

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Cases IPR2017-01797 and IPR2017-01798
Patent 8,724,622 B2

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(a)

I. INTRODUCTION

Samsung Electronics America, Inc. (“Petitioner”) filed a Petition in each of the captioned proceedings on July 20, 2017, collectively requesting *inter partes* review of claims 3, 4, 6–8, 10–19, 21–35, 38, and 39 of U.S. Patent No. 8,724,622 B2 (“the ’622 patent”). IPR2017-01797, Paper 1 (“1797 Petition” or “1797 Pet.”); IPR2017-01798 (“1798 Petition” or “1798 Pet.”). Each proceeding challenges a different set of claims, as follows:

Proceeding	Challenged Claim Set of the ’622 Patent
IPR2017-01797	3, 4, 6–8, 10–13, 18, 21–23, 27, 32, 34, 35, 38, and 39
IPR2017-01798	14–17, 19, 24–26, 28–31, and 33

See 1797 Pet. 1; 1798 Pet. 1. Patent Owner¹ filed a Preliminary Response to each Petition. IPR2017-01797, Paper 6; IPR2017-01798, Paper 6. We instituted *inter partes* review pursuant to 35 U.S.C. § 314 as to all challenged claims. IPR2017-01797, Paper 8 (“1797 Dec. on Inst.”); IPR2017-01798, Paper 8 (“1798 Dec. on Inst.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response in each case. IPR2017-01797, Paper 12 (“1797 PO Resp.”); IPR2017-01798, Paper 12 (“1798 PO Resp.”). Petitioner then filed Replies. IPR2017-01797, Paper 17 (“1797 Reply”); IPR2017-01798, Paper 17

¹ Uniloc Luxembourg S.A. was initially identified as the owner of the ’622 patent. *See, e.g.*, IPR2017-01797, Paper 3, 1. In Updated Mandatory Notices filed August 27, 2018, Uniloc 2017 LLC is identified as the owner of the ’622 patent. IPR2017-01797, Paper 19; IPR2017-01798, Paper 19.

("1798 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 ("Opp'n"). A transcript of the consolidated oral hearing held on October 30, 2018, has been entered into the record as Paper 31 in each case ("Tr.").

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, Petitioner has shown by a preponderance of the evidence that claims 3, 4, 6–8, 10–19, 21–35, 38, and 39 of the '622 patent are unpatentable.

II. CONSOLIDATION OF PROCEEDINGS

The two captioned proceedings (IPR2017-01797 and IPR2017-01798) 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 "Griffin" and "Zydney" references (identified with particularity below) are 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

IPR2017-01797 and IPR2017-01798
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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 § 315(d), and for a more efficient administration of these proceedings, we consolidate IPR2017-01797 and IPR2017-01798 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 multiple district court cases, including *Uniloc USA, Inc. v. Samsung Electronics America, Inc.*, Case No. 2:16-cv-00641-JRG (E.D. Tex.). *See, e.g.*, 1797 Pet. 1–3; IPR2017-01797, Paper 19, 2.

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 IPR2017-01667 and IPR2017-01668 (filed by Facebook, Inc. and WhatsApp Inc.), in which we instituted *inter partes* review on January 19, 2018; Cases IPR2017-02080 and IPR2017-02081 (filed by Google, Inc.), which we denied; Case IPR2017-02090 (filed by Huawei Device Co., Ltd. and LG Electronics, Inc.), in which we granted a motion for the petitioners' joinder with Case IPR2017-01667; and Cases IPR2018-00579 and IPR2018-00580 (filed by Apple Inc.), in which we granted motions for the petitioner's joinder with Cases IPR2017-01667 and IPR2017-01668,

respectively. We issued a consolidated Final Written Decision in Cases IPR2017-01667 and IPR2017-01668 on January 16, 2019, finding unpatentable claims 3, 6–8, 10–35, 38, and 39—but not claims 4 and 5—of the '622 patent. IPR2017–01667, Paper 37; IPR2017-01668, Paper 35 (“1667/1668 FD”).

B. Overview of the '622 Patent

The '622 patent, titled “System and Method for Instant VoIP Messaging,” relates to Internet telephony, and more particularly, to instant voice over IP (“VoIP”) messaging over an IP network, such as the Internet. Ex. 1001, [54], 1:18–22. The '622 patent acknowledges that “[v]oice messaging” and “instant text messaging” in both the VoIP and public switched telephone network environments were previously known. *Id.* at 2:22–46. In prior art instant text messaging systems, according to the '622 patent, a server would present a user of a client terminal with a “list of persons who are currently ‘online’ and ready to receive text messages,” the user would “select one or more” recipients and type the message, and the server would immediately send the message to the respective client terminals. *Id.* at 2:34–46. According to the '622 patent, however, “there is still a need in the art for . . . a system and method for providing instant VoIP messaging over an IP network,” such as the Internet. *Id.* at 1:18–22, 2:47–59, 6:47–49.

In one embodiment, the '622 patent discloses local instant voice messaging (“IVM”) system 200, depicted in Figure 2 below. Ex. 1001, 6:22–24.

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