UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,[1]
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

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Case IPR2017-02067
Patent 8,995,433 B2

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

QUINN, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. §§ 42.108, 42.122; 35 U.S.C. §§ 315(d), 325(d)

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[1] Petitioner filed Updated Mandatory Notices alerting the Board that Google
Inc. filed a Certificate of Conversion with the Delaware Secretary of State,
whereby Google Inc. converted from a corporation to a limited liability
company and changed its name to Google LLC. Paper 5.

Petitioner filed a Petition requesting *inter partes* review of claims 1–27 of U.S. Patent No. 8,995,433 B2 (Ex. 1001, "the '433 patent"). Paper 2 ("Pet."). Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response. Paper 8 ("Prelim. Resp."). Petitioner filed a Reply to Patent Owner's Preliminary Response, upon authorization of the Board, to address Patent Owner's arguments concerning application of the Board's institution discretion under 35 U.S.C. §§ 314(a) and 325(d). Paper 9.

We have authority under 35 U.S.C. § 314. Upon considering the information presented in the Petition, the Preliminary Response, and Reply, and for reasons discussed below, we deny the Petition and do not institute *inter partes* review of claims 1–27 of the '433 patent.

I. BACKGROUND

A. *Real Parties In Interest and Related Matters*

Petitioner asserts that following entities are real parties in interest: Motorola Mobility, LLC, Huawei Device Co., Ltd., Huawei Device USA, Inc., Huawei Investment & Holding Co., Ltd., Huawei Technologies Co., Ltd., and Huawei Device (Dongguan) Co., Ltd. Pet. 1.

Petitioner indicates that the '433 patent has been asserted against Motorola Mobility LLC in the Eastern District of Texas. *Id.* at 1–2 (identifying Case No. 2:16-cv-992). Petitioner also indicates that a complaint was filed against the Huawei entities (Case No. 2:16-cv-994). *Id.* at 2. Finally, Petitioner asserts that Patent Owner filed, in the Eastern District of Texas, several complaints against Petitioner (Case Nos. 2:17-cv-465, 2:17-cv-466, 2:17-cv-467, 2:17-cv-231, 2:17-cv-224, 2:17-cv-214). *Id.*

The '433 patent is the subject matter of several *inter partes* reviews: IPR2017-00225 (instituted May 25, 2017), IPR2017-01427 (instituted December 4, 2017), and IPR2017-01428 (instituted December 4, 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.
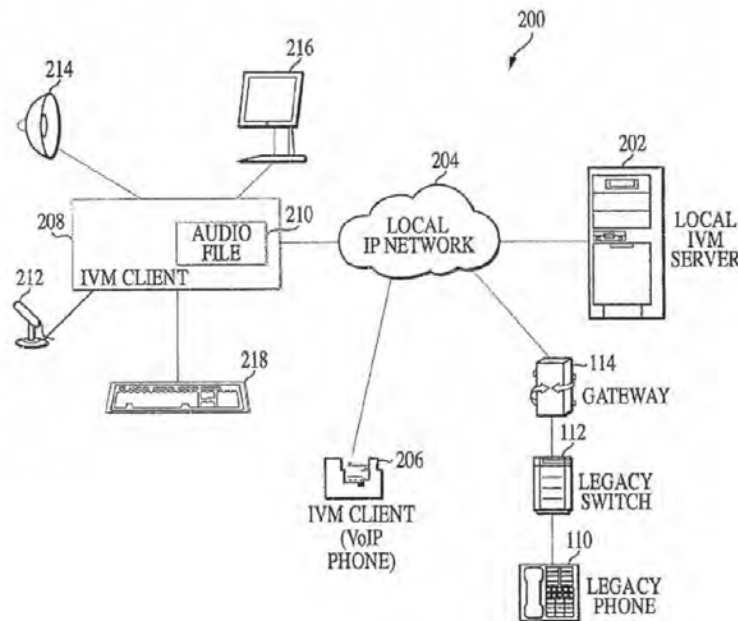

FIG. 2

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 7:49–53. 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 8:25–26. Only 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," 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 (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, which as they fill, automatically transmit their content to the IVM server for transmission to the one or more IVM recipients. *Id.* at 11:41–46. 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. Claim 1 is illustrative, and is reproduced below.

> 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.

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