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Paper 8
Entered: February 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01801
Patent 8,995,433 B2

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

QUINN, *Administrative Patent Judge.*

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

I. INTRODUCTION

Samsung Electronics America, Inc. (Petitioner or "Samsung") filed a Petition requesting *inter partes* review of claims 1–5, 7–12, 14–17, 25, and 26 of U.S. Patent No. 8,995,433 B2 (Ex. 1001, "the '433 patent"). Paper 1 ("Pet."). Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

We have jurisdiction under 35 U.S.C. § 314. Upon considering the record developed thus far, for reasons discussed below, we institute *inter partes* review of claims 1–5, 7–12, 14–17, 25, and 26 of the '433 patent.

A. Related Matters

The parties indicate that the '433 patent is involved in a multitude of district court cases, including *Uniloc USA, Inc. v. Samsung Electronics America, Inc.*, Case No. 2-16-cv-00641-JRG (E.D. Tex.). Pet. 1–5, Paper 4, 2. The '433 patent also has been the subject of multiple *inter partes* review petitions (*id.*), and is the subject of Case IPR2017-00225 (filed by Apple Inc.), which we instituted on May 25, 2017.

B. The '433 Patent

The '433 patent relates to Internet telephony, and more particularly, to instant voice over IP ("VoIP") messaging over an IP network, such as the Internet. Ex. 1001, 1:19–23. The '433 patent acknowledges that "instant text messaging is [] known" in the VoIP and public switched telephone network ("PSTN") environments, with its server presenting the user a "list of persons who are currently 'online' and ready to receive text messages on their own client terminals." *Id.* at 2:35–42. In one embodiment, such as

depicted in Figure 2 (reproduced below), the system of the '433 patent involves an instant voice message ("IVM") server and IVM clients. *Id.* at 7:21–22.

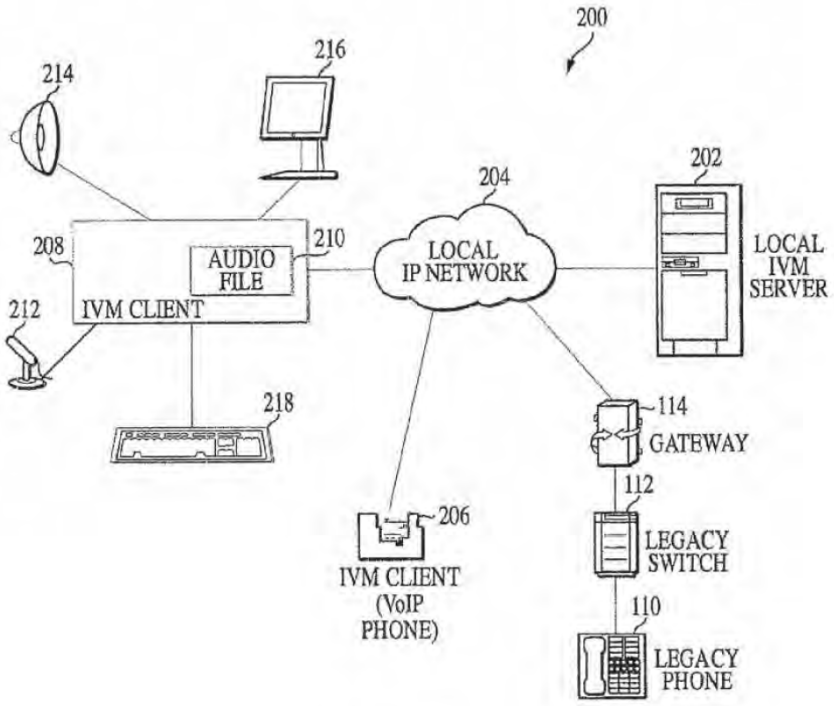

FIG. 2

Figure 2 illustrates IVM client 206 interconnected via network 204 to local IVM server 202, where IVM client 206 is a VoIP telephone, and where legacy telephone 110 is connected to legacy switch 112 and further to media gateway 114. *Id.* at 7:27–49. The media gateway converts the PSTN audio signal to packets for transmission over a packet-switched IP network, such as local network 204. *Id.* at 7:53–56. In one embodiment, when in "record mode," the user of an IVM client selects one or more IVM recipients from a list. *Id.* at 8:2–5. The IVM client listens to the input audio device and records the user's speech into a digitized audio file at the IVM client. *Id.* at 8:12–15. "Once the recording of the user's speech is finalized, IVM client

208 generates a send signal indicating that the digitized audio file 210 (instant voice message) is ready to be sent to the selected recipients." *Id.* at 8:19–22. The IVM client transmits the digitized audio file to the local IVM server, which, thereafter, delivers that transmitted instant voice message to the selected recipients via the local IP network. *Id.* at 8:25–33. "[O]nly the available IVM recipients, currently connected to the IVM server, will receive the instant voice message." *Id.* at 8:36–38. If a recipient "is not currently connected to the local IVM server 202 (i.e., is unavailable), the IVM server temporarily saves the instant voice message and delivers it to the IVM client when the IVM client connects to the local IVM server 202 (i.e., is available)." *Id.* at 8:38–43.

The '433 patent also describes an "intercom mode" of voice messaging. *Id.* at 11:34–37. The specification states that the "intercom mode" represents real-time instant voice messaging. *Id.* at 11:37–38. In this mode, instead of creating an audio file, one or more buffers of a predetermined size are generated in the IVM clients or local IVM servers. *Id.* at 11:38–41. Successive portions of the instant voice message are written to the one or more buffers. The content of each buffer is, as it fills, automatically transmitted to the IVM server for transmission to the one or more IVM recipients. *Id.* Buffering is repeated until the entire instant voice message has been transmitted to the IVM server. *Id.* at 11:46–59.

C. Illustrative Claim

Of the challenged claims, claim 1, 6, and 9 are independent and claim 1 is illustrative of the subject matter.

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.

Ex. 1001, 23:65–24:14.

D. Asserted Prior Art and Grounds of Unpatentability

This proceeding relies on the following prior art references:

a) *Griffin*: U.S. Patent No. 8,150,922 B2, issued April 3, 2012, filed in the record as Exhibit 1005;

b) *Zydney*: PCT App. Pub. No. WO 01/11824 A2, published February 15, 2001, filed in the record as Exhibit 1006;

c) *Clark*: U.S. Patent No. US 6,725,228 B1, issued April 20, 2004, filed in the record as Exhibit 1007;

d) *Väänänen*: PCT App. Pub. No. WO 02/17650 A1, published February, 28, 2002, filed in the record as Exhibit 1008;

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