

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. AND WHATSAPP, INC.,

Petitioners,

v.

UNILOC USA, INC. AND UNILOC LUXEMBOURG S.A.,
Patent Owner

Case IPR2017-01523
U.S. Patent 7,535,890

DECLARATION OF DR. VAL DI EULIIS

SEPTEMBER 8, 2017

TABLE OF CONTENTS

1. INTRODUCTION	5
2. QUALIFICATIONS.....	6
3. COMPENSATION, TESTIMONY, AND PUBLICATIONS	9
4. INFORMATION CONSIDERED	11
5. LEGAL STANDARDS.....	12
6. THE '890 PATENT	13
6.1 Claims.....	21
7. ORDINARY SKILL IN THE ART	23
8. INTERNATIONAL APPLICATION WO 01/11824 ("ZYDNEY")	24
9. ZYDNEY DOES NOT RENDER OBVIOUS ANY CHALLENGED CLAIM OF THE '890 PATENT	36
9.1 Zydney Does Not Disclose "transmitting the selected recipients and the instant voice message therefor over the network" or "the server receiving the selected recipients and the instant voice message therefor" (Claim 1)	38
9.1.1 Zydney Does Not Disclose that "the selected recipients" are transmitted or received.....	38
9.1.2 Zydney Does Not Disclose the Separate Transmission of the Voice Data and the List of Recipients	41
9.2 Zydney Does Not Disclose "transmitting the selected recipients and the instant voice message therefor over the network from the client to a server" or "the server receiving the selected recipients and the instant voice message therefor at the server" (Claim 40)	43
10. ZYDNEY DOES NOT DISCLOSE OR RENDER OBVIOUS THE FURTHER LIMITATIONS OF DEPENDENT CLAIM 5, 6, 42, OR 43.....	43

10.1	The Petitioners fail to show that Zydney discloses “wherein the server delivers the instant voice message to the selected recipients that are available” (Claim 5) and “delivering the instant voice message from the server to the selected recipients that are available” (Claim 42)	45
10.2	The Petitioners fail to show that Zydney discloses “wherein the client records the instant voice message in an audio file, transmits the audio file to the server, and the server delivers the audio file to the selected recipients, the selected recipients being enabled to audibly play the audio file” (Claim 6) and “recording the instant voice message at the client in an audio file; transmitting the audio file to the server; delivering the audio file from the server to the selected recipients; and audibly playing the audio file at the least one of the selected recipients.” (Claim 43)	48
10.2.1	Zydney does not disclose or render obvious “transmitting the audio file to the server”	49
10.2.2	Zydney does not disclose or render obvious “the server delivers the audio file to the selected recipients”	50
10.2.3	Zydney does not disclose or render obvious “audibly playing the audio file”	51
11.	U.S. PATENT NO. 6,750,881 (“APPELMAN”)	53
12.	THE PROPOSED COMBINATION OF ZYDNEY IN VIEW OF APPELMAN AND MARTIN-FLATIN FAILS TO RENDER OBVIOUS CLAIM 4 OR 41 OF THE ’890 PATENT	56
12.1	The Proposed Combination of Zydney and Appelman is Improper Because the Combination of Zydney and Appelman Would Render Zydney Unsatisfactory for an Intended Purpose of Zydney	57
12.2	The Proposed Combination of Zydney in view of Appelman and Martin-Flatlin Fails to Render Obvious “wherein the client requests a list of recipients associated with the client from the server and the server transmits the list of recipients to the client for selection of the one or more recipients” (Claim 4).....	60

12.2.1 Zydney does not disclose the client “requesting a list of recipients associated with the client from the server”	61
12.2.2 Zydney does not disclose the server transmitting the list of recipients to the client	63
12.3 The Proposed Combination of Zydney in view of Appelman and Martin-Flatlin Fails to Render Obvious “requesting from the client a list of recipients associated with the client from the server; and transmitting from the server the list of recipients to the client for selection of the one or more recipients” (Claim 41)	64

I, Dr. Val DiEuliis, hereby declare and state as follows:

1. Introduction

1. My name is Val DiEuliis, and I have been retained by Uniloc, USA, Inc. and Uniloc Luxembourg S.A. (“Uniloc” or the “Patent Owner”). My client Uniloc and its associated counsel, Etheridge Law Group, have asked me to study U.S. Patent No. 7,535,890 (“the ’890 patent”), the Petition, the proffered prior art in this case, and other relevant documents. I document my findings in this declaration.

2. I have concluded that International Application WO 01/11824 (“Zydney”) [EX1003], alone or in view of Appelman [EX1004] and Martin-Flatin [EX1009] does not render obvious any challenged claim of the patent at issue, the ’890 patent, at least for the following reasons:

- Zydney fails to disclose “transmitting the selected recipients and the instant voice message therefor over the network” recited in independent claim 1.
- Zydney fails to disclose “the server receiving the selected recipients and the instant voice message therefor” recited in independent claim 1.

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.