

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

Case IPR2017-00224
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 325(d) and 37 C.F.R. § 42.108

¹ Patent Owner's Mandatory Notice filed pursuant to 37 C.F.R. § 42.8 identifies Uniloc USA, Inc. and Uniloc Luxembourg S.A. as Patent Owner and as real parties in interest. Paper 4 at caption, 1. Therefore, we adjust the case caption to include Uniloc USA, Inc.

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 3, 4, 6–8, 10–19, 21–23, and 38 (“the challenged claims”) of U.S. Patent No. 8,724,622 B2 (Ex. 1001, “the ’622 patent”). Pet. 2. Uniloc USA, Inc. and Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Based on the particular circumstances of this case, we exercise our discretion under 35 U.S.C. § 325(d) and 37 C.F.R. § 42.108 and do not institute an *inter partes* review of the challenged claims.

II. BACKGROUND

A. *Related Matters*

Petitioner indicates that the ’622 patent is involved in *Uniloc USA, Inc. v. Apple Inc.*, No. 2:16-cv-00638 (E.D. Tex.) and twenty-six other actions in the U.S. District Court for the Eastern District of Texas. Pet. 51–52. The ’622 patent also is the subject of Case IPR2017-00223, which Petitioner filed concurrently with the instant proceeding. *See* Pet. 2–3; Prelim. Resp. 1 & n.1.

B. *Overview of the ’622 Patent*

The ’622 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, 2:22–46. 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 2:34–46. According to the ’622 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 1:18–22, 2:47–59, 6:47–49.

In one embodiment, the '622 patent discloses local instant voice messaging (“IVM”) system 200, depicted in Figure 2 below. *Id.* at 6:22–24.

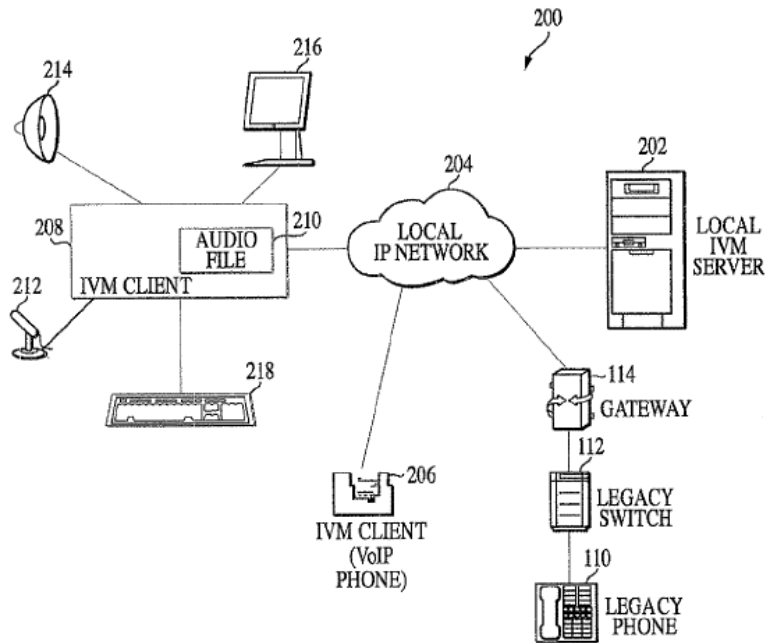


FIG. 2

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 6:50–7:2; *see id.* at 7:23–24, 7:61–65. Local IVM server 202 enables instant voice messaging functionality over network 204. *Id.* at 7:61–65.

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 7:57–59, 7:65–8:4. 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 8:4–11.

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 8:15–29. “[O]nly the available IVM recipients, currently connected to . . . IVM server 202, will receive the instant voice message.” *Id.* at 8:33–34. 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 8:34–39; *see id.* at 9:17–21. Upon receiving the instant voice message, the recipients can audibly play the message. *Id.* at 8:29–32.

C. Illustrative Claims

Of the challenged claims, claims 3 and 38 are independent. Those two independent claims, which are reproduced below, are illustrative of the recited subject matter:

3. A system comprising:
 - a network interface connected to a packet-switched network;
 - a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
 - a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and
wherein the instant voice message includes an object field including a digitized audio file.

38. A system comprising:
a client device;
a network interface coupled to the client device and connecting the client device to a packet-switched network; and
an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,
a display displaying a list of one or more potential recipients for an instant voice message.

Ex. 1001, 24:12–27, 27:11–23.

D. References Relied Upon

Petitioner relies on the following references:

Hogan	US 5,619,554	Apr. 8, 1997 (Ex. 1010)
Logan	US 5,732,216	Mar. 24, 1998 (Ex. 1011)
Dahod	US 2004/0022208 A1	Feb. 5, 2004 (Ex. 1009) ("the Dahod application")

Pet. 2. Petitioner also relies on a declaration of Leonard J. Forys, Ph.D. (Ex. 1003).

E. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 3, 4, 6–8, 10–19, 21–23, and 38 under 35 U.S.C. § 103 on the following grounds:

Reference(s)	Claim(s) Challenged
the Dahod application	3, 4, 7, 8, 11–13, 18, 21–23, and 38
the Dahod application and Hogan	6, 10, and 14–17
the Dahod application and Logan	19

Pet. 2.

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