

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., SNAP INC., FACEBOOK, INC., and WHATSAPP, INC.,
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,¹
Patent Owner.

Case IPR2017-00221²
Patent 7,535,890 B2

Before JENNIFER S. BISK, MIRIAM L. QUINN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C § 318(a) and 37 C.F.R. § 42.73

¹ Patent Owner's Mandatory Notice, filed pursuant to 37 C.F.R. § 42.8, and Preliminary Response identify Uniloc USA, Inc. and Uniloc Luxembourg S.A. as patent owners. Paper 4; Paper 6 ("Prelim. Resp.") at caption. Therefore, we adjust the case caption to include Uniloc USA, Inc.

² Snap Inc., which filed a petition in Case IPR2017-01612, and Facebook, Inc. and WhatsApp, Inc., which filed a petition in Case IPR2017-01636, have been joined as petitioners in this case. Papers 14, 15.

I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–6, 14, 15, 17–20, 28, 29, 31–34, 40–43, 51–54, 62–65, and 68 (“challenged claims”) 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. Prelim. Resp. We instituted this review as to all challenged claims. Paper 9 (“Inst. Dec.”). Snap Inc., Facebook, Inc., and WhatsApp, Inc. are joined to this proceeding pursuant to our grant of the petitions and motions for joinder filed in IPR2017-01612 and IPR2017-01635. *See* Papers 14, 15.

Subsequent to institution, Patent Owner filed a Patent Owner Response. Paper 13 (“PO Resp.”). Petitioner filed a Reply. Paper 17 (“Reply”). A transcript of the oral hearing held on February 8, 2018, has been entered into the record as Paper 30 (“Tr.”).

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). For the reasons that follow, Petitioner has demonstrated by a preponderance of the evidence that claims 1–6, 14, 15, 17–20, 28, 29, 31–34, 40–43, 51–54, 62–65, and 68 of the ’890 patent are unpatentable.

A. *Related Matters*

Petitioner represents that the ’890 patent is the subject of numerous ongoing actions before the U.S. District Court for the Eastern District of Texas, including actions filed against the various Petitioner entities (Case Nos. 2:16-cv-00638, 2:16-cv-00645, 2:16-cv-00696, 2:16-cv-00728). Pet. 71–72; *see* Paper 4, 2; Paper 29, 2; Paper 31, 2; Paper 32, 2.

Before the Office, the '890 patent also is the subject of Cases IPR2017-00220, IPR2017-01523, IPR2017-01524, and IPR2017-01802, in which we denied institution. Case IPR2017-00220, Paper 9 (May 25, 2017); Case IPR2017-01523, Paper 7 (Dec. 4, 2017); Case IPR2017-01524, Paper 7 (Dec. 4, 2017); Case IPR2017-01802, Paper 8 (Feb. 6, 2018).

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.

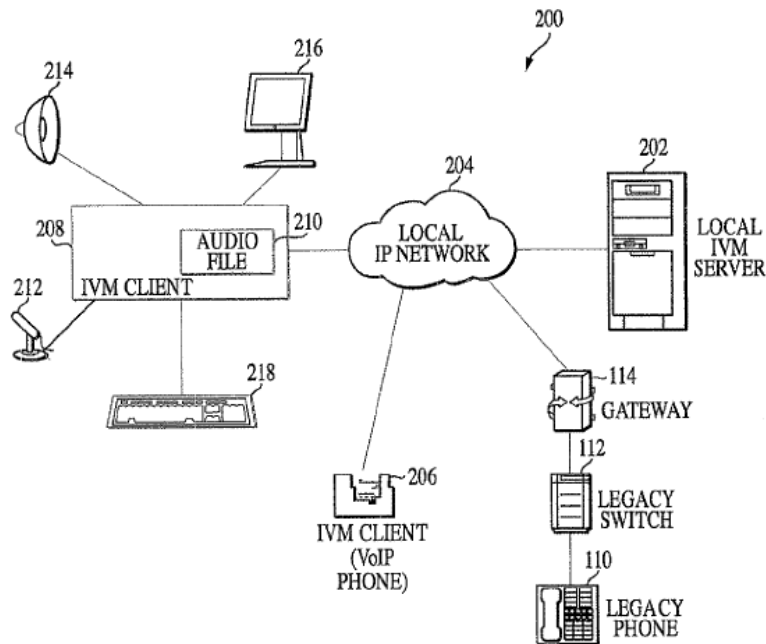


FIG. 2

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, exemplified as a VoIP softphone in Figure 2, “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 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.

In another embodiment, the ’890 patent discusses global IVM system 500. *Id.* at 15:24–28, Fig. 5. Global IVM system 500 includes a local IVM system, such as local IVM system 200, and global IVM server system 502, with global IVM clients 506, 508. *Id.* at 15:25–33. Both the local and global IVM systems are connected to “packet-switched network 102 (i.e., Internet)” to enable the local and global IVM clients to be able to exchange instant voice messages with one another. *Id.* at 15:25–38.

C. Illustrative Claims

Of the challenged claims, claims 1, 14, 28, 40, 51, and 62 of the ’890 patent are independent. Claims 1 and 28, reproduced below, are illustrative of the recited subject matter:

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

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