

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,¹
Patent Owner.

Case IPR2017-00221
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
37 C.F.R. § 42.108

¹ Patent Owner's Mandatory Notice, filed pursuant to 37 C.F.R. § 42.8, and Preliminary Response identify Uniloc USA, Inc. and Uniloc Luxembourg S.A. as patent owners. Paper 4; Paper 6 ("Prelim. Resp.") at caption. Therefore, we adjust the case caption to include Uniloc USA, Inc.

Apple Inc. (“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 (“challenged claims”) of U.S. Patent No. 7,535,890 B2 (Ex. 1001, “the ’890 patent”). Paper 2 (“Pet.”). Uniloc USA, Inc. and Uniloc Luxembourg S.A. (collectively, “Patent Owner”) filed a Preliminary Response. Prelim. Resp.

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons given below, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in establishing that all challenged claims of the ’890 patent are unpatentable, and we institute an *inter partes* review of the challenged claims.

I. BACKGROUND

A. RELATED MATTERS

Petitioner represents that the ’890 patent is the subject of numerous ongoing actions before the U.S. District Court for the Eastern District of Texas, including an action filed against Petitioner (Case No. 2-16-cv-00638). Pet. 71–72; *see* Paper 4, 2. Before the Office, the ’890 patent also is the subject of IPR2017-00220, which Petitioner filed concurrently with the instant proceeding. *See* Pet. 2–3; Prelim. Resp. 1 & n.1.

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.

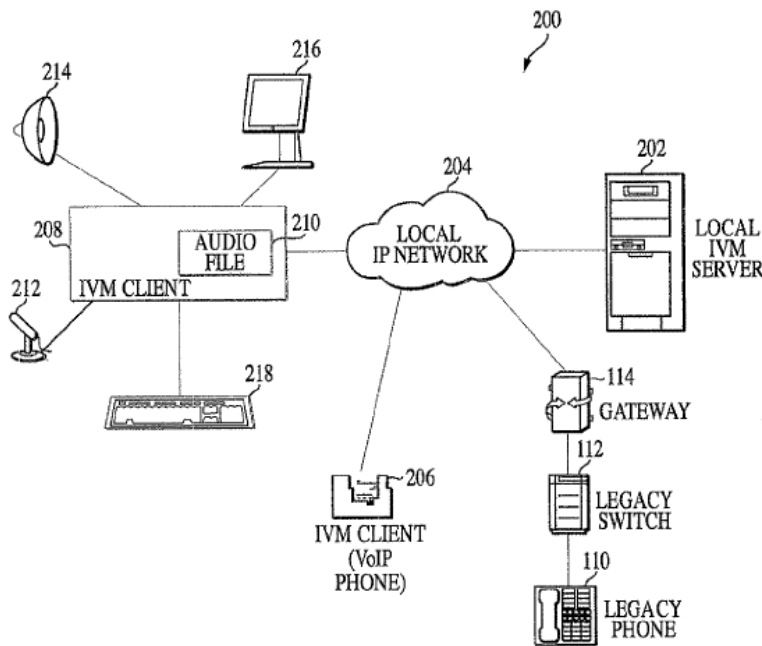


FIG. 2

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 temporarily storing the instant voice message if a selected recipient is unavailable and delivering the stored instant voice message to the selected recipient once the selected recipient becomes available.

28. An instant voice messaging system for delivering instant messages over a plurality of packet-switched networks, the system comprising:

- a client connected to an external network, the client selecting one or more recipients connected to a local network, generating an instant voice message therefor, and transmitting the selected recipients and the instant voice message therefor over the external network; and
- a external server system connected to the external network, the external server system receiving the selected recipients and the instant voice message, and routing the selected recipients and the instant voice message over the external network and the local network;
- a local server connected to the local network, the local server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message

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