

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP, INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01636
Patent 7,535,890 B2

Before MIRIAM L. QUINN, KERRY BEGLEY, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BEGLEY, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. §§ 42.108, 42.122

Facebook, Inc. and WhatsApp, Inc. (collectively, “Petitioner”) filed a Petition requesting *inter partes* review of claims 1–6, 14, 15, 17–20, 28, 29, 31–34, 40–43, 51–54, 62–65, and 68 (“the challenged claims”) of U.S. Patent No. 7,535,890 B2 (Ex. 1001, “the ’890 patent”). Paper 2 (“Pet.”). Along with the Petition, Petitioner filed a motion for joinder with IPR2017-00221, *Apple Inc. v. Uniloc USA, Inc.*, a pending *inter partes* review involving the same challenged claims of the ’890 patent. Paper 3 (“Mot.”).

Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 8 (“Prelim. Resp.”); *see* Paper 9 (Notice of Patent Owner Preliminary Response).¹ Patent Owner, however, did not file an opposition to Petitioner’s Motion for Joinder.

For the reasons given below, we institute *inter partes* review of claims 1–6, 14, 15, 17–20, 28, 29, 31–34, 40–43, 51–54, 62–65, and 68 of the ’890 patent. In addition, we exercise our discretion to join Petitioner as a petitioner in IPR2017-00221.

I. BACKGROUND

A. RELATED PROCEEDINGS

In IPR2017-00221, filed by Apple Inc. (“Apple”), we instituted *inter partes* review of the challenged claims—claims 1–6, 14, 15, 17–20, 28, 29, 31–34, 40–43, 51–54, 62–65, and 68—of the ’890 patent. *Apple Inc. v. Uniloc USA, Inc.*, Case IPR2017-00221 (PTAB May 25, 2017) (Paper 9)

¹ We authorized Patent Owner to file a Notice of Patent Owner Preliminary Response and the Preliminary Response filed in IPR2017-00221, which we would accept as the preliminary response in the instant proceeding. Paper 7, 4–5.

(“IPR2017-00221 Inst. Dec.”). In addition, the ’890 patent is the subject of IPR2017-01523 and IPR2017-01524, which were filed by Petitioner, as well as IPR2017-01612 and IPR2017-01802. *See* Pet. 72; Paper 4, 3. The ’890 patent also was the subject of IPR2017-00220, in which we denied institution of *inter partes* review. *See Apple Inc. v. Uniloc USA, Inc.*, Case IPR2017-00220 (PTAB May 25, 2017) (Paper 9).

Moreover, Petitioner and Patent Owner represent that the ’890 patent is the subject of numerous actions before the U.S. District Court for the Eastern District of Texas, including actions filed against Petitioner (Case Nos. 2-16-cv-00723 (Facebook, Inc.) and 2-16-cv-00645 (WhatsApp, Inc.)). Pet. 68–71; Paper 4, 1–3.

B. THE ’890 PATENT

The ’890 patent explains that “[v]oice messaging” and “instant text messaging” in both the Voice over Internet Protocol (“VoIP”) and public switched telephone network environments are known. Ex. 1001, 2:11–35. In prior art instant text messaging systems, a server presents a user of a client terminal with a “list of persons who are currently ‘online’ and ready to receive text messages,” the user “select[s] one or more” recipients and types the message, and the server immediately sends the message to the respective client terminals. *Id.* at 2:23–35. According to the ’890 patent, however, “there is still a need in the art for . . . a system and method for providing instant VoIP messaging over an IP network,” such as the Internet. *Id.* at 1:6–11, 2:36–48, 6:37–39.

In one embodiment, the ’890 patent discloses local instant voice messaging (“IVM”) system 200, depicted in Figure 2 below. *Id.* at 6:12–14.

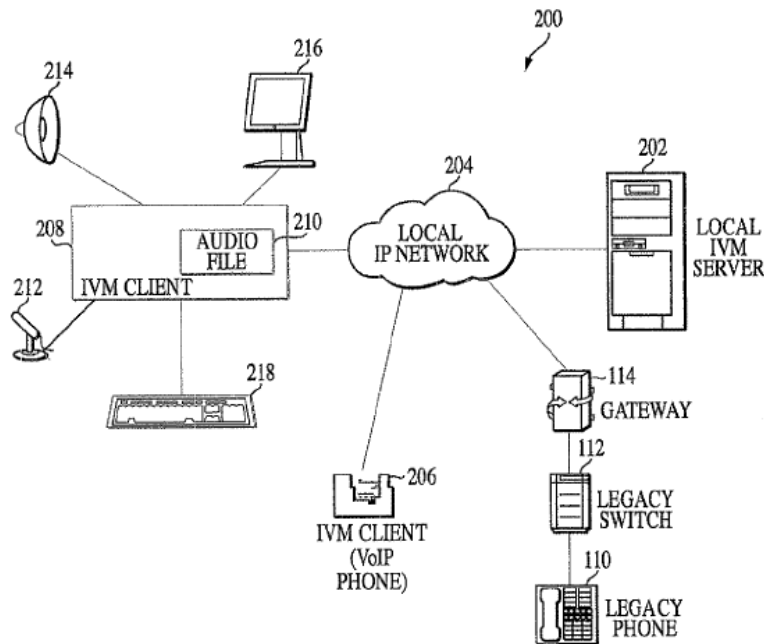


FIG. 2

As illustrated in Figure 2, local packet-switched IP network 204, which may be a local area network (“LAN”), “interconnects” IVM clients 206, 208 and legacy telephone 110 to local IVM server 202. *Id.* at 6:40–61; *see id.* at 7:13–14, 7:51–55. Local IVM server 202 enables instant voice messaging functionality over network 204. *Id.* at 7:53–55.

In “record mode,” IVM client 208, exemplified as a VoIP softphone in Figure 2, “displays a list of one or more IVM recipients,” provided and stored by local IVM server 202, and the user selects recipients from the list. *Id.* at 7:47–49, 7:55–61. IVM client 208 then transmits the selections to IVM server 202 and “records the user’s speech into . . . digitized audio file 210 (i.e., an instant voice message).” *Id.* at 7:61–8:1.

When the recording is complete, IVM client 208 transmits audio file 210 to local IVM server 202, which delivers the message to the selected recipients via local IP network 204. *Id.* at 8:5–19. “[O]nly the available

IVM recipients, currently connected to . . . IVM server 202, will receive the instant voice message.” *Id.* at 8:23–25. IVM server 202 “temporarily saves the instant voice message” for any IVM client that is “not currently connected to . . . local IVM server 202 (i.e., is unavailable)” and “delivers it . . . when the IVM client connects to . . . local IVM server 202 (i.e., is available).” *Id.* at 8:24–29; *see id.* at 9:7–11. Upon receiving the instant voice message, the recipients can audibly play the message. *Id.* at 8:19–22.

In another embodiment, the ’890 patent discusses global IVM system 500. *Id.* at 15:24–28, Fig. 5. Global IVM system 500 includes a local IVM system, such as local IVM system 200, and global IVM server system 502, with global IVM clients 506, 508. *Id.* at 15:25–33. Both the local and global IVM systems are connected to “packet-switched network 102 (i.e., Internet)” to enable the local and global IVM clients to be able to exchange instant voice messages with one another. *Id.* at 15:25–38.

C. ILLUSTRATIVE CLAIMS

Of the challenged claims, claims 1, 14, 28, 40, 51, and 62 of the ’890 patent are independent. Claims 1 and 28, reproduced below, are illustrative of the recited subject matter:

1. An instant voice messaging system for delivering instant messages over a packet-switched network, the system comprising:
 - a client connected to the network, the client selecting one or more recipients, generating an instant voice message therefor, and transmitting the selected recipients and the instant voice message therefor over the network; and
 - a server connected to the network, the server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message to the selected recipients over the network, the selected recipients enabled to audibly play the instant voice message, and the server

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