

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., WHATSAPP INC., LG ELECTRONICS, INC.,
HUAWEI DEVICE CO., LTD., and APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01667 (Patent 8,724,622 B2)

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

v.

UNILOC 2017 LCC,
Patent Owner.

Case IPR2017-01668 (Patent 8,724,622 B2)

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

QUINN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding, 37 C.F.R. § 42.5

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On August 30, 2018, we held the oral argument for the above-captioned cases.¹ During the argument, the parties to both proceedings were given an opportunity to address Exhibit 3001, a dictionary definition of “instant messaging,” as a starting point for discussing the appropriate claim construction of the claim term “instant voice message,” recited in all the independent challenged claims. By way of introduction, the definition of “instant messaging,” according to that dictionary, in relevant part, is: “A service that alerts users when friends or colleagues are on line and allows them to communicate with each other in real time through private online chat areas.” Ex. 3001, 2. The panel gave the parties an opportunity to object to the entry of Exhibit 3001 in the record. Tr. 67:12–68:5. There were no objections.

After review of the discussion on claim construction issues in the captioned cases, the panel requests additional briefing as detailed below. By way of background, we noted, in our Decision on Institution in the captioned cases, that Patent Owner’s argument regarding whether the prior art disclosed the required “instant voice message” was an issue of claim construction that required additional briefing. Decision on Institution, 19–20 (Paper 8, IPR2017-01667); *see also* Decision on Institution, 23 (Paper 8, IPR2017-01668). Patent Owner’s Response proposes that the Board construe “instant voice message” as “an audio file recording voice data.” *See* IPR2017-01667, Paper 17, 12–13 (arguing lexicography because of the repeated use of “i.e.” in certain embodiments). Petitioner’s Reply

¹ For IPR2017-01667, the transcript of the oral argument is filed as Paper 31, and for IPR2017-01668, the transcript of the oral argument is filed as Paper 29 (“Tr.”).

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proposes that the construction is not limited to an audio file, but does not otherwise propose a construction stating that the term “instant voice message” “can be left to its plain and ordinary meaning, encompassing the instant voice messages disclosed by Zydney.”² IPR2017-01667, Paper 24, 2–5. During oral argument we addressed with the parties the insufficiency of their respective briefs with regard to claim construction. Tr. 10:8–11:25, 21:17–15, 25:7–27:24.

After hearing argument on Exhibit 3001 and discussing claim construction alternatives, Petitioner agreed that the claimed “instant voice message” would be a “data structure including a representation of an audible message.” *Id.* at 13:6–11. Patent Owner agreed in principle that the scope of the term “instant voice message” would be the “data content including a representation of an audio message, not precluding the inclusion of fields.” Tr. 66:22–67:5. Patent Owner also argued the scope of the “content” in the “instant voice message” to clarify that the content (or audio data) cannot exist independently of the medium by which the content is transported. *Id.* at 64:3–66:1.

Although there are many similarities between these positions, Patent Owner’s preference for the word “content” versus the word “structure” presents an issue that requires further consideration by the parties. Further, we find that the record does not adequately reflect the parties’ positions as to how the respective constructions that have been agreed to allegedly would or would not map to Zydney’s voice container, asserted by Petitioner to be the

² Zydney is PCT Application Publication No. WO 01/11824 A2, published February 15, 2001, and filed in IPR2017-01667 as Exhibit 1003 and in IPR2017-01668 as Exhibit 1103.

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claimed “instant voice message” in these proceedings. Accordingly, the parties will be provided an opportunity to brief each other’s claim construction positions, as agreed to during the oral argument and summarized below. The brief should also address the applicability of each of these constructions to the asserted prior art. No new evidence will be allowed at this stage of the proceeding, and the arguments are to be limited to addressing solely the two claim construction positions, including the legal and factual reasons for each party’s position, and the application of those claim construction positions to Zydney’s voice container.

III. ORDER

Accordingly, it is:

ORDERED that the parties shall brief the following claim construction alternatives for the term “instant voice message”:

- “a data structure including a representation of an audible message”; and
- “the data content including a representation of an audio message, not precluding the inclusion of fields”;

FURTHER ORDERED that the parties shall address the applicability of these claim constructions to Zydney’s voice container;

FURTHER ORDERED that the opening brief for both parties is limited to 8 pages and shall be filed simultaneously, by September 28;

FURTHER ORDERED the parties may file a responsive brief, limited to 5 pages, by no later than October 5; and

FURTHER ORDERED that no other papers are authorized and no new evidence shall be introduced.

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