

PTAB Won't Ax Claims In Caller ID Patent Row On Remand

By **Jasmin Jackson**

Law360 (July 19, 2022, 3:02 PM EDT) -- The Patent Trial Appeal Board has still refused to invalidate several claims in a Neustar Inc. unit's caller identification patent on remand from the Federal Circuit, ruling that the invention is not obvious based on a trio of prior art references.

A panel held in a final written decision Monday that caller ID platform Next Caller Inc. failed to prove seven claims in Neustar subsidiary TrustID Inc.'s patent on caller ID technology for incoming Voice over Internet Protocol, or VoIP, calls are unpatentable. The panel said Next Caller didn't specify how three publications from 2007 to 2011 recited the disputed technology and rendered the challenged claims obvious.

According to the decision, similarities in the references — known as Martin, Abramson and Kealy — "do not suffice as an articulated reason with rational underpinning to combine their respective teachings."

"The Federal Circuit has concluded that merely asserting that references were drawn from the same field of art is 'simply too conclusory' to show that the skilled artisan would have combined these references in the way of the claimed invention," the panel ruled.

Next Caller initially petitioned the PTAB to conduct an inter partes review of the technology in October 2018, contending that Martin, Abramson and Kealy invalidated 20 claims in the challenged patent.

TrustID fired back in a January 2019 preliminary response and said the petition was riddled with "confusing and muddled claim charts" that failed to support Next Caller's obviousness arguments.

"The petition does not identify with particularity the evidence that supports the grounds for the challenge to each claim," TrustID said.

The PTAB issued a sealed final written decision in February 2020 and invalidated 14 of the challenged claims.

But the Federal Circuit partially vacated the board's ruling in September 2021 and remanded the suit back to the PTAB, ruling that the board had to take another look at claims it hadn't invalidated since it did not adequately explain why it upheld them.

The PTAB panel said Monday that Next Caller's obviousness arguments were still "deficient" on remand since the petitioner hadn't explained "why or how a person having ordinary skill in the art would have

modified the Martin and Abramson combination with Kealy in the manner recited" in the upheld claims.

Counsel for both parties did not immediately respond to requests for comment Tuesday.

The patent-in-suit is U.S. Patent No. 9,001,985.

Administrative Patent Judges Jean R. Homere, Barbara A. Parvis and Stacey G. White sat on the panel for the Patent Trial and Appeal Board.

Next Caller is represented by Ian B. Brooks of McDermott Will & Emery LLP and Eric Sophir of Foley & Lardner LLP.

TrustID is represented by Richard M. Bembien of Sterne Kessler Goldstein & Fox PLLC.

The suit is Next Caller Inc. v. TrustID Inc., case number IPR2019-00039, at the Patent Trial and Appeal Board.

--Additional reporting by Adam Lidgett. Editing by Stephen Berg.