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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IPR2017-01668
PATENT 8,724,622

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

Table of Contents

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

The '622 patent was the subject of two requests for *inter partes* review (IPR2017-00223 and IPR2017-00224) filed by Apple Inc. on November 14, 2016, which were both denied by the Board on May 25, 2017. The '622 patent was also the subject of an *inter partes* review (IPR2017-2080, based primarily on the same *Zydney* reference asserted here), which the Board denied on March 19, 2018.

Concurrent with the filing of this Petition, the Petitioner filed a second petition for *inter partes* review to address different claims of the '622 patent. More specifically, the present Petition addresses claims 4, 5, 12, and 24-26, whereas the other petition (IPR2017-01667) addresses claims 3, 6-8, 10, 11, 13, 14-23, 27-35, 38, and 39.

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

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.
EX2001 ¶18.

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."[1] EX1001, 1:35-36. EX2001 ¶19.

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[1] Consistent with the '622 patent specification, the USPTO has also recognized there
are significant differences between circuit-switched and packet-switched networks
during the relevant timeframe. *See*, *e.g.*, U.S. Application No. 90/012,728 and
90/012,789 (*Notice of Intent to Issue Ex Parte Reexamination Certificat*e, dated
April 10, 2014) at page 9, where the USPTO confirmed the following:

Ethernet packet switching protocol, including TCP/IP, are very specific
connectionless/packet switched protocols. In contrast to connection-

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