NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

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UNILOC 2017 LLC,
Appellant

v.

FACEBOOK, INC., WHATSAPP, INC.,
Cross-Appellants

ANDREW HIRSHFELD, PERFORMING THE FUNCTIONS AND DUTIES OF THE UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,
Intervenor

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2019-2162, 2019-2159

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Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2017-01667, IPR2017-01668, IPR2017-02090, IPR2018-00579, IPR2018-00580.

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Decided: November 18, 2021

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BRIAN MATTHEW KOIDE, Etheridge Law Group, South-lake, TX, argued for appellant. Also represented by JAMES ETHERIDGE, RYAN S. LOVELESS, BRETT MANGRUM, JEFFREY A. STEPHENS.

HEIDI LYN KEEFE, Cooley LLP, Palo Alto, CA, argued for cross-appellants. Also represented by LOWELL D. MEAD, MARK R. WEINSTEIN; PHILLIP EDWARD MORTON, Washington, DC.

ROBERT MCBRIDE, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, for intervenor. Also represented by THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED.

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Before LOURIE, REYNA, and TARANTO, *Circuit Judges.*

TARANTO, *Circuit Judge.*

Uniloc 2017 LLC (Uniloc) owns U.S. Patent No. 8,724,622, which addresses instant voice messaging by use of voice-over-internet-protocol (VoIP) communications. Facebook, Inc. and WhatsApp, Inc. (collectively, Facebook) challenged various claims of the '622 patent in two inter partes reviews in the Patent and Trademark Office. The Office's Patent Trial and Appeal Board held all challenged claims unpatentable for obviousness, except for dependent claims 4 and 5. *Facebook, Inc. v. Uniloc 2017 LLC*, IPR2017-01668, Paper No. 35, at 111–12 (P.T.A.B. Jan. 16, 2019) (*Final Written Decision*). Both Uniloc and Facebook appeal. We reject Uniloc's challenges to the Board's decision. But on Facebook's cross-appeal, we hold that the Board misunderstood Facebook's petition regarding claims 4 and 5, and we therefore vacate the Board's decision as to those claims and remand for any further proceedings as may be necessary and appropriate regarding those claims.

I

A

The '622 patent, entitled "System and Method for Instant VoIP Messaging," describes a "system and method for enabling local and global instant VoIP messaging." '622 patent, title and col. 2, lines 57–59.   A local, packet-switched IP network connects an instant voice message client, such as a telephone or a telephony-capable computer, to a local instant voice message server. *Id.*, Fig. 2; *id.*, col. 6, line 50 through col. 7, line 36. In "record mode," the client "records the user's speech into a digitized audio file . . . (i.e., an instant voice message)," then transmits it to the server. *Id.*, col. 7, line 57 through col 8, line 26. The server in turn delivers the message to selected recipient clients if those recipients are currently connected to the server. *Id.*, col. 8, lines 26–34. If a selected recipient is not connected, the server "temporarily saves the instant voice message" and delivers it later, once the recipient connects. *Id.*, col. 8, lines 34–39.

For present purposes, claims 3, 4, 5, and 24 are illustrative. They read:

3. A system comprising:

a network interface connected to a packet-switched network;

a messaging system communicating with a plurality of instant voice message client systems via the network interface; and

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

> wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and
>
> wherein *the instant voice message includes an object field including a digitized audio file.*

Id., col. 24, lines 12–27 (emphasis added).

> 4. The system according to claim 3, wherein *the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user.*

Id., col. 24, lines 28–30 (emphasis added).

> 5. The system according to claim 4, wherein the predetermined set of permitted action includes at least one of a connection request, a disconnection request, a subscription request, an unsubscription request, a message transmission request, and a set status request.

Id., col. 24, lines 31–35.

> 24. A system comprising:
>
> a network interface connected to a packet-switched network;
>
> a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
>
> a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,
>
> wherein *the messaging system receives connection object messages from the plurality of instant voice message client systems*, wherein each of the

connection object messages includes data repre-
senting a state of a logical connection with a given
one of the plurality of instant voice message client
systems.

Id., col. 25, line 59 through col. 26, line 8 (emphasis added).

B

On June 22, 2017, Facebook filed two petitions with the
Board for inter partes reviews of the '622 patent. In one
petition, Facebook challenged claims 3, 6–8, 10–11, 13–23,
27–35, and 38–39. In the second petition, Facebook chal-
lenged claims 4–5, 12, and 24–26.

In its first petition, Facebook argued that claim 3 was
unpatentable for obviousness over a combination of prior-
art references including Zydney (PCT Pub. No. WO
01/11824 A2). Facebook relied on certain passages of Zy-
dney as disclosing the claim 3 limitation that "the instant
voice message includes an object field including a digitized
audio file." J.A. 1554–56. Specifically, Zydney describes
voice exchange and voice distribution between users of
computer networks using "voice containers," which are
"container object[s] that contain[] no methods, but con-
tain[] voice data or voice data and voice data properties."
Zydney, p. 1, line 19 through p. 2, line 10; *id.*, p. 12, lines
6–8. Zydney says that its voice container can be formatted
using the multipurpose internet mail extension (MIME)
format, which "allows non-textual messages and multipart
message bodies attachments [sic] to be specified in the mes-
sage headers." *Id.*, p. 19, line 7 through p. 20, line 9 (incor-
porating by reference RFC [Request for Comments] 1521,
which further describes the MIME protocol). Stating that
an "object field" is "a field containing content that will ac-
company the instant voice message, with the term 'field'
simply referring to a block of data containing a particular
type of data," Facebook contended that "Zydney discloses
the claimed 'object field' in at least two independent ways."
J.A. 1554. First, "[i]t would . . . have been obvious that the

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