

Samsung Elec. America, Inc.

v.

Uniloc 2017 LLC

Case IPR2017-01797 & -1798
(Patent 8,724,622)

Hearing Before Jennifer S. Bisk,
Miram L. Quinn, and
Charles J. Bourdreau

October 30, 2018

IPR2017-01797
Independent Claim 3 of U.S. Patent No. 8,724,622

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.

27. A system comprising:

a client device;

a network interface coupled to the client device and connecting the client device to a packet-switched network; and

an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,

wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message.

28. A system comprising:

a client device;

a network interface coupled to the client device and connecting the client device to a packet-switched network; and

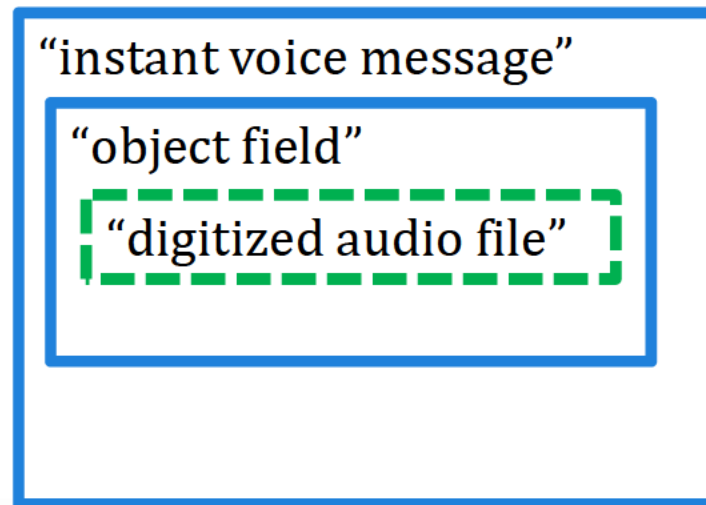
an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,

a display displaying a list of one or more potential recipients for an instant voice message.

“ . . . the instant voice message includes an object field including a digitized audio file” ('622 pat., claim 3)

Griffin's “message content 406” is not an “object field” as claimed

'622 patent, claim 3 recites a specific arrangement of three distinct elements:



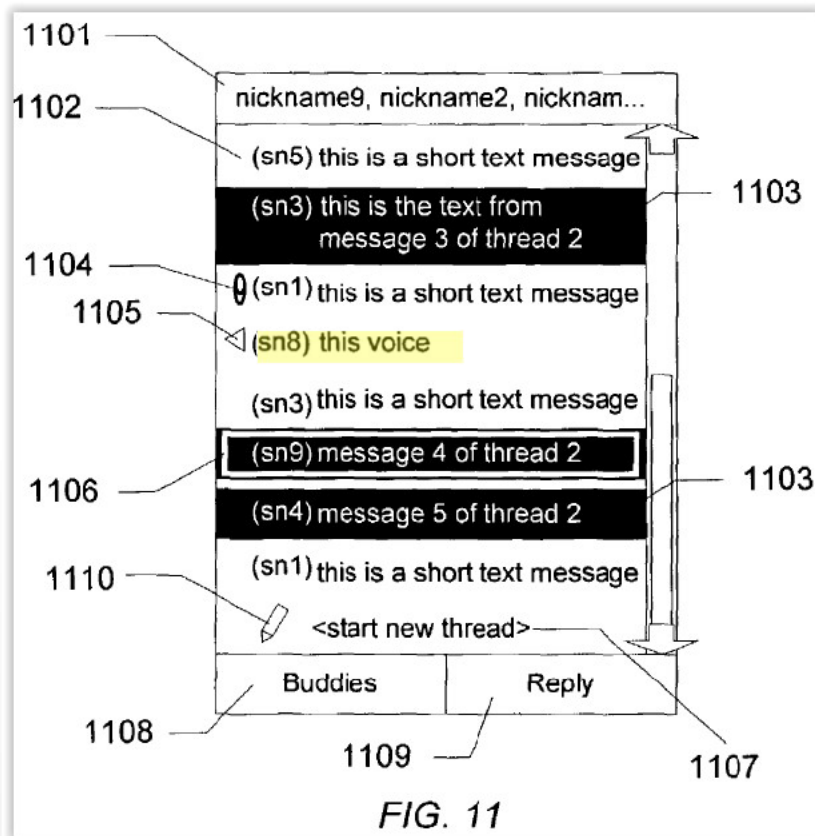
Griffin's only description of message content 406 is stated at col. 6, lines 38-44

chat message 400
message content 406

FIG. 4 illustrates an outbound chat message 400 that the terminal 100 sends to the message broadcaster 303. The outbound chat message 400 comprises a message type 401 (e.g., text, speech, and so on), a number of intended recipients 402, a plurality of recipient identifiers 403, a thread identifier 404, a message length 405, message content 406, and a number of attachments 407. Preferably, the mobile terminal 100 gener-

“ . . . the instant voice message includes an object field including a digitized audio file” ('622 pat., claim 3)

Even in the context of a speech message, Griffin describes its “message content” as displayable text

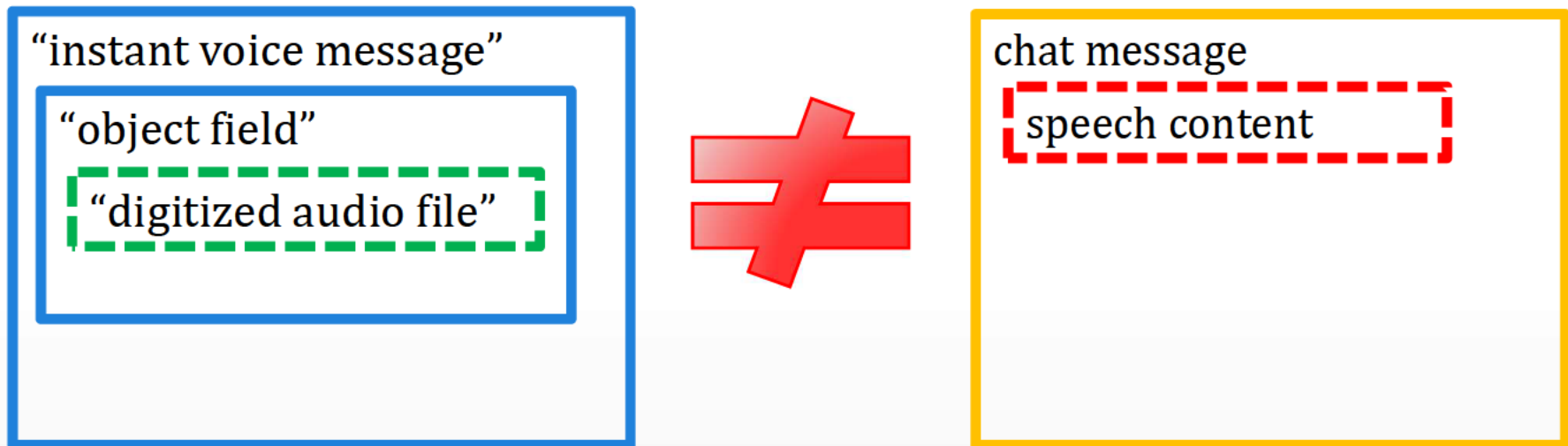


In the example of FIG. 11, each entry comprises an attachment indicator 1104-1105 that indicates if there is any attached content (e.g., documents, files, etc.) or transmitted speech available; the short name of the sender 705 or 803, and at least part of the message content or text (all of the text if the text fits within 2-3 lines). Although not illustrated in FIG. 11,

Griffin's Fig. 11 and the accompany description (e.g., 10:53-58, copied above) shows (at 1105) the “message content” for a speech message as displayable text.

“ . . . the instant voice message includes an object field including a digitized audio file” ('622 pat., claim 3)

Petitioner has not saved its theory by arguing in its Reply (at p. 10) that, in the context of a voice message, Griffin’s “message content” is the “speech content”



In related matter IPR2017-02080, the PTAB found that even if it is shown that a container includes voice data, this does not necessarily mean the voice data (let alone an audio file) is included within an object field of the container.

“packet-switched network” limitations of independent claims 3, 27 and 38

Claim construction dispute over recited structure:

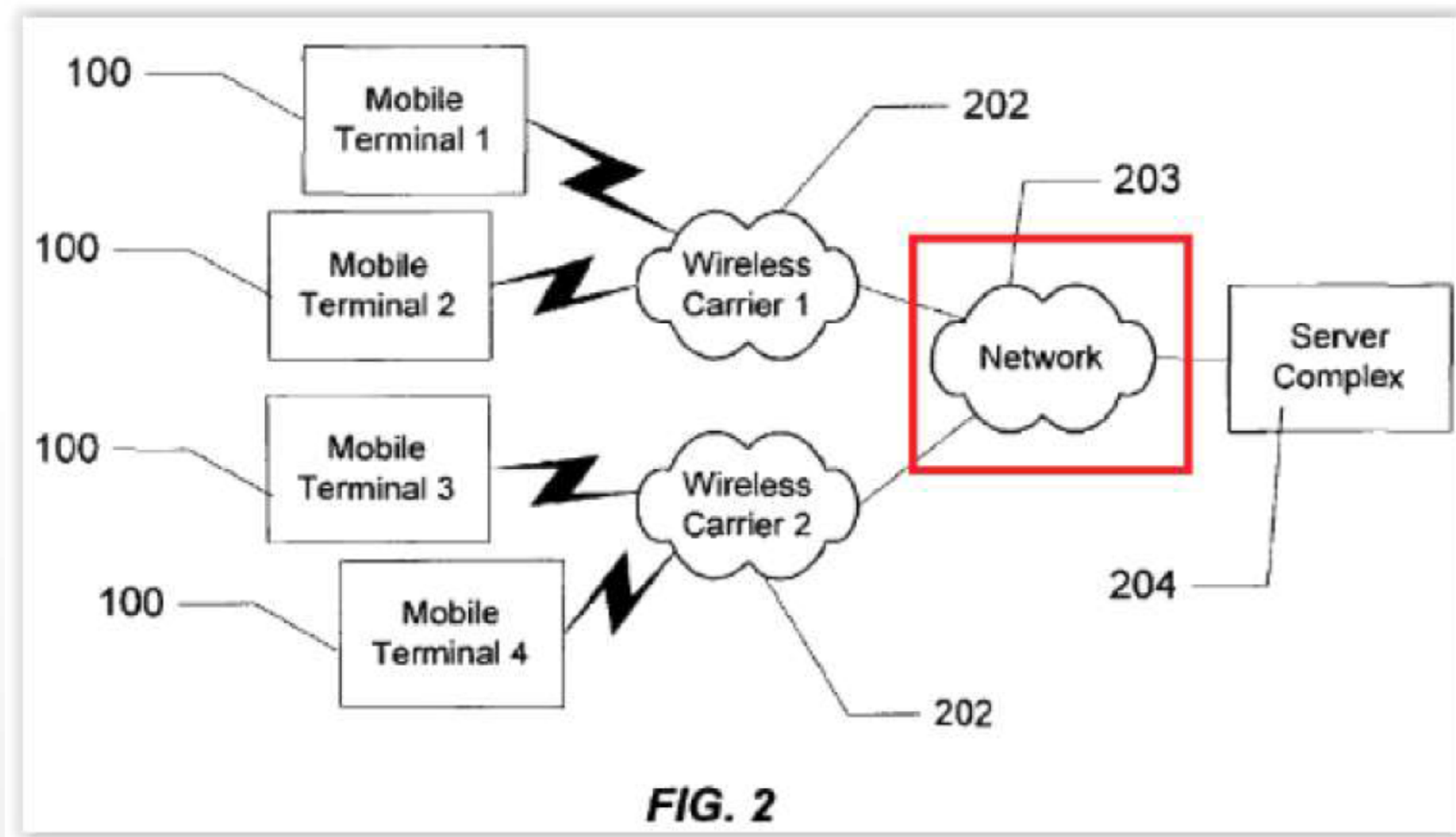
Independent claims 27 and 38 both recite: “a network interface coupled to the client device and connecting the client device to a packet-switched network;” and independent claim 3 recites “a network interface connected to a packet-switched network”

Petitioner’s reliance on Griffin erroneously interprets the above claim language to encompass “a network interface that provides an indirect connection to a packet-switched network” **(Pet. 12)**

The “connecting” and “connected to” claim language is not directed to what the network interface *provides*, but rather explicitly and unambiguously recites a direct structural interrelationship—i.e., “a network interface coupled to the client device and connecting the client device to a packet-switched network” and “a network interface connected to a packet-switched network.” **(Resp. at 13-14)**

“packet-switched network” limitations of independent claims 3, 27 and 38

It is undisputed Griffin discloses its mobile terminals 100 connect only to a circuit-switched cellular network 202



“packet-switched network” limitations of independent claims 3, 27 and 38

It is undisputed Griffin discloses its mobile terminals 100 connect only to a circuit-switched cellular network 202

40. Figure 2 of *Griffin* illustrates a plurality of mobile terminals connected to a plurality of wireless carriers. Nothing in the specification of *Griffin* discloses any other configuration.

41. Those terminals “communicate with at least one chat server complex 204 by wirelessly transmitting data to a corresponding wireless carrier’s infrastructure 202.” *Griffin*, 3:51–54.

42. The wireless carrier infrastructure would not have been a packet-switched network at the time of filing of *Griffin*.

Dr. Easttom’s testimony
at EX2001 ¶¶ 40-49

“packet-switched network” limitations of independent claims 3, 27 and 38

It is undisputed Griffin discloses its mobile terminals 100 connect only to a circuit-switched cellular network 202

THE WITNESS: As I look at the Figure 2, the Figure 2 that you asked me to look at shows that the mobile terminal 1, 2, 3, 4 are connected to wireless carrier 1 or wireless carrier 2, and those two, wireless carrier 1 and wireless carrier 2, are connected to the network 203, sir.

Dr. Haas cross-examination
(IPR2017-01799, EX2007 at
pp. 48-49)

“packet-switched network” limitations of independent claims 27 and 38

Because the Petition relies solely on Griffin in addressing independent claims 27 and 38, any purported reliance on extraneous art (e.g., Zydney) newly advanced in the Reply brief is a different and hence waived theory.

Pet. 62

- c. “a network interface coupled to the client device and connecting the client device to a packet-switched network; and”

Griffin discloses these features for reasons similar to those discussed in Part

IX.A.1.b. (Ex. 1002, ¶239.)

EX1002 ¶239

- c) [27b] “a network interface coupled to the client device and connecting the client device to a packet-switched network; and”

239. In my opinion, *Griffin* discloses these features for reasons similar to

those that I discussed above for claim element 3a. (*See* Part IX.A.1.b.)

Griffin teaches away from proposed “modification” purportedly based on Zydney (claim 3)

For independent claim 3, Griffin teaches away from the proposed combination with Zydney:

FIG. 2 illustrates the overall system architecture of a wireless communication system comprising a plurality of mobile terminals **100** in accordance with the present invention. The terminals **100** communicate with at least one chat server complex **204** by wirelessly transmitting data to a corresponding wireless carrier's infrastructure **202**. As known in the art, the wireless carrier infrastructures **202** comprise those elements necessary to support wireless communications with the terminals **100**. Various service providers (such as Verizon or

EX1005, 3:54-57

Zydney does not cure conceded deficiencies of Griffin for “connection information” limitations (claim 3)

“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” (claim 3)

- ✓ Petitioner acknowledges that Griffin does not detail “what precisely status 702 indicates.” Pet. 23.
- ✓ Zydney’s central server 24 passively waits to receive random status information notifications from the software agents: “the sender will log on, authenticate, and notify the central server of its status.” EX1006 14:3-4
- ✓ Due to its passive design, the Zydney system would not maintain the current connectivity status, for example, in instances where the actual connectivity status of software agent changes due to circumstances other than the user entering status information into the software agent (e.g., an unanticipated power outage).

“a document handler system for attaching one or more files to the instant voice message” (claim 27)

“document handler system”

- ✓ The PTAB has repeatedly recognized that Zydney expresses distinguishes its “voice container” from its separately-generated “voice message” contained therein. As set forth in the briefing in this matter and in related matters, attaching one or more files to the “voice container” on Zydney does not render obvious the “attaching” limitations.
- ✓ Petitioner does not allege, let alone attempt to prove, that the cited references, either alone or in combination, disclose that the same alleged “instant voice messaging application” that is (1) “installed at the client device” and that includes (2) “a client platform system for generating an instant voice message” and (3) “a messaging system for transmitting the instant voice message over the packet-switched network” is also the same application that includes (4) the claimed “document handler system.”

“... data rep. a state of a logical connection ...” (claim 24)

“wherein the messaging system receives connection object messages from the plurality of instant voice message client systems, wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems” (claim 24)

- ✘ The Petition relies exclusively Low’s description of a client sending connect and disconnect commands as the alleged “connection object messages.” Pet. at 67-68
- ✓ A command to do something (e.g., to change a state) is not the same thing as a data representing the actual state of a logical connection.
- ✓ The claimed “state of a logical connection” in the “connection object message” is with “one of the plurality of instant voice message client systems,” which can be distinct from the “messaging system” that is receiving the “connection objection message.”

“message database” (claims 14-17 and 28-31)

“wherein the instant voice messaging application includes a message database storing the instant voice message, wherein the instant voice message is represented by a database record including a unique identifier”
(dependent claims 14-17 and 28-31)

- ✓ In addition to other deficiencies, Petitioner fails to prove that any of the cited references disclose a “message database” arranged as disclosed and claimed—i.e., storing the “instant voice message” within a “message database” included as part of a client-side “instant voice messaging application.”
- ✗ At most, Petitioner argues Griffin discloses “each mobile terminal 100 stores both inbound and outbound speech (i.e., voice) chat messages permanently in the terminal’s storage.”
 - Griffin’s terminal device is not an application.
 - Petitioner acknowledges Griffin does not use the term database to describe the storage of speech chat messages, let alone a database arranged as claimed. Pet. 45 n.12.

“ . . . the instant voice message includes an action field . . . ”
(’622 pat., IPR2017-1797, dependent claims 4 and 5)

Neither Griffin nor Zydney discloses “the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user,” as recited in dependent claims 4 and 5.

- ✓ Petitioner concedes “Griffin does not explicitly disclose a messaging [sic] having an ‘action field,’ as claimed.” Pet. 30.
- ✓ Zydney not only fails to disclose, but also teaches away from the “action filed” limitations.

6 The voice data is transmitted in a voice container. The term “voice containers” as
7 used throughout this application refers to a container object that contains no methods,
8 but contains voice data or voice data and voice data properties. In the latter case,

Zydney (EX1103) at 12:6-7

Samsung Elec. America, Inc.

v.

Uniloc 2017 LLC

Case IPR2017-01799

(Patent 8,199,747)

Hearing Before Jennifer S. Bisk,

Miram L. Quinn, and

Charles J. Bourdreau

October 30, 2018

No *prima facie* obviousness for “attaching” limitations

In its original Institution Decision, the Board correctly found that the Petition fails to establish even *prima facie* obviousness for the “attaching” limitations of claims 1 and 13:

On the record before us, we agree with Patent Owner that Petitioner has not established sufficiently that the combination of Griffin and Zydney teaches or suggests “recording the instant voice message in an audio file *and attaching one or more files to the audio file*,” as recited in claim 1 (emphasis added), to demonstrate a reasonable likelihood of succeeding on the asserted ground of unpatentability with respect to claims 1 and 13. As Patent Owner points out (Prelim. Resp. 31–32), attaching a file to a message is not the same as attaching a file to an audio file included in that message, and the portions of Griffin relied upon by Petitioner as allegedly teaching this limitation disclose including files within Griffin’s speech chat message 400 but do not teach or suggest attaching files to an audio file. Indeed, Petitioner

No *prima facie* obviousness for “attaching” limitations

The Board can and should take **judicial notice** of its reasoning supporting a conclusion that the Petition fails to establish even *prima facie* obviousness for the “attaching” limitations of claims 1 and 13, including at least the following findings:

- ✓ Attaching a file to a message is not the same as attaching a file to an audio file included in that message
- ✓ Petitioner concedes that “Griffin does not explicitly disclose that speech is recorded in an ‘audio file’” and contends instead merely that “it would have been obvious to a POSA . . . to modify Griffin’s system/process such that speech is recorded in a digitized audio file . . . in view of the teachings of Zydney.”
- ✓ The portions of Zydney relied upon by Petitioner teach attachment of multimedia files to its “voice container,” rather than to an audio file as recited in claim 1 (citing Ex. 1006, 19:6–12, Fig. 16).

No *prima facie* obviousness for “attaching” limitations

The PTAB has repeatedly rejected the same Zydney-based arguments for the “attach[ing]” limitations

the asserted ground of unpatentability with respect to claims 1 and 13. As Patent Owner points out (Prelim. Resp. 12), the portions of Zydney relied upon by Petitioner as allegedly teaching this limitation disclose attaching additional files (e.g., a multimedia file) to a voice container, rather than to an audio file as recited in claim 1 (*see* Pet. 29; Ex. 1003, 19:6–12, Fig. 16).

[IPR2017-01257, Paper 8, Decision Denying Institution, at 18](#)

Not only has Petitioner failed to advance any argument that the elements Petitioner interchangeably identifies as the recited “instant voice message”—Zydney’s voice container and the voice data or message stored therein—are equivalent, but also we agree with Patent Owner that these elements of Zydney are distinct in the context of Petitioner’s obviousness arguments. Prelim. Resp. 12–13; Ex. 2001 ¶¶ 45, 48, 51 (opining that

[IPR2017-01524, Paper 7, Decision Denying Institution, at 17](#)

No *prima facie* obviousness for “attaching” limitations

We agree with Patent Owner that our reasoning in denying the petition in IPR2017-01257, wherein claim 1 was asserted to have been obvious over Zydney, is applicable here as well. In that case, we were not persuaded that the petitioner there had established sufficiently that Zydney teaches or suggests “attaching one or more files to the audio file,” as recited in claim 1, to demonstrate a reasonable likelihood of succeeding on the asserted ground. We agreed with Patent Owner in that case that the portions of Zydney now relied upon by Petitioner as allegedly disclosing this limitation instead disclose attaching additional files (e.g., a multimedia file) to a voice container, rather than to an audio file as recited in claim 1. *See* Case IPR2017-01257, slip op. at 18 (PTAB Dec. 4, 2017) (Paper 8) (“1257 DI”); Ex. 1004, 19:2–12, Figs. 16–18. We further observed that Zydney discloses that a voice container may “contain[] voice data or voice data and voice data properties” (Ex. 1004, 12:6–8) and also “has the ability to have other data types attached to it” (*id.* at 19:6), but we explained that “[e]ven if we regard Zydney’s voice data as being an audio file, however, we are not persuaded that Zydney’s disclosure that another file may be attached to a voice container that contains such an audio file teaches or suggests attaching that other file to the audio file.” 1257 DI 18–19. That conclusion applies *a fortiori* in this case, where Petitioner is alleging Zydney *anticipates* claim 1.

No *prima facie* obviousness for “controlling” limitations

In its original Institution Decision, the Board correctly found that the Petition fails to establish even *prima facie* obviousness for the limitation “controlling a method of generating [an] instant voice message based upon a connectivity status [of] each recipient,” as recited in claim 3:

On the record before us, we agree with Patent Owner that Petitioner has not established sufficiently that Zydney teaches or suggests “controlling a method of generating [an] instant voice message based upon a connectivity status [of] each recipient,” as recited in claim 3, to demonstrate a reasonable likelihood of succeeding on the asserted ground of unpatentability with respect to that claim. As Patent Owner points out (Prelim. Resp. 44–45), the

The Board correctly found no *prima facie* obviousness

The Board can and should take judicial notice of its reasoning supporting a conclusion that the Petition fails to establish even *prima facie* obviousness for the “controlling” limitations of claim 3, including at least the following findings:

- ✓ The Petition does not prove that either the pack and send mode or the intercom mode of operation is controlled in any manner by a connectivity status of a recipient.
- ✓ The ability to select a different mode of *delivery* is distinguishable from controlling the method of generating an instant voice message. “In other words, whether the pack and send method is mandatory or simply optional may determine whether or not the pack and send mode is used, but this determination does not change how the instant voice message is generated in the pack and send mode.”

(IPR2017-01799, Paper 9 at p. 33, internal citation and quotation omitted; *accord* IPR2017-02085, Paper 11 at p. 26.)

The PTAB provided similar reasoning in IPR2017-02085

On the record before us, we determine that Petitioner has not established sufficiently that Zydney discloses “controlling a method of generating [an] instant voice message based upon a connectivity status [of] each recipient,” as recited in claim 3, to demonstrate a reasonable likelihood of succeeding in showing that claim 3 is anticipated by Zydney. The cited portions of Zydney disclose that the instant voice message is generated as a voice container that may be delivered via different communication modes. However, Petitioner does not show that the selection between those communication modes discloses control of *generating* the instant voice message. In other words, regardless whether the “pack and send” or the “intercom” communication mode is selected, Petitioner identifies only a single method of generating an instant voice message, namely, “‘generating an instant voice message’ in the form of a ‘voice container,’” and Petitioner does not persuasively explain how generation of the voice container is controlled by the selection of one or the other communication mode.

Zydney repeatedly found to be deficient

- ✓ Zydney has been cited against this same family of patents (and indeed these same patents) in **26** petitions for *inter partes* review
- ✓ Most of those Zydney-based petitions were denied at the preliminary stage or have been voluntarily terminated by the petitioner, for certain reasons that are applicable here.

See, e.g., IPR2017-1257; IPR2017-1365; IPR2017-1523;
IPR2017-1524; IPR2017-2082; IPR2017-2083;
IPR2017-2084; IPR2017-2085; IPR2017-2067;
IPR2017-2080; IPR2017-2081; IPR2017-1804;
IPR2017-1805; etc.

The Petition does not defend its claim construction for “node”

The “list of nodes” term recited in claim 2 refers to multiple devices within a network, not people as Petitioner argues:

- ✗ In a footnote, and without any supportive argument or evidence, Petitioner asks the Board to construe “node” as “potential recipient,” without specifying whether “potential recipient” refers to a device or a person. Pet. at 45–46, n.11. The Petition first maps Griffin’s mobile terminal 100 onto the “node” term; and then it incontinently relies, instead, on a human user of a mobile terminal 100 for the “node” term. The recited “node” does not and cannot refer to both.
- ✓ In the context of computer communications networks, “node” is a term of art that refers to a device (e.g., a computer, a computer system, or another device) within a network. EX2001 ¶¶ 23–26.
- ✓ The 1992 edition of the American Heritage Dictionary of the English Language defines “node” in the computer network context as “[a] terminal in a computer network.” EX2001 ¶ 26 (citing EX2003 at 3).
- ✓ Consistent with this plain and ordinary meaning, claim 2 defines the “nodes” as being “within a packet-switched network.” Devices, not humans, are *within* packet-switched networks.

Griffin does not disclose “the list of nodes” limitations (claim 2)

Conveying user definitions and presence status of a person, as disclosed in Griffin, is distinguishable from “receiving a list of nodes within the packet-switched network, the list of nodes including a connectivity status of each node”—i.e., the connectivity status of each listed node within the packet-switched network (claim 2)

- ✓ In defining its presence status, Griffin expressly differentiates a human recipient from her terminal by using the possessive form of “recipient” when referring to status 702 and referring, instead, to the possessive form of “terminal” when referring to address 703:

tifiers **402**. It then queries a presence manager **302** to establish the recipients’ current status **702** (i.e., an indicator of whether the recipient is ready to receive the particular type of message, speech and/or text messages only, etc.) and the terminal’s address **703**. FIG. 7 illustrates a table with the plurality of

5:11-15

Griffin does not disclose “the list of nodes” limitations (claim 2)

“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 ...” (claim 2)

- ✓ Griffin repeatedly and consistently ties its presence status to a user (i.e., to a person), as opposed to a connectivity status of a network node.

display supports the composition of text messages. Nicknames and other identifiers of chat participants (or users) are controlled on two levels. At the first level, each chat message

2:26

the user's own presence indicator 904,

8:22

ifiers 402. It then queries a presence manager 302 to establish the recipients' current status 702 (i.e., an indicator of whether the recipient is ready to receive the particular type of message,

5:11-13

When a participant's presence status 702 changes, the message broadcaster 303, sends a buddy list update message 600 to other users subscribed to the participant's presence status 702. FIG. 6 illustrates a buddy list update message 600 sent from the server complex 204 to the mobile terminal 100. The message 600 comprises a list type 601 (e.g., alphanumeric list, group list, etc.), the number of groups identified in the message 602, at least one group definition 603-604, a list of ungrouped individuals 605-606, and a plurality of user definitions 502-505, 607. Note that the recipient status field 607 indicates the value of the presence status 702. A group defi-

7:39-49

In this manner, users (i.e., recipients)

6:31

the receiver (i.e., the receiving user)

5:25

ing a chat communication message), the buddy's presence status 911, the buddy's nickname 802 or 704, and/or the

8:50-51

Griffin does not disclose “the list of nodes” limitations (claim 2)

“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 ...” (claim 2)

- ✓ Patent Owner’s expert (Dr. Easttom) testified that Griffin’s presence status pertains to a person and not to a “node” as claimed:

FIG. 7 of *Griffin* shows a table of presence data records 700 compiled by a presence manager 302 at the server complex, where each presence data record includes the presence status 702 of a user (if known). *Griffin*, 5:9-22. FIG. 9 of *Griffin* shows a buddy list display that can be displayed on the screen of a user’s terminal 100, where the buddy list display includes a presence indicator icon 904 that varies in appearance depending on presence status 702 of a buddy. *Griffin*, 8:15-28.

(IPR2017-01799, EX2001 ¶ 52)

Griffin does not disclose “the list of nodes” limitations (claim 2)

“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 ...” (claim 2)

- ✓ Patent Owner’s expert (Dr. Easttom) testified that there is no device-specific information in Griffin’s buddy-list update message:

of people, not devices. There is no device-specific information in the buddy list update message 600. Rather, the buddy list update message 600 includes, for each buddy whose status is being updated, multiple names for that buddy (full name, nickname, and short name) along with the presence status 702 for that buddy (which is included in the recipient status field 607). *Griffin*, 7:18-8:14.

(IPR2017-01799, EX2001 ¶ 53)

Griffin does not disclose “the list of nodes” limitations (claim 2)

“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 ...” (claim 2)

- ✓ Petitioner’s declarant (Dr. Haas) conceded that Griffin fails to expressly or inherently disclose that its so-called “status” indicates whether or not terminal 100 is connected:

Griffin does not provide additional details regarding what precisely current status 702 indicates. For example, as I discussed above with respect to claim element 1c (Part IX.A.1.d), it is not specified whether “Off” indicates that terminal 100 is disconnected from server complex 204, that terminal 100 is connected to server complex 204 but the user of terminal 100 is not accepting messages, or some other state. Likewise, it is not specified whether “Available” simply indicates that

(IPR2017-01799, EX1002 ¶ 163)

Zydney does not disclose “the list of nodes” limitations (claim 2)

The Board has repeatedly found Zydney does not disclose “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 ...” (claim 2)

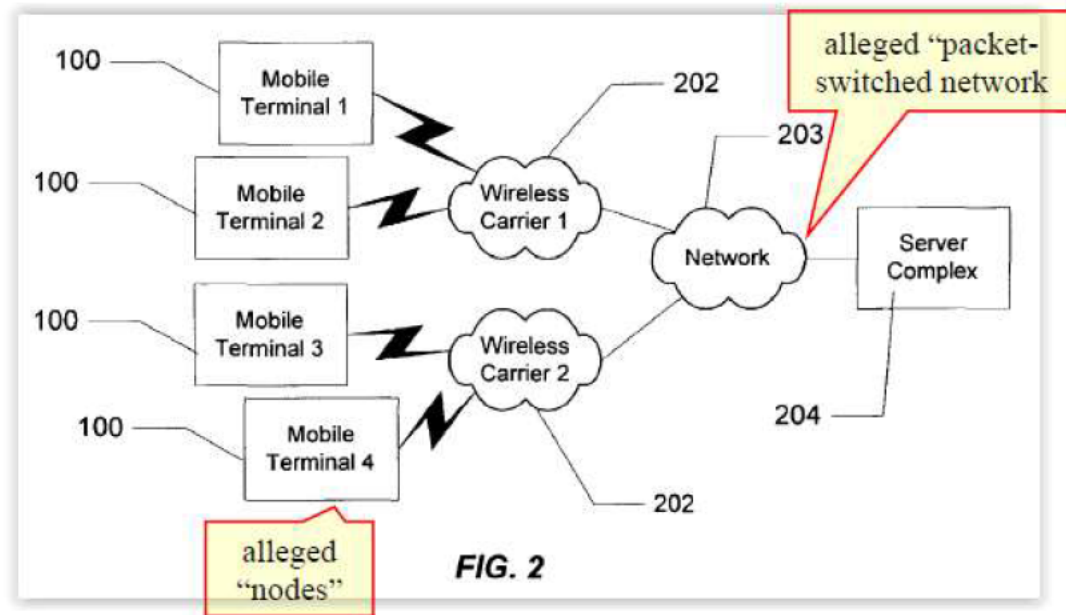
- ✓ **In IPR2017-01257**, in rejecting the same Zydney-based arguments of the instant Petition, the Board found Zydney at least fails to disclose that a “list of nodes ... including a connectivity status of each node” and is “received,” in addition to being “displayed,” as recited in claim 2. IPR2017-01257, Paper 8 at 30-31. This is true regardless whether “node” is interpreted to mean “potential recipient.”
- ✓ **In IPR2017-02085**, the Board again adopted similar (if not identical) findings from IPR2017-01257 concerning multiple deficiencies of Zydney for the same “list of nodes” limitations. IPR2017-02085, Paper 11 at 23-24. The Board further noted that it did not understand defining “node” to mean “potential recipient” would require that term to encompass a person. *Id.* at 10.

“nodes within the packet-switched network” (claim 2)

Claim construction dispute over the structural limitation

“... nodes within the packet-switched network” (claim 2)

Griffin fails to disclose that its mobile terminals 100 are *within* network 203 (the only network the Petition alleges is a packet-switched network). Petitioner erroneously attempts to save its Griffin-based argument by rewriting the claim language as “an indirect connection to a packet-switched network.” Pet. 49.



“nodes within the packet-switched network” (claim 2)

Griffin’s disclosure leads away from modifying its system (purportedly based on Zydney) in a manner that bypasses what Griffin describes as its “necessary” circuit-switched wireless carrier network(s) 202.

- ✓ If it would have been obvious to bypass wireless carrier infrastructure 202 entirely, surely Griffin would have said so. Griffin does not.
- ✓ Griffin states that as between wireless carrier infrastructure 202 and network 203, it is only the latter (network 203) that is optionally eliminated. EX1005, 4:20–21.
- ✓ Griffin explicitly emphasizes the necessity of wireless carrier infrastructure 202 by stating that “the wireless carrier infrastructures 202 comprise **those elements necessary** to support wireless communications with the terminals 100.” EX1005, 3:54–57 (underling added).

Samsung Elec. America, Inc.

v.

Uniloc 2017 LLC

Case IPR2017-01800

(Patent 8,243,723)

Hearing Before Jennifer S. Bisk,

Miram L. Quinn, and

Charles J. Bourdreau

October 30, 2018

No *prima facie* obviousness for claim 2 of '723 patent

The Board should take judicial notice of its findings that the Petition fails to establish the proposed combination of Griffin and Zydney discloses “the instant voice message includes one or more files attached to an audio file” (claim 2):

For the reasons given, we are not persuaded by Petitioner’s evidence that the combination of Griffin and Zydney would have taught or suggested “the instant voice message includes one or more files attached to an audio file,” as recited in claim 2. Accordingly, we conclude that Petitioner has not established a reasonable likelihood that it would prevail in showing that independent claim 2 is unpatentable over Griffin and Zydney.

(IPR2017-01800, Paper 8 at 22-23)

No *prima facie* obviousness for claim 3 of '723 patent

The Board should take judicial notice of its findings in related matter IPR2017-01799 that the Petition fails (in presenting the same arguments there) to establish the proposed combination of Griffin and Zydney discloses “controlling a method of generating the instant voice message based upon the connectivity status of said one or more recipient” (claim 3):

For the reasons given, we are not persuaded by Petitioner’s evidence that the combination of Griffin and Zydney would have taught or suggested “controlling a method of generating [an] instant voice message based upon a connectivity status [of] each recipient,” as recited in claim 3. Accordingly, we conclude that Petitioner has not established a reasonable likelihood that it would prevail in showing that claim 3 is unpatentable over Griffin and Zydney.

(IPR2017-01799, '747 patent, Paper 9 at 33)

No *prima facie* obviousness for claim 3 of '723 patent

The Board should also take judicial notice of its repeated findings in related matters IPR2017-01257 and IPR2017-02085 that the same Zydney-based arguments presented there fail to establish “controlling a method of generating the instant voice message based upon the connectivity status of said one or more recipient” (claim 3):

For the reasons given, we are not persuaded by Petitioner’s evidence that Zydney discloses “controlling a method of generating [an] instant voice message based upon a connectivity status [of] each recipient,” as recited in claim 3. Accordingly, we conclude that Petitioner has not established a reasonable likelihood that it would prevail in showing that either claim 3 or claims 4–6 and 8, which depend from claim 3 and accordingly include the same limitation, are anticipated by Zydney.

(IPR2017-02085, '747 patent, Paper 11 at 28; see also IPR2017-01257, Paper 8 at 20-23)

No proof of obviousness for the “associating” limitations (claim 1)

- ✓ The Board should take **judicial notice** of its repeated finding that Zydney fails to disclose “associating a sub-set of the nodes with a client,” as recited in claim 1 of the '723 patent.

IPR2017-01800, Paper 8 at 19-20; see also IPR2017-01365, Paper 8 at 8-11.

- ✓ Petitioner fails to prove its alternative argument that Griffin alone discloses the “associating” limitations:
 - 1) the Petition bases its arguments on erroneous claim constructions (as explained in Patent Owner’s Response);
 - 2) the Petition impermissibly interprets Griffin as attributing to a device certain disclosure expressly attributed, instead, to a user (i.e., a person); and
 - 3) Petitioner admits through its declarant that the cited disclosure is not enabling.

Griffin does not disclose the “associating” limitations (claim 1)

Pointing to Fig. 7 of Griffin, the Petition argues a subscriber user ID in column 706 (the alleged “client”) is associated with the one user ID in column 701 (the alleged “sub-set of nodes”) in that same record or row. (Pet. 32.)

The figure shows a table with columns labeled 701 through 706. Column 701 is 'ID', column 702 is 'Status', column 703 is 'Address', column 704 is 'Public Nickname', column 705 is 'Public Short Name', and column 706 is 'Subscriber IDs'. The first row has values: 123, Available, 123 210 12 112 2016, JimJ, JJ, and 120, 415, 654. The second row has values: 136, Off, 113 10 112 10 8012, Chris, CC, and 345, 246, 235, 346. The third row has values: 676, TextOnly, 123 10 112 10 7291, JaneT, JT, and 102, 349. Red boxes highlight the '123' in column 701 and the '120, 415, 654' in column 706 of the first row. A red line connects these two boxes. Below the table, two yellow boxes with red borders contain the text: 'alleged “sub-set of the nodes” associated with the “client”' and 'alleged “client” (in the singular)'. The label 'FIG. 7' is centered below the table.

ID	Status	Address	Public Nickname	Public Short Name	Subscriber IDs
123	Available	123 210 12 112 2016	JimJ	JJ	120, 415, 654
136	Off	113 10 112 10 8012	Chris	CC	345, 246, 235, 346
676	TextOnly	123 10 112 10 7291	JaneT	JT	102, 349
...					

EX1005, Figure 7 (annotated).

The PTAB has already proscribed application of such a **one-to-one** association by concluding that the claim language “requires more than one node in the ‘sub-set’ corresponding to the client.” (See IPR2017-00222, Paper 29 at 16.)

Griffin does not disclose the “associating” limitations (claim 1)

1) the Petition bases its arguments on erroneous claim constructions (as set forth in Patent Owner’s Response)

- The PTAB has already proscribed application of a one-to-one association by concluding that the claim language “requires more than one node in the ‘sub-set’ corresponding to the client.”

See IPR2017-00222, Paper 29 at 16.

- A one-to-one association between people is not a plural-to-one association between a “sub-set of the nodes” and “a client”—i.e., between devices.

See IPR2017-01800, Paper 16 at 10-12.

Griffin does not disclose the “associating” limitations (claim 1)

- 2) the Petition impermissibly interprets Griffin as attributing to a device certain disclosure expressly attributed, instead, to a user (i.e., a person)**
- Griffin discloses that each presence record 700 (i.e., a row in the table illustrated in Figure 7) “comprises the user’s identifier 701 ... and a plurality of other user identifiers 706 that subscribe to the presence information of the user corresponding to that record.” EX1005, 5:17–22.
 - Petitioner’s declarant speculates one possible interpretation of Griffin is that the “status” shown in column 702 indicates the user is not accepting messages even though her terminal 100 is connected to server complex 204. EX1002 ¶ 105.
 - Griffin’s disclosure that each “Address” entry in column 703 of Figure 7 will dynamically change from time to time, and at times is not even known, further confirms that attributes of a user described with reference to Figure 7 in Griffin (including alleged associations thereof) cannot be imputed, instead, to a device.

Griffin does not disclose the “associating” limitations (claim 1)

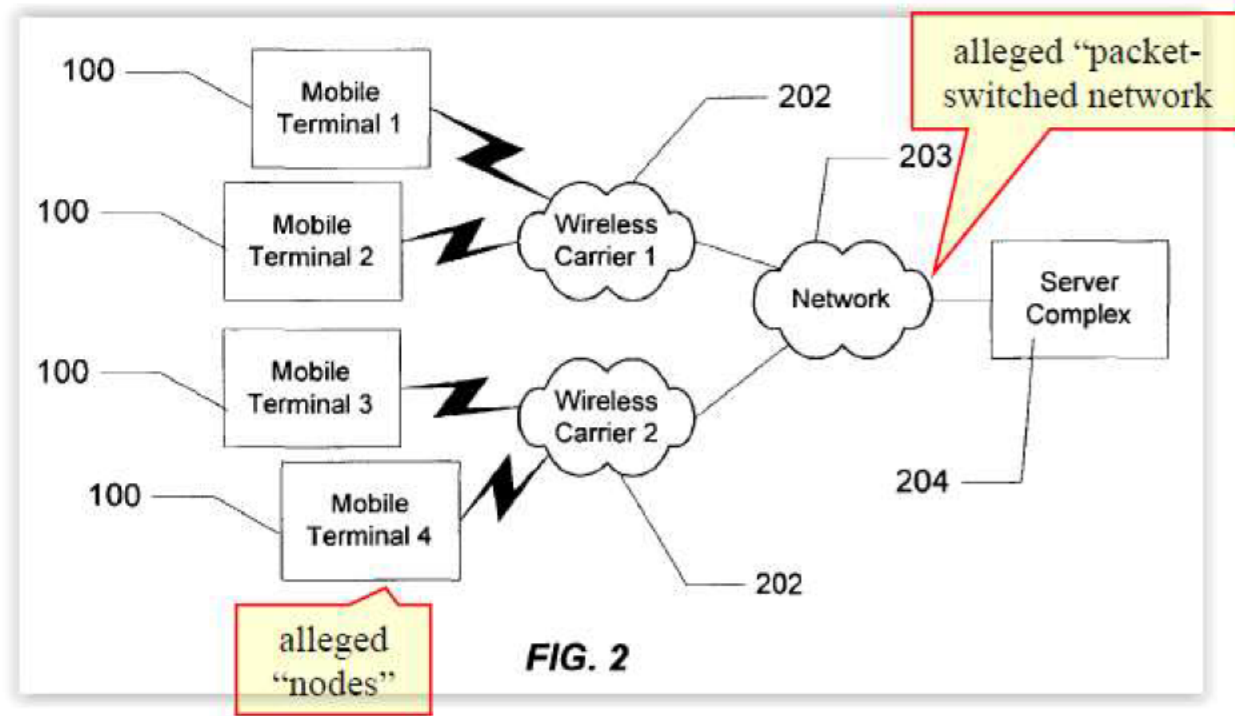
- 3) Petitioner admits through its declarant that the cited disclosure is not enabling, which is particularly significant here because the Board correctly characterized the relevant argument is based on “Griffin alone.”**

“Although Griffin describes that the potential recipients of a speech (i.e. voice) chat message are associated with each subscribing terminal, Griffin does not provide additional details regarding how this is done.”

IPR2017-01800, EX1002 ¶ 130; see also Pet. 37 (citing EX1002 ¶ 130).

No proof of obviousness for the “monitoring” limitations (claim 1)

Because Griffin fails to disclose its mobile terminals 100 are *within* network 203 (the only network the Petition alleges is a packet-switched network), it follows that there is no proof that Griffin discloses “monitoring a connectivity status of nodes within the packet-switched network,” as recited in claim 1.



Samsung Elec. America, Inc.

v.

Uniloc 2017 LLC

Case IPR2017-01801

(Patent 8,995,433)

Hearing Before Jennifer S. Bisk,

Miram L. Quinn, and

Charles J. Bourdreau

October 30, 2018

IPR2017-01801
Independent Claim 1 of U.S. Patent No. 8,995,433

1. A system comprising:

an instant voice messaging application including a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over a packet-switched network via a network interface;

wherein the instant voice messaging application displays a list of one or more potential recipients for the instant voice message;

wherein the instant voice messaging application includes a message database storing the instant voice message, wherein the instant voice message is represented by a database record including a unique identifier; and

wherein the instant voice messaging application includes a file manager system performing at least one of storing, deleting and retrieving the instant voice messages from the message database in response to a user request.

IPR2017-01801
Independent Claim 6 of U.S. Patent No. 8,995,433

6. A system comprising:
an instant voice messaging application including a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over a packet-switched network via a network interface;
wherein the instant voice messaging application displays a list of one or more potential recipients for the instant voice message;
wherein the instant voice messaging application includes a file manager system performing at least one of storing, deleting and retrieving the instant voice messages from a message database in response to a user request; and
wherein the instant voice messaging application includes a compression/decompression system for compressing the instant voice messages to be transmitted over the packet-switched network and decompressing the instant voice messages received over the packet-switched network.

IPR2017-01801
Independent Claim 9 of U.S. Patent No. 8,995,433

9. A system, comprising:

an instant voice messaging application comprising:

a client platform system for generating an instant voice message;

a messaging system for transmitting the instant voice message over a packet-switched network, and

wherein the instant voice message application attaches one or more files to the instant voice message.

Analogous arguments apply to the '433 patent

The following are non-exhaustive example deficiencies addressed in Patent Owner's briefing in this matter and in the related matters:

- ✓ No proof of obviousness for a client-side application that itself includes (among the other recited requirements) a “messaging system for transmitting the [IVM] over a packet-switched network via a network interface”
- ✓ No proof of obviousness for “the [IVM] application attaches one or more files to the [IVM]”
- ✓ Petitioner fails to prove obviousness for a client-side application that itself includes (among the other recited requirements) “a message database storing the [IVM], wherein the [IVM] is represented by a database record including a unique identifier”
- ✓ No proof of obviousness for a client-side application that itself includes (among the other recited requirements) a “file manager system ... storing, retrieving, and deleting the [IVM]”

Samsung Elec. America, Inc.

v.

Uniloc 2017 LLC

Case IPR2017-01802

(Patent 7,535,890)

Hearing Before Jennifer S. Bisk,

Miram L. Quinn, and

Charles J. Bourdreau

October 30, 2018

“delivering the stored [IVM] to the selected recipient once the selected recipient becomes available”

All challenged claims recite some variation of **the server**:

- (1) “receiving the ... [IVM]”
- (2) “delivering the [IVM] to the selected recipients” and
- (3) “temporarily storing the [IVM] if a selected recipient is unavailable and delivering the stored [IVM] to the selected recipient once the selected recipient becomes available”

“delivering the stored [IVM] to the selected recipient once the selected recipient becomes available”

Petitioner’s theory is premised on a erroneous interpretation of Griffin:

“Griffin discloses temporarily storing a speech message if a recipient is not viewing the chat history display, and delivering the stored speech message once the recipient is viewing the chat history display.”

(Pet. 24-25)

Griffin actually describes its queuing at the server complex as follows:

receiving terminal. In an alternate embodiment, such queuing can occur at the server complex such that the recipient can request playback within a predetermined period of time. Fur-

Griffin (EX1005) 11:53-55

“delivering the stored [IVM] to the selected recipient once the selected recipient becomes available”

34. Petitioner’s combination of *Griffin* and *Zydney* is inoperable for text-only buddies. If *Zydney*’s concept of available/unavailable was inserted in place of the status 702 in *Griffin*, then a text-only buddy such as JaneT (in the ability to receive and/or play speech messages (which is why she was designated “TextOnly” in the first place). A PHOSITA would realize that this would lead to erroneous behavior, because JaneT should not be considered available for instant voice messaging. Petitioner has not even acknowledged this problem, let alone explained how to deal with it. A PHOSITA would avoid such erroneous behavior, and would therefore not combine *Griffin* and *Zydney* in the manner Petitioner has.

(Ex. 2001 ¶ 34)

The Examiner found Malik distinguishable during prosecution

The Petition falsely states that Malik was not considered during prosecution:

None of the references in Grounds 1-2 were considered during prosecution of the '890 Patent. While certain secondary references are at issue in the other IPRs

Pet. 7

The Malik patent cited in the Petition is the parent of a continuation application published as U.S. 2007/0112925 (EX2004), which is listed on the face of the '890 patent as having been cited by the Examiner during prosecution

(12) **United States Patent**
Rojas

(10) **Patent No.:** **US 7,535,890 B2**
(45) **Date of Patent:** **May 19, 2009**

(54) **SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING**

2007/0112925 A1 * 5/2007 Malik 709/206
2007/0174403 A1 * 7/2007 Barry 709/207

Malik does not cure conceded deficiencies of Griffin & Zydney

“receiving the ... instant voice message ... and delivering the instant voice message over the [local/external] network,” as recited, for example, in challenged independent claims 1,14, 40, and 51.

- ✓ It is undisputed that Griffin and Zydney both fail to disclose instant voice message delivery over what the claim language expressly distinguishes as local and external networks.
- ✓ Petitioner’s reliance on Fig. 2 of Malik does not cure this deficiency at least because the accompanying description states that “prior art” configuration applies only to “conventional **IM**” (i.e., instant messaging), while the distinct single-sever architecture of Fig. 3 newly enables “voice instant messaging (**VIM**).”

Malik does not cure conceded deficiencies of Griffin & Zydney

“receiving the ... instant voice message ... and delivering the instant voice message over the [local/external] network,” as recited, for example, in challenged independent claims 1,14, 40, and 51.

[0024] Depicted in FIG. 3 is a block diagram of one representative embodiment, among others, of a voice message delivery system 300. The voice message delivery

Malik, ¶24

The VIM server 330 may act as a single IM server 105 of FIG. 1 or a local IM server, such as a Jabber Server 215 of FIG. 2. The VIM server 330 monitors the presence infor-

Malik, ¶25

users. Accordingly, the VIM server 330 includes the capabilities of conventional IM servers and the additional capabilities for handling VIM message delivery and storage.

Malik, ¶25