

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,  
Patent Owner.

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Case IPR2017-02080  
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge*.

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

## I. INTRODUCTION

Google, Inc., now known as Google LLC<sup>1</sup> (“Petitioner”), filed a Petition requesting *inter partes* review of claims 3–23 of U.S. Patent No. 8,724,622 B2 (Ex. 1001, “the ’622 patent”). Paper 2 (“Pet.”). Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). With authorization from the Board, Petitioner additionally filed a Reply to Patent Owner’s Preliminary Response. Paper 9.

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons given below, we determine after having considered the information presented in the Petition, the Preliminary Response, and the Reply that Petitioner has not established a reasonable likelihood of prevailing as to any of the challenged claims of the ’622 patent, and we deny institution of *inter partes* review.

## II. BACKGROUND

### A. Related Matters

Concurrently with the instant Petition, Petitioner additionally filed a petition requesting *inter partes* review of claims 1, 2, and 24–39 of the ’622 patent (Case IPR2017-02081). IPR2017-02081, Paper 2. In that case, as in the instant case, Petitioner identifies Motorola Mobility LLC, Huawei Device Co., Ltd., Huawei Device USA, Inc., Huawei Investment & Holding

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<sup>1</sup> See Paper 6, 2.

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Co., Ltd., Huawei Technologies Co., Ltd., and Huawei Device (Dongguan) Co., Ltd. as additional real parties in interest. *See* Pet. 1; IPR2017-02081, Paper 2 at 1. The '622 patent also has been the subject of petitions for *inter partes* review in Cases IPR2017-00223, IPR2017-00224, IPR2017-01804, and IPR2017-01805 (filed by Apple Inc.), all of which were denied; Cases IPR2017-01667 and IPR2017-01668 (filed by Facebook and WhatsApp), in which we instituted *inter partes* review on January 19, 2018; Cases IPR2017-01797 and IPR2017-01798 (filed by Samsung Electronics America, Inc.), in which we instituted *inter partes* review on February 6, 2018; and Case IPR2017-02090 (filed by Huawei Device Co., Ltd. and LG Electronics, Inc.), in which we instituted *inter partes* review and granted a motion for joinder with Case IPR2017-01667 on March 6, 2018. Apple Inc. additionally has filed petitions for *inter partes* review of certain claims of the '622 patent in Cases IPR2018-00579 and IPR2018-00580, accompanied by motions for joinder with Cases IPR2017-01667 and IPR2017-01668, respectively.

The parties additionally indicate that the '622 patent is involved in *Uniloc USA, Inc. v. Google, Inc.*, No. 2:17-cv-00214 (E.D. Tex.), *Uniloc USA, Inc. v. Google, Inc.*, No. 2:17-cv-00224 (E.D. Tex.), *Uniloc USA, Inc. v. Google, Inc.*, No. 2:17-cv-00231 (E.D. Tex.), *Uniloc USA, Inc. v. Motorola Mobility LLC*, No. 2:16-cv-00992 (E.D. Tex.), and *Uniloc USA, Inc. v. Huawei Device USA, Inc.*, No. 2:16-cv-00994 (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern District of Texas. Pet. 1–3; Paper 4, 2.

*B. The '622 Patent*

The '622 patent, titled “System and Method for Instant VoIP Messaging,” relates to Internet telephony, and more particularly, to instant voice over IP (“VoIP”) messaging over an IP network, such as the Internet. Ex. 1001, [54], 1:18–22. The '622 patent acknowledges that “[v]oice messaging” and “instant text messaging” in both the VoIP and public switched telephone network environments were previously known. *Id.* at 2:22–46. In prior art instant text messaging systems, according to the '622 patent, a server would present a user of a client terminal with a “list of persons who are currently ‘online’ and ready to receive text messages,” the user would “select one or more” recipients and type the message, and the server would immediately send the message to the respective client terminals. *Id.* at 2:34–46. According to the '622 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 1:18–22, 2:47–59, 6:47–49.

In one embodiment, the '622 patent discloses local instant voice messaging (“IVM”) system 200, depicted in Figure 2 below. Ex. 1001, 6:22–24.

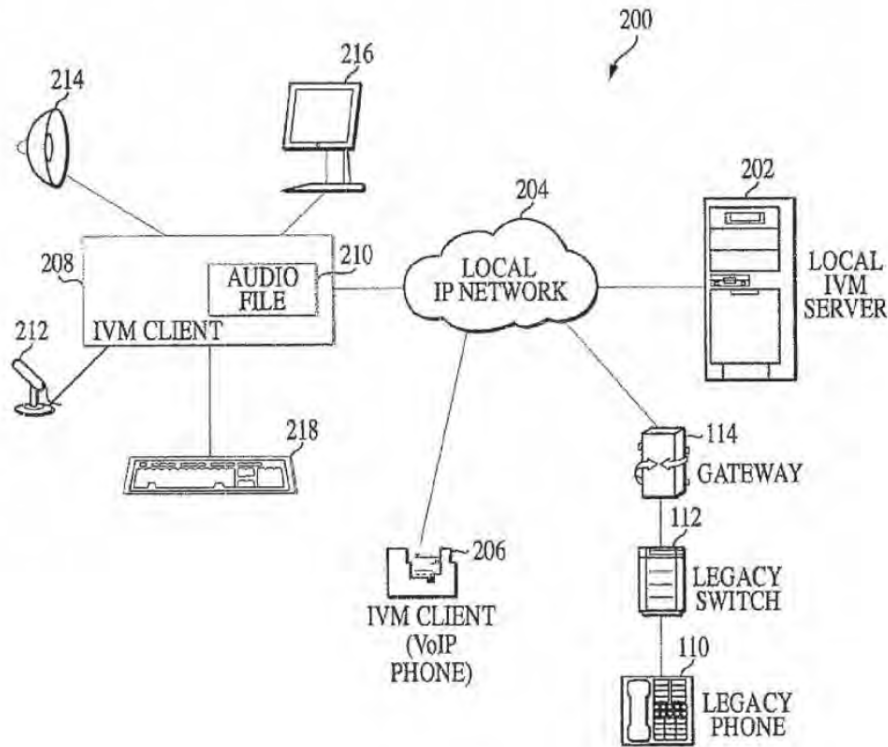


FIG. 2

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 6:50–7:2; *see id.* at 7:23–24, 7:61–65. Local IVM server 202 enables instant voice messaging functionality over network 204. *Id.* at 7:61–65.

In “record mode,” IVM client 208 “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. Ex. 1001, 7:57–59, 7:65–8:4. 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 8:4–11.

When the recording is complete, IVM client 208 transmits audio file 210 to local IVM server 202, which delivers the message to the selected

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