

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01667¹
Patent 8,724,622 B2

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

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01668²
Patent 8,724,622 B2

¹ Huawei Device Co., Ltd. and LG Electronics, Inc., which filed a petition in Case IPR2017-02090, and Apple Inc., which filed a petition in Case IPR2018-00579, have been joined as petitioners in IPR2017-01667.

² Apple Inc., which filed a petition in Case IPR2018-00580, has been joined as a petitioner in IPR2017-01668.

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

BOUDREAU, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318

I. INTRODUCTION

Facebook, Inc. and WhatsApp Inc. filed a Petition in each of the captioned proceedings on June 22, 2017, collectively requesting *inter partes* review of claims 3–8, 10–35, 38, and 39 of U.S. Patent No. 8,724,622 B2 (“the ’622 patent”). IPR2017-01667, Paper 2 (“1667 Petition” or “1667 Pet.”); IPR2017-01668, Paper 2 (“1668 Petition” or “1668 Pet.”). Each proceeding challenges a different set of claims, as follows:

Proceeding	Challenged Claim Set of the ’622 Patent
IPR2017-01667	3, 6–8, 10, 11, 13–23, 27–35, 38, 39
IPR2017-01668	4, 5, 12, 24–26

See 1667 Pet. 1; 1668 Pet. 1. Patent Owner³ filed a Preliminary Response to each Petition. IPR2017-01667, Paper 6 (“1667 Prelim. Resp.”); IPR2017-

³ Uniloc Luxembourg S.A. was initially identified as the owner of the ’622 patent. *See, e.g.*, IPR2017-01667, Paper 3, 1. In Updated Mandatory Notices filed August 25, 2018, Uniloc 2017 LLC is identified as the owner of the ’622 patent. IPR2017-01667, Paper 30; IPR2017-01668, Paper 28.

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01668, Paper 6 (“1668 Prelim. Resp.”). We instituted *inter partes* review pursuant to 35 U.S.C. § 314 as to all challenged claims. IPR2017-01667, Paper 8 (“1667 Dec. on Inst.”); IPR2017-01668, Paper 8 (“1668 Dec. on Inst.”). During the pendency of the proceedings, Huawei Device Co., Ltd. and LG Electronics, Inc. filed a petition and motion for joinder requesting to join IPR2017-01667, which we granted. IPR2017-01667, Paper 12. Similarly, Apple Inc. filed petitions and motions for joinder requesting to join IPR2017-01667 and IPR2017-01668, which we also granted. IPR2017-01667, Paper 29; IPR2017-01668, Paper 27.

Subsequent to institution, Patent Owner filed a Patent Owner Response in each case. IPR2017-01667, Paper 17 (“1667 PO Resp.”); IPR2017-01668, Paper 16 (“1668 PO Resp.”). Petitioner⁴ then filed Replies. IPR2017-01667, Paper 24 (“1667 Reply”); IPR2017-01668, Paper 22 (“1668 Reply”). Patent Owner also filed a Motion to Exclude as Paper 21 in each case (“Mot. Excl.”), and Petitioner filed an Opposition as Paper 24 in each case (“Opp’n”). We held a consolidated oral argument in both proceedings, as well as in related proceeding IPR2017-01428, on August 30, 2018. A transcript of the oral hearing (“Tr.”) has been entered into the record of IPR2017-01667 as Paper 31 and into the record of IPR2017-01668 as Paper 29.

⁴ References herein to “Petitioner” refer to Facebook, Inc., WhatsApp Inc., Huawei Device Co., Ltd., LG Electronics, Inc, and Apple Inc., collectively, where reference is made to IPR2017-01667, and to Facebook, Inc., WhatsApp Inc., and Apple Inc., collectively, where reference is made to IPR2017-01668.

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that claims 3, 6–8, 10–35, 38, and 39 of the '622 patent are unpatentable, but has not shown that claims 4 and 5 are unpatentable.

II. CONSOLIDATION OF PROCEEDINGS

The two captioned proceedings involve the '622 patent. Although each proceeding challenges the patentability of a different set of claims, there are disputed claim terms across the challenged claims and the primary prior art is identical. For instance, all the claims recite the term “instant voice message,” which we construe below, and the “Zydney” reference (identified with particularity below) is asserted as prior art in both proceedings. Consolidation is appropriate where, as here, the Board can more efficiently handle the common issues and evidence and also remain consistent across proceedings. Under 35 U.S.C. § 315(d) the Director may determine the manner in which these pending proceedings may proceed, including “providing for stay, transfer, consolidation, or termination of any such matter or proceeding.” *See also* 37 C.F.R. § 42.4(a) (“The Board institutes the trial on behalf of the Director.”). There is no specific Board Rule that governs consolidation of cases. But 37 C.F.R. § 42.5(a) allows the Board to determine a proper course of conduct in a proceeding for any situation not specifically covered by the rules and to enter non-final orders to administer the proceeding. Therefore, on behalf of the Director under

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§ 315(d), and for a more efficient administration of these proceedings, we consolidate IPR2017-01667 and IPR2017-01668 for purposes of rendering this Final Written Decision in which we construe the term “instant voice message” and determine whether the asserted prior art teaches the properly construed “instant voice message.”

III. BACKGROUND

A. *Related Matters*

The parties indicate that the ’622 patent is involved in *Uniloc USA, Inc. v. Apple Inc.*, No. 2:16-cv-00638 (E.D. Tex.), *Uniloc USA, Inc. v. WhatsApp Inc.*, Case and 2:16-cv-00645 (E.D. Tex.), *Uniloc USA, Inc. v. Facebook, Inc.*, No. 2:16-cv-00728 (E.D. Tex.), *Uniloc USA, Inc. v. LG Electronics USA, Inc.*, No. 2:16-cv-00991 (E.D. Tex.), and *Uniloc USA, Inc. v. Huawei Device USA, Inc.*, No. 2:16-cv-00994 (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern District of Texas. *See, e.g.*, IPR2017-01667, Paper 30, 3.

The ’622 patent also has been the subject of petitions for *inter partes* review in Cases IPR2017-00223, IPR2017-00224, IPR2017-01804, and IPR2017-01805 (filed by Apple Inc.), all of which were denied; Cases IPR2017-01797 and IPR2017-01798 (filed by Samsung Electronics America, Inc.), in which we instituted *inter partes* review on February 6, 2018; and Cases IPR2017-02080 and IPR2017-02081 (filed by Google, Inc.), which we denied.

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