

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-02088
Patent 8,995,433 B2

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

QUINN, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108,
37 C.F.R. § 42.122(b)

I. INTRODUCTION

LG Electronics, Inc. and Huawei Device Co., Ltd. (collectively, “Petitioner”) filed a Petition requesting *inter partes* review of claims 9–12, 14–17, 25, and 26 of U.S. Patent No. 8,995,433 B2 (“the ’433 patent”). Paper 2 (“Pet.”). Petitioner also filed a Motion for Joinder seeking joinder as petitioners with Facebook, Inc. and WhatsApp Inc. (collectively, “Facebook 1428 Petitioner”) in *Facebook, Inc. v. Uniloc Luxembourg S.A.*, Case No. IPR2017-01428 (the “Facebook IPR”). Paper 3 (“Joinder Motion”). Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). Patent Owner did not file an opposition to the Motion for Joinder.

We have authority under 35 U.S.C. § 314. Upon considering the information presented in the parties’ papers, for reasons discussed below, we institute *inter partes* review of claims 9–12, 14–17, 25, and 26 of the ’433 patent and grant Petitioner’s Motion for Joinder.

A. Related Matters

The parties indicate that the ’433 patent is involved in *Uniloc USA, Inc. v. LG Electronics U.S.A., Inc.*, Case No. 2-16-cv-00991-JRG (E.D. Tex.) and *Uniloc USA, Inc. v. Huawei Device USA, Inc.*, Case No. 2:16-cv-00994-JRG (E.D. Tex.). Pet. 1–2. The ’433 patent also is the subject of Case IPR2017-00225 (filed by Apple Inc.), in which we instituted *inter partes* review on May 25, 2017, and Cases IPR2017-01427 and IPR2017-01428 (filed by Facebook, Inc., and WhatsApp Inc.), in which we

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instituted *inter partes* review on December 4, 2017. *See* Paper 5. In addition, LG Electronics has filed another petition and motion for joinder in IPR2017-02087, where joinder is sought in connection with IPR2017-01427.

B. The '433 Patent

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. 1101, 1:19–23. The '433 patent acknowledges that “instant text messaging is . . . known” in the VoIP and public switched telephone network (“PSTN”) environments, with a server presenting the user 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.

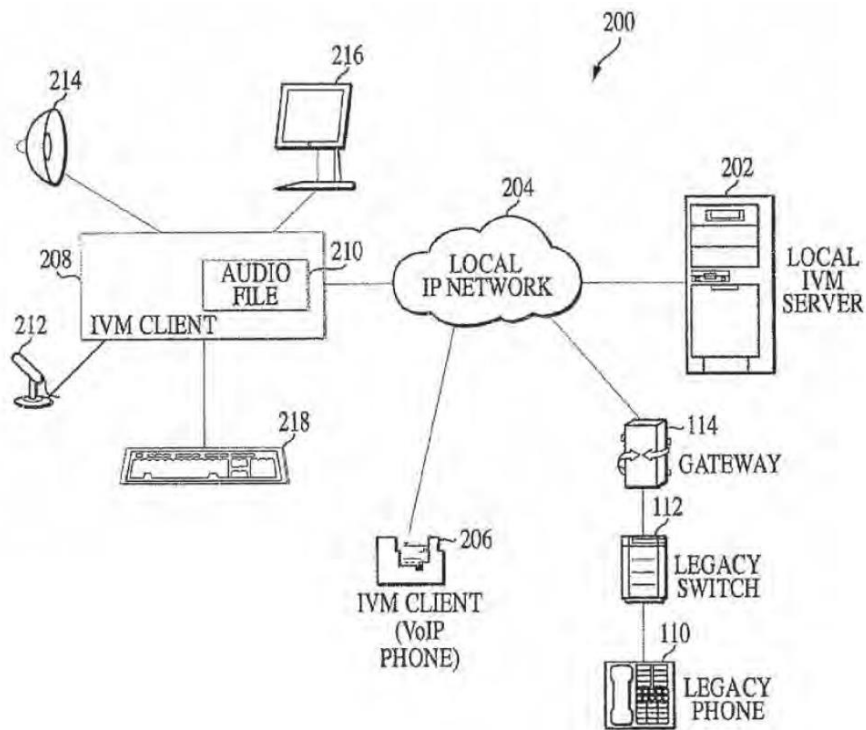


FIG. 2

Figure 2 illustrates IVM client 206 interconnected via network 204 to 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 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, i.e., those recipients who are 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, which, as they fill, automatically transmit their content to the IVM server for transmission to the one or more IVM recipients. *Id.* at 11:41–46. Buffering is repeated until the entire instant voice message has been transmitted to the IVM server. *Id.* at 11:46–59.

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