UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC., SNAP INC., FACEBOOK, INC.,
and WHATSAPP, INC.,[1]
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,[2]
Patent Owner.

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Case IPR2017-00225
Patent 8,995,433 B2

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Before JENNIFER S. BISK, MIRIAM L. QUINN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges.*

QUINN, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

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[1] Snap Inc. filed a petition and motion for joinder in IPR2017-01611, which
we granted. Paper 12. Facebook, Inc. and WhatsApp, Inc., filed a petition
and motion for joinder in IPR2017-01634, which we granted. Paper 13.
Thus, these entities, as captioned, are joined, as Petitioner, to this
proceeding.

[2] An updated Mandatory Notice filed by Patent Owner pursuant to 37 C.F.R.
§ 42.8(a)(2) states that Uniloc Luxembourg S.A. is the Patent Owner. Paper
25.

I.   INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 314, Petitioner, as listed in the caption above, challenges the patentability of claims 1–6 and 8 of U.S. Patent No. 8,995,433 B2 (Ex. 1001, "the '433 patent"), owned by Uniloc Luxembourg S.A. We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has not shown by a preponderance of the evidence that claims 1–6 and 8 ("the challenged claims") of the '433 patent are unpatentable.

A.   PROCEDURAL HISTORY

Apple Inc. filed a Petition to institute *inter partes* review of claims 1–6 and 8 of the '433 patent. Paper 2 ("Pet."). Patent Owner filed a Preliminary Response. Paper 6 ("Prelim. Resp."). On May 25, 2017, we instituted *inter partes* review as to all challenged claims. Paper 7 ("Institution Decision" or "Dec"). Snap Inc., Facebook, Inc., and WhatsApp, Inc. are joined to this proceeding pursuant to our grant of petitions and motions for joinder filed in IPR2017-01611 and IPR2017-01634. Papers 12, 13.

After institution, Patent Owner filed a Patent Owner Response. Paper 11 ("PO Resp."). And Petitioner filed a Reply. Paper 15 ("Reply"). We heard oral arguments on February 8, 2018. A transcript of the hearing has been entered into the record. Paper 26 ("Tr.").

B.   RELATED MATTERS

The parties indicate that the '433 patent is involved in *Uniloc USA, Inc. v. Apple, Inc.*, Case No. 6-16-cv-00638 (E.D. Tex.), *Uniloc USA, Inc. v.*

Snap Inc., 2-16-cv-00696-JRG (E.D. Tex.), *Uniloc USA, Inc. v. Facebook, Inc.*, 2-16-cv-00728-JRG (E.D. Tex.), *Uniloc USA, Inc. v. WhatsApp, Inc.*, 2-16-cv-00645-JRG (E.D. Tex.), and other proceedings. Pet. 75–77; Paper 28.

The '433 patent also has been the subject of multiple petitions for *inter partes* review filed by various petitioners. Paper 28 at 3. We mention here that the '433 patent is also the subject matter of IPR2017-01427 and IPR2017-01428, filed by two Petitioner entities in this proceeding: Facebook, Inc., and WhatsApp, Inc.

C. REAL PARTIES-IN-INTEREST

Patent Owner asserts that Uniloc U.S.A., Inc. is the exclusive licensee and is a real party-in-interest. Paper 25.

D. THE '433 PATENT (EX. 1001)

The '433 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, 1:19–23. The '433 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 2:35–42. In one embodiment, such as depicted in Figure 2 (reproduced below), the system of the '433 patent involves an instant voice message (IVM) server and IVM clients. *Id.* at 7:21–22.
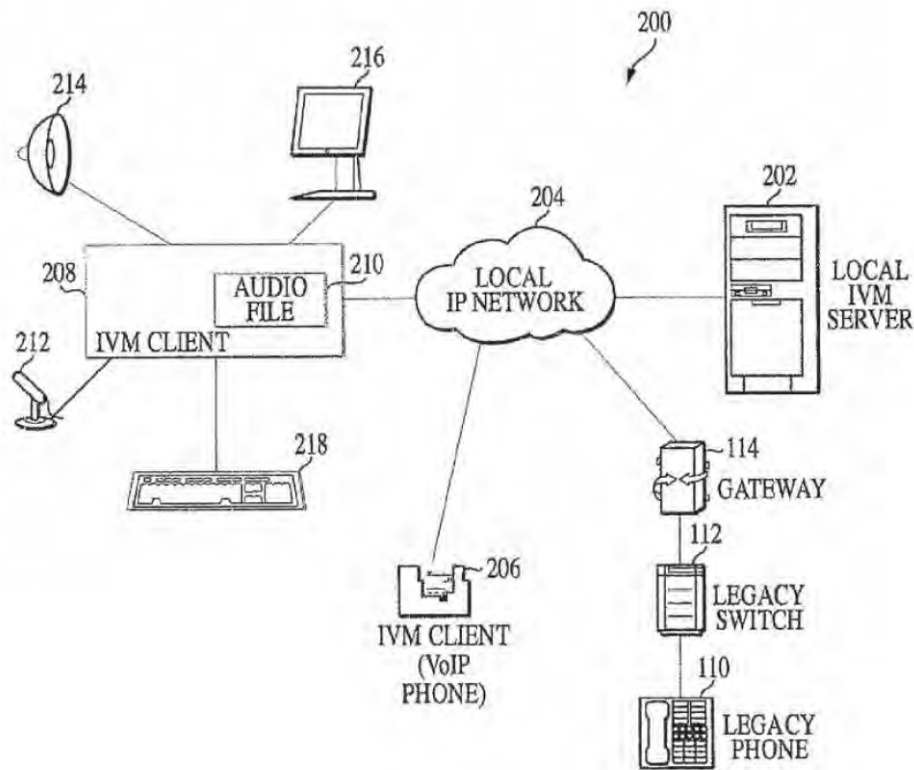
FIG. 2

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 6:65–7:6, 7:27–49. 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 7:49–53. In one embodiment, when in "record mode," the user of an IVM client selects one or more IVM recipients from a list. *Id.* at 8:2–5. 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 8:12–15. "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 8:19–22. 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 8:25–26. Only the available IVM recipients, currently connected to the IVM server, will receive the instant voice message. *Id.* at 8:36–38. 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 8:38–43.

The '433 patent also describes an "intercom mode" of voice messaging. *Id.* at 11:34–37. The specification states that the "intercom mode" represents real-time instant voice messaging. *Id.* at 11:37–38. 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 11:38–41. Successive portions of the instant voice message are written to the one or more buffers. *Id.* at 11:41–46. 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 11:46–59.

E. REPRESENTATIVE CLAIM

Of the challenged claims, claims 1 and 6 are independent. Each of claims 2–5 and 8 depends directly or indirectly from claim 1. Claim 1 is representative:

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