a
> user connected to said computer network comprising:
>
> * * *
>
> at the computer network, monitoring activity of a user computer
> connected to the computer network and associated with the
> second party;
>
> * * *

(JX-2 at 18:36-50 (emphasis added).) Claim 7 reads in part:

> In a system that includes a telephone network and a computer
> network with one or more users, and wherein each user is
> connected through a user computer to the computer network and is
> logically connected through the computer network to the telephone
> network, a computer program product comprising:
>
> * * *
>
> at the computer network, monitoring activity of a user computer
> connected to the computer network and associated with the second
> party;
>
> * * *

(JX-2 at 19:20-37 (emphasis added).)

Referring to the abstract of the '289 patent, the patentee distinguished between routing

calls based on the user's status and routing calls based on monitoring the activity of a user's

computer:

> A telecommunication system combines telephone technology and computer. network technology to monitor a caller and callee's computer activity and to access call processing criteria selected by the caller and callee and stored on the computer network. A component of the telephone system, such as a central office switch, accesses the caller and callee call processing criteria. The system evaluates the call processing criteria and, when conditions for both caller and callee are met, the telephone system initiates a telephone call between the caller and callee. The call processing criteria may include accepting all calls, no calls, or calls only from specified parties. In addition, the call processing criteria can vary in accordance with the time of day or an individual's personal preferences, or status, such as when an individual is in a meeting. A user's computer activity may also be monitored and the computer status as idle or active may be reported to the computer network as part of the call processing criteria.

(JX-2, abstract (emphasis added).) This distinction is further confirmed by the "third paragraph"

of the SUMMARY OF THE INVENTION section which reads:

> Both the caller and callee can specify user-selectable call processing criteria. The potential callee can specify call processing criteria for all incoming calls, such as such as providing a list of individuals from whom the person will accept calls, a list of individuals from whom the person will not accept calls, or conditional criteria, such as accepting or blocking calls during certain times of day or during certain periods of activity, such as when the user may be otherwise occupied and unwilling to accept an incoming call. In addition, the potential callee computer activity may be monitored and the status of the computer as active or idle may be reported to the computer network. The caller indicates a desire to establish a communication link with the callee. The computer network accesses the caller's call processing criteria and the callee's call processing criteria. The call processing criteria for both the caller and callee are analyzed and when all conditions are met, a telephone communication link is established between an originating telephone associated with the caller and a destination telephone associated with the callee.

(JX-2 at 2:7-26 (emphasis added).) In addition, the distinction between call routing based on the

activity or status of a user and call routing based on the activity or status of a user computer is

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repeated in the DETAILED DESCRIPTION OF THE INVENTION. Thus it is stated:

> The operation of the system 100 to establish a communication link with both the originating telephone 102 and the destination telephone 104 [100, 102 and 104 as in e.g. Fig. 2] is illustrated in the flowchart of FIG. 10 where, at a start 250, it is assumed that the caller and callee both have data in their respective affiliation lists. As previously noted, the affiliation list 150 for each individual may comprise separate sublists, such as illustrated in FIG. 5, or a single data structure containing call processing criteria, such as allowing or blocking individual calls (see FIG. 7) or establishing conditional criteria, such as time restrictions, current user status (e.g., in a meeting), or the current status of the user's computer (e.g., the idle or active status of the callee computer 154). Furthermore, as previously noted, user status can be automatically provided to the affiliation list 150 by a computerized schedule program.

<p align="center">* * *</p>

> As noted above, the system 100 can apply call processing rules derived from any source, such as the current status (e.g., idle or active) of the callee computer 154 or the caller computer, 184, the presence or absence on one of the sublists in FIG. 5 (e.g., the block list 164), the status of one party (e.g., the allowed status of the caller), callee or caller status data provided by computerized scheduling systems, or the like.

(JX-2 at 16:8-22, 17:59-66 (emphasis added).) Hence, the specification of the '289 patent

defines the status or activity of the user and the status or activity of the user computer as two

different things. Moreover, it equates computer status to "idle or active."

Other portions of the specification of the '289 patent that use the phrase "idle or active"

to describe the computer activity that is being monitored are:

> In other implementations, such as with a home computer, only a single telephone line may serve the function of both the communication link 110 and the communication link 132. Under these circumstances, the caller may use the caller computer 184 to indicate a desire to establish the telephone communication link and then must terminate the communication link 132 so that the central

office switch may generate the appropriate signals on the communication link 110 at a point in time when the callee call processing criteria and the caller call processing criteria are both met. It should be further noted that this implementation will preclude the use of the status (i.e., idle or active) of the caller computer 184 since the communication link 132 is not active.

Similarly, the destination telephone 104 and the callee computer 154 may be connected to the central office switch 116 and the Internet 134 via separate communication links (i.e., the communication link 120 and the communication link 132, respectively). However, the system 100 may also be implemented with a single phone line. The callee may use the callee computer 154 and the communication link 132 to generate or edit the callee call processing criteria in the affiliation list 150. However, the user must then terminate the communication link 132 to permit the central office switch 116 to establish the communication link 120. As noted above, a single phone line precludes the use of computer status monitoring (i.e., idle or active) for the callee computer 154 since the status cannot be monitored via the communication link 132.

* * *

For example, the caller may indicate an availability for a phone call after a predetermined time. The system 100 can detect the change in the state of the caller computer 184 from the idle state to the active state and interpret that as an indication that the caller is now available for a telephone call. The system can apply these conditions individually or in various combinations to determine the availability of the caller and callee. If the call does not meet the caller call processing criteria, the result of decision 264 is NO. In that event, the system 100 can return to step 258 to access the affiliation lists for the callee and caller, respectively, and thus continuously monitor the callee and caller call processing criteria to determine an appropriate time to make a phone call.

(JX-2 at 15:47-67, 16:1-7, 17:20-34 (emphasis added).)

Complainant admits that the word activity "has no specific meaning in the field of the '289 patent." (SPFF 82 (undisputed).) Moreover, the issue at hand is not the construction of the

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lone word "activity" but rather the construction of the claimed phrase "monitoring activity of a user computer" (emphasis added) which phrase contains the word "activity."

Complainant, in support of its argument that "activity means some undefined status, relies on hearing testimony of its expert Chang which testimony is some five years after the issuance of the '289 patent. (See COSFF 78, CRSFF78-A, CRSFF 78-B.) Here, however, the claims in issue of the '289 patent including the claimed phrase "monitoring activity of a user computer connected to the computer network," do not refer to the status or activity of the user but explicitly refer to the activity of the user computer. (JX-2 at 18:49-50, 19:36-37.) Thus to a person of ordinary skill in the art, said claims themselves indicate that the status or activity of a user in said claimed phrase is not covered. Instead, the patentee determined to limit the claimed phrase to "monitoring activity of a user computer." (emphasis added). See Vitronics and Phillips, supra (stressing the importance of the explicit language of claims).

Regarding complainant's contention that the "activity" limitations of the '439 and '289 patent refer to the same thing, i.e., the status of the user on the computer network, the '439 patent and the '289 patent do not use the same terms. Thus the '439 patent specifically refers to the "activity of the user on the computer network" while the '289 patent refers to the "activity of a user computer connected to the computer network." (Compare JX-1 at 14:25-26, 17:3-4, 18:15-16 with JX-2 at 18:49-50, 19:36-37.) In addition, although the '289 patent is similar to the '439 patent and has the same named inventor as the '439 patent, the specifications of the two patents contain substantial differences, including five columns of discussion and a different abstract. Moreover, the summary of invention section added to the later filed '289

specification[4] indicates how the monitored activity of the user computer is used to help

determine when the called party is available for a call. (See "third paragraph,"as cited supra of

said summary of invention section that uses the phrase "status of the computer as active idle"

which is not found in the summary of invention section of the '439 patent.)

Complainant referred to the use in the '289 patent specification of the illustrative

conjunction "e.g.," to connect "idle or active" to the word "status," citing JX-2 at 16:18-19,

17:59-62 (CBr at 34), and argued that examples of other "activity," presumably covered in the

claimed phrase "monitoring activity of a user computer connected to the computer network,"

include "unwilling to accept," "do not disturb," "occupied," "busy," "calendar-based activity"

and "being in a meeting." (See CRRFF IV A.1.2- CRRFF IV A. 1, 2-P and CRRFF IV A.1.2-X.)

However, nowhere in the '289 patent does the administrative law judge find those examples

associated with the user computer. To the contrary, the abstract and summary of the invention

specifically equate user's computer activity only to the "computer status as idle or active," or the

"status of the computer as active or idle. (See supra.)

Based on the foregoing, the administrative law judge interprets the claimed phrase

"monitoring activity of a user computer connected to the computer network" to mean

determining whether the user computer is "active or idle."

2.   Claimed Phrase "Independent"

Complainant argued that claims 28 and 38 of the '439 patent recite "accessing a data

structure contained within a computer network that is independent of the telephone network;"

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[4] The '289 application was filed on April 13, 1999 while the '439 application was filed
on March 24, 1999. (JX-1, JX-2.)

that the claim construction dispute boils down to whether the term "independent" means that the computer network and telephone network must be "logically distinct" (as proposed by Microsoft) or "physically distinct or separate" (as proposed by ALE); that according to Microsoft's expert Chang, the term "independent" denotes a "logical" difference between the computer and telephone networks, not a physical separation between the two networks; that Microsoft's proposed construction is based on the plain meaning of the term "independent," which is simply "not dependent or contingent upon something else for existence, operation, etc."; and that the '439 patent specification further supports Microsoft's position that the computer network and telephone network are not required to be physically separate. (CBr at 30-32.)

Respondent argued that the claim term "independent" does not appear in claim 1 of the '439 patent, which only recites a system with a telephone network and a computer network, and does not require that these two networks be independent; that in contrast, claim 28 and claim 38 of the '289 patent both specify that the telephone network and the computer network must be independent by reciting "a data structure contained within a computer network that is independent of the telephone network," and thus, in addition to reciting two distinct networks, this language further requires that the networks must be "independent;" and hence that a person of ordinary skill in the art would understand the inclusion of the term independent in the claims to be significant. (RBr at 104-105.)

The staff is of the view that the intrinsic evidence indicates that the limitation "independent of the telephone network" should be construed to mean "accessing a data structure in the computer network that is physically separate from the telephone network." (SBr at 28.) The staff's proposed construction however does not require that the telephone

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network and computer network be completely separate but rather that the data structure be on a part of the computer network that is physically separate from the telephone network. (SRBr at 8-9.) It is argued that complainant's contention that "independent" is construed only as "logically independent" means effectively nothing, pointing to complainant's expert Chang's testimony that the word independent "just emphasizes the logical separation between the two networks", citing Tr. at 1020. Moreover, the staff believes that all of the accused products, the domestic industry products, and the cited prior art references satisfy the phrase in issue. (SBr at 20-1; SRBr at 7.)

As found supra, the first consideration in construing claims is the language of the claims themselves. Here, independent claim 1 of the '439 patent requires a computer network and a telephone network, and states "a data structure contained within a computer network to store user-selectable criteria for call processing." (JX-1 at 14:18-19.) Claim 1 does not explicitly state that the data structure contained within a computer network is independent of the telephone network. Independent claims 28 and 38, however, do add an additional requirement, viz. "a data structure contained within "a computer network that is independent of the telephone network to retrieve user-selectable criteria for call processing stored within the data structure." (JX-1 at 16:64-67, 18:9-13 (emphasis added).) Hence, the language of independent claims 28 and 38 require explicitly that the data structure be independent of the telephone network. The administrative law judge finds that construing the claimed term "independent" in the claimed phrase "accessing a data structure contained within a computer network that is independent of the telephone network to retrieve user-selectable criteria for call processing stored within the data structure" (emphasis added) of claims 28 and 38 requires accessing a data structure in the

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computer network that is physically separate from the telephone network which gives meaning to the term "independent." Otherwise, he finds that the claimed word "independent" superfluous, redundant and meaningless. See Merck and Alza cited supra. He further finds that said requirement is supported by both the plain meaning of the word "independent" and by the specification of the '439 patent. The word "independent" by definition means not dependent upon something else for existence. See, Random House College Dictionary 676 (rev. ed. 1982) ("4. not dependent or contingent upon something else for existence, operation, etc."); Webster's Third New Int'l Dictionary 1148 (2002) ("not requiring or relying on something else (as for existence, operation, efficiency)").

Referring to the specification, the specification makes clear that there are physically separate computer and telephone networks, and that the required data structures are on parts of the system that are physically part of the computer network. Thus even though the specification of the '439 patent indicates that the "network link 156" may be a single telephone communication link, using the modem to communicate with the Internet 134 and thus a sharing of phone lines, see JX-1, at 6:36-38, it shows two separate systems that comprise the computer network (the internet) and the telephone network (the local and long distance exchanges). (See JX-1, FIGS. 2, 3 and 4.)

In the embodiments described in the '439 patent, the "data structure," which the phrase in issue specifically refers to, is entirely located on the internet. Thus the abstract of the '439 patent reads:

> A telecommunication system combines telephone technology and
> Internet technology to establish one or more user-specified
> affiliation lists. The affiliation lists are stored on the Internet and

are accessible by the user and by the telecommunication portion of the system. The affiliation lists are used to process incoming calls to the user's destination telephone number. A central office switch receives the call being directed to the destination telephone number and uses a communication link with the Internet to access the user's affiliation lists. The incoming call is processed in accordance with the user-specified rules in the affiliation lists. The user may accept all incoming calls, no incoming calls, or incoming calls only from specified parties. The call processing rules may be readily edited by the user and can also include alternative call processing rules that vary in accordance with the time of day or with the user's personal desires

(JX-1, abstract (emphasis added).) Moreover, under the subheading SUMMARY OF THE

INVENTION, the '439 patent reads:

A system to specify user-selectable criteria for call processing is implemented on a conventional telephone system, such as a public switched telephone network (PSTN). The user-specified call processing criteria is stored on a network that is accessible by the user for data entry and/or editing, and is also accessible by the PSTN to determine whether call processing criteria exists for the particular caller. The Internet provides a readily available data structure for storage of the user-selectable call processing criteria. The user can establish a database stored on the Internet in association with the user's telephone number and indicating the user-selectable call processing criteria for one or more potential callers.

* * *

The system may be readily implemented on current telephone systems with no significant modifications. For example, the system may apply the user-specified call processing criteria at the central office switch to which the destination telephone is coupled. All call processing prior to arrival at that central office switch is performed in accordance with conventional telecommunication techniques and standards. When a call arrives at the central office switch coupled to the destination telephone, the central office switch does not immediately establish a communication link with the destination telephone, but accesses the user-specified call processing criteria on the Internet and applies the call processing

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criteria. If the call is allowed, the central office switch establishes a communication link with the destination telephone in a conventional fashion to complete the telephone call. If the call is not allowed, the central office switch will not process the call, and may generate a busy signal to indicate that the user is unavailable.

(JX-1 at 1:44:55-2:8-25 (emphasis added).) In addition, under the subheading DETAILED DESCRIPTION OF THE INVENTION, the '439 patent indicates that the data structure is simply an ordinary computer database in any of a wide variety of forms. Thus the '439 patent reads:

> FIG. 6 illustrates sample data entries in the allow list 166. The allow list 166 may include data, such as a name, Internet subscriber name, and one or more phone numbers associated with the individual data entry. It should be noted that the calling party need not have an Internet subscriber name for proper operation of the system 100. That is, the central office switch 116 accesses the allow list 166 utilizing the calling party number and need not rely on any email addresses or other Internet subscriber identification for proper operation. The allow list 166 may also include an email alias in addition to or in place of the Internet subscriber name. Some Internet subscribers prefer to "chat" with other subscribers utilizing an alias rather than their actual Internet subscriber name. The data of FIG. 6 illustrates one possible embodiment for the allow list 166. However, those skilled in the art can appreciate that the allow list 166 may typically be a part of a large database (not shown). Database operation is well known in the art, and need not be described in greater detail herein. The database or other form of the forward list 160 may be satisfactorily implemented using any known data structure for storage of data. For example, the various lists (e.g., the allow list 166, the reverse list 162, the block list 164 and the allow list 166) may all be integrated within a single database structure. The present invention is not limited by the specific structure of the affiliation list 150 nor by the form or format of data contained therein.

(JX-1 at 9:55-67, 10:1-14 (emphasis added).) Hence, as seen from the foregoing, the data structure is not physically part of the telephone network.

At the hearing complainant's expert Chang was queried about support for complainant's

proposal that the claimed term "independent" as found in claims 28 and 38 means "logically

distinct."[5] Thus Chang testified:

> Q. We have just established claim 1 requires a computer network and a telephone network, correct?
>
> A. Claim 1 of '439 you are referring to, right, Mr. Lloyd?
>
> Q. Correct.
>
> A. Thank you. Yes.
>
> Q. And claim 28 requires a computer network that is independent of the telephone network, correct?
>
> A. That's the claim language, yeah.
>
> Q. So what does the word independent add to claim 28?
>
> A. I think it just emphasizes the logical separation between the two networks in claim 28.
>
> Q. Are the two networks going to be logically separate in claim 1?
>
> A. They can be.
>
> Q. Well, will they be?
>
> A. It depends on the context. I mean, claim 1 made reference to the computer network and made reference to the telephone network. They can share the same physical infrastructure. They can be largely independent.
>
> Q. Are there situations where the computer network and telephone network are not logically independent?

---

[5] The terms "logically," and "logically distinct" are not found in the '439 patent. Morever, the administrative law judge did not find Chang's testimony at the hearing helpful in arriving at a definition for said terms which a person of ordinary skill in the art would understand at the filing date of the '439 patent.

A.   Are not logically independent? You mean that means they are dependent on each other?

Q.   Logically independent is your choice of words, so I can't really define it for you.

A.   Could you repeat the question, please?

Q.   Sure. Are there situations where the telephone network and the computer network are not logically independent?

A.   That means they're logically dependent on each other. That would be my interpretation.

* * *

JUDGE LUCKERN: Go ahead.

MR. LLOYD: I will move on as you requested.

BY MR. LLOYD:

Q.   In the real world then, where is there a system where the telephone network and the computer network are not logically independent?

A.   Are not logically independent, meaning they are logically dependent, that would be my interpretation.

Q.   Okay. Using that interpretation.

A.   I think that that is a designer's choice. I mean, the designer of the computer systems and the computer networks and telephone system and telephone network could choose to design a CTI system where they are logically dependent.

Q.   Maybe I will ask it this way, Doctor. What do you mean by logically dependent in that case?

A.   That means that the functionality or delivery of the functionality of one network depends upon the existence or operation of the other network.

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(Tr. at 1020-24 (emphasis added).) Chang's testimony did not address the specific requirement of independent claims 28 and 38 that requires that a <u>data</u> <u>structure</u> contained within a computer network be independent of the telephone network. Moreover, the administrative law judge finds Chang's testimony confusing. For example, while on the one hand Chang testified, <u>supra</u>, that the word "independent" in claims 28 and 38 "just emphasizes the logical separation between the two networks in claim 28," he later testified, <u>supra</u>, that the designer of the computer systems and the computer networks and telephone system and telephone networks could choose to design a CTI system where the "functionality or delivery of the functionality of one network depends upon the existence or operation of the other network." The latter appears to be something more than a situation which "just emphasizes the logical separation between the two networks." The latter thus gives support to the claim differentiation doctrine.

Based on the foregoing, the administrative law judge finds that the limitations of claims 28 and 38 requiring "accessing a <u>data structure</u> contained within a computer network that is <u>independent</u> of the telephone network" (emphasis added) would be construed by a person of ordinary skill in the art at the time of filing for the '439 patent to mean "accessing a <u>data</u> <u>structure</u> in the computer network that is physically separate from the telephone network." (emphasis added).

3.   Claimed Phrase "current activity of the user on the computer network"

The parties had stipulated that the claimed phrase "current activity of the user on the computer network" found in each of claims 1, 28 and 38 should be construed as "current status of the user on the computer network." The parties did not, however, come to an agreement as to the meaning of the phrase that they stipulated to as it relates to infringement, domestic industry or

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validity.

Complainant argued, regarding "user status," that:

{

}

(CBr at 63.) Regarding the claim word "current activity," complainant argued:

> The act of logging on does not satisfy the "current activity on a computer network" limitation, because it is only a precursor to a user's activity on the computer network. [CPFF 3023 (Chang, Tr. 1743:14-20); CPFF 3021-3022, 3024.] The claim language makes this point clear by requiring that filtering depends on the "current activity on the computer network." Since logging onto the network necessarily means that the user not yet "on the computer network," this precursor act cannot satisfy the plain requirement of the claims.

> * * *

> The use of the term "current" in the '439 patent requires the activity to be the current status of the user's computer on the computer network at that moment in time, not merely the last location from which the user logged on regardless of how distant in

time such log-on event occurred. [JX-1 at 14:23-26.]

(CBr at 147-148 (emphasis in original).)

Respondent argued that complainant's claim that the user's computer is "busy" when the

user is engaged in a soft phone call is misplaced, as a user can use the computer for many other

things, like taking notes, running programs, or sending instant messages while the user is on the

phone call. (RBr at 107-108.) Respondent further argued that there is a difference between the

status of being logged onto the network, as disclosed by a Chestnut patent, and the process of

logging on. (ROCPFF 3023.) Respondent also argued that the '439 patent does not use the

phrase "at that moment in time" (see RRCPFF 3027.A, citing JX-1) and that nothing in the

parties agreed-upon construction of "according to current activity of the user on the computer

network" requires the phrase "at that moment in time" (RRCPFF 3027.D.).

The staff argued that the fact that a user is logged in and where the user is logged in

indicate the current status of the user on the computer network. (SRCFF 3020E.) The staff

further argued that anything that can be monitored by the computer network is status. (SRCFF

3023 citing Chang, Tr. at 931-32.)

The '439 specification describes affiliation lists in which user-selectable criteria are

stored:

> The user (i.e., the called party) can specify user-selectable call
> processing criteria for all incoming calls, incoming calls from
> selected callers, and may further apply conditional criteria based on
> user preferences. For example, the user may select all calls during
> certain times of the day, calls from selected parties during other
> specified times of the day, and no calls during other times of the
> day. The user-selectable call processing criteria may be readily
> edited by the user and may be applied to multiple phone numbers
> associated with a particular caller.

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(JX-1 at 1:65-2:7.) The specification further provides the following regarding said affiliation

lists:

> The affiliation list 150 is illustrated in greater detail in the
> functional block diagram of FIG. 5. The affiliation list comprises a
> series of sublists, illustrated in FIG. 3 as a forward list 160, a
> reverse list 162, a block list 164, and an allow list 166. The
> forward list 160 contains a list of Internet subscribers whose
> Internet activity a user wishes to monitor. This list is sometimes
> referred to as a "buddy" list. When the user operates the user
> computer 154 on the Internet 134, the Internet controller 152
> accesses the forward list 160 via an affiliation list input/output
> (I/O) interface 170 to determine which Internet subscribers
> contained within the forward list are currently active on the Internet
> 134. In conventional Internet operation, the Internet controller 152
> sends a message to the user computer 154 indicating which Internet
> subscribers on the forward list 160 are currently active on the
> Internet 134.

> The forward list 160 is a list of Internet subscribers whose activity
> is reported to the user. Other Internet subscribers may have their
> own forward list (not shown) and may monitor the Internet activity
> of the user. When the user accesses the Internet 134 with the user
> computer 154, that activity can be monitored by others. With the
> system 100, it is possible to determine who is monitoring the user's
> Internet activity. The reverse list 162 contains a list of Internet
> subscribers who have placed the user in their forward list. That is,
> the reverse list 162 contains a list of Internet subscribers who have
> placed the user in their buddy list. With the reverse list 162, the
> user can determine who is monitoring his Internet activity.

> The block list 164 contains a list of Internet subscribers that the
> user does not want to monitor his Internet activity. That is, the
> user's Internet activity will not be provided to any Internet
> subscriber contained in the block list 164. Thus, even if a particular
> Internet subscriber has placed the user on their forward list, the
> presence of that particular Internet subscriber's name on the block
> list 164 will prevent the user's Internet activity from being reported
> to the particular Internet subscriber. The use of the block list 164
> provides certain security assurances to the user that their Internet
> activity is not being monitored by any undesirable Internet
> subscribers.

The allow list 166 contains a list of Internet subscribers for whom the user may wish to communicate with but whose Internet activity the user does not wish to monitor.

The system 100 combines the capabilities of the affiliation list 150 with telephone switching technology to filter incoming calls to the destination telephone 104. For example, the user may specify that only calls from Internet subscribers contained in the forward list 154 may contact the user via the destination telephone 104. Alternatively, the user may specify that a calling party whose name is contained in the forward list 160 or the allow list 166 may place a call to the destination telephone 104. As will be discussed in greater detail below, the system 100 allows the user to create general conditional processing, such as blocking calls or allowing calls. However, the user can also create specific conditional processing for individual callers or based on the user's current status or preferences.

The central office switch 116 accesses the affiliation list 150 via the communication link 132 and determines whether the calling party is in a list (e.g., the forward list 160) that the user wishes to communicate with. If the calling party is contained within an "approved" list, the central office switch 116 establishes the communication link 120 and sends a ring signal to the destination telephone 104. Thus, the user can pick up the telephone with the knowledge that the calling party is an individual with whom the user wishes to communicate.

Conversely, if the calling party is not contained within an approved list, such as the forward list 160 or the allow list 166, the central office switch 116 will not establish the communication link 120 with the destination telephone 104. Thus, the user will not be bothered by undesirable phone calls. In one embodiment, the central switch office simply will not establish the communication link 120 and the calling party will recognize that the call did not go through. Alternatively, the central office switch 116 may generate a signal indicating that the destination telephone 104 is busy. In this alternative embodiment, the calling party will receive a busy signal on the originating telephone 102. Thus, the user has the ability to filter incoming calls by creating a list of those individuals with whom the user wishes to communicate.

It should be noted that the affiliation list 150 may be dynamically

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altered by the user to add or delete individuals, change individuals
from one list to another, or to change the call processing options
for a particular list depending on the user's preferences. For
example, the user may want to accept all calls from any source at
certain times of the day. Under these circumstances, the user can
edit the allow list 166 to accept calls from any calling party.
Alternatively, the user may still maintain the block list 164 such
that calls will not be processed from certain specified parties even
if the user is willing to accept calls from any other source. Under
other circumstances, the user may not wish to communicate with
any individuals. In this instance, the user may indicate that all
calling parties are on the block list 164. Thus, the central office
switch 116 will access the Internet 134 in real-time and review data
in the affiliation list 150 to thereby process incoming calls for the
user in accordance with the rules present in the affiliation list.

* * *

Furthermore, the user may attach conditional status to individual
callers or to calling lists. Conditional status may be based on
factors, such as the time of day, current availability of the user,
work status, or the like. For example, the user may accept calls
from certain work parties during specified periods of the day (e.g.,
9:00 a.m.-11:00 a.m.), block calls from selected calling parties
during other periods of time (e.g., 12:00-1:00 p.m.), or allow calls
during a business meeting only from certain calling parties (e.g.,
the boss). These conditional status criteria may be applied to
individuals or to one or more lists in the affiliation list 150

(JX-1 at 7:57-9:24 (emphasis added).) Thus, the administrative law judge finds that the '439

specification contemplates allowing the user to set certain "conditional processing" for individual

callers or based on the user's status at certain times.

In light of the foregoing, the administrative law judge finds that the "status" of a user can

consist of both user-selected indicators based on user activity (e.g., "conditional processing" as

per the '439 specification) and the transfer of data between the computer and telephone networks

while the user is engaged in a VoIP phone call.

The parties have also put into issue the claim phrase "current status." Notably, although

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complainant alleges that the word "current" as used in the '439 patent means "at that moment in time," complainant does not cite to anything in the specification or prosecution history of the '439 patent for support. (See generally CBr at 148; CRBr at 125.)

The '439 patent specification does not explicitly use the phrase "current activity of the user[subscribers] on the computer network" and there appears to be no disclosure in the specification of the '439 patent that explicitly teaches such a concept. The specification does refer to the ability of the invention of the '439 patent to assess the Internet activity of a subscriber to see if the subscriber is currently active on the Internet, but the specification does not teach processing a call based on this activity. (See JX-1 at 7:61-8:2.) Additionally, the '439 patent discloses that a user can create specific conditional processing based on the user's current status, but the specification never explicitly discloses whether the "user's current status" includes the user's status on a computer network. (See id. at 8:46-48.)

Turning to the prosecution history, the limitation requiring a call to be filtered based on the current activity of the user or subscriber was added during the prosecution of the '439 patent to overcome a prior art rejection by the United States Patent and Trademark Office (USPTO). (See JX-5 at MSAL 00587-593 (Office Action), MSAL 00682-00709 (Response to Office Action).) In response to the Office Action of July 30, 2001, rejecting the claims of the '439 patent application as anticipated by U.S. Patent No. 5,329,578 ('578 patent) to Brennan and as obvious in light of the '578 patent in view of U.S. Patent No. 6,005,870 ('870 patent) to Leung, the patent applicant remarked:

> With regard to Figures 2a-2g, Brennan teaches that the flow
> of information is fixed and is not dependent on any particular
> status or activity of the user or of the caller and that the flow of

information is determined by the user's requirements for that particular caller.

> Thus, the treatment of an incoming call [in Brennan] is dependent on a caller list that does not change. More specifically, actions or activity of callers on a telephone network or on a computer network have no effect on the caller list or other user requirements for callers.

<div align="center">* * *</div>

> In contrast to Brennan, claim 1 as amended recites that the one or more lists used in filtering an incoming call change according to current activity of the subscribers (i.e., persons making the calls), or according to current activity of the user (e.g., intended recipient of the call). In one example, the current activity of the subscriber and/or the user usually occurs on a computer network. The ability to process an incoming call on a telephone network according to activity on a computer network is not taught or suggested by Brennan.

(JX-5 at MSAL 00694-695.) Although the applicant explains that the '439 patent application is patentable because it can, among other things, filter calls based on the status of a subscriber or user and not simply based on a fixed set of rules, the applicant's remarks do not add anything to enlighten the proper construction of the phrase "current activity."

In the absence of anything in the specification or prosecution history to indicate otherwise, the word "current" is construed in accordance with its plain and ordinary meaning. The Federal Circuit has stated that sometimes, the ordinary meaning of claim terms is readily apparent to laymen and claim construction "involves little more than the application of the widely accepted meaning of commonly understood words." Phillips v. AWH Corp., 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc). The word "current" is a word that is understood to mean either "occurring in or existing at the present time" or "most recent." See Merriam-Webster's

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Ninth New Collegiate Dictionary 316 (1984); Merriam-Webster's Online Dictionary (www.m-w.com). As for the intrinsic evidence, the administrative law judge finds nothing, and complainant has cited to nothing, that supports reading the claim phrase "current activity" to mean the activity at that moment in time.

Based on the foregoing, the administrative law judge construes the phrase "current status" to include either the status of a user or subscriber at the present time or the most recent status of a user or subscriber.

B.   The O'Neal '064 And '357 Patents

The claims at issue in the '064 patent are dependent claims 3, 8, 11, and 12 which are dependent on independent claim 1 and independent claim 20. (JX-3; RFF I.C.1.5 (undisputed).) Each of asserted claims 3, 8, 11, and 12 depend from unasserted claim 1 of the '064 patent. (JX-3.) The claim in issue of the '357 patent is dependent claim 6 of the '357 patent. (JX-4; RFF I.C.1.23 (undisputed).) Claim 6 of the '357 patent depends from unasserted independent claim 1 of the '357 patent. The parties argued that there are only two claim phrases in dispute, viz. the GUI[6] limitation and the TUI[7] limitation. (CBr at 38; RBr at 1-2; SRBr at 11.) Thus the parties have agreed upon the following claim construction for purposes of this investigation:

Claim Term	Agreed Upon Construction
unified messaging system	system that allows messages of a data-centric network and a telephony-centric network to be received, stored, retrieved, and forwarded without regard to the

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[6] "GUI" stands for "graphical user interface," and has been used synonymously with the term "graphical menu." (RBr at 37 n. 3.)

[7] "TUI" stands for "telephony user interface." (RBr at 37 n. 4.)

Claim Term	Agreed Upon Construction
	communication devices or networks employed for the transmission of the messages
communication options	parameters associated with specific types of communication services
telephony-centric network	a network that carries telephony information used by devices such as telephones, pagers, facsimile machines, and voice mail boxes
data-centric network	a network, that carries digital data, primarily to facilitate information exchange among computers and computer peripherals
e-mail service	a communication service for receiving, storing, retrieving, and forwarding e-mails
voice telephone service	a communication service for receiving, storing, retrieving, and forwarding telephony information

[See Order No. 18 (attached letter dated October 5, 2007).]

According to complainant, the disputed claim terms in the O'Neal patents that need

construction are:

> "said computer server being configured to generate a single
> graphical menu for displaying said communication options for each
> of said communication services at the same time" (claims 1 and 20
> of the '064 patent and claim 1 of the '357 patent)

> "a telephony server coupled to exchange data with said
> communication profile database, said telephony server being
> configured to audibly represent said communication options to said
> telephone when said subscriber employs said telephone to access
> said computer-implemented control center" (claims 1 and 20 of the
> '064 patent and claim 1 of the '357 patent)

(CBr at 38.)

Respondent argued that only two claim construction issues remain with respect to the

O'Neal patents, the meaning of the following two elements from claim 1 of the '064 patent: [8]

> (1) a single graphical menu for displaying said communication options for each of said communication services at the same time (the "GUI limitation"); and

> (2) said telephony server being configured to audibly represent said communication options to said telephone. (the "TUI limitation").

(RBr at 37.)

The staff argued that the parties have not stipulated to the construction of the phrase "communication services" as it appears in independent claims 1 and 20 of the '064 patent and independent claim 1 of the '357 patent and of the phrase "enable option for enabling or disabling the . . . communication service" as it appears in independent claims 1 and 20 of the '604 patent and independent claim 1 of the '357 patent. (SBr at 32-3.)

Each of the GUI and TUI limitations is in unasserted claim 1 of each of the O'Neal patents, as well as in independent claim 20 of the '064 patent. (JX-3; JX-4.) The language of the disputed claim phrases is substantially the same in each of claims 1 and 20 of the '064 patent and claim 1 of the '357 patent. The parties agreed that the O'Neal patents have the same specification. (RFF I.C.1.20 (undisputed).) Each of the party's arguments treated the disputed limitations identically as between the patents, and between claims 1 and 20 of the '064 patent.

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[8] Respondent noted that claims 3, 8, 11 and 12 all depend from claim 1, which is also representative of all of the remaining asserted claims (including claim 20 of the '064 patent and claim 6 of the '357 patent, which also include the limitations at issue), and thus, an analysis of claim 1 is appropriate because although claim 1 is no longer asserted, it is "a fundamental principle of patent law that dependent claims cannot be found infringed unless the claims from which they depend have been found to have been infringed." citing Jeneric/Pentron, Inc. v. Dillon Co., 205 F.3d 1377, 1383 (Fed. Cir. 2000).

(CBr at 38; RBr at 37; SBr at 34-35.) The parties appear to agree that the claim terms appearing

in the claims of both of said patents should be construed consistently. (CBr at 21 n. 21; RBr at 1;

SBr at 30) Therefore, the administrative law judge finds that only said disputed claim phrases

are at issue in construing the claims of the asserted O'Neal patents. Moreover, the administrative

law judge treats the disputed claim phrases from claims 1 and 20 of the '064 patent and claim 1

of the '357 patent identically.

1. The GUI Limitation: The Claimed Phrase "generate [or generating] a single
    graphical menu for displaying said communication options for each of said
    communication services at the same time" (JX-3 at 18:38-42; JX-3 at 22:60-63
    JX-4 at 18:32-34.)

This claim phrase appears in independent claims 1 and 20 of the '064 patent and

independent claim 1 of the '357 patent. (JX-3 at 18:39-42, 22:60-63; JX-4 at 18:32-34)

Complainant argued that the claim phrase in issue should be construed "to require a

computer server that is configured to generate a single graphical menu for displaying at least a

first communication service and option and a second communication service and option at the

same time." (CBr at 39.)

Respondent argued that "[t]he claims require that a subscriber have at least two or more

communication services but, as many services and options as the subscriber has must be

displayed on 'a single graphical menu.'" (RBr at 2.)

The staff argued that:

> [A]lthough the claim language and specifications of the '064 and
> '357 patent only permit all of the available options to be displayed
> on a single graphical menu, the prosecution history requires it. The
> "single graphical menu" limitation should therefore be construed to
> mean "one graphical menu that shows all of the communication
> options associated with all of subscriber's communication

services."

(SBr at 44.)

The prosecution history is intrinsic evidence and provides evidence of how the inventors and the Patent Office understood what is disclosed in a patent following the prosecution. (See Phillips, supra.) The application which resulted in the '064 patent was filed on January 29, 1999 with twenty-two original claims. (JX-7 at 00766-00800.) In an Office Action dated April 24, 2000, the Examiner rejected original claims 1-3, 5, 9-13, 15, and 19-21 under 35 U.S.C. 102 (b) as being anticipated by Pepe et al (U.S. Patent No. 5,742,905). (JX-7 at 00820-00821.) The Examiner characterized Pepe as disclosing a "unified messaging computer center that permits subscribers to customize communication options pertaining to the unified messaging service including routing." (JX-7 at MSAL 00820-21 (citations omitted).) Applicants, in an amendment dated July 24, 2000, amended original claims 1 and 20[9] to read:

> 1.   (Once Amended) A computer-implemented control center for permitting a subscriber of a plurality of communication services of a unified messaging system to customize communication options pertaining to said plurality of communication services **through either a telephony-centric network using a telephone or a data-centric network using a display terminal,** [**said communication options include parameters associated with individual ones of said plurality of said communication serves and routings among said plurality of communication services, said plurality of communication services comprising a voice telephone service through a telephony-centric network and an e-mail service through a data centric network, said communication options being accessible via display terminals coupled to said data-centric network and via telephones coupled to said telephony-centric network,**] said computer-implemented control center comprising:

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[9]   Original claim 20, after being amended and allowed by the Examiner as found, infra, became unasserted claim 16, and is not to be confused with asserted claim 20.

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a subscriber communication profile database, said subscriber communication profile database having therein an account pertaining to said subscriber, said account including said communication options for said subscriber, **said communication options including parameters associated with individual ones of said plurality of said communication services and routings among said plurality of communication services**:

a computer server coupled to exchange data with said subscriber communication profile database, said computer server being configured to **generate a single graphical menu for displaying said communication options for each of said communication services at the same time, and to** visually display said **single graphical menu** [communication options] on [**one of**] said display terminal[s] when said subscriber employs [**said one of**] said display terminal[s] to access said computer-implemented control center **through said data-centric network**, said computer server also being configured to receive from said subscriber via said [**one of said**] display terminal[s] **and said data-centric network** a first change to said communication options and to update said first change to said account in said subscriber communication profile database; and

a telephony server coupled to exchange data with said communication profile database, said telephony server being configured to audibly represent said communication options to [**one of**] said telephone[s] when said subscriber employs [**said one**] said telephone[s] to access said computer-implemented control center, said telephony server also being configured to receive from said subscriber via [**said one of**] said telephone[s] a second change to said communication options and to update said second change to said account in said subscriber communication profile database.

* * *

20.   A computer-implemented method for permitting a subscriber of a unified messaging system to customize communication options pertaining to a plurality of communication services [**of**] **associated with** said unified messaging system **through either a telephony-centric network using a telephone or a data-centric network using a display terminal** [, **said communication options include parameters associated with individual ones of said plurality of said communication services and routings**

among said plurality of communication services], said plurality
of communication services comprising a voice telephone service
and e-mail service, said communication options being accessible
via display terminals coupled to said data-centric network and via
telephones coupled to [a] **said** telephony-centric network, said
computer-implemented method comprising:
receiving, via either a first display terminal of said display
terminals or a first telephone of said telephones, a request to access
an account pertaining to said subscriber, **said account including
said communication options for said subscriber**;

obtaining from a subscriber communication profile
database said communication options for said subscriber in said
account, **said communication options including parameters
associated with individual ones of said plurality of said
communication services and routings among said plurality of
communication services**,

presenting said communication options for said subscriber
on respective one of said first display terminals [and] **or** through
said first telephone from which said request to access is received**,
said communication options being visually presented in a
single graphical menu arranged for displaying said
communication options for each of the communication services
at the same time on said first display terminal via an
individualized web page associated with said subscriber or
audibly presented at said first telephone**;

receiving communication setting edits from said subscriber
through said respective one of said first display terminal and said
first telephone from which said request to access is received, said
communication setting edits pertaining to said communication
options; and

modifying said communication options in accordance with
said communication setting edits, wherein said communication
services are subsequently controlled in accordance with said
communication options after said modifying.

(JX-7 at MSAL 00993-00994, MSAL 00997-00998.)[10] As seen from the foregoing, amended

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[10] In an office action, underlined text is added, and text in brackets is removed.

claims 1 and 20 have the limitation "to generate a single graphical menu for displaying said communication options for each of said communication services at the same time. . ."

In said amendment, applicants also added, <u>inter alia</u>, claims 23, 24, and 30, which read:

> 23.   The computer implemented control center of claim 1 wherein said single graphical menu comprises at least:
> a first display area for showing a first communication service, and a first communication option associated with said first communication service; and
> a second display area for showing a second communication service, and a second communication option associated with said second communication service, the first display area and the second display area being displayed at the same time in said single graphical menu.

> 24.   The computer implemented control center of claim 23 wherein the first communication option includes a first enable option for enabling or disabling the first communication service, and wherein the second communication option includes a second enable option for enabling or disabling the second communication service.

<center>* * *</center>

> 30.   The computer-implemented control center of claim 1 wherein the communication service is an on-demand communication service, and wherein said communication options include an on-demand communication enable option associated with said on-demand communication service and a forwarding number, said on-demand communication enable option when enabled by said subscriber, permits a caller to said subscriber at said unified messaging system to elect to forward a call or message by said caller to said forwarding number.

(JX-7 at MSAL 00997-00999.) As seen from the foregoing, said claim 24 required that the first communication option also include the option of enabling or disabling the first service and the second communication option include the option of enabling or disabling the second service, and also had <u>all</u> the limitations of claim 23 <u>and</u> amended claim 1. In addition claim 30 had all the

limitations of amended claim 1. (JX-7 at MSAL 00997-00998.)

In said amendment, the applicants then argued:

> In contrast to Pepe, independent claims 1 and 20 of the
> present application require a single graphical menu that is arranged
> to display the communication options for each of the
> communication services at the same time. That is, the
> communication options for each of the communication services are
> simultaneously displayed on a computer terminal when the
> subscriber employs the display terminal to access the
> computer-implemented control center through a data-centric
> network. In essence, the graphical menu serves as a centralized
> visual interface or control panel for reviewing and/or customizing
> the communication options associated with various communication
> services. As should be appreciated, by providing a single graphical
> menu, a user may quickly and conveniently review the
> communication options and make changes thereto. Claims 1 and
> 20 have been amended to better clarify this aspect of the invention.
>
> While Pepe may disclose the use of control options and
> subscriber profiles, Pepe does not contemplate a single graphical
> menu where only one view is used to display the communication
> options. Rather, in Pepe, the subscriber must go through a plurality
> of views independently, where the options are displayed at
> different times. . . . In order to access all of the screens in Pepe, a
> subscriber must traverse through at least 18 screens as shown in
> Figures 28-45. In contrast, the present invention does not have to
> access multiple screens to modify options. In fact, the
> communication options, which are displayed on a single screen,
> may be modified as needed with a few keystrokes. Accordingly, it
> is respectfully submitted that a single graphical menu containing
> the communication options is neither disclosed nor reasonably
> suggested by Pepe et al. . . .
>
> With respect to the secondary references, it is respectfully
> submitted that the addition of Feit and Bissel to the Pepe patent
> does not cure the deficiencies of the Pepe et al. patent discussed
> above. It is the applicant's understanding that each of the cited
> references completely fails to suggest displaying a single graphical
> menu.

(JX-7 at MSAL 01001-02 (emphasis in original).) As seen from the foregoing, applicants argued

that independent claims 1 and 20, as amended, <u>require</u> a single graphical menu that is arranged to display the communication options for each of the communication services at the same time

Significantly, in the next office action mailed on October 4, 2000, which rejected certain claims on art, including independent claims 1 and 20, and dependent claim 23, the Examiner specifically stated:

> Pepe fails to disclose a "single graphical menu for displaying said communication options for each of said communications services at the same time." Instead, Pepe teaches that the interactive menu program displays the user options in a hierarchical manner (Figs. 28-45).

(JX-7 at MSAL 01011.) Moreover, as to claims 24-27 and 30, he stated:

> Claims 24-27 and 30 are objected to as being dependent upon a rejected base claim, <u>but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims</u>.

(JX-7 at 01017 (emphasis added).)

In the next amendment received by the Patent Office on December 8, 2000, following what the Examiner had said was allowable subject matter in the Office action of October 4, 2000, applicants amended claim 1 to include the limitation of allowed claim 24 and intervening claim 23, and claim 20 was amended to include the limitations of claim 30. (JX-7 at 01150-59.) Applicants also added several new claims that included similar limitations, <u>viz.</u> claims 32 and 37. Then number claim 37, after allowance, was renumbered claim 20, which is a claim asserted in this investigation, and which includes the GUI limitation at issue.

Based on the foregoing, the administrative law judge finds that the patentees' argument at JX-7 at MSAL 01001-01002, cited <u>supra</u>, is a clear and unambiguous narrowing of the claims to

a single graphical menu that displays all of the services and options on one screen. Said narrowing also extends to the '357 patent. See cited cases involving prosecution history, supra.

Based on the foregoing, the administrative law judge finds that the claim phrase, "generate [or generating] a single graphical menu for displaying said communication options for each of said communication services at the same time" is construed as "generate, or generating, one graphical menu for displaying all of the communication options for all of the plurality of communication services."

Complainant argued that reading the prosecution history so as to require that all services and options be displayed would be "inconsistent with the fundamental premise that a dependent claim must be narrower in scope than the claim(s) from which it depends." (CBr at 48.) Specifically, complainant argued that the patentees could not have meant to narrow the base independent claim to a single graphical menu including all the communication services and options because, in the same amendment, the patentees modified two dependent claims (viz. claims 23 and 24) in such a way that was broader than the base independent claim. Claims 1 and 20 however, after being amended, contained a requirement for "a single graphical menu for displaying said communication options for each of said communication services at the same time." (JX-7 at MSAL 00994, 00997.) Claim 23 included a requirement for a first communication service to be displayed in a first display area and a second communication service to be displayed in a second display area; both being displayed at the same time in a single graphical menu. (JX-7 at MSAL 00997-98.) Claim 24, which depended from claim 23, included a limitation that each of the two display areas must include an option for enabling or disabling the communication service so displayed. (JX-7 at MSAL 00998.) In other words, independent

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claim 1 required that all communication services and options be displayed but did not disclose the requirement of a "display area," while dependent claim 23 required that two of said services be displayed at the same time, and introduced the requirement of two "display areas." The administrative law judge finds that the requirement of a first and second display area is narrower than not having said requirement. Claim 24 contained the further limitation of including an enable/disable option for each displayed communication service, and it was this claim limitation the Examiner eventually allowed. The administrative law judge finds that said limitation is narrower than the limitation in claim 23. Thus, the administrative law judge finds that claim 1, as interpreted herein, was broader than claim 23, which was broader than claim 24.

Complainant further argued that a person of ordinary skill in the art, "having reviewed the claims in the context of the intrinsic evidence, (including the Examiner's Reasons for allowance) would have understood the asserted claims to require only the display of first and second communication options and services in the single graphical menu." (CBr at 49). However, the patentees argued that the "single graphical menu" limitation distinguished their invention over Pepe, and the Examiner thereafter specifically stated "Pepe fails to disclose a 'single graphical menu for displaying said communication options for each of said communications services at the same time.'" (See JX-7 at MSAL 01011.) Thus, the "single graphical menu" limitation was squarely before the Examiner, and the claims that the Examiner allowed included said limitation. Complainant relies on Omega Eng'g, Inc. v. Raytek Corp., 334 F.3d 1314 (Fed. Cir. 2003) (Omega) and Storage Tech. Corp. v. Cisco Sys., Inc., 329 F.3d 823 (Fed. Cir. 2003) (Storage Tech). Omega stands for the proposition that the doctrine of prosecution disclaimer should not be applied where the alleged disavowal of claim scope is ambiguous. Such is not the case in this

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investigation, as found, supra. Storage Tech stands for the proposition that the "[t]he applicants' inaccurate statement cannot override the claim language itself, which controls the bounds of the claim." (Storage Tech at 832.) More completely, Storage Tech reads:

> Cisco's use of the prosecution history to narrow the meaning of claim 1 is also misplaced. During prosecution, the patent applicants stated that in the invention as recited in claims 1, 11, and 18, the instance of network policy and the policy identification information are both cached. While on its face this statement appears to limit claim scope, it cannot do so absent some claim language referring to the caching of the instance of network policy. The prosecution history statement describes generally the features of the claimed invention and erroneously suggests that the independent claims include a cache for the instance of network policy. The applicants' inaccurate statement cannot override the claim language itself, which controls the bounds of the claim. See Rambus Inc. v. Infineon Techs. AG, 318 F.3d 1081, 1089, 65 USPQ2d 1705, 1711 (Fed. Cir. 2003) (holding that general statement introducing new limitations does not limit scope of claims not amended to include the new limitations); Intervet, 887 F.2d at 1054, 12 USPQ2d at 1477 (holding that erroneous statement made during prosecution does not limit claim scope because "the claims themselves control").

329 F.3d at 832 (emphasis added).) Thus, the patentees in Storage Tech stated that a limitation was in the claim, where there was no basis for that limitation in the claim. Unlike in Storage Tech, the patentees of the '064 patent added language to the claims to overcome a rejection by the Examiner, and explained in that same amendment why they believed that said language overcame said rejection. Therefore, there is no "inaccurate statement" as there was in Storage Tech.

2.   The TUI Limitation: The Claimed Phrase, "said telephony server being configured to audibly represent said communication options to said telephone when said subscriber employs said telephone to access the computer implemented control center" (JX-3 at 18:67-19:4; JX-3 at 24:4-8) or "audibly representing said communication options to one of said telephones, using said telephony server,

when said subscriber employs one of said telephones to access said computer-implemented control center." (JX-4 at 18:57-60.)

Said claimed phrase appear in independent claims 1 and 20 of the '064 patent and independent claim 1 of the '357 patent. (JX-3 at 18:67-19:4; JX-3 at 24:4-8; JX-4 at 18:57-60.)

Complainant argued that "only some of the communication options of the computer-implemented control center need be audibly represented via the telephony server." (CBr at 50.)

Respondent argued that this claim limitation requires that "the telephony server audibly represent the same communication options that are available through the graphical menu." (RBr at 48.) Respondent further argued that:

> A straightforward reading of the claim language establishes that the phrase "said communication options" in the TUI limitation refers to the same communication options as the phrase "said communication options" in the GUI limitation. (RFF III.A.2.6 - RFF III.A.2.7.) The TUI limitation is thus properly construed to mean that the telephony server must audibly represent the same communication options that are available through the graphical menu. (See ALE Post-Hearing Br. at 48-50.) Indeed, Microsoft's brief acknowledges that in patent parlance, the word "said" requires refers to an earlier use of the term in the claim. (See Microsoft Post-Hearing Br. at 51.) Accordingly, the "said communication options" in the TUI and GUI limitations necessarily refer to the same options.

(RRBr at 19.)

The staff argued that the TUI limitation should be "construed consistently with the GUI limitation to mean that 'the telephony server audibly represents all of the communications options to the telephone when the subscriber uses the telephone to access the system.'" (SBr at 19.) The staff further argued that:

> During prosecution, the patentees limited the GUI limitation such that displaying "said communication options" requires displaying

all communication options. Unless there are exceptional circumstances, the same claim terms in the same patent should be given the same meaning, and so the construction of the language in the GUI limitation should be applied to the TUI limitation as well. See, e.g., PODS, Inc. v. Porta Stor, Inc., 484 F.3d 1359, 1366 (Fed. Cir. 2007) ("We apply a 'presumption that the same terms appearing in different portions of the claims should be given the same meaning unless it is clear from the specification and prosecution history that the terms have different meanings at different portions of the claims.'").

(SBr at 45 (internal citations omitted).)

The claim term "said communication options" is first disclosed in the preamble of the claim, and is found thereafter in several elements prior to the claim element including the TUI limitation. As the administrative law judge has found, supra, "said communication options" has antecedent basis in the preamble. The preamble of claim 1 of the '064 patent states:

> 1. A computer-implemented control center for permitting a subscriber of a plurality of communication services of a unified messaging system to customize communication options pertaining to said plurality of communication services through either a telephony-centric network using a telephone or a data-centric network using a display terminal, said computer-implemented control center comprising:

(JX-3 at 18:22-28 (emphasis added).) Thus, the preamble creates a distinction between using a telephone and using a display terminal of a computer to access the control center. Moreover, the GUI limitation is found in a claim element reciting a "computer server," while the TUI limitation is found in a claim element reciting a "telephony server." Neither of said claim elements refers to the other, and both are separate components comprising the "computer-implemented control center." (JX-3 at 18:22-19:9.) Therefore, the language of the claims discloses that "communication options," in this claim element, refers back to the preamble for antecedent basis,

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and does not incorporate limitations contained solely in other claim elements. The GUI limitation has restrictions not contained in the TUI limitation; specifically, the TUI limitation does not include a reference to the "each of said communication services." Thus, the plain language of the TUI limitation, as modified by combining it with the antecedent basis of communication options from the preamble, requires that the telephony service be configured to audibly represent "communication options pertaining to said plurality of communication services." The language of the claims, therefore, does not require that all communication options, or even all communication services, be represented audibly. Further, the specification discloses:

> It should be appreciated that the communication services and options discussed in connection with FIGS. 3 and 4 are only illustrative of the capabilities of the inventive computer-implemented control center. It should be apparent to those skilled in the art that the same control panel may be presented to the subscriber through the telephony server and the telephone interface if the subscriber wishes to review and/or change the communication options using a telephone connected to the telephony-centric network. The communication options may be presented in a sound format and the subscriber may be offered an option menu to review and/or change any communication option setting. Further, it should also be apparent to those skilled in the art that communication services options other than the preferred and discussed communication services and options can readily be controlled by the inventive computer-implemented control center. Irrespective of the services and options involved, a subscriber can access the centralized computer-implemented control center through either a computer connected to the data-centric network or a telephone connected to the telephony-centric network to review and/or change the communication options.

(JX-3 at 14:59-15:13 (emphasis added).) Thus, the language of the specification does not clearly disclose that each communication service and option represented on the graphical display must

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be presented in a sound format. In fact, by use of the words "may" and "irrespective of the services and options involved," the specification implicitly leaves open the possibility that the graphical display and the telephonic menu communication options may be different. Further, the prosecution history, which was critical to the interpretation of the GUI limitation, shows that the GUI and TUI limitations are distinct. The argument with which the patentees overcame the Examiner's rejection based on Pepe explained a proposed amendment to the claim language purporting to add further requirements to the GUI limitation; language that was not added to the TUI limitation.

Based on the foregoing, the administrative law judge finds, for claims 1 and 20 of the '064 patent, that the claim phrase "said telephony server being configured to audibly represent said communication options to said telephone when said subscriber employs said telephone to access the computer implemented control center" is construed as "the telephony server being configured to audibly represent communication options pertaining to at least two communication services to a telephone when the subscriber employs said telephone to access the computer implemented control center." The administrative law judge further finds, for claim 1 of the '357 patent, that the claim phrase "audibly representing said communication options to one of said telephones, using said telephony server, when said subscriber employs one of said telephones to access said computer-implemented control center" is construed as "audibly representing communication options pertaining to at least two communication services to a telephone, using said telephony server, when a subscriber employs one of the telephones to access the computer-implemented control center."

VII. Validity

In issue is whether the asserted claims of the Liffick and O'Neal patents are anticipated by certain prior art.[11]

A patent is presumed valid, and ALE has the burden of proving invalidity by clear and convincing evidence. 35 U.S.C. § 282; Iron Grip Barbell Co. v. USA Sports, Inc., 392 F.3d 1317, 1320 (Fed. Cir. 2004); Stryker Corp. v. Davol Inc., 234 F.3d 1252, 1259 (Fed. Cir. 2000). Clear and convincing evidence has been described as evidence which proves in the mind of the trier of fact "an abiding conviction that the truth of [the] factual contentions [is] 'highly probable.'" Intel Corp. v. United States Int'l Trade Comm'n, 946 F.2d 821, 829-30 (Fed. Cir. 1991) (quoting Colorado v. New Mexico, 467 U.S. 310, 316 (1984)).

A patent claim is invalid as anticipated if "the invention was patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or ... patented or described in a printed publication in this or a foreign country more than one year prior to the date of the application for patent in the United States." 35 U.S.C. § 102(a)-(b). Anticipation requires that a single prior art reference discloses each and every limitation of the claimed invention. Schering Corp. v. Geneva Pharms., 339 F.3d 1373, 1379-80 (Fed. Cir. 2003). Anticipation is a question of fact. SmithKline Beecham Corp. v. Apotex Corp., 403 F.3d 1331, 1342-43 (Fed. Cir. 2005).

To anticipate, a prior art reference must also describe the claimed invention sufficiently to

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[11] See CPFF 3001-3 which asserts that ALE did not present any evidence that the asserted claims are invalid over the prior art based on obviousness nor did ALE's technical expert Hyde-Thomson offer any opinion relating to any obviousness defense. In rebuttal ALE merely "specifically reserves the right to pursue its obviousness defenses in other proceedings." See ROCPFF 3001-3.

have placed it in possession of a person of ordinary skill in the field of the invention, and be "enabling." Helifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1346 (Fed. Cir. 2000). An enabling reference contains a description detailed enough to allow one skilled in the art to make and use the claimed invention without undue experimentation. In re Wright, 999 F.2d 1557, 1561 (Fed. Cir. 1993).

For a reference to anticipate a claim under the doctrine of "inherent anticipation," the evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (quoting Cont'l Can Co. v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991)). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Cont'l Can, 948 F.2d at 1269 (citations omitted) (emphasis added).

A.   The Liffick '439 Patent

1.   The Chestnut Patent

a.   Claim 1 Of The '439 Patent

Respondent argued that U.S. Patent No. 6, 041,114 which issued to Chestnut (the '114 patent) anticipates claim 1 of the '439 patent. At the hearing in this investigation, respondent's expert Hyde-Thomson testified that all of the limitations of claim 1 were disclosed in the '114 patent. See Tr. at 1413-30; RDX-10.

Complainant, however, disputed Hyde-Thomson's testimony and respondent's conclusions regarding anticipation, and argued that respondent has failed to prove, by clear and convincing evidence, that the '114 patent discloses all of the limitations in claim 1. Specifically,

complainant argued that the '114 patent does not disclose the following limitations of claim 1: (1) "a data structure contained within a computer network to store user-selectable criteria for call processing, wherein the data structure stores the user-selectable criteria in one or more lists that are used in filtering an incoming call"; (2) "wherein some of the one or more lists are used to filter the incoming call according to current activity of subscribers on the computer network or according to current activity of the user on the computer network"; (3) "a computer network access port used by the telephone network to access the data structure such that the telephone network has access to the one or more lists over the computer network access port"; and (4) "a controller to receive the incoming call designated for the user telephone and to process the incoming call in accordance with the user-selectable criteria, the controller accessing the user-selectable criteria in the one or more lists of the data structure via the computer network access port and thereby applying the user-selectable criteria to the incoming call." (CBr at 146-150.) Additionally, complainant argued that respondent has failed to show that the '114 patent discloses all the elements of claim 1 of the '439 patent arranged in the same manner and residing in the same place as in said claim 1. (CRBr at 119-120.)

The staff argued that the '114 patent anticipates independent claims 1, 28 and 38 of the '439 patent. (SBr at 72.) Specifically, the staff argued that the '114 patent discloses both a "data structure contained within a computer network to store user-selectable criteria for call processing" (claim 1) and a "data structure contained within a computer network that is independent of the telephone network" (claims 28 and 38); that the '114 patent discloses filtering incoming calls according to the "current activity of the user on the computer network" (see JX-1, col. 14:25-26, 17:3-4, 18:15-16); and that the '114 patent discloses a "controller to receive the

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incoming call designated for the user telephone and to process the incoming call in accordance with the user-selectable criteria." (JX-1, col. 14:31-33). (SBr at 72-74.)

> The Claimed Phrase "a data structure contained within a computer network to store user-selectable criteria for call processing, wherein the data structure stores the user-selectable criteria in one or more lists that are used in filtering an incoming call"

Respondent argued that this limitation is disclosed by the '114 patent, relying in support on explicit statements in the patent and the testimony of its expert, Hyde-Thomson. (RBr at 115-117.) In particular, respondent noted that the '114 patent discloses that:

> The telecommute server 2, can also forward incoming calls based upon other criteria including day or date, time of day, the identity of the caller, or any preprogrammed set of rules. It is within the scope of the invention for the telecommute server 2 to utilize a set of forwarding preferences which are based on the above criteria as well as other factors such as who else in the office is logged onto the computer network 8 or the telephone extensions currently in use.

(RBr at 116; RX-1 at 5:18-25.) Respondent also noted that the '114 patent states that the:

> telecommunication server 2 selects the telephone number to which incoming calls should be forwarded based upon a record stored in a memory which associates a forwarding telephone number, such as the number for called party home phone 22, with a network logon device, such as a called party home workstation 26.

(RBr at 116; RX-1 at 4:64-5:2.) Further, respondent and the staff both point to the fact that the '114 patent explicitly discloses that:

> [T]he telephone number associated with the current called party network login device is determined 44 by comparing the identity of the logon device with a list of telephone numbers indexed by logon device stored in a memory. Other factors including time of day, day of week, date, and/or the identity of the calling party may be used to determine the forwarding number by providing additional indexing criteria.

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(RRBr at 56; SBr at 73; SRBr at 36; RX-1 at 6:34-46.) In addition to the explicit disclosures

from the '114 patent, set forth supra, respondent relies on the testimony of its expert Hyde-

Thomson, who stated, when asked if this limitation was disclosed by the '114 patent:

> Yes.   There's a data structure which stores user-selectable criteria
> for the call processing, which are used in one or more lists that are
> used in filtering an incoming call.
>
> So within the Chestnut system, there are -- well, there
> would be a data structure associated with the, well, Windows or
> whatever network it is that the users are connected to, which are
> the kind of user directory and user logon status data structure,
> which will be -- and maybe the Remote Access Server, which I
> mentioned earlier, which indicates where people have logged on
> from.
>
> And that data structure is accessed by the Telecommute
> Server and, based on rules that have been set up, will route calls to
> either the office extension or the home phone according to the data
> that's read from the database of the network logons.

(Tr. at 1415:16-1416:9.)

Complainant has argued that respondent failed to prove that the limitation

> a data structure contained within a computer network to store user-
> selectable criteria for call processing, wherein the data structure
> stores the user-selectable criteria in one or more lists that are used
> in filtering an incoming call

is disclosed in the '114 patent. Complainant's opposition, however, rests solely on the testimony

of respondent's expert Hyde-Thomson cited supra. See CRBr at 120-122. Complainant argued

that Hyde-Thomson identified a "Remote Access Server" as the data structure, and that because

the '114 patent does not disclose a Remote Access Server, that the '114 patent does not satisfy

the "data structure" limitation of claim 1. (Id.) Absent from complainant's post-hearing briefs is

any argument as to why the explicit passages in the '114 patent cited by both respondent and the

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staff do not satisfy the limitation in issue.

The limitation of claim 1 at issue requires a data structure that stores user-selectable criteria in one or more lists for call processing. The passages in the '114 patent, cited supra and relied on by respondent and the staff, disclose that the telecommute server selects a forwarding phone number by accessing a record in memory that contains a list of telephone numbers indexed by logon device. See RX-1 at 5:18-25, 4:64-5:2. The passages also disclose that any set of preprogrammed rules or additional indexing criteria may be used to forward the incoming call. See id. at 6:34-46. The '439 patent broadly defines what constitutes a data structure, stating that:

> Database operation is well know in the art, and need not be
> described in greater detail herein. The database or other form of
> the forward list 160 may be satisfactorily implemented using any
> known data structure for storage of data. For example, the various
> lists (e.g. the allow list 166, the reverse list 162, the block list 164
> and the allow list 166) may all be integrated within a single
> database structure. The present invention is not limited by the
> specific structure of the affiliation list 150 nor by the form or
> format of the data contained therein.

(JX-1 at 10:5-14 (emphasis added).) Based on this description in the '439 patent, the administrative law judge finds that the disclosure in the '114 patent of a "record in memory" that contains a list of telephone numbers is a data structure. Because said record in memory may also contain any set of preprogrammed rules or other indexing criteria, the requirement of the limitation at issue that the data structure store user-selectable criteria is also met. Additionally, the '114 patent explicitly discloses that the list of telephone numbers, set of preprogrammed rules, or other indexing criteria stored in the record in memory are used to forward an incoming call. Thus, the requirement of the limitation at issue requiring that the user-selectable criteria be used to filter an incoming call is also satisfied. Further, as seen in Figure 1 of the '114 patent, the

telecommute server 2 may be part of a computer network connected through a LAN/WAN 8 with the called party home workstation 26 and the called party office workstation 20. See RX-1, Figure 1. Because the data structure is stored in a record in memory in the telecommute server, the data structure is contained within a computer network as required by the limitation at issue. Based on the foregoing, the administrative law judge finds that the '114 patent discloses the limitation of claim 1 of the '439 patent calling for "a data structure contained within a computer network to store user-selectable criteria for call processing, wherein the data structure stores the user-selectable criteria in one or more lists that are used in filtering an incoming call."

Complainant had argued that Hyde-Thomson's testimony identified a Remote Access Server as the data structure that must be disclosed in the '114 patent for said patent to anticipate the asserted claims of the '439 patent. (CRBr at 120-122.) The administrative law judge, however, finds that respondent's expert Hyde-Thomson did not identify the data structure element of claim 1 as a "Remote Access Server." Rather, his testimony indicated that when he referenced the Remote Access Server he was referring back to his previous comment that there would be a data structure associated with "Windows or whatever network it is the users are connected to." See Tr. at 1415:21-23. The administrative law judge finds that Hyde-Thomson equates the data structure accessed by the Telecommute Server with the "rules that have been set up." Further support for this interpretation can be found in Exhibit RDX-10, where the "preprogrammed set of rules" is again relied on to satisfy the "data structure" limitation. See RDX-10 at 3.

> The Claimed Phrase "wherein some of the one or more lists are used to filter the
> incoming call according to current activity of subscribers on the computer
> network or according to current activity of the user on the computer network"

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Respondent and the staff argued that the '114 patent discloses the limitation "wherein some of the one or more lists are used to filter the incoming call according to current activity of subscribers on the computer network or according to current activity of the user on the computer network." (RBr at 117-119; SIB at 73-74.) Specifically, respondent and the staff argued that the disclosure in the '114 patent of call forwarding based on whether the user is logged onto the computer network constitutes routing a call based on the "user's current status on the computer network." (CBr at 117, SRBr at 37.)

Complainant argued that the '114 patent fails to disclose the one or more lists used to filter the incoming call, and also fails to disclose filtering the incoming call according to current activity of the subscriber or user. (CBr at 147-148; CRBr at 125.) With regard to the recitation of the one or more lists used to filter an incoming call, complainant again argued that this limitation is not met because Hyde-Thomson identified a Remote Access Server as the data structure and the '114 patent does not disclose a Remote Access Server. (CBr at 147; CRBr 125.) Regarding the requirement that the incoming call be filtered according to the current activity of the subscriber or user, complainant argued that the use of the term "current" in the '439 patent requires the activity to be the current status of the user on the computer network at that moment in time. (CRBr at 125.) According to complainant, the '114 patent forwards calls based on the last location from which the user logged on, not the user's current status on the computer network. (Id.) Complainant argued that the act of logging on does not satisfy the "current activity on a computer network" limitation because it is only a precursor to a user's activity on the computer network. (CBr at 147-148; CRBr at 125.) Specifically, complainant argued that logging on necessarily means that the user is not yet on the computer network as required by the

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limitation in dispute. (CBr at 148.)

The parties have agreed to a construction of the phrase "current activity of the user on the computer network" as meaning the "current status of the user on the computer network." See Order No. 18, attached letter at 2. The administrative law judge has found that the "status" of a user can consist of both user-selected indicators based on user activity (e.g., "conditional processing" as per the '439 specification) and the transfer of data between the computer and telephone networks while the user is engaged in a VoIP phone call. (See Section VI.A.3, supra.) As further found in Section VI.A.3, supra, the administrative law judge has further found that the phrase "current status" is construed to include either the status of a user or subscriber at the present time or the most recent status of a user or subscriber. The limitation of claim 1 at issue requires both one or more lists used for filtering an incoming call and filtering the incoming call according to the current status of the user or subscriber on the computer network. The limitation "one or more lists used for filtering an incoming call" finds antecedent basis in the limitation supra, viz.

> a data structure contained within a computer network to store user-selectable criteria for call processing, wherein the data structure stores the user-selectable criteria in one or more lists that are used in filtering an incoming call.

Complainant's argument regarding the one or more lists in the limitation at issue is the same argument it made regarding said data structure limitation. For the same reasoning as set out in Section VI.A.2,A.3, supra, the administrative law judge finds complainant's argument regarding the one or more lists limitation unpersuasive.

Regarding whether being logged into the computer network is a user status, the '114

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patent states:

> If the called party is identified, then the system checks to see if calls are being forwarded 66. If calls are being forwarded, then a list of potential forwarding numbers will be determined 68. <u>The list of potential forwarding numbers can be based on one or more preprogrammed criteria, including the identity of the called party's current or most recent network logon device</u>. . .

(RX-1 at 6:64-7:3 (emphasis added).) The '114 patent further discloses that:

> When an outside caller 30 places a call on the PSTN 6 the call is directed to the called party office extension 10 by the private branch exchange 4. Before the PBX sends the call to the called party office extension 10, <u>the telecommute server 2 checks the computer network 8 to see if the called party is logged on</u>. If the called party is logged on, the telecommute server 2 instructs the private branch exchange 4 to forward the call to the telephone extension associated with the device the called party has used to log onto the computer network 8.

(<u>See</u> RX-1 at 4:48-57 (emphasis added).) The patent '114 patent also discloses:

> The identity of the called party is determined 34 by looking up the dialed extension in an index stored in a computer memory and storing the identity of the associated called party stored in a memory. If the identity of the called party is determined, then the next step is to determine the current called party network logon device 40. <u>The current called party network logon device is determined 40 by comparing identity of the called party, . . . with a list of persons currently logged onto the computer network</u>.

(RX-1 at 6:13-24 (emphasis added).) The administrative law judge finds that the passages from

the specification of the '114 patent cited, <u>supra</u>, disclose a system where an incoming call is

received, the called party is determined, the identity of the called party is compared by the

telecommute server with a list of persons currently logged onto the computer network, a private

branch exchange (PBX) is instructed by the telecommute server to forward the call to the number

associated with the user's computer logon device, and the call is forwarded. As previously found

in Section VI.A.3, supra, the phrase "current activity" can mean either the status of the user at the current time or the most recent status of the user. Further, Hyde-Thomson testified:

> Q. Now, let's go to page 4 of RDX-10. Here we have the agreed-upon construction. I believe that's right this time. The language there is: And wherein some of the one or more lists are used to filter the incoming call according to current activity of subscribers on the computer network or according to current activity of the user on the computer network.
>
> Do you see that?
>
> A. Yes.
>
> Q. Do you believe that element is disclosed in the Chestnut patent?
>
> A. Yes. The agreed construction of the term is according to the current status of the user on the computer network. And that is exactly what Chestnut is all about, the status of the user of the computer network.
>
> It's either you're not logged in at all or you're logged in from the office or you're logged in at home or from other place where there's an association already been set up with a telephone to that login address that can be used to determine where calls can be routed to.

(Tr. at 1416-1417.) Also, complainant's expert Chang testified that:

> Q. So under your construction, if you simply monitored the activity of the user's computer and the user had no status on that computer, then that claim element would not be met, correct?
>
> A. I'm not sure what you mean by user has no status on that computer.
>
> Q. He doesn't have any -- he didn't put a schedule, those kinds of things that you talked about in the computer.
>
> A. That by itself could be a form of status.

Q. So what you are saying is the lack of status is status?

A. Is also a form of status.

Q. Okay. So basically what you are saying is this element is met if the user has a computer, period?

A. All I am saying is as long as there is a way to track that status, to monitor that status, whatever that status might be.

(Tr. at 931-932.) Thus, complainant's expert testified that anything that can be monitored is status. Thus, a determination of whether a user is logged onto the network and where the user is logged onto the computer network is a determination of the current status of the user on the computer network. The '114 patent explicitly teaches that the telecommute server is able to see if the called party is logged onto the network. Thus, when the telecommute server checks a list of users logged onto the computer network and then instructs the PBX to forward the call based on where a user is logged onto the computer network, the incoming call is being filtering based on the current status of the user on the computer network.

Based on the foregoing, the administrative law judge finds that the '114 patent discloses the limitation at issue in claim 1 of the '439 patent requiring that "wherein some of the one or more lists are used to filter the incoming call according to current activity of subscribers on the computer network or according to current activity of the user on the computer network."

The Claimed Phrase "a computer network access port used by the telephone network to access the data structure such that the telephone network has access to the one or more lists over the computer network access port. . ."

Respondent and the staff argued that the '114 patent discloses the limitation "a computer network access port used by the telephone network to access the data structure such that the telephone network has access to the one or more lists over the computer network access port."

(RRBr at 58-59; SRBr at 37-38.) Specifically, respondent and the staff argued that CTI

applications running on the telecommute server disclosed in the '114 patent satisfy the computer

network access port limitation. See RRBr at 58-59; SRBr at 37-38. In support, respondent and

the staff noted that the '114 patent discloses that:

> Computer and telephone systems are being linked through
> Computer Telephony Integration (CTI) applications which
> facilitate incoming and outgoing call handling and control.
>
> CTI applications can be used to seamlessly interface the
> caller, the called party, and information on a host computer for a
> variety of applications. CTI applications deliver caller ID,
> automatic number identification (ANI), dialed number
> identification services (DNIS), and interactive voice response
> (IVR) dialed digits, such as a customer's account number, to a
> software application. CTI applications can also deliver request
> signals, such as "hold call" or "transfer call", to a telephone
> system.

(See RX-1 at 1:41-52; see also RRBr at 58; SRBr at 38.) The staff, in their reply brief at 37, also

pointed to the portion of the '114 patent reading:

> When an outside caller 30 places a call on the PSTN 6 the call is
> directed to the called party office extension 10 by the private
> branch exchange 4. Before the PBX sends the call to the called
> party office extension 10, the telecommute server 2 checks the
> computer network 8 to see if the called party is logged on. If the
> called party is logged on, the telecommute server 2 instructs the
> private branch exchange 4 to forward the call to the telephone
> extension associated with the device the called party has used to
> log onto the computer network 8.

(RX-1 at 4:48-57.) In addition, both respondent and the staff relied on the testimony of

respondent's expert Hyde-Thomson, who, in response to questioning about whether he thought

the '114 patent disclosed the computer network access port, testified:

> Q. Okay. Now, let's look at page 8 of RDX-10. The next one is:

A computer network access port used by the telephone network to access the data structure such that the telephone network has access to the one or more lists over the computer network access port.

Do you believe that element is met by the Chestnut patent?

A. Yes. In the Chestnut patent, he talks about a Telecommute Server. This server is a combination of software and hardware running in a -- probably a computer, but it might be a number of computers in a larger scale system, which has on one side an interface to the telephone network, on the other side an interface to the computer network.

So the computer network access port will be a part of the software stack inside the Telecommute Server or possibly the actual physical hardware of the ethernet port of the Telecommute Server and according to how much else might be going on on this Telecommute Server.

(Tr. at 1419-20; RDX-10 at 8.)

Complainant argued that the limitation "a computer network access port used by the telephone network to access the data structure such that the telephone network has access to the one or more lists over the computer network access port" is not disclosed in the '114 patent. (CBr at 148-149.) In particular, complainant argued that respondent's expert Hyde-Thomson could not identify a specific computer network access port disclosed in the '114 patent or state whether the computer network access port would be a physical Ethernet jack or software within the telecommute server. (Id.) Additionally, complainant asserted that on cross-examination Hyde-Thomson admitted that the '114 patent does not expressly disclose the computer network access port, but that the computer network access port is "implicit in the description of the telecommute server and the functionality that it performs." (Id. at 149 citing Tr. 1672:4-9.) Because Hyde-Thomson testified that the computer network access port was "implicit," complainant asserts that

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Hyde-Thomson must be making an inherency argument. (Id.) Thus, complainant argued that

respondent must show that the network access port is necessarily present in the '114 patent.

Complainant asserted that respondent has failed to make such a showing. (Id.)

Complainant further argued that even if it is determined that the computer network access

port is inherently disclosed in the '114 patent, respondent has failed to point to any disclosure in

the '114 patent that the computer network access port is used by the telephone network to access

the data structure such that the telephone network has access to the one or more lists over the

computer network access port. (Id.) Additionally, complainant repeated its previous argument

that the '114 patent does not disclose a Remote Access Server. (Id.)

The limitation of claim 1 at issue requires a computer network access port that is used by

the telephone network to access both the data structure and the one or more lists contained in the

data structure. According to the explicit language of claim 1of the '439 patent, a computer

network access port is something that links the telephone network and the computer network,

which allows the telephone network to access information on the computer network. See JX-1 at

14:27-36; see also, JX-1 at 5:21-6:22. The '114 patent discloses in the Background of the

Invention section:

> Computer and telephone systems are being linked through
> Computer Telephony Integration (CTI) applications which
> facilitate incoming and outgoing call handling and control. CTI
> applications can be used to seamlessly interface the caller, the
> called party, and information on a host computer.

(RX-1 at 1:41-5:2 (emphasis added).) Thus, the CTI applications not only link a telephone

network with a computer network, but also allow information on the computer to be interfaced

with the caller or called party on the telephone network. Therefore, the administrative law judge

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finds that the description of the CTI applications in the '114 patent constitutes a disclosure of a computer network access port.

Although the '114 patent discloses the use of CTI applications, none of the embodiments of the invention described in the '114 patent explicitly disclose that a CTI application is used. However, as respondent's expert Hyde-Thomson testified:

> There is, in a computer telephony system, [as the one disclosed in the '114 patent,] there is on the one side a telephone network, on the other side, a computer network. And in between the two, there is a computer network access port.

See Tr. at 1671:7-13; see also Tr. at 1667:22-1668:13; RX-1, Figure 1. Also, he testified that:

> A.   Okay.   Well, I would say that what I have argued in my report, and confirming now, is that both the existence of a controller and existence of a computer network access port is implicit in the description of the telecommute server and the functionality that it performs.

(Tr. at 1672 (emphasis added).) In addition, as quoted supra, the '114 patent explicitly discloses the PBX communicating with the telecommute server and vice versa, so there must be something between the two to facilitate that communication. See RX-1 at 4:48-56. Furthermore, in the Background of the Invention section of the specification of the '114 patent, the applicant describes the prior art as already using CTI applications. See RX-1 at 1:10-2:24. Because CTI applications were already known in the prior art, there was no need for the applicant to explicitly describe the use of CTI applications when describing the embodiments of his invention. See Koito Mfg. Co. v. Turn-Key-Tech, LLC, 381 F.3d 1142, 1156 (Fed. Cir. 2004) ("This Court has repeatedly explained that a patent applicant does not need to include in the specification that which is already known to and available to one of ordinary skill in the art."); In re Howarth, 654

F.2d 103, 105 (CCPA 1981) ("An inventor need not, however, explain every detail since he is speaking to those skilled in the art."). With regard to complainant's criticism that Hyde-Thomson could not identify whether the network access port was implemented in hardware or software, it is noted that Hyde Thomson testified that it was not relevant. See Tr. at 1671:23-1672:1. In fact, complainant's expert Chang also testified that the computer network access port could be either hardware or software. See Tr. at 1025:1-4. Accordingly, the administrative law judge finds that the embodiments of the invention described in '114 patent inherently disclose a computer network access port that resides as either hardware or software in the telecommute server with the computer network access port being necessary in order for the PBX, which is a part of the telephone network, to communicate with the telecommute server, which is part of the computer network.

While the administrative law judge has found herein that the '114 patent discloses a computer network access port in the telecommute server, claim 1 of the '439 patent also requires that the telephone network be able to access both the data structure and the one or more lists on the computer network through the computer network access port. Neither respondent nor the staff, has shown that the '114 patent discloses this element of the limitation at issue, as neither pointed to any evidence that the telephone system can access the data structure or one or more lists over the computer network access port. The administrative law judge has found supra that the data structure that contains the one or more lists is disclosed in the '114 patent as being stored on the telecommute server and the telecommute server is part of the computer network. Likewise, the '114 patent discloses a private telephone switch (PBX) that is part of the telephone system that communicates with the telecommute server. However, in contrast to the limitation at

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issue requiring the telephone network to access the data structure and the one or more lists, it is the telecommute server (i.e., the computer network) that accesses the data structure and one or more lists and then it is the telecommute server that communicates information synthesized from the data structure and one or more lists back to the PBX for call routing. As disclosed in the '114 patent, the PBX (i.e., the telephone network) does not access the data structure or the one or more lists. Accordingly, the administrative law judge finds that respondent has failed to prove, by clear and convincing evidence, that the '114 patent discloses a telephone network that accesses the data structure and one or more lists over a computer network access port as required by claim 1 of the '439 patent.

> The Claimed Phrase "a controller to receive the incoming call designated for the user telephone and to process the incoming call in accordance with the user-selectable criteria, the controller accessing the user-selectable criteria in the one or more lists of the data structure via the computer network access port and thereby applying the user-selectable criteria to the incoming call."

Respondent and the staff argued that the '114 patent discloses this limitation of claim 1. See RBr at 119-120; RRBr at 59-60; SBr at 74; SRBr at 38-39. Both respondent and the staff relied on the testimony of respondent's expert Hyde-Thomson, although both also cite to the specification of the '114 patent to buttress said testimony. Hyde-Thomson testified at the hearing that the '114 patent disclosed a controller. (Tr. at 1422:7-9.) Specifically, Hyde-Thomson testified that:

> Q. Let's go back to RDX-10, page 9. So the next element there: A controller to receive the incoming call designated for the user telephone and to process the incoming call in accordance with the user-selectable criteria, the controller accessing the user-selectable criteria in the one or more lists of the data structure via the computer network access port and thereby applying the user-selectable criteria to the incoming call.

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Do you believe that element is disclosed in the Chestnut patent?

A.   Yes. So the controller is within that Telecommute Server. It consists of the hardware of the Telecommute Server and the software running on the processor of the Telecommute Server that controls the computer telephony system.

(Tr. at 1421-1422.) When asked where he found support for his assertion, Hyde-Thomson

pointed to the passage in the '114 patent that states that "[c]omputer and telephone systems are

being linked through Computer Telephony Integration (CTI) applications which facilitate

incoming and outgoing call handling and control." See RX-1 at 1:41-47; Tr. at 1422:22-25;

RDX-10 at 10. According to Hyde-Thomson's testimony:

Q.   And why is it that that supports your opinion that the last element is disclosed, last element of claim 1 is disclosed?

A.   The controller -- in particular, that it discloses the controller?

Q.   Yes.

A.   Yeah. So the Chestnut system is all about a system which equals Telecommute Server, which is controlling how telephone calls are routed. And this controller is physically embodied in the Telecommute Server hardware and under the control of appropriate software. And, indeed, that's exactly what Active Voice Corporation were making at the time was computer telephony software systems.

(Tr. at 1423.) In addition to the testimony of Hyde Thomson, respondent and the staff cited the

following passage from the '114 patent, which states:

When an outside caller 30 places a call on the PSTN 6 the call is directed to the called party office extension 10 by the private branch exchange 4. Before the PBX sends the call to the called party office extension 10, the telecommute server 2 checks the computer network 8 to see if the called party is logged on. If the called party is logged on, the telecommute server 2 instructs the

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private branch exchange 4 to forward the call to the telephone extension associated with the device the called party has used to log onto the computer network 8.

If the called party was logged onto the computer network 8 from the called party office workstation 20, then the call would be directed to the called party office extension 10. If the called party were logged onto the computer network 8 from the called party home workstation 26, then the telecommute server 2 would instruct the PBX 4 to forward the call to called party home phone 22. The telecommute server 2 selects the telephone number to which incoming calls should be forwarded based upon a record stored in a memory which associates a forwarding telephone number, such as the number for called party home phone 22, with a network logon device, such as called party home workstation 26.

(RX-1 at 4:48-5:2.)

Complainant argued that the limitation "a controller to receive the incoming call designated for the user telephone and to process the incoming call in accordance with the user-selectable criteria, the controller accessing the user-selectable criteria in the one or more lists of the data structure via the computer network access port and thereby applying the user-selectable criteria to the incoming call" is not disclosed in the '114 patent. (CBr at 127-129.) In particular, complainant argued that Hyde-Thomson could not identify anything specifically in the telecommute server as the controller, nor could he state where the controller resides in the telecommute server or whether the controller was hardware or software. (Id. at 128.) Additionally, complainant asserted that, on cross-examination, Hyde-Thomson admitted that the '114 patent does not expressly disclose the controller but that the controller is "implicit in the description of the telecommute server and the functionality that it performs." See id.; see also Tr. at 1672:4-9. Because Hyde-Thomson testified that the controller was "implicit," complainant asserted that Hyde-Thomson must be making an inherency argument. Complainant then argued

that respondent must show that the controller is necessarily present in the '114 patent. Complainant asserted that respondent has failed to make such a showing. (CBr at 128.)

Complainant also argued that even if it is determined that the controller is inherently disclosed in the '114 patent, respondent has failed to point to any teaching in the '114 patent that the controller accesses the user-selectable criteria in the one or more lists via the computer network access port. (Id.) Additionally, complainant repeated its previous argument that the '114 patent does not disclose a Remote Access Server. (Id. at 128-129.)

The parties agreed to a construction of the word "controller" as "hardware or software that accesses a user selectable criteria in one or more lists of the data structure via the computer network access port thereby applying the user selectable criteria to the incoming call." See Order No. 18, attached letter at 2. The limitation of claim 1 at issue requires a controller that receives an incoming call and processes the call in accordance with the user-selectable criteria in the one or more lists of the data structure which the controller accesses via the computer network access port. Hyde-Thomson identified the controller as a combination of hardware and software in the telecommute server and part of the Computer Telephony Integration applications. (Tr. at 1422:9-13, 22-25.) The '114 patent explicitly discloses that Computer Telephony Integration (CTI) applications "facilitate incoming and outgoing call handling and control." See RX-1 at 1:41-47. Although none of the embodiments described in the '114 patent explicitly discloses using a controller, Hyde Thomson testified that a controller is "implicit in the description of the telecommute server and the functionality that it performs." See Tr. at 1672:4-9. Because none of the embodiments described in the '114 patent explicitly discloses that the telecommute server includes a controller, respondent must show that the controller is inherently present in the

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telecommute server. On this point, Hyde-Thomson testified that the '114 patent "is all about a system which equals Telecommute Server, which is controlling how telephone calls are routed." (Tr. at 1423:15-20.)

Assuming arguendo, that the controller is necessarily present in the telecommute server, both the agreed on construction of the term by the parties and the explicit requirements of the limitation at issue still require that the "controller": (1) receive the incoming call; and (2) access the user-selectable criteria in the one or more lists of the data structure via the computer network access port. Neither respondent nor the staff has shown that the '114 patent discloses these elements of the limitation at issue. In fact, the administrative law judge finds that the '114 patent teaches away from such a disclosure. Thus, in accord with the explicit language of the limitation at issue, the controller must receive the incoming call designated for the user phone. As set forth supra, respondent and the staff asserted that the controller is a combination of hardware and software that resides on the telecommute server. Thus, in order for the '114 patent to disclose this element of the limitation at issue, the administrative law judge finds that it must disclose that the hardware and software that reside on the telecommute server receive the incoming call. However, he finds that this is not what the '114 patent teaches. In contrast to the requirement that the hardware and software that reside on the telecommute server receive the incoming call, the '114 patent discloses that it is the PBX that receives the call. See RX-1 at 4:48-5:2.

Furthermore, if the controller were within the telecommute server, the administrative law judge finds that there is no evidence to support respondent's and the staff's assertion that the controller accesses the user-selectable criteria in the one or more lists of the data structure via the computer network access port as required by the limitation at issue. Thus, there is no evidence

that the controller is what accesses the data structure. The '114 patent only discloses that it is the telecommute server in general that accesses the data structure. See, e.g., RX-1 at 4:51-53, 4:64-5:2. In addition, Hyde-Thomson testified that the controller is what controls the computer telephony (i.e., the communications link between the computer network and the telephone network). Hence the administrative law judge finds that the function of the controller as described by Hyde-Thomson is not consistent with the requirement that the controller "access" the data structure. Moreover, even if the controller were the device that accesses the data structure he finds that there is no evidence that the controller accesses the data structure via the computer network access port. The administrative law judge has found, supra, consistent with the testimony of Hyde-Thomson and the arguments presented by both respondent and the staff, that the data structure that contains the one or more lists is stored on the telecommute server. Additionally, the administrative law judge has found, supra, that the computer network access port that links the telecommute server, which is part of the computer network, with the PBX, which is part of the telephone network, is in the telecommute server. Because the controller, data structure and the computer network access port are all part of the telecommute server, the administrative law judge finds that there is no evidence to support the notion that the controller would access the data structure using the computer network access port. Logically, because the data structure is already stored on the telecommute server the data structure should be directly accessible by the telecommute server and thus there would be no need to use a device (i.e., the computer network access port) that links the telecommute server with the PBX to access the data structure. Accordingly, for the reasons, supra, the administrative law judge finds that respondent has failed to prove, by clear and convincing evidence, that the '114 patent discloses the limitation

of claim 1 requiring "a controller to receive the incoming call designated for the user telephone and to process the incoming call in accordance with the user-selectable criteria, the controller accessing the user-selectable criteria in the one or more lists of the data structure via the computer network access port and thereby applying the user-selectable criteria to the incoming call."

Based on the foregoing the administrative law judge finds that respondent has not established, by clear and convincing evidence, that the '114 patent anticipates claim 1 of the '439 patent.

b.   Claim 28 Of The '439 Patent

Respondent argued that claim 28 is anticipated by the '114 patent. (RBr at 120-122; RRBr at 60.)

Complainant argued that the '114 patent does not anticipate claim 28 of the '439 patent. (CBr at 151; CBr at 130.)

The staff argued that claim 28 is anticipated by the '114 patent. (SBr at 74.)[12]

Claim 28 is directed to a computer program product that implements a method for processing calls over a telephone network. Unlike claim 1, which sets out very specific requirements in the manner the data structure, computer network access port, and controller relate to and interact with each other, the method steps of claim 28 do not expressly require all of those relationships. Additionally, claim 28 does not explicitly require a computer network access

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[12]   With the exception of the limitation of claim 28 requiring "a computer program product for implementing a method for processing a call . . . comprising: a computer readable medium having computer executable instructions for performing the method," the parties rely on the same arguments they made with regard to claim 1 in arguing whether the '114 patent discloses or does not disclose the limitations of claim 28.

port or a controller. Claim 28 of the '439 patent does, however, explicitly require a computer program product comprising a computer readable medium having computer executable instructions for implementing a method for call processing. See JX-1 at 16:55-61. Claim 1 of the '439 patent has no such requirement. The method for call processing as claimed includes the steps of: (1) accepting an incoming call; (2) accessing a data structure; and (3) processing the incoming call. (Id. at 16:62-17:6.) Thus, in order to prove that the limitation of claim 28 requiring a computer program product is disclosed by the '114 patent, respondent must show that the '114 patent discloses implementing each of the described method steps in software.

Respondent relied on several passages in the specification of the '114 patent and the testimony of its expert Hyde-Thomson to support its argument that the limitation of claim 28 requiring a computer program product is disclosed by the '114 patent. (RBr at 120.) In particular, respondent noted that the Chestnut patent describes the invention as a "method and device for managing a telecommunications system, including call forwarding, with a computer network (LAN, WAN, etc.) integrated with a private branch exchange (PBX) connected to a Public Switched Network (PSTN)." (RX-1, Abstract; see also RBr at 120 citing RFF V.C.1.54.) Respondent does not explain the significance of this passage and it is not clear from a plain reading of the passage how it would teach a computer program product for implementing a method for call processing. Additionally, respondent noted in support of its anticipation argument that the '114 patent states that "call forwarding options may be automatic." See RX-1 at 3:30-32; see also RBr at 120 citing RFF V.C.1.55. Again, however, respondent provided no explanation as to the significance of this passage. Notably, the passage does not state that the call forwarding may be automatic. The passage only states that the call forwarding "options"

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may be automatic. Respondent further noted in support of its argument that the '114 patent states that the "present invention also includes a call progress manager which controls the protocols used to forward a call depending upon where the call originated and where it was forwarded to." See RX-1 at 3:43-46; see also RBr at 120 citing RFF V.C.1.56. Respondent however does not explain the significance of this passage and it is not readily apparent how this passage would support a finding that the '114 patent discloses a computer program product for implementing a method of call processing. Notably, the passage to which respondent cites does not state the call progress manager controls the forwarding of the call. The passage only states that the call progress manager controls the "protocols" used to forward a call.

In addition to the citations supra to the specification of the '114 patent, respondent also relied on the testimony of its expert Hyde-Thomson, to show that the '114 patent discloses the computer program product limitation of claim 28. (RBr at 120 citing RFF V.C.1.57.) Specifically, Hyde Thomson testified that:

> The system described is implemented by computers -- a software program running on the processor of the Telecommute Server. Chestnut is not describing something which is built out of hardware. It's describing something which is built by software on appropriate computer platform with telephony interface cards.

(Tr. at 1424-1425.) Although it appears that Hyde-Thomson is testifying to what he believes is explicitly disclosed in the '114 patent, in an answer to a later question, he makes plain that the disclosure in the '114 patent of Computer Telephony Integration applications "implied" the existence of a computer program product:

> Q. Do you believe that element is disclosed by the Chestnut reference?

A. Well, I think the -- the language that he already talked about, defining it as a type of computer telephony integration, <u>implies</u> that's exactly what it was. It was a combination of software and telephony hardware and a computer.

Q. And why is it that a -- it <u>implies</u> that to you?

A. Because that's what people meant by computer telephony integration.

(Tr. at 1425 (emphasis added).) Because Hyde-Thomson argued that the computer program product is implied in the '114 patent, it appears that he is making an inherency argument. Thus, in order to show that the '114 patent discloses the computer program product limitation of claim 28, respondent must show that such a product is necessarily present in the '114 patent.

As found <u>supra</u>, it is unclear how the passages in the specification of the '114 patent cited to by respondent disclose a method for call processing implemented as a computer program. This is especially so in light of the fact that neither respondent nor its expert provided any explanation regarding the significance of the passages. Certainly, none of the passages explicitly teaches accepting an incoming call, accessing a data structure, or processing the incoming call in software. Furthermore, because the computer program product is not explicitly disclosed, respondent has the additional burden of showing that such a product is inherent in the '114 patent. The administrative law judge finds nothing in Hyde-Thomson's testimony or in the specification that shows the '114 patent necessarily discloses a computer program product that receives an incoming call, accesses a data structure, and processes the incoming call.

Based on the foregoing, the administrative law judge finds that respondent has failed to prove, by clear and convincing evidence, that the '114 patent discloses the limitation of claim 28 requiring "a computer program product for implementing a method for processing a call . . .

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comprising: a computer readable medium having computer executable instructions for performing the method."

Based on the foregoing, the administrative law judge finds that respondent has failed to prove by clear and convincing evidence, that the '114 patent discloses all the limitations of claim 28. Accordingly, the administrative law judge finds that the '114 patent does not anticipate claim 28 of the '439 patent.

c.   Claim 38 Of The '439 Patent

Claim 38 is directed to a computer program product that implements a method for processing calls over a telephone network. Unlike claim 1, which sets out very specific requirements in the manner the data structure, computer network access port, and controller relate to and interact with each other, the method steps of claim 38 do not expressly require all of those relationships. Additionally, claim 38 does not explicitly require a computer network access port or a controller. Further, unlike claim 28, claim 38 also does not require that the method for call processing be implemented as a computer program product comprising a computer readable medium having computer executable instructions for performing the method.

Respondent and the staff argued that the '114 patent anticipates claim 38 of the '439 patent. Complainant argued that it does not so anticipate. All of the parties rely on their anticipation arguments regarding claim 1 of the '439 patent to prove that the limitations of claim 38 are disclosed by the '114 patent.

> The Claimed Phrase "In a system including a telephone network and a computer network where an originating telephone connects with a user telephone over the telephone network. . ."

Respondent argued that the '114 patent discloses this limitation. (RPFF V.C.1.84.)

Complainant does not dispute that this limitation is disclosed by the '114 patent. (SPFF 351 (undisputed).)

The staff argued that the '114 patent discloses this limitation. (SPFF 351.)

The '114 patent discloses that "the present invention . . . is a method for controlling call forwarding using a computer connected to a data network and a telephone network." (RX-1 at 2:33-36; 4:36-39; Figure 1.) Based on the foregoing, the administrative law judge finds that respondent has established that the '114 patent discloses this limitation of claim 38.

> The Claimed Phrase "a method for processing call from the originating telephone to the user telephone according to user specifications, the method comprising:"

Respondent argued that this limitation is disclosed in the '114 patent, as found in RX-1 at col. 4:36-47; Figure 1. (RPFF V.C.1.84; RFF V.C.1.85.)

Complainant argued that respondent has failed to meet its burden of showing that the '114 patent clearly and convincingly discloses this limitation. (CORFF V.C.1.87.) Specifically, complainant argued that, at trial, Hyde-Thomson did not explain how the citations to Chestnut satisfy this limitation. (CRRFF V.C.1.85-A.)

The staff argued that this limitation is disclosed in the '114 patent. (SPFF 352 citing Tr. at 1430, RDX-10 at 20, RX-1 at 4:48-57, RX-1 at 5:13-21.)

The '114 patent discloses that:

> When an outside caller 30 places a call on the PSTN 6 the call is directed to the called party office extension 10 by the private branch exchange 4. Before the PBX sends the call to the called party office extension 10, the telecommute server 2 checks the computer network 8 to see if the called party is logged on. If the called party is logged on, the telecommute server 2 instructs the private branch exchange 4 to forward the call to the telephone extension associated with the device the called party has used to

> log onto the computer network 8.

> * * *

> The telecommute server 2 selects the telephone number to which
> incoming calls should be forwarded based upon a record stored in a
> memory which associates a forwarding telephone number, such as
> the number for called party home phone 22, with a network logon
> device, such as called party home workstation 26.

> * * *

> The telecommute server 2, can also forward incoming calls
> based upon other criteria including day or date, time of day, the
> identity of the caller, or any preprogrammed set of rules.

(RX-1 at 4:48-53, 4:64-5:2, 5:18-21; see also id. at 6:34-42.) Thus, the '114 patent discloses

forwarding a call (i.e., processing a call) from an outside caller (i.e., originating telephone) to the

called party (i.e., user telephone) based on where the called party is logged onto the computer

network or based upon other criteria including any preprogrammed set of rules (i.e, user

specifications). Therefore, the administrative law judge finds that respondent has established that

the '114 patent explicitly discloses this limitation of claim 38.

> The Claimed Phrase "accepting an incoming call designated for the user telephone
> from an originating telephone of a subscriber. . ."

> Respondent argued that the '114 patent discloses this limitation. (RFF V.C.1.88.)

Complainant argued that respondent has failed to meet its burden of showing that the '114 patent

clearly and convincingly discloses this limitation. (CRRFF V.C.1.91-A.)

> The staff argued that the '114 patent discloses this limitation. (SPFF 353.)

> As cited, supra, the '114 patent explicitly states that:

>> When an outside caller 30 places a call on the PSTN 6 the
>> call is directed to the called party office extension 10 by the private

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> branch exchange 4. Before the PBX sends the call to the called
> party office extension 10, <u>the telecommute server 2 checks the</u>
> <u>computer network 8 to see if the called party is logged on.</u>

(RX-1 at 4:48-53 (emphasis added).) Thus, the '114 patent discloses that before an incoming

call is directed to the called party, the PBX accepts the incoming call and checks to see if the

called party is logged on. Additionally respondent's expert Hyde-Thomson testified that

"accepting an incoming call is a key capability of the Telecommute Server. Basically all it does

is accept incoming calls, route them to appropriate extensions." (Tr. at 1426:5-10.) Thus, the

administrative law judge finds that respondent has established that the '114 patent explicitly

discloses this limitation of claim 38.

> The Claimed Phrase "accessing a data structure contained within a computer
> network that is independent of the telephone network to retrieve user-selectable
> criteria for call processing stored within the data structure"

Respondent argued that the '114 patent discloses this limitation, citing to RX-1 at

3:30-32, 4:64-5:2, 5:13-28; Hyde-Thomson Tr. at 1426:11-1427:21. (RFF V.C.1.92.)

Complainant argued that respondent's expert did not explain at trial why the citations

referred to by respondent show that this limitation is met, and further that the citations do not

support respondent's position. (CRRFF V.C.1.92-A, CRRFF V.C.1.92-B.)

The staff argued that the '114 patent discloses this limitation. (SPFF 354.)

As found in detail with regard to the limitation of claim 1 of the '439 patent requiring "a

data structure contained within a computer network to store user-selectable criteria for call

processing, wherein the data structure stores the user-selectable criteria in one or more lists that

are used in filtering an incoming call," the administrative law judge found that the data structure

element of this limitation disclosed in the description in the '114 patent as a record stored in

memory on the telecommute server. See, supra; see also, e.g., RX-1 at 6:34-46. Also, as found

with regard to claim 1 of the '439 patent, the administrative law judge found that the '114 patent

discloses that the data structure stores user-selectable criteria which is used for call processing.

See, supra; see also, e.g., RX-1 at 5:18-25, 6:34-46. Additionally, the '114 patent discloses that

"[t]he telecommute server 2 selects the telephone number to which incoming calls should be

forwarded based upon a record stored in a memory . . ." (RX-1 at 4:64-66.) Thus, the

administrative law judge finds that respondent has established that the '114 patent explicitly

discloses accessing the data structure for call processing as required by the limitation at issue.

Further, Figure 1 of the '114 patent shows the telecommute server as part of the computer

network and separate from the PBX and PSTN that are part of the telephone network. See RX-1,

Figure 1. Thus, as construed herein, the administrative law judge finds that the '114 patent

discloses a data structure contained within a computer network that is physically distinct from the

telephone network. Accordingly, for the reasons found, supra, the administrative law judge finds

that respondent has established that the '114 patent discloses this limitation of claim 38.

> The Claimed Phrase "wherein some of the user-selectable criteria is conditioned
> on current activity of subscribers on the computer network or according to current
> activity of the user on the computer network"

Respondent argued that the '114 patent discloses this limitation, as it discloses filtering

an incoming call based on the current status of the user on the computer network, and forwards

calls based on whether a user is logged on to the computer network (current status of the user).

(RFF V.C.1.97.)

Complainant argued that it does not, because the act of logging on is not current activity

of the user on the computer network, but instead is a precursor to such activity. (CRRFF

V.C.1.97-D.)

The staff argued that this limitation is disclosed by the '114 patent. (SBr at 73-74; SPFF 355.)

As found, supra, regarding the limitation of claim 1 of the '439 patent that states "wherein some of the one or more lists are used to filter the incoming call according to current activity of subscribers on the computer network or according to current activity of the user on the computer network," the administrative law judge finds that the disclosure in the '114 patent of the telecommute server checking the list contained in the data structure of where the called party is logged on, and on what logon device, to determine where to appropriately forward the incoming call satisfies the requirement of this limitation at issue calling for the user-selectable criteria to be conditioned on the current activity of the user on the computer network. See supra; see also, e.g., RX-1 at 6:65-7:3. Accordingly, the administrative law judge finds that respondent has established that the '114 patent discloses this limitation of claim 38.

> The Claimed Phrase "processing the incoming call of the subscriber in accordance with the user-selectable criteria."

Respondent argued that this limitation is disclosed by the '114 patent, citing to RX-1 at col. 4:64-5:2, col. 5:44-48, col. 6:34-43, col. 6:67-7:4; Hyde-Thomson Tr. at 1428:11-1429:11. (RFF V.C.1.103.)

Complainant argued that, at trial, Mr. Hyde-Thomson did not explain how the above citations to Chestnut satisfy this limitation. (CRRFF V.C.1.103-A.)

The staff argued that this limitation is disclosed by the '114 patent. (SBr at 74.)

The '114 patent explicitly discloses that:

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> Before the PBX sends the call to the called party office extension
> 10, the telecommute server 2 checks the computer network 8 to see
> if the called party is logged on. If the called party is logged on, the
> telecommute server 2 instructs the private branch exchange 4 to
> forward the call to the telephone extension associated with the
> device the called party has used to log onto the computer network
> 8.

(RX-1 at 4:50-53.) The '114 patent also discloses that "[t]he telecommute server 2, can also

forward incoming calls based upon other criteria including day or date, time of day, the identity

of the caller, or any preprogrammed set of rules." See RX-1 at 5:18-21; see also RX-1 at 6:34-43.

As plainly stated in the cited excerpts, from the '114 patent, the telecommute server can forward

an incoming call based on any number of user-selectable criteria, including where the user is

logged onto the computer network. Thus, the administrative law judge finds that respondent has

established that the '114 patent explicitly discloses this limitation of claim 38.

Based on the foregoing, the administrative law judge finds that respondent has

established, by clear and convincing evidence, that the '114 patent discloses each limitation of

claim 38 of the '439 patent. Accordingly, the administrative law judge finds that the '114 patent

to Chestnut anticipates claim 38 of the '439 patent.

2.   Miner Patent

a.   Claims 1, 28 And 38 Of The '439 Patent

Respondent argued that U.S. Patent No. 5,652,789 issued to Miner (the '789 patent)

anticipates independent asserted claims 1, 28 and 38 of the '439 patent in that it discloses

forwarding calls based on the user's current status on the computer network, a computer network

access port, a controller, and each of the remaining limitation of said claims of the '439 patent.

(RBr at 124.)

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Complainant argued that claims 1, 28, and 38 of the '439 patent are not anticipated,

because respondent fails to show, by clear and convincing evidence, that Miner discloses a data

structure, user criteria in said data structure, that the user criteria are used to filter incoming calls,

the use of computer network access ports, and the existence of a controller. (CBr at 151-156.)

Complainant further argued that respondent uses the same arguments regarding claim 28 of the

'439 patent as for claim 1 of the '439 patent, and thus claim 28 is not anticipated by Miner for the

same reasons as claim 1 of the '439 patent is not anticipated. (CBr at 156.) Likewise,

complainant argued that for the same reasons that claims 1 and 28 are not anticipated by Miner,

claim 38 is not anticipated by Miner. (CBr at 156-157.)

The staff argued that the Miner patent discloses the "current activity of the user on the

computer network" limitation, the controller and computer network access port limitations, and

each of the other limitations of the asserted claims and hence anticipates the claims in issue. (SBr

at 75-77.)

> The Claimed Phrases "wherein the data structure stores the user-selectable criteria
> in one or more lists . . . wherein some of the one or more lists are used to filter the
> incoming call according to current activity of subscribers . . . or . . . user on the
> computer network" (JX-1 at 14:18-26), "user-selectable criteria for call processing
> . . . wherein some of the user-selectable criteria is conditioned on current activity
> of subscribers . . . or . . . user on the computer network" (JX-1 at 16:66-17:4) and
> "user-selectable criteria for call processing . . . wherein some of the
> user-selectable criteria is conditioned on current activity of subscribers . . . or . . .
> user on the computer network" (JX-1 at 18:9-16.)

Each of the claimed phrases, supra, of claims 1, 28, and 38 of the '439 patent include a

limitation that requires call processing based on user-selectable criteria conditioned on the

current activity of a subscriber or user on the computer network. The parties have agreed that

properly construed the phrase "current activity of the user on the computer network" means the

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"current status of the user on the computer network." See Order No. 18, attached letter at 2.

Respondent and the staff argued that the '789 patent discloses call processing based on user-selectable criteria conditioned on the current activity of a subscriber or user on the computer network. See RBr at 124-125; RRBr at 61-62; SBr at 75-76; SRBr at 40. Specifically, respondent and the staff argue that the '789 patent expressly discloses processing phone calls based on a user's current status as logged onto the computer network. (RBr at 124; SBr 76.) In support, both parties rely on various passages in the specification of the '789 patent and the testimony of respondent's expert Hyde-Thomson.

In particular, respondent and the staff noted that the '789 patent states that:

> As a first step in locating the subscriber[13], the system determines whether the subscriber is already connected to the system, either through another call or through some other communications medium (e.g. logged into his computer). If the subscriber is on another call being handled by the system, the system briefly interrupts that call to notify the subscriber that he has a call waiting and it identifies the name of the caller. If the caller is also logged onto the system through his computer, the system may also send a visual message to the workstation notifying the subscriber of the call and identifying the caller.[14]

(RX-3 at 8:25-35; see also RBr at 153; SBr 76.) Respondent and the staff do not provide any analysis of this passage as it relates to the limitation at issue. However, the staff asserts that the passage discloses call routing based on the user's status as "logged on." See SBr at 76. While the

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[13] In the '439 patent the "user" is the person being called and the "subscriber" is the person doing the calling. In the '789 patent, the "subscriber" is the person being called and the "caller" is the person doing the calling. Except where quoting evidence or testimony, the word "user" will exclusively be used to describe the person being called.

[14] The last sentence of this passage has an apparent error. Although the sentence begins "[i]f the caller is also logged onto the system," it appears plain from the remaining context of the sentence that the sentence should begin "[i]f the subscriber is also logged onto the system."

passage does acknowledge that in trying to locate the user, the system of the '789 patent will check to see if a user is logged into his computer, the passage does not discuss processing the call in any way according to whether the user is logged onto his computer. The last sentence of the above passage states that if the user is logged onto the system, the system may send the user a visual message to the user's computer about the caller. However, simply sending a visual message that notifies the user of the incoming call and identifies the caller does not amount to call processing because there is no disclosure that the system does anything with the actual incoming call. Additionally, the administrative law judge finds nothing in the above passage that discloses any user-selectable criteria conditioned on the status of the user as being logged onto his computer.

Respondent and the staff also note that the '789 patent discloses that:

> Once the assistant either recognizes the caller either through a match with a stored vocalization or through the caller's phone number or labels the caller as unknown, it then attempts to locate the subscriber. It does this by carrying out a sequence of operations the first of which is to check the subscriber's status. If the subscriber currently has a connection established with his assistant (and he has not enabled a do not disturb function), then his status is available. If the subscriber is not connected, then the assistant may check a secondary information source (such as a cellular network) to determine the subscriber's availability. Finally, the assistant will check the subscriber's schedule. The subscriber can set his availability to indicate that he is accepting all calls, he is accepting no calls, or he is accepting only important calls.

(RX-3 at 7:51-65; see also RFF V.C.4.21; SBr 75-76.) Respondent does not provide any analysis of this passage. However, according to the staff, the passage discloses call routing based on a variety of indicators of a user's status, including whether the user has activated a do not disturb function, and whether the user is available to take calls based on the identity of the caller. See

SBr at 76. Although the passage does disclose that a user's status will be determined depending on whether the user currently has a connection established with his assistant, there is no disclosure that the "connection" discussed in the above quoted passage refers to the user's connection with a computer network. In fact, Microsoft's expert Chang, testified that the above passage is directed to checking the user's status on a telephone network. See Tr. at 1750:11-19 ("So it is pretty clear to me that the paragraphs referenced in this particular section refers to ability for the Miner's electronic assistant to determine a user's status over a telephone line, for instance, with reference to a cell or a network. It is not clear to me how this particular paragraph could possibly indicate the current status of the user on the computer network.") Additionally, there is nothing in the above passage that discloses any user-selectable criteria conditioned on the status of the user as being logged onto his computer.

In addition, respondent noted that the '789 patent discloses that:

> When an incoming call arrives for a given subscriber there are a number of ways in which the assistant might handle the call, depending on the preferences which the subscriber has previously selected. The assistant might directly forward the call to a telephone on the subscriber's desk phone, it might simply offer to take a message from the incoming caller, or it might attempt to locate the subscriber and offer to connect him to incoming call once he is located. In handling the call, the answer call task first checks the subscriber's status to determine which preference he has selected (step 500).

(RX-3 at 32:54-64; see also RFF V.C.4.19 (citing the above quoted passage).) Respondent does not provide any analysis of this passage and it is unclear from a plain reading of the text how this passage supports respondent's argument that the '789 patent discloses the limitation in issue. Although the above quoted passage discloses that when the system receives an incoming call the

system first checks the user's status, there is nothing in the passage to suggest that this "status" includes the user's status as being logged onto his computer. In fact, Microsoft's expert Chang testified that, in his opinion, the above quoted passage does not disclose checking a user's status on a computer network (which the limitation in issue requires), but rather discloses checking a user's status on a telephone network. See Tr. at 1752:11-18 ("So to me this is another example where the Miner system with the electronic assistant was trying to figure out what to do with the call by attempting to contact the user on the telephone system. And it is my opinion that this does not -- this is not the same as according to the current status of the user on the computer network."). Further, even if "status" did include the user's status as logged onto his computer, the passage "[i]n handling the call, the answer call task first checks the subscriber's status to determine which preference he has selected (step 500)" (RX-3 at 32:62-64) does not disclose any type of call processing based on the user's status. To the contrary, said passage explicitly states that any call processing is based on the user's preferences, not status. See RX-3, Figure 24A (showing that call processing is based on whether the user is taking calls immediately, screening calls, or taking no calls). Moreover, the administrative law judge finds that said passage does not disclose any user-selectable criteria conditioned on the status of the user as being logged onto his computer.

Respondent and the staff have relied on the testimony of respondent's expert Hyde-Thomson, who testified:

> Q. Go to page 4 of RDX-11. The language there: And wherein some of the one or more lists are used to filter the incoming call according to the current activity of subscribers on the computer network or according to current activity of the user on the computer network.

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Do you believe that element is disclosed by the Miner reference?

A.   Yes. If we go to the next slide, slide 5, the language in Miner is: It then attempts to locate the subscriber. It does this by carrying out a sequence of operations, the first of which is to check the subscriber's status. If the subscriber currently has a connection established with his assistant (and he has not enabled a do not disturb function), then his status is available. If the subscriber is not connected, then the assistant may check a secondary information source (such as a cellular network) to determine the subscriber's availability. Finally, the assistant will check the subscriber's schedule.

So the Miner system determines the user's status on the computer network. There's probably some further language in Miner that amplifies exactly how that does that.

Q.   If you look at 6 of RDX-11.

A.   Yeah. So when an incoming call arrives for a given subscriber, there are a number of ways in which the assistant might handle the call depending on the preferences which the subscriber has previously selected. The assistant might directly forward the call to a telephone on the subscriber's desk. It might simply take a message or might attempt to locate the subscriber to connect him to the incoming call once he is located. In handling the call, the answer call task first checks the subscriber's status to determine which preference he has selected.

Q.   And why is it that that indicates to you that the Miner reference discloses that element?

A.   So, again, slide 7, we -- Miner checks the user status as logged on or logged off the computer network. So in this first sentence highlighted, it says: Whether the subscriber is already connected to the system, either through another call or through some other communications medium (e.g. logged into his computer). And then in the last sentence: If the caller is also logged on to the system through his computer, the system may also send a visual message to the workstation notifying the subscriber of the call and identifying the caller.

Q.   And why does that indicate to you that the -- the element

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that we just read is disclosed?

A.   It does. It definitely indicates that to me.

Q.   But why is that?

A.   Why? Because it explicitly talks about checking whether the user is logged onto his computer, and that's a status of the user on the computer network.

(Tr. at 1435-1437.) Pages 5-7 of RDX-11, on which Hyde-Thomson relies, quote the three passages from the specification of the '789 patent set forth supra. Hyde-Thomson concludes from the quoted passages that the '789 patent discloses "checking whether the user is logged onto his computer," which according to Hyde-Thomson is "a status of the user on the computer network." (Tr. at 1437:12-15.) Although Hyde-Thomson testified that the '789 patent discloses checking the user's status on the computer network, claims 1, 28 and 38, of the '439 patent require more than simply checking a user's status on the computer network. Rather, the limitation in issue require call processing based on user-selectable criteria conditioned on the user's status on the computer network. Hyde-Thomson did not provide any testimony describing how the user's status as logged onto his computer is used to process an incoming call. Further, Hyde-Thomson did not testify that the '789 patent discloses any user-selectable criteria conditioned on the user's status as logged onto his computer.

As found, supra, the '789 patent discloses that, in trying to locate the user, the system will check to see if the user is logged onto his computer. As found, supra, with regard to the '114 patent to Chestnut, whether a user is logged onto his computer is the "current status of the user on the computer network." The administrative law judge finds that it is not sufficient, however, to merely show that the '789 patent discloses checking the user's current status on the computer

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network. Claims 1, 28 and 38 of the '439 patent require call processing based on user-selectable criteria conditioned on the status of the user on the computer network. The administrative law judge also finds no indication in the '789 patent that an incoming call is processed based on the user's status as logged onto his computer. Rather, he finds that the '789 patent simply discloses that if the user is logged onto his computer, the system may send the user a message indicating that the user has an incoming call and the identity of the caller. Moreover, assuming arguendo the '789 patent did disclose call processing based on whether the user is logged onto his computer, the administrative law judge further finds no evidence presented by either respondent or the staff that the '789 patent discloses user-selectable criteria conditioned on the current status of the user on the computer network as required by claims 1, 28 and 38.

> The Claimed Phrase "a computer network access port used by the telephone
> network to access the data structure such that the telephone network has access to
> the one or more lists over the computer network access port. . ."

The claimed phrase in issue is found only in claim 1 of the '439 patent. Respondent argued that the Miner patent discloses that "[f]or each channel, there is a set of ports that can be attached to it. The ports, which are represented in software by port objects, refer to input/output devices supported on the interface cards. (RBr at 126 citing RFF V.C.4.26.)

Complainant argued that Miner does not "disclose the controller (i.e. electronic assistant) accessing anything contained with[in] the computer network via the computer network access port (i.e., software ports). (CBr at 156 citing CPFF 3088, Tr. at 1763-1764.)

The staff argued that Miner discloses this limitation. (SBr at 76-77.) Specifically, the staff argued that the controller, or electronic assistant, uses a port to retrieve the call-processing information from the database; which database is on the computer network. (SBr at 77.)

The limitation of claim 1 at issue requires a computer network access port that is used by the telephone network to access both the data structure and the one or more lists contained in the data structure. According to the explicit language of claim 1of the '439 patent, a computer network access port is something that links the telephone network and the computer network, which allows the telephone network to access information on the computer network. See JX-1 at 14:27-36; see also, JX-1 at 5:21-6:22. Claim 1 of the '439 patent also requires that the telephone network be able to access both the data structure and the one or more lists on the computer network through the computer network access port. The electronic assistant disclosed by the Miner patent is "a computer-based electronic assistant to receive and manage incoming calls to a subscriber." (RX-3 at 3:4-5.) Thus, assuming arguendo, that the electronic assistant disclosed by Miner is a controller and does access a data structure containing user-based criteria on a computer network via a computer network access port, the administrative law judge finds that neither respondent nor staff has shown that said controller is a portion of the telephone network, as required by the claims of the '439 patent. Hence, the administrative law judge finds that respondent has failed to prove, by clear and convincing evidence, that the '789 patent discloses this limitation.

Based on the foregoing, the administrative law judge finds that respondent has not established, by clear and convincing evidence, that each of asserted claims 1, 28 and 38 of the '439 patent is anticipated by the Miner patent.

B.   The Liffick '289 Patent

Respondent argued that each of the Chestnut patent and the Munday patent anticipates asserted claims 1 and 7 of the '289 patent. (RBr at 89-97.)

Complainant argued that respondent has not established, by clear and convincing evidence, that either the Chestnut patent or the Munday patent anticipates the asserted claims in issue of the '289 patent. (CBr at 157-63.)

The staff argued that the record does not contain clear and convincing evidence that asserted claims 1 and 7 of the '289 patent are invalid as anticipated by either the Chestnut patent or the Munday patent. (SBr at 78, 80.)

1.   Munday Patent

    a.   Claim 1

In the system of claim 1 of the '289 patent, the method therein has the following limitation: "at the computer network, receiving information from the telephone network that a first party from who a call is originating desires to establish telephone communication with a second party." (JX-2 at 18:44-47.) (Referred to by respondent as "Limitation B"). Respondent argued that the Munday Patent (U.S. Patent No. 6,480,593 B1 ('593 patent) (RX-187))[15] discloses Limitation B, citing RX-187 at 3:56-64, Figure 5; Hyde-Thomson Tr. at 1377:14-1378:9; Chang Tr. at 1901:15-1904:24.) (RFF IV.C2.14.)

The invention of the Munday patent (RX-187) relates to apparatus and methods for controlling communication networks and routing, which therefore and particularly, but not exclusively, can be employed to control call divert or data transfer in a communications network. (RX-187 at 1:7-10.)[16] The '593 patent at 3:56-64, cited by ALE, contains the subheading

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[15] The Munday patent derives from an application filed with the PCT on December 3, 1997, and is prior art to the '289 patent under at least 35 U.S.C. §§ 102(a) and 102(e). (RX-187).

[16] The Munday patent, as to initiating a call divert, states:

DETAILED DESCRIPTION OF THE INVENTION and states the following:

> According to FIG, 1, a scenario incorporating an embodiment of the present invention includes a local telephone 100 connected to a telephone network 130 via a wall socket 120. The configuration of the communications network 130 is not shown since it is not relevant tot he operation of the present invention. This representation of the network 130 is intended to` depict any type of communications network including, for example, a local, private, national, or even an international network, which provides a call divert facility. For the present embodiment, however, the network is assumed to be a PSTN. [BT public switched telephone network[17]]
>
> Also shown connected to the communications network 130 is a telephone 140, designated as a caller telephone, and a mobile telephone 150, designated as a remote telephone.
>
> Connected in parallel with the local telephone 100, to the wall socket 120, is a computer system 160. The computer system 160. The computer system 160 comprises the standard features of a computer 1621; a keyboard 162; a mouse 164; a VDU 166; and a modem 170 which connects the computer to the wall socket 120 and thus to the network 130. The computer to the wall socket 120 and thus to the network 130. The computer system 160 is, for example, an IBM-compatible Personal Computer (PC).
>
> The computer system 160 might alternatively initiate call divert via one or more other devices having a connection with the communication network. In this case the computer system 160 might not have its own direct communications network connection. The computer system 160 may be networked connection. The computer system 160 may be networked in a local area network

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> Process 8, for initiating call divert, will now be described with reference to FIG.4. According to FIG. 4, the process awaits a signal from process 7 to initiate call divert, in step 400. When a signal is received, the process issues a command, in step 410, to the modem 170 to seize the telephone line.

(RX-187 at 5-15.)

[17] See RX-187 at 1:17-18.

(LAN) and be connected to the communications network via, for example, a server which is connected by an appropriate means to the communications network.

The cited FIG. 5 is referenced in the following:

> FIG. 5 illustrative an alternative embodiment of the present invention. In FIG. 5, components which are equivalent to components shown in FIG. 1 are indicated by the same reference numeral increased by 400. The main difference between the embodiment in FIG. 1 and the embodiment in FIG. 5 is that the computer system 560 in FIG. 5 is connected, via a modem (not shown) to the Internet 535. Although the Internet 535 and the communications network 530 are represented as two separate networks, this representation is for the purposes of clarity only, the skilled person appreciating that an Internet connection, in practice, is usually made across a normal communications network. Also, whilst in this example the Internet is used, it is clear that other network types could be used. Again, however, the communications network in this embodiment is assumed to be a PSTN.

(RX-187 at 5:50-65.) The administrative law judge does not find Limitation B in RX-187 at 3:56-64 or in Figure 5.

Respondent, supra, relies on direct examination of respondent's expert Hyde-Thomson at 1377:14-1378:9:

> Q.   All right. Let's look at page 4 of RDX-13. Now, the first element we have there, claim 1, says: At the computer network, receiving information from the telephone network that a first party from whom a call is originating desires to establish telephone communication with a second party.
>
> Do you see that?
>
> A.   Yes.
>
> Q.   Do you believe that Munday discloses that element of the claim?

A.   Yes.

Q.   And why is that?

A.   Because that's obviously what's happening. When a call is initiated, information will be registered in the PSTN that a caller wishes to make a call to the second party. And this control system they're talking about will decide whether that should be put through to the local extension or to another extension, another phone number.

(emphasis added) However on cross examination he testified:

Q.   Now let's look at the next slide, which is page 4. You tell us Munday discloses forwarding a call request to the computer network; is that right?

A.   Yes.

Q.   And you point to figure 4, and you say, this is what shows us that the system is receiving a phone call, correct?

A.   Correct.

Q.   You have highlighted block 400 of figure 4, and you say that's the point where the system receives the phone call, correct?

A.   Correct.

Q.   In fact, sir, block 400 has nothing to do with receiving a phone call, correct?

A.   Fig 4 is how the system sets up the call divert, actually.

Q.   Quite specifically, the block 400 receive signal has nothing to do with receiving a phone call, correct?

A.   Correct.

Q.   So where you say Munday discloses forwarding a call request to the computer network, if it does that, it might be somewhere else, but it is not in figure 4, correct?

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A.   Correct.

Q.   What figure 4 does is it receives a signal from a timer process, correct?

A.   Yes. I mean, when it has detected lack of activity over a period of time, such as when the screen saver starts, it will receive a signal from the inference engine, whatever they call it, and sees the line and set up a call divert and drop the line, and vice versa when it detects a new activity, will go through a similar process to cancel the call.

Q.   And that received signal is just from like the computer equivalent of an egg timer, correct?

A.   Yes.

Q.   When the egg timer goes off, it generates that signal to the processor figure 4 saying, do your thing, correct?

A.   Yes. I mean, I think what it might be worth just stressing here is that if you need to monitor a computer's activity, there is a couple of different ways you can do it. One is that you can send a signal to the thing that's doing the monitoring, whenever that state changes. And the other way of doing it is that you can just kind of keep looking.

And when you are interested in knowing what the state of the computer is, you can go and look again. But you can implement well a system for monitoring a user's computer activity through these kind of effectively on/off switches, where this system Munday describes basically setting up call diverts and then when there is new activity, canceling the call divert.

So, you know, the telephony network is kept apprised all the time of what the state of Mr. Munday's PC is through this setup and strip down of the call.

Q.   So the way it works is when the egg timer goes off, block 400 receives a signal saying the egg timer has gone off, and it starts this process to adjust whatever it adjusts, correct?

A.   Yes.

Q.   So the one thing we're absolutely clear about, Mr.
Hyde-Thomson, is that the received signal block 400 does not at
any time receive information from the telephone network, such that
the first party from whom a call is originating desires to establish
telephone communication with a second party, correct?

A.   I agree that the diagram is not exactly relevant to the highlight
in this slide.

Q.   And, in fact, nothing in the Munday patent receives
information from the telephone network that a first party from
whom a call is originating desires to establish telephone
communication with a second party, correct?

A.   If the definition in the context here is that the computer
network is the local PC, I think I would concede that that is true,
that the local PC doesn't see any information about a new call
coming in.

The information needed to write the call is already in the
communications network through this process of setting up and
stripping down the call divert. I think in the other instance, where
he talks in figure 5 about the more elaborate system involving
computers on an extended Internet network, then I think you could
argue that one of these blocks that he talks about in figure 5 does
have knowledge of incoming calls and simultaneously knowledge
of the state of the user's PC.

(Tr. at 1680-84 (emphasis added).)

Respondent, supra, relies on the following testimony of complainant's expert Chang for

the disclosure of Limitation B in the '593 patent:

Q.   All right. So now once that, the computer becomes inactive
and it implements the automatic call divert procedure, correct, so
that computer then will communicate with the Internet 535, right?

A.   Which computer are you referring to?

Q.   Computer 560.

A.   Uh-huh.

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Q. So that will now communicate with the Internet there, 535, correct?

A. Correct.

Q. And there it will communicate to that, in our example, the numbers to which the call should be forwarded now, correct?

A. The computer 566 would notify, I guess in this case unit 580 and 590, which will in turn send the call divert command to the telephone network.

Q. It would send it via the Internet, correct?

A. It will send the command through box 590 to the telephone network.

Q. Okay. And that information, the forwarding information, will be stored as a data structure there somewhere. And what you are saying is the telephone network, correct?

A. You mean the forwarding structure as far as where the call is supposed to go, once the timer expires?

Q. Yes.

A. I believe that information is stored somewhere on the computer.

Q. Right. But once it is forwarded to the, what you say is the telephone network, then that information will be stored somewhere there, correct?

A. There is a command that's sent by box 590 to the telephone network to instruct the telephone network how to forward those calls.

Q. And it has to store that information somewhere, right? It is not a permanent event, correct?

A. I think that, yeah, telephone network has knowledge about where the call is supposed to go.

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Q. Okay. So then a call would come in and the call would come in and then the call would then be forwarded according to whatever number was the result of the call divert procedure, correct?

A. Correct.

Q. Okay. So your distinction then between Munday and the '289 patent is that you think the call forwarding information is not stored at the computer network, correct?

A. The call forwarding information for -- first of all, it is not clear to me from Mr. Hyde-Thomson's testimony where the call forwarding information will be stored in the first place. So that's the first area that I am not clear on.

Q. Okay. But in your example, what you are saying is that in the two -- with respect to the '289 patent, you believe that in Munday, there is no indication to the computer network about the incoming call; is that what you are saying?

A. What I was saying earlier is that incoming call, telephone call comes in, there was no access or no retrieval of any user-selectable rules on the computer network, and in order to determine how that call should be routed.

Q. Okay. And it is your belief that under the '289 patent, that that information must come from the computer network at the moment that the call comes in?

A. Which information?

Q. The information about where to route the call.

A. Information, the information on where to route the call is determined by the user-selectable criteria. So that information and those rules should be stored in the computer network in '289.

(Tr. at 1901-04 (emphasis added).) The administrative law judge does not find an admission in said testimony that Limitation B is disclosed in the Munday patent. Moreover there is the following testimony from complainant's expert as to processes 7 and 8 of the Munday patent:

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Q.   Can you explain to the Court what is shown here with respect to the process 7 and process 8 and the figures 3 and 4?

A.   Sure. On this slide, I am going to illustrate the fact that why Munday does not satisfy the claim limitation "receiving information from the telephone network" as required in the '289 claim. So at the bottom of the slide, figure 4, Mr. Hyde-Thomson pointed to figure 4, received signal, which is box 400 in figure 4 as receiving a signal from the telephone network.

He stated that that will be the condition, that will be the act necessary to satisfy the act of receiving information from the telephone network. Now, to the contrary, the signal that's referenced in figure 4, received signal, actually came from the process identified in figure 3, which is a timer process or what Mr. Cordell referred to as an egg timer this morning in his cross.

So what we have in front of us, in fact, is two computer process. The first process at the top is a timer process that executes in a computer when the timer expires.

It sends a signal to a second process on the computer, and the same computer, and the process identified in figure 4, once they receive that timer expiration signal, initiates a call divert, what we call forward to the telephone network.

So there is nothing here that indicated that this satisfies the requirement of receiving information from the telephone network.

(Tr. at 1786-88 (emphasis added).)

Respondent also make reference to RDX-13 at 7; RX-187, fig. 4, col. 5:1-18 with respect to claim 1 of the '289 patent as well as claim 7 of said patent. Respondent's expert however agreed on cross-examination that this citation was in error and testified that in the Munday patent, where the computer network is a local PC, the computer clearly does not receive any information about an incoming call. See supra.

Based on the foregoing the administrative law judge finds that ALE has not established,

by clear and convincing evidence, that Limitation B, viz. whether the call routing procedure takes place entirely on the telephone network (i.e., whether the computer network receives any information about the incoming call), is necessarily present in the Munday patent and that it would be so recognized by a person of ordinary skill at the time of filing of the '289 patent.

In the system of claim 1 of the '289 patent the method therein, in addition, provides: "at the computer network, storing a set of pre-determined rules for determining when the second party is available to take a call from the first party," (JX-2 at 18:52-54) which respondent has characterized as "Limitation D." Respondent argued that the Munday patent discloses Limitation D of claim 1, citing RX-187 at abstract, 7:34-41; Hyde-Thomson Tr. at 1382:7-1383:9; Chang Tr. at 1901:15-1902:21.[18]) (RFF IV. C. 2. 27.) The abstract of the Munday patent cited by respondent merely states:

> In a communications network (130), call divert, for calls directed
> to a local telephone (100), from the local telephone (100) to a
> remote telephone (150) is initiated by a computer system (160)
> after the user has had no interaction with the computer system for a
> predetermined period of time. Thus, a user need not remember to
> initialize call divert manually before leaving the vicinity of the
> local telephone (100)

(RX-187, cover page.) Munday at 7:34-41 also cited by respondent states:

> A simplified divert procedure can also be used such that more
> complex arrangements (such as time of day, day of week
> dependent duration) can be effected. In such cases, a predetermined
> control signal from the telephone or connected computer or
> detected system may be transmitted to control means of the
> network, the network effecting call diversion in accordance with
> pre-programmed arrangements.

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[18] The Chang testimony cited here overlaps with the Chang testimony cited for Limitation B. See supra (RFF VI.C.214).

The administrative law judge does not find Limitation D in said portions of the Munday patent.

The testimony of respondent's expert Hyde-Thomson, cited by respondent supra, reads:

> Q. All right. Let's go to RDX-13, page 9. It says: At the computer network, storing a set of predetermined rules for determining when the second party is available to take a call from the first party.
>
> Do you see that?
>
> A. Yes.
>
> Q. Do you believe that element is disclosed by the Munday patent?
>
> A. Yes. Because you can have a simple rule which just says, divert to this number when I'm not there or -- but it also, in the Munday patent, talks about, on the right-hand side here, a more sophisticated type of capability. And he says: A simplified divert procedure can also be used such that more complex arrangements (such as time of day, day of week, dependent duration) can be effected.
>
> So this implies that there are -- there's an ability to set up some rules on how calls will be diverted, different numbers that it will be diverted to based on time of day, day of week and that kind of thing.
>
> Q. And is that something that a person of ordinary skill in the art would understand from reading this?
>
> A. Yes. Yes. It's implicit in saying that these complex arrangements can be effected.

The administrative law judge finds that such testimony on its face, having the word "implies"

indicates that Limitation D is necessarily present. The Chang testimony cited by ALE was cited

by ALE for Limitation B. See supra. Moreover, the administrative law judge finds that Chang in

said testimony, supra, is merely referring to the forwarding information, once the time expires, as

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stored somewhere on the computer. Significantly Chang also testified:

> Q. Can you describe for the Court what you have shown on CDX-269.
>
> A. On CDX-269, I have reproduced figure 1from the Munday patent. And this also was referenced in RDX-13, page 2. And here I think Mr. Hyde-Thomson attempted to describe what he considered to be a telephone network and the computer network, and that those were highlighted. And I believe he pointed to the computer 162 as the computer network, and he pointed to two telephones, 100, and 140 as the telephone network. And those are also highlighted.
>
> The problem with this scenario is that I was unable to identify where the set of predetermined rules could be stored on the system. It wasn't very explicit, in Mr. Hyde-Thomson's testimony, and I just wasn't able to figure out how that would work.
>
> Q. <u>Can such rules be stored on a PBX,[19] for example</u>?
>
> A. <u>Absolutely, absolutely</u>.

(Tr. at 1789-90 (emphasis added).)

Based on the foregoing, the administrative law judge finds that Respondent has not met its burden in establishing that Limitation D is necessarily present in the Munday patent and that it would be so recognized by a person of ordinary skill at the time of the filing of the '289 patent.

The method in the system of claim 1 of the '289 patent also provides: "at the computer network, using the set of a pre-determined rules to process i) the information received from the telephone network regarding the call being originated by the first party, and ii) information regarding the monitored activity of the user computer of the second party, to determine when the second party is available to take the call originated by the first party." (JX-2 at 18:55-61.) ALE

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[19] A PBX is a telephone switching system that is usually privately controlled by a business and is also a combination of hardware and software. <u>See</u> Section IV, <u>supra</u>.

has referred to this limitation as "Limitation E." (RFF IV.C.2.31) ALE argued that its expert Hyde-Thomson explained that the Munday patent discloses "Limitation E" in the following testimony:

> Q. Now, let's look at RDX-13, page 10. Here element: At the computer network, using the set of a predetermined rules to process the information received from the telephone network regarding the call being originated by the first party, and, two, information regarding the monitored activity of the user computer of the second party, to determine when the second party is available to take the call originated by the first party.
>
> Do you have an opinion as to whether that element is met by the Munday reference?
>
> A. Yes. Yes. And yes, it is.
>
> Q. And what's the basis for that?
>
> A. Well, he describes the process of how the routing of calls will be changed based on the activity that's being monitored on the computer or, you know, the mouse movements and things. And when there is mouse movements for a period of time after the last mouse movement or keyboard stroke, there will -- calls will be put through to one number. And after that time, time out, it will go to another number, diverted to another number.
>
> And come back to the first number when there is any renewal of activity.
>
> So he describes the whole process and it's, you know, including the special codes that you would use in the British telecom system for setting up call diverts.
>
> Q. For setting up what was that?
>
> A. Call diverts. You can set up a call divert by putting in something like star 21 star and then the number you want to divert your phone to.
>
> Q. And how is it that you believe that the Munday reference

> discloses using the monitored activity of the user computer to determine that the party is available to take the call?
>
> A.   Yes. Because as soon as some new activity is detected, it is deduced that the user is back at his computer. And under the Munday system, a cancel call divert instruction is given to the network so that calls will now be routed to the desktop phone associated with the computer.

(Tr. at 1383-1385) (RFF IV.C.2.37) The administrative law judge does not find that said

testimony establishes that Limitation E is necessarily present in the Munday patent. Moreover

the phrase "information received from the telephone network regarding the call being originated

by the first party" recited in Limitation E refers back to Limitation B. (JX-2 (col. 18:36-65)) and

the phrase "set of pre-determined rules" recited in Limitation E refers back to the "set of pre-

determined rules" recited in Limitation D. (JX-2 (col, 18:36-56).) The administrative law judge

has found that Limitation B and D are not necessarily found in the Munday patent. See supra.

Based on the foregoing, the administrative law judge finds that Respondent has not

established, by clear and convincing evidence that Limitation E would necessarily be found in the

Munday patent by a person of ordinary skill at the time of filing of the '289 patent.

Claim 1 of the '289 patent further provides: "using the information processed at the

computer network to facilitate connecting the call originated by the first party through the

telephone network to the secondary party." (JX-2 at 18:62-65.) Respondent has referred to this

limitation as "Limitation F" (RFF IV.C.2.41.) The phrase "information processed at the

computer network" recited in Limitation F refers back in part to "information received from the

telephone network" referenced in Limitations B and E. (JX-2 (col. 18:36-55).) The

administrative law judge has found that Limitations B and E are not necessarily found in the

Munday patent. See supra. Hence, he finds that respondent has not established, by clear and convincing evidence, that Limitation F is necessarily found in the Munday patent.

Based on the foregoing the administrative law judge finds that ALE has not established, by clear and convincing evidence, that claim 1 of the '289 patent is anticipated by the Munday patent.

b.   Claim 7

In the system of claim 7 of the '289 patent the method therein provides: "at the computer network, receiving information from the telephone network that a first party from whom a call is originating desires to establish telephone communication with a second party." (JX-2 at 19:32-35). (Referred to by ALE as "Limitation D") (RFF IV.C.2.61) ALE argued that the Munday patent discloses limitation D of claim 7, citing RX-187 at col. 3:56-64, Figure 5; Hyde-Thomson Tr. at 1377:14-1378:9; Chang Tr. at 1901:15-1904:24.)[20] (RFF IV.C.2.62.)

The Munday patent at 3:56-44, cited by respondent reads:

> The computer system 160 might alternatively initiate call divert via one or more other devices having a connection with the communication network. In this case the computer system 160 might not have its own direct communications network connection. The computer system 160 may be networked in a local area network (LAN) and be connected to the communications network via, for example, a server which is connected by an appropriate means to the communications network.

As with Limitation B of claim 1 of the '289 patent, the administrative law judge finds that Limitation D of claim 7 of the '289 patent has not been established by ALE to be necessarily present in the Munday patent and that it would be so recognized by a person of ordinary skill in

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[20] The same citations were cited by ALE with reference to Limitation B of claim 1 of the '289 patent and are set forth supra. See RFF IV.C. 2.14.

the art at the time of filing of the '289 patent.

In the system of claim 7 of the Munday patent the method therein also provides: "at the computer network, storing a set of predetermined rules for determining when the second party is available to take a call from the first party." (JX-2 at 19:39-41.) (Referred to by ALE as "Limitation F"). ALE argued that at the hearing, its expert Hyde-Thomson explained that a person of ordinary skill in the art would understand that the Munday patent discloses Limitation F. (Tr. at 1382:7-1383:9.) (RFF IV.C.2.75) Hyde-Thomson however admitted that Munday does not expressly disclose Limitation F:

> Q. Do you believe that element [Limitation F] is disclosed by the Munday patent?
>
> A. Yes. Because you can have a simple rule which just says, divert to this number when I'm not there or -- but it also, in the Munday patent, talks about, on the right-hand side here, a more sophisticated type of capability. And he says: A simplified divert procedure can also be used such that more complex arrangements (such as time of day, day of week, dependent duration) can be effected.
>
> So this implies that there are -- there's an ability to set up some rules on how calls will be diverted, different numbers that it will be diverted to based on time of day, day of week and that kind of thing.
>
> Q. And is that something that a person of ordinary skill in the art would understand from reading this?
>
> A. Yes. Yes. It's implicit in saying that these complex arrangements can be effected.

(Tr. at 1382:14-1383:9 (emphases added).)

Based on the foregoing, the administrative law judge finds that Limitations F is not necessarily found in the Munday patent.

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In the system of claim 7 of the '289 patent the method further therein provides:

> "at the computer network, using the set of predetermined rules to
> process I) the information received from the telephone network
> regarding the call being originated by the first party, and ii)
> information regarding the monitored activity of the user computer
> of the second party, to determine when the second party is
> available to take the call originated by the first party." (JX-2 at.
> 42-48).

(Referred to by ALE as "Limitation G") The phrase "information received from the telephone network regarding the call being originated by the first party" recited in limitation G refers back to limitation D. (JX-2 (col. 18:36-65).) The administrative law judge has found that Limitation D is not necessarily found in the Munday patent. Hence he finds that ALE has not established, by clear and convincing evidence that said Limitation G is necessarily found in the Munday patent.

Based on the foregoing, the administrative law judge finds that ALE has not established, by clear and convincing evidence, that claim 7 of the '289 patent is anticipated by the Munday patent.

2.   Chestnut Patent

a.   Claims 1 And 7 Of The '289 Patent

Respondent argued that asserted claims 1 and 7 of the '289 patent recite "monitoring activity of a user computer connected to the computer network and associated with the second party;" that Microsoft construes this limitation to mean monitoring the status of a user computer connected to the computer network and associated with second party; and that the Chestnut patent discloses this limitation under Microsoft's construction because the Chestnut patent monitors whether and from where the user's computer is logged onto the computer network to

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determine where to forward a telephone call. (RBr at 89.)

Each of complainant and the staff has argued that respondent has not established, by clear and convincing evidence, that the Chestnut patent anticipates the asserted claims 1 and 7 of the '289 patent.

The administrative law judge in Section VI.A.1 supra has rejected complainant's proposed construction for "monitoring activity of a user computer connected to the computer network" and has found that it means determining whether the user computer is "active or idle."

The Chestnut patent relates to a telecommute server that "closely integrates a company's LAN with its telephone network and controls call forwarding based upon user activity on an associated computer terminal." (RX-1 at 2:25-28, 1:6-9.) It discloses that the telecommute server can forward telephone calls "based upon the device used to log onto the computer network by the called party." (RX-1 at Abstract.) In particular, the Chestnut patent discloses that call forwarding can be based on "the called party's current or most recent network logon device." (RX-1 at 7:2-3.) Significantly the Chestnut patent discloses routing calls based on whether the user is logged in. Thus it states under "SUMMARY OF THE INVENTION:

> Call forwarding based on computer logon may be further scheduled so that calls are forwarded to different telephone lines associated with telephones or voice messaging systems depending upon a predefined schedule. Alternatively, call forwarding may be made conditional based upon other information received by the telephone system, such as caller ID or ANI. The system can also be set up to alter the schedule if it detects that the called party is logged onto a terminal associated with a different telephone extension than the one defined in the schedule.

(RX-1 at 2:52-61 (emphasis added).) Later on under DETAILED DESCRIPTION OF THE INVENTION, it states:

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> When an outside caller 30 places a call on the PSTN 6 the call is directed to the called party office extension 10 by the private branch exchange 4. Before the PBX sends the call to the called party office extension 10, the telecommute server 2 checks the computer network 8 to see if the called party is logged on. If the called party is logged on, the telecommute server 2 instructs the private branch exchange 4 to forward the call to the telephone extension associated with the device the called party has used to log onto the computer network 8.

(RX-1 at 4: 48-51 (emphasis added).) The administrative law judge finds that being logged in is not the same thing as being active or idle. Rather, a user who is logged in can be either active or idle, as disclosed by the specification of the '239 patent:

> The computer operating system, such as the Windows® operating system, is capable of monitoring user activity on the computer. For example, the operating system on the callee computer 154 can detect user activity on the keyboard 154 a or the mouse 154 b . By monitoring this activity, the operating system can determine the user's status and activate certain software programs, such as a screen saver, when no user activity has been detected for a certain period of time. Under these circumstances, the operating system may determine that the callee computer 154 has entered an "idle" state.

(JX-2 at 14:37-43 (emphasis added).) Thus, the specification discloses a user who has logged into the computer and then ceased using the computer without specifically logging out; that is, has become "idle" while still being logged into the computer.

Based on the foregoing, the administrative law judge finds that respondent has not established, by clear and convincing evidence, that asserted claims 1 and 7 are anticipated by the Chestnut patent.

C.   The O'Neal '064 And '357 Patents

1.   Swartz Or Nagai Patents

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Respondent argued that if both the GUI and TUI limitations are construed as Microsoft contends, then all the asserted claims of the O'Neal '064 and '357 patents are invalid on the ground that a Swartz patent (U.S. Patent No. 6,445,694) (RX-5)[21] or the Nagai patent (U.S. Patent No. 6,636,587 (RX-4)[22] anticipates said claims. (RBr at 55-68.)

Complainant argued that ALE's anticipation defense fails because it does not clearly and convincingly demonstrate that each limitation of any of the asserted claims of the O'Neal patents is present in either the Swartz or Nagai patents. (CBr at 163.)

The staff argued that under the "correct" construction of the GUI and TUI limitations, neither the Swartz patent nor the Nagai patent anticipates the asserted claims of the O'Neal patents. (SBr at 82, 85.)

The administrative law judge has interpreted the claim phrase "generate [or generating] a single graphical menu for displaying said communication options for each of said communication services at the same time" (the GUI limitation), which is present in each of the asserted claims of the O'Neal patents, as "generate, or generating, one graphical menu for displaying all of the communication options for all of the plurality of communication services" See Section VI.B.1, supra.

The administrative law judge finds that the graphical user interface disclosed by Swartz is not "one graphical menu" but rather is hierarchical in nature and requires the use of multiple screens to change options. See RX-5, Figs. 2-11. Also, the Nagai patent is found to disclose not

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[21] The Schwartz patent derives from an application filed on Marcy 2, 1998 and is therefore prior art to the O'Neal patents under at least 35 U.S.C. § 102(e)(2).

[22] The Nagai patent derives from an application filed on June 24, 1998 and is therefore prior art to the O'Neal patents under at least 35 U.S.C. § 102(e)(2).

"one graphical menu" but the use of multiple menus to change options. See RX-4, Figs. 5, 6.

Based on the foregoing the administrative law judge finds that respondent has not established, by clear and convincing evidence, that the asserted claims of the O'Neal patents are anticipated by either the Swartz or the Nagai patents.

VIII.   Infringement

The unfair acts covered under Section 337 include "all forms of infringement, including direct, contributory, and induced infringement." Certain Home Vacuum Packaging Machines, Inv. No. 337-TA-496, Order No. 44, 2004 ITC LEXIS 202 * 2 n.2 (March 3, 2004). To establish infringement, there must be a preponderance of evidence. See Kao Corp. v. Unilever United States, Inc, 441 F.3rd 963 (Fed. Cir. 2006). A determination of patent infringement encompasses a two-step analysis. Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems, Inc., 261 F.3d 1329, 1336 (Fed. Cir. 2001) (Scimed). First, the court determines the scope and meaning of the patent claims asserted, and then properly construed claims are compared to the allegedly infringing device. Id. "Literal infringement of a claim exists when each of the claim limitations reads on, or in other words is found in, the accused device." Allen Engineering Corp. v. Bartell Indus., 299 F.3d 1336, 1345 (Fed. Cir. 2002).

Under the doctrine of equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is equivalence between the elements of the accused product or process and the claimed elements of the patented invention." Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 21 (1997). Equivalency may be determined using the "triple identity test" and thus "focusing on the function served by a particular claim element, the way that element serves that function, and the

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result . . . obtained by that element . . . ." Id. at 39. Regardless of the linguistic framework of the test used, the "essentially inquiry" is: "[d]oes the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" Id. at 40.

Direct infringement includes the making, using, selling, offering for sale and importing into the United States an infringing product, without authority. 35 U.S.C. § 271(a). To prove direct infringement, the plaintiff must establish by a preponderance of the evidence that one or more claims of the patent read on the accused device either literally or under the doctrine of equivalents. Scimed, 261 F.3d at 1336.

A person may also infringe a patent claim indirectly. Section 271 (b) of the Patent Act provides that "[w]hoever actively induces infringement of a patent shall be liable as an infringer." To establish liability for induced infringement, "a patent holder must prove that once the defendants knew of the patent, they actively and knowingly aided and abetted another's direct infringement." DSU Med. Corp. v. JMS Co., 471 F.3d 1293, 1305 (Fed. Cir. 2006) (DSU Med. Corp.) (citations omitted). However, "[t]he mere knowledge of possible infringement by others does not amount to inducement; specific intent and action to induce infringement must be proven." Id.

Additionally, 35 U.S.C. § 271(c) provides that:

> [w]hoever offers to sell or sells within the United States . . . a component of a patented machine, manufacture, combination or composition . . . constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article of commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

Thus, "[i]n order to succeed on a claim of contributory infringement, in addition to proving an

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act of direct infringement, plaintiff must show that defendant knew that the combination for which its components were especially made was both patented and infringing, and that defendant's components have no substantial non-infringing uses." Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc., 424 F.3d 1293, 1312 (Fed. Cir. 2005).

Direct infringement is a necessary element of induced and contributory infringement. DSU Med. Corp., 471 F.3d at 1303.

A.   Accused Products

Complainant has put in issue for the infringement analysis two of respondent's communication systems. (CBr at 24.) The first system that complainant identifies, the OmniPCX Enterprise ("OXE") System, includes 1) OmniPCX Enterprise communication server (the "OXE" IP-PBX), 2) OmniTouch Unified Communication software suite ("OTUC"), 3) 4980 softphone application ("My Softphone"), and 4) OTUC server(s). (CPFF 215.) Complainant argued that the accused OXE System is a combination of individual ALE products, designed and sold together as unified communication solutions. (CRRFF I.D.1.1-A.) The second system that complainant identifies includes the OmniPCX Office IP-PBX ("OXO") and the PIMPhony software ("PIMPhony") that runs and operates on a personal computer. (CPFF 216.) Complainant alleged that these systems infringe the asserted patents under both direct and indirect theories of infringement. (CBr at 24-27.) All parties agree that the accused OXO System consists of the ALE OmniPCX Office IP-PBX ("OXO") and the PIMPhony software ("PIMPhony") that runs and operates on a personal computer. (CFF 216 (undisputed).)

B.   The Liffick Patents

Complainant accuses each of the OXO and OXE Systems of infringing claims 1, 28, and

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38 of the '439 patent and claims 1 and 7 of the '289 patent.

1.   The '439 Patent

a.   Claim 1

The Claimed Phrase, "In an environment where subscribers call a user over a telephone network, wherein a user telephone is coupled with the telephone network . . ."

OXE System

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Complainant further argued that respondent does not dispute that the accused products meet this limitation. (CBr at 55; CPFF 1066 (undisputed in relevant part).)

Respondent does not dispute that the accused OXE system meets this limitation. (CPFF 1066 (undisputed in relevant part).)

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} The staff also argued that complainant "has established a prima facie case that the elements of claim 1 are present in the accused OXE system." (SBr at 51.)

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} In the claims of the '439 patent, the term "user" refers to a called party. (CPFF 1059 (undisputed).) In CDX-38, complainant's expert Chang highlights a caller who is connected to the PSTN and is

about to make a call to a user in the OXE System. (CPFF 1054 (undisputed).) CDX-39 shows a user who is sitting at his computer or PC 1. (CPFF 1060 (undisputed).) The user shown on CDX-39 is the destination of the incoming call. (CPFF 1061 (undisputed).) The red arrows on CDX-39 show the direction of the call from the caller. (CPFF 1063 (undisputed).) Thus, the administrative law judge finds that CDX-38 and CDX-39 demonstrate that the accused OXE system practices this element of claim 1 of the '439 patent. Furthermore, respondent does not dispute that the accused OXE system practices this element. (CPFF 1066 (undisputed in relevant part).)

Based on the foregoing, the administrative law judge finds that complainant has established that the accused OXE system products meet this limitation of claim 1 of the '439 patent.

OXO System

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} Complainant further argued that respondent does not dispute that the accused OXO system products meet this limitation. (CBr at 85.)

Respondent did not dispute that this limitation is met by the accused OXO system products. (CPFF 1662 (undisputed).)

The staff does not dispute that the accused OXO system products meet this limitation. (CPFF 1647 (undisputed by the staff).)

The administrative law judge agrees with complainant. Thus, he finds that complainant

has established that the complainant has established that the accused OXO system products meet

this limitation of claim 1 of the '439 patent.

> The Claimed Phrase, "a system for processing an incoming call from a subscriber
> to a user in the telephone network according to user specifications, the system
> comprising . . ."

OXE System

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} Respondent, however, does not dispute that the OXE system practices this element of

claim 1 of the '439 patent. (CPFF 1076 (undisputed in relevant part).)

The staff argued that complainant "has established a _prima facie_ case that the elements of

claim 1 are present in the accused OXE system." (SBr at 51.)

The administrative law judge finds that CX-606 shows that respondent advertises the

accused product as an integrated product. (CX-606.){

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Furthermore, respondent does not dispute that the accused OXE system practices this element.

(CPFF 1076 (undisputed in relevant part).)

Based on the foregoing, the administrative law judge finds that complainant has

established that the accused OXE system products meet this limitation of claim 1 of the '439

patent.

OXO System

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} Complainant further argued that respondent

does not dispute that the accused OXO system products meet this limitation. (CBr at 85-86.)

Respondent does not dispute that the accused OXO system products meet this limitation.

(CPFF 1698 (undisputed in relevant part).)

The staff does not dispute that the OXO system meets this limitation. (CPFF 1664

(undisputed by the staff).)

The administrative law judge agrees with complainant. Thus, he finds that complainant

has established that the accused OXO system products meet this limitation of claim 1 of the '439

patent.

> The Claimed Phrase, "a data structure contained within a computer network to
> store user-selectable criteria for call processing, wherein the data structure stores
> the user-selectable criteria in one or more lists that are used in filtering an
> incoming call and . . ."

OXE System

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} Respondent

did not, however, dispute that the OXE system meets this limitation in any configuration. (CPFF

1227 (undisputed in relevant part).)

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The staff argued that complainant "has established a <u>prima facie</u> case that the elements of claim 1 are present in the accused OXE system." (SBr at 51.)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that this claim limitation is satisfied.

OXO System

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} Complainant further argued that respondent did not dispute that the accused OXO system products meet this limitation. (CBr at 88.)

Respondent does not dispute that the accused OXO system products meet this limitation. (CPFF 1728 (undisputed in relevant part).)

The staff did not dispute that this limitation is met by the accused OXO system products. (CPFF 1699 (undisputed by the staff).)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that this limitation of claim 1 of the '439 patent is met by the accused OXO system products.

> The Claimed Phrase, "wherein some of the one or more lists are used to filter the incoming call according to current activity of subscribers on the computer network or according to current activity of the user on the computer network . . ."

OXE System

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Respondent argued that the accused products do not infringe the '439 patent because they process calls according to whether a user's phone is in use, not according to a user's status on a computer network. (RBr at 105.)

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The parties agreed that this claim element should be construed as "wherein some of the one or more lists are used to filter the incoming call according to current status of subscribers on the computer network or according to current status of the user on the computer network." (RBr at 105; CRRFF V.B.5.5-B; SBr at 51-52.) The parties also agreed that "[i]n the claims of the '439 patent, the term 'user' refers to a called party." (CPFF 1059 (undisputed).) The parties further agreed that the term "subscriber" in the '439 patent refers to a caller. (CPFF 1052 (undisputed).) {

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In your opinion, does the OXE system meet this claim limitation?

A.   Yes, it does.

Q.   And can you please explain the basis for your opinion.

A.   Sure. We are looking at CDX-161. And what I have done here is I displayed a screen capture of the OXE system that I tested over at Fish & Richardson's office here in D.C.

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CHECK INTERPRETER: Slight correction from the check interpreter. In the same way it recognizes the busy status of a traditional phone.

THE INTERPRETER: That's fine.

JUDGE LUCKERN: Would the witness agree with that? You can ask him. Is that okay?

THE WITNESS: Yes, that's fine.

BY MR. COLAIANNI:

Q. So being engaged on a voice over IP call constitutes a busy state of the user, correct?

A. It is correct, I will precise that it is a state of -- it is -- but it is a status of busy telephone.

(Tr. at 499-500, 597-599, 1102-1105 (emphasis added).) {

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} The administrative law judge finds that the specification of the '439 patent

specifically discloses, <u>inter</u> <u>alia</u>, several of the statuses described in the transcript excerpts, <u>supra</u>:

> The user (i.e., the called party) can specify user-selectable call
> processing criteria for all incoming calls, incoming calls from
> selected callers, and may further apply conditional criteria based on
> user preferences. For example, the user may select all calls during
> certain times of the day, calls from selected parties during other
> specified times of the day, and no calls during other times of the
> day. The user-selectable call processing criteria may be readily

edited by the user and may be applied to multiple phone numbers associated with a particular caller.

(JX-1 at 1:65-2:7.) Thus, the user assigns a "status" to various subscribers. Likewise, FIG. 8 of the '439 patent discloses a flow chart showing how several "lists" of callers are checked in order to properly route a call; said lists are further described in the specification. (See JX-1 at FIG.8; JX-1 at 7:57-8:34; see also JX-1 at 9:7-24, 9:45-55, 11:57-12:5, 13:41-52.)

Based on the foregoing, the administrative law judge finds that complainant has established that the OXE accused system meets this element of claim 1 of the '439 patent.

OXO System

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} Specifically, complainant argued that the routing of an incoming call based on detecting the software activity on the user computer resulting from a VoIP communication meets this claim limitation. (CBr at 88-89.)

Respondent argued that "the same issues set forth above with respect to the accused OXE system apply to the accused OXO system. (RBr at 113.) Specifically, respondent argued that the accused OXO product does not route or process calls based upon any user computer or user computer network activity. (RRCPFF 1729.B.)

The staff argued that:

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The parties agreed that this claim element should be construed as "wherein some of the one or more lists are used to filter the incoming call according to current status of subscribers on the computer network or according to current status of the user on the computer network." (RBr at 105; CRRFF V.B.5.5-B; SBr at 51-52.) Thus, as found regarding the accused OXE system products, supra, when a user sets a status of "do not disturb," said limitation is met because the call is routed according to that user status. Yet, complainant has argued for the accused OXO system products that the activity of the user's computer, for example a VoIP telephone call, would be sufficient to meet this claim limitation. The administrative law judge does not agree with complainant. Thus, for this claim limitation, he finds that showing that there is user activity is not sufficient. He further finds that complainant must also show that the accused product uses the current user status to filter incoming calls. Likewise, setting the status of a subscriber to allow said subscriber to bypass the "do not disturb" status of the user would also be sufficient to meet this claim limitation because of the disjunctive "or." {   }

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} Thus, the administrative law judge finds that complainant has not

established that the accused OXO system products meet this limitation of claim 1 of the '439

patent.

> The Claimed Phrase "a computer network access port used by the telephone network to access the data structure such that the telephone network has access to the one or more lists over the computer network access port . . ."

OXE System

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Respondent does not dispute that the OXE system meets this limitation. (CPF 1301

(undisputed in relevant part).)

The staff argued that complainant "has established a prima facie case that the elements of

claim 1 are present in the accused OXE system." (SBr at 51.)

The administrative law judge agrees with complainant. Thus, he finds that complainant

has established that the accused OXE system practices this element of claim 1 of the '439 patent.

OXO System

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} Complainant further argued that respondent does not dispute that the accused

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OXO system products meet this limitation. (CBr at 90.)

Respondent does not dispute that the accused OXO system products meet this limitation. (CPFF 1763 (undisputed in relevant part).)

The staff did not dispute that the accused OXO system products meet this limitation. (CPFF 1750 (undisputed by staff).)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXO system practices this element of claim 1 of the '439 patent.

> The Claimed Phrase "and a controller to receive the incoming call designated for the user telephone and to process the incoming call in accordance with the user-selectable criteria, the controller accessing the user-selectable criteria in the one or more lists of the data structure via the computer network access port and thereby applying the user-selectable criteria to the incoming call."

OXE System

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Respondent does not dispute that the OXE system meets this limitation. (CPFF 1314 (undisputed in relevant part).)

The staff argued that complainant "has established a prima facie case that the elements of claim 1 are present in the accused OXE system." (SBr at 51.)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXE system products meet this limitation of claim 1of the '439

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patent.

OXO System

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Respondent does not dispute that the accused OXO system products meet this claim limitation. (CPFF 1775 (undisputed in relevant part).)

The staff does not dispute that the accused OXO system products meet this claim limitation. (CPFF 1764 (undisputed by staff).)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXO system products meet this limitation of claim 1 of the '439 patent.

Based on the foregoing, the administrative law judge finds that the accused OXE system products infringe claim 1 of the '439 patent, while the accused OXO system products do not infringe claim 1 of the '439 patent.

b.   Claim 28

The Claimed Phrase "In a system where subscribers call a user over a telephone network, wherein a user telephone is coupled with the telephone network . . ."

OXE System

Complainant argued that this limitation is substantially similar to a limitation of claim 1

of the '439 patent, except that claim 28 is a computer product claim rather than a method claim. (CBr at 67-68; CPFF 1321 (undisputed); CPFF 1319.) Complainant therefore relies on its argument for that limitation of claim 1. (CBr at 67-68.)

Respondent argued that claim 1 recites a system with a telephone network and a computer network, but does not require that these two networks be independent, citing to JX-1 at col. 14:13-37. (RRCPFF 1319.A.) Respondent further argued that since the term "independent" does not appear in claim 1, it must be given meaning in claims 28 and 38. (See RFF V.A.2.1-2.5.)

The staff argued that the only limitation that respondent argued regarding claim 28 of the '439 patent is the "independent of the telephone network" limitation, and that the accused OXE system products meet that limitation. (SBr at 22-23.)

There is only a one word difference between the first elements of claim 1 and claim 28 of the '439 patent, i.e., the term "environment" of claim 1 is replaced in claim 28 by the term "system." (See JX-1 at 14:13; JX-1 at 16:53.) The claim phrase "independent of the telephone network" does not appear in this claim phrase. Thus, respondent has not rebutted complainant's argument that this claim limitation is substantially similar to the claim limitation of claim 1. Moreover, the administrative law judge finds no substantial difference between the claim terms "environment" and "system" in the context of the claims. Hence, the administrative law judge finds that complainant has established that the accused OXE system products meet this limitation of claim 28 of the '439 patent.

OXO System

Complainant argued that this limitation is similar to the first limitation of claim 1 of the '439 patent. (CBr at 91.) Complainant further argued that respondent does not dispute that the

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accused OXO system products meet this limitation. (CBr at 91.)

Respondent does not dispute that the accused OXO system products meet this claim limitation. (CPFF 1790 (undisputed in relevant part).)

The staff argued that the analysis for infringement of claim 28 is substantially the same as for claim 1. (SBr at 53.) The staff does not dispute that the accused OXO system products meet this claim limitation. (CPFF 1787 (undisputed by staff).)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXO system products meet this limitation of claim 28 of the '439 patent.

> The Claimed Phrase "a computer program product for implementing a method for processing a call from a subscriber to a user over a telephone network, the computer program product comprising: a computer readable medium having computer executable instructions for performing the method, the method comprising: . . ."

OXE System

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Respondent does not dispute that the accused OXE system products meet this limitation. (CPFF 1339 (undisputed in relevant part).)

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The staff argued that the only limitation that respondent argued regarding claim 28 of the '439 patent is the "independent of the telephone network" limitation, and that the accused OXE system products meet that limitation. (SBr at 22-23.)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXE system products meet this limitation of claim 28 of the '439 patent.

OXO System

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Respondent does not dispute that the accused OXO system products meet this limitation. (CPFF 1800 (undisputed in relevant part).)

The staff argued that the analysis for infringement of claim 28 is substantially the same as for claim 1. (SBr at 53.) The staff did not dispute that the accused OXO products meet this limitation. (CPFF 1792 (undisputed by staff).)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXO system products meet this limitation.

The Claimed Phrase "accepting an incoming call designated for the user telephone . . ."

OXE System

Complainant argued that this limitation of claim 28 is similar to the sixth limitation of claim 1. (CBr at 69.) Thus, complainant argued that the accused OXE system products meet this

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limitation for the same reasons that the accused OXE system products meet the sixth limitation of claim 1. (CBr at 69.)

Respondent does not dispute that the OXE system accused products practice this limitation. (CPFF 1346 (undisputed in relevant part).)

The staff argued that the only limitation that respondent argued regarding claim 28 of the '439 patent is the "independent of the telephone network" limitation, and that the accused OXE system products meet that limitation. (SBr at 22-23.)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXE system products meet this limitation of claim 28 of the '439 patent.

OXO System

Complainant argued that this limitation is similar to the sixth limitation of claim 1 of the '439 patent, and that the accused OXO system meets this limitation for the same reasoning. (CBr at 92.) Complainant further argued that respondent does not dispute that the accused OXO system products meet this limitation. (CBr at 92.)

Respondent does not dispute that the accused OXO system products meet this limitation. (CPFF 1806 (undisputed in relevant part).)

The staff argued that the analysis for infringement of claim 28 is substantially the same as for claim 1. (SBr at 53.) The staff does not dispute that the accused OXO system products meet this limitation. (CPFF 1803 (undisputed by staff).)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXO system products meet this limitation.

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The Claimed Phrase "accessing a data structure contained within a computer network that is independent of the telephone network to retrieve user-selectable criteria for call processing stored within the data structure . . ."

OXE System

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}

Respondent argued that "independent" should be construed as "physically distinct," and that the accused products do not meet this limitation. (RBr at 113.) Respondent further argued that even if "independent" is construed as "not dependent upon anything," the accused products still do not infringe, as the telephone network would be dependent upon the computer network for existence. (RBr at 113.)

The staff argued that:

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For each portion of this element except for the limitation of "independent," as found infra, the administrative law judge finds that complainant has established that this claim

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limitation is met by the accused products for the same reasoning set forth for the fifth limitation of claim 1 of the '493 patent. (See Section VIII.B.1.a, supra.)

The administrative law judge has found in Section VI.A.2, supra, that the limitation of claims 28 and 38 requiring "accessing a data structure contained within a computer network that is independent of the telephone network" is construed to mean "accessing a data structure in the computer network that is physically separate from the telephone network." {

} Hence, the administrative law judge finds that complainant has established that the accused OXE system products meet this limitation of claim 28 of the '439 patent.

OXO System

Complainant argued that this limitation is similar to the fifth limitation of claim 1 of the '439 patent, and satisfies the limitation for the same reasoning. (CBr at 92.) Complainant further argued that this claim limitation is met by the accused OXO system products because "independent" means "logically distinct" and not "physically distinct," as argued by the staff and respondent. (CBr at 92.)

Respondent argued that "the same issues set forth above with respect to the accused OXE system apply to the accused OXO system." (RBr at 113.)

The staff argued that with the exception of the claim term "independent," the analysis of

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claim 28 is the same as for claim 1 as regards the accused OXO system products and thus, said

products do not infringe for the same reasoning. (SBr at 53-54.)

The administrative law judge finds that the analysis of whether the accused OXO system

products meet this limitation of claim 28 is the same as the analysis of whether the accused OXO

system products meet claim 1, except for with respect to the claim term "independent." See

Section VIII.B1.a, supra. {

} Thus, the administrative law judge finds

complainant has established that the accused OXO system products meet this limitation of claim

28 of the '439 patent.

> The Claimed Phrase "wherein some of the user-selectable criteria is conditioned
> on current activity of subscribers on the computer network or according to current
> activity of the user on the computer network; and . . ."

OXE System

Complainant argued that this limitation of claim 28 is similar to the fourth limitation of

claim 1. (CBr at 71.) Thus, complainant argued that the accused OXE system products meet this

limitation for the same reasons that the accused OXE system products meet the fourth limitation

of claim 1. (CBr at 71.)

Respondent does not dispute that the fourth limitation of claim 1 is similar to this

limitation of claim 28. (CPFF 1362 (undisputed).)

The staff argued that the only limitation that respondent argued regarding claim 28 of the

'439 patent is the "independent of the telephone network" limitation, and that the accused OXE

system products meet that limitation. (SBr at 22-23.)

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The fourth element of claim 1 reads, "wherein some of the one or more lists are used to filter the incoming call according to current activity of subscribers on the computer network or according to current activity of the user on the computer network . . ." (JX-1 at 14:22-26.) The parties agreed that this claim phrase is similar to the limitation at issue in claim 28, as shown supra. The administrative law judge finds that there are no substantial differences between the claim limitation from claim 1 and the limitation recited, supra, of claim 28. Therefore, he finds that complainant has established that the accused OXE system products meet the limitation of claim 28 for the same reasons that said accused products met the fourth element of claim 1 of the '439 patent. (See Section VII.B.1.a, supra.)

OXO System

Complainant argued that this limitation is similar to the fourth limitation of claim 1 of the '439 patent, and that the accused OXO system products meet this limitation for the same reasoning. (CBr at 93.)

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}

The staff argued that the analysis for infringement of claim 28 is substantially the same as for claim 1. (SBr at 53.) {

}

The administrative law judge finds that the infringement analysis for this limitation of claim 28 is the same as for claim 1 of the '439 patent. Thus, he finds that complainant has not

established that the accused OXO system products meet this claim limitation for the same

reasons set forth in Section VIII.B.1.a, supra.

> The Claimed Phrase "processing the incoming call in accordance with the
> user-selectable criteria."

OXE System

Complainant argued that this limitation of claim 28 is similar to the sixth limitation of

claim 1. (CBr at 71.) Thus, complainant argued that the accused OXE system products meet this

limitation for the same reasons that the accused OXE system products meet the sixth limitation

of claim 1. (CBr at 71.)

Respondent does not dispute that the OXE system accused products practice this

limitation. (CPFF 1379 (undisputed in relevant part).)

The staff argued that the only limitation that respondent argued regarding claim 28 of the

'439 patent is the "independent of the telephone network" limitation, and that the accused OXE

system products meet that limitation. (SBr at 22-23.)

The administrative law judge agrees with complainant. Thus, he finds that complainant

has established that the accused OXE system products meet this limitation of claim 28 of the

'439 patent.

OXO System

Complainant argued that this limitation of claim 28 is similar to the sixth limitation of

claim 1 of the '439 patent, and thus satisfies this limitation for the same reasons. (CBr at 93.)

Complainant further argued that respondent does not dispute that the accused OXO system

products meet this limitation. (CBr at 93.)

Respondent did not dispute that the accused OXO system products meet this limitation. (CPFF 1830 (undisputed in relevant part).)

The staff argued that the analysis for infringement of claim 28 is substantially the same as for claim 1. (SBr at 53.) The staff does not dispute that the accused OXO system products meet this limitation. (CPFF 1827 (undisputed by staff).)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXO system products meet this limitation of claim 28 of the '439 patent.

Based on the foregoing, the administrative law judge finds that complainant has established that the accused OXE system products infringe claim 28 of the '439 patent, while it has not established that the accused OXO system products infringe said claim 28.

c.   Claim 38

> The Claimed Phrase, "In a system including a telephone network and a computer network where an originating telephone connects with a user telephone over the telephone network, a method for processing a call from the originating telephone to the user telephone according to user specifications, the method comprising: . . ."

OXE System

Complainant argued that this limitation of claim 38 is similar to the first and second limitations of claim 1 of the '439 patent, and thus the accused OXE system products meet this limitation for the same reasons as the accused OXE system products meet those limitations. (CBr at 72.)

Respondent does not dispute that the accused OXE system products meet this limitation.

(CPFF 1396 (undisputed in relevant part).)[24]

The staff argued that the analysis with respect to claim 38 is substantially the same as with respect to claims 1 and 28. (SBr at 54.) Thus, the staff argued that the accused OXE system products infringes claim 38 of the '439 patent. (SBr at 54.)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXE system products meet this limitation of claim 38 of the '439 patent.

OXO System

Complainant argued that this limitation is similar to the first and second limitations of claim 1 of the '439 patent, and that the accused OXO system products meet this limitation for the same reasons. (CBr at 94.) Complainant further argued that respondent did not dispute that the accused OXO products meet this limitation. (CBr at 94.)

Respondent did not dispute that the accused OXO system products meet this limitation. (CPFF 1845 (undisputed in relevant part).)

The staff did not dispute that the accused OXO system products meet this limitation. (CPFF 1842 (undisputed by staff).)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXO system products meet this limitation.

> The Claimed Phrase "accepting an incoming call designated for the user telephone from an originating telephone of a subscriber . . ."

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[24] CPFF 1396 concerns the OXE system, while RRCPFF 1396. A concerns the OXO system, and thus the administrative law judge presumes that RRCPFF 1396.A contains a typo. Whether RRCPFF 1396.A is in error is irrelevant to the findings in this investigation.

OXE System

Complainant argued that this limitation is similar to the sixth limitation of claim 1 and the third limitation of claim 28 of the '439 patent, and thus the accused OXE system products infringe for the same reasons. (CBr at 73.)

Respondent does not dispute that the accused OXE system products meet this limitation. (CPFF 1404 (undisputed in relevant part).)[25]

The staff argued that the analysis with respect to claim 38 is substantially the same as with respect to claims 1 and 28. (SBr at 54.) Thus, the staff argued that the accused OXE system products infringes claim 38 of the '439 patent. (SBr at 54.)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXE system products meet this limitation of claim 38 of the '439 patent.

OXO System

Complainant argued that this limitation is similar to the sixth limitation of claim 1 and third limitation of claim 28 of the '439 patent, and that the accused OXO system products meet this limitation for the same reasoning. (CBr at 95.) Complainant further argued that respondent did not dispute that the accused OXO system products meet this limitation. (CBr at 95.)

Respondent did not dispute that the accused OXO system products meet this limitation. (CPFF 1852 (undisputed in relevant part).)

The staff did not dispute that the accused OXO system products meet this limitation.

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[25] CPFF 1404 concerns the OXE system, but RRCPFF 1404.A concerns the OXO system, and thus the administrative law judge presumes that RRCPFF 1404.A contains a typo. Whether RRCPFF 1404.A is in error is irrelevant to the findings in this investigation.

(CPFF 1850 (undisputed by staff).)

The administrative law judge agrees with complainant. Thus he finds that complainant has established that the accused OXO system products meet this limitation of claim 38 of the '439 patent.

> The Claimed Phrase "accessing a data structure contained within a computer network that is independent of the telephone network to retrieve user-selectable criteria for call processing stored within the data structure . . ."

OXE System

Complainant argued that this limitation of claim 38 is similar to the fifth limitation of claim 1 and the fourth limitation of claim 28 of the '439 patent, and thus the accused OXE system products meet this limitation for the same reasons. (CBr at 73.)

Respondent argued that claim 38 requires "a computer network that is independent of the telephone network," (RBr at 113) where "independent" means "physically distinct." (RBr at 113.) Respondent further argued that under its construction or under complainant's construction of "not dependent on anything," there is no infringement of claim 38. (RBr at 113.)

The staff argued that the analysis with respect to claim 38 is substantially the same as with respect to claims 1 and 28. (SBr at 54.) Thus, the staff argued that the accused OXE system products infringe claim 38 of the '439 patent. (SBr at 54.)

The administrative law judge finds that the analysis of this limitation of claim 38 is substantially the same as the analysis of the fifth limitation of claim 1 and the fourth limitation of claim 28 of the '439 patent. Hence, the administrative law judge finds that complainant has established that the accused OXE system products meet this limitation of the '439 patent for the same reasoning as applied by the administrative law judge for the fourth limitation of claim 28 in

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Section VIII.B.1.b, supra.

OXO System

Complainant argued that this limitation is similar to the fifth limitation of claim 1 and the fourth limitation of claim 28 of the '439 patent, and the accused OXO system products practice this limitation for the same reasons. (CBr at 95.)

Respondent argued that claim 38 requires that the computer network be physically distinct from the telephone network, and that the accused OXO system products do not practice this limitation for the same reasons as the OXE system products did not. (RBr at 113.)

The staff argued that the analysis with respect to claim 38 is substantially the same as with respect to claims 1 and 28. (SBr at 54.) The staff does not dispute that the accused OXO system product meet this limitation. (CPFF 1857 (undisputed by staff).)

The administrative law judge finds that the analysis of this claim limitation is substantially the same as the reasoning in Section VIII.B.1.b, supra, regarding the fourth limitation of claim 28 of the '439 patent. Hence, the administrative law judge finds that complainant has established that the accused OXO system products meet this limitation of claim 38 of the '439 patent.

> The Claimed Phrase "wherein some of the user-selectable criteria is conditioned on current activity of subscribers on the computer network or according to current activity of the user on the computer network; and . . ."

OXE System

Complainant argued that this limitation is "similar" to the fourth limitation of claim 1 and the fifth limitation of claim 28, and thus the accused OXE system products meet this limitaiton of claim 38 as well. (CBr at 73-74.)

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Respondent argued that "[f]or claims 28 and 38, the relevant element for this infringement issue is very similar." (RBr at 105-06.)

The staff argued that the analysis with respect to claim 38 is substantially the same as with respect to claims 1 and 28. (SBr at 54.) Thus, the staff argued that the accused OXE system products infringe claim 38 of the '439 patent. (SBr at 54.)

The administrative law judge agrees with complainant. Thus, he finds that the analysis of this limitation of claim 38 is substantially the same as the analysis of the fourth limitation of claim 1 and the fifth limitation of claim 28 of the '439 patent. Hence, the administrative law judge finds that complainant has established that the accused OXE system products meet this limitation of the '439 patent for the same reasoning as applied by the administrative law judge for the fourth limitation of claim 1 in Section VIII.B.1.a, supra.

OXO System

Complainant argued that this limitation is similar to the fourth limitation of claim 1 and the fifth limitation of claim 28 of the '439 patent, and that the accused OXO system products practice this limitation for the same reasons. (CBr at 95-96.)

Respondent argued that the accused OXO system products do not infringe for the same reasons as the OXE system product does not infringe. (RBr at 113.) {

}

The staff argued that the analysis with respect to claim 38 is substantially the same as with respect to claims 1 and 28. (SBr at 54.) Thus, the staff argued that the OXO system products do not infringe claim 38 of the '439 patent for the same reasons that the OXO system

product does not meet the limitation of claim 1 of the '439 patent. (SBr at 54.) {

}

The administrative law judge finds that the analysis of this limitation of claim 38 is substantially the same as the analysis of the fourth limitation of claim 1 and the fifth limitation of claim 28 of the '439 patent. Hence, the administrative law judge finds that complainant has not established that the accused OXO system products meet this limitation for the same reasoning as set forth in Section VIII.B.1.a, supra.

The Claimed Phrase "processing the incoming call of the subscriber in accordance with the user-selectable criteria."

OXE System

Complainant argued that this limitation of claim 38 is similar to the sixth limitation of claim 1 and the sixth limitation of claim 28 of the '439 patent, and thus that the accused OXE system products meet this limitation. (CBr at 74.)

Respondent did not dispute that the accused OXE system products meet this limitation. (CPFF 1434 (undisputed in relevant part).)

The staff argued that the analysis with respect to claim 38 is substantially the same as with respect to claims 1 and 28. (SBr at 54.) Thus, the staff argued that the accused OXE system products infringe claim 38 of the '439 patent. (SBr at 54.)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXE system products meet this limitation of claim 38 of the '439 patent.

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<u>OXO System</u>

Complainant argued that the fifth limitation of claim 38 of the '439 patent is similar to the sixth limitation of claim 1 and the sixth limitation of claim 28 of the '439 patent, and thus the accused OXO system products meet this limitation for the same reasons. (CBr at 96.) Further, complainant argued that respondent did not dispute that the accused OXO system products meet this limitation. (CBr at 96.)

Respondent does not dispute that the accused OXO system products meet this limitation. (CPFF 1872 (undisputed in relevant part).)

The staff does not dispute that the accused OXO system products meet this limitation. (CPFF 1876 (undisputed by staff).)

The administrative law judge agrees with complainant. Thus, he finds that this limitation is similar to the sixth limitations of claim 1 and claim 28 of the '439 patent. Hence, the administrative law judge finds that complainant has established that the accused OXO system products meet this limitation of claim 38 of the '439 patent.

Based on the foregoing, the administrative law judge finds that the complainant has not established that the accused OXO system products infringe claim 38 of the '439 patent, but that complainant has established that the accused OXE system products infringe claim 38 of the '439 patent, assuming claim 38 is valid.

2.   The '289 Patent

a.   Claim 1

<u>OXE System</u>

The Claimed Phrase "In a system that includes a telephone network and a

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computer network with one or more users, wherein each user is connected through a user computer the computer network and is logically connected through the computer network to the telephone network . . ."

Complainant argued that respondent has stipulated that the accused OXE system products meet this limitation. (CBr at 74.)

Respondent did not dispute that the accused OXE system products meet this limitation. (CPFF 1439 (undisputed in relevant part).)

The staff argued that the "parties have stipulated that the accused products satisfy most of the limitations of the claim." (SBr at 54.)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXE system products meet this limitation of claim 38 of the '439 patent.

> The Claimed Phrase " a method of determining when to establish telephone communication between two parties, at least one of whom is a user connected to said computer network, comprising: . . ."

Complainant argued that respondent has stipulated that the accused OXE system products meet this limitation. (CBr at 74.)

Respondent does not dispute that the accused OXE system products meet this limitation. (CPFF 1444 (undisputed in relevant part).)

The staff argued that the "parties have stipulated that the accused products satisfy most of the limitations of the claim." (SBr at 54.)

The administrative law judge agrees with complainant. Thus he finds that complainant has established that the accused OXE system products meet this limitation of claim 38 of the '439 patent.

The Claimed Phrase "at the computer network, receiving information from the telephone network that a first party from whom a call is originating desires to establish telephone communication with a second party; . . ."

Complainant argued that respondent has stipulated that the accused OXE system products meet this limitation. (CBr at 75.)

Respondent does not dispute that the accused OXE system products meet this limitation. (CPFF 1449 (undisputed in relevant part).)

The staff argued that the "parties have stipulated that the accused products satisfy most of the limitations of the claim." (SBr at 54.)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXE system products meet this limitation of claim 38 of the '439 patent.

The Claimed Phrase "at the computer network, monitoring activity of a user computer connected to the computer network and associated with the second party; . . ."

{

} Specifically, complainant argued that being on a VoIP call is a monitored activity that "constitutes 'activity' under either party's construction of this term." (CBr at 75.)

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[26] {

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[27] {

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} The staff further

argued that complainant has "failed to establish infringement of claim 1 because it has not shown

that the accused systems monitor the activity of a user computer in order to route the calls." (SBr

at 54.)

The administrative law judge has construed the claimed phrase "monitoring activity of a

user computer connected to the computer network" to mean determining whether the user

computer is "active or idle." (See Section VI.A.1, supra.) Regarding monitoring the user

computer's activity, the specification of the '289 patent states:

> The computer operating system, such as the Windows® operating
> system, is capable of monitoring user activity on the computer. For
> example, the operating system on the callee computer 154 can
> detect user activity on the keyboard 154*a* or the mouse 154*b*. By
> monitoring this activity, the operating system can determine the
> user's status and activate certain software programs, such as a
> screen saver, when no user activity has been detected for a certain
> period of time. Under these circumstances, the operating system
> may determine that the callee computer 154 has entered an "idle"
> state. Similarly, operating system on the caller computer 184 may
> perform similar functions to determine user activity on the caller
> computer. Using the principles of the present invention, the callee
> computer 154 and the caller computer 184 may report the current
> status to the affiliation list 150 for each respective computer.

(JX-2 at 14:33-49 (emphasis added).) The specification makes a distinction between said user

computer's activity and the user's activity, as shown by the following excerpt:

> The fact that both computers' are not in the idle state indicates that the users of each respective computer may be available for a telephone conversation. In addition, the system 100 can apply call processing rules that may also govern operation of the telephone portion of the system 100 . For example, the callee computer 154 may be in an "active" state (as opposed to the idle state) but the user has indicated that he should not be disturbed at the present time. Thus, the central office switch 116 or the call processor 176 accesses the affiliation list 150 for the destination telephone 104 to determine the callee-selected call processing criteria. In addition, the central office switch 116 or the call processor 176 can access the affiliation list 150 for the caller and apply any caller-selected call processing rules. For example, the caller computer 184 may be in the active state, but the caller status in the affiliation list 150 may indicate that the caller is in a meeting and is, therefore, unavailable for a telephone call with the callee. In this manner, the system 100 can monitor computer activity and determine when the caller and callee may both be available for a telephone call and further applies call processing criteria for both the caller and callee.

(JX-2 at 14:53-15:7 (emphasis added).) Also, complainant's expert testified that the user status

and the user computer's status are distinct:

> Q. Okay. Well, you agree that monitoring the activity of the user computer could include, at least, whether the computer is awake or asleep, right?
>
> A. Sure.
>
> Q. And that would be independent of whether I had an electronic calendar program or anything else?
>
> A. Absolutely.
>
> Q. Correct?
>
> A. Correct.

(Tr. at 924-25.) Further, respondent's expert testified that routing a call based on a user

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computer's status is not the same as routing a call based on whether the user is using the phone:

> Q. Okay. So is there any indication here to you that routing calls based upon monitoring the current activity of the user computer is something different from routing calls based upon phone state?
>
> A. Yeah. Yeah, it is different. Clearly different.
>
> Q. Can you explain to me why it is?
>
> A. That's why he's suggesting this is an invention worthy of a patent, is that he's come up with another way of deciding how to route a call.
>
> You can -- instead of just always trying to ring a phone when it's not already busy, to see -- and then discovering that it just rings and rings and rings, you can anticipate that it's not going to be answered by monitoring whether there's any activity of the user's computer.
>
> If there is, then there's a presumption that it's a good time to call and, therefore, put the call through. But if there is no computer activity, the presumption may be that the -- typically would be that the user is not there and, therefore, the call could be routed somewhere else, to an assistant or to a different phone number.

(Tr. at 1350-51.) The specification, as shown in the excerpt cited, supra, contemplates an active computer indicating that a user is available for a telephone conversation. Thus, to meet this limitation, the accused products would need to check the activity of the computer itself, not simply whether there is a telephone call currently in progress. Each of the examples used by complainant's expert to illustrate alleged infringement of the '289 patent routed calls away from users engaged in a VoIP telephone call:

> Q. So this -- what I have here in CDX-75, this was the only infringement scenario that you discussed yesterday during your direct, correct?

A.   Well, there is two configurations, configuration 1 and configuration 2.

Q.   Understood. But in both configuration 1 and configuration 2, it depends upon the called party being on their Softphone, correct?

A.   Correct.

(Tr. at 956.) Thus, the examples used by complainant's expert do not definitively show that the accused products have the required capability of determining a computer's idle or active status, as a VoIP telephone call could be detected by either monitoring computer activity or by checking the phone extension. Also, respondent's expert testified:

Q.   So that kind of capability of routing calls to another extension or to voice mail when somebody is on the phone, is that something that you have seen in your work with unified messaging systems in the past?

A.   Sure. I mean, any voice mail system obviously embodies this concept of routing calls. And if your extension is busy, then they route to, typically, the voice mail.

But you can have alternate numbers to route to an assistant's number or you can set things up to route somewhere else. If on a no answer condition, it might indicate you're out of the office, so you can set it up to route to your mobile phone.

Q.   Okay. So let's look at RDX-20, page 3. Can you tell me what you have shown here on RDX-20, 3?

A.   Yes. So here is an example of doing essentially just that with the OXE system. Here is a user interface for setting up what they call filtering rules, where we can actually set up conditions based on different, for instance, who is calling, what time of day it is and whether, for instance, it's a busy condition or a no answer condition, what then happens to that call, whether it goes to voice mail, whether it gets forwarded to another phone number.

Q.   Now, do any of those rules route calls based upon monitoring the current activity of the user computer?

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A. No.

Q. And why is that?

A. Because as I said, the only condition that it's routing based on is the actual state of your extension.

Q. Let's look at page 4 of RDX-20. Can you explain to me what you have shown here?

A. Yeah. Again, so there's a drop down box. And basically there's two setups. You can set up different routing options according to only one of two things, either on no answer or on busy. And in each case, you can say route the call to voice mail, to another number or -- I can't see what that last option is. But basically the only triggers you can use are whether the phone is currently busy or not answered.

Q. Are either of those triggers based upon monitoring the current activity of the user computer?

A. No. It's monitoring the status of the extension in the PBX.

Q. Now, is that the case if the user is -- using a Softphone as opposed to a hard phone?

A. It's the same whether it's using a Softphone or a hard phone.

Q. Why is that?

A. Because the Softphone is just a software implementation of a telephone extension over a computer network. But basically it's a telephone. And it works just the same as any other telephone.

Q. And does that appear any different to the OmniPCX Enterprise switch than the hard phone?

A. No.

Q. Now, look at RDX-20, page 5. Can you tell me what you have shown here?

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} Based on the
foregoing, the administrative law judge finds that complainant has not met its burden of proving

that the accused OXE system products practice this limitation of claim 1 of the '289 patent.

Complainant has argued that the user status that satisfies the limitation "current activity

of the user on the computer network" from the '439 patent, viz., do not disturb, unwilling to

accept, etc., also satisfies this limitation of claim 1 of the '289 patent, citing in support to the

specification of the '289 patent. (CRSFF 193-A-AT; see also JX-2 at 2:13-15.) The

specification, however, reads:

> Both the caller and callee can specify user-selectable call
> processing criteria. The potential callee can specify call processing
> criteria for all incoming calls, such as providing a list of
> individuals from whom the person will accept calls, a list of
> individuals from whom the person will not accept calls, or
> conditional criteria, such as accepting or blocking calls during

certain times of day or during certain periods of activity, such as
when the user may be otherwise occupied and unwilling to accept
an incoming call. In addition, the potential callee's computer
activity may be monitored and the status of the computer as idle or
active may be reported to the computer network.

(JX-2 at 2:7-18 (emphasis added).) Thus, the portion of the specification cited by complainant

discloses that whether the user's computer is active or idle is in addition to "user-selectable call

processing criteria." Hence, if a user status is set to "do not disturb," simply checking that status

without also monitoring whether the computer is active or idle does not meet the claim

requirement; {

}

The Claimed Phrase, "at the computer network, storing a set of pre-determined
rules for determining when the second party is available to take a call from the
first party . . ."

Complainant argued that the parties have stipulated that this limitaiton is met by the

accused OXE system products. (CBr at 78.)

Respondent did not dispute that the accsued OXE system products meet this limitation.

(CPFF 1515, 1516 (undisputed in relevant part).)

The staff argued that the "parties have stipulated that the accused products satisfy most of

the limitations of the claim." (SBr at 54.)

The administrative law judge agrees with complainant. Thus, he finds that complainant

has established that the accused OXE system products meet this limitation of claim 1 of the '289

patent.

The Claimed Phrase, "at the computer network, using the set of a pre-determined rules to process i) the information received from the telephone network regarding the call being originated by the first party, and ii) information regarding the monitored activity of the user computer of the second party, to determine when the second party is available to take the call originated by the first party; and . . ."

{

} The staff further

argued that complainant has "failed to establish infringement of claim 1 because it has not shown

that the accused systems monitor the activity of a user computer in order to route the calls." (SBr at 54.)

The administrative law judge has construed the claimed phrase "monitoring activity of a user computer connected to the computer network" to mean determining whether the user computer is "active or idle." (See Section VI.A.1, supra.) Therefore, the claim phrase in this claim limitation, viz. "ii) information regarding the monitored activity of the user computer of the second party," means information regarding whether the user computer is active or idle. The administrative law judge has also found supra, that the accused OXE products do not monitor whether the user's computer is active or idle. The administrative law judge finds that the language of the claim indicates that both i) and ii) are required components, through use of the word "and." Also, complainant's expert has testified that:

> Q. So according to you then, we talked about the invention and the background and the problem he was trying to solve, what you are saying is that Mr. Liffick invented the phone being on a computer?
>
> A. No, that's not what I am trying to say. <u>Mr. Liffick invented a way to route calls based on a combination of user specified criteria and the combination of user's computer status.</u>

(Tr. at 980 (emphasis added).) Thus, complainant's expert stated that the invention concerns the combination of user specified criteria <u>and</u> the user's computer status. Based on the foregoing, the administrative law judge finds that complainant has not established that the accused OXE system products meet this claim limitation.

> The Claimed Phrase "using the information processed at the computer network to facilitate connecting the call originated by the first party through the telephone network to the second party."

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Respondent argued that claim 1 of the '289 patent requires "using the information

processed at the computer network to facilitate connecting the call originated by the first party

through the telephone network to the second party." (RRCPFF 1578.A citing JX-2 at col.

18:62-65; RFF IV.B.4.1.) Respondent further argued that complainant's expert Chang

acknowledged that the examples relied upon by Microsoft for its infringement allegations do not

result in connecting the call to the second party. (RRCPFF 1578.B citing Tr. at 968:16-969:4,

977:3-978:11, 978:22-979:20; RFF IV.B.4.2.) Finally, respondent argued that complainant's

expert Chang admitted that neither he nor Microsoft provided any examples to the Court where

what they contend to be information regarding the monitored activity of a user computer is used

to connect a call to the party the first party is trying to call. (RRCPFF 1578.C citing Tr. at

977:3-978:11; RFF IV.B.4.3.)

The staff argued that the only status monitored by the accused systems when a softphone

is in use is the state of the user's phone extension. (SPFF 194; SPFF 198.) The staff further

argued that complainant has "failed to establish infringement of claim 1 because it has not shown

that the accused systems monitor the activity of a user computer in order to route the calls." (SBr

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at 54.)

The administrative law judge finds that the "information processed at the computer network" must refer to the immediately-prior claim element, viz., "at the computer network, using the set of a pre-determined rules to process i) the information received from the telephone network . . . and ii) information regarding the monitored activity of the user computer . . ." (JX-2 at 18:55-59.) Thus, it is a requirement of this claim limitation that the "information processed" include each of the "information received from the telephone network" and "information regarding the monitored activity of the user computer." The administrative law judge has also found, supra, that the accused OXE system products do not monitor whether the user's computer is idle or active. Thus, he finds that complainant has not established that the accused OXE system products practice this limitation of claim 1 of the '289 patent.

OXO System

Regarding the accused OXO system products, for each element of claim 1 of the '289 patent, complainant has argued either that said element has been stipulated to by the parties, or that the accused OXO system products infringe for the same reasons as the accused OXE system products. (CBr at 96-100.)

Respondent argued that:

> Microsoft and Mr. Chang relied upon the same scenarios for its claim of infringement regarding the accused OXO system as it did for the accused OXE system. (RFF IV.B.6.1.) As a result, the accused OXO system does not infringe the asserted claims of the '289 patent for the same reasons discussed above with respect to the OXE system. (RFF IV.B.6.2.)

(RBr at 87.)

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The administrative law judge agrees with the private parties and thus, he finds that the infringement analysis for the accused OXO system products as regards claim 1 of the '289 patent is identical as for the infringement analysis of the OXE system products regarding said claim. Based on the foregoing, the administrative law judge finds that complainant has not established that the accused OXO system products infringe claim 1 of the '289 patent.

Based on the foregoing, the administrative law judge finds that complainant has not established that each of the accused OXO system products and the accused OXE system products infringe claim 1 of the '289 patent.

b.   Claim 7

OXE System

> The Claimed Phrase "In a system that includes a telephone network and a computer network with one or more users, and wherein each user is connected through a user computer to the computer network and is logically connected through the computer network to the telephone network . . ."

Complainant argued that the parties have stipulated that the accused OXE system products meet this claim limitation. (CBr at 82.)

Respondent did not dispute that the OXE system products meet this limitation. (CPFF 1606, 1607 (undisputed in relevant part).)

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The staff argued that the private parties have stipulated the accused products satisfy most of the limitations of the claims. (SBr at 58.)

The administrative law judge agrees with complainant. Thus, he finds that the complainant has established that the accused OXE system products meet this limitation.

> The Claimed Phrase "a computer program product comprising: a computer readable medium for carrying computer executable instructions for implementing at the computer network a method of determining when to establish. telephone communication between two parties, at least one of whom is a user connected to said computer network, and wherein said method comprises: . . ."

Complainant argued that the parties have stipulated that the accused OXE system products meet this claim limitation. (CBr at 82.)

Respondent did not dispute that the OXE system products meet this limitation. (CPFF 1609, 1610 (undisputed in relevant part).)

The staff argued that the private parties have stipulated the accused products satisfy most of the limitations of the claims. (SBr at 58.)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXE system products meet this limitation.

> The Claimed Phrase, "at the computer network, receiving information from the telephone network that a first party from whom a call is originating desires to establish telephone communication with a second party; . . ."

Complainant argued that the parties have stipulated that the accused OXE system products meet this claim limitation. (CBr at 82.)

Respondent did not dispute that the OXE system products meet this limitation. (CPFF 1616, 1617 (undisputed in relevant part).)

The staff argued that the private parties have stipulated the accused products satisfy most

of the limitations of the claims. (SBr at 58.)

The administrative law judge agrees with complainant. Thus, he finds that complainant

has established that the accused OXE system products meet this limitation.

> The Claimed Phrase, "at the computer network, monitoring activity of a user
> computer connected to the computer network and associated with the second
> party; . . ."

Complainant argued that this limitation is similar to the fourth limitation of claim 1 of the

'289 patent and the accused OXE system products meet this limitation for the same reasoning.

(CBr at 82.)

Respondent did not dispute that this limitation is similar to the fourth limitation of claim

1 of the '289 patent. (CPFF 1619 (undisputed).) Respondent further argued that "Mr. Chang

testified that his analysis for claim 1 of the '289 patent also applies to claim 7 of the '289 patent,

but the analysis for claim 7 fails for the same reasons as his analysis for claim 1." (RRCPFF

1620.A.) Respondent also makes no distinction between the asserted claims of the '289 patent in

its post-hearing brief. (See generally RBr at 81-87.)

The staff argued that "this limitation is not satisfied with respect to the accused products

for the same reason that the limitations in claim 1 are not satisfied. (SBr at 58.)

The administrative law judge finds that this limitation of claim 7 of the '289 patent is

similar to the fourth limitation of claim 1 of the '289 patent. Thus, the administrative law judge

further finds that complainant has not established that the accused OXE system products meet

this limitation for the same reasoning as in Section VIII.B.2.a, supra.

> The Claimed Phrase "at the computer network, storing a set of predetermined
> rules for determining when the second party is available to take a call from the
> first party; and . . ."

Complainant argued that the parties have stipulated that the accused OXE system products meet this claim limitation. (CBr at 82.)

Respondent did not dispute that the OXE system products meet this limitation. (CPFF 1626, 1627 (undisputed in relevant part).)

The staff argued that the private parties have stipulated that the accused products satisfy most of the limitations of the claims. (SBr at 58.)

The administrative law judge agrees with complainant. Thus, he finds that complainant has established that the accused OXE system products meet this limitation.

> The Claimed Phrase, "at the computer network, using the set of predetermined rules to process i) the information received from the telephone network regarding the call being originated by the first party, and ii) information regarding the monitored activity of the user computer of the second party, to determine when the second party is available to take the call originated by the first party."

Complainant argued that this limitation of claim 7 of the '289 patent is similar to the sixth limitation of claim 1 of the '289 patent, and that the accused OXE system products meet this limitation also. (CBr at 83.)

Respondent did not dispute that this limitation is similar to the fourth limitation of claim 1 of the '289 patent. (CPFF 1629 (undisputed).) Respondent further argued that "Mr. Chang testified that his analysis for claim 1 of the '289 patent also applies to claim 7 of the '289 patent, but the analysis for claim 7 fails for the same reasons as his analysis for claim 1." (RRCPFF 1630.A.) Respondent also makes no distinction between the asserted claims of the '289 patent in its post-hearing brief. (See generally RBr at 81-87.)

The staff argued that "this limitation is not satisfied with respect to the accused products for the same reason that the limitations in claim 1 are not satisfied. (SBr at 58.)

The administrative law judge finds that this limitation of claim 7 of the '289 patent is similar to the sixth limitation of claim 1 of the '289 patent. He further finds that the accused OXE system products do not meet this limitation for the same reasoning in Section VIII.B.2.a, supra.

OXO System

Regarding the accused OXO system products, for each element of claim 7 of the '289 patent, complainant has argued either that said element has been stipulated to by the parties, or that the accused OXO system products infringe for the same reasons as the accused OXE system products. (CBr at 101-102.)

Respondent argued that:

> Microsoft and Mr. Chang relied upon the same scenarios for its claim of infringement regarding the accused OXO system as it did for the accused OXE system. (RFF IV.B.6.1.) As a result, the accused OXO system does not infringe the asserted claims of the '289 patent for the same reasons discussed above with respect to the OXE system. (RFF IV.B.6.2.)

(RBr at 87.)

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The administrative law judge finds that the infringement analysis for the accused OXO

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system products as regards claim 7 of the '289 patent is identical as for the infringement analysis

of the OXE system products regarding said claim. Thus, complainant has not established that the

accused OXO system products infringe claim 7 of the '289 patent.

Based on the foregoing, the administrative law judge finds that complainant has not

established that either of the accused OXO system products or the accused OXE system products

infringe claim 7 of the '289 patent.

C.   The O'Neal Patents

Complainant argued that only the OXE system infringes claims 3, 8, 11, 12, and 20 of the

'064 patent, and claim 6 of the '357 patent. (CBr at 102.) Complainant also included an analysis

of claim 1 of the '064 patent, because asserted dependent claims 3, 8, 11, and 12 of the '064

patent depend from unasserted claim 1 of the '064 patent. (CBr at 103 n. 6.) Likewise,

complainant included an analysis of claim 1 of the '357 patent because asserted dependent claim

6 of the '357 patent depends from claim 1 of the '357 patent. (CBr at 110 n. 7.) Complainant, in

support, argued that claims 1 and 20 of the '064 patent and claim 1 of the '357 patent each

include the GUI and TUI limitations (CBr at 104-08; CBr at 109; CBr at 111-12), and that:

> [A]s set out in JX-33, Respondent ALE acknowledges that its
> accused products include all of the limitations of the asserted '064
> and '357 claims except for two: "said computer server being
> configured to generate a single graphical menu for displaying said
> communication options for each of said communication services at
> the same time" ("the GUI limitation"), and "a telephony server
> coupled to exchange data with said communication profile
> database, said telephony server being configured to audibly
> represent said communication options to said telephone when said
> subscriber employs said telephone to access said computer-
> implemented control center" ("the TUI limitation"). [CPFF 2028.]

(CBr at 102-103.)

Respondent argued that the accused products meet neither the GUI nor TUI limitations.

(RBr at 51-55.)

The staff argued that, regarding the '064 patent:

> The private parties have stipulated that the accused products
> satisfy all of the limitations of claim 1 except for the GUI
> limitation and the TUI limitation. (JX-33C, at § II.3). The Staff
> is of the view that the evidence of record shows that accused
> products do not satisfy the GUI and TUI limitations when those
> limitations are properly construed, and therefore do not infringe
> claim 1 or the asserted claims that depend from claim 1.

(SBr at 58-59.) The staff also argued that claim 20 of the '064 patent is not infringed for

substantially the same reasons that said claim 1 is not infringed. (SBr at 61.) The staff argued

that regarding the '357 patent:

> The private parties have stipulated that the accused products satisfy
> all of the limitations of independent claim 1 except the GUI and
> TUI limitations. (JX-33C, at § II.9). The parties agree, moreover,
> the GUI and TUI limitations should be construed the same way for
> purposes of claim 1 of the '357 patent as claim 1 of the '064
> patent. (See, e.g., CDX-127; CDX-138; RDX-1) (discussing both
> O'Neal patents). As discussed above in the context of the '064
> patent, the accused products do not have either a single graphical
> menu or a telephone user interface that displays all of the options
> available to the subscriber. (Hyde-Thomson, Tr. at 1250-57; RDX-
> 19). Because the accused products do not satisfy all of the
> limitations of independent claim 1 then, by definition, they do not
> satisfy all of the limitations of dependent claim 6. See, e.g.,
> Monsanto Co., 2007 U.S. App. LEXIS 23225, at *15-*16;
> Wahpeton Canvas Co., 870 F.2d at 1552 n.9 (Fed. Cir. 1989); see
> also 35 U.S.C. § 112, ¶ 4. Thus, the evidence of record shows that
> the accused products do not infringe claim 6 of the '357 patent for
> substantially the same reasons that they do not infringe the asserted
> claims of the '064 patent.

(SBr at 61-62.)

The parties agreed that each limitation of the asserted claims of the '064 and '357 patents

is met, except for the GUI and TUI limitations. (CPFF 2028 (undisputed in relevant part).) As the parties only provided one analysis of the GUI and TUI limitations, the administrative law judge finds that the parties agreed that each of claims 1 and 20 of the '064 patent and claim 1 of the '357 patent disclose said GUI and TUI limitations, and that the same infringement analysis applies. (CBr at 102-103;RBr at 51-55; SBr 58-62.) Moreover, as found in Section VII.B, supra, the administrative law judge has found that the claim constructions of the GUI and TUI limitations are substantially the same as between the claims of the '064 and '357 patents. As for the GUI limitation, complainant argued that:

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The staff argued that the accused products do not satisfy the GUI limitation. (SBr at 59.) Specifically, the staff argued that "it is not possible to modify all of the available options from one screen or one menu of the accused products; the user must go through multiple screens in order to do so." (SBr at 59.)

The administrative law judge has found in Section VI.B.1, supra, that the claim phrase "generate [or generating] a single graphical menu for displaying said communication options for each of said communication services at the same time" is construed as "generate, or generating, one graphical menu for displaying all of the communication options for all of the plurality of communication services." He thus rejected complainant's proposed construction.

It is undisputed that the accused OXE system does not generate a single graphical menu that shows all of the communication options associated with a user's communication services at the same time. (RFF III.B.1.1 (undisputed).) In fact, complainant's infringement arguments depend on its claim construction argument:

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} Thus, complainant not only provided no argument that the accused products infringe under a different claim construction, but also admitted that several graphical menus are generated. Also, complainant's expert had no opinion as to whether the

accused products infringed, given that all options of all communications services must be displayed. (Tr. at 856-57; 1049.) Respondent's expert, however, testified that the accused products did not infringe under these conditions:

> Q. So, then, based upon your review of the OTUC product, the -- is it your opinion that under the ABS construction of the graphical user interface limitation, that the accused products would infringe?
>
> A. No. The accused products -- sorry. Which construction did you just say?
>
> {

} Based on the foregoing, the administrative law judge finds that complainant has not established that the OXE system accused products practice the GUI limitation as required by the asserted claims of the '064 and '357 patents.

Regarding the TUI limitation, complainant argued that "the evidence establishes that the

accused OXE System practices the 'telephony server' limitation under Microsoft's proposed

construction because the telephony server of the accused system audibly represents some of the

communication options offered by the system. (CBr at 108.)

Respondent argued that there is no dispute that "in the accused OXE system, the options

available through the multiple graphical menus are not all available through the TUI. (RFF

III.B.1.11; RBr at 53.)

The staff argued that because the interface for the accused products does not display all of

the available options, but rather displays only a subset of options, that the TUI limitation is not

satisfied. (SBr at 60.)

The administrative law judge has found, in Section VII.B.2, supra, that, for claims 1 and

20 of the '064 patent, the claim phrase "said telephony server being configured to audibly

represent said communication options to said telephone when said subscriber employs said

telephone to access the computer implemented control center" is construed as "the telephony

server being configured to audibly represent communication options pertaining to at least two

communication services to a telephone when the subscriber employs said telephone to access the

computer implemented control center." The administrative law judge has also found that, for

claim 1 of the '357 patent, that the claim phrase "audibly representing said communication

options to one of said telephones, using said telephony server, when said subscriber employs one

of said telephones to access said computer-implemented control center" is construed as "audibly

representing communication options pertaining to at least two communication services to a

telephone, using said telephony server, when a subscriber employs one of the telephones to

access the computer-implemented control center," which is inconsistent with complainant's

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proposed construction. As the parties agreed, <u>supra</u>, the language of the asserted patents regarding the claims is substantially the same as regards the infringement analysis and will be so treated by the administrative law judge.

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} Moreover, respondent does not provide any argument in the post-hearing briefs or the rebuttal findings of fact for non-infringement where the administrative law judge substantially found for respondent and staff regarding claim construction of the GUI limitation and complainant regarding claim construction of the TUI limitation, i.e., where the GUI is required to have all communication services and communication options, but the TUI is not required to have all of the communication services and options displayed in the GUI. (See generally RBr at 53-54 (arguing that the accused products do not meet the TUI limitation under ALE's construction); RRBr at 22 (arguing that the accused products do not meet the TUI limitation under ALE's construction.) Thus, the administrative law judge finds that complainant's argument that the accused products meet the TUI limitation stands essentially unrebutted. (CPFF 2050 - 2062 (undisputed in relevant part).) Further, complainant's expert Chang has testified:

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} Hence, the administrative law judge finds that CDX-168 and CDX-169 shows

testing performed by complainant's expert showing that the TUI of the accused products has a

menu with more than one communication service, and that each service has several options. (See

CDX-168, CDX-169.) Thus, the administrative law judge finds that complainant has established

that the OXE system accused products meet the TUI limitation. However, because the

administrative law judge has found that complainant has not established that the OXE system accused products practice the GUI limitation, he finds that complainant has not established, by a preponderance of the evidence, that the asserted claims of the '064 and '357 patents are infringed by said accused products.

D.   Contributory Infringement

Complainant argued that respondent has contributed to the infringement of the patents-in-suit by others. (CBr at 113.) Specifically, complainant argued that respondent has conceded that it (or another ALE company) has used in the United States both the accused OXE and OXO system products (CBr at 113-114); that there has been at least one use in the United States, by at least one ALE customer as identified in ABS14633-34, of each of the accused OXE and OXO system products (CBr at 114); that said accused products do not have substantial noninfringing use (CBr at 114); and that respondent has been aware of the alleged infringement of the '439, '289, and '357 patents since December 2004 and the alleged infringement of the '064 patent since October 2005 (CBr at 115). Thus, complainant argued that respondent has contributed to the infringement of the asserted patents. (CBr at 115-116.)

Respondent argued that there is no direct infringement, and thus there can be no indirect infringement. (RBr at 54-55, 87-88, 113-114.) Further, respondent argued that both the accused OXO and OXE system products have substantial non-infringing use. (RBr at 88-89, 114-115.)

The staff argued that respondent has stipulated that its customers use the accused systems in the United States. (SBr at 64 citing JX-9C at ¶¶ 2-3.) The staff argued that although respondent has known of the patents for several years, the evidence does not show that there are no substantial non-infringing uses for the OXE system, and thus complainant has not proven

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contributory infringement. (SBr at 64.)

The administrative law judge has found, supra, that the accused OXE system products infringe only claims 1 and 28 of the '439 patent, (which relates to a "system") and none of the other asserted claims of the '439 patent. The administrative law judge has also found that the accused OXO system products do not infringe any of the asserted claims of any asserted patent. As direct infringement is a requirement of contributory infringement, the administrative law judge only need analyze contributory infringement regarding the accused OXE system products and claims 1 and 28 of the '439 patent.

Respondent has stipulated that it imports or has imported, sells or has sold for importation, or sells or has sold within the United States after importation the accused OXE system products. (CPFF 2103 (undisputed in relevant part); see also JX-9 at 1.) Respondent has also stipulated that there has been at least one use in the United States, by at least one of respondent's customer as identified in ABS14633-34, of the accused OXE system products. (CPFF 2107 (undisputed in relevant part); see also JX-9 at 1.) ALE has been aware of the '439, patent since December 2004. (CPFF 2161 (undisputed).) Respondent does not raise any opinions of counsel as a defense. (CPFF 2162 (undisputed).) {

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} Thus, OmniPCX Enterprise PBX

component of the accused OXE system products have substantial non-infringing use.

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} Thus, the administrative law judge finds that the

accused OXE system products which include the OTUC software, have no substantial non-

infringing use. Based on the foregoing, the administrative law judge finds that respondent

contributorily infringes claims 1 and 28 of the '439 patent by selling the accused OXE system

products, which include the OTUC software.

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[28] Respondent incorporated RRCPFF 2112.A-I. as its rebuttal findings to CPFF 2113.

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E.   Induced Infringement

Complainant argued that respondent has induced others to infringe the patents-in-suit. (CBr at 116.) Specifically, complainant argued that respondent's customers and resellers have directly infringed the Microsoft Patents by selling, offering for sale and using the accused systems that ALE has admitted to importing into the United States (CBr at 116); that respondent has exhibited an intent to induce these acts of direct infringement by providing directions, demonstrations, guides, manuals, training for use, and other materials that encourage the infringing use of the accused ALE systems (CBr at 116); and that respondent has been aware of the '439, '289 and '357 patents since December 2004 and the '064 patent since October 2005 and has known since that time that the components of the accused ALE systems were especially adapted for use in an infringing manner (CBr at 116). Thus, complainant argued that in view of ALE's knowledge of the patents, its specific actions to encourage use of the accused ALE systems in an infringing manner, and the direct infringement of the patents by ALE's customers and resellers, ALE has induced infringement of the patents-in-suit. (CBr at 116.)

Respondent argued that there is no direct infringement, and thus there can be no indirect infringement. (RBr at 54-55, 87-88, 113-114.) Further, respondent argued that both the accused OXO and OXE system products have substantial non-infringing use. (RBr at 88-89, 114-115.)

The staff argued that respondent possessed the requisite specific intent for induced infringement, as respondent knew of the patents for several years, has distributed user guides and other public materials to its resellers and customers explaining how to use the accused systems, and did not present any affirmative evidence to attempt to show that it did not believe that is products infringed when used as directed. (SBr at 63.) Thus, the staff argued that respondent has

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induced infringement, should complainant prove direct infringement. (SBr at 63.)

The administrative law judge has found, supra, that the accused OXE system products infringe claims 1 and 28 of the '439 patent, and none of the other asserted claims. The administrative law judge has found that the accused OXO system products do not infringe any of the asserted claims. As direct infringement is a requirement of induced infringement, the administrative law judge only need analyze whether or not respondent induced others to infringe claims 1 and 28 of the '439 patent by using the accused OXE system products.

Respondent has stipulated that it imports or has imported, sells or has sold for importation, or sells or has sold within the United States after importation the accused OXE system products. (CPFF 2103 (undisputed in relevant part); see also JX-9 at 1.) Respondent has also stipulated that there has been at least one use in the United States, by at least one of respondent's customers as identified in ABS14633-34, of the accused OXE system products. (SPFF 250 (undisputed in relevant part); CPFF 2107 (undisputed in relevant part); see also JX-9 at 1.) ALE has been aware of the '439, '289 and '357 patents since December 2004 and the '064 patent since October 2005. (CPFF 2161 (undisputed).) Respondent does not raise any opinions of counsel as a defense. (CPFF 2162 (undisputed).) Further, respondent does not dispute that it has "distributed user guides and other public materials to its resellers and customers explaining how to use the accused systems." (SPFF 252 (undisputed).) Also, there is evidence that respondent has distributed public materials to its resellers and customers showing that the accused OXE system products have functionality that has been shown to infringe. {

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} Based on the foregoing, the administrative law judge finds that respondent has induced others to infringe claims 1 and 28 of the '439 patent through use of the accused OXE system products.

IX.   Enforceability ('289 And '439 Patents)

Respondent argued that each of the '289 patent and '439 patent are unenforceable due to inequitable conduct.[29] It is argued that, during the prosecution of the application that led to the '289 patent, Microsoft never informed the Examiner about the co-pending application for the '439 patent, despite the "substantial similarities" between the specifications and claims of the '289 patent and the '439 patent, which failure means that Microsoft did not submit material information of which it was aware to the Examiner regarding the '289 patent. (RBr at 99.) Respondent also argued that a Brennan reference cited in the prosecution of the '439 application

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[29] Respondent, in its preheairng brief, had alleged that the '357 patent was unenforceable due to inequitable conduct. Respondent has, however, waived said argument, because it presented no argument in its post hearing submissions, including its proposed finding of fact, regarding said issue. Moreover, respondent has offered no relevant objections to complainant's proposed findings of fact regarding said issue. (See generally CPFF 3641 - CPFF 3666.)

(JX-5)[30] disclosed the element upon which the applicant distinguished the prior art in the '289 application. (RBr at 101.) Similar arguments by respondent were made as to the '439 patent. Thus it was argued that the '289 application was never disclosed to the Examiner reviewing the '439 application and that a DeSimone reference cited in the prosecution of the '289 application (JX-6) disclosed the element upon which the applicant distinguished the prior art in the '439 application. (RBr at 128-30.)

Complainant argued that because respondent has failed to provide evidence of either materiality or intent to deceive, respondent's allegation of inequitable conduct relating to the prosecutions of the '439 and '289 patents should be rejected. It was also argued that the Brennan reference was not material to the '289 application and that the DeSimone reference was not material to the '439 application. (CBr at 173-9.)

The staff argued that the evidence of record does not establish an intent to deceive the Patent Office and hence the '439 and '289 patents have not been shown, by clear and convincing evidence, to be unenforceable based on inequitable conduct. (SBr at 92-3.)

To prove inequitable conduct in the prosecution of a patent, the challenging party must provide clear and convincing evidence of "affirmative misrepresentations of a material fact, failure to disclose material information, or submission of false material information, coupled with an intent to deceive." Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1327 (Fed. Cir. 1998). To determine this issue, a court must follow a two-step analysis: "first, a determination of whether the withheld reference meets a threshold level of materiality and intent to mislead, and second, a weighing of the materiality and intent in light of all the circumstances to determine

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[30] See Section VI.A.3 supra.

whether the applicant's conduct is so culpable that the patent should be unenforceable." GFI, Inc.

v. Franklin Corp., 265 F.3d 1268, 1273 (Fed. Cir. 2001). Both materiality of the reference and

intent to deceive must be independently established. Key Pharms. v. Hercon Labs. Corp., 161

F.3d 709, 719 (Fed. Cir. 1998) (requiring independent threshold findings of materiality and

intent). Moreover materiality does not presume intent, which is a separate and essential

component of inequitable conduct. Sanofi-Synthelabo v. Apotex, Inc., 470 F.3d 1368, 1381 (Fed.

Cir. 2006). Also, "[i]ntent to deceive 'cannot be inferred solely from the fact that information

was not disclosed; there must be a factual basis for a finding of deceptive intent.'" Kao Corp. v.

Unilever U.S. Inc., 441 F.3d 963, 972 (Fed. Cir. 2006).

In the first step, the court must determine whether the withheld reference meets a

threshold level of materiality and whether the evidence shows a threshold level of intent to

mislead the Patent Office. Baxter, 149 F.3d at 1327. "The more material the omission, the less

culpable the intent required, and vice versa." Halliburton Co. v. Schlumberger Tech. Corp., 925

F.2d 1435, 1439 (Fed. Cir. 1991). As to materiality, a reference, even if it is not prior art, is

deemed material if there "is a 'substantial likelihood that a reasonable examiner would consider

it important in deciding whether to allow the application to issue as a patent.'" Id. at 1440

(quoting 37 C.F.R. § 1.56 (1989)). However, "a patentee need not cite an otherwise material

reference to the PTO if that reference is merely cumulative or is less material than other

references already before the examiner." Baxter, 149 F.3d at 1328.

When weighing "whether uncited prior art is more material than that before the

Examiner, a trial court considers similarities and differences between prior art and the claims of

the patent [and] must consider portions of prior art references which teach away from the claimed

invention." Halliburton, 925 F.2d at 1440. Inequitable conduct also requires an intent to act inequitably. GFI, 265 F.3d at 1274. The intent element of the offense is therefore proven by inferences drawn from facts, with the collection of inferences permitting a confident judgment that deceit has occurred. Id.

Once the threshold levels of materiality and intent have been established, the trial court must weigh materiality and intent. Molins PLC v. Textron, Inc., 48 F.3d 1172, 1178 (Fed. Cir. 1995). The more material the omission, the less evidence of intent will be required in order to find that inequitable conduct has occurred. N.V. Akzo v. E.I. du Pont de Nemours & Co., 810 F.2d 1148, 1153 (Fed. Cir. 1987). In light of all the circumstances, the court must then determine whether the applicant's conduct is so culpable that the patent should be held unenforceable. LaBounty Mfg., Inc. v. United States Int'l Trade Comm'n, 958 F.2d 1066, 1070 (Fed. Cir. 1992).

Respondent, relying on its assertion that Nydegger and Israelsen were the prosecuting attorneys of the application for the '289 patent (RBr at 97), argued that in the prosecution of the application that led to the '439 patent, Microsoft never informed the Examiner about the co-pending application for the '289 Patent. (RFF V.C.5.2.) {

} The administrative law judge finds said testimony of

Nydeggar and Israelsen unrefuted by any hearing testimony.

Respondent further argued that Israelsen and Reed were responsible for the prosecution of

the '439 patent. See RRCPFF 3516 A. {

}

With respect to the materiality of the Brennan patent as it affects the '289 patent, the

Examiner for the '439 patent application described the Brennan reference as follows:

> Regarding claims 1, 21, 28, and 38, Brennan teaches a system,
> method, and a computer readable medium for user specifications of

call processing in a telephone network having a user telephone (Fig. 1, 15-17) coupled to the telephone network (Fig. 1, 12), the system comprising: a data structure contained within a computer network (Fig. 1b, 10) to store user selectable criteria for call processing (Fig. 1b, 24); a computer network access port used by the telephone network to access the data structure (Fig. 1c); and a controller (Fig. 1c, 48) to receive an incoming call designated for the user telephone 15-17 and to process the incoming call in accordance with the user-selectable criteria (column 3, line 54 through column 4, line 18), the controller accessing the data structure via the computer network access port and thereby applying the user-selectable criteria to the incoming call (column 4, lines 19-35)

* * *

Regarding claims 6, 23, 33, and 45, Brennan further teaches the system wherein the user-selectable criteria indicates no permission to process the incoming call, the controller blocking the incoming call and not generating a ring signal at the user telephone (when the caller is directed to voice mail, the user telephone will not be rung).

* * *

Regarding claims 9, 24, 36, and 48, Brennan further teaches the system wherein the user-selectable criteria indicates permission to process the incoming call during a user-selected time period, the controller processing the incoming call during the user-selected time period in accordance with the permission to generate a ring signal at the user telephone, the controller blocking the incoming call and not generating a ring signal at the user telephone during a time period other than the user-selected time period (column 6, lines 46-48.)

(JX-5 at MSAL 00588-00590.) Based on this description, the administrative law judge finds that

the Brennan patent, does not contemplate the limitations in the asserted claims for the '289 patent

calling for "monitored activity" and "processing the call according to said monitored activity."

The administrative law judge further finds that the pre-determined rules claimed in the '289

patent are essential to the functioning of the invention claimed as they are used to process

information regarding the monitored activity of the user computer to determine where the telephone call should be routed. (JX-2 at 18:55-61.)

As for any materiality of the DeSimone patent as it affects the '439 patent the Examiner for the '289 patent described the DeSimone patent as follows:

> DeSimone discloses an interactive chat room whereby one participant to an on-line chat may give information, e.g., credit card information, his/her phone number, to a 3rd party in order to obtain another chat room participant's phone number so that both chat room participant's may engage in a private telephone conversation. DeSimone shows a telephone network (PSTN-130) and an independent computer network (Internet-100). An originating telephone (103) is associated with a calling party and is coupled to the PSTN (130), along with a destination telephone (114) associated with the called telephone (114). PC (102) is associated with calling party (102) who is engaged in an Internet chat session and PC (113) is associated with the called party. A call processor will set up a telephone call from the calling party (102/103) to the called party (113/114) based upon the status of the calling and called parties' computer status. Both the calling and the called parties' computer status will be "busy" in order that a telephone call can be set up between the parties.

(JX-6 at MSAL 01497 (emphasis added).) Based on this description, the administrative law judge finds, and the parties agree, that the DeSimone patent "uses an affirmative request from both participants to initiate the call in an anonymous manner through a broker." (CPFF 3633 (undisputed).) Hence, the administrative law judge finds that the DeSimone patent does not disclose assessing both caller (e.g., subscriber) and callee (e.g., user) activity, as do the asserted claims of the '439 patent, in order to determine the appropriate action to take with respect to an incoming telephone call. Furthermore, based on the description, supra, the administrative law judge finds that the DeSimone patent does not disclose any user-selected criteria for filtering or processing a telephone call as recited in asserted claims.

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Based on the foregoing the administrative law judge finds that respondent has not

established, by clear and convincing evidence, that the '439 and '289 patents are unenforceable.

X.   Domestic Industry

To invoke the protection afforded by Section 337, a complainant must show by a

preponderance of the evidence that a domestic industry exists or is in the process of being

established within the United States. The domestic industry requirement has two prongs: an

"economic" prong and a "technical" prong.

On September 5, 2007, the administrative law judge issued Order No. 9, which granted

complainant's motion for summary determination that it satisfied the economic prong of the

domestic industry requirement. On September 20, 2007, the Commission determined not to

review Order No. 9.

The "technical" prong requires that the activities alleged to constitute a domestic industry

actually utilize the intellectual property at issue. In the context of a patent-based investigation,

the technical prong is satisfied if the complainant demonstrates that it is practicing at least one

claim of each of the patents-in-issue. The test for claim coverage for purposes of the domestic

industry requirement is the same as that for infringement. The technical prong of the domestic

industry can be satisfied either literally or under the doctrine of equivalents. Certain Excimer

Laser Systems for Vision Correction Surgery and Components Thereof and Methods for

Performing Such Surgery, Inv. No. 337-TA-419, Order No. 43, 1999 ITC LEXIS 245, *7 (July

30, 1999). The complainant, however, is not required to show that it practices any of the claims

asserted to be infringed, as long as it can establish that it practices at least one claim of the

asserted patent. Certain Point of Sale Terminals and Components Thereof, Inv. No. 337-TA-524,

Order No. 40, 2005 ITC LEXIS 374, *26 (Apr. 11, 2005).

A.   The Liffick Patents

1.   Products In Issue

The Microsoft systems in issue are:

(i) Microsoft Office Communicator 1.0 ("OC 1.0") in association with Live
Communications Server 2005 (LCS) LCS System"); and

(ii) Microsoft Office Communicator 2.0 ("OC.2.0") in association with Office
Communications Server 2007 ("OCS") "OCS System").)[31]

(CBr at 118.) Both LCS and OCS Systems work in combination with the Microsoft Exchange

Server 2007, which includes Outlook Web Access and Outlook Voice Access, to provide

Microsoft customers with a broad range of options and features. (Chang, Tr. at 607:14-608:2.)

(CPFF 133 (undisputed).) The LCS and OCS provide centralized call management conferencing,

video collaboration, instant messaging, and other related capabilities. (Chang, Tr. at 464:20-23;

CDX-20.) (CPFF 134 (undisputed).) LCS or OCS are connected to personal computers that are

running either version 1.0 or 2.0 of OC software, respectively, over the computer network.

(Serafin, Tr. 234:18-20, 235:16-236:20; CDX-20.) (CPFF 135 (undisputed).) The Office

Communicator software works in conjunction with the LCS and OCS and collectively provides a

very broad range of communication services. (Chang, Tr. 465:9-12; CDX-20.) (CPFF 136

(undisputed).) OCS and LCS serve to support communications on the Office Communicator

client. (Chang, Tr. 464:23-25; CDX-20.) (CPFF 137 (undisputed).) "Client" refers to a computer

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[31] Complainant has used the generic term "Microsoft System" to refer to either the LCS
System or the OCS System in conjunction with the other system components because the
technical analysis for domestic industry is identical for the LCS and OCS Systems. (CBr at 118-
19; CPFF 149.)

program that executes on the computer, for instance, PC 1 and PC 2. (Chang, Tr. 464:25-465:2; CDX-20.) (CPFF 1388 (undisputed).)

Microsoft has two versions of the Office Communicator ("OC"). (Chang, Tr. 465:4-5; CDX-20.) (CPFF 139 (undisputed).) OC 1.0 is an older version of Office Communicator and OC 2.0 is a newer version of the Office Communicator. (Chang, Tr. 465:6-8; CDX-20.) (CPFF 140 (undisputed).) The LCS/OCS server is necessary for the Microsoft System to connect people who are trying to send instant messages to each other. (Serafin, Tr. 253:13-254:21.) (CPFF 141 (undisputed).) The domestic industry systems with respect to the Liffick patents further include a Microsoft-supplied CSTA software module, called Remote Call Control (or "RCC"), and a legacy PBX. (Chang, Tr. 608:13-24.) (CPFF 142 (undisputed).) The Microsoft System includes a module called Remote Call Control ("RCC") that connects the elements on the OCS and LCS and Exchange to the Legacy PBX. (Chang, Tr. 466:4-6; CDX-20.) (CPFF 143 (undisputed).) RCC is a module that uses the CSTA protocol. (Chang, Tr. 466:6-9; CDX-20.) (CPFF 144 (undisputed).) RCC is a software using a gateway protocol called CSTA, and can enable communication between Microsoft Office Communicator via the LCS/OCS server and a PBX. (JX-29C (Tidwell Depo.) at 27:6-10, 41:25-42:1.) (CPFF 145 (undisputed).) CSTA allows computers to communicate with a Legacy PBX, which connects in turn to the outside PSTN world. (Chang, Tr. 466:9-14; CDX-20.) (CPFF 146 (undisputed).) Microsoft OC 1.0, OC 2.0, LCS, OCS, and Microsoft Exchange Server 2007, including Outlook Web Access and Outlook Voice Access are software products. (Serafin, Tr. 354:16-355:8; JX-14C (Borgman Depo.) at 29:13-20.) (CPFF 147 (undisputed).)

2.   Technical Prong

a. '289 Patent (Claim 1)

Regarding the products in issue and the Liffick '289 patent the private parties on October

11, 2007 submitted a joint stipulated order regarding domestic industry.[32] In said order, the

parties stipulated to the following:

> 1. The parties hereby stipulate that in regard to US. Patent No. 6,430,289 ("the
> '289 Patent") . . . the Microsoft Domestic Industry products Microsoft Office
> Communicator 1.0 in association with Live Communications Server 2005,
> Microsoft Office Communicator 2.0 in association with Office Communications
> Server 2007, and Microsoft Exchange Server 2007, which includes Outlook Web
> Access and Outlook Voice Access, meet the limitations of claim 1, except the
> following elements underlined below:

>> 1. In a system that includes a telephone network and a
>> computer network with one or more users, wherein each user is
>> connected through a user computer the computer network and is
>> logically connected through the computer network to the telephone
>> network, a method of determining when to establish telephone
>> communication between two parties, at least one of whom is a user
>> connected to said computer network, comprising:

>> at the computer network, receiving information from the
>> telephone network that a first party from whom a call is originating
>> desires to establish telephone communication with a second party;

>> at the computer network, monitoring activity of a user
>> computer connected to the computer network and associated with
>> the second party;

>> at the computer network, storing a set of pre-determined
>> rules for determining when the second party is available to take a
>> call from the first party;

>> at the computer network, using the set of a pre-determined
>> rules to process i) the information received from the telephone

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network regarding the call being originated by the first party, and
ii) information regarding; the monitored activity of the user
computer of the second party, to determine when the second party
is available to take the call originated by the first party;

and using the information processed at the computer
network to facilitate connecting the call originated by the first party
through the telephone network to the second party.

2. The parties hereby stipulate that in regard to U.S. Patent No. 6,430,289 ("the
'289 Patent") . . . the Microsoft Domestic Industry Products Microsoft Office
Communicator 1.0 in association with Live Communications Server 2005,
Microsoft Office Communicator 2.0 in association with Office Communications
Server 2007, and Microsoft Exchange Server 2007, which includes Outlook Web
Access and Outlook Voice Access, meet the following limitations of claim 7,
except the elements underlined below:

7. In a system that includes a telephone network and a
computer network with one or more users, and wherein each user is
connected through a user computer to the computer network and is
logically connected through the computer network to the telephone
network, a computer program product comprising:

a computer readable medium for carrying computer
executable instructions for implementing at the computer network
a method of determining when to establish telephone
communication between two parties, at least one of whom is a user
connected to said computer network, and wherein said method
comprises:

at the computer network, receiving information from the
telephone network that a first party from whom a call is originating
desires to establish telephone communication with a second party;

at the computer network, monitoring activity of a user
computer connected to the computer network and associated with
the second party;

at the computer network, storing a set of predetermined
rules for determining when the second party is available to take a
call from the first party;

and at the computer network, using the set of predetermined

rules to process i) the information received from the telephone network regarding the call being originated by the first party, and ii) information regarding the monitored activity of the user computer of the second party, to determine when the second party is available to take the call originated by the first party.

The Claimed Phrase "at the computer network, monitoring activity of a user computer connected to the computer network and associated with the second party" (Limitation A)

Complainant argued that being on a VoIP call constitutes "activity" under either party's construction of this term. (CBr at 129.) Under Microsoft's construction of "activity" as "status," PC 1 purportedly would be in a "busy" state when engaged in a VoIP call via the Office Communicator application, and free otherwise. (CBr at 129-30, citing CPFF 2621-22, 2629-35.) Under ALE's construction of "activity" as "active or idle," PC 1 would purportedly be "active" when engaged in a VoIP call, because the computer is executing the Office Communicator software application. (CBr at 130, citing CPFF 2623-24.) Complainant further argued that while executing the softphone application, the computer PC 1 is also running other software programs involved in capturing the user's voice, compressing the voice information, digitizing the voice, packetizing the digitized and compressed voice information into digital packets for transmission over the network, and transmitting various control information. (CBr at 130, citing CPFF 2625, 2636.) At the same time, the computer also purportedly receives incoming voice data packets, and must reverse the digitizing and compression process to render the analog voice over its speakers. (CBr at 130, citing CPFF 2626.) Complainant further argued that while performing these tasks, the computer actively monitors and responds to various inputs from the user's keyboard and mouse, allowing the user to perform other tasks while engaged in a VoIP call. (CBr at 130, citing CPFF 2627-28.)

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Respondent argued that complainant's expert Chang relied upon the same example of activity for both the '439 and the '289 patents, viz., the called party being engaged in a VoIP softphone call. (RBr at 136, citing RFF VI.B.2.1, RFF VI.B.2.2.) Respondent argued that Chang's only example involves the Microsoft Communicator application, not the OWA and OVA applications (RBr at 136); and that when incoming calls are processed based on a called party being busy on a VoIP softphone telephone call, those calls are not being routed based on the called party's activity or status on a computer network or a computer. (RBr at 136.) Rather, it is argued that the incoming calls are being processed in the same way they would be processed if the called party was busy on a telephone handset. (RBr at 136, citing RFF VI.B.2.3.) Thus, respondent argued that this example of call processing in the Microsoft domestic industry products does not demonstrate that the products route calls based on either the current activity of the user on the computer network, or the activity of the user computer. (RBr at 136.)

The staff argued that the evidence shows that complainant's domestic industry products are covered by claim 1 of the '289 patent under the correct claim construction. (SBr at 68.) It is argued that respondent's expert did not offer any testimony concerning the technical prong of the domestic industry requirement. (SBr at 68, citing Tr. at 1455.) The staff also argued that although complainant's expert applied an incorrect construction of the "activity" limitation, the evidence nevertheless shows that the Microsoft System can route calls based on whether the user is "active or idle" on his or her computer. (SBr at 68.)

The parties agree that the Live Communications Server (LCS) is a server software that provides real-time communication services such as telephony, presence, instant messaging, and audio and video. (CPFF 150 (undisputed).) They also agree that the LCS System includes among

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other components: (i) LCS server software that provides real-time communication services; (ii) the OC 1.0 software application which runs on a computer connected to the LCS and which provides a number of unified communications options, including softphone features; and (iii) a Legacy PBX connected to the LCS via the RCC module. (CPFF 151 (undisputed).) The parties further agree that the LCS is connected through a network to the Legacy PBX and to one or more client computers, and that it communicates with a PBX via Microsoft Office Communicator and the CSTA gateway: the CSTA gateway is a bridge between Microsoft Office Communicator and the PBX. (CPFF 153, 152 (undisputed).)

The administrative law judge has found in Section VI.A.1, supra, that the phrase "activity of a user computer" means determining whether the user computer is "active or idle." Furthermore, the '289 patent specification describes the activity of a user computer as follows: "[a] user's computer activity may also be monitored and the computer status as idle or active may be reported to the computer network as part of the call processing criteria." (JX-2 at Abstract.); "[i]n addition, the potential callee's computer activity may be monitored and the status of the computer as idle or active may be reported to the computer network." (JX-2 at 2:15-18); "[t]he system 100 can monitor computer activity and generate signals to both the originating telephone 102 and the destination telephone 104 when the callee computer 154 and the caller computer 184 are not in the idle state" (JX-2 at 14:50-53); and "[i]n this manner, the system 100 can monitor computer activity and determine when the caller and callee may both be available for a telephone call and further applies call processing criteria for both the caller and callee." (JX-2 at 15:4-7.)

Additionally, complainant's expert Chang testified to the following regarding the activity of a computer for this claim limitation and domestic industry:

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Q. So now if we can turn to the '289 patent, if I can direct your attention to CDX-211. ABS has stipulated with respect to the '289 patent certain limitations, so we will turn to the disputed limitations, but just for the record, is it your opinion that the domestic industry system meets the limitations set forth in CDX-211 through 213?

A. Yes, it does.

Q. And is the basis for your opinion set forth in those slides and the documents cited on those slides?

A. That's correct.

Q. So if I can direct your attention then to CDX-214, the disputed claim limitation is "at the computer network, monitoring activity of a user computer connected to the computer network and associated with the second party."

Is it your opinion that the domestic industry system meets this limitation?

A. Yes, it does.

Q. And can you explain the basis for your opinion?

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Q. If I can direct your attention to CDX-215, in your opinion, does the domestic industry system meet the limitations that are set forth in CDX-215?

A. Yes, it does.

Q. And can you explain the basis for your opinion?

A. Sure. Similar to the previous analysis, I have shown two users, user 1 and user 2 engaged in a Voice over IP call using their Office Communicator cell phone feature. And the caller, which in this case is a user who is attempting to establish a call with user 1 running on his computer using Office Communicator software, because user 1 is engaged in a telephone call, therefore, user 1's computer is in a busy state. And that condition is detected by the LCS and OCS and the Legacy PBX as shown in this diagram is directed to redirect the call to the call forwarding target, which in this case is user B.

So at the end, user A becomes connected to user B because the original called party, user 1's computer was in a busy state.

Q. And so, again, is it your opinion that being on a VoIP call constitutes computer activity?

A. That's correct.

Q. So in your opinion, does the domestic industry system meet claim 1 of the '289 patent?

A. Yes, it does.

(Tr. at 618:2-620:20 (emphasis added).) Also Zig J. Serrafin[33] testified to the following

regarding the capability of the Microsoft System:

A. There are certain set of rules that Office Communicator allows users to change in order to be able to customize their communication experience.

Q. Can you give the Court some examples of how a user might customize his or her experience using Office Communicator?

A. Yes. An example would be if I'm busy in a meeting, I can let my calendar system inside the Exchange know that during the times when I am busy, my phones should automatically be put on

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[33] Serrafin is a general manager in Microsoft's Unified Communications Group. (Tr. at 233.)

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"do not disturb" so I am not interrupted in the middle of a meeting.

Another example would be that if I am making a
presentation and I am using PowerPoint, the moment my computer
launches the PowerPoint in order to make my presentation, the
computer network can let all of my voice communication devices,
in this case my phones, know that I should not be disturbed and so
the rule can be set to allow people not to interrupt me when I am
actually busy, as an example.

So those are just a couple of examples.

Q.   What would happen if someone tried to call you while you
were using your computer to speak with Ms. Green?

A.   The call could be intercepted and rerouted. I could actually
automatically have the call go to voice mail. I could have it
rerouted to another phone, as an example.

Q.   And what is that feature called?

A.   That feature would be called forward on busy or forward on
do not -- do not disturb if I am busy, those are some examples of
that.

(Tr. at 265:25-267:10 (emphasis added).) In addition the administrative law judge finds that the

deposition testimony in CPX-10 discloses the ability of the Microsoft System to route calls

according to user-selected criteria when the user is performing certain activity. (CPX-10 at 3-5

minutes, 7-8 minutes.) For example, the Microsoft System user can set the system to route calls

to a particular destination when the user is using the PowerPoint software. (CPX-10 at 3-5, 7-8

minutes.)

Based on the foregoing, the administrative law judge finds that the user computer is

"active" when the Microsoft System is engaged in a VoIP call or when the user is using

PowerPoint and as such, the user computer is necessarily active when the user is engaged in these

activities. Thus, the administrative law judge finds that a user computer is undertaking activity when the Microsoft System is engaged in a VoIP call as the computer is necessarily performing certain tasks and is interacting with the Legacy PBX in order to successfully transmit and receive data between the computer and telephone networks. (CRRFF VI.B.2.1-F.) The administrative law judge also finds that the user computer is undertaking activity when the Microsoft System user is using the PowerPoint software. The administrative law judge accordingly finds that the Microsoft System monitors such activity of a user computer when it checks for the "active" or "idle" nature of the user's computer to determine if it needs to reroute a phone call when the computer is already engaged in a VoIP call or using PowerPoint. (CPFF 2631, 2632, 2634; CPFF 633 (undisputed); SRCFF 2641.) Thus, the administrative law judge finds that the complainant has established that the Microsoft System satisfies Limitation A.

> The Claimed Phase "at the computer network, using the set of pre-determined rules to process . . . ii) information regarding the monitored activity of the user computer of the second party, to determine when the second party is available . . . " (Limitation B)

Complainant argued that the Microsoft System uses the pre-determined rules to process (i) information received from the telephone network regarding the call originated by the caller and (ii) information regarding the monitored activity of the user computer of the callee, to determine when the callee is available to take the call from the caller. (CBr at 130-31.) By selecting one or more of the pre-determined rules allowed by the Office Communicator software, complainant argued that the user can instruct the Microsoft System, for example, to block or allow certain callers to reach the user based on certain times when the user would be available or otherwise engaged in a VoIP call. (CBr at 131, citing CPFF 2638-89.) Complainant further

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argued that the Microsoft System uses those sets of pre-determined rules and then processes two sets of information, one from the telephone network and the other from the computer. Complainant in addition argued that the information regarding the monitored activity of the callee's computer is the status of the computer, for example, PC 1 in CDX-115, running the softphone software application. (CBr at 131, citing CPFF 2641.)

Respondent argued that at the hearing, complainant's expert Chang relied upon the same example of activity for both the '439 Patent and the '289 Patent, namely, the called party being engaged in a VoIP softphone call. (RBr at 136, citing RFF VI.B.2.1, RFF VI.B.2.2.) It is argued that Chang's only example involves the Microsoft Communicator application, not the OWA and OVA applications. (RBr at 136.) It was again argued that when incoming calls are processed based on a called party being busy on a VoIP softphone telephone call, those calls are not being routed based on the called party's activity or status on a computer network or a computer. (RBr at 136.) Rather, respondent argued that the incoming calls are being processed in the same way they would be processed if the called party was busy on a telephone handset. (RBr at 136, citing RFF VI.B.2.3.)

The staff argued that the evidence shows that complainant's domestic industry products are covered by claim 1 of the '289 patent under the correct claim construction. (SBr at 68.) It is argued that although complainant's expert applied an incorrect construction of the "activity" limitation, the evidence nevertheless shows that the Microsoft System can route calls based on whether the user is "active or idle" on his or her computer. (SBr at 68-69.)

The '289 patent specification defines certain rules with respect to affiliation lists as follows:

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Alternatively, the user may still maintain the block list 164 such that calls will not be processed from certain specified parties even if the user is willing to accept calls from any other source. Under other circumstances, the user may not wish to communicate with any individuals. In this instance, the user may indicate that all calling parties are on the block list 164. Thus, the central office switch 116 will access the Internet 134 in real-time and review data in the affiliation list 150 to thereby process incoming calls for the user in accordance with the rules present in the affiliation list.

(JX-2 at 9:21-31.) The specification further defines user-selectable criteria being applied in conjunction with the status of both the caller and the callee:

These rules may be applied differentially to different ones of the list in the affiliation list 150. For example, the user may accept calls from any calling party on the forward list 160 (see FIG. 3) or the allow list 166 during the evening hours. However, after a certain time at night, the caller may accept calls only from calling parties on the forward list 160. Thus, the system 100 allows great flexibility in the user selection of calling rules and lists. The system 100 allows the user to filter incoming calls in accordance with generalized rules or in accordance with highly specific rules.

In addition to filtering incoming calls to the destination telephone 104, the system 100 can monitor the status or activity of both the caller and the callee and establish a communication link between the originating telephone 102 and the destination telephone 104 when the status data indicates that both the caller and callee are available for a telephone conversation. The system 100 has been previously described with respect to callee status monitoring and processing of incoming calls in accordance with the user-selected (i.e., the callee-selected) call processing criteria. Similar status monitoring can be performed for the caller.

(JX-2 at 13:58-14:11.) The specification also describes the system's consideration of both user selected criteria and the status of a user on the computer network:

The system 100 can monitor computer activity and generate signals to both the originating telephone 102 and the destination telephone 104 when the callee computer 154 and the caller computer 184 are not in the idle state. The fact that both computers' are not in the idle

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state indicates that the users of each respective computer may be available for a telephone conversation. In addition, the system 100 can apply call processing rules that may also govern operation of the telephone portion of the system 100. For example, the callee computer 154 may be in an "active" state (as opposed to the idle state) but the user has indicated that he should not be disturbed at the present time. Thus, the central office switch 116 or the call processor 176 accesses the affiliation list 150 for the destination telephone 104 to determine the callee-selected call processing criteria. In addition, the central office switch 116 or the call processor 176 can access the affiliation list 150 for the caller and apply any caller-selected call processing rules. For example, the caller computer 184 may be in the active state, but the caller status in the affiliation list 150 may indicate that the caller is in a meeting and is, therefore, unavailable for a telephone call with the callee. In this manner, the system 100 can monitor computer activity and determine when the caller and callee may both be available for a telephone call and further applies call processing criteria for both the caller and callee. The call processing criteria for the caller and callee as well as the current status of the callee computer 154 and the caller computer 184 are stored within the respective affiliation lists 150 on the Internet 134. This data may be accessed by the central office switch 116 or the call processor 176 via the network connection 132 in the manner previously described.

(JX-2 at 14:50-15:13.)

The administrative law judge has found, supra, as to Limitation A of claim 1, that the user computer is "active" when it is engaged in a VoIP call or when the user is running PowerPoint. The administrative law judge has also found, as to Limitation A, that the Microsoft System monitors activity of a user computer such as running of VoIP software or PowerPoint, when it checks if a user computer is in "active" or "idle" status in order to determine if it needs to reroute a phone call based on any user-selected preference. Hence, the administrative law judge further finds that the complainant has established that the Microsoft System satisfies Limitation B because it either connects the telephone call or reroutes it when the callee is engaged in a VoIP

call or PowerPoint.

The Claimed Phrase "and using the information processed at the computer network to facilitate connecting the call . . . " (Limitation C)

Complainant argued that based on the information processed at the computer network, the call handling module inside the Legacy PBX facilitates, i.e., helps bring about, the connection of the incoming call with the user-callee if the System determines that he is available, the re-routing of the incoming call to a pre-set destination if the user-callee is otherwise unavailable, or even the forwarding of the incoming call to the user-callee's own cellular telephone if he is engaged on a VoIP call. (CBr at 132, citing CPFF 2649; CDX-215 and documents cited thereon.)

Respondent argued that in the Microsoft System when incoming calls are processed based on a called party being busy on a call using a soft phone, such calls are not being routed based on the called party's activity or status on a computer network or a computer. (RRBr at 69.) Rather, respondent argued that the incoming calls are being processed in the same way they would be processed if the called party was busy on a standard telephone handset. (RRBr at 69, citing RFF VI.B.2.3.)

The staff argued that with respect to the "to facilitate connecting the call . . . to determine when the second party is available to take the call" limitations, it is clear from Mr. Chang's testimony that the Microsoft system at least allows the user to determine which calls are routed to him and which calls are blocked, thus satisfying the limitations calling for facilitating or determining when to connect the calls. (SBr at 68, citing Tr. at 611-12.)

In light of the findings supra, as to Limitations A and B of claim 1 the administrative law judge further finds that the capability of the Microsoft System to route calls according to

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information, such as computer status or specific user-selected criteria, determines the ultimate destination that will receive the call. For example, by either connecting a call to the initial destination or by rerouting the call to an alternate one, the Microsoft System uses said information to establish a connection between the caller and callee. Thus, the administrative law judge finds that the complainant has established that the Microsoft System satisfies Limitation C.

Based on the foregoing, including the administrative law judge's findings as to Limitations A, B and C of claim 1 of the '289 patent, the administrative law judge finds that complainant has established the technical prong of the domestic industry requirement with respect to the '289 patent.

b.   '439 Patent (Claim 1)

Complainant argued that although Commission precedent only requires a domestic industry for one valid claim of the '439 patent, the evidence presented at the hearing demonstrates that the "Microsoft System" practices at least claims 1, 28 and 38 of the '439 patent.

Respondent argued that Microsoft cannot satisfy the technical prong of the domestic industry requirement for the '439 patent. (RBr at 135.) It argued that all of complainant's expert Chang's examples of activity for the '439 patent with respect to the domestic industry products are of the called party being busy on a VoIP softphone call (RFF VI.A.2.), which is the same example of activity Chang relies upon for his examples of infringement in the accused ALE systems. (RFF VI.A.3; RBr at 135.)

The staff argued that the evidence shows that complainant's domestic industry products are covered by claims 1, 28, and 38 of the '439 patent under the correct claim construction. (SBr

at 66.) The staff argued that the testimony of complainant's expert generally satisfies complainant's burden of showing that its products practice claim 1 of the '439 patent. (SBr at 67, citing Tr. at 611-15.)

> The Claimed Phrase "In an environment where subscribers call a user over a telephone network, wherein a user telephone is coupled with the telephone network, a system for processing an incoming call . . . " (Limitation D)

Complainant argued that the Microsoft System allows subscribers (i.e., callers) to call a user (i.e., callee) over a telephone network, with the user's telephone being coupled to the telephone network (CBr at 119, citing CDX-190 & CDX-191; see also CPFF 2510-2514); that as complainant's expert Chang explained at the hearing, the caller, who is called a "subscriber" in the claims of the '439 patent and represented on CDX-190 by his blue-highlighted telephone, is connected to the PSTN (CBr at 119, citing CPFF 2515 (Tr. at 609:16-610:3; CDX-190)); and that the callee, called a "user" by the claims, appears on CDX-191 as someone using his Office Communicator 1.0 or 2.0 software program's softphone feature on his computer PC 1, which is coupled to the local area network and ultimately to the PSTN. (CBr at 119, citing CPFF 2516-19.) Complainant further argued that the Microsoft System processes an incoming call according to the user's specifications. (CBr at 120, citing CPFF 2524-25); and that the user of the Microsoft System can purportedly use his Office Communicator interface to set various call processing features, such as selective forward-on-busy where the system deflects his incoming calls to a pre-defined destination when he is engaged on a softphone call while still allowing important callers to interrupt him. (CBr at 120.)

Respondent did not offer any arguments for the preamble of claim 1 with respect to domestic industry. (See RBr at 134-136; see also RRBr at 68-69.)

The staff did not offer any arguments for the preamble of claim 1 with respect to domestic industry. (See SBr at 66-68; SRBr at 32-34.)

It is undisputed that the Microsoft System allows subscribers (i.e., callers) to call a user (i.e., callee) over a telephone network, with the user's telephone being coupled to the telephone network. (CPFF 2513 (undisputed).) It is also undisputed that because a user of the Microsoft System can use his computer to execute OC 1.0 or 2.0 as a VoIP softphone that is connected to the caller on the PSTN, the Microsoft System meets the limitation "wherein a user telephone is coupled with the telephone network." (CPFF 2519 (undisputed).) It is further undisputed that the Microsoft System meets the limitation "a system for processing an incoming call from a subscriber to a user in the telephone network according to user specifications." (CPFF 2525 (undisputed).) In light of the foregoing, the administrative law judge finds that the complainant has established that the Microsoft System satisfies Limitation D of claim 1.

> The Claimed Phrase "a data structure contained within a computer network to store user-selectable criteria for call processing . . . wherein some of the one or more lists are used to filter the incoming call according to current activity of subscribers on the computer network or according to current activity of the user on the computer network " (Limitation E)

Complainant argued that the Microsoft System includes a data structure contained within a computer network to store user-selectable criteria in one or more lists that are used to filter an incoming call. (CBr at 121, citing CPFF 2526, 2527, 2536-40); and that as shown in complainant's expert Chang's demonstratives, the list on CDX-193 is a "buddy list" or more generally a list of contacts for a particular user. (CBr at 121, citing CPFF 2528-30.) Complainant also argued that through his Office Communicator software interface, the user can edit permissions related to each of the contacts on the list, designating a given contact as someone

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who the system should block or allow to reach the user under certain situations (CBr at 121, citing (CPFF 2531-34)); and that the permissions constitute user-selectable criteria for call processing that are stored on the LCS/OCS server computer. (CBr at 121, citing CPFF 2535.) Complainant further argued that Chang showed how the system handled an incoming call from User A to User 1 where User 1 is currently engaged in Voice over IP call with User 2. (CBr at 122, citing CDX194, CPFF 2541-44.) Complainant in addition argued that when the Legacy PBX informs the LCS/OCS server that there is an incoming call from User A for User 1, the LCS/OCS server knows that User 1's status is "busy" because there is activity on his computer. (CBr at 122, citing CPFF 2545, 2553-55.) According to complainant, such activity includes User 1's computer's execution of the Office Communicator software application as well as running other software programs involved in capturing the user's voice, compressing the voice information using various standard CODECs, digitizing the voice, and then packetizing the digitized and compressed voice information into digital packets for transmission over the network (CBr at 122, citing CPFF 2546-50) and that at the same time, the computer purportedly also receives incoming voice data packets, and must reverse the digitizing and compression process to render the analog voice over its speakers. (CBr at 122-23, citing CPFF 2551.) Complainant argued that while performing these tasks, the computer actively monitors and responds to various inputs from the user's keyboard and mouse, allowing the user to perform other tasks, such as sending instant messages, while engaged in a VoIP call. (CBr at 123, citing CPFF 2552.)

Respondent argued that Chang relied upon the same example of activity for both the '439 and the '289 patents, viz., the called party being engaged in a VoIP softphone call. (RBr at 136,

citing RFF VI.B.2.1, RFF VI.B.2.2.) It is argued that Chang's only example involves the

Microsoft Communicator application, not the OWA and OVA applications. (RBr at 136); that

when incoming calls are processed based on a called party being busy on a VoIP softphone

telephone call, those calls are not being routed based on the called party's activity or status on a

computer network or a computer (RBr at 136), but rather, the incoming calls are being processed

in the same way they would be processed if the called party was busy on a telephone handset.

(RBr at 136, citing RFF VI.B.2.3.) Thus, respondent argued that this example of call processing

in the Microsoft domestic industry products does not demonstrate that the products route calls

based on either the current activity of the user on the computer network, or the activity of the user

computer. (RBr at 136.)

The staff argued that unlike the accused ALE products, the Microsoft products can route

calls based on whether the user is using a full screen computer application, such as Power Point.

(SBr at 67, citing Tr. at 266; CPX-10, at approx. 5 minutes.) It is argued that the Microsoft

system can actually route calls based on whether or not the user is active or idle, such as when

the user is typing or using his or her mouse. (SBr at 67, citing CPX-10, at approx. 3-4 minutes,

7-8 minutes.) Thus, the staff argued that it is not necessary to reach the issue of whether making

a VoIP phone call satisfies the limitation requiring the system to "filter the incoming call . . .

according to current activity of the user on the computer network." (SBr at 67, citing CDX-194.)

The parties agree that the Microsoft System meets the limitation

> a data structure contained within a computer network to store
> user-selectable criteria for call processing, wherein the data
> structure stores the user-selectable criteria in one or more lists that
> are used in filtering an incoming call.

(CPFF 2527 (undisputed).) However, the parties dispute whether the Microsoft System filters the incoming call "according to current activity of subscribers on the computer network or according to current activity of the user on the computer network." Nonetheless, the parties agree that the phrase, "current activity of the user on the computer network" means the "current status of the user on the computer network." (10/5/07 Joint Stipulation Letter (Motion Docket No. 598-25) Attached to Order No. 18.) The administrative law judge in the claim construction section has found that the "status" of a user can consist of both user-selected indicators based on user activity (e.g., "conditional processing" as per the '439 specification) and the transfer of data between the computer and telephone networks while the user is engaged in a VoIP phone call. Furthermore, complainant's expert Chang testified regarding this particular claim limitation as it relates to domestic industry:

> Q. Now, if we can turn to CDX-193, which has the limitation "a data structure contained within a computer network to store user-selectable criteria for all processing, wherein the data structure stores the user-selectable criteria in one or more lists that are used in filtering an incoming call."
>
> In your opinion, does the domestic industry system meet this limitation?
>
> {

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(Tr. at 611:8-614:2.) Addtionally, complainant's Serrafin testified to the following regarding the

capability of the Microsoft System as it relates to domestic industry:

> A.   There are certain set of rules that Office Communicator allows users to change in order to be able to customize their communication experience.

> Q.   Can you give the Court some examples of how a user might customize his or her experience using Office Communicator?

> A.   Yes. An example would be if I'm busy in a meeting, I can let my calendar system inside the Exchange know that during the times when I am busy, my phones should automatically be put on "do not disturb" so I am not interrupted in the middle of a meeting.

> Another example would be that if I am making a presentation and I am using PowerPoint, the moment my computer launches the PowerPoint in order to make my presentation, the computer network can let all of my voice communication devices, in this case my phones, know that I should not be disturbed and so the rule can be set to allow people not to interrupt me when I am actually busy, as an example.

> So those are just a couple of examples.

> Q.   What would happen if someone tried to call you while you were using your computer to speak with Ms. Green?

> A.   The call could be intercepted and rerouted. I could actually automatically have the call go to voice mail. I could have it rerouted to another phone, as an example.

> Q.   And what is that feature called?

> A.   That feature would be called forward on busy or forward on do not -- do not disturb if I am busy, those are some examples of that.

(Tr. at 265:25-267:10 (emphasis added).) On this same point, the deposition testimony in CPX-10 discloses the ability of the Microsoft System to route calls according to user-selected criteria when the user is performing certain activity (CPX-10 at 3-5 minutes, 7-8 minutes.) For example,

the Microsoft System user can set the system to route calls to a particular destination when the user is using the PowerPoint software. (CPX-10 at 3-5, 7-8 minutes.)

Furthermore, respondent recognized that "the '439 Patent discusses monitoring whether a particular party is "on" the Internet." (RFF I.C.3.14; RFF I.C.3.15, JX-1 at col. 8:6-18.) The administrative law judge finds that the Microsoft System user is "on" the Internet when he is engaged in a VoIP phone call, as his talking activity is closely related to the accompanying VoIP software activity on his computer. Additionally, the administrative law judge finds that the user's status is active when he is engaged in PowerPoint. The ability of a user to forward calls to another location when he is at that time using PowerPoint enables the Microsoft System to monitor and process the phone call based on the user's status. In order for the user's conditional preferences to operate, the Microsoft System must recognize that the user is presently using the PowerPoint software so that the call can be appropriately routed when the "Do Not Disturb" preference is set with such PowerPoint use. Thus, the administrative law judge finds that the user of the Microsoft System is engaged in "activity on the computer network" after he selects his "status" as "Do Not Disturb" when using a computer program such as PowerPoint, or when he initiates a call over the Internet via VoIP. Hence, the administrative law judge finds that complainant has established that the Microsoft System satisfies Limitation E.

> The Claimed Phrase "a computer network access port used by the telephone network to access the data structure . . . " (Limitation F)

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The Claimed Phrase "a controller to receive the incoming call designated for the user telephone and to process the incoming call in accordance with the user-selectable criteria . . . " (Limitation G)

It is undisputed that the Microsoft System meets the controller limitation of claim 1 as the parties agree that the controller inside the Legacy PBX of the Microsoft System fulfills the controller function as required by the claim language of the controller limitation. (CPFF 2563, 2565, CPFF 2567 (undisputed).) The administrative law judge therefore finds that complainant has established that the Microsoft System meets Limitation G.

Based on the foregoing, the administrative law judge finds that complainant has established the technical prong of the domestic industry requirement with respect to the '439 patent.

B.   The O'Neal Patents

1.   Products In Issue

Microsoft has put in issue the same systems as were put in issue with respect to the Liffick patents. See CBR at 134.[34]

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[34] It is undisputed that Microsoft does not sell PBX switches (RFF 1.D.3.1 (undisputed);) and that Microsoft's domestic industry products are only software. (RFF 1.D.3.2 (undisputed).) However while respondent argued that Microsoft's domestic industry software products rely on PBXs to function, Microsoft argued that its domestic industry software products can function without a PBX. See RFF I.D.3.3. and CRRFF1.12.3.3A. To determine whether Microsoft has established a domestic industry with respect to each of the O'Neal patents, the administrative law judge finds that it is unnecessary to determine whether Microsoft's domestic industry software

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2.   Technical Prong

As to the O'Neal patents in the Joint Stipulation, <u>supra</u> the private parties stipulated as

follows:

> 3. The parties hereby stipulate that in regard to U.S. Patent No. 6,263,064 ("the
> '064 Patent") . . . the Microsoft Domestic Industry Products Microsoft Office
> Communicator 1.0 in association with Live Communications Server 2005,
> Microsoft Office Communicator 2.0 in association with Office Communications
> Server 2007, and Microsoft Exchange Server 2007, which includes Outlook Web
> Access and Outlook Voice Access, meet the following limitations of claim 1,
> except the elements underlined below:

>> 1. A computer-implemented control center for permitting a
>> subscriber of a plurality of communication services of a unified
>> messaging system to customize communication options pertaining
>> to said plurality of communication services through either a
>> telephony-centric network using a telephone or a data-centric
>> network using a display terminal, said computer-implemented
>> control center comprising:

>> a subscriber communication profile database, said
>> subscriber communication profile database having therein an
>> account pertaining to said subscriber, said account including said
>> communication options for said subscriber, said communication
>> options including parameters associated with individual ones of
>> said plurality of said communication services and routings among
>> said plurality of communication services;

>> a computer server coupled to exchange data with said
>> subscriber communication profile database, <u>said computer server
>> being configured to generate a single graphical menu for displaying
>> said communication options for each of said communication
>> services at the same time</u>, and to visually display said single
>> graphical menu on said display terminal when said subscriber
>> employs said display terminal to access said computer-
>> implemented control center through said data-centric network, said
>> computer server also being configured to receive from said
>> subscriber via said display terminal and said data-centric network a
>> first change to said communication options and to update said first

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products can function without a PBX.

change to said account in said subscriber communication profile database, wherein said single graphical menu comprises at least a first display area for showing a first communication service and a first communication option associated with said first communication service, and a second display area for showing a second communication service and a second communication option associated with said second communication service, the first display area and the second display area being displayed at the same time in said single graphical menu, and wherein the first communication option includes a first enable option for enabling or disabling the first communication service, and wherein the second communication option includes a second enable option for enabling or disabling the second communication service; and

a telephony server coupled to exchange data with said communication profile database, said telephony server being configured to audibly represent said communication options to said telephone when said subscriber employs said telephone to access said computer-implemented control center, said telephony server also being configured to receive from said subscriber via said telephone a second change to said communication options and to update said second change to said account in said subscriber communication profile database.

4. The parties hereby stipulate that in regard to U.S. Patent No. 6,263,064 ("the '064 Patent"). . . the Microsoft Domestic Industry Products Microsoft Office Communicator 1.0 in association with Live Communications Server 2005, Microsoft Office Communicator 2.0 in association with Office Communications Server 2007, and Microsoft Exchange Server 2007, which includes Outlook Web Access and Outlook Voice Access, meet the following limitations of claim 3:

wherein said plurality of communication services include a call forwarding service configured to permit said subscriber to specify whether a call received at a telephone number associated with said account be forwarded to a forwarding telephone number, said communication options including a call forwarding enable option and said forwarding telephone number.

5. The parties hereby stipulate that in regard to U.S. Patent No. 6,263,064 ("the '064 Patent") . . . the Microsoft Domestic Industry Products Microsoft Office Communicator 1.0 in association with Live Communications Server 2005, Microsoft Office Communicator 2.0 in association with Office Communications

Server 2007, and Microsoft Exchange Server 2007, which includes Outlook Web Access and Outlook Voice Access, meet the following limitations of claim 8:

> wherein the first communication option includes a first routing option, and wherein the second communication option includes a second routing option

6. The parties hereby stipulate that in regard to U.S. Patent No. 6,263,064 ("the '064 Patent") . . . the Microsoft Domestic Industry Products Microsoft Office Communicator 1.0 in association with Live Communications Server 2005, Microsoft Office Communicator 2.0 in association with Office Communications Server 2007, and Microsoft Exchange Server 2007, which includes Outlook Web Access and Outlook Voice Access, meet the following limitations of claim 11:

> wherein said plurality of communication services comprise an email service configured to permit said subscriber to receive and transmit e-mails through said data centric network, and a voice telephone service configured to permit said subscriber to receive and transmit voicecalls through said telephony-centric network

7. The parties hereby stipulate that in regard to U.S. Patent No. 6,263,064 ("the '064 Patent") . . . the Microsoft Domestic Industry Products Microsoft Office Communicator 1.0 in association with Live Communications Server 2005, Microsoft Office Communicator 2.0 in association with Office Communications Server 2007, and Microsoft Exchange Server 2007, which includes Outlook Web Access and Outlook Voice Access, meet the following limitations of claim 12:

> wherein said plurality of communication services include a facsimile service configured to permit said subscriber to receive at said unified messaging system a facsimile through said telephony-centric network and said telephony server, said communication options including a facsimile receiving enable option associated with said facsimile service.

8. The parties hereby stipulate that in regard to U.S. Patent No. 6,263,064 ("the '064 Patent") . . . the Microsoft Domestic Industry Products Microsoft Office Communicator 1.0 in association with Live Communications Server 2005, Microsoft Office Communicator 2.0 in association with Office Communications Server 2007, and Microsoft Exchange Server 2007, which includes Outlook Web Access and Outlook Voice Access, meet the following limitations of claim 20, except the elements underlined below:

> 20. A computer-implemented control center for permitting

a subscriber of a plurality of communication services of a unified
messaging system to customize communication options pertaining
to said plurality of communication services through either a
telephony-centric network using a telephone or a data-centric
network using a display terminal, said computer-implemented
control center comprising:

a subscriber communication profile database, said
subscriber communication profile database having therein an
account pertaining to said subscriber, said account including said
communication options for said subscriber, said communication
options including parameters associated with individual ones of
said plurality of said communication services and routings among
said plurality of communication services;

a computer server coupled to exchange data with said
subscriber communication profile database, said computer server
being configured to generate a single graphical menu for displaying
said communication options for each of said communication
services at the same time, and to visually display said single
graphical menu on said display terminal when said subscriber
employs said display terminal to access said computer-
implemented control center through said data-centric network, said
computer server also being configured to receive from said
subscriber via said display terminal and said data-centric network a
first change to said communication options and to update said first
change to said account in said subscriber communication profile
database, wherein said single graphical menu comprises at least a
first display area for showing a first communication service, and a
first communication option associated with said first
communication service, and a second display area for showing a
second communication service, and a second communication
option associated with said second communication service, the first
display area and the second display area being displayed at the
same time in said single graphical menu, and wherein the first
communication service and the second communication service are
selected from a call forwarding service, a follow me service, an
alternate number service, a message alert service, a fax receiving
service or a paging service,

a telephony server coupled to exchange data with said
communication profile database, said telephony server being
configured to audibly represent said communication options to said

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telephone when said subscriber employs said telephone to access said computer-implemented control center, said telephony server also being configured to receive from said subscriber via said telephone a second change to said communication options and to update said second change to said account in said subscriber communication profile database.

9. The parties hereby stipulate that in regard to U.S. Patent No. 6,728,357 ("the '357 Patent") . . . the Microsoft Domestic Industry Products Microsoft Office Communicator 1.0 in association with Live Communications Server 2005, Microsoft Office Communicator 2.0 in association with Office Communications Server 2007, and Microsoft Exchange Server 2007, which includes Outlook Web Access and Outlook Voice Access, meet the following limitations of claim 1 , except the elements underlined below:

1. A computer-implemented method for permitting a subscriber of a plurality of communication services of a unified messaging system to customize communication options pertaining to said plurality of communication services, said communication options include parameters associated with individual ones of said plurality of said communication services and routings among said plurality of communication services, said plurality of communication services comprising a voice telephone service through a telephony-centric network and an e-mail service through a data-centric network, said communication options being accessible via display terminals coupled to said data-centric network and via telephones coupled to said telephony-centric network, said method comprising:

providing a subscriber communication profile database, said subscriber communication profile database having therein an account pertaining to said subscriber, said account including said communication options for said subscriber;

generating a single graphical menu for displaying said communication options for each of said communication services at the same time, wherein said single graphical menu comprises at least a first display area for showing a first communication service and a first communication option associated with said first communication service, and a second display area for showing a second communication service and a second communication option associated with said second communication service, the first display area and the second display area being displayed at the

same time in said single graphical menu, and wherein the first communication option included a first enable option for enabling or disabling the first communication service, and wherein the second communication option includes a second enable option for enabling or disabling the second communication service;

visually displaying said single graphical menu on one of said display terminals, using a computer server coupled to exchange data with said subscriber communication profile database, when said subscriber employs said one of said display terminals to access said computer-implemented control center;

providing a telephony server coupled to exchange data with said communication profile database;

audibly representing, said communication options to one of said telephones, using, said telephony server, when said subscriber employs said one of said telephones to access said computer-implemented control center;

receiving from said subscriber via said one of said display terminals at said computer server a first change to at least one of said communication options, said first change to said communication options pertains to either said voice telephone service or said e-mail service;

and updating said first change to said account in said subscriber communication profile database, thereby resulting in a first updated subscriber communication profile database, wherein subsequent messages to said subscriber at said unified messaging system, including said voice telephone service, are handled in accordance with said first updated subscriber communication profile database.

10. The parties hereby stipulate that in regard to U.S. Patent No. 6,728,357 ("the '357 Patent") . . . the Microsoft Domestic Industry Products Microsoft Office Communicator 1.0 in association with Live Communications Server 2005, Microsoft Office Communicator 2.0 in association with Office Communications Server 2007, and Microsoft Exchange Server 2007, which includes Outlook Web Access and Outlook Voice Access meets the following limitations of claim 6:

wherein said plurality of communication services include a call forwarding service configured to permit said subscriber to specify

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whether a call received at a telephone number associated with said account be forwarded to a forwarding telephone number, said communication options including a call forwarding enable option and said forwarding telephone number.

a.   '064 Patent

Independent claims 1 and 20 of the '064 patent contain the same claim limitations regarding the GUI and TUI limitations. (See JX-3 at 18:37-42; 18:66-19:4; 22:58-63; 24:4-9.) Said GUI limitation reads:

> a computer server coupled to exchange data with said subscriber communication profile database, said computer server being configured to generate a single graphical menu for displaying said communication options for each of said communication services at the same time . . . (Limitation H)

Complainant argued that under Microsoft's proposed construction of this claim language ("a single graphical menu for displaying at least a first communication service and option and a second communication service and option at the same time"), the Microsoft System practices Limitation H. (CBr at 135-36, citing CPFF 2678-2684.) It is argued that the Microsoft System generates a variety of single graphical menus that include two or more communication services and communication options. (CBr at 136, citing CPFF 2679-2684.) Complainant also argued that the OWA GUI of CDX-231 is a single graphical menu simultaneously displaying at least a first communication service ("Telephone Access") and an associated first communication option ("Phone number to use to listen to voicemail using Play on Phone") in a first display area, and a second communication service ("Missed Call Notifications") and an associated second communication option ("Send e-mail to my inbox when I miss a phone call") in a second display area. (CBr at 137, citing CPFF 2680.) Complainant further argued that the Communicator GUI

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of CDX-232 is a single graphical menu simultaneously displaying at least a first communication service ("Status") and an associated first communication option ("Change my status to Do Not Disturb when I am running a full-screen program") in a first display area, and a second communication service ("Phone") and an associated second communication option ("Enable Do Not Disturb on my phone automatically when my status is Do Not Disturb") in a second display area. (CBr at 138, citing CPFF 2683.)

Respondent argued that at the hearing, complainant's expert Chang provided two examples of the claimed single graphical menu in the Microsoft domestic industry products, one for OWA and one for Communicator. (RBr at 135, citing RFF VI.B.1.1.) It is argued that neither of these examples displayed all the communication options for all the communication services provided by either the OWA or Communicator products. (RBr at 135, citing RFF VI.B.1.2, RFF VI.B.1.3.) Therefore, respondent argued that under its and the staff's constructions of the single graphical menu limitation, Microsoft's domestic industry products do not satisfy this limitation. (RBr at 135.)

The staff did not provide arguments regarding domestic industry and the "single graphical menu" limitation found in claim 1 of the '064 patent. (See SBr at 69-70, SRBr at 34-35.)

The parties agree that at the hearing Chang provided two examples of the claimed single graphical menu in the Microsoft domestic industry products, one for OWA and one for Communicator. (RFF VI.B.1.1 (undisputed).) The parties also agree to the following findings of fact:

> In the screenshot example from Outlook Web Access shown in CDX-231, communication services generally include "Telephone Access," "Missed Call Notifications," "Reset Voice Mail PIN,"

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and "Telephone Access Folder." "Missed Call Notification" gives the subscriber the option to enable the service by clicking "Send e-mail to my Inbox when I miss a phone call." "Telephone Access" includes two different services—"Play on Phone" for remotely retrieving voice mails [enabled by entering a phone number], and voice mail greeting selection. Similarly, "Reset Voice Mail PIN" gives the subscriber the option to reset his voice mail PIN and "Telephone Access Folder" allows a subscriber to select an e-mail folder to be read over the phone via Outlook Voice Access. (CPFF 2681);

In the screenshot example from Communicator shown in CDX-232, communication services generally include e-mail notification services that allows the subscriber to enable the delivery of an e-mail when he misses a call or a call is forwarded. There are also a variety of communication services associated with the user's "Status"—the "Phone" service allows the subscriber to enable "do not disturb" if that is his Communicator status. Other services allow the subscriber options to enable automatic determination of status based on the subscriber's Outlook calendar or computer activity [e.g., "when my computer has been idle" or "when I am running a full-screen program"]. (CPFF 2684.)

However, the parties dispute whether a single graphical menu displays all the communication options for all the communication services provided by either Outlook Web Access or Office Communicator. (RFF VI.B.1.2, B.1.3.) With respect to this dispute, Chang testified to the following regarding the graphical menus of Outlook Web Access and Officer Communicator:

Q. So let's turn to the claims of the '064 patent. It is my understanding that ABS has stipulated to certain limitations of claim 1 of the '064 patent, so we will try to skip those and just go to the disputed limitations.

But just for the record, if I can direct your attention to CDX-227 through CDX-230, is it your opinion that the domestic industry system meets those limitations?

A. Yes, it is.

Q. And is your opinion, the basis for your opinion, set forth in

slides CDX-227 through CDX-230?

A.   That's correct.

Q.   So now, if I can direct your attention to CDX-231. Again, the disputed limitation is referred to as the GUI limitation. It is up top. "Said computer server being configured to generate a single graphical menu for displaying said communications options for each of said communication services at the same time."

In your opinion, does the domestic industry system meet this limitation?

A.   Yes, it does. And on CDX-231, I have reproduced a particular screen capture of the Microsoft Outlook Web Access or OWA, and sometimes referred to as OWA. And this is a web interface and allows the user to be able to use the web browser and to configure various communication services and options as available on the Microsoft system.

So on this particular diagram, I have shown two communication services, and also the options we need in each of the services.

Specifically, I have shown a service that allows a voice mail to be played via remote telephone as a first service and option that's available to set that particular phone number.

And the second service relates to a missed call indication regarding how -- what happens when an incoming call is not answered by the user. And here the option associated with that service would be to send an e-mail to the user if the user missed the call.

So this is an example of the Microsoft domestic industry system with a graphical user interface where it displays at least two communication services and the options in each of the services.

Q.   And then if I can direct your attention to CDX-232, can you describe to the Court what is shown on CDX-232?

A.   Sure. On CDX-232, this is a second example of Microsoft graphical user interface as far as how it meets the limitation of

'064, claim 1. <u>What I have shown here is a screen capture of the Microsoft Office Communicator graphical user interface and this will be the option, the screen, a Communicator user will be able to see and use to configure various options.</u>

And so I have shown as a first service about -- regarding how the user is able to manage his do not disturb status and how calls should be answered when the user is in do not disturb status.

The second service relates to telephone service and, again, relating to the do not disturb status and options available under the -- this particular service. So in the Communicator example, I have shown, again, two communication services and options displayed under each of the services.

Q.   Thank you. This is the second example you used Communicator in on CDX-231, that was an example using OWA?

A.   Yes, using OWA web access, yes. The Communicator access is not OWA. That is the interface presented by the communicator client software.

Q.   And that's for CDX-232?

A.   That's correct.

(Tr. at 624:7-627:13 (emphasis added).) Respondent's expert Hyde-Thompson also testified to the following regarding claim construction of the "single graphical menu" limitation:

Q.   So in terms of the infringement for the O'Neal patents, you've addressed two limitations, correct?

A.   Yes.

Q.   The GUI limitation and the TUI limitation; is that right?

A.   Correct.

Q   All right. If I could have page 2 of RDX-1.

So here, sir, you summarized ABS' construction. Should this say Alcatel-Lucent Enterprise's, I suppose?

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A. I suppose it should.

Q. We'll learn. It's just harder to say. That's part of the problem. So let's call it ABS just because that's what the graphic says.

On the right-hand side, you have ABS' constructions. And when you read the single graphical menu construction into the -- into the record, you stressed the -- all of the communication options. Do you recall doing that?

A. Yes.

Q. And you, in fact, mean that all communication options presented in the system have to be presented on a single graphical menu? Is that right?

A. All of the options of that subscriber's -- you know, for that subscriber, yes.

Q. Well, that's the problem, sir.

A. All of the services that subscriber is subscribing to.

Q. How do you know what all the services are?

A. Well --

Q. Is it all of them in the system?

A. I think this -- this concept that O'Neal is describing was, you know, he's talking about various different embodiments. But what he is talking about is, in a particular setup where there are a particular set of services, all of those services should be shown on a single graphical menu --

Q. Does that mean --

A. -- and the options associated with it.

* * *

Q. So there can be no drop down menus in your version of all the communication options in a single graphical menu, correct?

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A. I don't think I mentioned drop down menus.

Q. But that's my question, sir. Isn't that a fact, under your definition, under ABS' definition of single graphical menu, there can be no drop down menus, correct?

A. I think a drop down selection box is probably just a way of choosing the options. I mean, options can have binary values either/or, and they can be done with tick boxes or radio controls. But a more sophisticated option might be done with a drop down. I would regard that as all part of the single graphical user interface. I mean, it's a common practice, you know. I mean, goodness, we've all got them on our Windows computers.

Q. So the single graphical menu has to display all the options, but it can put some of them into drop down menus under your version of the construction, correct?

A. It's not a point, I must admit, I thought very long about. In fact, I thought about 30 seconds about it so far. So perhaps I should ponder it a little bit more in the context of the patent and think about the language that might be indicative of whether or not drop down menus are anticipated. Maybe some of his pictures have drop downs. I can't remember.

Q. Well, in fact, sir, as you're looking through the figures there, you can't find a single embodiment that shows all of the communication options associated with all of the subscriber's communication services on a single menu, can you?

A. I have found a drop down. So here within figure 4, for instance, there are a couple of drop downs which are indicated on the figure 4.

Q. So in your opinion, then, drop down menus are permitted within ABS' construction of single graphical menu, correct?

A. I think it's reasonable. In fact, there's more drop downs in figure 3, yes.

Q. So we know we have to have all the services that the subscriber has available on his system on a single menu. But some of them can be hidden in drop down menus, correct?

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A.   Not the services. The options associated with the services.

Q.   Oh, I see. So the drop down menu can only contain the options but cannot contain the services themselves, correct?

A.   Again, I say I haven't pondered this very hard. You're criticizing me already for not taking long enough to look at these things. Now you're trying to make me make an opinion on the spot here.

But I think, given the pictures that are illustrating the patent, it's clear his concept is to put all of the communication services on a screen and have on/off buttons or other simple options that can be accessed, with, quote, a few key strokes such as these drop down boxes it's got on figure 3 for selecting telephone numbers, for instance.

Q.   So it's okay to have things that require the user to manipulate with a few key strokes, correct?

A.   That was absolutely the language of the patent application history, yes. The claim is that you can change all your options with just a few key strokes.

(Tr. at 1484:19-1490:1 (emphasis added).)

The administrative law judge has found, supra, that the patentees' argument in the prosecution history of the '064 patent is a clear and unambiguous disclaimer of claim scope, with the narrowing of the claims to a single graphical menu that displays all of the services and options on one screen. (See Section VI.B.1 supra.) The administrative law judge also found that said disclaimer extends to the '357 patent. (Id.) In light of these findings, the administrative law judge construed the "single graphical menu" limitation as requiring "one graphical menu for displaying all of the communication options for all of the plurality of communication services." (See Id.) More specifically, the administrative law judge found that in order to overcome the

Examiner's objection, the patentee added the limitation for "a single graphical menu for

displaying said communication options for each of said communication services at the same

time." (JX-7 at MSAL 01000.) The patentee argued that:

> In contrast to Pepe, independent claims 1 and 20 of the present
> application require a **single graphical menu** that is arranged to
> display the communication options for each of the communication
> services **at the same time**. That is, the communication options for
> each of the communication services are simultaneously displayed
> on a computer terminal when the subscriber employs the display
> terminal to access the computer-implemented control center
> through a data-centric network. In essence, the graphical menu
> serves as a centralized visual interface or control panel for
> reviewing and/or customizing the communication options
> associated with various communication services. As should be
> appreciated, by providing a single graphical menu, a user may
> quickly and conveniently review the communication options and
> make changes thereto. Claims 1 and 20 have been amended to
> better clarify this aspect of the invention.

> While Pepe may disclose the use of control options and
> subscriber profiles, Pepe does not contemplate a single graphical
> menu where only one view is used to display the communication
> options. Rather, in Pepe, the subscriber must go through a plurality
> of views independently, where the options are displayed at
> different times. . . . In order to access all of the screens in Pepe, a
> subscriber must traverse through at least 18 screens as shown in
> Figures 28-45. In contrast, the present invention does not have to
> access multiple screens to modify options. In fact, the
> communication options, which are displayed on a single screen,
> may be modified as needed with a few keystrokes. Accordingly, it
> is respectfully submitted that a single graphical menu containing
> the communication options is neither disclosed nor reasonably
> suggested by Pepe et al. . . .

(JX-7 at MSAL 01001-02 (bold face emphasis in original, emphasis added).)

Hence the administrative law judge finds that the patentees, in describing a single

graphical menu, limited said menu to one that utilizes "a few keystrokes" in order to modify the

communication options, and one that simultaneously displays all of the communication options, for all the services on a single screen. However, multiple screens appear in both the Office Communicator and the Outlook Web Access programs of the Microsoft System. Complainant's demonstrative exhibits, CDX-231 and CDX-232, show the user having to make multiple key strokes in order to modify all of the communication options. For the Office Communicator the GUI shows an option menu with eight tabs. (See CDX-232.) In order to display all the options associated with the Office Communicator, the user must make at least seven clicks with each click allowing the subsequent display of the various options associated with each of the "Options" tabs. (See CDX-232.) The same requirement of multiple clicks and screens to display and modify all the communication options is also apparent in the Outlook Web Access program. (See CDX-231.)

In light of the language employed by the patentees and the disavowal of claim scope, the administrative law judge finds that complainant has not established that the Microsoft System meets Limitation H because it does not simultaneously display all the options, and the user is therefore unable to modify all the options without making at least seven clicks and displaying multiple screens containing all the options.

Based on the foregoing, the administrative law judge finds that complainant has not established the technical prong for independent claims 1 or 20 of the '064 patent. Accordingly, the administrative law judge finds that complainant has not established the technical prong with respect to dependent claims 3, 8, 11, or 12, because those claims depend on claim 1 and consequently include the same limitations as claim 1. Therefore, the administrative law judge finds that complainant has not established the technical prong of the domestic industry

requirement with respect to the '064 patent.

b.   '357 patent

Complainant argued, as to the '357 patent, that it has established that the Microsoft

system practices independent claim 1 and claim 6 which is dependent on claim 1. Each of the

respondent and the staff argued that complainant has not so established.

Claim 1 of the '357 patent has the phrase:

> generating a single graphical menu for displaying said
> communication options for each of said communication services at
> the same time, wherein said single graphical menu . . . (Limitation
> I)

This claim limitation is substantially similar to the GUI Limitation H of claim 1 of the

'064 patent as analyzed supra. For the reasons set forth supra with respect to said claim element

of the '064 patent, the administrative law judge finds that complainant has not established that

the Microsoft system satisfies Limitation I for the '357 patent.

Claim 1 of the '357 patent also has the phrase "virtually displaying said single graphical

menu on one of said display terminals . . . " (Limitation J)

The only disputed portion of this claim limitation is the phrase "single graphical menu."

(JX-33 at 8.) In light of the analysis, supra, which analyzed the phrase "single graphical menu,"

the administrative law judge finds that complainant has not established that the Microsoft System

satisfies Limitation J.

Based on the foregoing, the administrative law judge finds that complainant has not

established the technical prong for claim 1 of the '357 patent. As claim 6 depends on

independent claim 1, the administrative law judge finds that complainant also has not established

the technical prong with respect to claim 6. Therefore, the administrative law judge finds that

complainant has not established the technical prong of the domestic industry requirement with

respect to the '357 patent.

XI.   Remedy

Upon issuing an initial determination on whether there is or there is not a violation of

Section 337, the administrative law judge, pursuant to Commission rule 210.42(a)(1)(iv), should

issue a recommended determination concerning his views on remedy as well as bonding. In this

investigation complainant Microsoft requests (i) entry of a permanent, limited exclusion order

prohibiting the importation into the United States of ALE's infringing products and (ii) a cease

and desist order. (CBr at 180-81.) It is argued that because ALE is repeatedly changing the

names of its products without any substantive changes to the product's architecture or operation,

the Commission should exclude all infringing products regardless of the marketing name used;

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} and that despite this re-branding, there is no functional change to the product,

citing (Leroy, Tr. at 1111:19-1113:4); and that to avoid circumvention of the exclusion order, the

Commission should preclude entry of all infringing ALE products, regardless of the brand name,

for any purpose, including for testing, sampling, sale, promotion and/or demonstration purposes,

citing Certain Automated Mech. Transmission Sys. For Medium-Duty And Heavy-Duty Trucks,

Inv. No. 337-TA-503, Init. Determin., 2005 ITC LEXIS 241 at *303 (Jan. 7, 2005)

(Transmissions Sys.).

Complainant further argued that any exclusion order should cover components of the

infringing systems because if components are not covered, ALE could easily disregard the

exclusion order by importing the individual components separately, and then reassembling them

in this country; that another respondent in a recent investigation argued that the exclusion order

"should not cover components or parts," citing Transmission Sys., at *299; and that the argument

was rejected because

> [t]he central purpose of remedial orders is to ensure complete relief
> to the domestic industry. An exclusion order covering only specific
> models of an accused device could easily be circumvented, thereby
> denying complete relief to the domestic industry

Id. at *303-05.

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and that given the collaboration of ALE's related companies (such as Alcatel USA, Inc.) and a

host of resellers and distributors, the exclusion order should extend beyond ALE and cover

principals, stockholders, officers, directors, employees, agents, licensees, parent companies,

subsidiaries, related companies within the Alcatel-Lucent corporate structure, distributors,

resellers, controlled and/or majority owned business entities and their employees and agents, successors and assigns, in order to prevent ALE from circumventing the order by acting through others. (CBr at 182-85.)

Complainant further argued that an exclusion order should not be limited to specific models because an exclusion order covering only specific models of an accused device could easily be circumvented, thereby denying complete relief to the domestic industry which approach is consistent with the Commission's "long-standing practice" in Certain Hardware Logic Emulators Systems and Components Thereof, Inv. No. 337-TA-383, U.S.I.T.C. Pub. 2089, Comm'n Op. at 26 (Mar. 1998) (Hardward Logic) wherein the Commission:

> adopted the ALJ's recommendation and issued a permanent limited exclusion order directed to all infringing emulation systems and components thereof manufactured abroad by foreign respondent Meta. The limited exclusion order is not limited to the specific models of emulation system found by the Commission to infringe, as urged by respondents. As the ALJ noted, the Commission's long-standing practice is to direct its remedial orders to all products covered by the patent claims as to which a violation has been found, rather than limiting its orders to only those specific models selected for the infringement analysis…. We also agree with the ALJ that the central purpose of remedial orders is to ensure complete relief to the domestic industry. An exclusion order covering only specific models of an accused device could easily be circumvented, thereby denying complete relief to the domestic industry.

Commission Opinion on Remedy, the Public Interest, and Bonding, 15-20 (Mar. 31, 1998) (emphasis added by complainant, citations omitted). (CBr at 160.)

It is argued by complainant that a certification provision is unnecessary and inappropriate; that in Certain Ink Jet Print Cartridges and Components Thereof, the Commission explained that it has:

included certification provisions in exclusion orders where, inter alia, [1] the patent(s) that form the basis for the order cover <u>processes for manufacturing goods</u> and Customs is unable to readily determine how imported goods possibly covered by the order are made….[and] [2] in exclusion orders involving <u>semiconductor chips</u>, where complicated and costly reverse engineering procedures would have to be used by customs to determine whether the imported merchandise was covered by the claims at issue.

Inv. No. 337-TA-446, Commission Opinion, 10-11 (May 8, 2002), USITC Pub, 3549 (Oct. 2002), <u>Ink Jet Print Cartridges</u>; that the Commission went on to deny respondent's request for a certification provision because the infringing ink jet print cartridges were easily identified by the labeling on the cartridge and packaging; that a certification provision may unduly complicate enforcement of the order, <u>Id.</u> at 11 and citing <u>Certain Cellular Radiotelephones</u>, Inv. No. 337-TA-297, Notice of Commission Decision (Feb. 1991) (denying respondent's proposed certification provision because Customs had adequate means to determine infringement and further noting a certification provision might unnecessarily invite abuse of the provision and circumvention of the exclusion order); that the alleged infringing unified communications products here are "easily identified" by package labeling and shipment manifests and hence there is no need for ascertaining manufacturing processes or reverse engineering; and that customs need only look for the OmniPCX Enterprise, OmniTouch Unified Communications, 4980 My Softphone, OmniPCX Office, and PIMPhony product names and variations thereof. (CRBr at 162-3.)

Regarding any cease and desist order, complainant argued that such an order is an entirely appropriate remedy; that the evidence of record establishes that respondent maintains a commercially significant inventory of accused products in the United States of over $2m; and

that because ALE may import, warehouse, and sell the accused components of its OXE and OXO systems individually any cease and desist order and exclusion order must cover those components individually and collectively in order to ensure effective relief to Microsoft, citing Transmission Sys. *299, 303-305 (granting exclusion order covering components and parts to "ensure complete relief to the domestic industry"). (CRBr at 163-4.)

Respondent argued that, in the event a violation is found, a limited exclusion order directed at products that Microsoft has proven, by a preponderance of evidence, infringe the asserted patents and that are manufactured by or for ALE would be the only appropriate remedy.

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Respondent further argued that in situations where respondent imports both infringing and non-infringing products, the Commission frequently includes a certification provision in the exclusion order, citing Certain Laser Bar Code Scanners and Scan Engines, Components Thereof and Products Containing Same, Inv. No. 337-TA-551, 2007 ITC LEXIS 623, Comm'n Op. (June 14, 2007) (issuing exclusion order with certification provision to ensure order does not block non-infringing products from entering the United States), Certain Laminated Floor Panels, Inv. No. 337-TA-545, 2007 ITC LEXIS 175, Comm'n Op. (Jan. 24, 2007) ("Given the number ... not subject to the order, it is reasonable to provide CBP with maximum flexibility to administer the order. Non-infringing products, such as Yekalon's Engagement Products, can be certified as non-infringing, and be allowed entry."), Certain Condensers, Parts Thereof, and Products Containing Same, ITC Inv. No. 337-TA-334 (Remand Proceeding), Comm'n Op. at 39, 1997 WL 599891 (Sept. 10, 1997), Certain Minoxidil Powders, Salts, and Compositions for Use in Hair Treatment, ITC Inv. No. 337-TA-267 (1988); Certain Curable Fluoroelastomer Compositions and Precursors Thereof, ITC. Inv. No. 337-TA-364 (May 8, 1995);{

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As for any cease and desist order,{

} citing <u>Certain Strip Lights</u>, 337-TA-287, Comm'n Op. on

the Issue Under Review, Remedy, The Public Interest, and Bonding at 6 (Oct. 3, 1989):

> We believe that a cease and desist order is not appropriate in this
> investigation. In prior investigations, the Commission has looked
> for the existence of substantial inventories of the infringing product
> before issuing a cease and desist order. In this investigation, there
> is no evidence of any inventories of infringing strip lights now in
> the possession of Golden Apple.

<u>Certain Nonwoven Gas Filter Elements</u>, ITC Inv. No. 337-TA-275, USITC Pub. 2129 (Sept.

1988), at 10:

> We determine that a cease and desist order should not be issued.
> Our decision is based on the facts that there is no evidence of
> stockpiling or substantial inventories of infringing articles in the
> United States . . . ."

<u>Certain Cloisonne Jewelry</u>, ITC Inv. 337-TA-195, USITC Pub. 1822 (March 1986), at 6:

> [C]omplainant has not cited any record evidence which would
> indicate that there are large inventories of infringing jewelry
> remaining in the United States. In the absence of such evidence,
> we conclude that cease and desist orders are not warranted . . . .,

<u>Certain Heavy-Duty Staple Gun Tackers</u>, 337-TA-137, USITC Pub. 1506 (March 1984), at 5:

> [T]here is no evidence to indicate that respondents . . . have
> stockpiled inventories for later sale. We therefore conclude that

cease and desist orders are unwarranted. . . .

Coin-Operated Audio-Visual Games and Components Thereof, 337-TA-87, USITC Pub. 1160

(June 1981), at 30:

> There are many respondents in the United States (distributors)
> which can only be reached by a cease and desist order. However,
> because the record did not contain sufficient evidence regarding
> instances of stockpiling by respondents, we decline to issue cease
> and desist orders.

(RBr at 139 argued at 139-40.)

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}and that any cease and desist order should not be directed to ALE's distributors and/or customers, because the Commission does not have personal jurisdiction over third party distributors and/or customers. (RBr at 140.)

The staff argued that if a violation of Section 337 is found in this investigation, the appropriate remedy should include a limited exclusion order; that while the private parties do not appear to dispute this fact they appear to contest how such an order should be drafted, including what brand names should be included, whether components should be included, and whether related companies should be included; and that assuming that these are issues for the administrative law judge (as opposed to the Commission), neither party has presented an adequate basis for departing from the Commission's usual practice in drafting exclusion orders. (SBr at 48-9.)

The staff also argued that certification provisions are normally used when it will be difficult for Customs "to determine whether the imported merchandise [is] covered by the patent claims at issue," citing Ink Jet Print Cartridges which was cited by complainant; that here, the claims at issue do not involve methods of manufacture, nor will the products require substantial reverse engineering in order to determine whether the products infringe; that respondent has not explained why Customs will allegedly encounter any difficulties in identifying infringing goods; and that hence the administrative law judge should not recommend a Customs certification provision. (SBr at 49.)

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that such components can be used in infringing systems, and sales of components that are used in this manner should also be prohibited; and that this is consistent with the purpose of a cease and desist order, which is to prevent a respondent from undercutting an exclusion order through the sale of its inventory, citing Certain Abrasive Products Made Using a Process for Powder Preforms, and Products Containing Same, Inv. No. 337-TA-449, Commission Opinion on Remedy, the Public Interest, and Bonding, at 7, USITC Pub. 3530 (Aug. 2020), rev'd on other grounds sub. nom Kinik Co. v. International Trade Comm'n, 362 F.3d 1359 (Fed. Cir. 2004). (SBr at 95-97, SRBr at 49-50.)

The Commission "has" broad discretion in selecting the form, scope, and extent of the remedy in Section 337 proceedings" Certain Integrated Circuit Telecommunication Chips, Inv. No. 337-TA-337, (Comm'n Op.) at 21 (August 3, 1993). Pursuant to its statutory authority found at 19 U.S.C. § 1337 (d), the Commission may exclude from importation goods and products that form the basis for a finding of a violation of Section 337 which includes products that have been found to infringe the patents-in-suit directly, contributorily or by inducement after importation has occurred. Certain Flash Memory Circuits, Inv. No. 337-TA-382, (Comm'n Opn.) at 26 (June 26, 1997) ("The Commission has the authority to enter an exclusion order, a cease and desist order, or both."). Indeed, absent special circumstances, the statute requires such exclusion:

> If the Commission determines . . . that there is a violation of this
> section, it shall direct that the articles concerned . . . be excluded
> from entry into the United States, unless, after considering the
> public health and welfare, competitive conditions in the United
> States economy, the production of like or directly competitive
> articles in the United States, and United States consumers, it finds
> that such articles should not be excluded from entry.

19 U.S.C. § 1337(d) (emphasis added). Hence, a remedy excluding ALE's infringing products

from entry is mandatory if a violation of Section 337 is found, unless the Commission finds that

public interest factors militate against such remedy.

The Commission also has the authority to issue cease and desist orders where a

respondent has a sufficient inventory of infringing goods in the United States," Certain NAND

Flash Memory Circuits, Inv. No. 337-TA-526, 2005 ITC Lexis 859, Init. Determ. at *255 (Oct.

19, 2005) (citing Certain Plastic Encapsulated Integrated Circuits, Inv. No. 337-TA-315,

U.S.I.T.C. Pub. No. 2574, Comm'n Op. at 37 (November 1992); and that one infringing product

is sufficient to constitute a "sufficient inventory" for purposes of a cease and desist order,

Hardware Logic, U.S.I.T.C. Pub. 2089, Comm'n Op. at 26 (Mar. 1998).

In the event a violation is found, the administrative law judge recommends the issuance

of a limited exclusion order prohibiting the importation into the United States of infringing

articles regardless of brand name "that are manufactured abroad or imported by or on behalf of

[the respondents], or any of their affiliated companies, parents, subsidiaries, or other related

business entities, or their successors or assigns." See Certain Laser Bar Code Scanners and Scan

Engines, Components Thereof, and Products Containing Same, Inv. No. 337-TA-551, Limited

Exclusion Order, ¶ 1 (May 30, 2007). Moreover, he recommends that said order should not be

limited to specifically-identified products, but rather extend to all infringing products. See e.g.,

Certain Integrated Repeaters, Switches, Transceivers and Products Containing Same, Inv. No.

337-TA-435, Commission Opinion at 23, USITC Pub. 3547 (Oct. 2002). In addition, the

administrative law judge recommends that components of said articles should be barred from

importation if they will be assembled in the United States into infringing products. See Certain

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Condensers, Parts Thereof and Products Containing Same, Including Air Conditioners for Automobiles, Inv. No. 337-TA-334 (Remand), Commission Opinion at 38, USITC Pub. 3063 (Sept. 1997). The administrative law judge does not recommend a certification provision because if a violation is found, the infringing unified communication products in issue should be identified by package labeling and shipment manifests.

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Regarding respondent's argument that many of the articles in inventory have non-infringing uses, a cease and desist order only directs persons to "cease and desist from engaging in the unfair methods or acts involved." 19 U.S.C. § 1337(f)(1). Hence with entry of a cease and desist order respondent would not be required to cease and desist from acts that do not result in infringement. See, e.g., Laser Bar Code Scanners, Order to Cease and Desist, § III (May 30, 2007). Thus the administrative law judge recommends, if a violation of Section 337 is found, recommends that a cease and desist order against respondent ALE should issue directed to infringing unified communication systems, products used with such systems and components thereof.

XII.   Bond

If the Commission enters an exclusion order, ALE may continue to import and sell its products during the 60-day Presidential Review period under a bond in an amount determined by the Commission to be "sufficient to protect the complainant from any injury." 19 U.S.C. §

1337(j)(3); Commission rule 210.50. <u>Certain Dynamic Random Access Memories, Components Thereof and Products Containing Same</u>, Inv. No. 337- TA-242, Comm'n Op. (Sept. 21, 1987).

Microsoft argued that the amount of bond in this investigation should be set at 100% of the "entered value." It is argued that the Commission has frequently used this bond amount where direct price comparisons between the parties' respective products are not possible, citing, e.g., <u>Certain NAND Flash Memory Circuits</u>, 2005 WL 3701389, at *86-87 (setting bond at 100% of entered value); <u>Certain Microsphere Adhesives</u>, Inv. No. 337-TA-366, 1996 WL 1056095, Comm'n Op. (U.S.I.T.C. Jan. 16, 1996) (citing cases).[35] (CBr at 187-8.)

Respondent argued that given Microsoft's absolute failure to present any evidence relating to the appropriate bond rate and the lack of competition between the bulk of ALE's imports and Microsoft's products, the Commission should not impose a bond during the Presidential review period, citing <u>Certain Rubber Antidegradants</u>, Inv. No. 337-TA-533, 2006 ITC Lexis 212 (February 17, 2006); <u>affirmed</u> Final Commission Determination Regarding Violation; Issuance of Limited Exclusion Order; Termination of Investigation (July 13, 2006);

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[35] Microsoft noted that for "the same reasons," any cease and desist order that is issued should also include a provision for a bond in the amount of 100% of the entered value with respect to any products that are sold during the Presidential review period but that were imported prior to the imposition of an exclusion order bond.

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The staff argued that a bond can be calculated based on the pricing differentials between the parties' competitive product, citing <u>Certain Power Supply Controllers and Products Containing Same</u>, Inv. No. 337-TA-541, Commission Opinion at 10-12 (Aug. 29, 2006) (setting bond based on price differentials);{

}

Thus should a violation be found, in view of the wide ranges of prices for infringing products, the

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administrative law judge recommends a bond in the amount of 100 percent of entered value. <u>See</u>

<u>Certain Neodymium-Iron-Boron Magnets</u>, Inv. No. 337-TA-372, Commission Opn., 1996 WL

1056324 (April 30, 1996) ("In cases such as this one, in which it is impossible for the

Commission to calculate what level of bond based on price differentials will protect a

complainant from any injury, it is appropriate to issue a bond of 100% of entered value.")

XIII.   Additional Findings

A.   Parties

1.   Complainant Microsoft Corporation (Microsoft) is a Washington corporation,

having its principal place of business in Redmond, Washington. (See RX-61, ¶ 2.1)

2.   Microsoft is a global technology company that designs, develops, manufactures

and supports a wide range of software and hardware products. (Id.).

3.   {

}

4.   {

}

B.   Experts

5.   Jack Chang was qualified as complainant's expert in the fields of unified

messaging and computer telephony. (Tr. at 405.)

6.   Henry Hyde-Thomson was qualified as respondent's expert witness in the fields of

unified messaging and computer telephony. (Tr. at 1217.)

CONCLUSIONS OF LAW

1. The Commission has <u>in personam</u> jurisdiction and subject matter jurisdiction.

2. There has been an importation of accused products which are the subject of the unfair trade allegation.

3. While asserted claim 38 of the '439 patent has been proven to be invalid based on anticipation none of the other asserted claims have been proven to be invalid based on anticipation.

4. The accused OXE system products directly infringe asserted claims 1 and 28 of the '439 patent.

5. Respondent contributorily infringes asserted claims 1 and 28 of the '439 patent by selling the accused OXE system products, which include the OTUC software.

6. Respondent has induced others to infringe asserted claims 1 and 28 of the '439 patent through use of the accused OXE system products which include the OTUC software.

7. None of the accused products infringe the asserted claims of the '289 patent, '064 patent and the '357 patent.

8. The accused OXO system products do not infringe asserted claims 1 and 28 of the '439 patent.

9. The asserted claims of the '289 patent and asserted claims 1 and 28 of the '439 patent are enforceable.

10. A domestic industry exists as to the '439 and '289 patents.

11. A domestic industry does not exist as to the '064 and '357 patents.

12. There has been a violation of Section 337.

13.   The record supports issuance of a limited exclusion order, a cease and desist order and a bond set in the amount of 100 percent of entered value during the sixty day Presidential review period.

ORDER

Based on the foregoing, and the record as a whole, it is the administrative law judge's Final Initial Determination that there is a violation of section 337 in the importation into the United States, sale for importation, and the sale within the United States after importation of certain unified communication systems, products used with such systems and components thereof. It is also the administrative law judge's recommendation that a limited exclusion order should issue barring entry into the United States of infringing unified communication systems, products used with such systems and components thereof as well as a cease and desist order; and that a bond be set at 100 percent of entered value during the Presidential review period.
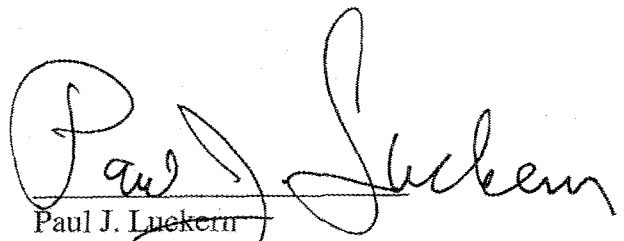
The administrative law judge hereby CERTIFIES to the Commission his Final Initial and Recommended Determinations together with the record consisting of the exhibits admitted into evidence. The pleadings of the parties filed with the Secretary and the transcript of the pre-hearing conference, and the hearing, are not certified, since they are already in the Commission's possession in accordance with Commission rules.

Further it is ORDERED that:

1.   In accordance with Commission rule 210.39, all material heretofore marked in camera because of business, financial and marketing data found by the administrative law judge to be cognizable as confidential business information under Commission rule 201.6(a), is to be given in camera treatment continuing after the date this investigation is terminated.

2.   Counsel for the parties shall have in the hands of the administrative law judge those portions of the Final Initial and Recommended Determinations which contain bracketed confidential business information to be deleted from any public version of said determinations, no later than February 19, 2008. Any such bracketed version shall not be served via facsimile on the administrative law judge. If no such bracketed version is received from a party, it will mean that the party has no objection to removing the confidential status, in its entirety, from these initial and recommended determinations.

3.   The initial determination portion of the Final Initial and Recommended Determinations, issued pursuant to Commission rule 210.42(h)(2), shall become the determination of the Commission forty-five (45) days after the service thereof, unless the Commission, within that period shall have ordered its review or certain issues therein or by order has changed the effective date of the initial determination portion. The recommended determination portion, issued pursuant to Commission rule 210.42(a)(1)(ii), will be considered by the Commission in reaching a determination on remedy and bonding pursuant to Commission rule 210.50(a).

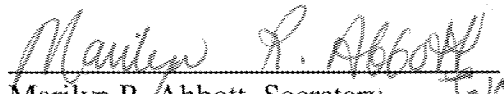Paul J. Luckern
Administrative Law Judge

Issued: January 28, 2008

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**CERTAIN UNIFIED COMMUNICATIONS
SYSTEMS, PRODUCTS USED WITH SUCH
SYSTEMS, AND COMPONENTS THEREOF**

Investigation No. 337-TA-598

<u>CERTIFICATE OF SERVICE</u>

I, Marilyn R. Abbott, hereby certify that the attached **Public Version Final Initial and
Recommended Determinations** was served by hand upon Commission Investigative Attorney
David O. Lloyd, Esq., and upon the following parties overnight delivery on March 10, 2008.

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<u>CERTIFICATE OF SERVICE</u> pg. 2

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