

Declaration of Tal Lavian, Ph.D., in Support of
Petition for *Inter Partes* Review of
U.S. Patent No. 8,995,433

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Facebook, Inc., WhatsApp, Inc.
Petitioners

v.

Uniloc USA, Inc., Uniloc Luxembourg S.A.,
Patent Owner

U.S. Patent No. 8,995,433

TITLE: SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING

DECLARATION OF TAL LAVIAN, PH.D.

TABLE OF CONTENTS

	Page
I. INTRODUCTION AND QUALIFICATIONS	1
A. Qualifications and Experience	1
B. Materials Considered.....	5
II. PERSON OF ORDINARY SKILL IN THE ART	7
III. BASIS FOR MY OPINION AND STATEMENT OF LEGAL PRINCIPLES	9
A. Claim Construction	9
B. Anticipation	9
C. Obviousness.....	10
1. Motivation to Combine.....	13
IV. RELEVANT TECHNOLOGY BACKGROUND	15
A. The Internet and TCP/IP Protocol Suite.....	15
B. Voice over IP (VoIP).....	16
C. Instant messaging (IM).....	19
1. IETF in RFC 2778 – “A Model for Presence and Instant Messaging”.....	23
2. IETF in RFC 2779 – “Instant Messaging / Presence Protocol Requirements”	24
3. Prior Art Instant Messaging (“IM”) Systems	24
V. THE ’433 PATENT.....	28
A. The Specification.....	28
B. The Claims of the ’433 Patent.....	30
C. Claim Construction	30
1. “instant voice messaging application”	30
2. “client platform system”	37
VI. APPLICATION OF THE PRIOR ART TO THE CLAIMS.....	39
A. Brief Description and Summary of the Prior Art.....	40
1. Brief Summary of Zydney [Ex. 1003/1103].....	40

TABLE OF CONTENTS
(continued)

	Page
2. Brief Summary of Greenlaw [Ex. 1010/1110]	47
3. Brief Summary of Clark [Ex. 1008/1108]	48
4. Brief Summary of Appelman [Ex. 1004/1104]	51
5. Brief Summary of Newton [Ex. 1006/1106]	56
B. Zydney Renders Obvious Claims 9, 12, 14, 17, and 25-26	56
1. Independent Claim 9	56
(a) Preamble of Claim 9: “A system, comprising:”	57
(b) “an instant voice messaging application comprising:” (Claim 9[a])	57
(c) “wherein the instant voice message application attaches one or more files to the instant voice message.” (Claim 9[b])	70
2. Dependent Claim 12	74
(a) Preamble of Claim 12: “The system according to claim 9,”	75
(b) “wherein the instant voice messaging application encrypts the instant voice message.” (Claim 12[a])	75
3. Dependent Claim 14	77
(a) Preamble of Claim 14: “The system according to claim 9,”	77
(b) “wherein the instant voice messaging application invokes a document handler to create a link between the instant voice message and the one or more files.” (Claim 14[a])	78
4. Dependent Claim 17	83
(a) Preamble of Claim 17: “The system according to claim 9 further comprising”	83

TABLE OF CONTENTS
(continued)

	Page
(b) “an instant voice messaging server receiving the instant voice message and an indication of one or more intended recipients of the instant voice message.” (Claim 17[a])	84
5. Dependent Claim 25	89
(a) Preamble of Claim 25: “The system of claim 17”	89
(b) “wherein the instant voice messaging server determines availability of the one or more intended recipients for receipt of the instant voice message.” (Claim 25[a])	89
6. Dependent Claim 26	91
(a) Preamble of Claim 26: “The system of claim 25, wherein the instant voice messaging server”	92
(b) “delivers the instant voice message to the one or more intended recipients who are determined to be currently available;” (Claim 26[a])	92
(c) “stores the instant voice message for the one or more intended recipients who are not currently available; and” (Claim 26[b])	93
(d) “delivers the instant voice message to the one or more intended recipients who are not currently available when the instant voice messaging server determines that the not currently available one or more intended recipients become available.” (Claim 26[c])	95
C. Zydney in View of Greenlaw Discloses and Renders Obvious Claims 11, 15, and 16	97
1. Dependent Claim 11	97

TABLE OF CONTENTS
(continued)

	Page
(a) Preamble of Claim 11: “The system according to claim 9,”	97
(b) “wherein the instant voice messaging application displays one or more controls for audibly playing the instant voice message.” (Claim 11[a]).....	97
2. Dependent Claim 15	103
(a) Preamble of Claim 15: “The system according to claim 9,”	104
(b) “wherein the instant voice messaging application displays the attachment.” (Claim 15[a]).....	104
3. Dependent Claim 16	105
(a) Preamble of Claim 16: “The system according to claim 9,”	106
(b) “wherein the instant voice messaging application displays one or more controls for performing at least one of reviewing, re-recording or deleting the instant voice message.” (Claim 16[a]).....	106
D. Zydney in View of Newton Discloses and Renders Obvious Claim 10	108
1. Dependent Claim 10	108
(a) Preamble of Claim 10: “The system according to claim 9,”	108
(b) “wherein the packet-switched network comprises a WiFi network.” (Claim 10[a])	108
E. Zydney in View of Clark Renders Obvious Claims 1-6 and 8	113
1. Independent Claim 1	113
(a) Preamble of claim 1: “A system, comprising:”	114

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.