

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., WHATSAPP INC., and LG ELECTRONICS, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01427 (Patent 8,995,433 B2)

FACEBOOK, INC., WHATSAPP INC., LG ELECTRONICS, INC., and
HUAWEI DEVICE CO., LTD.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01428 (Patent 8,995,433 B2)

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

QUINN, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding, 37 C.F.R. § 42.5

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On August 30, 2018, we held the oral argument for the above-captioned cases.¹ During the argument for IPR2017-01428, the parties to both proceedings were given an opportunity to address Exhibit 3001, a dictionary definition of “instant messaging,” as a starting point for discussing the appropriate claim construction of the claim term “instant voice message,” recited in all the independent challenged claims. By way of introduction, the definition of “instant messaging,” according to that dictionary, in relevant part, is: “A service that alerts users when friends or colleagues are on line and allows them to communicate with each other in real time through private online chat areas.” Ex. 3001, 2. The panel gave the parties an opportunity to object to the entry of Exhibit 3001 in the record. Tr. 67:12–68:5. There were no objections.

After review of the discussion on claim construction issues in the captioned cases, the panel requests additional briefing as detailed below. By way of background, we noted, in our Decision on Institution in IPR2017-01428, that Patent Owner’s argument regarding whether the prior art disclosed the required “instant voice message” was an issue of claim construction that required additional briefing. Decision on Institution, 11-12 (Paper 8, IPR2017-01428). Patent Owner’s Response proposes that the Board construe “instant voice message” as “an audio file recording voice data.” IPR2017-01428, Paper 21, 6–7 (arguing lexicography because of the

¹ For IPR2017-01427, the transcript of the oral argument is filed as Paper 40, and for IPR2017-01428, the transcript of the oral argument is filed as Paper 34 (“Tr.”). The discussion of claim construction for “instant voice message” was introduced in the oral argument for IPR2017-01428, but is applicable to IPR2017-01427 as both of these cases involve the same patent and all claims recite the “instant voice message” term.

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repeated use of “i.e.” in certain embodiments). Petitioner’s Reply proposes that the construction is not limited to an audio file, but does not otherwise propose a construction stating that the term “instant voice message” “can be left to its plain and ordinary meaning, encompassing the instant voice messages disclosed by Zydney.”² IPR2017-01428, Paper 29, 2–5. During oral argument we addressed with the parties the insufficiency of their respective briefs with regard to claim construction. Tr. 10:8–11:25, 21:17–15, 25:7–27:24.

After hearing argument on Exhibit 3001 and discussing claim construction alternatives, Petitioner agreed that the claimed “instant voice message” would be a “data structure including a representation of an audible message.” *Id.* at 13:6–11. Patent Owner agreed in principle that the scope of the term “instant voice message” would be the “data content including a representation of an audio message, not precluding the inclusion of fields.” Tr. 66:22–67:5. Patent Owner also argued the scope of the “content” in the “instant voice message” to clarify that the content (or audio data) cannot exist independently of the medium by which the content is transported. *Id.* at 64:3–66:1.

Although there are many similarities between these positions, Patent Owner’s preference for the word “content” versus the word “structure” presents an issue that requires further consideration by the parties. Further, we find that the record does not adequately reflect the parties’ positions as to how the respective constructions that have been agreed to allegedly would or

² Zydney is PCT Application Publication No. WO 01/11824 A2, published February 15, 2001, and filed in IPR2017-01427 as Exhibit 1003 and in IPR2017-01428 as Exhibit 1103.

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would not map to Zydney's voice container, asserted by Petitioner to be the claimed "instant voice message" in these proceedings. Accordingly, the parties will be provided an opportunity to brief each other's claim construction positions, as agreed to during the oral argument and summarized below. The brief should also address the applicability of each of these constructions to the asserted prior art. No new evidence will be allowed at this stage of the proceeding, and the arguments are to be limited to addressing solely the two claim construction positions, including the legal and factual reasons for each party's position, and the application of those claim construction positions to Zydney's voice container.

III. ORDER

Accordingly, it is:

ORDERED that the parties shall brief the following claim construction alternatives for the term "instant voice message":

- "a data structure including a representation of an audible message"; and
- "the data content including a representation of an audio message, not precluding the inclusion of fields";

FURTHER ORDERED that the parties shall address the applicability of these claim constructions to Zydney's voice container;

FURTHER ORDERED that the opening brief for both parties is limited to 8 pages and shall be filed simultaneously, by September 28;

FURTHER ORDERED the parties may file a responsive brief, limited to 5 pages, by no later than October 5; and

FURTHER ORDERED that no other papers are authorized and no new evidence shall be introduced.

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