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 Owners

_____

Case IPR2017-01524
U.S. Patent 7,535,890

_____

DECLARATION OF DR. VAL DIEULIIS

SEPTEMBER 8, 2017

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

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 26

8. INTERNATIONAL APPLICATION WO 01/11824 ("ZYDNEY") 27

9. EXCERPT OF *COMPUTER NETWORKING ESSENTIALS* ("SHINDER") 39

10. THE PROPOSED COMBINATION OF ZYDNEY AND SHINDER DOES NOT RENDER OBVIOUS ANY CHALLENGED CLAIM OF THE '890 PATENT 43

10.1 A POSITA Would Not Have Been Motivated to Combine Zydney with Shinder in the Manner Proposed by the Petitioners 44

10.2 The Proposed Combination of Zydney and Shinder Does Not Disclose "transmitting the selected recipients and the instant voice message therefor over the local network and the external network" or "the server receiving the selected recipients and the instant voice message therefor" (Claim 14) 48

10.2.1 Zydney Does Not Disclose that "the selected recipients" are transmitted or received 48

10.2.2 Zydney Does Not Disclose the Separate Transmission of the Voice Data and the List of Recipients 51

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

10.3 The Proposed Combination of Zydney and Shinder Does Not Disclose "transmitting the selected external recipients and the instant voice message therefor over the local network and the external network" or "receiving the selected external recipients and the instant voice message therefor at an external server connected to the external network" (Claim 51) 53

11. THE PROPOSED COMBINATION OF ZYDNEY AND SHINDER DOES NOT DISCLOSE OR RENDER OBVIOUS THE FURTHER LIMITATIONS OF DEPENDENT CLAIMS 19, 20, 53, OR 54 54

11.1 The Petitioners fail to show that Zydney discloses "wherein the server delivers the instant voice message to the selected recipients that are available" (Claim 19) and "delivering the instant voice message from the external server to the selected recipients that are available" (Claim 53) 55

11.2 The Petitioners fail to show that the proposed combination of Zydney and Shinder 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 20) and "recording the instant voice message in an audio file at the client; transmitting the audio file to the external server; delivering the audio file to the selected recipients from the external server; and audibly playing the audio file at the selected recipients." (Claim 54) 59

11.2.1 Zydney does not disclose or render obvious "transmitting the audio file to the server" 60

11.2.2 Zydney does not disclose or render obvious "the server delivers the audio file to the selected recipients" 61

11.2.3 Zydney does not disclose or render obvious "audibly playing the audio file" 62

12. U.S. PATENT NO. 7,016,978 ("MALIK") 64

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

13. THE PROPOSED COMBINATION OF ZYDNEY IN VIEW OF SHINDER AND MALIK DOES NOT RENDER OBVIOUS ANY CHALLENGED CLAIM OF THE '890 PATENT 65

14. THE PROPOSED COMBINATION OF ZYDNEY IN VIEW OF SHINDER AND MALIK DOES NOT DISCLOSE OR RENDER OBVIOUS THE FURTHER LIMITATIONS OF DEPENDENT CLAIM 33, 34, 64, OR 65 69

15. U.S. PATENT NO. 6,750,881 ("APPELMAN") 73

16. THE PROPOSED COMBINATION OF ZYDNEY AND SHINDER (OR ZYDNEY, SHINDER, AND MALIK) IN FURTHER VIEW OF APPELMAN AND MARTIN-FLATIN FAILS TO RENDER OBVIOUS CLAIMS 18, 32, 52, OR 63 OF THE '890 PATENT 76

16.1 The Proposed Combination of Zydney and Appelman is Improper Because the Combination Would Render Zydney Unsatisfactory for an Intended Purpose of Zydney 78

16.2 The Proposed Combination of Zydney and Shinder in further view of Appelman and Martin-Flatin 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 18) 81

16.2.1 Zydney does not disclose the client "requesting a list of recipients associated with the client from the server" 82

16.2.2 Zydney does not disclose the server transmitting the list of recipients to the client 85

16.3 The Proposed Combination of Zydney and Shinder in further view of Appelman and Martin-Flatin Fails to Render Obvious the "requesting" and "transmitting the list" limitations of Claims 32, 52, or 63 86

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

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") [EX1103] in view of Shinder [EX1108], Malik [EX1115], Appelman [EX1104] and Martin-Flatin [EX1109] does not render obvious any challenged claim of the patent at issue, the'890 patent, at least for the following reasons:

- A POSITA would not have been motivated to add Shinder's local area network to Zydney and the Petitioners have not explained how Zydney's central server could be modified to communicate with users of Shinder's local network.
- If Zydney is modified by Shinder as proposed by the Petitioners, an important feature of Zydney—peer-to-peer communication—would be rendered inoperative.

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

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.