UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

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Case IPR2017-01797
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Samsung Electronics America, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 3, 4, 6–8, 10–13, 18, 21–23, 27, 32, 34, 35, 38, and 39 of U.S. Patent No. 8,724,622 B2 (Ex. 1001, "the '622 patent"). Pet. 1. Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

We have authority to determine whether to institute *inter partes* review under 35 U.S.C. § 314. Upon considering the record developed thus far, for reasons discussed below, we institute *inter partes* review as to all challenged claims.

II. BACKGROUND

A. Related Matters

The parties indicate that the '622 patent is involved in *Uniloc USA, Inc. v. Samsung Electronics America, Inc.*, No. 2:16-cv-00642-JRG (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern District of Texas. Pet. 1–3; Paper 3, 2.

Concurrently with the instant Petition, Petitioner additionally filed a petition requesting *inter partes* review of claims 14–17, 19, 24–26, 28–31, and 33 of the '622 patent (Case IPR2017-01798). IPR2017-01798, Paper 1. The '622 patent also has been the subject of four earlier requests for *inter partes* review—two filed by Apple Inc. ("Apple") (Cases IPR2017-00223 and IPR2017-00224) and two filed by Facebook Inc. and WhatsApp Inc. (Cases IPR2017-01667 and IPR2017-01668)—as well as later requests filed by Apple (Cases IPR2017-01804 and IPR2017-01805), Google Inc. (Cases IPR2017-02080 and IPR2017-02081), and Huawei Device Co., Ltd. (Case IPR2017-02090).

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.
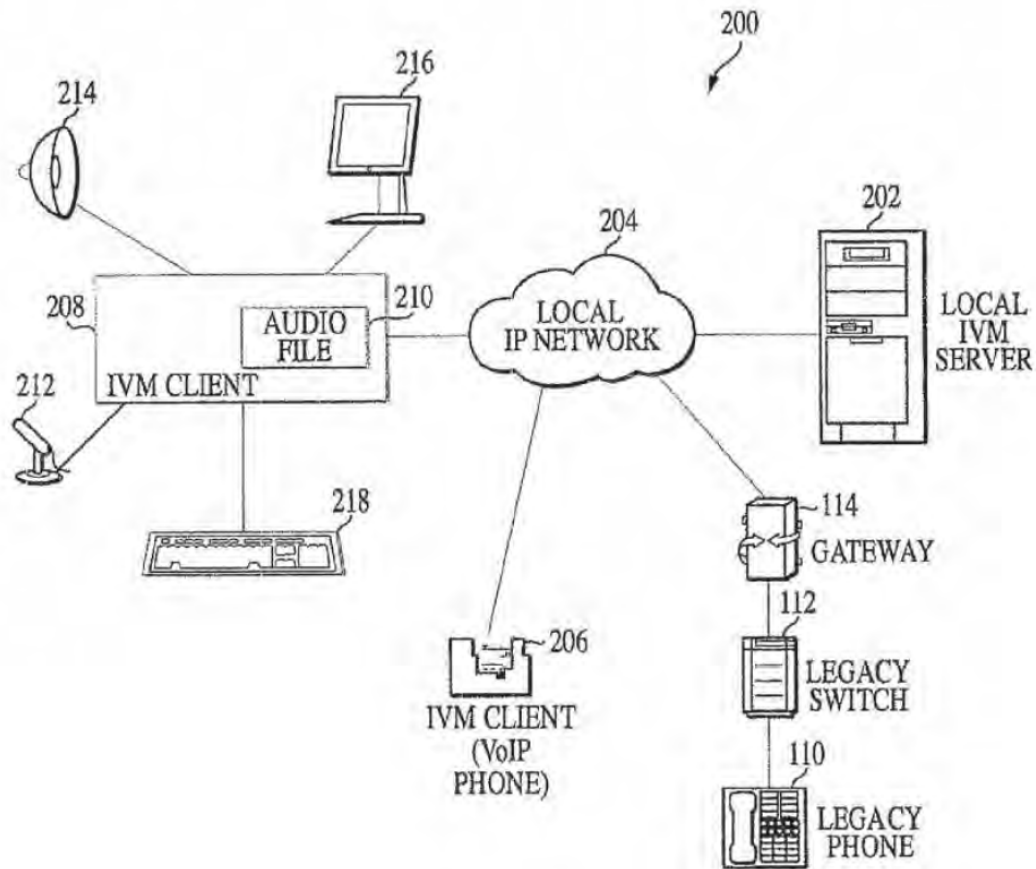
FIG. 2

As illustrated in Figure 2, local packet-switched IP network 204, which may be a local area network ("LAN"), "interconnects" IVM clients 206, 208 and legacy telephone 110 to local IVM server 202. *Id.* at 6:50–7:2; *see id.* at 7:23–24, 7:61–65. Local IVM server 202 enables instant voice messaging functionality over network 204. *Id.* at 7:61–65.

In "record mode," IVM client 208 "displays a list of one or more IVM recipients," provided and stored by local IVM server 202, and the user selects recipients from the list. Ex. 1001, 7:57–59, 7:65–8:4. IVM client 208 then transmits the selections to IVM server 202 and "records the user's speech into . . . digitized audio file 210 (i.e., instant voice message)." *Id.* at 8:4–10.

When the recording is complete, IVM client 208 transmits audio file 210 to local IVM server 202, which delivers the message to the selected recipients via local IP network 204. Ex. 1001, 8:15–29. "[O]nly the available IVM recipients, currently connected to . . . IVM server 202, will receive the instant voice message." *Id.* at 8:33–34. IVM server 202 "temporarily saves the instant voice message" for any IVM client that is "not currently connected to . . . local IVM server 202 (i.e., is unavailable)" and "delivers it . . . when the IVM client connects to . . . local IVM server 202 (i.e., is available)." *Id.* at 8:34–39; *see id.* at 9:17–21. Upon receiving the instant voice message, the recipients can audibly play the message. *Id.* at 8:29–32.

C. Illustrative Claims

Of the challenged claims, claims 3, 27, and 38 are independent. Claims 3 and 27 are illustrative of the challenged claims and are reproduced below.

3. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,
   wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and
   wherein the instant voice message includes an object field including a digitized audio file.

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