UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MICROSOFT CORPORATION,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

_____

Case IPR2019-01559
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

Microsoft Corporation ("Petitioner") filed a Petition requesting *inter partes* review of claim 5 of U.S. Patent No. 8,724,622 B2 (Ex. 1001, "the '622 patent"). Paper 1 ("Pet."). Uniloc 2017 LLC ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp.").

We review the Petition under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). For the reasons that follow, we determine Petitioner has not established a reasonable likelihood that it would prevail in showing the unpatentability of the challenged claim. Therefore, we deny the Petition for an *inter partes* review.

II.   BACKGROUND

A. Related Matters

Petitioner indicates that the '622 patent is asserted in *Uniloc 2017 LLC v. Microsoft Corp.*, No. 8:19-cv-00780 (C.D. Cal.), as well as in thirty-four district court actions filed in the Eastern District of Texas. Pet. ix–xii; *see also* Prelim. Resp. 9–10; Paper 5, 2 ("PO Mand. Notice") (identifying a subset of those actions).

Concurrently with the filing of the instant Petition, Petitioner additionally filed a petition requesting *inter partes* review of claims 1, 2, 9, 36, and 37 of the '622 patent. IPR2019-01558, Paper 1.

The '622 patent also has been the subject of thirteen previous petitions for *inter partes* review filed by other petitioners, four of which petitions resulted in final written decisions in which certain claims of the '622 patent

were held to be unpatentable. *See* IPR2017-01667, Paper 37 (PTAB Jan. 16, 2019) ("1667/1668 Final Dec."; also filed as Paper 35 in IPR2017-01668) (concluding that claims 3, 6–8, 10–35, 38, and 39 of the '622 patent are unpatentable but that claims 4 and 5 had not been shown to be unpatentable); IPR2017-01797, Paper 32 (PTAB Jan. 31, 2019) ("1797/1798 Final Dec."; also filed as Paper 32 in IPR2017-01798) (concluding that claims 3, 4, 6–8, 10–19, 21–35, 38, and 39 of the '622 patent are unpatentable). Those decisions were appealed to the United States Court of Appeals for the Federal Circuit. *See* IPR2017-01667, Paper 40; IPR2017-01668, Papers 39, 41; IPR2017-01797, Paper 35; IPR2017-01798, Paper 35. The appeal from IPR2017-01667 and IPR2017-01668 remains pending, whereas the decision in IPR2017-01797 and IPR2017-01798 has been vacated by the Federal Circuit and remanded to the Board for proceedings consistent with the court's decision in *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019). *Uniloc 2017 LLC v. Samsung Elecs. Am., Inc.*, No. 2019-2165, Document 29 (Fed. Cir. Feb. 27, 2020).

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, code (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.
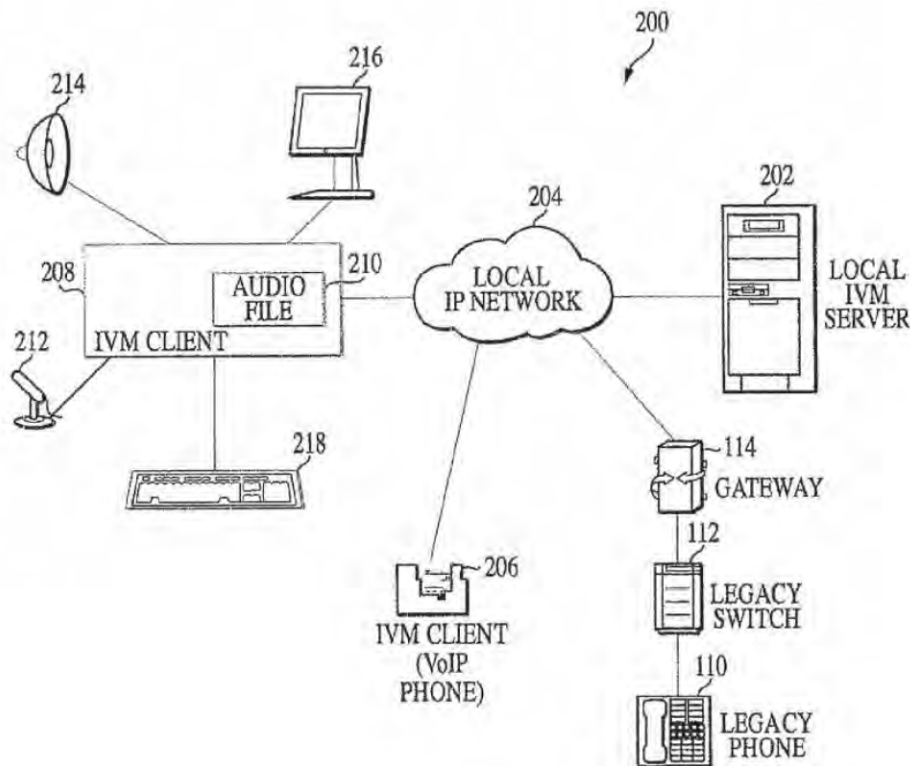

FIG. 2

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.
Ex. 1001, 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.

The '622 patent also describes an "intercom mode" of voice
messaging. *Id.* at 11:32–35. The specification states that the "'intercom
mode' represents real-time instant voice messaging." *Id.* at 11:35–36. 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.

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