

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 IPR2017-01802
Patent 7,535,890 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 1–6, 9, 14, 15, 17–20, 23, 40–43, 51–54, and 57 (“challenged claims”) of U.S. Patent No. 7,535,890 B2 (Ex. 1001, “the ’890 patent”). Paper 1 (“Pet.”). 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 of the challenged claims of the ’890 patent.

A. Related Matters

The parties indicate that the ’890 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. 1–3, Paper 4, 2–3. The ’890 patent also has been the subject of multiple *inter partes* review petitions, and is the subject of Case IPR2017-00221 (filed by Apple Inc.), in which we instituted *inter partes* review on May 25, 2017.

B. The ’890 Patent

The ’890 patent explains that “[v]oice messaging” and “instant text messaging” in both the Voice over Internet Protocol (“VoIP”) and public switched telephone network environments are known. Ex. 1001, 2:11–35. In prior art instant text messaging systems, a server presents a user of a client terminal with a “list of persons who are currently ‘online’ and ready to

receive text messages,” the user “select[s] one or more” recipients and types the message, and the server immediately sends the message to the respective client terminals. *Id.* at 2:23–35. According to the ’890 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 1:6–11, 2:36–48, 6:37–39.

In one embodiment, the ’890 patent discloses local instant voice messaging (“IVM”) system 200, depicted in Figure 2 below. *Id.* at 6:12–14.

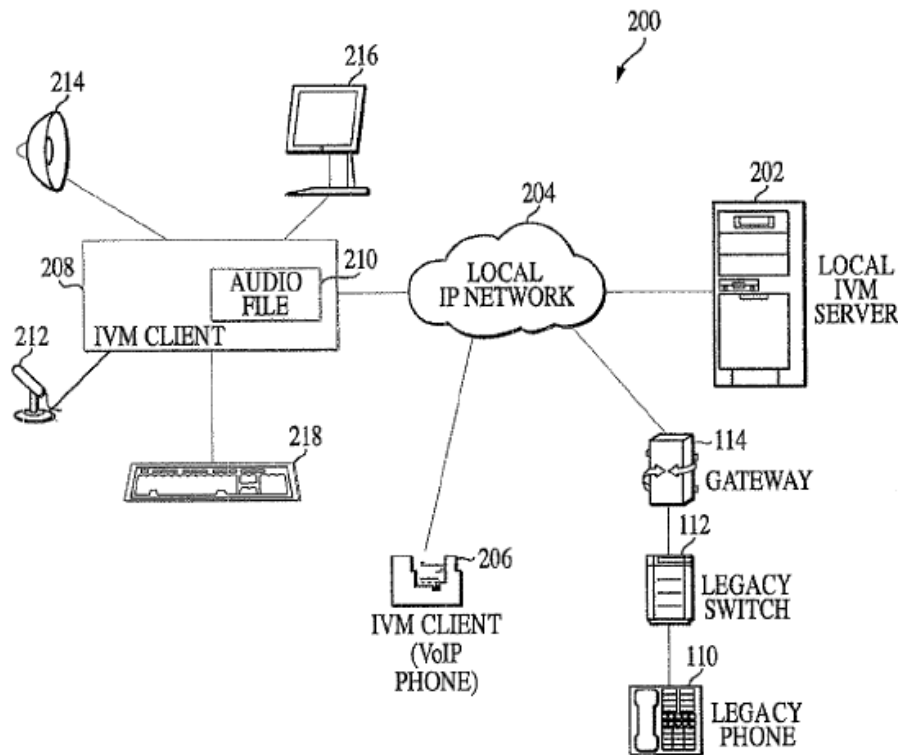


FIG. 2

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 6:40–61; see *id.* at 7:13–14, 7:51–55. Local IVM server 202 enables instant voice messaging functionality over network 204. *Id.* at 7:53–55.

In “record mode,” IVM client 208, exemplified as a VoIP softphone in Figure 2, “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 7:47–49, 7:55–61. 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 7:61–8:1.

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 8:5–19. “[O]nly the available IVM recipients, currently connected to . . . IVM server 202, will receive the instant voice message.” *Id.* at 8:23–25. 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 8:24–29; see *id.* at 9:7–11. Upon receiving the instant voice message, the recipients can audibly play the message. *Id.* at 8:19–22.

In another embodiment, the ’890 patent discusses global IVM system 500. *Id.* at 15:24–28, Fig. 5. Global IVM system 500 includes a local IVM system, such as local IVM system 200, and global IVM server system 502, with global IVM clients 506, 508. *Id.* at 15:25–33. Both the local and global IVM systems are connected to “packet-switched network 102 (i.e., Internet)” to enable the local and global IVM clients to be able to exchange instant voice messages with one another. *Id.* at 15:25–38.

C. Independent Claims

Of the challenged claims, claims 1, 14, 40, and 51 of the '890 patent are independent. Claims 1 and 14 reproduced below, are illustrative of the recited subject matter:

1. An instant voice messaging system for delivering instant messages over a packet-switched network, the system comprising:
a client connected to the network, the client selecting one or more recipients, generating an instant voice message therefor, and transmitting the selected recipients and the instant voice message therefor over the network; and
a server connected to the network, the server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message to the selected recipients over the network, the selected recipients enabled to audibly play the instant voice message, and the server temporarily storing the instant voice message if a selected recipient is unavailable and delivering the stored instant voice message to the selected recipient once the selected recipient becomes available.

14. An instant voice messaging system for delivering instant messages over a plurality of packet-switched networks, the system comprising:

a client connected to a local network, the client selecting one or more recipients connected to an external network outside the local network, generating an instant voice message therefor, and transmitting the selected recipients and the instant voice message therefor over the local network and the external network; and
a server connected to the external network, the server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message to the selected recipients over the external network, the selected recipients being enabled to audibly play the instant voice message, and the server temporarily storing the instant voice message if a selected recipient is unavailable and delivering the stored instant voice message to the selected recipient

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