

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 IPR2017-00222
Patent 8,243,723 B2

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

QUINN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

¹ The Mandatory Notice filed by Patent Owner pursuant to 37 C.F.R. § 42.8(a)(2) states that Uniloc USA, Inc. and Uniloc Luxembourg S.A. are both Patent Owners and real parties-in-interest. Paper 4. Accordingly, the caption shall reflect that the Patent Owner in this proceeding encompasses both “Uniloc” entities.

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–8 of U.S. Patent No. 8,243,723 B2 (Ex. 1001, “the ’723 patent”). Paper 2 (“Pet.”). Uniloc USA, Inc. and Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314. Upon considering the record developed thus far, for reasons discussed below, we institute *inter partes* review of the ’723 patent as to challenged claims 1–7.

A. Related Matters

The parties indicate that the ’723 patent is involved in *Uniloc USA, Inc. v. Apple, Inc.*, Case No. 2-16-cv-00638 (E.D. Tex.) and other proceedings. Pet. 75–77; Paper 6.

B. The ’723 Patent

The ’723 patent relates to Internet telephony, and more particularly, to instant Voice over IP (“VoIP”) messaging over an IP network, such as the Internet. Ex. 1001, 1:14–17. The ’723 patent acknowledges that “[i]nstant text messaging is [] known” in the VoIP and public switched telephone network (“PSTN”) environments, with its server presenting the user with a “list of persons who are currently ‘online’ and ready to receive text messages on their own client terminals.” *Id.* at 2:19, 30–37. In one embodiment, such as depicted in Figure 2 (reproduced below), the system of

the '723 patent involves an instant voice message (IVM) server and IVM clients. *Id.* at 7:19–24.

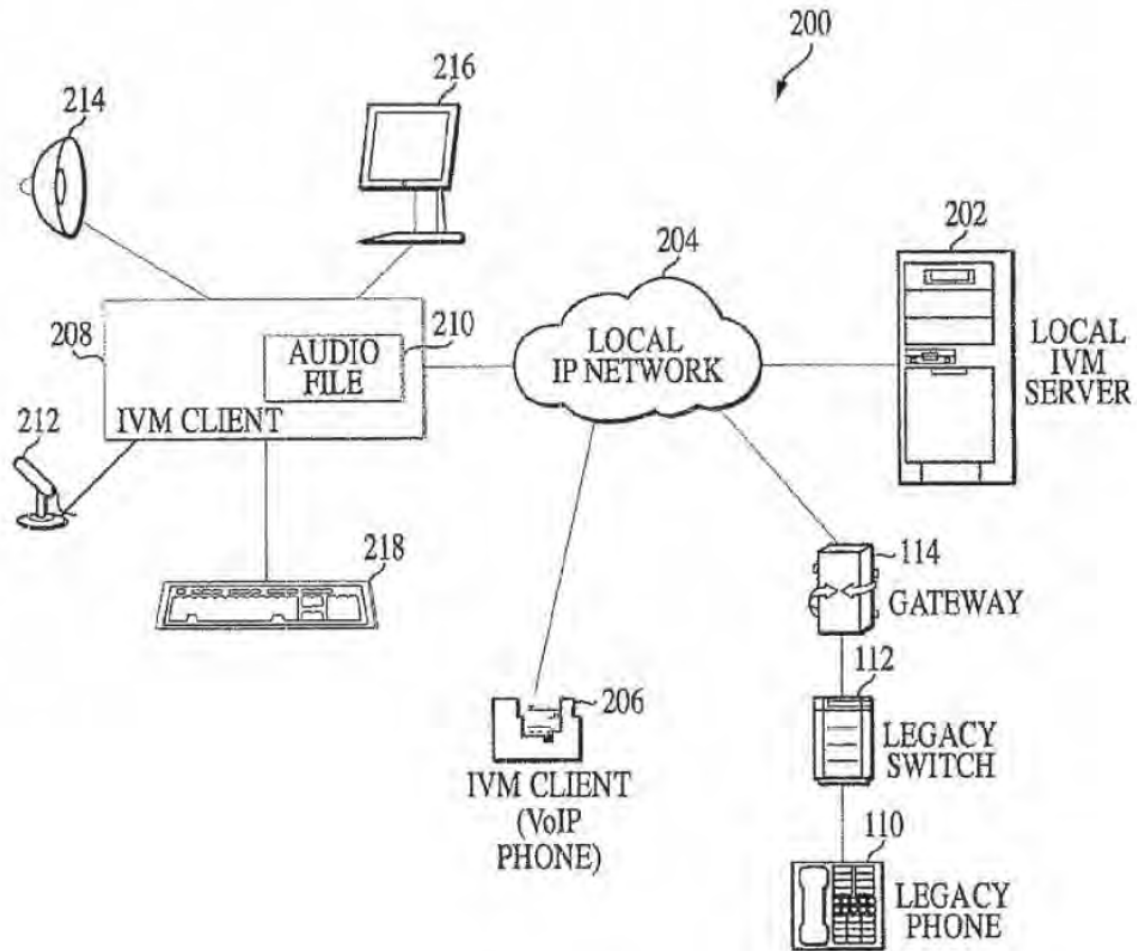


FIG. 2

Figure 2 illustrates IVM clients 206, 208 and legacy telephone 110 interconnected via network 204 to the local IVM server 202, where IVM client 206 is a VoIP telephone, and where legacy telephone 110 is connected to legacy switch 112 and further to media gateway 114. *Id.* at 6:61–65, 7:19–41. The media gateway converts the PSTN audio signal to packets for

transmission over a packet switched IP network, such as local network 204. *Id.* at 7:45–48. In one embodiment, when in “record mode,” the user of an IVM client selects one or more IVM recipients from a list. *Id.* at 7:53–64. The IVM client listens to the input audio device and records the user’s speech into a digitized audio file at the IVM client. *Id.* at 8:1–7. “Once the recording of the user’s speech is finalized, IVM client 208 generates a send signal indicating that the digitized audio file 210 (instant voice message) is ready to be sent to the selected recipients.” *Id.* at 8:11–14. The IVM client transmits the digitized audio file to the local IVM server, which, thereafter, delivers that transmitted instant voice message to the selected recipients via the local IP network. *Id.* at 8:1–25. Only the available IVM recipients, currently connected to the IVM server, will receive the instant voice message. *Id.* at 8:28–30. If a recipient “is not currently connected to the local IVM server 202,” the IVM server temporarily saves the instant voice message and delivers it to the IVM client when the IVM client connects to the local IVM server (i.e., is available). *Id.* at 8:30–35.

The ’723 patent also describes an “intercom mode” of voice messaging. *Id.* at 11:26–29. The specification states that the “intercom mode” represents real-time instant voice messaging. *Id.* at 11:29–30. In this mode, instead of creating an audio file, one or more buffers of a predetermined size are generated in the IVM clients or local IVM servers. *Id.* at 11:30–33. Successive portions of the instant voice message are written to the one or more buffers. *Id.* at 11:35–43. As the buffers fill, the content of each buffer is automatically transmitted to the IVM server for

transmission to the one or more IVM recipients. *Id.* Buffering is repeated until the entire instant voice message has been transmitted to the IVM server. *Id.* at 11:48–52.

C. Illustrative Claim

Of the challenged claims, claim 1 is independent. Each of claims 2–8 depends directly or indirectly from claim 1. Claim 1 is illustrative:

1. A method for instant voice messaging over a packet-switched network, the method comprising:

monitoring a connectivity status of nodes within the packet-switched network, said connectivity status being available and unavailable;

recording the connectivity status for each of the nodes;

associating a sub-net of the nodes with a client;

transmitting a signal to a client including a list of the recorded connectivity status for each of the nodes in the sub-set corresponding to the client;

receiving an instant voice message having one or more recipients;

delivering the instant voice message to the one or more recipients over a packet-switched network;

temporarily storing the instant voice message if a recipient is unavailable; and

delivering the stored instant voice message to the recipient once the recipient becomes available.

Ex. 1001, 23:55–24:16.

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