

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01667
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge*.

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

I. INTRODUCTION

The above-captioned Petitioner (Facebook, Inc. and WhatsApp Inc.) filed a Petition requesting *inter partes* review of claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 of U.S. Patent No. 8,724,622 B2 (Ex. 1001, “the ’622 patent”). Paper 2 (“Pet.”). Uniloc Luxembourg S.A. (“Patent Owner”)¹ filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314. Upon considering the record developed thus far, for reasons discussed below, we institute *inter partes* review of claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 of the ’622 patent.

II. BACKGROUND

A. Related Matters

The parties indicate that the ’622 patent is involved in *Uniloc USA, Inc. v. Facebook, Inc.*, No. 2:16-cv-00728-JRG (E.D. Tex.), and *Uniloc USA, Inc. v. WhatsApp Inc.*, No. 2:16-cv-00645-JRG (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern

¹ Patent Owner’s Mandatory Notice filed pursuant to 37 C.F.R. § 42.8 identifies Uniloc Luxembourg S.A. as the owner of the challenged patent and identifies Uniloc USA, Inc. only as licensee and additional real party in interest. Paper 4, 1. Accordingly, we have removed Uniloc USA, Inc. from the case caption as Patent Owner. We note, however, that this identification varies from earlier cases involving the challenged patent and certain related patents, in which Uniloc USA, Inc. and Uniloc Luxembourg S.A. both were identified in mandatory notices as “Patent Owner.” *See, e.g.*, IPR2017-00221, Paper 4, 1; IPR2017-00222, Paper 4, 1; IPR2017-00225, Paper 4, 1; IPR2017-01427, Paper 4, 1; IPR2017-01428, Paper 4, 1. The parties are reminded of their ongoing obligation under 37 C.F.R. § 42.8(a)(3) to keep mandatory notices updated.

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District of Texas. Pet. 1–3; Paper 4, 2. The '622 patent also was the subject of two requests for *inter partes* review filed by Apple Inc. (“Apple”) on November 14, 2016 (Cases IPR2017-00223 and IPR2017-00224), both of which were denied. *See* IPR2017-00223, Paper 7 (PTAB May 25, 2017); IPR2017-00224, Paper 7 (PTAB May 25, 2017).

Concurrently with the instant Petition, Petitioner additionally filed a petition requesting *inter partes* review of claims 4, 5, 12, and 24–26 of the '622 patent (Case IPR2017-01668). IPR2017-01668, Paper 2. Further, Samsung Electronics America, Inc. filed two requests for *inter partes* review of certain claims of the '622 patent on July 20, 2017 (Cases IPR2017-01797 and IPR2017-01798); Apple filed two additional requests for *inter partes* review, also on July 20, 2017, challenging the same claims as the instant Petition and the petition in Case IPR2017-01668, respectively (Cases IPR2017-01804 and IPR2017-01805); Huawei Device Co., Ltd. (“Huawei”) filed a request for *inter partes* review of the same claims as the instant Petition on September 11, 2017 (Case IPR2017-02090); and Google Inc. filed two requests for *inter partes* review of certain claims of the '622 patent on September 12, 2017 (Cases IPR2017-02080 and IPR2017-02081). Huawei additionally filed a motion for joinder to the instant proceeding concurrently with its petition in Case IPR2017-02090, and Apple indicated in its petition in Case IPR2017-01804 that it intends to seek joinder with the instant proceeding “when appropriate.” IPR2017-02090, Paper 3; IPR2017-01804, Paper 2, 76.

B. The '622 Patent

The '622 patent, titled “System and Method for Instant VoIP Messaging,” relates to Internet telephony, and more particularly, to instant voice over IP (“VoIP”) messaging over an IP network, such as the Internet. Ex. 1001, [54], 1:18–22. The '622 patent acknowledges that “[v]oice messaging” and “instant text messaging” in both the VoIP and public switched telephone network environments were previously known. *Id.* at 2:22–46. In prior art instant text messaging systems, according to the '622 patent, a server would present a user of a client terminal with a “list of persons who are currently ‘online’ and ready to receive text messages,” the user would “select one or more” recipients and type the message, and the server would immediately send the message to the respective client terminals. *Id.* at 2:34–46. According to the '622 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 1:18–22, 2:47–59, 6:47–49.

In one embodiment, the '622 patent discloses local instant voice messaging (“IVM”) system 200, depicted in Figure 2 below. Ex. 1001, 6:22–24.

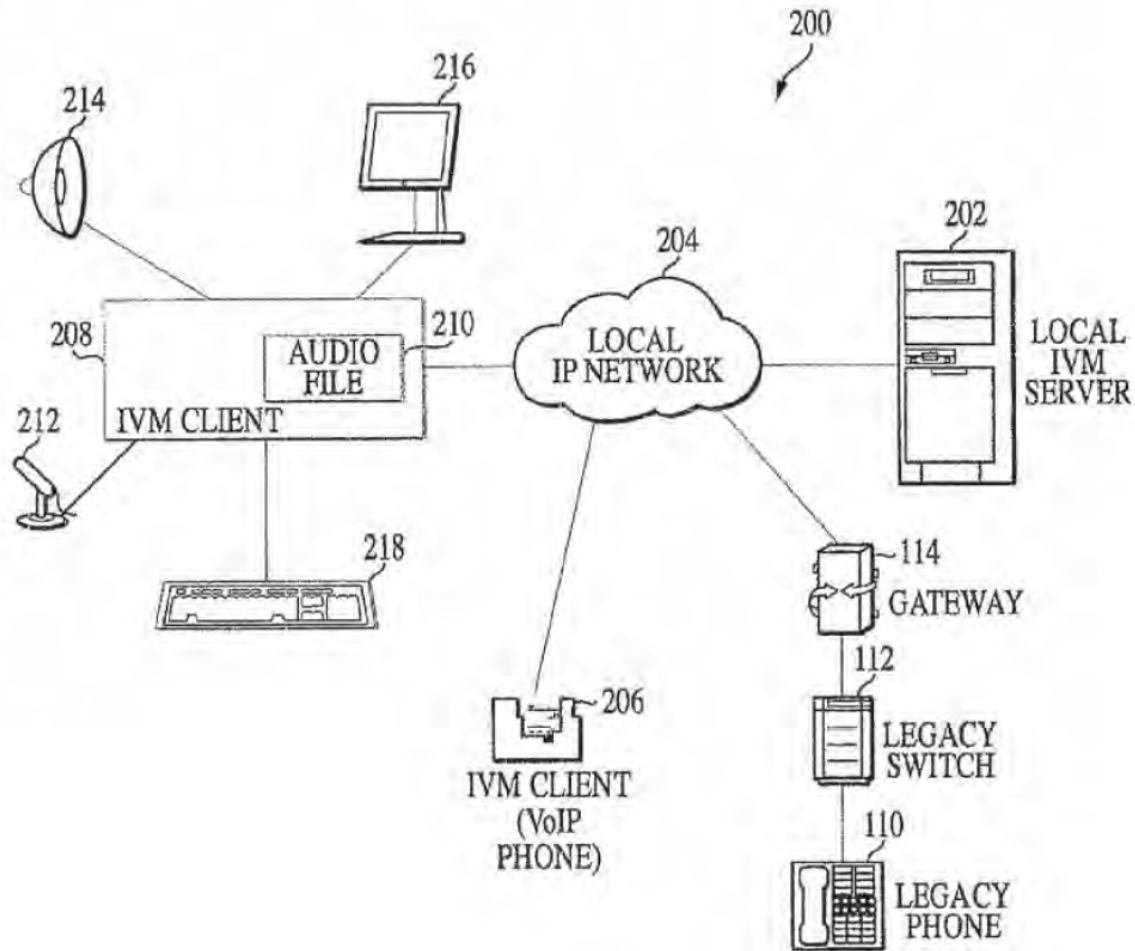


FIG. 2

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 6:50–7:2; *see id.* at 7:23–24, 7:61–65. Local IVM server 202 enables instant voice messaging functionality over network 204. *Id.* at 7:61–65.

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. Ex. 1001, 7:57–59, 7:65–8:4. IVM client 208 then transmits the selections to IVM server 202 and “records the

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