

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP., INC.,
Petitioners

v.

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

Case No. IPR2017-01668
U.S. Patent No. 8,724,622 B2

**PETITIONER'S RESPONSE TO PATENT OWNER'S
OPENING BRIEF ON REMAND**

In authorizing post-remand briefing, the Board made clear that “the parties are not authorized to file or otherwise introduce any new evidence or to present any new arguments with or in the briefs.” (Paper 42, at 4 (emphasis added).) Patent Owner’s brief violates this directive by making new arguments about claims 4 and 5 that should not be considered. And those new arguments, even if considered, fail.

Prior to remand, Patent Owner presented (and thus preserved) only one argument directed to claims 4 and 5, appearing on pages 18-20 of its Patent Owner Response – that Zydney “teaches away” from the proposed combination. (Paper 16, at 18-20; EX2001, ¶¶52-54.) Patent Owner argued that the Zydney voice container “contains no methods,” and as such, teaches away from “**an action field identifying one of a predetermined set of permitted actions,**” as recited in claim 4. (*Id.*)

Petitioner fully addressed and rebutted that argument by explaining that Patent Owner had mischaracterized the Petition. Petitioner explained that it had mapped the “**instant voice message**” of claims 4 and 5 to an HTTP message, and the “**action field**” to the “Request-Line” element of an HTTP message. (Petition, Paper 2, at 37-39; Petitioner Reply, Paper 22, at 10-12.) As the Federal Circuit observed in summarizing Petitioner’s proposed combination for claims 4 and 5, “the required ‘instant voice message includ[ing] an action field’ was taught by an HTTP message as a whole, in which the Request-Line portion contains the action field (specifically a POST method) and the Entity-Body carries the Zydney voice container.” *Uniloc*

2017 LLC v. Facebook, Inc., Nos. 2019-2159, 2019-2162, 2021 WL 5370480, at *7 (Fed. Cir. Nov. 18, 2021). Because Petitioner’s proposed combination did not place the “**action field**” within the Zydney voice container *itself*, the fact that the voice container in Zydney “contains no methods” was irrelevant. (Paper 22, at 10-12.)

And that disposes of the only argument Patent Owner preserved with respect to claims 4 and 5. All other arguments Patent Owner now makes in its post-remand brief should be disregarded for exceeding the scope of the Board’s order. Moreover, those new arguments, even if considered on their merits, fail.

A. New Arguments About the Claimed “Instant Voice Message”

Patent Owner’s arguments depend primarily on its construction of “**instant voice message**,” *i.e.*, “data content including a representation of an audio image,” which the Board adopted. Patent Owner now appears to argue that the Board’s construction excludes the HTTP message cited for the “**instant voice message**” of claims 4 and 5. (Paper 43, at 1-2.) But Patent Owner never before argued that an HTTP message could not qualify as an “**instant voice message**.”

This argument fails even if considered. The Board concluded that the Zydney voice container qualifies as an “**instant voice message**” under the adopted construction. (Final Written Decision, Paper 35, at 44-45.) In making this ruling, the Board expressly rejected Patent Owner’s suggestion, now redirected towards claims 4 and 5, that the “**instant voice message**” construction somehow limits the

way in which data can be packaged or structured. The Board explained that “[t]he format of the data content or how it is packaged (i.e., structure) is **not relevant**, as we focus on whether the voice container is data content notwithstanding additional data and structure that ensures adequate transport or delivery of the data content.” (*Id.* at 45 (emphasis added).) That holding was unaffected by the Federal Circuit remand and is dispositive of Patent Owner’s new arguments against claims 4 and 5. Because if the Zydney voice container qualifies as “**instant voice message**” (which the Board found it does), then so too does an HTTP message that includes that same Zydney voice container. The Final Written Decision made clear that an “**instant voice message**” does not exclude “additional data and structure that ensures adequate transport or delivery of the data content” (*id.*), which precisely describes the additional data contained in an HTTP message as described in the Petition. (Petition, Paper 2, at 37-40.) Accordingly, Patent Owner’s new contention that a Zydney voice container is no longer an “**instant voice message**,” simply by virtue of being packaged in an HTTP message, should be rejected.

B. New Arguments About the “Object Field” of Claim 3

Patent Owner makes a substantially similar argument with respect to the claimed “**object field containing a digitized audio file**,” but that limitation does not appear in claims 4 or 5. (Paper 43, at 2-3.) It appears instead in independent claim 3, which the Board found unpatentable and the Federal Circuit affirmed.

Patent Owner never before argued that reliance on an HTTP message for the “**instant voice message**” of claims 4 and 5 presented any issues with respect to how the prior art applies to claim 3. But this argument also fails on the merits if considered.

As explained, the Board made clear that how data is packaged or structured is “not relevant” to whether the data can qualify as an “**instant voice message.**” (Final Written Decision, Paper 35, at 45.) Because a Zydney voice container by itself qualifies as an instant voice message having “**an object field containing a digitized audio file,**” as the Board correctly concluded, then so too does that same Zydney voice container when packaged in an HTTP message.

C. New Arguments About Use of HTTP for Claim 4

Patent Owner also newly argues that Zydney’s transport mechanism would not have worked with HTTP. (Paper 43, at 4-5 (citing Ex. 2001, ¶¶59-64).) But prior to remand, Patent Owner only made these arguments with respect to the “**connection object messages**” limitation of claim 24. (Paper 16 at 21-23; Ex. 2001, ¶¶59-64.) Patent Owner’s attempt to recast earlier arguments about claim 24 as new arguments against claims 4-5 is improper. And the arguments also lack merit.

The Final Written Decision, in finding claim 24 unpatentable, devoted several pages to specifically considering and rejecting the same arguments Patent Owner now makes about the purported incompatibilities between Zydney and HTTP. (Final Written Decision, Paper 35, at 104 (“Patent Owner further contends that Zydney

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.