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Paper No. 7
Filed: December 4, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP, INC.,
Petitioner,

v.

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

Case IPR2017-01523
Patent 7,535,890 B2

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

BEGLEY, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Facebook, Inc. and WhatsApp, Inc. (collectively, "Petitioner") filed a Petition requesting *inter partes* review of claims 1–6, 9, 40–43, and 46 of U.S. Patent No. 7,535,890 B2 (Ex. 1001, "the '890 patent"). Paper 2 ("Pet."). Uniloc USA, Inc. and Uniloc Luxembourg S.A. (collectively, "Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

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Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless "the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." Having considered the Petition and the Preliminary Response, we determine that the information presented does not show that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of any of the challenged claims of the '890 patent. For the reasons given below, we deny institution of an *inter partes* review.

I. BACKGROUND

A. RELATED MATTERS

Petitioner and Patent Owner represent that the '890 patent is asserted in numerous actions before the U.S. District Court for the Eastern District of Texas, including actions filed against Petitioner (Case Nos. 2-16-cv-00728 (Facebook, Inc.) and 2-16-cv-00645 (WhatsApp, Inc.)). Pet. 2–3; Paper 4, 2.

In addition, the '890 patent is the subject of several *inter partes* review proceedings before the Office. In IPR2017-00221, filed by Apple Inc., the Board instituted *inter partes* review of claims 1–6, 14, 15, 17–20, 28, 29, 31–34, 40–43, 51–54, 62–65, and 68 of the '890 patent on May 25, 2017. *Apple Inc. v. Uniloc USA, Inc.*, Case IPR2017-00221 (PTAB May 25, 2017) (Paper 9). On June 16, 2017, Snap Inc. and Petitioner filed IPR2017-01612 and IPR2017-01636, respectively, both of which included a motion for joinder with IPR2017-00221. The Board instituted review in these proceedings and joined Snap Inc. and Petitioner as petitioners in IPR2017-00221. *Snap Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-01612 (PTAB Oct. 3, 2017) (Paper 11); *Facebook, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-01636 (PTAB Oct. 3, 2017) (Paper 10).

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Moreover, on June 2, 2017—concurrent with the instant Petition—Petitioner filed IPR2017-01524, which challenges claims 14, 15, 17–20, 23, 28, 29, 31–34, 37, 51–54, 57, 62–65, and 68 of the '890 patent. *See* Pet. 1. The '890 patent also is at issue in IPR2017-01802 (filed by Samsung Electronics America, Inc.), IPR2017-02082, IPR2017-02083, and IPR2017-02084 (filed by Google, Inc.)—in which the Board has not yet issued an institution decision. *See Samsung Elecs. Am., Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-01802 (PTAB), Paper 1; *Google, Inc. v. Uniloc Luxembourg S.A.*, Cases IPR2017-02082, IPR2017-02083, IPR2017-02084 (PTAB), Paper 2.

Further, the '890 patent previously was the subject of IPR2017-00220, filed by Apple Inc., in which the Board denied institution. *See* Pet. 1.

B. THE '890 PATENT

The '890 patent explains that "[v]oice messaging" and "instant text messaging" in both the Voice over Internet Protocol ("VoIP") and public switched telephone network environments are known. Ex. 1001, 2:11–35. In prior art instant text messaging systems, a server presents a user of a client terminal with a "list of persons who are currently 'online' and ready to receive text messages," the user "select[s] one or more" recipients and types the message, and the server immediately sends the message to the respective client terminals. *Id.* at 2:23–35. According to the '890 patent, however, "there is still a need in the art for . . . a system and method for providing instant VoIP messaging over an IP network," such as the Internet. *Id.* at 1:6–11, 2:36–48, 6:37–39.

In one embodiment, the '890 patent discloses local instant voice messaging ("IVM") system 200, depicted in Figure 2 below. *Id.* at 6:12–14.

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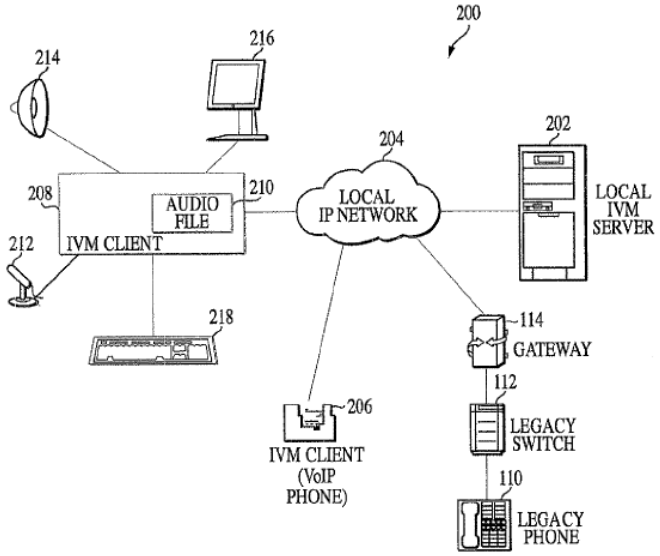

FIG. 2

As illustrated in Figure 2, local packet-switched IP network 204, which may be a local area network ("LAN"), "interconnects" IVM clients 206, 208 and legacy telephone 110 to local IVM server 202. *Id.* at 6:40–61; *see id.* at 7:13–14, 7:51–55. Local IVM server 202 enables instant voice messaging functionality over network 204. *Id.* at 7:53–55.

In "record mode," IVM client 208 "displays a list of one or more IVM recipients," provided and stored by local IVM server 202, and the user selects recipients from the list. *Id.* at 7:47–49, 7:55–61. IVM client 208 then transmits the selections to IVM server 202 and "records the user's speech into . . . digitized audio file 210 (i.e., an instant voice message)." *Id.* at 7:61–8:1.

When the recording is complete, IVM client 208 transmits audio file 210 to local IVM server 202, which delivers the message to the selected recipients via local IP network 204. *Id.* at 8:5–19. "[O]nly the available IVM recipients, currently connected to . . . IVM server 202, will receive the instant voice message." *Id.* at 8:23–25. IVM server 202 "temporarily saves the instant voice message" for any IVM client that is "not currently

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connected to . . . local IVM server 202 (i.e., is unavailable)" and "delivers it . . . when the IVM client connects to . . . local IVM server 202 (i.e., is available)." *Id.* at 8:24–29; *see id.* at 9:7–11. Upon receiving the instant voice message, the recipients can audibly play the message. *Id.* at 8:19–22.

C. Illustrative Claim

Of the challenged claims, claims 1 and 40 of the '890 patent are independent. Claim 1, reproduced below, is illustrative:

> 1. An instant voice messaging system for delivering instant messages over a packet-switched network, the system comprising:
>
> a client connected to the network, the client selecting one or more recipients, generating an instant voice message therefor, and transmitting the selected recipients and the instant voice message therefor over the network; and
>
> a server connected to the network, the server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message to the selected recipients over the network, the selected recipients enabled to audibly play the instant voice message, and the server temporarily storing the instant voice message if a selected recipient is unavailable and delivering the stored instant voice message to the selected recipient once the selected recipient becomes available.

Ex. 1001, 23:55–24:3.

D. Evidence of Record

The Petition relies upon the following asserted prior art references:

U.S. Patent No. 6,750,881 B1 (filed Feb. 24, 1997) (issued June 15, 2004) (Ex. 1004, "Appelman");

PCT International Application Publication No. WO 01/11824 A2 (published Feb. 15, 2001) (Ex. 1003, "Zydney");[1]

[1] Exhibit 1003 includes line numbers that were added by Petitioner. Pet. v, 10–11. Petitioner also submitted the original version of Zydney, without line numbers, as Exhibit 1013. *Id.* at vi, 11.

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