UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP, INC.,[1]
Petitioners

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,
Patent Owners

IPR2017-01668
PATENT 8,724,622

PATENT OWNER OPENING BRIEF ON REMAND

[1] Apple Inc., which filed a petition in Case IPR2018-00580, was previously joined as a petitioner but is no longer a party to this proceeding. *See* Order Conduct of Proceeding, Paper 42, n.2 and n.3. LG Electronics, Inc. and Huawei Device Co., Ltd. also filed a motion for joinder and petition in IPR2017-02090.

Patent Owner submits the following brief pursuant to the Board's Order (Paper 42) and in view of the Federal Circuit decision vacating and remanding for further consideration the Board's determinations with respect to claims 4 and 5 of U.S. Patent No. 8,724,622 ("the '622 patent"). *Uniloc 2017 LLC v. Facebook, Inc.*, Nos. 2019-2159, -2162, 2021 WL 5370480 (Fed. Cir. Nov. 18, 2021) ("*Uniloc*").

The overarching issue on remand is whether Petitioner had established that the "instant voice message" recited in claims 4 and 5 is rendered obvious by a combination of Zydney and Hethmon, in which an HTTP request message allegedly would transport Zydney's voice container using Hethmon's POST method. *Uniloc*, *12, 15-17. A review of the record reveals Petitioner did not meet its burden.

Petitioner's theory incorrectly equated the claimed "instant ***voice*** message" with a modified HTTP ***request*** message as a whole. The record reveals patentable distinctions. This issue squarely invokes, and should be deemed resolved by, the claim construction dispute the parties addressed during trial (in supplemental briefing) concerning the "instant voice message" term. Papers 31-34. In its briefing, Patent Owner summarized the claim construction dispute over this term as follows:

> The parties essentially dispute whether the term "instant voice message" . . . is directed to *data content* or, instead, to *data structure*. Petitioner advances a structure-based construction to broaden the scope of "instant voice message" to encompass a separately-generated structural container, **even if it is used only to transport** the voice data and then is subsequently discarded.

Paper 31, 1 (boldface and underlining added, emphasis original).

The Board resolved the claim construction dispute in Patent Owner's favor. Paper 35, 15. In its Final Written Decision, the Board adopted Patent Owner's

construction of "'instant voice message' to mean 'data content including a representation of an audio message.'" *Id*. The Board rejected and distinguished Petitioner's counterproposal, "a data *structure* including a representation of an audible message." *Id.*, 17 (emphasis by Board). This remains the law of the case.

The Petition remains tainted by its application of an erroneous and rejected claim construction. Petitioner asserted that Hethmon's HTTP request message *as a whole* (if modified to transport Zydney's voice container) constitutes an "instant voice message" as claimed. As Patent Owner observed, the Petition unreasonably sought to expand the scope of "instant voice message" to encompass *structure* used only to transport voice data *content*. *See generally* Papers 31, 33 and 35. Such error is compounded where Petitioner interpreted "instant voice message" to encompass *transporting structure* not only in the form of Zydney's voice container, but also the HTTP message used only to transport that container. Thus, the theory at issue on remand was doubly tainted by a construction that the Board flatly rejected. *Id*.

Petitioner's failure to establish obviousness is further underscored by Petitioner's purported mapping of certain limitations of claims 4 and 5 expressly qualifying the "instant voice message" term. Patent Owner addressed distinctions arising from at least the requirements that the "instant voice message" must include (1) "an object field including a digitized audio file" and (2) "an action field identifying one of a predetermined set of permitted actions requested by the user." Resp., 8-20; Hearing Transcript (Paper 29), 57-61.

For the "object field" limitation, Petitioner asserted that "the voice data is contained in *a field of the [Zydney] voice container*." Reply, 35 (emphasis added).

In rebuttal, Patent Owner offered the declaration testimony of Dr. Easttom, who testified that Zydney does not expressly or inherently disclose its voice container has "an object field" as claimed. Ex. 2001, ¶¶ 49-51.[2] Petitioner opted to not cross-examine Dr. Easttom during trial or to submit rebuttal testimony in its Reply.

Petitioner's misplaced reliance on Zydney's *voice container* for supplying the "object field" presented another fundamental flaw. Petitioner's combination theory relied on the untethered and rejected claim interpretation that the "instant voice message" need not *itself* have both required fields and, instead, it encompasses *structure* of an HTTP message merely used to *transport* a structurally distinct *voice container*. Specifically, Petitioner asserted the "entity body" of the modified HTTP message would carry a structurally distinct "voice container" having its own internal "fields" (a disputed fact), one of which allegedly contains what Petitioner refers to as "voice data." Petitioner's theory remains tainted by its reliance on the rejected interpretation that the claimed "instant voice message" encompasses *structure* used only to transport voice data *content*. Paper 31, 1; Paper 35, 15.

These deficiencies were further underscored by how the Petition addressed the "action field" term. Pointing to structure of the HTTP message itself, Petitioner asserted that "[t]he 'Method' field in the 'Request-Line'" satisfies the "action field" limitations. Pet., 38. Thus, Petitioner pointed to transporting structure of the HTTP message itself for certain limitations qualifying the "instant voice message" term, yet Petitioner pointed to Zydney's voice container as transporting structure for other

[2] Dr. Easttom was a doctoral candidate when he submitted his declaration, and he has since obtained his doctorate. *Id.*, CV at 1.

limitations further qualifying that *same* term. This theory is not salvaged by arguing Zydney's voice container is part of the HTTP message *as a whole*. At a minimum, such a theory conflicts with the Board's adoption of "Patent Owner's position that the '622 patent specification consistently refers to the 'instant voice message' as *content*," not transport *structure*. Paper 35, 15 (emphasis added).

Petitioner also failed to persuasively defend its combination theory against the teach-away rebuttal of record. Resp., 18-20. Zydney refers to its transport mechanism as a "voice container" that is purposefully designed as "contain[ing] no methods." *Id*. (quoting Ex. 1103, 13:6-7). The proposed combination, however, would require a distinct transport mechanism that ***relied on*** a POST method. As Dr. Easttom testified, the combination theory would thus violate Zydney's definitional design constraint expressly directed to its specific transport mechanism. Ex. 2001, ¶¶ 52-54. Petitioner did not cross-examine Dr. Easttom nor offer rebuttal testimony.

Petitioner failed to persuasively counter this teach-away issue by offering mere attorney argument that "[t]he combination would not result in the voice container itself containing any methods." Reply, 11. Petitioner overlooked that Zydney's transport mechanism *is* the voice container. *See* Ex. 1103, 13:6 ("The voice data is transmitted in a voice container."). Zydney's definitional description of its voice container thus constrains the transport mechanism *itself*. Ex. 2001, ¶¶ 52-54. Moreover, Petitioner cannot reasonably argue on the one hand that the Board should consider the modified HTTP message *as a whole*, while arguing on the other hand that Hethmon's POST method should be considered *separate and apart* from Zydney's voice container to which that method allegedly would apply.

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