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 IPR2017-01799
Patent 8,199,747 B2

_____

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 1–3, 12, and 13 ("the challenged claims") of U.S. Patent No. 8,199,747 B2 (Ex. 1001, "the '747 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 claims 2 and 12 of the '747 patent.

## II.  BACKGROUND

### A.  Related Matters

The parties indicate that the '747 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.  The '747 patent was the subject of an earlier request for *inter partes* review filed April 7, 2017, by Facebook, Inc. and WhatsApp Inc. (Case IPR2017-01257), which request was denied.  *See* IPR2017-01257, Paper 8 (PTAB Dec. 3, 2017).  The '747 patent also is the subject of a petition for *inter partes* review filed September 11, 2017, by Google Inc. (IPR2017-02085, Paper 2).

### B.  Overview of the '747 Patent

The '747 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], 1:14–18.  The '747 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 2:18–42. In prior art instant text messaging systems, according to the '747 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 2:30–42. According to the '747 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 2:43–47. The invention of the '747 patent is thus directed to such a system and method. *Id.* at 1:15–18, 6:43–45.

In one embodiment, the '747 patent discloses local instant voice messaging ("IVM") system 200, depicted in Figure 2 below. *Id.* at 6:18–20.
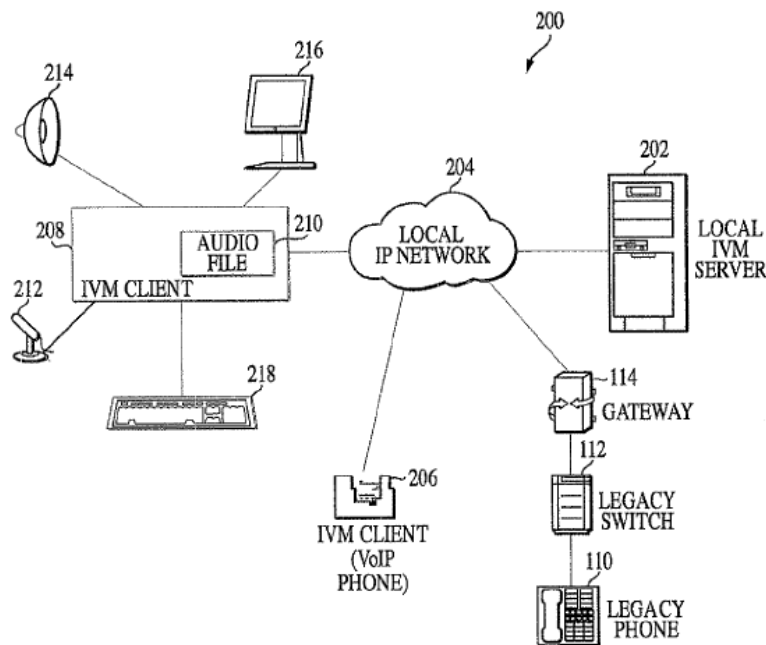


FIG. 2

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 6:46–65; *see id.* at 7:19–20, 7:57–61. Local IVM server 202 enables instant voice messaging functionality over network 204. *Id.* at 7:57–61.

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. *Id.* at 7:53–55, 7:61–67. IVM client 208 then transmits the selections to IVM server 202 and "records the user's speech into . . . digitized audio file 210 (i.e., an instant voice message)." *Id.* at 8:1–7.

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. *Id.* at 8:11–25. "[O]nly the available IVM recipients, currently connected to . . . IVM server 202, will receive the instant voice message." *Id.* at 8:29–30. 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 8:30–35; *see id.* at 9:13–17. Upon receiving the instant voice message, the recipients can audibly play the message. *Id.* at 8:25–28.

*C. Illustrative Claims*

Of the challenged claims, claims 1–3 are independent. Those claims are reproduced below:

> 1. A method for instant voice messaging over a packet-switched network, the method comprising:
> generating an instant voice message, wherein generating

includes recording the instant voice message in an audio file and attaching one or more files to the audio file;

transmitting the instant voice message having one or more recipients;

receiving an instant voice message when a recipient is available; and

receiving a temporarily stored instant voice message when a recipient becomes available, wherein the instant voice message is temporarily stored when at least one recipient is unavailable.

2. A method for instant voice messaging over a packet-switched network, the method comprising:

receiving a list of nodes within the packet-switched network, the list of nodes including a connectivity status of each node, said connectivity status being available and unavailable, wherein a node within the list is adapted to be selected as a recipient of an instant voice message;

displaying said list of nodes;

transmitting the instant voice message having one or more recipients;

receiving an instant voice message when a recipient is available; and

receiving a temporarily stored instant voice message when a recipient becomes available, wherein the instant voice message is temporarily stored when at least one recipient is unavailable.

3. A method for instant voice messaging over a packet-switched network, the method comprising:

generating an instant voice message; and

controlling a method of generating the instant voice message based upon a connectivity status each recipient;

transmitting the instant voice message having one or more recipients;

receiving an instant voice message when a recipient is available; and

receiving a temporarily stored instant voice message when a recipient becomes available, wherein the instant voice message is temporarily stored when at least one recipient is unavailable.

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