Facebook, Inc. et al.
v.
Uniloc Luxembourg S.A.

Case IPR2017-01427
(Patent 8,995,433)

Hearing Before Jennifer S. Bisk,
Miram L. Quinn, and
Charles J. Bourdreau

August 30, 2018

Facebook and WhatsApp are estopped as to all challenges (in IPR2017-1427) except claim 7:

> previously instituted trial. Further, because the Board has issued a Final Written Decision in IPR2017-00225 concerning claims 1–6 and 8, we determine that Facebook and WhatsApp are estopped from maintaining the instant proceeding under § 315(e)(1) as to those claims. However, because this proceeding challenges claim 7, which was not addressed in the Final Written Decision in IPR2017-00225, we determine that Facebook and WhatsApp are not estopped from maintaining the proceeding with respect to *claim 7 only*. *See* 35 U.S.C. § 318(e)(1) (stating petitioner "may not request

Partial Dismis
(Paper 30) at

Facebook and WhatsApp joined in a consolidated Reply that again raises the estopped challenges:

> III. Independent claims 1 and 6
>
>   A. The combination of Zydney and Clark renders the "message database" obvious

Reply (Paper 3

The plain language of claim 7 reveals that it must be possible for each "potential recipient" (in the displayed "list of one or more potential recipients") to be currently <u>unavailable</u> to receive an instant voice message:

7. The system according to claim 1, wherein the instant voice messaging application displays an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message.

Appleman's "offline buddies" are not "potential recipients" as cl

104.	Appelman discloses that only buddies that are currently logged into the system (i.e., online and available) can be selected for instant messaging. EX1004 at 6:2-5 ("Once a co-user is displayed on a user's buddy list, indicating that the co-user is currently logged into the network system, the preferred embodiment of the invention enables a simple way of communicating with that co-user."). Although offline buddies can be displayed in the Buddy List window, offline buddies cannot be selected for instant messaging. From the passage of Appelman above, it is clear that the communication with a co-user is enabled once that co-user is logged in, i.e., available.

105.	Because the Buddy List window of Appelman does not allow selecting an offline buddy, the Petitioners' asserted combination of

EX2001 (Dr. DiEuliis
(quoting Appelman
at 6:1-4)

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Case IPR2017-01428 (Patent 8,995,433)
Case IPR2017-01667, -1668 (Patent 8,724,622

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