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Paper 9
Entered: March 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUAWEI DEVICE CO., LTD. and LG ELECTRONICS, INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-02090
Patent 8,724,622 B2

Before MIRIAM L. QUINN, KERRY BEGLEY, and CHARLES J. BOUDREAU, *Administrative Patent Judges.*

BOUDREAU, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review and
Grant of Motion for Joinder
37 C.F.R. §§ 42.108, 42.122(b)

I. INTRODUCTION

Huawei Device Co., Ltd. ("Huawei") and LG Electronics, Inc. ("LG") (collectively, "Petitioner") filed a Petition requesting *inter partes* review of claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 of U.S. Patent No. 8,724,622 B2 (Ex. 1001, "the '622 patent"). Paper 1 ("Pet.").[1] Petitioner also filed a Motion for Joinder, seeking joinder as petitioner with Facebook, Inc. ("Facebook") and WhatsApp Inc. ("WhatsApp") (collectively, "Facebook 1667 Petitioner") in *Facebook, Inc. v. Uniloc Luxembourg S.A.*, Case No. IPR2017-01667 (the "Facebook 1667 IPR"). Paper 3 ("Mot."). Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). Patent Owner did not file an opposition to the Motion for Joinder.

We have authority under 35 U.S.C. § 314. Upon considering the information presented in the parties' papers, for reasons discussed below, we institute *inter partes* review of claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 of the '622 patent and grant Petitioner's Motion for Joinder.

II. DISCUSSION

A. Related Matters

The parties indicate that the '622 patent is involved in *Uniloc USA, Inc. v. LG Electronics U.S.A., Inc.*, No. 2:16-cv-00991-JRG (E.D. Tex.), and *Uniloc USA, Inc. v. Huawei Device USA, Inc.*, No. 2:16-cv-00994-JRG

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[1] The Petition identifies Huawei Device USA, Inc., Huawei Investment & Holding Co., Ltd., Huawei Technologies Co., Ltd., Huawei Device (Dongguan) Co., Ltd., LG Electronics U.S.A., Inc., and LG Electronics MobileComm USA, Inc., in addition to Petitioner entities Huawei and LG, as real parties in interest. Pet. 1.

(E.D. Tex.), among numerous other actions in the United States District Court for the Eastern District of Texas. Pet. 2–3; Paper 5, 2. 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; and Cases IPR2017-01797 and IPR2017-01798 (filed by Samsung Electronics America, Inc.), in which we instituted *inter partes* review on February 6, 2018. In addition, Google LLC formerly known as Google, Inc. ("Google") has filed petitions for *inter partes* review of certain claims of the '622 patent in Cases IPR2017-02080 and IPR2017-02081, in which Petitioner Huawei is listed as a real party in interest along with Google, Motorola Mobility LLC ("Motorola"), Huawei Technologies USA, Inc., Huawei Investment & Holding Co., Ltd., Huawei Technologies Co., Ltd., and Huawei Device (Dongguan) Co., Ltd. *See* IPR2017-02080, Paper 2 at 1; IPR2017-02081, Paper 2 at 1.

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.

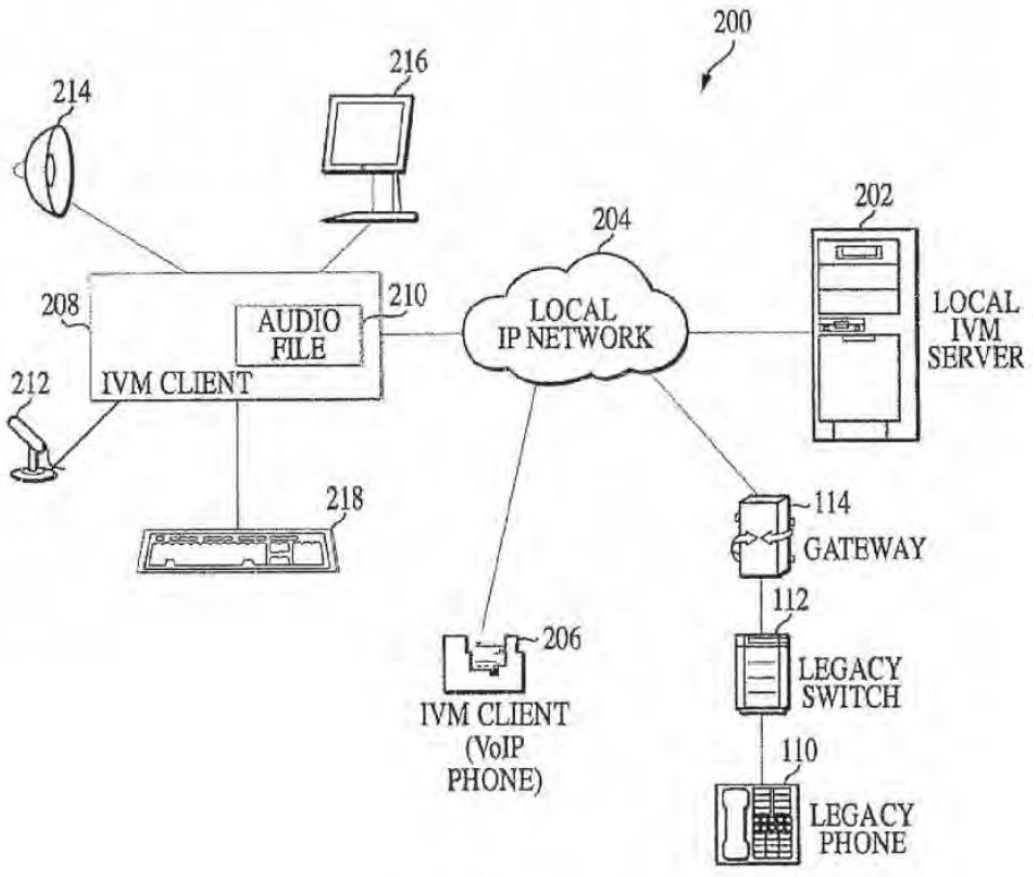

FIG. 2

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 recipients via local IP network 204. Ex. 1001, 8:15–29. "[O]nly the available IVM recipients, currently connected to . . . IVM server 202, will receive the instant voice message." *Id.* at 8:33–34. 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 8:34–39; *see id.* at 9:17–21. Upon receiving the instant voice message, the recipients can audibly play the message. *Id.* at 8:29–32.

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