

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Rojas
U.S. Pat. No.: 8,995,433 Attorney Docket No.: 19473-0371IP1
Issue Date: March 31, 2015
Appl. Serial No.: 14/224,125
Filing Date: March 25, 2014
Title: SYSTEM AND METHOD FOR INSTANT VOIP
MESSAGING

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PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,995,433
PURSUANT TO 35 U.S.C. §§ 311–319, 37 C.F.R. § 42

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EXHIBITS

- GOOGLE1001 U.S. Pat. No. 8,995,433 to Rojas (“the ’433 patent”)
- GOOGLE1002 Prosecution History of the ’433 patent (Serial No. 14/224,125)
- GOOGLE1003 Declaration of Dr. Paul S. Min
- GOOGLE1004 Prosecution History of U.S. Pat. No. 7,535,890 (Serial No. 10/740,030)
- GOOGLE1005 International Publication No. WO01/11824 (“Zydney”)
- GOOGLE1006 International Publication No. WO98/47252 (“Stern”)
- GOOGLE1007 International Publication No. WO02/087135 (“Trapani”)
- GOOGLE1008 U.S. Publication No. 2003/0182323 to Demsky et al. (“Demsky”)
- GOOGLE1009 U.S. Pat. No. 6,301,258 to Katseff et al. (“Katseff”)
- GOOGLE1010 U.S. Publication No. 2003/0208543 to Enete et al. (“Enete”)

I. INTRODUCTION

Google Inc. (“Petitioner”) petitions for *Inter Partes* Review (“IPR”) of claims 1-27 of U.S. Patent 8,995,433 (“the ’433 patent”). The specification of the ’433 patent describes “an instant voice messaging system for delivering instant messages over a packet-switched network.” GOOGLE1001, 2:61-63. As explained below and in the accompanying testimony of Dr. Paul S. Min, Ph.D., a number of publications such as Zydney (GOOGLE1005) show that patentee’s claimed solution for an instant voice messaging system was known in the prior art before 2003. Zydney and the predictable combinations cited in Grounds 1-7 were not considered during prosecution. If they had been, the ’433 patent never would have issued. Petitioner therefore requests the Board to institute IPR of claims 1-27 as set forth below.

II. MANDATORY NOTICES UNDER 37 C.F.R §42.8

A. Real Parties-In-Interest Under 37 C.F.R. §42.8(b)(1)

Google Inc. is the Petitioner. Google is a real party-in-interest in this proceeding, along with 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.

B. Related Matters Under 37 C.F.R. §42.8(b)(2)

Patent Owner filed a complaint on September 6, 2016 in the U.S. District Court for the Eastern District of Texas (Case No. 2:16-cv-992) alleging that

Motorola Mobility LLC infringed the '433 patent. The complaint was served on September 13, 2016. Patent Owner also filed another complaint on September 6, 2016 (Case No. 2:16-cv-994) alleging that Huawei Device USA, Inc. and Huawei Technologies USA, Inc. infringed the '433 patent (the complaint was also served on September 13, 2016). On October 6, 2016, Patent Owner filed an amended complaint, which eliminated Huawei Technologies USA, Inc. as a defendant and added Huawei Device Co., LTD., as a defendant.

Patent Owner filed subsequent complaints in 2017 in the Eastern District of Texas (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) alleging that Google infringed the '433 patent.¹

The Patent Owner also filed complaints in the Eastern District of Texas alleging infringement of the '433 patent by other parties: Avaya Inc. (2:16-cv-777); Shoretel, Inc. (2:16-cv-779); Sony Interactive Entertainment LLC (2:16-cv-732); Tangome, Inc. (2:16-cv-733); Green Tomato Limited (2:16-cv-731); Facebook, Inc. (2:16-cv-728); Voxernet LLC (2:16-cv-644); Viber Media S.A.R.L. (2:16-cv-643); Samsung Electronics America, Inc. (2:16-cv-777, 2:16-cv-642); Apple Inc. (2:16-cv-638); AOL Inc. (2:16-cv-722); Beetalk Private Ltd. (2:16-cv-

¹ Patent Owner amended its complaints in Case Nos. 2:17-cv-214, 2:17-cv-224, and 2:17-cv-231 to remove any allegations that Google infringed the '433 patent.

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