

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC., WHATSAPP INC.,  
Petitioners

v.

UNILOC LUXEMBOURG S.A.,  
Patent Owner

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IPR2017-01667  
PATENT 8,724,622

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**PATENT OWNER RESPONSE TO PETITION  
PURSUANT TO 37 C.F.R. § 42.120**

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Patent Owner’s List of Exhibits

Exhibit No.	Description
2001	Declaration of William “Chuck” Easttom II
2002	Microsoft TechNet article showing Microsoft IIS 6.0 enabled compression over HTTP
2003	Deposition Transcript of Dr. Tal Lavin.

## I. Introduction

Pursuant to 37 C.F.R. § 42.120, Uniloc Luxembourg S.A. (“Uniloc” or “Patent Owner”) submits this Response to the Petition for *Inter Partes* Review (“the Petition”) of U.S. Patent No. 8,724,622 (“the ’622 patent”) filed by Facebook, Inc. and WhatsApp, Inc. (“Petitioners”).

## II. Related Matters of the ’622 Patent

This is not the first time the Board has considered challenges against the ’622 patent. On May 25, 2017, the Board denied institution of two petitions for *inter partes* review against the ’622 patent filed by Apple Inc. on November 14, 2016 (IPR2017-00223 and IPR2017-00224). Even more relevant to the present Petition, the Board denied institution of two additional petitions for *inter partes* review (IPR2017-02080 and IPR2017-02081) challenging the same ’622 patent based primarily on the same *Zydney* reference at issue here.<sup>1</sup>

Concurrent with the filing of the instant Petition, Petitioners filed a second petition for *inter partes* review to address different claims of the ’622 patent. More specifically, the present Petition addresses claims 3, 6-8, 10, 11, 13, 14-23, 27-35, 38, and 39, whereas the other petition (IPR2017-01668) addresses claims 4, 5, 12, and 24-26.

The Petition provides what appears to be an accurate summary of pending litigation related to the ’622 patent. Pet. 1-3.

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<sup>1</sup> Trial is currently pending in two related *inter partes* review matters (IPR2017-01797 and IPR2017-01798) that challenge the ’622 patent based primarily on a reference (*Griffin*) not at issue here.

### **III. The '622 Patent**

#### **A. Effective Filing Date of the '622 Patent**

The '622 patent is titled "SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING." EX1001. The '622 patent issued from U.S. Patent Application No. 13/546,673, which is a continuation of U.S. Patent No. 8,243,723, which is a continuation of U.S. Patent No. 7,535,890, filed on Dec. 18, 2003. The '622 patent issued on May 13, 2014. Petitioner does not contest that the '622 patent is at least entitled to an effective filing date of Dec. 18, 2003.

#### **B. Overview of the '622 Patent**

The '622 patent recognized that conventional circuit-switched communications enabled traditional telephony yet had a variety of technical disadvantages that limited developing other forms of communication over such networks. According to the '622 patent, "[c]ircuit switching provides a communication path (i.e., dedicated circuit) for a telephone call from the telephone terminal to another device 20 over the [public switched telephone network or] PSTN, including another telephone terminal. During the telephone call, voice communication takes place over that communication path." EX1001, 1:29-34.

The '622 patent expressly distinguishes circuit-switched networks from packet-switched networks (*e.g.*, the Internet) at least in that the latter routes packetized digital information, such as "Voice over Internet Protocol (i.e., "VoIP"), also known as IP telephony or Internet telephony."<sup>2</sup> *Id.*, 1:35-36. Because legacy

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<sup>2</sup> Consistent with the '622 patent specification, the USPTO has also recognized there are significant differences between circuit-switched and packet-switched networks

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