AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-1313	11/28/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	HEYWIRE, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading		
	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1			
2			
3			
4			
5			

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
ORDERS that Plaintiff Uniloc's action against Defendant HeyWire, Inc. be and hereby is dismissed with prejudice

CLERK	(BY) DEPUTY CLERK	DATE
David A. O'Toole	ch	1/10/17

(Duplicate first page for exhibit labeling, per 37 C.F.R. § 42.63(d)(2)(ii).) this c

MICROSOFT CORP.
EXHIBIT 1002

AO 120 (Rev. 08/10)

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David A. O'Toole	ch	1/10/17

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

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Tel: 571-272-7822

Paper 32
Entered: January 31, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Cases IPR2017-01797 and IPR2017-01798
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a)

I. INTRODUCTION

Samsung Electronics America, Inc. ("Petitioner") filed a Petition in each of the captioned proceedings on July 20, 2017, collectively requesting *inter partes* review of claims 3, 4, 6–8, 10–19, 21–35, 38, and 39 of U.S. Patent No. 8,724,622 B2 ("the '622 patent"). IPR2017-01797, Paper 1 ("1797 Petition" or "1797 Pet."); IPR2017-01798 ("1798 Petition" or "1798 Pet."). Each proceeding challenges a different set of claims, as follows:

Proceeding	Challenged Claim Set of the '622 Patent
IPR2017-01797	3, 4, 6–8, 10–13, 18, 21–23, 27, 32, 34, 35, 38, and 39
IPR2017-01798	14–17, 19, 24–26, 28–31, and 33

See 1797 Pet. 1; 1798 Pet. 1. Patent Owner[1] filed a Preliminary Response to each Petition. IPR2017-01797, Paper 6; IPR2017-01798, Paper 6. We instituted *inter partes* review pursuant to 35 U.S.C. § 314 as to all challenged claims. IPR2017-01797, Paper 8 ("1797 Dec. on Inst."); IPR2017-01798, Paper 8 ("1798 Dec. on Inst.").

Subsequent to institution, Patent Owner filed a Patent Owner Response in each case. IPR2017-01797, Paper 12 ("1797 PO Resp."); IPR2017-01798, Paper 12 ("1798 PO Resp."). Petitioner then filed Replies. IPR2017-01797, Paper 17 ("1797 Reply"); IPR2017-01798, Paper 17

[1] Uniloc Luxembourg S.A. was initially identified as the owner of the '622 patent. *See, e.g.*, IPR2017-01797, Paper 3, 1. In Updated Mandatory Notices filed August 27, 2018, Uniloc 2017 LLC is identified as the owner of the '622 patent. IPR2017-01797, Paper 19; IPR2017-01798, Paper 19.

("1798 Reply"). Patent Owner also filed a Motion to Exclude as Paper 21 in each case ("Mot. Excl."), and Petitioner filed an opposition as Paper 24 ("Opp'n"). A transcript of the consolidated oral hearing held on October 30, 2018, has been entered into the record as Paper 31 in each case ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has shown by a preponderance of the evidence that claims 3, 4, 6–8, 10–19, 21–35, 38, and 39 of the '622 patent are unpatentable.

II. CONSOLIDATION OF PROCEEDINGS

The two captioned proceedings (IPR2017-01797 and IPR2017-01798) involve the '622 patent. Although each proceeding challenges the patentability of a different set of claims, there are disputed claim terms across the challenged claims and the primary prior art is identical. For instance, all the claims recite the term "instant voice message," which we construe below, and the "Griffin" and "Zydney" references (identified with particularity below) are asserted as prior art in both proceedings. Consolidation is appropriate where, as here, the Board can more efficiently handle the common issues and evidence and also remain consistent across proceedings. Under 35 U.S.C. § 315(d) the Director may determine the manner in which these pending proceedings may proceed, including "providing for stay, transfer, consolidation, or termination of any such matter or proceeding." *See also* 37 C.F.R. § 42.4(a) ("The Board institutes the trial on behalf of the Director."). There is no specific Board Rule that governs consolidation of cases. But 37 C.F.R. § 42.5(a) allows the Board to

determine a proper course of conduct in a proceeding for any situation not specifically covered by the rules and to enter non-final orders to administer the proceeding. Therefore, on behalf of the Director under § 315(d), and for a more efficient administration of these proceedings, we consolidate IPR2017-01797 and IPR2017-01798 for purposes of rendering this Final Written Decision in which we construe the term "instant voice message" and determine whether the asserted prior art teaches the properly construed "instant voice message."

III. BACKGROUND

A. Related Matters

The parties indicate that the '622 patent is involved in multiple district court cases, including *Uniloc USA, Inc. v. Samsung Electronics America, Inc.*, Case No. 2:16-cv-00641-JRG (E.D. Tex.). *See, e.g.*, 1797 Pet. 1–3; IPR2017-01797, Paper 19, 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, Inc. and WhatsApp Inc.), in which we instituted *inter partes* review on January 19, 2018; Cases IPR2017-02080 and IPR2017-02081 (filed by Google, Inc.), which we denied; Case IPR2017-02090 (filed by Huawei Device Co., Ltd. and LG Electronics, Inc.), in which we granted a motion for the petitioners' joinder with Case IPR2017-01667; and Cases IPR2018-00579 and IPR2018-00580 (filed by Apple Inc.), in which we granted motions for the petitioner's joinder with Cases IPR2017-01667 and IPR2017-01668,

respectively. We issued a consolidated Final Written Decision in Cases IPR2017-01667 and IPR2017-01668 on January 16, 2019, finding unpatentable claims 3, 6–8, 10–35, 38, and 39—but not claims 4 and 5—of the '622 patent. IPR2017–01667, Paper 37; IPR2017-01668, Paper 35 ("1667/1668 FD").

B. Overview of 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.

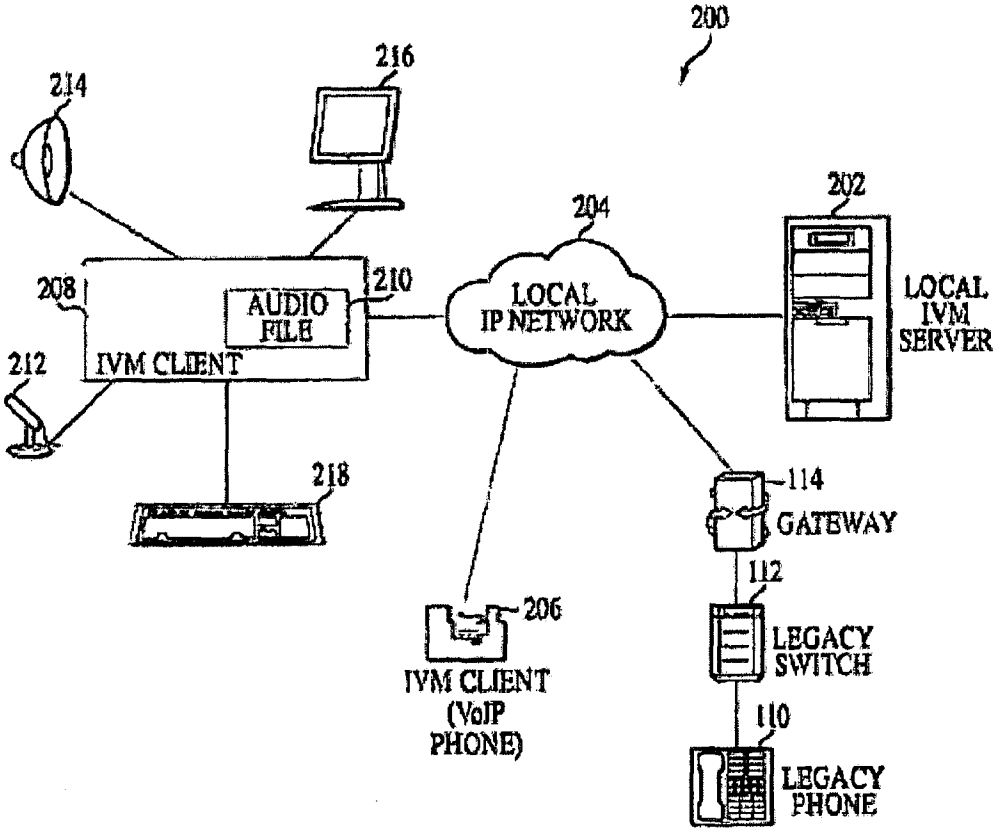

FIG. 2

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.

C. Illustrative Claim

Of the challenged claims, claims 3, 24, 27, and 38 are independent. Claims 3, 24, and 27 are illustrative of the challenged claims and are reproduced below.

3. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,
   wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and
   wherein the instant voice message includes an object field including a digitized audio file.

24. A system comprising:
a network interface connected to a packet-switched network;
a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,
wherein the messaging system receives connection object messages from the plurality of instant voice message client systems, wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems.

27. A system comprising:
a client device;
a network interface coupled to the client device and connecting the client device to a packet-switched network; and
an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,
wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message.

Ex. 1001, 24:12–27, 25:59–26:8, 26:17–30.

D. Evidence of Record

The Petitions rely on the following asserted prior art references:

a) *Griffin*: U.S. Patent No. 8,150,922 B2, issued Apr. 3, 2012 (filed in both IPR2017-01797 and IPR2017-01798 as Ex. 1005);

b) *Zydney*: PCT App. Pub. No. WO 01/11824 A2, published Feb. 15, 2001 (filed in both IPR2017-01797 and IPR2017-01798 as Ex. 1006);

c) *Aravamudan*: U.S. Patent No. 6,301,609 B1, issued Oct. 9, 2001 (filed in IPR2017-01797 as Ex. 1009);

d) *Vuori*: U.S. Patent App. Pub. No. 2002/0146097 A1, published Oct. 10, 2002 (filed in IPR2017-01797 as Ex. 1015);

e) *Clark*: U.S. Patent No. 6,725,228 B1, issued Apr. 20, 2004 (filed in IPR2017-01798 as Ex. 1007);

f) *Väänänen*: PCT App. Pub. No. WO 02/17650 A1, published Feb. 28, 2002 (filed in both IPR2017-01797 and IPR2017-01798 as Ex. 1008); and

g) *Low*: U.S. Patent App. Pub. No. 2003/0018726 A1, published Jan. 23, 2003 (filed in IPR2017-01798 as Ex. 1010).

Petitioner supports its contentions with the Declaration of Dr. Zygmunt J. Haas, filed as Exhibit 1002 in both proceedings ("Haas Decl."), and Patent Owner cites Declarations of William C. Easttom II, each filed as Exhibit 2001 in the respective proceedings ("1797 Easttom Decl." and "1798 Easttom Decl.," respectively). Mr. Easttom also has been the subject of cross-examination, and a transcript of his deposition addressing the '622 patent is filed in the record of each proceeding as Exhibit 1040.

E. Asserted Grounds of Unpatentability

We instituted *inter partes review* on the following grounds of unpatentability under 35 U.S.C. § 103.[2] 1797 Dec. on Inst. 34–35; 1798 Dec. on Inst. 42.

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[2] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112–29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. § 103, effective March 16, 2013. Because the patent application resulting in the '622 patent was filed

Challenged Claim(s)	References
3, 4, 6–8, 10, 11, 13, 18, 21–23, 27, 32, 34, 35, 38, and 39	Griffin and Zydney
11	Griffin, Zydney, and Vuori
12	Griffin, Zydney, and Aravamudan
14–17 and 28–31	Griffin, Zydney, and Clark
19 and 33	Griffin, Zydney, and Väänänen
24–26	Griffin, Zydney, and Low

IV. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b) (2017);[3] *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim interpretation

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before the effective date of the relevant section of the AIA, we refer to the pre-AIA version of § 103 throughout this decision.

[3] A recent amendment to this rule does not apply here because the Petition was filed before November 13, 2018. *See* Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018) (to be codified at 37 C.F.R. pt. 42).

standard to be applied in an *inter partes* review proceeding). Under the broadest reasonable interpretation standard, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We note that only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

In the Petitions, Petitioner argued that the Board need not construe the challenged claims for resolution of the controversy in these proceedings and that the challenged claims should be given their plain and ordinary meaning under the broadest reasonable interpretation standard. 1797 Pet. 8–9; 1798 Pet. 13. Neither party proposed a construction for any claim term in its pre-institution briefing, and we agreed with Petitioner that no terms required express construction for purposes of institution. 1797 Dec. on Inst. 7; 1798 Dec. on Inst. 8. In its Reply briefs, Petitioner contends that Patent Owner offers implied constructions of the terms "instant voice message" and "network interface." 1797 Reply 1–8; 1798 Reply 1–7. We address each of these terms in turn.

1. Instant Voice Message

Independent challenged claims 3, 27, and 38 recite the term "instant voice message." In particular, claim 3 recites a messaging system that "receives an instant voice message" from one of a plurality of instant voice message client systems, "wherein the instant voice message includes an

object field including a digitized audio file." Claims 27 and 38 recite a client platform system for "generating an instant voice message and a messaging system for transmitting the instant voice message." Claim 27 further requires an "instant voice messaging application" that "includes a document handler system for attaching one or more files to the instant voice message." Certain of the challenged dependent claims recite additional limitations concerning, for example, additional fields included in the instant voice message (claims 4, 6–8), storage, deletion, or retrieval of instant voice messages (claims 10, 14, 17, 28, 31), the generation of the instant voice messages (claims 13, 18, 32), encryption/decryption of instant voice messages (claims 19, 33), compression/decompression of instant voice messages (claim 34), effects indicating receipt of instant voice messages (claim 23, 35), and display of instant voice messages (claim 30).

As mentioned above, our Decision on Institution did not provide a construction for "instant voice message." Since our institution determination, however, we had occasion to revisit the claim term "instant voice message" in the present proceedings, as well as in related proceedings, such as IPR2017-01667 and IPR2017-01668, which, as noted above, also concern claims of the '622 patent. In the Patent Owner Responses in the present proceedings, Patent Owner raises two implied disputes concerning the term "instant voice message." First, Patent Owner appears to argue that the "instant voice message" must itself be an audio file. In particular, relying on testimony of Mr. Easttom that "the 'instant voice message' is recorded in [an] audio file" (1797 Easttom Decl. ¶ 51), Patent Owner argues that disclosure in the asserted prior art of "[i]ncluding attachments (in addition to a voice message) in a voice container . . . does not disclose or

suggest 'attaching one or more files to the instant voice message' itself." 1797 PO Resp. 21 (citing 1797 Easttom Decl. ¶¶ 50–58). Second, Patent Owner contends that "[i]nstant (or real-time) communication requires both instant (or real-time) transmission and instant (or real-time) receipt." *Id.* at 25. Patent Owner challenges Petitioner's assertion that a voice message is "instant" because it is a voice message *transmitted* in real time to an available recipient. *Id.* at 24–25 (citing 1797 Pet. 20–21).

Regarding Patent Owner's first argument, Petitioner responds that "the only reasonable reading of the disclosure of the '622 patent is that the term [instant voice message] refers to both the message object itself and the digitized speech (i.e., audio file) contained within the message object." 1797 Reply 2. Petitioner points out that the challenged claims themselves recite various data fields included within the claimed instant voice message, including "an object field including a digitized audio file" in claim 3 (Ex. 1001, 24:26–27), an "action field" in claim 4, a "source field" in claim 7, and a "destination field" in claim 8. *Id.* Additionally, Petitioner argues, claim 18 requires "creating an audio file for the instant voice message." *Id.* Based on this claim language, Petitioner contends, "[Patent Owner's] interpretation that the audio file *is* the claimed [instant voice message] makes no sense." *Id.* Instead, Petitioner asserts, the claimed instant voice message is a message containing audio and other data, corresponding to the description in the specification of "a 'message object' . . . as a message that 'comprises an action field, an ID field, a source field, a destination field, and an object field.'" *Id.* (quoting Ex. 1001, 14:6–7) (citing Ex. 1001, 14:7–10, 14:19–21, 14:36–40). Petitioner points out that the object field itself is described in the specification as "a block of data being carried by the

message object, which may be, for example, a digitized instant voice message," establishing that the instant voice message is not the audio file or contained within the audio file but is instead a message object that includes an audio file containing the digitized instant voice message, among other data. *Id.* at 2–3 (quoting Ex. 1001, 14:7–10). Thus, Petitioner proposes, "instant voice message" should be construed as "a message containing digitized speech (that is capable of being transmitted in real time to a recipient device)." *Id.* at 3.

Having considered the parties' respective arguments, we conclude that "instant voice message" is properly construed as "data content including a representation of an audio message," which is the construction that we previously adopted in our consolidated Final Written Decision in IPR2017-01667 and IPR2017-01668. 1667/1668 FD 19. In those cases, we explained that we were persuaded that the specification of the '622 patent describes the "instant voice message" as content in three different embodiments, specifically:

> First, in the "record mode" embodiment, by describing the "instant voice message" as an audio file (Ex 1001, 8:7–11, 8:26–27, 9:64–65, 10:38–39, 10:45–46, 12:40–41, 16:22, 17:23–24, 18:6–7, 18:58, 18:64–65, 19:46–47, 19:53), the '622 patent specification focuses on the digitized audio file itself being the "instant voice message." . . . The digitized audio file is the user's speech that the client records. *See* [*id.* at] 8:8–11. Second, in the "intercom mode," the specification describes buffering "successive portions of the instant voice message," referring thusly to portions of the user's speech that are written to a buffer. *Id.* at 11:35–44. Again, the "instant voice message" includes the digitized audio. In a third embodiment, the specification describes a "message object" with an object field in this manner: "The content of the object field is a block of data being carried by the message object, which may be, for example, a digitized

> instant voice message." *Id.* at 14:37–40. These embodiments, thus, paint a picture of the "instant voice message" as first and foremost being the content of the message, or the user's speech, in some digitized form. Although the manner in which the data content is partitioned, stored, and delivered may vary from embodiment to embodiment (such as from audio file to digitized audio in a buffer), what is important is that the "instant voice message" always refers to the digitized audio message. . . .
>
> . . . .
>
> From the description of the three embodiments identified above, we conclude that the "instant voice message" is data content, and more specifically, is data content that includes a representation of an audio message. In all embodiments, the "instant voice message" refers, at a minimum, to the digitized speech, regardless of whether it is contained in an audio file, successive portions stored in a buffer, or a block of data in an object field.

1667/1668 FD 15–17. We further explained, however, that the "instant voice message" is not *merely* an audio file (i.e., not only content), because the specification also describes non-audio-file uses of the term. For instance, the specification describes the "intercom mode" of instant voice messaging distinctly from the "record mode" (audio file embodiment). Ex. 1001, 7:57–61. "In the 'intercom mode,' *instead of creating an audio file 210*, one or more buffers (not shown) of a predetermined size are generated in the IVM client 206, 208 or local IVM server 202." *Id.* at 11:36–39 (emphasis added). This alternative to creating an audio file is further described as buffering successive portions of the instant voice message. *Id.* at 11:39–41. Therefore, although the specification consistently *relates* "instant voice message" to content, is does not limit that content to any particular form or structure (audio file or portions of digitized speech).

Regarding Patent Owner's second argument, Petitioner responds that the specification and claims of the '622 patent explain that a message can be an instant voice message even if it is not received by a recipient device in real time, because, for example, the specification and claims explain that, if a recipient device is not available, the instant voice message may be temporarily stored at a server for later delivery when the recipient becomes available. 1797 Reply 4 (citing Ex. 1001, 8:32–39, 9:17–21, 10:7–11, 10:52–56, 16:35–40, 17:32–36, 18:19–24, 19:6–11, 19:65–20:2, 24:61–25:3). According to Petitioner, these portions of the patent establish that instant voice messages need not always be received in real time. *Id.*

On this second issue, we agree with Patent Owner that merely transmitting the "instant voice message" in real time is insufficient to define the "instant" feature of an "instant voice message." The Background of the Invention purposely distinguishes a voice mail message from an "instant" text message. Ex. 1001, 2:22–46. In the voice mail message example, the specification describes the drawbacks of dialing a telephone number, and after a few more steps, finally "recording the message for *later pickup* by the recipient." *Id.* at 2:26–32 (emphasis added). In contrast, for an "instant" text message, a server presents the user with "a list of persons who are currently 'online' and *ready to receive* text messages on their own client terminals." *Id.* at 2:38–41 (emphasis added). "The text message is sent immediately via the text messaging server to the selected one or more persons and is displayed on their respective client terminals." *Id.* at 2:44–46. That is, with a voice mail message, a person on the receiving end, who admittedly was not *ready* to engage in a direct voice conversation, must take an active step to retrieve the recorded message, regardless of when

the message was recorded. In contrast, the "instant" text message is immediately transmitted *to the recipient*, which is *ready* to receive it, thus ensuring a speedy arrival. Thus, the specification distinguishes a voice mail message from the "instant" text message in that, although both messages are recorded and transmitted, only the "instant" text message, as the word "instant" implies, confers immediacy to its receipt by a ready recipient. The "instant" in the "instant voice message" imparts the same speedy receipt.

Our conclusion that an "instant" voice message must involve this immediate transmission and, likewise, speedy reception of the message is not diminished by embodiments that store the message at the server for later delivery. *See id.* at 8:35–39 ("[I]f a recipient IVM client is not currently connected to the local IVM server 202 (i.e., is unavailable), 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 202 (i.e., is available)."). Neither the sender nor the recipients can have any expectation with regard to the timing of the message's receipt when the recipients are *not online*, and thus, *not available* to receive the message. Indeed, this same embodiment carries out the "instant" capability by delivering the message stored at the server to the client, when the client connects to the server, thus becoming available to receive it. Consequently, we determine that an "instant voice message" is one that is transmitted in real time and received accordingly, *when the recipient is available.*

2. Network Interface

Independent challenged claims 3 and 24 recite "a network interface connected to a packet-switched network." Similarly, independent challenged claims 27 and 38 recite "a network interface coupled to [a] client

device and connecting the client device to a packet-switched network." Although Patent Owner does not offer a formal construction of the term "network interface," Patent Owner argues in its analysis of the prior art that the recited interface in each of the independent claims must be "directly" connected to the "packet-switched network." *See, e.g.*, 1797 PO Resp. 13–19. Petitioner responds that such a reading is contrary to the disclosure of the '622 patent and Patent Owner's expert's deposition testimony. 1797 Reply 6–8. First, according to Petitioner, the claim language does not recited the term "directly," but instead merely requires the network interface and the network to be "connected." *Id.* at 6. Petitioner contends, "[a]s confirmed by Mr. Easttom's deposition testimony, the specification supports this understanding by describing embodiments that 'facilitat[e] instant voice messaging according to the present invention' using a legacy telephone 110 that has an indirect connection to a packet-switched network through a [public switched telephone network] PSTN network." *Id.* (quoting Ex. 1001, 7:37–52) (citing Pet. 13; Ex. 1001, 1:66–2:21; Ex. 1040, 103:10–104:22). Further, "[o]ther portions of the specification also use 'connected to' to refer to indirect connections" (*id.* (citing Ex. 1001, 8:32–39, 9:17–21, 22:67–23:3)), and "Mr. Easttom confirmed this understanding of 'connected to' during his deposition," testifying that IVM client 208 in Figure 5 of the '622 patent "is 'connected to' IP Network (Internet) 102, even though Local IP Network 204 is interposed between IVM client 208 and network 102" (*id.* at 7 (citing Ex. 1040, 139:20–146:22; Ex. 1001, Fig. 5)). Similarly, Petitioner contends, when discussing Griffin, Mr. Easttom agreed that a network interface depicted in a figure of that reference is "connected to" a

router, where such connection has both a wireless carrier and a network interposed. *Id.* at 7–8 (citing Ex. 1040, 161:7–13; Ex. 1005, Figs. 2, 3).

Having considered the parties' respective arguments, we are persuaded, based on the evidence cited and reasoning articulated by Petitioner, which we hereby adopt, that the claim term "connected to" does not preclude an indirect connection. *See, e.g., id.* at 6–8; Ex. 1001, 7:37–52; Ex. 1040, 139:20–146:22, 161:7–13. We conclude, therefore, that the recited "network interface" in challenged claims 3, 24, 27, and 38 need not be *directly* connected to the recited packet-switched network. We do not find that any construction of that term otherwise is required for purposes of this Decision.

B. Analysis of the Asserted Grounds

1. General Principles

A claim is unpatentable for obviousness under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are "such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations).[4] *Graham v.*

[4] The parties do not address secondary considerations, which, therefore, do

John Deere Co., 383 U.S. 1, 17–18 (1966). Additionally, the obviousness inquiry typically requires an analysis of "whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue." *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2016) (requiring "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")).

To prevail on its challenges, Petitioner must demonstrate by a preponderance of the evidence that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). "In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid Tech., Inc.* 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify "with particularity . . . the evidence that supports the grounds for the challenge to each claim")). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC. v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review). Furthermore, Petitioner does not satisfy its burden of proving obviousness by employing "mere conclusory statements," but "must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness. *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

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not constitute part of our analysis.

2. Level of Ordinary Skill in the Art

Citing Dr. Haas's testimony, Petitioner proposes that a "person of ordinary skill in the art at the time of the alleged invention . . . would have had at least a bachelor's degree in computer science, computer engineering, electrical engineering, or the equivalent and at least two years of experience in the relevant field, e.g., network communication systems." 1797 Pet. 8 (citing Ex. 1002 ¶¶ 15–16); 1798 Pet. 8 (same). Petitioner further states that "[m]ore education can substitute for practical experience and vice versa." *Id.* Patent Owner's declarant, Mr. Easttom, similarly testifies that a person of ordinary skill in the art is "someone with a baccalaureate degree related to computer technology and 2 years of experience with network communication technology, or 4 years of experience without a baccalaureate degree." 1797 PO Resp. 7 (citing 1797 Easttom Decl. ¶ 17); 1798 PO Resp. 11–12 (citing 1798 Easttom Decl. ¶ 17).

The principal difference between the parties' proposed qualifications is that, as an alternative to an undergraduate degree and two years of relevant work experience, Patent Owner's proposal allows for a specific number of years of experience as a substitute for an undergraduate degree, while Petitioner's proposal is vague in this regard. Based on our review of the '622 patent and the prior art of record, we find that Patent Owner's proposal is more precise as it takes into account a level of experience of four years with network communication technology without the undergraduate degree. We, therefore, adopt Patent Owner's expression of the level of skill in the art, which encompasses both alternative sets of qualifications.

3. Scope and Content of the Prior Art

We discuss more fully certain disclosures in the asserted references in our analysis below. A discussion of those references follows.

a. Overview of Griffin

Griffin, titled "Voice and Text Group Chat Display Management Techniques for Wireless Mobile Terminals," relates to a technique of managing the display of "real-time speech and text conversations (e.g., chat threads) on limited display areas." Ex. 1005, [54], 1:9–11. Griffin discloses a wireless mobile terminal as shown in Figure 1, reproduced below.

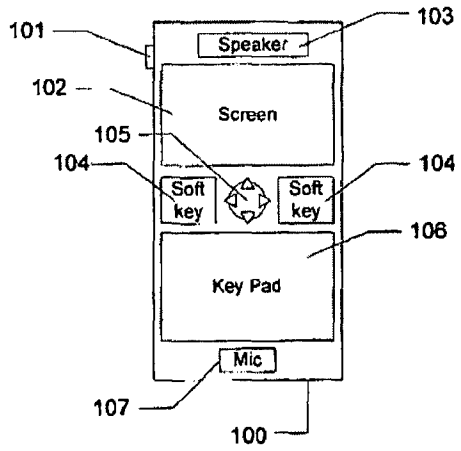

FIG. 1

Figure 1, above, depicts mobile terminal 100 comprising speaker 103 (which renders signals, such as received speech, audible), display 102 (for rendering text and graphical elements visible), navigation rocker 105 (which allows a user to navigate a list or menu displayed on the screen), microphone 107 (for capturing the user's speech), and push-to-talk button 101 (which allows the user to initiate recording and transmission of audio). *Id.* at 3:14–30. Griffin also describes, in connection with Figure 2, reproduced

below, the overall system architecture of a wireless communication system where the mobile terminals communicate with a chat server complex. *Id.* at 3:49–51.

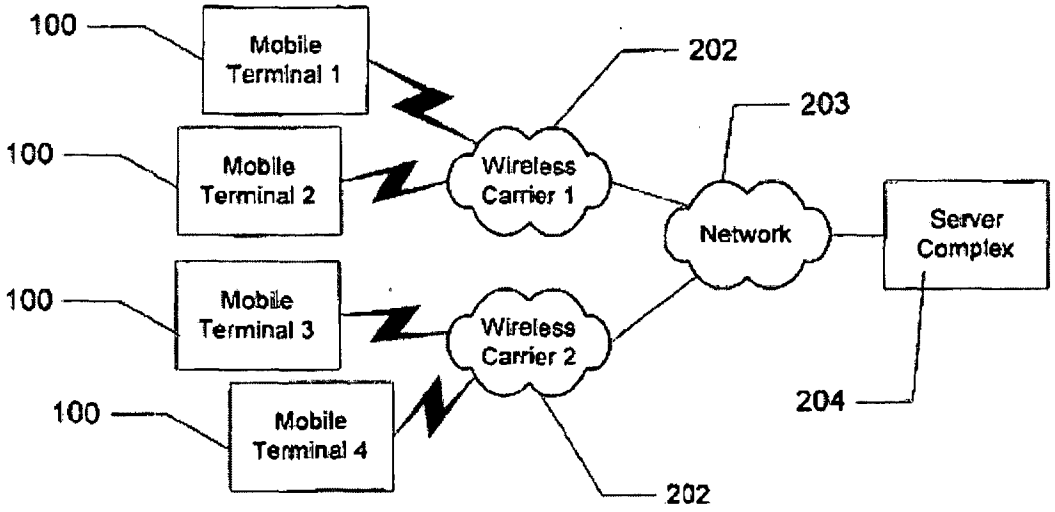

FIG. 2

Figure 2, above, illustrates wireless carrier infrastructures 202, which support wireless communications with mobile terminals 100, such that the mobile terminals wirelessly transmit data to a corresponding infrastructure 202 for sending the data packets to communication network 203, which forwards the packets to chat server complex 204. *Id.* at 3:49–61. Communication network 203 is described as a "packet-based network, [which] may comprise a public network such as the Internet or World Wide Web, a private network such as a corporate intranet, or some combination of public and private network elements." *Id.* at 3:61–65.

Griffin's chat server complex 204 receives encoded data comprising text, speech, and/or graphical messages (or some combination thereof), when a plurality of users chat together (i.e., send chat messages from one

terminal 100 to another). *Id.* at 4:11–15, 4:62–65. An outbound chat message, for example, is decomposed to locate the list of recipients, and the recipient's current status is determined. *Id.* at 5:9–15. Griffin describes presence status 702 as "an indicator of whether the recipient is ready to receive the particular type of message, speech and/or text messages only, etc.)." *Id.* "When presence status 702 changes, the presence manager 302 [of server complex 204] sends a buddy list update message 600 to all the subscribers listed in the subscriber identifier field 706 of the corresponding presence record 700." *Id.* at 5:27–30.

Griffin provides a buddy list display illustrated in Figure 9, reproduced below. *Id.* at 8:15–16.

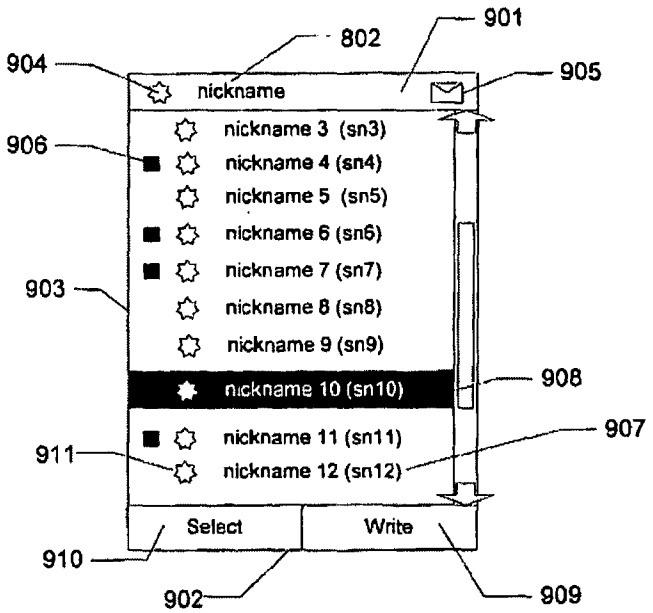

FIG. 9

Figure 9, above, depicts title bar 901, where inbound chat message indicator 905 is an icon accompanied by an audible sound when the icon is first displayed, indicating to the user that there is at least one unheard or

unread inbound chat message that has arrived at terminal 100. *Id.* at 8:17–18, 8:28–32. Left softkey 910, labeled "Select," permits selection of a particular buddy for chatting, which selection is indicated with selection indicator 906. *Id.* at 8:45–52, 8:60–67, 9:1–5. "If the user pushes-to-talk, the display switches to the chat history, and the user is able to record and transmit a speech message and consequently start a new thread with the selected buddies." *Id.* at 9:27–31.

b. Overview of Zydney

Zydney, titled "Method and System for Voice Exchange and Voice Distribution," relates to packet communication systems that provide for voice exchange and voice distribution between users of computer networks. Ex. 1006, [54], [57], 1:4–5. While acknowledging that e-mail and instant messaging systems were well-known text-based communication systems utilized by users of on-line services and that it was possible to attach files for the transfer of non-text formats via those systems, Zydney states that the latter technique "lack[ed] a method for convenient recording, storing, exchanging, responding and listening to voices between one or more parties, independent of whether or not they are logged in to their network." *Id.* at 1:7–17. Zydney, thus, describes a method in which "voice containers"—i.e., "container object[s] that . . . contain[] voice data or voice data and voice data properties"—can be "stored, transcoded and routed to the appropriate recipients instantaneously or stored for later delivery." *Id.* at 1:19–22, 12:6–8. Figure 1 of Zydney is reproduced below.

FIG. 1

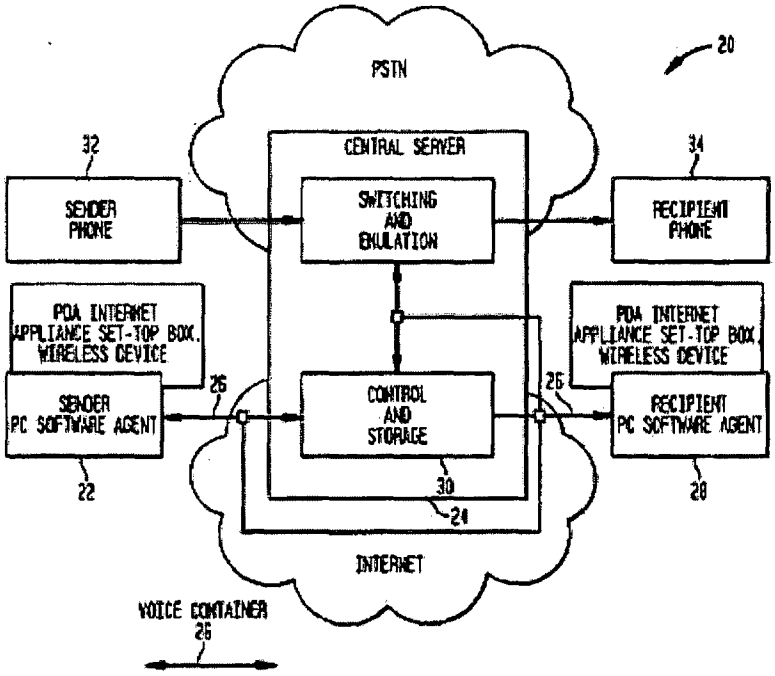

Figure 1, above, illustrates a high level functional block diagram of Zydney's system for voice exchange and voice distribution. *Id.* at 10:19–20. Referring to Figure 1, system 20 allows software agent 22, with a user interface, in conjunction with central server 24 to send messages using voice containers illustrated by transmission line 26 to another software agent 28, as well as to receive and store such messages, in a "pack and send" mode of operation. *Id.* at 10:20–11:1. Zydney explains that a pack and send mode of operation "is one in which the message is first acquired, compressed and then stored in a voice container 26 which is then sent to its destination(s)." *Id.* at 11:1–3. The system has the ability to store messages both locally and centrally at server 24 whenever the recipient is not available for a prescribed period of time. *Id.* at 11:3–6.

Zydney discloses that the voice container also has the ability to have other data types attached to it. *Id.* at 19:6–7. Formatting the container using Multipurpose Internet Mail Extension ("MIME") format, for example, "allows non-textual messages and multipart message bodies attachments [sic] to be specified in the message headers." *Id.* at 19:7–10.

Figure 3 of Zydney is reproduced below.

FIG. 3

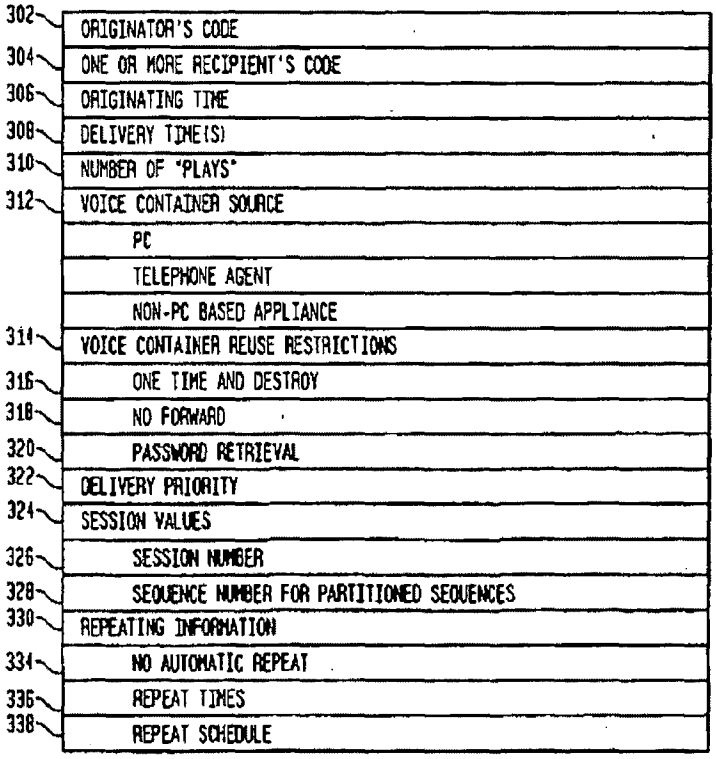

Figure 3, above, illustrates an exemplary embodiment of Zydney's voice container structure having voice data and voice data properties components. *Id.* at 2:19, 23:1–2. Referring to Figure 3, voice container components include the following:

> originator's code 302 (which is a unique identifier), one or more recipient's code 304, originating time 306, delivery time(s) 308, number of "plays" 310, voice container source 312 which may

> be a PC, telephone agent, non-PC based appliance, or other, voice container reuse restrictions 314 which may include one time and destroy 316, no forward 318, password retrieval 320, delivery priority 322, session values 324, session number 326, sequence number for partitioned sequences[] 328, repeating information 330, no automatic repeat 332, repeat times 334, and a repeat schedule 336.

Id. at 23:2–10.

c. Overview of Aravamudan

Aravamudan, titled "Assignable Associate Priorities for User-Definable Instant Messaging Buddy Groups," describes an instant messaging services platform in which a user is able to define rules for responding to received data and communications. Ex. 1009, [54], [57]. Figure 1 of Aravamudan is reproduced below.

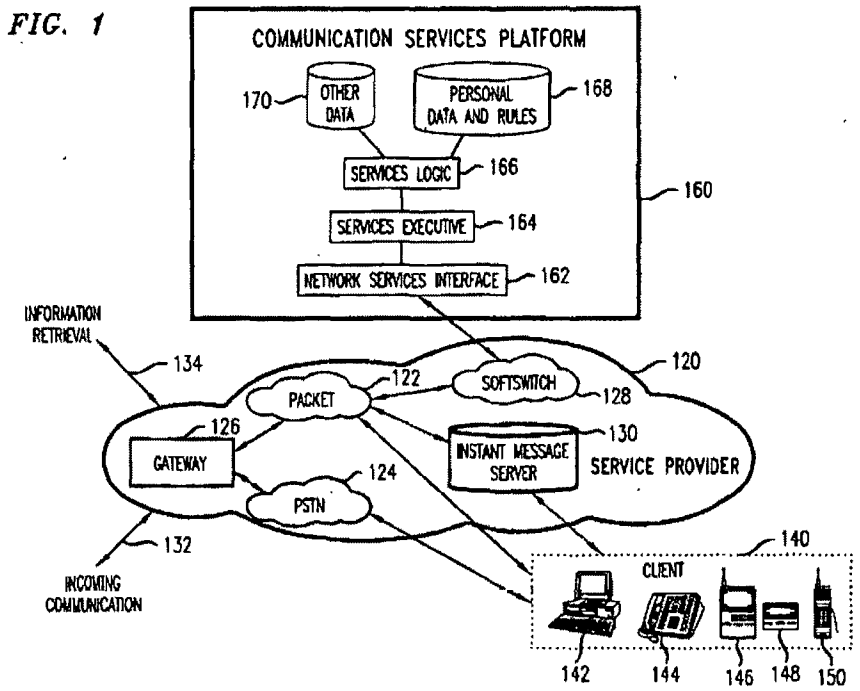

Figure 1, above, is a block diagram illustrating an exemplary architectural configuration of Aravamudan. *Id.* at 2:55–58. With reference

to Figure 1, communications services platform 160 comprises a number of client devices 140 connected to instant message ("IM") server 130. *Id.* at 4:59–64. Each client device's connection status (e.g., online/offline) is maintained on a database located on platform 160. *Id.* at 8:5–10.

Figure 7 of Aravamudan is reproduced below.

FIG. 7

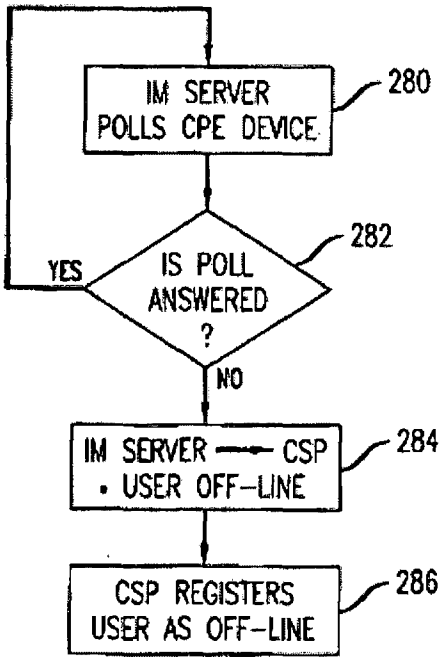

Figure 7, above, is a flow diagram of an exemplary method utilized to determine termination of a network session and update a Communication Services Platform (CSP) in accordance with Aravamudan's invention. *Id.* at 3:10–13. Specifically, to determine whether a user is online, IM server 130 periodically polls each client device 140. *Id.* at 8:5–19, Fig. 7 (step 280). If a user is online, the user's client device 140 returns a response. *Id.* at 8:19–21; Fig. 7 (step 282). If no response is returned, IM

server 130 determines that client device 140 is offline and updates the database to reflect the offline status of the device. *Id.* at 8:21–31, Fig. 7 (steps 284, 286).

d. Overview of Vuori

Vuori, titled "Short Voice Message (SVM) Service Method, Apparatus and System," discloses a method for sending voice-type short messages using an SVM service. Ex. 1015, [54], [57], ¶ 31. Vuori teaches that SVMs are "recorded in the sending terminal and sent to a[n] SVM service center (SVMSC)," and a "second terminal may then commence a bidirectional communication so that an instant voice message session can be established." *Id.* at [57].

In one embodiment, a user initiates a short voice message by pressing a menu key on a user equipment, which prepares to receive the message and may emit a sound to alert the user to commence speaking. *Id.* ¶ 32, Figs. 1–2. The user equipment then receives and stores the short voice message. *Id.* Next, the user "select[s] one or more intended recipients" and initiates the transfer. *Id.* ¶ 33. The short voice message is then sent to the SVMSC, which "check[s]" and "determines the availability of the one or more intended recipients." *Id.* ¶¶ 34, 50; *see id.* ¶ 37. The SVMSC sends the short voice message "immediately to the intended recipients who are available." *Id.* ¶ 34; *see id.* ¶ 50. For recipients who are not available, however, the SVMSC "temporarily stor[es]" the message and "continue[s] attempting to send [the message] . . . until the[recipients] become available or until a time out occurs." *Id.* ¶¶ 34, 51. Upon delivery of the short voice message, the recipient may play back the message. *Id.* ¶ 35, Figs. 1–2.

Vuori teaches that the SVM service may be carried out in a Global System for Mobile communications ("GSM") network as shown in Figure 3, reproduced below. *Id.* ¶ 37.

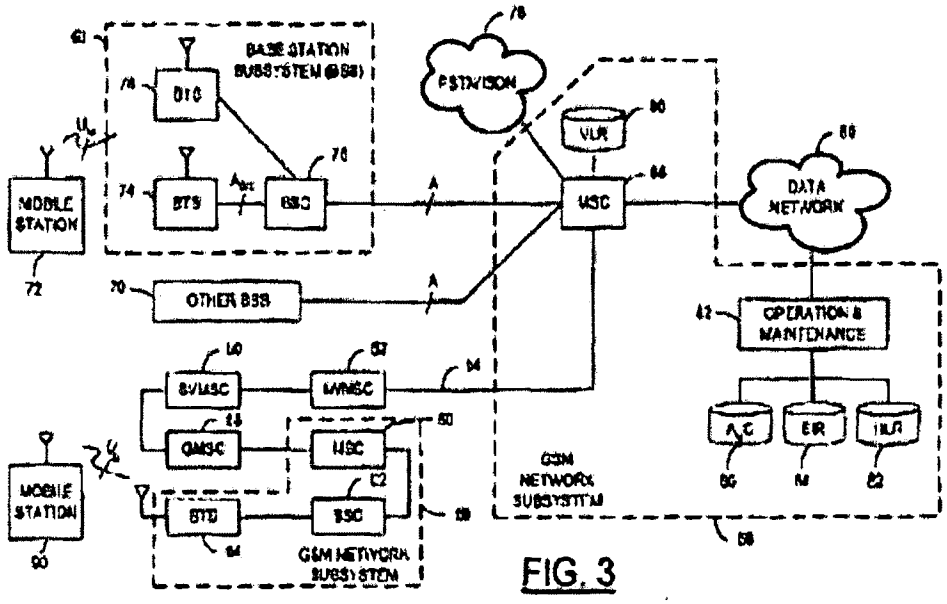

FIG. 3

Figure 3 of Vuori

In Figure 3, SVMSC 50 is shown along with interworking mobile switching center ("MSC") 52 connected by line 54 to GSM Network Subsystem 56. *Id.* Gateway 58 is provided for interworking between SVMSC 50 and MSC 58 of another GSM network 59. *Id.* Vuori explains that GSM Network Subsystem 56 also includes MSC 66 connected to a base station subsystem ("BSS") 68 as well as other base station subsystems 70 for communication with a plurality of mobile stations, but that only one mobile station 72 is shown in Figure 3. *Id.* According to Vuori, MSC 66 is also connected to public switched telephone network ("PSTN")/Integrated Services Digital Network ("ISDN") network 78 for allowing mobile stations to communicate with wired telephone sets in a circuit-switched manner, as

well as to a plurality of databases that may in turn be connected directly to MSC 66 or via data network 80 and operation and maintenance center 82. *Id.*

e. Overview of Clark

Clark, titled "System for Managing and Organizing Stored Electronic Messages," is directed to systems for managing and organizing electronic messages. Ex. 1007, [54], 1:8–9. According to Clark,

> A computer-based system catalogs and retrieves electronic messages saved in a message store. The system automatically organizes each saved message into multiple folders based on the contents and attributes of the message, and implements improved methods for manually organizing messages.

Id. at [57]. A particularly relevant embodiment in Clark is shown in Figure 4A, reproduced below.

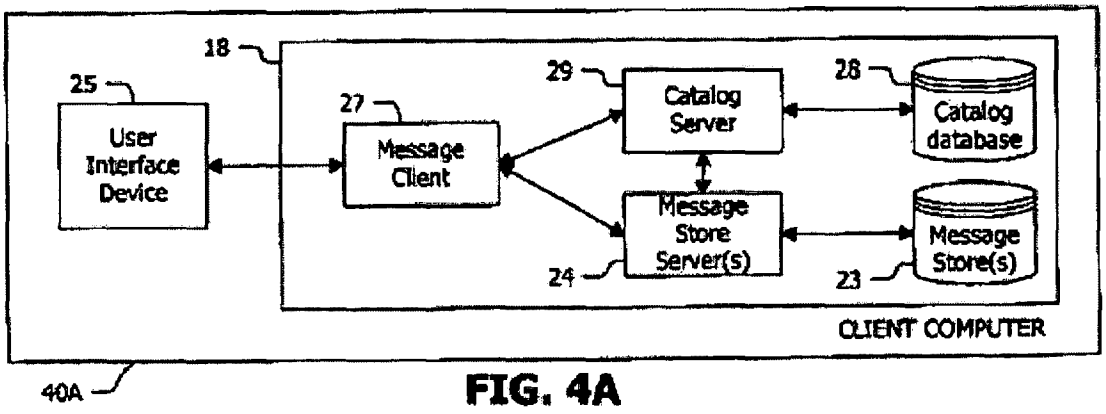

FIG. 4A

Figure 4A illustrates system 40A with client computer 18 implementing catalog server 29 and catalog database 28, and also including message client 27, message store 23, and message store server 24. *Id.* at 10:29–33. "Each message store 23 comprises a memory, file, or

database structure that provides temporary or permanent storage for the contained messages." *Id.* at 9:13–15. Clark describes providing catalog database 28 (and preferably catalog server 29) to organize the contents of one or more message stores 23. *Id.* at 9:54–56. Catalog database 28 and message store 23 may be separate from one another or may be integrated in a single message store. *Id.* at 11:1–3. In the embodiment where they are separate from each other, illustrated in Figure 5A (reproduced below), catalog database 28 may be linked to a separate external message store 23. *Id.* at 11:3–7.

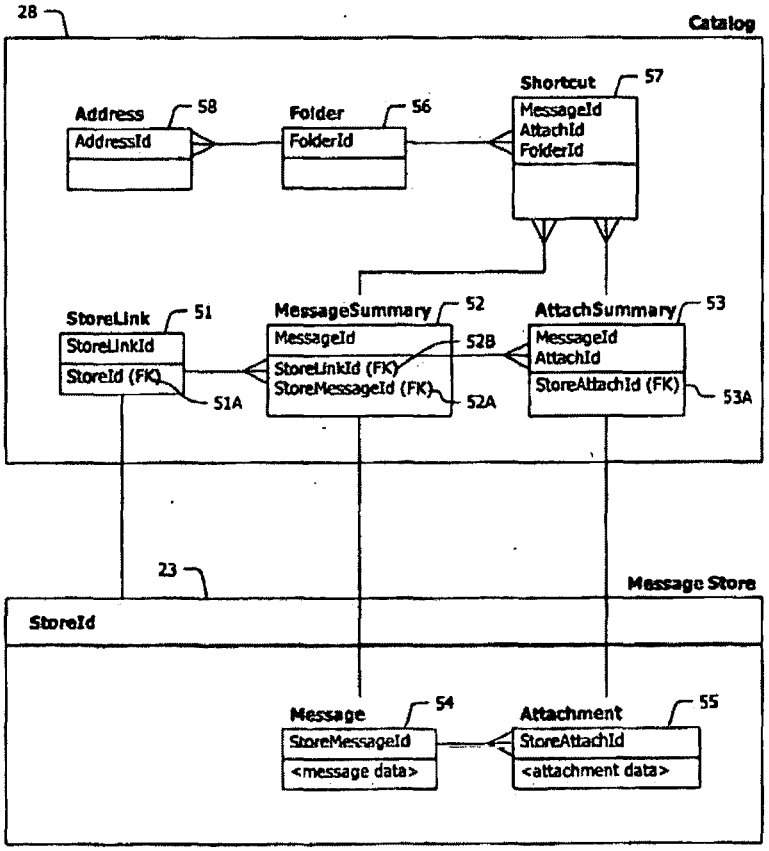

FIG. 5A

Figure 5A depicts the linking between catalog database 28 and external message store 23, where StoreLink table 51 contains rows, each with a StoreId pointing to a linked message store 23, and catalog database 28 includes MessageSummary table 52, which contains StoreMessageId 52A of messages in message store 23. *Id.* at 11:25–33. The Figure 5A embodiment also shows that messages 22 are stored in Message table 54 in message store 23 and that attachments are stored in Attachment table 55 in message store 23. *Id.* at 35–37.

f. Overview of Väänänen

Väänänen, titled "Voicemail Short Message Service Method and Means and a Subscriber Terminal," concerns instantaneous voice mail between Internet compatible computers, personal digital assistants, telephones, and mobile stations. Ex. 1008, [54], 1:4–6. Väänänen notes that prior art subscriber terminals did not allow the use of audio features with the Internet connection and that for prior art voicemail systems a specific voicemail central server was an essential requirement that introduced unnecessary network hardware. *Id.* at 1:26–2:2. The method of Väänänen, in one embodiment, is "arranged with a mobile station" (*id.* at 8:30), for example, a computer program within a SIM card in the mobile station (*id.* at 8:30–32, 16:9–12). A message recipient (or several recipients or group) may be chosen from the memory of the SIM card or the memory of the mobile station or is inputted into the mobile station. *Id.* at 9:1–4, 16:12–15. When a user presses a button on the mobile station, a data file is recorded, using a media player/recorded, from the dictation, voice, or video. *Id.* at 16:15–18. Figure 6, reproduced below, illustrates a user interface 600 of a subscriber terminal, such as a mobile station. *Id.* at 15:16–18.

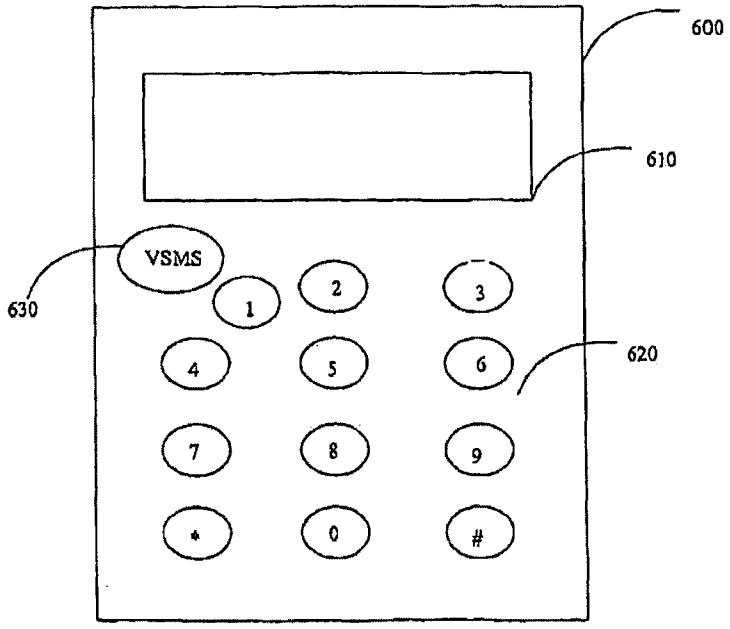

Figure 6 depicts user interface 600 including a voicemail short message service (VSMS) button 630 and a screen 610. *Id.* at 15:18–21, 16:2–4. The release of the VSMS button finishes the recording and sends the file with the message to the recipient or dials the telephone number of the recipient in order to playback the message to the recipient or to leave a voicemail with the message. *Id.* at 16:16–23. The recipient plays the packet stream in real time or reassembles the data file. *Id.* at 11:9–10.

g. Overview of Low

Low, titled "Instant Messaging," describes an instant messaging ("IM") process executed by an IM gateway in a communications network. Ex. 1010, [54], [57]. Figure 1 of Low is reproduced below.

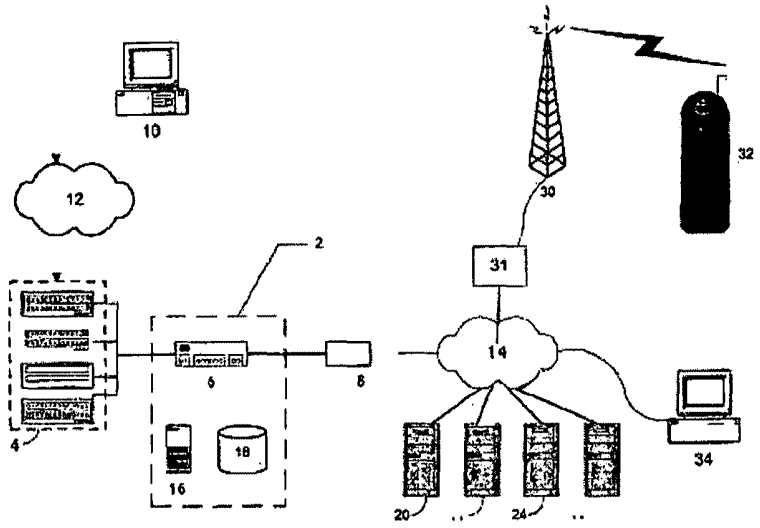

FIG. 1

Figure 1, above, illustrates an embodiment of an IM gateway within a network access system. *Id.* ¶ 20. As shown in Figure 1, IM gateway 2 is connected to communications network 14, such as the Internet, and is connected between IM clients (e.g., computer 10) and IM servers 20, 22, 24, 26 on network 14. *Id.* ¶¶ 27, 29. Low's system allows IM client users to monitor the presence of other users on the system in order to exchange messages and files. *Id.* ¶¶ 4, 27, 29. "IM gateway 2 processes the IM packets received from different IM clients in order to allow them to communicate with one another, notwithstanding the fact that they use a different IM protocol." *Id.* ¶ 29. The IM clients can send commands to IM gateway 2 to change "the user's state or presence" on the IM network, such to log into and out from the network. *Id.* ¶¶ 39, 42. An IM state change process in IM gateway 2 then forwards the commands to switch 6 in IM gateway 2, which in turn sends the command to an appropriate IM server (e.g., authentication server 20). *Id.* ¶ 42.

4. Analysis of Claims 3, 4, 6–8, 10–13, 18, 21–23, 27, 32, 34, 35, 38, and 39

In IPR2017-01797, Petitioner contends that claims 3, 4, 6–8, 10, 11, 13, 18, 21–23, 27, 32, 34, 35, 38, and 39 are unpatentable over the combination of Griffin and Zydney; that claim 11 alternatively is unpatentable over the combination of Griffin, Zydney, and Vuori; and that claim 12 is unpatentable over the combination of Griffin, Zydney, and Aravamudan. 1797 Pet. 9–78. We address first whether Petitioner has demonstrated by a preponderance of the evidence that independent claims 3, 27, and 38 would have been obvious over the combination of Griffin and Zydney, and then we turn to the dependent claims.

a. Independent Claim 3

Petitioner contends Griffin discloses all limitations of independent claim 3, with the exception of "a communication platform system maintaining connection information . . . indicating whether there is a current connection to each of the plurality of instant voice message client systems" and the instant voice message including an object field "including a digitized audio file," for which limitations Petitioner relies on the combined teachings of Griffin and Zydney. 1797 Pet. 9–30. Petitioner also cites Zydney's disclosure of agents 22, 28 and server 24 as being "directly connected to a packet-switched network (e.g., Internet)" in support of an alternative mapping with respect to claim 3's "network interface connected to a packet-switched network." *Id.* at 13–14. Petitioner supports its arguments, including reasons that a person of ordinary skill in the art would have combined the teachings of Griffin and Zydney, with Dr. Haas's testimony.

Patent Owner raises four principal arguments in response to Petitioner's contentions with respect to claim 3. 1797 PO Resp. 8–21, 24–36. Specifically, Patent Owner argues that Petitioner fails to prove that the Griffin/Zydney combination renders obvious "wherein the instant voice message includes an object field including a digitized audio file" (the "object field" limitation); "a network interface connected to a packet-switched network" (the "network interface" limitation); and "a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems" (the "communication platform system" limitation). *Id.* at 8–21. Patent Owner also argues that Petitioner has failed to provide sufficient motivation to combine Griffin and Zydney as proposed. *Id.* at 24–36). We address these arguments in turn.

"object field" limitation

With respect to the disputed claim 3 limitation "wherein the instant voice message includes an object field including a digitized audio file," Petitioner contends that, although Griffin does not expressly disclose that the data contained in field 406 when message 400 is a speech message is a "digitized audio file," it would have been obvious to a person of ordinary skill in the art to modify Griffin to include such a digitized audio file in view of Zydney's teaching, for example, that a client software agent in a sender device generates a voice message by "digitally recording," compressing, and storing the user's speech as an MP3 audio file before packing that audio file into a voice container. 1797 Pet. 28–29 (citing Ex. 1002 ¶¶ 150–156; Ex. 1006, 12:6–8, 14:2–5, 16:1–4, 21:15–18, 23:1–11, 39:16). Petitioner

points out that Zydney also explains that the voice container can be formatted using the MIME standard, "which 'allows for non-textual messages and multipart message bodies [sic] attachments to be specified in the message headers.'" *Id.* at 29 (quoting Ex. 1006, 19:7–10) (citing *id.* at 19:13–20:9). Relying on Dr. Haas's testimony, Petitioner contends that, in view of these teachings and the knowledge of a person of ordinary skill in the art, such a person "would have been motivated to modify Griffin's system/process such that outbound message 400 ('instant voice message') includes an object field (similar to field 406) having a digital audio file of speech data, similar to as described in Zydney," and also "would have recognized that such a modification would have been nothing more than a simple substitution of one known and commonly-used technology for another (e.g., a digital audio file in place of other forms of data) to achieve [a] predictable result." *Id.* (emphasis omitted) (citing Ex. 1002 ¶¶ 151–153).

Patent Owner responds that Griffin does not expressly disclose that its "speech message" is included within message content 406, but instead "describes message content 406 only as displayable text information pertaining to either a text or speech message." 1797 PO Resp. 8–9 (emphasis omitted) (citing Ex. 1005, 6:38–43, 10:53–65, Figs. 4, 11). With reference to Figure 11 of Griffin, for example, Patent Owner contends Griffin provides only "a generic character string or symbol [that] is used to indicate that the message was a voice message." *Id.* at 10 (quoting Ex. 1005, 10:41–43). According to Patent Owner, "regardless whether a message is classified as speech or text, Griffin does not expressly or inherently disclose that 'message content 406' can itself include anything other than displayable text," and, Patent Owner contends, "this would lead a [person of ordinary

skill in the art] away from attempting to modify Griffin's text-based 'message content 406' to include, instead, a digitized audio file (i.e., something other than displayable text)." *Id.* Further, Patent Owner contends, Petitioner has not established that message content 406 "must . . . necessarily" be configured to include non-displayable "speech data for a speech message" to support an inherency argument. *Id.* Patent Owner also contends, "[t]here is likewise no merit to Petitioner's alternative argument . . . that '[e]ven if Griffin could be read such that the speech data is not contained in field 406, . . . the speech data would nevertheless disclose the claimed "object field."'" *Id.* at 11 (quoting 1797 Pet. 27). According to Patent Owner, "Petitioner's presentation of two mutually-exclusive possibilities is a tacit admission that an 'object field' as claimed is *not necessarily* present in either." *Id.* at 12 n.4. Finally, citing the Board's decision not to institute *inter partes* review based on a petition filed by a different petitioner, Patent Owner argues "Petitioner's co-defendants failed to raise a similar inherency argument with respect to *Zydney* in related matters also challenging claim 3 . . . ." *Id.* at 12–13 (citing IPR2017-02080, slip op. at 17 (PTAB Mar. 19, 2018) (Paper 10)).

Patent Owner's arguments notwithstanding, we are persuaded by Petitioner's arguments and evidence that the combination of Griffin and Zydney teaches the recited "object field" limitation. As Petitioner points out in its Reply, Patent Owner "does not specifically contest Petitioner's argument that it would have been obvious 'to modify *Griffin*'s system/process such that outbound message 400 . . . includes an object field (similar to field 406) having a digital audio file of speech data, similar to as described in Zydney.'" 1797 Reply 10 (quoting 1797 Pet. 28–30). As

Petitioner notes, we indicated in our Institution Decision in this case that we were persuaded by that argument on the record then before us. *Id.* (citing 1797 Dec. on Inst. 25–27). With no substantive rebuttal of that argument in the full record now before us, we remain persuaded. Contrary to Patent Owner's contentions, no resort to inherency is required here, as we are persuaded by Petitioner's contentions regarding the combined teachings of Griffin and Zydney. 1797 Pet. 28–30; *see also* Ex. 1002 ¶¶ 154–155 (Dr. Haas explaining why a person of ordinary skill in the art would have been motivated to modify Griffin as proposed by Petitioner). We also credit Dr. Haas's testimony that a person of ordinary skill in the art would have understood message content field 406 of message 400 would contain speech for a speech chat message and that it would have been obvious to have included this speech data in field 406 in the form of "digitized audio file" in view of Zydney, as well as in view of Griffin's express disclosure that "message type" 401 can be "speech" rather than "text." Ex. 1002 ¶¶ 147–148, 150–156; Ex. 1005, 6:39–44.[5]

"network interface" limitation

Regarding the "network interface" limitation, Petitioner contends that neither the claims nor the specification of the '622 patent requires the recited network interface to be "directly" connected to a packet-switched network, but that they instead contemplate an indirect connection. 1797 Pet. 12–13.

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[5] Although Patent Owner correctly observes that we denied institution of *inter partes* review of claim 3 on a Zydney-based ground in IPR2017-02080, we also found, in contrast, that the petitioners in IPR2017-01667 established by a preponderance of the evidence that Zydney renders obvious the "object field including a digitized audio file" of claim 3. 1667/1668 FD 45–53.

Nonetheless, Petitioner contends, even if the claim imposed such a requirement, it would have been obvious for a person of ordinary skill, in view of Zydney's teachings, to modify Griffin's system such that mobile terminal 100 is directly connected to network 203. *Id.* at 13. Petitioner argues that a person of ordinary skill in the art would have been aware of many well-known benefits of using a direct connection, rather than the indirect connection taught in Griffin. *Id.* at 15. For example, according to Petitioner, a person of ordinary skill in the art would have known that a direct connection would have provided a more reliable and faster transfer speed, and allowed for unimpeded communication in the event that the wireless carrier network is slow or unavailable. *Id.* (citing Ex. 1002 ¶ 111). According to Petitioner, a person of ordinary skill in the art would also have understood that direct and indirect connections to a packet-switched network, such as network 203 of Griffin, would have been complementary technologies. *Id.* We agree with Petitioner in both regards.

First, as discussed in Section IV.A.2. above, we agree there is no requirement that the network interface recited in the challenged independent claims must be "directly" connected to the recited packet-switched network. Patent Owner's arguments that Petitioner has failed to prove that the combination of Griffin and Zydney renders obvious the recited network interface are premised on a contention that the network interface recited in each of the independent claims must be "directly" connected to the "packet-switched network" (*see* 1797 PO Resp. 13–18), a position that we find unmeritorious.

Second, we are persuaded by Petitioner's arguments and supporting evidence that it would have been obvious to a person of ordinary skill in the

art to connect Griffin's network interface 306 directly to network 203 in view of Zydney's teachings. *See id.* at 13–16 (citing, e.g., Ex. 1002 ¶¶ 31–41, 48–51, 71–76, 106–114; Ex. 1006, 10:19–11:6, 11:14–20, 17:5–9, 26:1–2, Figs. 1, 2).[6] In this regard, we credit the testimony of Dr. Haas that a person of ordinary skill in the art would have understood the benefit of Griffin's mobile terminal communicating directly to communication network 203 (Internet) for achieving a communication that is faster and more reliable than an indirect connection through a wireless carrier network. Ex. 1002 ¶¶ 110–111. Zydney provides evidence that the method of connecting directly to the Internet via a PC with appropriate software was known, and we credit Dr. Haas's testimony that the technology for a mobile terminal to connect directly to a packet-switched network was well-known at the time of the invention and that it was within the level of ordinary skill to incorporate such a technology, e.g., Ethernet card, to a Griffin mobile terminal. Ex. 1002 ¶ 113. Such a combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *KSR*, 550 U.S. at 416.

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[6] Petitioner also poses yet another alternative mapping, of Griffin alone, to the recited "network interface," based on Griffin's disclosure of server 204 being directly connected with network 203 for communicating with terminals 100, where messages flow into server 204 via its router 301. 1797 Pet. 16 (citing Ex. 1002 ¶¶ 115–117; Ex. 1005, 3:51–61, 4:61–5:15, 6:56–7:17, Figs. 2, 3). Because Figure 2 of Griffin shows that server 203 is directly connected to network 203, Petitioner contends router 301 comprises a network interface providing connectivity to network 203. *Id.* (citing Ex. 1002 ¶ 117; Ex. 1005, 3:59–65, Fig. 2). Because we find that Griffin in view of Zydney teaches the recited network interface under either of Petitioner's first two theories, we do not consider this additional alternative theory any further.

The testimony of Dr. Haas evidences that a person of ordinary skill in the art had the knowledge, capability, and motivation to make the combination, and that the combination of Griffin's networks with Zydney's teachings would have resulted in each network performing as they had been known to perform. Ex. 1002 ¶¶ 112–114. In comparison, we give little weight to Patent Owner's attorney argument that there would have been insufficient motivation to modify Griffin, based on an alleged teaching away resulting from Griffin's statement that "the wireless carrier infrastructures 202 comprise those elements necessary to support wireless communications with the terminals 100." 1797 PO Resp. 18–19 (emphasis omitted).

A reference teaches away "when a person of ordinary skill in the art, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1069 (Fed. Cir. 2018). A reference does not teach away "if it merely expresses a general preference for an alternative invention but does not 'criticize, discredit, or otherwise discourage' investigation into the invention claimed." *Id.* Here, we agree with Petitioner that, read in context, the sentence of Griffin relied upon by Patent Owner is merely describing the elements necessary for wireless communication "within a wireless carrier's infrastructure 202," and does not "teach[] away from the proposed modification" or lead to the conclusion that the modification would not "operate as intended," as Patent Owner contends. 1797 Reply 12 (citing Ex. 1005, 3:51–59; 1797 PO Resp. 18–19). Although Griffin describes the wireless carrier infrastructure as being necessary for the mobile terminals to communicate with each other, or in some embodiments, with the server,

Griffin is silent as to whether the mobile terminal is or is not *also* capable of communicating directly with communication network 203. That is, Griffin does not preclude inquiring as to whether the mobile terminal would communicate directly with the communication network 203, much like Zydney's PC, PDA, or other Internet-compatible appliance is capable of logging on to the connected Internet-based network and server.

Indeed, as Petitioner points out, Griffin also explains that its mobile terminal 100 may be a "cellular phone" or "PDA," which are the same types of devices that Zydney demonstrates can be directly connected to a packet-switched network (1797 Reply 12 (citing Ex. 1005, 3:14–17; Ex. 1006, 11:16–18, Fig. 1a); Pet. 13–14), and Patent Owner's own expert, Mr. Easttom, also explained that such devices could directly connect to packet-switched networks (e.g., a Wi-Fi network) and that it would have been desirable to do so because data usage through a mobile carrier network was very expensive (Ex. 1040, 101:11–103:6). Thus, at best, Griffin leaves open the question of whether mobile terminals could communicate directly with network 203 if there was a desire to do so. Griffin does not, however, *discourage* a person of ordinary skill in the art from bypassing the wireless carrier network, if an *alternative*, more beneficial direct connection with network 203 is desired. Here we note that Petitioner's theory of obviousness does not rely solely on replacing or substituting the wireless carrier infrastructure with a packet-switched network. The Petition conveys the contention that a person of ordinary skill in the art would have understood the benefits of directly connecting to network 203, instead of *or in addition to* an indirect connection via infrastructure 202. 1797 Pet. 15 (citing Ex. 1002 ¶ 111). As we understand the combination, the resulting Griffin

mobile terminal would therefore use a wireless link to the wireless carrier infrastructure for cellular communications, and another wireless link to network 203 for data packet communications (such as via Wi-Fi). There is no teaching in Griffin that would teach away from such a mobile terminal. The testimony of record, which we credit, shows the opposite—i.e., that there is a benefit to not using the wireless carrier infrastructure for data communications because that infrastructure is slower, less reliable, and more expensive to use than network 203. Ex. 1002 ¶ 111; Ex. 1040, 101:11–103:6.

"communication platform system" limitation

Noting that neither claim 3 nor the specification of the '622 patent recites any particular structure for the recited "communication platform," Petitioner contends that Griffin in view of Zydney discloses a component and/or functionality that performs the recited functions thereof. 1797 Pet. 21–22 (citing Ex. 1001, 14:64–15:3; Ex. 1002 ¶¶ 128–144). As an initial matter, Petitioner points out that Griffin's presence manager 302 maintains a plurality of "presence data records 700" for terminals 100, which Petitioner maps to the recited "instant voice message client systems," as shown in Figure 7 of Griffin, reproduced below. *Id.* at 22 (citing Ex. 1005, 4:62–5:2, 5:11–30, Fig. 7).

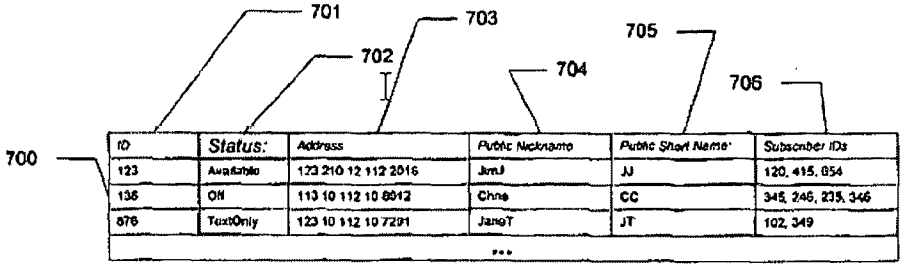

FIG. 7

Figure 7, above, is a table that illustrates the data contained in a presence manager in accordance with Griffin's invention. Ex. 1005, 2:57–58. Petitioner explains that each data record 700 in Figure 7 corresponds to one of a plurality of terminals 100, each identified by identifier 701. 1797 Pet. 23 (citing Ex. 1002 ¶¶ 130–133). Presence manager 302 tracks changes to each terminal 100's current status (listed in column 702 in Figure 7), indicating whether the terminal 100 is available to receive messages, and informs other terminal of such changes. *Id.* (citing Ex. 1005, 5:15–22, 5:27–30, 7:39–42, 7:48–49, 8:1–8, Fig. 6). Petitioner concedes that Griffin does not provide additional details "regarding what precisely current status 702 indicates." *Id.* at 23. Citing Dr. Haas's testimony, Petitioner alleges, nevertheless, that it would have been obvious to configure the system based on Zydney's teachings so that status 702 includes connectivity information indicating whether terminal 100 is currently connected to server 204. *Id.* (citing Ex. 1002 ¶¶ 135–144). In particular, Petitioner cites Zydney's disclosure that central server 24 maintains and conveys the connectivity status of each agent in the network, where connectivity status includes "the core states of whether the recipient is online or offline . . . ." *Id.* (quoting Ex. 1006, 14:22–15:1) (citing Ex. 1006, 13:12–14, 14:6–9, 14:17–5:1, 30:13–15, 32:9–33:2; Ex. 1002 ¶¶ 136–137).

Patent Owner disputes Petitioner's assertions, arguing that "[t]he cited portions of Zydney do not expressly state that the alleged 'connectivity information' indicates whether there is a *current* connection to each of the plurality of instant voice message systems." 1797 PO Resp. 20. Instead, according to Patent Owner, "Zydney's central server 24 passively waits to receive random status information notifications from the software agents"

and "would not maintain the current connectivity status, for example, in instances where the actual connectivity status of software agent changes due to circumstances other than the user entering status information into the software agent (e.g., an unanticipated power outage)." *Id.* at 20–21 (citing Ex. 1006, 14:3–4, 14:20–21, 31:13–15).

In its Reply, Petitioner persuasively rebuts Patent Owner's contentions, pointing out those contentions are unsupported and at odds with positions taken elsewhere in the Patent Owner Response regarding Zydney's teachings. 1797 Reply 13 & n.4 (citing 1797 PO Resp. 31–33). As Petitioner correctly explains, prior art need not recite exactly the same words as the claim. *Id.* at 13. Here, despite the fact that Zydney does not use the word "current," we find no support for Patent Owner's attorney argument that Zydney's system "passively waits" to receive status information notifications and therefore does not maintain "current" status. *Cf.* 1797 PO Resp. 20. As Petitioner quotes, Zydney expressly states that central server "*track*[*s*] and maintain[s] the status of all software agents." Ex. 1006, 14:8–9 (emphasis added), *cited at* 1797 Pet. 23; 1797 Reply 13–14. Moreover, we note that Petitioner relies on the combined teachings of Griffin and Zydney, not on Zydney alone, and the portion of Griffin relied upon itself discloses that Figure 7 includes, among other things, "the *current* status." Ex. 1005, 5:18.

Accordingly, we are persuaded, for the reasons stated by Petitioner and discussed above, that Petitioner has established by a preponderance of the evidence that Griffin in view of Zydney teaches the recited communication platform system.

motivation to combine

Patent Owner argues that, for several reasons, a person of ordinary skill in the art would not have combined Griffin and Zydney as asserted by Petitioner. 1797 PO Resp. 24–36. For the reasons discussed below, we find that a preponderance of the evidence shows a person of ordinary skill in the art would have found it obvious to combine the teachings of Griffin and Zydney in the manner contemplated by Petitioner.

First, Patent Owner contends that that combination of Griffin and Zydney is inoperable for "text-only buddies" supported by Griffin alone. *Id.* at 26–28. According to Patent Owner,

> replac[ing] *Griffin*'s status 702 with availability/unavailability as understood by *Zydney* would result in an inoperable system, at least for text-only buddies. [1797 Easttom Decl.] ¶¶ 62–64. A Text-only buddy connected to the server complex 204 would be considered "available" as understood by *Zydney* simply by virtue of having an Internet connection (e.g., that enables communication with the server complex 204), and would therefore be available for selection as a recipient of a speech message. *Id.* However, *Griffin* does not disclose or even contemplate, what would happen if a text-only buddy were to be selected to receive a speech message. *Id.*

1797 PO Resp. 26. Patent Owner further contends, "[e]ven a single text-only buddy is enough to destroy any proposed rationale for combining Griffin and Zydney." *Id.* at 27. We do not agree with Patent Owner's arguments.

The combination of Griffin and Zydney does not do away with Griffin's current status of "text-only" capability. The combination of teachings adds to Griffin's "Available" and "Off" statuses the meanings ascribed to the "Available" and "Not logged on" statuses of Zydney. *See*

Ex. 1002 ¶ 135 (Dr. Haas's opinion that "a person of ordinary skill in the art at the time of the alleged invention would have been motivated to configure status 702 to include connectivity information indicating whether client 100 is currently connected to server complex 204"). The Zydney statuses do not replace or modify any other status in Griffin, including that of the "text-only" buddies. As Petitioner states, the "text-only" status would continue to operate in the same manner. 1797 Reply 22. That is, presence status 702 would still indicate whether Griffin's terminal 100 is connected to server 204 (according to Zydney's status), without restriction, while the "text-only" status would indicate that the terminal is connected to server 204 and technically capable of receiving only text messages. *Id.* We agree with Petitioner that the "text-only" status is not rendered inoperable in Griffin by the asserted combination.

Second, Patent Owner argues that the combination of Griffin and Zydney would render Zydney inoperable for its intended purpose. 1797 PO Resp. 28–29. We disagree. Patent Owner focuses here on whether Zydney's communications are instantaneous versus Griffin's alleged indifference of whether a recipient is "actually online." *Id.* at 29 (citing 1797 Easttom Decl. ¶ 30). These distinctions are contrary to Griffin's teachings of providing presence status information that is constantly updated (Ex. 1005, 5:27–30), showing that Griffin is not indifferent as to the status of its recipients, and providing for an "Off" and "Available" status that the system utilizes to determine whether to deliver the speech chat message (*id.* at 5:2–15). Thus, we do not credit Mr. Easttom's testimony that Griffin does not know and does not care about the recipient's status online. 1797 Easttom Decl. ¶ 30. We also do not credit Mr. Easttom's testimony

that Zydney's purpose would be frustrated or eliminated. *Id.* ¶ 63. The combined teachings do not involve any changes or modifications of Zydney. Thus, the purpose of Zydney is not compromised (or even impacted) by the asserted combination of teachings. Finally, the arguments provided by Patent Owner and Mr. Easttom regarding Zydney's frustrated purpose are generic and devoid of factual support, and, therefore, not entitled to any weight.

Third, Patent Owner alleges that "Griffin only makes available the most recent message" and that the combination of Griffin and Zydney would, therefore, result in Zydney's messages being lost. 1797 PO Resp. 29–30. Citing Griffin's disclosure that "the most recently received speech message (or at least that portion that will fit in available memory) [is] queued at the receiving terminal," Patent Owner alleges, based on Mr. Easttom's testimony, that a person of ordinary skill in the art "would understand this to mean that *only* the most recently received speech message (or portion thereof) is queued . . . ." *Id.* at 29 (citing Ex. 1005, 11:50–53; 1797 Easttom Decl. ¶¶ 31, 68). We do not credit Mr. Easttom's testimony as it is contrary to the teachings of Griffin. Griffin's chat history display contains a list of sent and received speech chat messages. Ex. 1005, 10:20–25. The chat history display entries include more than the last received speech chat message. *See id.*, Fig. 11, item 1105. The queuing only occurs because the speech chat message arrived while the terminal display was not on the chat history display. *See id.* at 11:48–52. This is not the same as disclosing that Griffin only stores the last received message. We find the opposite: Griffin expressly discloses storing messages in permanent storage, without qualification, i.e., regardless of whether the message was

the last to be received. *See id.* at 12:38–42. Thus, the argument that Griffin would only be concerned with storing the last received message, and no others, is contrary to Griffin's disclosure, and, therefore, is unpersuasive.

Fourth, Patent Owner contends that Griffin's and Zydney's methods of managing availability are incompatible, such that "[i]ncluding *Zydney* in the system described by *Griffin* would frustrate the purpose of *Griffin* of a *server-based* messaging paradigm in which technical feasibility of communicating a message to a recipient terminal is *determined at the server complex 204* rather than at the mobile terminal 100 and in which only the messages vetted by the server complex 204 as feasible are subsequently communicated by the server complex 204." 1797 PO Resp. 30–36 (citing 1797 Easttom Decl. ¶¶ 59–61, 64). This argument is not persuasive because Petitioner does not rely on the incorporation of Zydney's availability determination at the terminal into Griffin's server-based determination. Instead, the Petition relies on Zydney's disclosure of whether, for example, the "available" status (meaning that the user is online) would suggest that Griffin's current status 702 of recipients being "available" would also take that meaning. *See* 1797 Pet. 24–25 (arguing that the combination would have predictably resulted in Griffin's presence manager 302 ("communication platform system") maintaining connection information for each terminal 100 in records 700, such that status 702 indicates whether each client 100 is currently connected to server 204). Patent Owner's arguments take Petitioner's contention too far into a bodily incorporation position that is not compatible with Petitioner's actual contentions. Moreover, "[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference," but instead

"the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1294 (Fed. Cir. 2015) (quoting *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). A preponderance of the evidence shows that a person of ordinary skill in the art at the time of the invention would have found it obvious to combine Zydney's teaching of applying an availability status to recipients in Griffin's system to gain the benefits of improving the usability, convenience, efficiency, and privacy. *See, e.g.*, Ex. 1002 ¶¶ 138–143.

Conclusion

In conclusion, Petitioner has demonstrated by a preponderance of the evidence that claim 3 of the '622 patent is unpatentable as obvious over Griffin in view of Zydney.

b. Independent Claim 27

Independent claim 27 differs from independent claim 3 principally in its recitations of (1) the network interface being coupled "to the client device," rather than to the server, and connecting "the client device," again rather than the server, to the network; (2) "an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message"; (3) the messaging system being included in the instant voice messaging application installed on the client device, rather than being a system residing on the server; and (4) the instant voice messaging application "includ[ing] a document handler system for attaching one or more files to the instant voice message." Petitioner relies on the same arguments and evidence for the preamble, "client device," and "network

interface" limitations of independent claim 27 as discussed above with regard to claim 3. 1797 Pet. 61–62 (cross-referencing discussion of claim 3) (citing Ex. 1002 ¶¶ 237–239).

Noting that neither claim 27 nor the specification of the '622 patent recites any particular structure for the recited "document handler system," Petitioner contends that Griffin in view of Zydney discloses a component and/or functionality that performs the recited functions thereof. 1797 Pet. 64 (citing Ex. 1001, 12:26–20; Ex. 1002 ¶¶ 244–251). Petitioner argues that Griffin, for example, discloses the recited "document handler system" because when terminal 100 generates an outbound message, the software provides the user with the option of attaching files to the message. *Id.* at 64–65 (citing Ex. 1005, 5:42–48, 6:39–52, 7:22–25, 10:53–58, 12:63–66). Petitioner also relies on Zydney's disclosures of including attachments in the voice container along with the voice message. *Id.* at 65 (citing Ex. 1006, 4:7–9, 19:1–12, 22:19–20, 35:15–22, Figs. 6, 16, 17–18). Petitioner asserts that it would have been obvious for Griffin to attach a file to a speech chat message, based on Zydney's teachings of attaching a file to a voice container, using the well-known MIME standard. *Id.* at 65–66 (citing Ex. 1006, 19:6–20:9). For a rationale, Petitioner argues that a person of ordinary skill in the art would have been motivated to enable attachments to speech chat messages in Griffin because "it would have enhanced the capabilities and convenience of Griffin's system/process by providing users with the ability to collectively send and receive files with a speech message, instead of needing to send the files and message separately." *Id.* at 66 (citing Ex. 1002 ¶ 249). Petitioner also proffers that Zydney itself provides a reason for such attachments: to provide a richer communication

environment. *Id.* (citing Ex. 1006, 19:2–4). Relying on Dr. Haas's testimony, Petitioner further contends that a person of ordinary skill in the art "would have recognized that such a modification would have been nothing more than a straightforward combination of known technologies by known methods without changing their respective functions to achieve a predictable result, and would have been well within the capabilities of such a person." *Id.* (citing Ex. 1002 ¶ 250).

We are persuaded by Petitioner's showing that it would have been obvious to attach files to a speech chat message. 1797 Pet. 65–66. Zydney discloses attaching a digitized greeting card or other data types to the voice container to be transported to the recipient. Ex. 1006, 19:1–7 (stating that an important part of voice exchange and distribution is "attaching other media to the voice container" and that voice containers may have "digitized greeting cards appended to them"). Zydney describes "attachment" as "associating" in referring to Figure 6, which discloses that the software agent asks the user "what multimedia file *to associate* [to] this voice container." Ex. 1006, Fig. 6 (emphasis added). Figure 16 of Zydney also describes, at step 5.1.4, "associating the multimedia file with the originator's voice container, as well as networked voices." Ex. 1003, Fig. 16, 35:15–17, Fig. 17. These disclosures of Zydney teach attaching one or more files to a voice container as an association of the one or more files to that voice container.

Zydney's teaching of performing the attachment is further informed by the use of the MIME standard. For example, Zydney discloses formatting voice containers using the MIME format, which allows attachment of files to be specified in a message header. Ex. 1006, 19:6–12.

According to this embodiment then, a voice container would be formatted under the MIME standard, where a header identifies the file or files attached to the MIME-formatted voice container. *Id.* We find that this MIME-formatted voice container, which includes the voice data or digitized audio, includes the information necessary in the header to link the files that the user has attached to the voice container.

In the resulting combination, therefore, Griffin's software, which already has the functionality to perform attachments to the outbound chat message, would perform attachments or the required associations in the manner described in Zydney. We also credit Dr. Haas's testimony that a person of ordinary skill in the art would be motivated to provide for attachment of one or more files to the speech chat message of Griffin because the users would find it more convenient than performing separate actions of sending files and attachments. Ex. 1002 ¶ 249. We are also persuaded by Dr. Haas's testimony that Zydney provides a motivation to provide a richer communications environment by specifically allowing for attachments of multimedia files to a voice container, which includes the recorded message. *Id.* (citing Ex. 1006, 19:2–4). We find that the combination applies the known technique of attaching files in a known manner, such as by formatting the speech chat message using the MIME standard and utilizing the MIME header to indicate the files associated with the speech chat message. *See KSR*, 550 U.S. at 417. The combination predictably would have resulted in speech chat messages having attachments, as Griffin already discloses attaching files to the outbound message. *See* Ex. 1002 ¶ 250 ("*Griffin's* system/process would perform the same function of transmitting/receiving speech chat messages in the same

way described in *Griffin*, with the added ability to attach one or more files to such messages."). We are also persuaded that it would have been within the capability and knowledge of a person or ordinary skill in the art to make such a modification. *Id.* ¶ 251.

Patent Owner argues that neither Griffin nor Zydney attaches a file to an instant voice message. 1797 PO Resp. 21–23. According to Patent Owner, "[i]ncluding attachments (in addition to a voice message) in a voice container . . . does not disclose or suggest 'attaching one or more files to the instant voice message' *itself*." *Id.* at 21 (citing 1797 Easttom Decl. ¶¶ 50–58). Patent Owner argues that Zydney's voice container is not an "instant voice message," and that Zydney's attachment to a voice container accordingly is not an attachment to the "instant voice message." *Id.* at 21–22. We are not persuaded by this argument. Moreover, Petitioner's theory of obviousness relies on Griffin's speech chat message as the "instant voice message." That is, Petitioner argues that the combination results in Griffin attaching files to *Griffin's speech chat message*. 1797 Pet. 65–66; *see also* 1797 Reply 15 ("[A]s explained in the Petition, a [person of ordinary skill in the art] would have recognized that *Griffin*'s system could have attached files to its speech chat messages in the exact same way as its text chat messages for the same reasons and advantages.") (citing 1797 Pet. 65; Ex. 1002 ¶ 47). This combination does not rely on Zydney's voice container as teaching the "instant voice message." Rather, Zydney contributes the teaching of how to perform attachments to a Griffin speech chat message because attachments provide a richer communication environment. *Id.* at 66; *see also* Ex. 1006, 19:2–4. Therefore, Patent

Owner's arguments focusing on the differences between Zydney's voice container and an "instant voice message" are not germane to our analysis.

Patent Owner further argues that

> Petitioner does not allege, let alone attempt to prove, that the cited references . . . disclose that the ***same*** alleged "instant voice messaging application" that is (1) "installed at the client device" and that includes (2) "a client platform system for generating an instant voice message" and (3) "a messaging system for transmitting the instant voice message over the packet-switched network" is also the ***same*** application that includes (4) the claimed "document handler system."

1797 PO Resp. 22–23. Instead, according to Patent Owner, "Petitioner myopically focuses on the various limitations in isolation, reducing each to only alleged functionality that Petitioner vaguely attributes to various unspecified 'components' of Griffin's 'system' in general." *Id.* at 23 (citing 1797 Pet. 64). We disagree. We understand Petitioner to rely consistently on Griffin's "machine readable and executable instructions," stored in mobile terminal 100's application storage 310 and executed on terminal 100's CPU 311, as the recited "instant voice messaging application" that meets each of the recited limitations. As Petitioner points out in its Reply, Patent Owner's expert, Mr. Easttom, "appears to agree, testifying that this 'chat software' provides the functionalities associated with sending and receiving speech chat messages." 1797 Reply 18 (citing Ex. 1040, 152:13–154:11).

In sum, having fully considered the parties' respective arguments and cited evidence, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that claim 27 of the '622 patent is unpatentable as obvious over Griffin in view of Zydney.

c. Independent Claim 38

Independent claim 38 differs from independent claim 27 in its omission of the "document handler system" limitation and inclusion instead of "a display displaying a list of one or more potential recipients for an instant voice message." *Compare* Ex. 1001, 27:11–23, *with id.* at 26:17–30. Petitioner relies on the same arguments and evidence for the common limitations among independent claims 1, 27, and 38, as well as dependent claim 21, which similarly recites "display[ing] a list of one or more potential recipients for the instant voice message" and is discussed in Section IV.B.4.m below. 1797 Pet. 70–71. With respect specifically to that "display" limitation, Petitioner maps the "buddies" shown in the buddy list of Figure 9 of Griffin, reproduced in Section IV.B.3.a above, to the recited "potential recipients for the instant voice message." *Id.* at 58 (citing Ex. 1005, Fig. 9; Ex. 1002 ¶¶ 229–230). As Petitioner points out, Griffin explains that software and related components display the buddy list, with each entry representing a buddy that can be selected when sending a speech message. *Id.* (citing Ex. 1005, 8:39–52, Fig. 9). In particular, Griffin discloses that to initiate an instant voice message, a user may select one or more listed buddies and activate the "push-to-talk" button, allowing the user to record and transmit a speech message. *Id.* (citing Ex. 1005, 9:23–31). Patent Owner does not argue claim 38 separately from independent claims 3 and 27, and after full consideration of Petitioner's arguments and cited evidence, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that claim 38 of the '622 patent is unpatentable as obvious over Griffin and Zydney.

d. Dependent Claim 4

Claim 4 depends from claim 3 and further recites "wherein the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user." Ex. 1001, 24:28–30. Petitioner concedes that Griffin does not explicitly disclose that speech messages received by terminal 100 have an "action field," but Petitioner contends it would have been obvious to a person of ordinary skill in the art to modify Griffin's system to implement such features in view of the teachings of Zydney and the knowledge of a person of ordinary skill. 1797 Pet. 30–31 (citing Ex. 1002 ¶¶ 157–164). According to Petitioner, Zydney discloses messages having fields that contain data identifying permitted actions, even though Zydney does not use the specific word "field" to identify them. *Id.* at 31 n.11. For example, Petitioner contends, reuse restriction fields 314, shown in Figure 3 of Zydney, control how the voice message can be reused after it is transmitted, and repeating information fields 330 specify whether a message can be automatically repeated, and if so, how many times. *Id.* at 32 (citing Ex. 1006, 23:1–12, Fig. 3; Ex. 1002 ¶ 159). Petitioner also cites other examples from Zydney. *Id.* at 32–33 (citing Ex. 1006, 12:8–9, 26:20–23; Ex. 1002 ¶ 160). In view of these teachings and the knowledge of a person of ordinary skill in the art, Petitioner contends, such a person would have been motivated to modify Griffin's system such that its speech messages include an action field similar to those described by Zydney, to improve the utility, convenience, and security of the system. *Id.* at 33 (citing Ex. 1002 ¶¶ 161–164). Relying on Dr. Haas's testimony, Petitioner further contends that a person of ordinary skill in the art would have recognized that such a modification would have been nothing more than a straightforward

combination of known technologies by known methods without changing their respective functions to achieve a predictable result, and would have been well within the capabilities of such a person. *Id.* at 34 (citing Ex. 1002 ¶ 162). Indeed, Petitioner contends, "based on Griffin's disclosures of configuring a speech message with various fields (Ex. 1005, 6:38-44, Fig. 4), a [person of ordinary skill in the art] would have been encouraged to expand such features based on other teachings in the field." 1797 Pet. 34 (citing Ex. 1002 ¶ 163).

Patent Owner responds that exemplary embodiments of an action field, described in the '622 patent specification, relate to user-requested actions requiring immediate execution, such as requests to connect, disconnect, subscribe, unsubscribe, or transmit a message. 1797 PO Resp. 36. Claim 5, which depends from claim 4, recites similar actions. *Id.* at 36–37. Patent Owner contends that "Petitioner identifies no such 'action field' in *Zydney* and makes no reference to this intrinsic evidence." *Id.* at 37. Further, according to Patent Owner, Zydney "teaches away" from an instant voice message including an action field because it "expressly defines its 'voice container' to mean 'a container object that contains no methods'—i.e., no actions for the system to execute." *Id.* at 37 (emphasis omitted) (citing Ex. 1006, 12:6–8). Finally, Patent Owner contends that none of the actions identified by Petitioner constitute actions requested by the user for the system to execute, but they instead "merely provide ***restrictions*** on how a message may be used by a recipient" and "do not require any action whatsoever." *Id.* at 37–38.

We are persuaded by Petitioner's showing. As an initial matter, although Zydney uses the term "components" rather than "fields" in

reference to Figure 3, we credit Dr. Haas's testimony that Figure 3 shows fields containing data identifying permitted actions such as reuse restrictions and repeating information. Ex. 1002 ¶ 159. We also credit Dr. Haas's testimony that these permitted actions are requested by the user. *Id.* ¶ 160 (Dr. Haas testifying that Zydney teaches setting privacy features and tailoring the container such that a user may have the ability to limit how many times a confidential message is repeated). Patent Owner's arguments notwithstanding, we find no support in claim 4 or the '622 patent for limiting the "actions" permitted by the "action field" to those expressly recited in the specification or in claim 5 or to actions for "immediate execution." Indeed, as Petitioner points out in its Reply, the principle of claim differentiation creates a presumption that claim 4 is not limited to the permitted actions expressly recited in claim 5, which depends from claim 4. 1797 Reply 19. Although that presumption of claim differentiation may be rebutted by evidence from the specification or prosecution history, Patent Owner does not identify, and we do not find on the record before us, any persuasive rebuttal evidence in this regard. *See, e.g., D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1574 & n.2 (Fed. Cir. 1985); *cf. Tandon Corp. v. United States Int'l Trade Comm'n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987). Claim 4 recites that the action field must "identify[] one of a predetermined set of permitted actions requested by the user," and we agree with Petitioner, at minimum, that "repeat times" field 336 shown in Figure 3 of Zydney identifies a permitted action (i.e., repeating of a message) that a user is permitted to request. We are also persuaded, as we stated above, by Dr. Haas's testimony that the "repeat" field refers to an action requested by a

user because it gives the user control over how many times a confidential message, for example, is repeated. *See* Ex. 1002 ¶ 160.

Accordingly, after full consideration of the parties' respective arguments and evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claim 4 is unpatentable as obvious over the combination of Griffin and Zydney.

e. Dependent Claim 6

Claim 6 depends from claim 3 and further recites "wherein the instant voice message includes an identifier field including a unique identifier associated with the instant voice message." Ex. 1001, 24:36–38. In support of its contention that this further limitation is disclosed by Griffin in view of Zydney, Petitioner points to Griffin's disclosure that outbound message 400 includes thread identifier ("Thread ID") field 404, as well as to Zydney's disclosure that each message created by the software agent has a "unique identifier." 1797 Pet. 35 (citing Ex. 1005, 3:43–48, 4:56–61, 6:38–50, Fig. 4; Ex. 1006, 34:4–8). Relying on Dr. Haas's testimony, Petitioner argues that it would have been obvious to a person of ordinary skill in the art to configure Griffin's system, in view of Zydney's teachings, so that each speech message has a unique identifier to facilitate the storage, retrieval, and management of individual speech messages. *Id.* at 35–36 (citing Ex. 1002 ¶ 167). According to Petitioner, "such a modification would have been a straightforward combination of known technologies by known methods without changing their respective functions to achieve a predictable result, and would have been well within the capabilities of such a person," particularly because "Griffin already discloses providing a unique identifier for each chat thread," and a person of ordinary skill in the art "could have

easily adapted the disclosed teachings to provide a unique identifier for each message in the thread in view of the teachings of Zydney." *Id.* at 36 (citing Ex. 1002 ¶¶ 168, 169; Ex. 1005, 6:44–46). We are persuaded by Petitioner's showing, and we also note that Patent Owner does not argue dependent claim 6 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claim 6 is unpatentable as obvious over the combination of Griffin and Zydney.

f. Dependent Claim 7

Claim 7 depends from claim 3 and further recites:

> wherein the instant voice message includes a source field including a unique identifier associated with at least one of a given one of the plurality of instant voice message client systems that created the instant voice message and a given one of the plurality of users using the given one of the plurality of instant voice message client systems.

Ex. 1001, 24:39–45. In support of its contention that this further limitation is disclosed by Griffin in view of Zydney, Petitioner relies on Griffin's disclosure that its outbound messages 400 include recipient identifiers ("Recipient IDs") in field 403, the first of which identifiers is disclosed as "the sender's identifier." 1797 Pet. 37 (citing Ex. 1005, 6:37–41, 6:56–59, Fig. 4). Petitioner argues that the sender's identifier uniquely identifies terminal 100 and the user that created message 400. *Id.* at 37–38 (citing Ex. 1005, 5:15–22, 5:23–27, 5:50–6:5, 6:10–33, Figs. 7, 8). Although Petitioner concedes that Griffin does not explicitly state that the sender's identifier is "unique," Petitioner contends, relying on Dr. Haas's testimony, that a person of ordinary skill in the art would at least have found it obvious

that the sender's identifier should in fact be globally unique. *Id.* at 39–40 (citing Ex. 1002 ¶¶ 177–178). Moreover, Petitioner contends it would have been obvious to modify Griffin's sender identifier to be unique, if necessary, in view of Zydney's disclosure of each agent having a "unique identifier," as cited previously in the discussion of claim 6. *Id.* at 40 (citing Ex. 1002 ¶¶ 179–183; Ex. 1006, 23:2–3, 23:18–24:2, Fig. 3). We are persuaded by Petitioner's showing, and we also note that Patent Owner does not argue dependent claim 7 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claim 7 is unpatentable as obvious over the combination of Griffin and Zydney.

g. Dependent Claim 8

Claim 8 depends from claim 3 and further recites:

> wherein the instant voice message includes a destination field including a unique identifier associated with at least one of a given one of the plurality of instant voice message client systems identified as a recipient of the instant voice message and a given one of the plurality of users using the given one of the plurality of instant voice message client systems.

Ex. 1001, 24:46–52. In support of its contention that this further limitation is disclosed by Griffin in view of Zydney, Petitioner again points to Griffin's recipient identifiers ("Recipient IDs") in field 403 of outbound message 400, particularly to the recipient identifiers other than the sender's identifier, which Petitioner contends uniquely identify "other terminals 100 and users that are intended recipients of message 400." 1797 Pet. 41 (citing Ex. 1005, 6:37–41, 6:56–59, Fig. 4). More particularly, Petitioner contends that, "[a]s with the sender's identifier, each of the other recipient identifiers in field 403

is associated with a terminal address, which identifies a recipient terminal 100, and a nickname and short name associated with the user of terminal 100, which identifies a user of terminal 100." *Id.* at 42 (citing Ex. 1005, 5:15–22, 5:23–27, 5:50–6:5, 6:10–33, Figs. 7–8). Petitioner also raises similar arguments with respect to the uniqueness of the identifiers as presented for claim 7, discussed above. *Id.* at 42–43 (citing Ex. 1002 ¶¶ 185–189; Ex. 1006, 23:2–3, 23:18–24:2, Fig. 3). We are again persuaded by Petitioner's showing, and we also note that Patent Owner does not argue dependent claim 8 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claim 8 is unpatentable as obvious over the combination of Griffin and Zydney.

h. Dependent Claim 10

Claim 10 depends from claim 3 and recites that the system further comprises "a message database storing the instant voice messages received from the instant voice message client systems." Ex. 1001, 24:58–60. Petitioner contends that Griffin in view of Zydney discloses the claimed "message database" both in a client system (i.e., Griffin's terminal 100) and in a server (Griffin's server 204, Zydney's message server). 1797 Pet. 44–45. For example, Petitioner contends, Griffin discloses that terminal 100 stores both inbound and outbound speech messages permanently in storage. *Id.* (citing Ex. 1005, 10:20–36, 10:45–47, 12:38–42, Fig. 3; Ex. 1002 ¶¶ 191–192). Additionally, Petitioner contends, Griffin discloses that messages may be queued at terminal 100 and/or server 204 for later playback (i.e., if an inbound message arrives while the chat history display is not visible to the user), and a person of ordinary skill in the art would have

understood that queued messages are necessarily stored. *Id.* at 45 (citing Ex. 1005, 11:48–67; Ex. 1002 ¶ 193).

We do not agree with Petitioner that Griffin teaches a "message database" at terminal 100. At best, Griffin teaches that mobile terminal 100 includes temporary storage and permanent storage, for storing received and sent chat messages. Ex. 1005, Fig. 3, 12:41–42. Griffin does not disclose, however, storing the messages in a "message database" at the terminal. And we are not persuaded by Petitioner's footnoted and conclusory argument that under the plain meaning of the words "message database," by merely disclosing storage of the messages, Griffin discloses a "message database" under the broadest reasonable interpretation. *See* 1797 Pet. 45 n.12.

Still further, Petitioner points out that Zydney also describes a server containing a "message store" for storing messages "centrally at the server whenever the recipient is not available" and that the server includes a "database mechanism." *Id.* at 45–46 (citing Ex. 1006, 11:3–6, 23:15–17, 25:1–3, 30:6–8, Figs. 2, 4); *see also id.* at 46–48 (providing motivation to modify Griffin in view of Zydney's teachings, citing Ex. 1002 ¶¶197–200). We are persuaded by Petitioner's showing that Zydney discloses the recited "message database," and we also note that Patent Owner does not argue dependent claim 10 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claim 10 is unpatentable as obvious over the combination of Griffin and Zydney.

i. Dependent Claim 11

Claim 11 depends from claim 3 and further recites:

> wherein, upon receipt of an instant voice message, the communication platform system determines if there is the current connection to one of the plurality of instant voice message client systems identified as a recipient of the instant voice message, and if there is no connection with the one of the plurality of instant voice message client system identified as the recipient, the instant voice message is stored and delivered when the one of the plurality of instant voice message client systems identified as the recipient re-established a connection.

Ex. 1001, 24:61–25:3. Petitioner presents two alternative theories with respect to the further limitations set forth in claim 11.

First, Petitioner contends that the recited features are disclosed by Griffin in view of Zydney. 1797 Pet. 48–53. Petitioner points to Griffin's disclosure of server 204, including presence manager 302 that maintains a "presence data record[] 700" for each terminal 100, indicating via current status 702 whether the terminal is currently "Available" or "Off." *Id.* at 48 (citing Ex. 1005, 4:62–5:2, 5:11–30, Fig. 7). Petitioner maps presence manager 302 to the recited "communication platform system" and terminals 100 to the recited "instant voice message client systems." *Id.* Referring back to Dr. Haas's testimony with respect to claim 3, Petitioner contends it would have been obvious to a person of ordinary skill in the art for status 702 also to include connectivity information indicating whether terminal 100 is currently connected to server 204. *Id.*; Ex. 1002 ¶¶ 135–144. For the second conditional branch of claim 11 (i.e., "if there is no connection . . ."), Petitioner contends, "*Griffin* explains that server 204 only sends inbound messages 500 to available recipients based on the recipient's status 702" and "also explains that if a speech message arrives while the chat history display is not visible to the user, . . . the message is 'queued' at server 204 and/or terminal 100) for later playback." *Id.* at 49. Accordingly,

Petitioner contends, "*Griffin* discloses storing a speech message if the recipient is not viewing the chat history display, and delivering the stored message to the recipient once the recipient is viewing the chat history display." *Id.* at 49–50 (citing Ex. 1002 ¶ 204). As persuasively argued for claim 3, Petitioner contends it would have been obvious to modify Griffin's system based on the teachings of Zydney so that status 702 includes connectivity information indicating whether terminal 100 is currently connected to server 204, and it also would have been obvious to modify Griffin's system such that server 204 would store a message if there is no connection as determined based on status 702 for later delivery once the recipient re-established a connection. *Id.* at 50–53 (citing Ex. 1002 ¶¶ 206–216).

Second, Petitioner contends that the recited features of claim 11 are obvious in view of Griffin, Zydney, and Vuori. *Id.* at 76–78. According to Petitioner, "Vuori provides additional details related to the features of claim 11" (*id.* at 77 n.15), and "it would have been obvious to modify the combined *Griffin-Zydney* system/process based on the teachings of *Vuori* so that speech messages are stored at server 204 and delivered depending on whether the recipient's status 702 indicates a current connection." *Id.* at 77 (citing Ex. 1002 ¶¶ 356–363). Petitioner points, for example, to Vuori's disclosure of its SVMSC determining the availability of the intended recipients (e.g., on-line) upon receipt of an SVM, and then either "send[ing] the SVM immediately to those intended recipients who are available" or storing the SVM for later deliver for currently unavailable recipients. *Id.* at 77–78 (citing Ex. 1015 ¶¶ 8, 34, 43–47, 50, 54; Ex. 1002 ¶¶ 91, 358–363). Petitioner contends a person of ordinary skill in the art "would have been

encouraged to look to *Vuori* to complement the teachings of *Griffin* and *Zydney* because these references are in the same technical field of network communication systems, teach solutions to common problems in the field, and describe technologies that were well known, similar, and compatible." *Id.* at 78 (citing Ex. 1005, 1:8–12, 3:59–65, 4:10–15; Ex. 1006, Abstract, 5:1–5, 10:11–18; Ex. 1015, Abstract, ¶¶ 3, 31–34, 41, Figs. 1, 6; Ex. 1002 ¶ 362).

We are persuaded by Petitioner's contentions and also note that Patent Owner does not argue dependent claim 11 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claim 11 is unpatentable as obvious over the combination of Griffin and Zydney, with or without the addition of Vuori.

j. Dependent Claim 12

Claim 12 depends from claim 3 and further recites "wherein the communication platform system updates the connection information for each of the instant voice message client systems by periodically transmitting a connection status request to the given one of the plurality of instant voice message client systems." Ex. 1001, 25:4–8. Petitioner concedes that "neither Griffin nor Zydney explicitly discloses updating connection information for each terminal 100 by periodically transmitting connection status requests to the terminal 100," but, relying on the testimony of Dr. Haas, Petitioner contends that it would have been obvious to a person of ordinary skill in the art to modify the system/process of the Griffin/Zydney combination to implement such features based on Aravamudan's teachings. 1797 Pet. 72–73 (citing Ex. 1002 ¶¶ 82–83, 270–280). In particular,

Petitioner points to Aravamudan's disclosure of IM server 130 periodically polling client devices 140 and updating its database to reflect the offline status of the device. *Id.* at 73–74 (citing Ex. 1009, 8:5–31). Relying on Dr. Haas's testimony, Petitioner contends that Aravamudan accordingly discloses updating connection information for each client device 140 by periodically transmitting connection status requests to the device. *Id.* at 74 (citing Ex. 1002 ¶¶ 271–273). Petitioner further contends that a person of ordinary skill in the art would have been motivated to modify the combined Griffin/Zydney system/process to implement a polling technique similar to that disclosed by Aravamudan, such that presence manager 302 would update the connection information of each terminal 100 by periodically transmitting a connection status request to each terminal. *Id.* (citing Ex. 1002 ¶¶ 274–280). According to Petitioner, such a modification would have provided various advantages, would have been a straightforward combination of known technologies by known methods without changing their respective functions to achieve a predictable result, and would have been well within the capabilities of a person of ordinary skill in the art at the time of the alleged invention. *Id.* at 74–76.

We are persuaded by Petitioner's contentions and also note that Patent Owner does not argue claim 12 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claim 12 is unpatentable as obvious over the combination of Griffin, Zydney, and Aravamudan.

k. Dependent Claim 13

Claim 13 depends from claim 3 and further recites "wherein each of the instant voice message client systems comprises an instant voice

messaging application generating an instant voice message and transmitting the instant voice message over the packet-switched network to the messaging system." Ex. 1001, 25:9–13. For the recited "instant voice messaging application," Petitioner identifies Griffin's mobile terminal as including software that performs the messaging functions disclosed in Griffin. 1797 Pet. 54–55 (citing Ex. 1005, 3:43–48, 4:29–61, 12:61–63; Ex. 1002 ¶¶ 217–219). For the function of "generating an instant voice message," Petitioner identifies Griffin's mobile terminal as including chat software that, when a user activates the "push-to-talk" button, controls the recording and transmission of a speech message. *Id.* at 55 (citing Ex. 1005, 9:20–31, 11:42–47, 12:1–3; Ex. 1002 ¶¶ 220–221). For the function of "transmitting the instant voice message over the packet-switched network to the messaging system," Petitioner relies on Griffin's mobile terminal 100, including software that transmits the speech chat message over packet-based network 203 via network interface 306 to server complex 204. *Id.* at 55–56 (citing Ex. 1005, 3:51–61, 4:62–65, 9:20–31, 12:61–63; Ex. 1002 ¶ 222).

We agree that Griffin teaches software performing the messaging functionalities in the mobile terminal, and we also note that Patent Owner does not argue dependent claim 13 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claim 13 is unpatentable as obvious over the combination of Griffin and Zydney.

l. Dependent Claims 18 and 32

Claims 18 and 32 depend from claims 13 and 27, respectively, and each further recites "wherein the instant voice messaging application

includes an audio file creation system creating an audio file for the instant voice message based on input received via an audio input device coupled to the client device." Ex. 1001, 25:31–35, 26:48–52. Petitioner explains that Griffin teaches capturing speech from a microphone, which is an audio input device, and encoding the speech using voice codec 307. 1797 Pet. 57 (citing Ex. 1005, 4:30–45, 4:52–53, Fig. 7; Ex. 1002 ¶¶ 225–226); *see also id.* at 67 (relying for claim 32 on arguments with respect to claim 18). Petitioner acknowledges, however, that Griffin does not disclose that the speech is in the form of an "audio file." *Id.* at 57. Thus, Petitioner relies on Zydney's teaching of digitally recording a voice message in an "audio file," such as an MP3 file. *Id.* (citing 1797 Pet. 28 (citing Ex. 1005, 16:1–4, 21:15–18, 39:16)). Petitioner argues, and we agree, that it would have been obvious for a person of ordinary skill in the art to modify the message content of Griffin to be in the form of an audio file as taught by Zydney. *Id.* (citing Ex. 1002 ¶¶ 227–228). The combination, we are persuaded, is a predictable substitution of one known element for another. *KSR*, 550 U.S. at 416–17. Patent Owner does not argue dependent claims 18 and 32 separately from claims 3 (from which claim 13 depends) and 27. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claims 18 and 32 are unpatentable as obvious over the combination of Griffin and Zydney.

m. Dependent Claim 21

Claim 21 depends from claim 13 and further recites "wherein the instant voice messaging application displays a list of one or more potential recipients for the instant voice message." Ex. 1001, 25:48–50. As noted

above, Petitioner relies on the same arguments for the "display" limitation of independent claim 38 as for this additional limitation of claim 21. *See supra* Section IV.B.4.c. Patent Owner does not argue dependent claim 21 separately from claim 3, and, for the reasons stated in the above discussion of claim 38, we are persuaded by Petitioner's arguments and cited evidence showing by a preponderance of the evidence that claim 21 is unpatentable as obvious over the combination of Griffin and Zydney.

n. Dependent Claims 22 and 39

Claim 22 depends from claim 21 and further recites "wherein the instant voice messaging application displays an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message." Ex. 1001, 25:51–55. Claim 39 depends from claim 38 and further recites "wherein the display includes an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message." *Id.* at 27:24–27.

Petitioner argues that each entry in Griffin's buddy list, as shown in Figure 9 of Griffin, includes a presence status icon 911 that varies depending on presence status 702 of the corresponding potential recipient (i.e., whether the potential recipient is currently available to receive a speech message). 1797 Pet. 58–59 (citing Ex. 1005, 5:11–30, 8:24–28, 8:47–52, Fig. 9).

Petitioner further contends that Griffin does not provide *additional details* regarding what precisely status 702 indicates, but that it would have been obvious to a person of ordinary skill in the art for status 702 to include connectivity information indicating whether client 100 is currently connected to server 204, based on the teachings of Zydney, for reasons set

forth in the discussion of claim 3. 1797 Pet. 59. Although we acknowledge this further showing, we do not find that additional details are necessary because Griffin's disclosure and Mr. Easttom's testimony provide persuasive evidence that Griffin's presence status indicates "whether the recipient is ready to receive the particular type of message, speech and/or text messages only," consistent with the scope of claims 22 and 39. Ex. 1005, 5:11–15, 6:64–7:11 (describing message delivery for "available" targets), Fig. 7; Ex. 1040, 165:18–166:7 (Mr. Easttom testifying that "Off" is "unavailable for any communication at all" and simply means "you can't communicate with them in any fashion"); *see also* 1797 PO Resp. 46 n.15 (Patent Owner arguing that Griffin does show what presence status indicates and calling Petitioner's statement "disingenuous"). Therefore, the *additional details* provided by Zydney, again, are not necessary to show that claims 22 and 39 would have been obvious, as Petitioner shows, by a preponderance of the evidence that Griffin alone teaches the further limitation of those claims. As discussed in reference to claim 3, Griffin's Figure 7 illustrates at least two instances of presence status ("Available" and "Off"), indicating "whether the recipient is ready to receive the particular type of message." *See* Ex. 1005, 5:11–30; 1797 Pet. 22 (citing Ex. 1005, 5:11–30, Fig. 7). When a presence status of a buddy changes, presence manager 302 detects this change and sends a buddy list update message 600 to the appropriate terminals 100. *See* Ex. 1005, 5:27–30; 1797 Pet. 22–23 (citing Ex. 1005, 5:15–22, 5:27–30, 7:39–42, 7:48–49, 8:1–8, Fig. 6). In this manner, Griffin teaches that each terminal 100 receives current presence status information for each buddy of the buddy list displayed in Figure 9, together with the indicia that represents that presence status. Dr. Haas's testimony, which we credit, states that

presence manager 302 provides the current status 702 of each terminal 100 as "Available" or "Off," which terminals use to determine the appearance of the presence status icon 911 corresponding to each entry in the buddy list. Ex. 1002 ¶ 231. These disclosures in Griffin demonstrate by a preponderance of the evidence that Griffin alone teaches that "the instant voice messaging application displays an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message," as recited in claim 22.

In particular, we are persuaded that Griffin, by disclosing that the presence status can be "Available" or "Off," a buddy of the buddy list will have an indicator (via icon 911 of Figure 9) that informs the sender "whether the recipient is ready to receive the particular type of message." *See* Ex. 1005, 5:11–30, Fig. 7; Ex. 1002 ¶ 231. The claim language requires indicating "whether the potential recipient is currently available to receive an instant voice message." Ex. 1001, 25:53–55, 27:26–27. This is precisely what Griffin discloses, indicating that the buddy, which uses its terminal to communicate with others in Griffin's system, is ready to receive the particular type of message. Griffin also includes other types of presence status, such as "Text Only," which may indicate availability for receiving text-only messages, and not speech chat messages. *See* Ex. 1005, Fig. 7. This disclosure, however, does not undermine the teaching that for "Available" buddies, without qualification, Griffin indicates that such a buddy "is ready to receive" a speech chat message. On the other hand, when Griffin provides the "Off" status, Griffin indicates that the buddy and terminal cannot receive *any* messages. Ex. 1040, 165:18–166:7. The claim language does not require more. If a buddy cannot receive any messages,

then the potential recipient is not "currently available to receive an instant voice message," as recited in claims 22 and 39. If a buddy is "Available," the potential recipient is "currently available to receive an instant voice message."

Accordingly, we determine that Petitioner has shown by a preponderance of the evidence that Griffin alone teaches the limitation of claims 22 and 39.

Nevertheless, because Patent Owner spent a significant portion of its resources responding to the ground based on the combination of Griffin with Zydney (*see* 1797 PO Resp. 38–39), we address the asserted combination. As discussed above in relation to the "communication platform system" limitation of claim 3, Petitioner relies on Zydney specifically for the teaching of the "Available" status indicating that a software agent is logged onto the system and available for messaging, and the "Not logged on" status indicating that the software agent is logged off the system. 1797 Pet. 23–24 (citing Ex. 1006, 33:1–2). Petitioner argues that these Zydney statuses teach indicating whether the software agent is "currently available" as claimed. *Id.* (citing Ex. 1002 ¶¶ 136–137). We agree with Petitioner that Zydney's status of "Available" and "Not logged on" indicate "whether the potential recipient is currently available to receive an instant voice message." Much like in Griffin, an "Available" indicator means that the software agent is ready to receive a message, and a "Not logged on" status, equivalent to Griffin's "Off" indicator, means that the software agent is unavailable for receiving any message.

Based on the foregoing, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that claims 22 and 39 are unpatentable as obvious over the combination of Griffin and Zydney.

o. Dependent Claims 23 and 35

Claims 23 and 35 depend from claims 13 and 27, respectively, and each further recites "wherein the instant voice message application generates an audible or visual effect indicating receipt of an instant voice message." Ex. 1001, 25:56–58, 26:65–67. Petitioner identifies Griffin's "inbound chat message indicator 905," which appears on the display when "an unheard . . . inbound chat message 500 . . . has arrived at the terminal 100," as a "visual effect," and "Griffin's disclosure of an "audible sound when the icon is first displayed" as an "audible . . . effect." 1797 Pet. 60 (citing Ex. 1005, 8:29–33; Ex. 1002 ¶¶ 235–236). We agree with Petitioner that this disclosure of Griffin teaches the limitation further recited in claims 23 and 35. Patent Owner does not argue dependent claims 23 and 35 separately from claims 3 (from which claim 13 depends) and 27. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claims 23 and 35 are unpatentable as obvious over the combination of Griffin and Zydney.

p. Dependent Claim 34

Claim 34 depends from claim 27 and further recites "wherein the instant voice messaging application includes a compression/decompression system for compressing the instant voice messages to be transmitted over the packet-switched network and decompressing the instant voice messages received over the packet-switched network." Ex. 1001, 26:59–64.

Petitioner points to disclosure in Griffin that its system/process could use "common compression . . . techniques," and contends that it would have been obvious to a person of ordinary skill in the art at the time of the alleged invention to modify Griffin's system to implement compression/ decompression of speech messages transmitted/received over network 203 in view of the teachings of Zydney. 1797 Pet. 68–70 (citing Ex. 1005, 7:11–17; Ex. 1006, 10:20–11:3, 12:1–5, 12:12–13, 16:1–4, 20:11–14, 21:14–16, Figs. 2, 9; Ex. 1002 ¶¶ 255–261). Patent Owner does not argue dependent claim 34 separately from claim 27. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claim 34 is unpatentable as obvious over the combination of Griffin and Zydney.

5. Analysis of Claims 14–17, 19, 24–26, 28–31, and 33

In IPR2017-01798, Petitioner contends that claims 14–17 and 28–31 are unpatentable over the combination of Griffin, Zydney, and Clark; that claims 19 and 33 are unpatentable over the combination of Griffin, Zydney, and Väänänen; and that claims 24–26 are unpatentable over the combination of Griffin, Zydney, and Low. 1798 Pet. 44–76. We address those contentions in turn.

a. Dependent Claims 14 and 28

Claims 14 and 28 depend from claims 13 and 27, respectively, and each further recites "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." Ex. 1001, 25:14–18, 26:31–35. Petitioner asserts that Griffin's

software (which Petitioner maps to the recited "instant voice messaging application") includes a "message database," as recited in claims 14 and 28. 1798 Pet. 44–45; *see also id.* at 59 (relying for claim 28 on arguments with respect to claim 14). As explained in our above analysis of claim 10, we disagree. To repeat, at best, Griffin teaches that mobile terminal 100 includes temporary storage and permanent storage, for storing received and sent chat messages. Ex. 1005, Fig. 3, 12:41–42. Griffin does not disclose, however, storing the messages in a "message database" at the terminal. And we are not persuaded by Petitioner's footnoted and conclusory argument that under the plain meaning of the words "message database," by merely disclosing storage of the messages, Griffin discloses a "message database" under the broadest reasonable interpretation. *See* 1798 Pet. 45 n.12.

In the alternative, Petitioner argues that it would have been obvious to modify Griffin in view of Clark so that the software of mobile terminal 100 stores each speech message in an integrated message database (as taught by Clark), with each message represented by a database record including a unique identifier. *Id.* at 49. Such a modification would be motivated by a desire to improve the storage, retrieval, and management of messages. Ex. 1002 ¶¶ 284–289. Additionally, Clark itself teaches a reason for implementing the disclosed database techniques, such as, for example, Clark's disclosure of automatically managing the stored messages as a fast and quick solution for users to locate messages or groups of messages. 1798 Pet. 49–50 (citing Ex. 1007, 1:20–4:8, 4:9–22; Ex. 1002 ¶ 289).

We agree with Petitioner that Clark's database allows for easy cataloging, retrieving, and manipulating messages (Ex. 1007, 4:25–48), benefits that a person of ordinary skill in the art would have appreciated and

would have found useful to improve Griffin's storage of messages (*see* Ex. 1002 ¶ 290). Clark, for example, describes an embodiment in Figure 4A, reproduced below, in which the user's computer contains the message client and the message store. *Id.*; Ex. 1007, Fig. 4A.

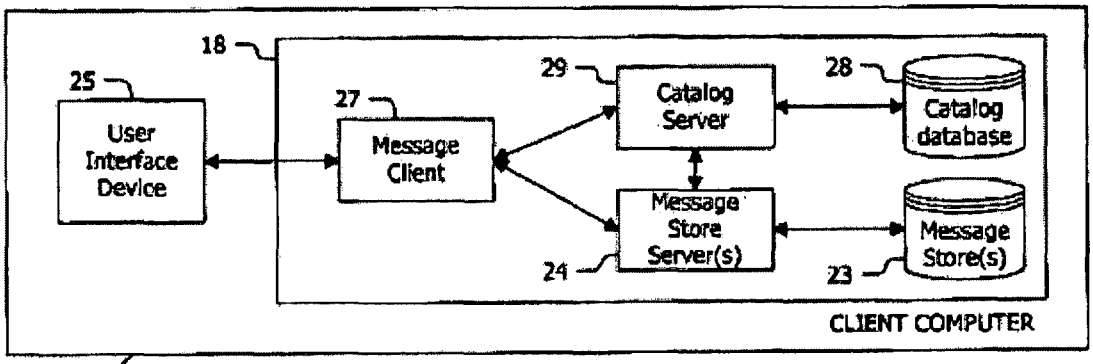

FIG. 4A

Figure 4A depicts an embodiment of a physical configuration of the client computer 18 on which electronic messages are received and stored. Ex. 1007, 5:1–3, 4:25–27. Clark describes that it is known for electronic messages to include instant messaging and that the electronic message may have attachments. *Id.* at 1:37–39, 8:36–44. Clark organizes the stored electronic messages in the database of message store 23 using a catalog database 28, which organizes the messages into different folders. *Id.* at 9:54–60; *see also id.* at 10:11–19 (describing the various elements of an electronic message shown in Figure 3 and that the elements can be the basis for associating the message with one or more folders). Notwithstanding Clark's use of the catalog database for further organizing the messages into folders, Clark describes a message store 23, at the client, as a database for storing the messages, which teaches the required "message database." *See, e.g., id.*, Fig 4A (depicting message store 23 at the client), 9:13–16

(describing message store 23 as "a memory, file or database structure that provides temporary or permanent storage for the contained messages 22").

We are also persuaded that it would have been obvious to modify Griffin's mobile terminal storage to include such a message store. 1798 Pet. 46–49. We agree that a person of ordinary skill in the art would have been motivated to combine the teachings of Griffin and Clark, as the benefits of message organization, touted by Clark, would improve Griffin's storage of messages. *Id.* at 49–51. Clark recognizes a need for systems and methods of automatically organizing stored electronic messages, including instant messages. Ex. 1007, 4:9–12. And Clark's invention provides not only the message store or database, but also the cataloging of messages that accomplishes the desired organization. *Id.* at 4:25–32. Particularly relevant to our analysis is Clark's description of its invention as "advantageously [] integrated with messaging client software . . . to facilitate the organization of electronic messages." *Id.* at 4:36–39. Thus, Clark informs us that it would have been advantageous to include a message database in messaging client software to organize further electronic messages, including instant messages. As further support for our conclusion, we credit Dr. Haas's testimony that Clark addresses the need for automatically managing stored messages, such that users quickly locate a message or group of messages. Ex. 1002 ¶ 289. We find that given Clark's teachings, a person of ordinary skill in the art, looking to improve Griffin's mobile terminal's storing of messages, would have looked to Clark's method and system for organizing electronic messages using a message store. *See KSR*, 550 U.S. at 417 ("[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way,

using the technique is obvious unless its actual application is beyond his or her skill."); Ex. 1002 ¶ 288.

With regard to the specific teachings of a database record and the unique identifier, Petitioner has identified Clark's message store 23 and catalog 28 as integrated databases, where each message 22 is represented by a "Message" record in message store 23 ("message database") and is uniquely identified by a "StoreMessageId" (in the embodiment shown in Figure 5A) or "Message Id" (in the embodiment shown in Figure 5B). 1798 Pet. 48 (citing Ex. 1007, 11:14–17, 11:35–37, 11:50–54, 11:66–12:1, Figs. 5A, 5B). Petitioner also points out that Clark describes the "MessageSummary" record as holding information about the underlying message. *Id.* (citing Ex. 1007, 11:31–33, 11:66–12:1).

We agree with Petitioner that Clark teaches that the "instant voice message is represented by a database record including a unique identifier." Clark assigns a StoreMessageId to the message when the message is added to the message store. Ex. 1007, 11:50–54. This StoreMessageId is a unique identifier that is stored in MessageSummary table 54, but more importantly, Petitioner points out that Clark *also* stores the StoreMessageId, as depicted in Figure 5A, *in Message table 54* of message store 23. *See* 1798 Pet. 48–49; Ex. 1007, 11:31–32, 11:38–40, 16:50–63, Fig. 5A. According to the embodiment shown in Figure 5B of Clark, the catalog database and message store are preferably a single database comprising related tables. Ex. 1007, 11:1–5, 11:55–65, Fig. 5B. In the Figure 5B embodiment, the unique identifier is the MessageId, which is stored in Message table 54' and in the MessageSummary table 52'. Thus, Clark teaches various embodiments of a message record, in the form of Message table 54 (Figure 5A) and Message

table 54' (Figure 5B), each storing a message and the unique identifier (either StoreMessageId or MessageId) for that message. Ex. 1007, 11:35–40. The stored message is retrieved using the unique identifier that not only identifies the stored message uniquely, but also uniquely addresses the message record. *See id.* at 11:14–24. Because each message record uniquely pertains to the stored message, the store message "is represented" by the message record.

Patent Owner raises several arguments in an attempt to show that Clark does not teach the "database record" limitation. First, Patent Owner argues that the claim requires the "database record" to be a record of the "message database." 1798 PO Resp. 29. Second, stating that the claim language is unambiguous, Patent Owner asserts that claim 14 requires storing the instant voice message *and* the unique identifier in the *same* database record. *Id.* at 28. Patent Owner points out that the Specification describes the *database record* as comprising *both* a message identifier and the instant voice message. *Id.* at 29 (citing Ex. 1001, 12:34–38). Patent Owner highlights the Specification's statement that the instant voice messages are "represented" as database records, such that the Specification implies a meaning of "represented" to refer to the content of the database record. *Id.* In sum, Patent Owner contends that the claims require a *single* database record, in a *single* message database, where the record includes both the instant voice message and the unique identifier. Because the arguments from Patent Owner attempt to distinguish Clark based on the single-database-record argument, our analysis below focuses on that issue.

Based on the single-database-record characterization, Patent Owner argues that Clark's message is stored in Message table 54 and the

StoreMessageId is stored elsewhere, in MessageSummary table 52. *Id.* at 30–31 (citing Ex. 1007, Fig. 5A, 16:64–17:23). Specifically, Patent Owner highlights that the unique identifier is stored in MessageSummary table 52 (in the catalog database), purposely separate from message store 23, which stores the message. *Id.*

We begin by ascertaining whether Patent Owner's characterization of the claim scope as requiring a single database record is proper. Claim 14 recites "the instant voice message is represented by a database record including a unique identifier." Two things are evident from this plain language: (1) the instant voice message is *represented* by a database record; and (2) the same database record includes a unique identifier. Neither of these two features requires *storing* the instant voice message in the same database record that includes the unique identifier. Instead, by using the word "represented," the claim language seems to reject a requirement of *storing* the instant voice message in a database record. We conclude that this is the correct claim scope because, among other things, the claim uses the word *storing* elsewhere to expressly require *storing the instant voice message in the message database*. If it were a requirement to store the instant voice message in the database record of the message database, the applicant could have specifically claimed *storing* rather than requiring a "representative" relationship between the instant voice message and the database record. In a way, Patent Owner asks us to read the claim as if it stated "a message database storing the instant voice message in a database record including a unique identifier." *But see K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1364 (Fed. Cir. 1999) ("Courts do not rewrite claims; instead, we give effect to the terms chosen by the patentee."); *Tex.*

Instruments, Inc. v. U.S. Int'l Trade Comm'n, 988 F.2d 1165, 1171 (Fed. Cir. 1993) ("[C]ourts can neither broaden nor narrow claims to give the patentee something different than what he has set forth.") (internal quotes omitted). We also view Patent Owner's request as urging that we read limitations into the claim from an embodiment of a database record comprising the instant voice message, which would be improper. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004) ("We have cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.").

Finally, on the issue of claim scope, we note that the Specification uses the word "represented" in connection with another embodiment of a database record that does not support Patent Owner's argument. That embodiment states that "[t]he users are *represented in the database as records*, each record comprising a user name, a password, and a contact list . . . and other data relating to the user." Ex. 1001, 13:63–66 (emphasis added). This embodiment also describes a *representative* relationship that does not require storing the "users" in the database record—such a requirement would be nonsensical. Only information pertaining to the user is stored in the record. The same *representative* relationship is encompassed by the claim language at issue. We are, therefore, not persuaded that the claims are as narrow as Patent Owner argues, and we disagree that Clark's "separate-table" disclosure is fatal to Petitioner's position.

Nevertheless, here, Petitioner has identified StoreMessageId and the MessageId as unique identifiers, each stored in a MessageSummary table of the catalog database, and each having the required representative

relationship to the stored message. 1798 Pet. 48–49. We agree that the representative relationship is satisfied, as the StoreMessageId and MessageId each pertains uniquely to the stored message. *Id.* (citing Ex. 1007, 11:38–40, 13:66–14:3, 16:50–17:23). For the reasons discussed above regarding the proper scope of the claim, it is not relevant that the StoreMessageId, in some embodiments of Clark, may be in a record (row of the MessageSummary table (*see* Ex. 1007, 16:58–60)) separate from the record that stores the message in message store 23.

But even under Patent Owner's narrow reading of the claim, we note that Petitioner persuasively *rebuts* Patent Owner's single-record distinctions because the unique identifier of Clark's StoreMessageId is not limited to being stored in a record that is separate from the record that contains the message in the message store. 1798 Pet. 48; 1798 Reply 15–16 (arguing that in Figure 5B of Clark, the MessageId is contained in the *same record* as the message data (<message.data>)). Thus, the record that contains the message (Message table 54 in Fig. 5A and Message table 54' in Fig. 5B) includes both the message and the unique identifier (StoreMessageId in Fig. 5A and MessageId in Fig. 5B). As discussed above, in either Figure 5A or Figure 5B, Clark depicts the unique identifier (StoreMessageId or MessageId, respectively) stored in the Message table, together with the message. Ex. 1007, Figs. 5A, 5B; 11:1–5, 11:38–40, 11:55–64, 16:50–63. As explained by Petitioner and supported by Clark, it is evident that a *single record* of the Message table includes both the message and the unique identifier.

Patent Owner also argues that Petitioner speculates that catalog database 28 and the message store of Clark could be combined, as in

Figure 5B. 1798 PO Resp. 33. We disagree. Clark expressly discloses that in the embodiment shown in Figure 5B, catalog database 28 and message store 23 are integrated into a single database. Ex. 1007, 11:1–3. Patent Owner finally argues that Petitioner identified only "StoreMessageId," which is not shown in Figure 5B. 1798 PO Resp. 31. We again disagree. Petitioner expressly identified "MessageId" in connection with the embodiment of Clark's Figure 5B. 1798 Pet. 48.

Accordingly, based on the evidence provided by Petitioner, we find unpersuasive Patent Owner's arguments that Clark does not teach "wherein the instant voice message is represented by a database record including a unique identifier," even under Patent Owner's claim scope arguments, with which we do not agree.

Patent Owner also challenges the rationale to combine Clark and Griffin. Patent Owner argues that Clark teaches away from including the message data in the same table as MessageSummary table 52. 1798 PO Resp. 32–33. This argument is not persuasive. Petitioner's asserted combination does not rely on modifying Clark's MessageSummary table to include the message data. As we explained above, we do not view the claim scope as requiring that a single database record include both the instant voice message and the unique identifier. Therefore, an argument that Clark precludes a single-database-record modification is not commensurate with the claim scope. We have discussed above, nevertheless, that Clark teaches a single record that includes both the message and the unique identifier: a record in the Message table. Accordingly, we are not persuaded that Clark teaches away from the combination of the teachings and reasons to combine discussed above.

Based on the foregoing, we conclude that Petitioner has shown by a preponderance of the evidence that claims 14 and 28 are unpatentable as obvious over the combination of Griffin and Zydney, as applied to claims 13 and 27, in further view of Clark.

b. Dependent Claims 15 and 29

Claim 15 depends from claim 14 and further recites "wherein the message database includes a plurality of instant voice messages recorded by a user of the client device and instant voice messages received over the packet-switched network." Ex. 1001, 25:19–22. Claim 29 depends from claim 28 and further recites "wherein the instant voice message stored in the message database include a plurality of instant voice messages recorded by a user of the client device and instant voice messages received over the packet-switched network." *Id.* at 26:36–40. Relying on Dr. Haas's testimony, Petitioner contends that Griffin in view of Zydney and Clark discloses the features of claims 15 and 29. 1798 Pet. 52 (citing Ex. 1002 ¶¶ 294–296); *see also id.* at 59 (relying for claim 29 on arguments with respect to claim 15). In particular, Petitioner argues the Griffin/Zydney combination stores inbound speech chat messages received over packet-based network 203, as well as outbound speech chat messages recorded by the user of terminal 100, in permanent storage of mobile terminal 100. *Id.* at 52 (citing Ex. 1005, 10:20–36, 10:58–62, 12:38–42). Petitioner further contends, for reasons discussed with respect to claim 14, it would have been obvious for terminal 100's permanent storage to be a database like that described in Clark. *Id.* We agree with Petitioner, and we also note that Patent Owner does not argue dependent claims 15 and 29 separately from claims 14 and 28. Based on Petitioner's arguments and cited evidence, we

are persuaded that Petitioner has shown by a preponderance of the evidence that claims 15 and 29 are unpatentable as obvious over the combination of Griffin, Zydney, and Clark.

c. Dependent Claims 16 and 30

Claim 16 depends from claim 15 and further recites "wherein the instant voice messaging application displays at least one of the plurality of instant voice messages stored in the message database." Ex. 1001, 25:23–26. Claim 30 depends from claim 29 and further recites "a display displaying at least one of the plurality of instant voice messages stored in the message database." *Id.* at 26:41–43. Relying on Dr. Haas's testimony, Petitioner contends that Griffin in view of Zydney and Clark discloses the features of claims 15 and 29. 1798 Pet. 53–55 (citing Ex. 1002 ¶¶ 297–302); *see also id.* at 59 (relying for claim 30 on arguments with respect to claim 16). Petitioner contends, first, that Griffin discloses that stored messages 1105 displayed in terminal 100's "chat history," as illustrated in Figure 11 of Griffin, reproduced below, may be "locked" messages that are "saved in permanent storage 305 and will always appear in the chat history display until it is unlocked." *Id.* at 53 (citing Ex. 1005, 10:20–25, 10:58–62, Fig. 11).

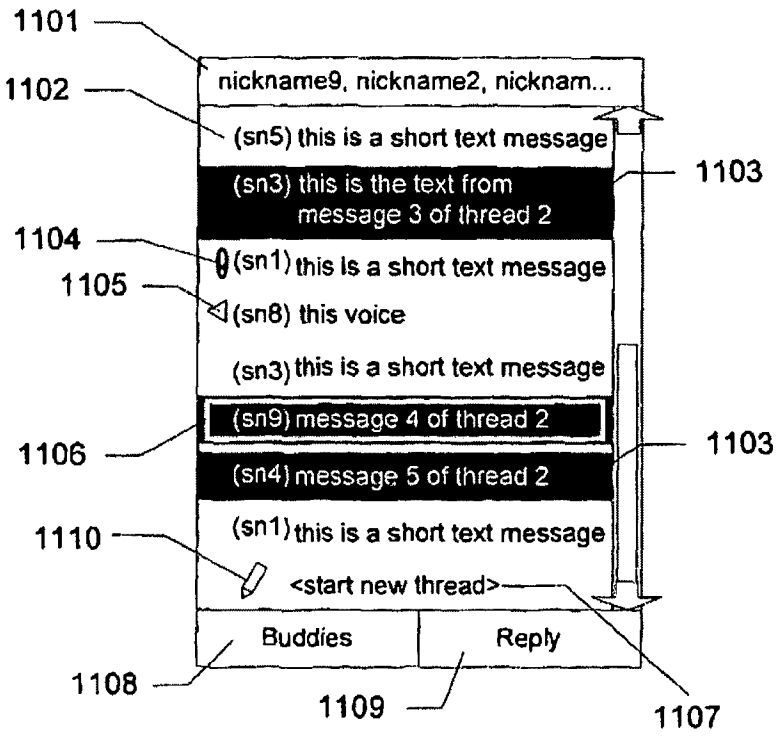

FIG. 11

Figure 11 of Griffin, reproduced above, is a schematic illustration of a chat history display. Ex. 1005, 2:66–67.

Petitioner further contends, for reasons discussed with respect to claim 14, it would have been obvious for terminal 100's storage of displayed messages to be a database similar to that described in Clark. 1798 Pet. 54. We agree with Petitioner, and we also note that Patent Owner does not argue dependent claims 16 and 30 separately from claims 14 and 28. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claims 16 and 30 are unpatentable as obvious over the combination of Griffin, Zydney, and Clark.

d. Dependent Claims 17 and 31

Claim 17 depends from claim 14 and further recites "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." Ex. 1001, 25:27–30. Claim 31 depends from claim 28 and further recites "wherein the instant voice messaging application includes a file manager system storing, deleting and retrieving the instant voice messages from the message database in response to a user request." *Id.* at 26:44–47. Petitioner explains that Griffin stores inbound and outbound messages in terminal 100's permanent storage in response to a user selection of an option presented by "[c]lick-holding the right softkey" (e.g., when viewing the inbound chat message display shown in Figure 13). 1798 Pet. 56 (citing Ex. 1005, 12:38–42); *see also id.* at 60 (relying for claim 31 on arguments with respect to claim 17). Furthermore, Petitioner identifies Griffin's chat history display, referenced in our analysis of claims 16 and 30 above, which lists the chat messages stored at the mobile terminal, each of which can be selected for playback, which means that the chat message is retrieved from storage 305 of terminal 100. *Id.* (citing Ex. 1005, 5:42–48, 10:20–25, 10:39–47, 12:38–42; Ex. 1002 ¶ 305). From these disclosures, we are persuaded that the software of Griffin's mobile terminal includes a file manager system for storing and retrieving the instant voice message in response to a user's selection to save the message (storing) and for playback of the message (retrieving). Because, according to our analysis regarding claims 14 and 28, we have determined that Griffin would include a message database at the mobile terminal for organizing the speech chat messages, any such storing or retrieving of speech chat messages would be performed in connection with the message store in which the speech chat messages are stored. Accordingly, we are persuaded that Griffin, in view of Clark's teachings as discussed above with respect to

claim 14, teaches the limitation of "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," as recited in claim 17, and further, "in response to a user request," as recited in claim 31.

Petitioner argues in the alternative that, if Patent Owner characterizes the claim language as requiring all three functions (storing, deleting, and retrieving)—which we note that claim 31 does—Clark additionally teaches deleting messages. 1798 Pet. 56–57. Although Patent Owner misquotes the claim language of claim 17 as "file manager system storing, retrieving, and deleting the instant voice message" (*see, e.g.*, 1798 PO Resp. 48), Patent Owner's arguments do not seem to distinguish the claim based on whether the performing of "at least one" of the three functions requires performance of all three functions. Rather, Patent Owner argues that the claim language requires the recited "file manager system" included in "the instant voice messaging application" to be located in a sending device. *Id.* at 48–49 (citing claims 13, 16, 17, and 29–31). Patent Owner argues against the combination of Griffin and Clark asserted as teaching the *deleting* function of the file manager system. Petitioner, however, has shown that Griffin *alone* performs *storing and retrieving*—two of the recited functions. 1798 Pet. 56. The language of claim 17, in the context of the specification, does not require all three functions to be performed, as it states that the "file manager system perform[s] *at least one* of storing, deleting and retrieving . . . ." *See* Ex. 1001, 12:38–40 (emphasis added) ("The file manager 308 services requests from the user to record, delete or retrieve messages to/from the message database 310."). Accordingly, Patent

Owner's arguments focusing on the deleting function disclosures of Clark are not responsive to Petitioner's contention that Griffin alone teaches at least one of the recited functions.

As to Griffin's teachings of storing and retrieving, Patent Owner argues that Griffin's sender does not store a copy of messages sent. 1798 PO Resp. 49–50. We are not persuaded by Patent Owner's arguments. Griffin expressly discloses echoing, which is where the broadcaster sends a copy of the outbound chat message to the transmitting terminal or where the transmitting terminal directly copies the message to the local display. Ex. 1005, 10:25–52. In this manner, we find that Griffin teaches that the speech chat message is copied at the sending device, and, thus, stored at the sending mobile terminal, which is sufficient for claim 17. Moreover, we agree with Petitioner that Clark discloses the third function, of deleting, as required by claim 31. Patent Owner's arguments to the contrary are not persuasive.

Having fully considered the parties' respective arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claims 17 and 31 are unpatentable as obvious over the combination of Griffin, Zydney, and Clark.

e. Dependent Claims 19 and 33

Claims 19 and 33 depend from claims 13 and 27, respectively, and each further recites "wherein the instant voice messaging application includes an encryption/decryption system for encrypting the instant voice messages to be transmitted over the packet-switched network and decrypting the instant voice messages received over the packet-switched network." Ex. 1001, 25:36–41, 26:53–58. Petitioner relies on Väänänen's teachings of

encrypting the finished recording of the voice message before sending the message to the recipient. 1798 Pet. 61–62 (citing Ex. 1008, 1:3–8, 2:25–3:2, 5:1–30; Ex. 1002 ¶¶ 84–85); *see also id.* at 64 (relying for claim 33 on arguments with respect to claim 19). Väänänen also teaches that, to play the message, the recipient terminal decrypts the file prior to opening the message. *Id.* at 62 (citing Ex. 1008, 18:4–10). Petitioner argues, and we agree, that it would have been obvious to encrypt/decrypt Griffin's speech chat messages communicated to/from packet-based network 203. *Id.* In particular, Petitioner argues that the encryption/decryption technique would secure the privacy of the message content. *Id.* at 63 (citing Ex. 1005, 5:38–40; Ex. 1002 ¶ 324). Dr. Haas's testimony, which we credit, establishes that encryption and decryption of messages was well-known, as taught in Väänänen, and that Griffin already provides for encryption at the server side, which is evidence that Griffin contemplates, and thus provides explicit motivation for, securing the privacy of the message in its system. Ex. 1002 ¶¶ 324–326. Patent Owner does not challenge Petitioner's showing for claims 19 and 33 separately from claims 3 (from which claim 13 depends) and 27. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claims 19 and 33 are unpatentable as obvious over the combination of Griffin, Zydney, and Väänänen.

f. Independent Claim 24

In a similar manner as for claim 3, Petitioner relies on the combined teachings of Griffin and Zydney for the "communication platform system" and "network interface" limitations of claim 24 and relies on Griffin alone

for the "messaging system" limitation of claim 24. 1798 Pet. 64–65. With respect to the further limitations of claim 24, "wherein the messaging system receives connection object messages from the plurality of instant voice message client systems" and "wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems," Petitioner relies on Low's disclosure that data packets transmitted from IM clients may include commands establishing and maintaining the logical connections between a client and a server, as well as data representing the state of the connection. *Id.* at 67. In particular, Petitioner contends, "*Low* explains that IM clients send commands to the IM gateway that change 'the user's state or presence' on the IM network," where "[t]hese include commands initiating the user's login/logout from the network (i.e., commands (e.g., code) establishing and maintaining the logical connections) and commands indicating that the IM client user is 'away, idle, or does not wish to be disturbed' (i.e., data representing the state of the connection)." *Id.* (citing Ex. 1010 ¶¶ 36–39, 42, 45, 46, 50). Petitioner points out that Table 1 of Low, reproduced below, shows that Low's IM gateway includes a state table that is created based on commands and data sent by IM clients and maintains the "state" of the IM clients. *Id.* (citing Ex. 1010 ¶ 39).

TABLE 1

UID	screen name	protocol	state	IP address/mobile #	mode
0123456	rab	AIM	online	128.256.32.2	1
0123457	fink	MSN	away	128.256.76.81	1
0123458	elmo	Yahoo	online	128.256.43.22	1
8745682	nos	HTML	online	128.256.87.24	1
1093278	syd	GSM	con-nected	+61 0408 967 522	1
1099803	miro	GSM	online	+61 0411 857 937	1
8942084	smithamat	MSN	offline		

Table 1, above, depicts a state table for Low's gateway 2, including each user's screen name, IM protocol, presence state, IP address or mobile telephone number, and a permit/deny mode. Ex. 1010 ¶ 39.

Relying on Dr. Haas's testimony, Petitioner contends that Low accordingly "discloses an instant messaging system where IM clients send data and commands (e.g., code) to a server that represent the state of the connection with the server and for establishing and maintaining their logical connections with the server, like the 'connection object' described in the specification of the '622 Patent" (*id.* at 69 (citing Ex. 1001, 14:47–63; Ex. 1002 ¶ 339)), and that in view of the teachings of Low and the knowledge of a person of ordinary skill in the art, "it would have been obvious to a [person of ordinary skill in the art] to modify the *Griffin-Zydney* system/process such that broadcaster 303 receives data and/or commands from each terminal 100 representing the state of the connection with server complex 204 and for establishing and maintaining the logical connection with server complex 204" (*id.*).

In response to Petitioner's contentions, Patent Owner asserts that Petitioner fails to prove that the proposed combination of Griffin, Zydney,

and Low renders obvious "connection object messages includ[ing] data representing a state of a local connection with a given one of the plurality of instant voice message client systems." 1798 PO Resp. 25–26. In particular, Patent Owner contends, "a command to change to a state (e.g., as provided by [P]etition[er] identifying example [sic] 'sign-on' command) is not the same thing as a message with a current state." *Id.* at 25. Patent Owner further contends, "[a] client identifying what it wants to do is not communication [of] what it has already done," and "[a]dditionally, the claimed 'state of a logical connection' in the 'connection object message' is with 'one of the plurality of ***instant voice message client systems***,' which can be distinct from the 'messaging system' that is receiving the 'connection objection [sic] message.'" *Id.* at 25–26. Still further, Patent Owner contends that Zydney expressly teaches away from the proposed combination. *Id.* at 51–52. In particular, Patent Owner contends that, because Zydney's voice container contains "no methods," whereas the proposed combination with Low "would require containment of 'commands . . . commands . . . and commands . . . ,'" Zydney teaches away from the combination and cannot be modified as proposed. *Id.* at 51 (ellipses in original) (citing Ex. 1006, 12:6–8; Pet. 67).

We are persuaded by Petitioner's arguments and evidence with respect to claim 24, Patent Owner's arguments notwithstanding. We are persuaded, in particular, by Petitioner's explanation that Low describes an instant messaging system in which IM clients transmit data packets to an IM gateway not only to initiate a user's login/logout from the network (i.e., the "sign_on" command on which Patent Owner's arguments are focused), but also to indicate that the IM client user is "away, idle, or does not wish to be

disturbed," or to maintain the network connection (i.e., "KEEP_ALIVE packets"). 1798 Pet. 66–68 (citing Ex. 1002 ¶¶ 334–339; Ex. 1010 ¶¶ 36–39); 1798 Reply 13–14; *see also* Ex. 1010 ¶ 39 (table showing states including "online," "away," and "connected"). We agree with Petitioner that Patent Owner's attorney argument, which includes no citations to the prior art, the challenged patent, or either expert's testimony, and addresses only the first of the exemplary object messages identified by Petitioner, "falls short." 1798 Reply 13–14.

Moreover, although Patent Owner accurately cites Zydney as stating that a "voice container" refers to a container object that contains no methods (*see* Ex. 1006, 12:6–8), we are not persuaded that the "commands" described by Low are "methods," as that term is used by Zydney. In any case, even assuming *arguendo* that the "commands" recited by Low are properly understood to be "methods" within the meaning of that term as used in Zydney's definition of a voice container, we do not understand Petitioner to propose placing Low's connection object messages inside Zydney's voice containers. *See* 1798 Pet. 69–70; *see also* 1798 Reply 14 ("[Patent Owner]'s argument that Zydney teaches away from the combination is based on a combination that was never proposed—i.e., placing Low's connection object messages inside Zydney's voice containers. ([1798 PO] Resp. 51–52.) Instead, Petitioner explains that it would have been obvious for Griffin's broadcaster 303 (located in server complex 204) to receive 'data and or commands from each terminal 100 representing the state of the connection with server complex 204 and for maintaining the logical connection with server complex 204,' as taught in Low. ([1798] Pet.[] 69–70; Ex. 1002 ¶¶ 340–341.)"). And indeed, claim 24 does not require that the recited

"connection objects" be included within the recited instant voice message itself. Accordingly, even if Low's "commands" are properly understood to include a "method" within the meaning of that term as used in Zydney's definition of a voice container, we disagree with Patent Owner's argument that Zydney teaches away from the proposed combination.

Accordingly, after full consideration of the parties' arguments and cited evidence, we are persuaded, for the reasons stated by Petitioner and discussed above, that Petitioner has established by a preponderance of the evidence that claim 24 is unpatentable as obvious over the combination of Griffin, Zydney, and Low.

g. Dependent Claims 25 and 26

Claim 25 depends from claim 24 and further recites "wherein the connection object messages identifies [sic] at least one of a socket, a size of data to be transferred and a priority of the data." Ex. 1001, 26:9–11. Claim 26 depends from claim 24 and further recites "wherein the communication platform system populates a connection list for the plurality of instant voice message client systems with the data in the connection object messages received from each of the plurality of instant voice message client systems." *Id.* at 26:12–16.

With respect to claim 25, Petitioner contends that Griffin in view of Zydney and Low discloses the recited limitations for reasons similar to those discussed with respect to claim 24 regarding information identifying a socket, noting that the claim language only requires that the connection object messages identify "at least one" of a socket, a size of data to be transferred, and a priority of the data. 1798 Pet. 71 (citing Ex. 1002 ¶ 345). We agree, and we also note that Patent Owner does not argue dependent

claim 25 separately from claim 24. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claim 25 is unpatentable as obvious over the combination of Griffin, Zydney, and Low.

With respect to the additional limitation of claim 26, Petitioner contends it would have been obvious to a person of ordinary skill in the art to modify the system of the Griffin/Zydney combination such that Griffin's broadcaster 303 would receive "connection object messages" similar to those described by Low. 1798 Pet. 73. Petitioner argues it also would have been obvious for the system to populate a connection list (e.g., Griffin's presence data records 700) with data received from each terminal 100, including connection state information and information that describes a socket. *Id.* (citing Ex. 1002 ¶¶ 349–355). Indeed, Petitioner points out, Figure 7 of Griffin shows that presence data records 700 are populated with state information 702 and current address 703 for each terminal 100, and Low similarly discloses populating a database with information received from IM clients. *Id.* at 73–74 (citing Ex. 1005, 5:15–22; Ex. 1010 ¶ 39). Relying on Dr. Haas's testimony, Petitioner contends it would have been straightforward to a person of ordinary skill in the art either for Griffin's presence manager 302 to store such information received in connection object messages in database records as described by Griffin and Low or to configure the system to populate buddy lists on terminals 100 with status information received from each terminal, to provide users with the ability to determine whether other users are available to receive messages. *Id.* at 74–76 (citing Ex. 1002 ¶¶ 352–354; Ex. 1005, 5:9–30, 6:61–7:1, 7:39–49, 8:1–3, 8:15–17, 8:40–45, 8:47–52, 9:24–28, Fig. 6; Ex. 1010 ¶¶ 36, 39, 42, 43,

50). We agree and also note that Patent Owner does not argue dependent claim 26 separately from claim 24. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that claim 26 is unpatentable as obvious over the combination of Griffin, Zydney, and Low.

C. Summary

Upon due consideration of the trial record, we conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 3, 4, 6–8, 10–19, 21–35, 38, and 39 of the '622 patent are unpatentable on the grounds presented.

V. MOTION TO EXCLUDE

Patent Owner filed a Motion to Exclude addressing portions of deposition transcripts alleged to "exceed the permissible scope of cross examination." Mot. 2. In particular, Patent Owner asserts that Petitioner questioned Mr. Easttom on matters outside the scope of his direct testimony in violation of 37 C.F.R. § 42.53(d)(4)(ii). *Id.* Patent Owner provides a few examples of "hypotheticals" that were not contemplated in his direct testimony. For instance, Patent Owner points to the question about whether a delay of an hour at the time would be an instant message. *Id.* (citing Ex. 1040, 31:25–32:6, 32:13–32:24, 33:6–33:12). Patent Owner asserts that it objected to the questions as outside the permissible scope of the deposition. *Id.* at 3. The Motion then proceeds to list, without explanation, 89 portions of three deposition transcripts alleged to contain objectionable questions. *Id.* at 3–5.

Petitioner responds that, given the breadth of Mr. Easttom's direct testimony, Petitioner's cross-examination questions were within the scope of permissible questioning. Opp'n 4–9. Petitioner then identifies for each of the multitude of citations to the transcripts in Patent Owner's motion the correlation to Mr. Easttom's declarations in these and co-pending proceedings. *Id.* at 9–12 (citing 1797 Easttom Decl.; 1798 Easttom Decl.; IPR2017-01799, Exhibit 2001; IPR2017-01800, Exhibits 2001 and 2009; IPR2017-01801, Exhibit 2001; IPR2017-01802, Exhibit 2001). Finally, Petitioner argues that Patent Owner's Motion is facially deficient as it leaves it to the Board to figure out "whether and where the objected-to portions of Mr. Easttom's testimony are relied upon in the record, which is improper." *Id.* at 4.

We agree with Petitioner. First, Patent Owner, as the movant, has the burden to show that it is entitled to the relief requested. 37 C.F.R. § 42.20(c). Patent Owner's general allegations of questions and hypotheticals being outside the scope, with a lengthy list of deposition citations without explanation, are insufficient to carry the burden. For this reason alone, the Motion is *denied*.

Moreover, in reviewing the transcript of the deposition testimony, we highly doubt that the lodged objections are sustainable. For instance, asking Mr. Easttom about Figure 1 of the Griffin patent was objected to under a "form, scope" objection. Ex. 1040, 148:22–25. We do not see anything wrong with the form of the question. And certainly we are puzzled as to how the scope is exceeded when Mr. Easttom testified that he relied on Griffin and provided details explanations of how Griffin operates. 1797 Easttom Decl. ¶¶ 4, 23–31; 1798 Easttom Decl. ¶¶ 4, 23–31.

Petitioner's Opposition also provides adequate explanation to rebut Patent Owner's general allegation of the irrelevance of the questions to the direct testimony of Mr. Easttom. Opp'n 9–12. Relying on Petitioner's explanations, in light of Patent Owner's very general allegations, we find an additional basis to *deny* Patent Owner's Motion to Exclude.

VI. ORDER

Accordingly, it is

ORDERED that claims 3, 4, 6–8, 10–19, 21–35, 38, and 39 of the '622 patent have been shown to be unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Exclude is denied; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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Paper 37
Entered: January 16, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., WHATSAPP INC., HUAWEI DEVICE CO., LTD., LG ELECTRONICS, INC., and APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01667[1]
Patent 8,724,622 B2

FACEBOOK, INC., WHATSAPP INC., and APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01668[2]
Patent 8,724,622 B2

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[1] Huawei Device Co., Ltd. and LG Electronics, Inc., which filed a petition in Case IPR2017-02090, and Apple Inc., which filed a petition in Case IPR2018-00579, have been joined as petitioners in IPR2017-01667.

[2] Apple Inc., which filed a petition in Case IPR2018-00580, has been joined as a petitioner in IPR2017-01668.

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

BOUDREAU, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318

I. INTRODUCTION

Facebook, Inc. and WhatsApp Inc. filed a Petition in each of the captioned proceedings on June 22, 2017, collectively requesting *inter partes* review of claims 3–8, 10–35, 38, and 39 of U.S. Patent No. 8,724,622 B2 ("the '622 patent"). IPR2017-01667, Paper 2 ("1667 Petition" or "1667 Pet."); IPR2017-01668, Paper 2 ("1668 Petition" or "1668 Pet."). Each proceeding challenges a different set of claims, as follows:

Proceeding	Challenged Claim Set of the '622 Patent
IPR2017-01667	3, 6–8, 10, 11, 13–23, 27–35, 38, 39
IPR2017-01668	4, 5, 12, 24–26

See 1667 Pet. 1; 1668 Pet. 1. Patent Owner[3] filed a Preliminary Response to each Petition. IPR2017-01667, Paper 6 ("1667 Prelim. Resp."); IPR2017-

[3] Uniloc Luxembourg S.A. was initially identified as the owner of the '622 patent. *See, e.g.*, IPR2017-01667, Paper 3, 1. In Updated Mandatory Notices filed August 25, 2018, Uniloc 2017 LLC is identified as the owner of the '622 patent. IPR2017-01667, Paper 30; IPR2017-01668, Paper 28.

01668, Paper 6 ("1668 Prelim. Resp."). We instituted *inter partes* review pursuant to 35 U.S.C. § 314 as to all challenged claims. IPR2017-01667, Paper 8 ("1667 Dec. on Inst."); IPR2017-01668, Paper 8 ("1668 Dec. on Inst."). During the pendency of the proceedings, Huawei Device Co., Ltd. and LG Electronics, Inc. filed a petition and motion for joinder requesting to join IPR2017-01667, which we granted. IPR2017-01667, Paper 12. Similarly, Apple Inc. filed petitions and motions for joinder requesting to join IPR2017-01667 and IPR2017-01668, which we also granted. IPR2017-01667, Paper 29; IPR2017-01668, Paper 27.

Subsequent to institution, Patent Owner filed a Patent Owner Response in each case. IPR2017-01667, Paper 17 ("1667 PO Resp."); IPR2017-01668, Paper 16 ("1668 PO Resp."). Petitioner[4] then filed Replies. IPR2017-01667, Paper 24 ("1667 Reply"); IPR2017-01668, Paper 22 ("1668 Reply"). Patent Owner also filed a Motion to Exclude as Paper 21 in each case ("Mot. Excl."), and Petitioner filed an Opposition as Paper 24 in each case ("Opp'n"). We held a consolidated oral argument in both proceedings, as well as in related proceeding IPR2017-01428, on August 30, 2018. A transcript of the oral hearing ("Tr.") has been entered into the record of IPR2017-01667 as Paper 31 and into the record of IPR2017-01668 as Paper 29.

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[4] References herein to "Petitioner" refer to Facebook, Inc., WhatsApp Inc., Huawei Device Co., Ltd., LG Electronics, Inc, and Apple Inc., collectively, where reference is made to IPR2017-01667, and to Facebook, Inc., WhatsApp Inc., and Apple Inc., collectively, where reference is made to IPR2017-01668.

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine that Petitioner has shown by a preponderance of the evidence that claims 3, 6–8, 10–35, 38, and 39 of the '622 patent are unpatentable, but has not shown that claims 4 and 5 are unpatentable.

II. CONSOLIDATION OF PROCEEDINGS

The two captioned proceedings involve the '622 patent. Although each proceeding challenges the patentability of a different set of claims, there are disputed claim terms across the challenged claims and the primary prior art is identical. For instance, all the claims recite the term "instant voice message," which we construe below, and the "Zydney" reference (identified with particularity below) is asserted as prior art in both proceedings. Consolidation is appropriate where, as here, the Board can more efficiently handle the common issues and evidence and also remain consistent across proceedings. Under 35 U.S.C. § 315(d) the Director may determine the manner in which these pending proceedings may proceed, including "providing for stay, transfer, consolidation, or termination of any such matter or proceeding." *See also* 37 C.F.R. § 42.4(a) ("The Board institutes the trial on behalf of the Director."). There is no specific Board Rule that governs consolidation of cases. But 37 C.F.R. § 42.5(a) allows the Board to determine a proper course of conduct in a proceeding for any situation not specifically covered by the rules and to enter non-final orders to administer the proceeding. Therefore, on behalf of the Director under

§ 315(d), and for a more efficient administration of these proceedings, we consolidate IPR2017-01667 and IPR2017-01668 for purposes of rendering this Final Written Decision in which we construe the term "instant voice message" and determine whether the asserted prior art teaches the properly construed "instant voice message."

III. BACKGROUND

A. Related Matters

The parties indicate that the '622 patent is involved in *Uniloc USA, Inc. v. Apple Inc.*, No. 2:16-cv-00638 (E.D. Tex.), *Uniloc USA, Inc. v. WhatsApp Inc.*, Case and 2:16-cv-00645 (E.D. Tex.), *Uniloc USA, Inc. v. Facebook, Inc.*, No. 2:16-cv-00728 (E.D. Tex.), *Uniloc USA, Inc. v. LG Electronics USA, Inc.*, No. 2:16-cv-00991 (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. *See, e.g.*, IPR2017-01667, Paper 30, 3.

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 IPR2017-01797 and IPR2017-01798 (filed by Samsung Electronics America, Inc.), in which we instituted *inter partes* review on February 6, 2018; and Cases IPR2017-02080 and IPR2017-02081 (filed by Google, Inc.), which we denied.

B. Overview of the '622 Patent[5]

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.

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[5] Reference to the '622 patent is always to the exhibit number in IPR2017-01667.

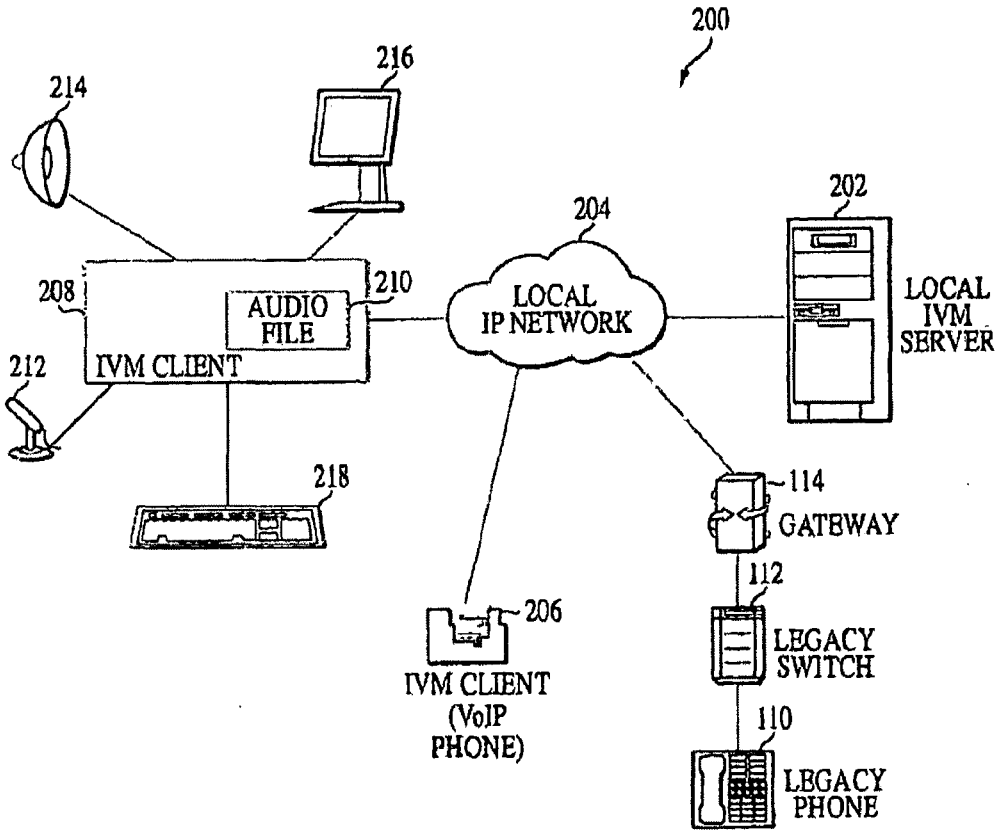

FIG. 2

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.

C. Illustrative Claims

Of the challenged claims, claims 3, 24, 27, and 38 are independent. Claims 3, 24, and 27 are illustrative of the challenged claims and are reproduced below.

3. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and

wherein the instant voice message includes an object field including a digitized audio file.

24. A system comprising:

a network interface connected to a packet-switched network;

a messaging system communicating with a plurality of instant voice message client systems via the network interface; and

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

wherein the messaging system receives connection object messages from the plurality of instant voice message client systems, wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems.

27. A system comprising:

a client device;

a network interface coupled to the client device and connecting the client device to a packet-switched network; and

an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,

wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message.

Ex. 1001, 24:12–27, 25:59–26:8, 26:17–30.

D. Asserted Prior Art and Instituted Grounds of Unpatentability

These proceedings rely on the following prior art references:

a) *Zydney*: PCT App. Pub. No. WO 01/11824 A2, published Feb. 15, 2001, filed in IPR2017-01667 as Exhibit 1003 and in IPR2017-01668 as Exhibit 1103, with line numbers added by Petitioner;

b) *Shinder*: Excerpts from Debra Littlejohn Shinder, *Computer Networking Essentials* (2002), filed in IPR2017-01667 as Exhibit 1014 and in IPR2017-01668 as Exhibit 1114;

c) *Clark*: U.S. Patent No. 6,725,228 B1, issued Apr. 20, 2004, filed in IPR2017-01667 as Exhibit 1008 and in IPR2017-01668 as Exhibit 1108;

d) *Appelman*: U.S. Patent No. 6,750,881 B1, issued June 15, 2004, filed in IPR2017-01667 as Exhibit 1004 and in IPR2017-01668 as Exhibit 1104;

e) *Hethmon*: Excerpts from Paul S. Hethmon, *Illustrated Guide to HTTP* (1997), filed in IPR2017-01667 as Exhibit 1009 and in IPR2017-01668 as Exhibit 1109;

f) *Microsoft*: Excerpts from Microsoft Press Computer Dictionary (1991), filed in IPR2017-01667 as Exhibit 1018 and in IPR2017-01668 as Exhibit 1118; and

g) *Moghe*: U.S. Patent No. 6,173,323 B1, issued Jan. 9, 2001, filed in IPR2017-01667 as Exhibit 1019 and in IPR2017-01668 as Exhibit 1119.

The following grounds of unpatentability are at issue:

Challenged Claim(s)	**Basis**	**References**
3, 6–8, 10, 11, 13, 18 21, 23, 27, 32–35, and 38	§ 103(a)	Zydncy and Shinder
14–17 and 28–31	§ 103(a)	Zydney, Shinder, and Clark

Challenged Claim(s)	Basis	References
22 and 39	§ 103(a)	Zydney, Shinder, and Appelman
4, 5, and 24–26	§ 103(a)	Zydney, Shinder, and Hethmon
12	§ 103(a)	Zydney Shinder, Microsoft, and Moghe

See 1667 Pet. 5; 1668 Pet. 5. Each Petition also cites declaration testimony as follows: Declaration of Tal Lavian, Ph.D., filed as Exhibit 1002 in IPR2017-01667 ("1667 Lavian Decl."); and Declaration of Tal Lavian, Ph.D., filed as Exhibit 1102 in IPR2017-01668 ("1668 Lavian Decl.").

Patent Owner cites declaration testimony in support of its arguments of patentability as follows: Declaration of William C. Easttom II, filed as Exhibit 2001 in IPR2017-01667 ("1667 Easttom Decl."); and Declaration of William C. Easttom II, filed as Exhibit 2001 in IPR2017-01668 ("1668 Easttom Decl.").

IV. ANALYSIS

A. Claim Construction

Claim terms in an unexpired patent, as here, are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b) (2016);[6] *Cuozzo Speed Techs., LLC v.*

[6] A recent amendment to this rule does not apply here, because the Petition was filed before November 13, 2018. *See* "Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before

Lee, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim interpretation standard to be applied in *inter partes* reviews). Under the broadest reasonable interpretation standard, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We note that only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

In the 1667 Petition, the terms "instant voice messaging application," "client platform system," and "communication platform system" were identified for claim construction. 1667 Pet. 6–11. In the 1668 Petition, the terms "connection object messages" and "communication platform system" were identified for claim construction. We did not construe those terms in our Decisions on Institution; they are discussed below.

1. Instant Voice Message

Independent challenged claims 3, 27, and 38 recite the term "instant voice message." In particular, claim 3 recites a messaging system that "receives an instant voice message" from one of a plurality of instant voice

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the Patent Trial and Appeal Board," 83 Fed. Reg. 51,340 (Oct. 11, 2018) (to be codified at 37 C.F.R. pt. 42).

message client systems, "wherein the instant voice message includes an object field including a digitized audio file." Claims 27 and 38 recite a client platform system for "generating an instant voice message and a messaging system for transmitting the instant voice message." Claim 27 further requires an "instant voice messaging application" that "includes a document handler system for attaching one or more files to the instant voice message." Certain of the challenged dependent claims recite additional limitations concerning, for example, additional fields included in the instant voice message (claims 4–8), storage, deletion, or retrieval of instant voice messages (claims 10, 14, 17, 28, 31), the generation of the instant voice messages (claims 13, 18, 32), encryption/decryption of instant voice messages (claims 19, 33), compression/decompression of instant voice messages (claims 20, 34), effects indicating receipt of instant voice messages (claims 23, 35), and display of instant voice messages (claim 30).

Our Institution Decision in IPR2017-01667 noted Patent Owner's arguments regarding the "instant voice message" centered on the scope of the term. 1667 Dec. on Inst. 18, 22–23. Patent Owner had argued an implied construction in which "instant voice message" encompasses only the voice message. *Id.* at 19, 23. The parties were invited to brief the claim construction during trial. *Id.* at 19–20, 23.

In its Response in IPR2017-01667, Patent Owner proposed that an "instant voice message" is "an audio file recording voice data." 1667 PO Resp. 11–13, 15. In particular, Patent Owner relied on the specification's use of "i.e." to indicate lexicography in equating the "instant voice message"

to audio file 210. *Id.* at 12–13 (citing various portions of the specification that state "the digitized audio file 210 (i.e., instant voice message)").

Petitioner, on the other hand, argued in Reply that the "instant voice message" is not synonymous with an audio file recording voice data because a related patent (having the same specification as the '622 patent) has a claim that recites "recording the instant voice message in an audio file." 1667 Reply 5 (citing U.S. Patent No. 8,199,747, claim 1). According to Petitioner, if an "instant voice message" is an "audio file" then the language of that claim requiring the recording of the instant voice message "in an audio file" would be superfluous. *Id.* More importantly, Petitioner also argued that the "audio file" is one of two disclosed embodiments of the "instant voice message." *Id.* at 3–4. Specifically, the '622 patent describes that instead of taking the form of an audio file, the instant voice message is generated in real time by buffering successive portions of the instant voice message. Ex. 1001, 11:31–58. If we were to adopt Patent Owner's proposed construction of an audio file, according to Petitioner, we would exclude a preferred embodiment where the instant voice message is described as buffered successive portions. 1667 Reply 4–5 (citing *Epos Techs. Ltd. v. Pegasus Techs. Ltd.*, 766 F.3d 1338, 1347 (Fed. Cir. 2014)). After persuasively arguing against Patent Owner's proposed construction, Petitioner proposed no alternative construction, arguing instead that "instant voice message" "can be left to its plain and ordinary meaning, encompassing the instant voice messages disclosed by Zydney." *Id.* at 5.

At oral argument, we renewed the concern for the appropriate scope of the term "instant voice message" in light of the record developed to that

point. Tr. 9:12–12:13. We also entered as Exhibit 3001 in the record of both proceedings a dictionary definition of "instant messaging." Thereafter, we issued an order authorizing additional briefing on claim construction of "instant voice message" and its applicability to the asserted prior art. IPR2017-01667, Paper 32 ("Order on Claim Constr."); *also* IPR2017-01668, Paper 30. The parties simultaneously filed initial claim construction briefs and responsive claim construction briefs, in accordance with that order. IPR2017-01667, Papers 33–36; IPR2017-01668, Papers 31–34.

After reviewing the parties' briefs, we construe "instant voice message" to mean "data content including a representation of an audio message." This accords with Patent Owner's position that the '622 patent specification consistently refers to the "instant voice message" as content. IPR2017-01667, Paper 33, 2–4 ("PO Supplemental Br."). In particular, we are persuaded that the specification describes the "instant voice message" as content in three different embodiments. First, in the "record mode" embodiment, by describing the "instant voice message" as an audio file (Ex 1001, 8:7–11, 8:26–27, 9:64–65, 10:38–39, 10:45–46, 12:40–41, 16:22, 17:23–24, 18:6–7, 18:58, 18:64–65, 19:46–47, 19:53), the '622 patent specification focuses on the digitized audio file itself being the "instant voice message." *See* PO Supplemental Br. 3. The digitized audio file is the user's speech that the client records. *See* Ex. 1001, 8:8–11. Second, in the "intercom mode," the specification describes buffering "successive portions of the instant voice message," referring thusly to portions of the user's speech that are written to a buffer. *Id.* at 11:35–44. Again, the "instant

voice message" includes the digitized audio. In a third embodiment, the specification describes a "message object" with an object field in this manner: "The content of the object field is a block of data being carried by the message object, which may be, for example, a digitized instant voice message." *Id.* at 14:37–40. These embodiments, thus, paint a picture of the "instant voice message" as first and foremost being the content of the message, or the user's speech, in some digitized form. Although the manner in which the data content is partitioned, stored, and delivered may vary from embodiment to embodiment (such as from audio file to digitized audio in a buffer), what is important is that the "instant voice message" always refers to the digitized audio message.

Patent Owner argues that lexicography mandates the equivalence of content with "instant voice message." In particular, Patent Owner argues that in describing the "record mode" the specification uses the abbreviation "i.e." to consistently *define* the "instant voice message" as voice data content. *See* PO Supplemental Br. 3. The use of "i.e." has been held to signal an intent of the inventor to define the word to which it refers. *Edwards Lifesciences LLC v. Cook Inc.*, 582 F.3d 1322, 1334 (Fed. Cir. 2009). The use of "i.e.," alone, however, is not conclusive of an intent to define the term. The specification must use the term "instant voice message" consistently as an audio file for the use of "i.e." to be accorded such definitional status. *See SkinMedica, Inc. v. Histogen Inc.*, 727 F.3d 1187, 1202 (Fed. Cir. 2013) (explaining that "i.e." is definitional when it "comports with the inventors' other uses . . . in the specification and with each and every other reference").

Although we agree that there is repeated use of "i.e." in the specification to signal an equivalency of "instant voice message" with an audio file, the specification uses "instant voice message" inconsistently by describing non-audio-file uses of "instant voice message." For instance, the specification describes the "intercom mode" of instant voice messaging distinctly from the "record mode" (audio file embodiment). Ex. 1001, 7:57–61. "In the 'intercom mode,' *instead of creating an audio file 210*, one or more buffers (not shown) of a predetermined size are generated in the IVM client 26, 208 or local IVM server 202." *Id.* at 11:36–39 (emphasis added). This alternative to creating an audio file is further described as buffering successive portions of the instant voice message. *Id.* at 11:39–41. Thus, the use of "i.e." is not definitional since the "instant voice message" may take the form of successive portions of the digitized speech that are buffered, *instead of an audio file.* Therefore, although the specification consistently relates "instant voice message" to content, is does not limit that content to any particular form or structure (audio file or portions of digitized speech).

From the description of the three embodiments identified above, we conclude that the "instant voice message" is data content, and more specifically, is data content that includes a representation of an audio message. In all embodiments, the "instant voice message" refers, at a minimum, to the digitized speech, regardless of whether it is contained in an audio file, successive portions stored in a buffer, or a block of data in an object field. For this reason, we do not agree with Petitioner's position, advanced in its Supplemental Brief, that the construction of "instant voice message" should be "a data *structure* including a representation of an

audible message." IPR2017-01667, Paper 34, 1 ("Pet. Supplemental Br.") (emphasis added); *see also* Tr. 62:17–5 (Patent Owner further arguing that the phrase "audio message" tracks more closely the intrinsic evidence than the phrase "audible message"). Although we agree that the audio file and buffered portions form a data structure (Pet. Supplemental Br. 1–2), we are not persuaded that referring to the "instant voice message" as a data structure captures *what it is*; but rather, such construction would place undue focus on the instant voice message's *form*. The specification describes three different data structures that may constitute the "instant voice message," signifying that its structure is not what defines the "instant voice message."

In contrast, the word "content" is more closely associated with how the specification describes the "instant voice message." For instance, as noted above with regard to the third embodiment (data carried by a message object), the "instant voice message" is "a block of data" that is also the *content* of the object field. Ex. 1001, 14:37–40. Likewise, the specification describes the "intercom mode" buffers as having "content" corresponding to successive portions of the "instant voice message," which content is transmitted to an IVM server as the buffers are filled. *See, e.g.*, *id.* at 11:41–49; 11:67–12:3 (describing writing audio of a predetermined size as the "content of the first buffer" and processing of the "audio contents of the buffers" before transmission); *see also* Tr. 55:21–56:14 (Patent Owner explaining that the content is binary information contained within the file or within the buffered data of the intercom mode, where the binary information may include structural information such as headers). None of the data

structures identified in the specification (e.g., audio file, successive portions of buffered data, or a block of data in an object field) clarify the essence of the "instant voice message," but they merely highlight that the digitized audio could be stored and manipulated in a variety of ways for processing and transmission.

Accordingly, we construe "instant voice message" as data content including a representation of an audio message. This determination, however, does not resolve all the disputes surrounding the term because Patent Owner also argues that attaching files to an "instant voice message" must be limited to attachments to the *data content itself.* PO Supplemental Br. 4–5 ("This reaffirms that the limitations at issue require an attachment to the data content, as opposed, for example, to a distinct and separately-generated data structure (like Zydney's 'voice container') that is used only to transport the data content and that is subsequently discarded."). Therefore, we analyze and construe below the claim's requirement of "attaching" files to the "instant voice message."

2. Attaching One or More Files to the Instant Voice Message

As noted above, claim 27 of the '622 patent recites that the "instant voice message application includes a document handler system for attaching one or more files to the instant voice message." Ex. 1001, 26:28–30.[7]

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[7] *See also* U.S. Patent No. 7,535,890, claim 9 (reciting "the client is enabled to attach one or more files to the instant voice message"); U.S. Patent No. 8,995,433, claims 9 and 14 (reciting, respectively, "instant voice message application attaches one or more files to the instant voice message" and

Although that claim requires attaching one or more files to the "instant voice message," we note that related patents recite attaching one or more files to an "audio file" instead. For instance, claim 2 of U.S. Patent No. 8,243,723, which shares the same disclosure with the '622 patent, recites that "the instant voice message includes one or more files attached to an audio file." Similarly, in claim 1 of related U.S. Patent No. 8,199,747, generating an "instant voice message" includes "attaching one or more files to the audio file." We include the above claim language in our discussion to highlight the challenge we face—whether to construe "attaching" or "attached" to *both* an "instant voice message" and an "audio file" to require attachment to the *data content*, notwithstanding the difference in claim terms.

We start with the claim language. As noted above, the claims of the '622 patent require attachment of one or more files *to the instant voice message*. The specification also describes "attachment" by linking:

> The attachment of one or more files is enabled conventionally via a methodology such as "drag-and-drop" and the like, which invokes the document handler 306 to make the appropriate linkages to the one or more files and flags the messaging system 320 that the instant voice message also has the attached one or more files.

Ex. 1001, 13:33–38. This passage also describes that, in addition to making linkages, flags alert the messaging system in the client device that the instant

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"wherein the instant voice messaging application invokes a document handler to create a link between the instant voice message and the one or more files").

voice message has an attachment. Thus, "attaching" creates *an association* between the one or more files and the instant voice message so that the system, once alerted, may transmit the instant voice message with the associated one or more files. This passage describes the attachment of files to an instant voice message in the "record mode," i.e., when the "instant voice message" is recorded in an audio file. *Id.* at 13:11–33 (describing how the audio file is recorded and processed before transmission, including giving the user options to attach documents). The specification provides no other detailed description of how to attach a file to an "instant voice message" in either the "record mode" or "intercom mode." It seems reasonable, therefore, that, in reciting attachment to an "instant voice message," when dealing with the audio file form of the message, the specification supports that attachment to an "audio file" is synonymous with attachment to an "instant voice message," because those claims would be referring to the "record mode." In claim 27 of the '622 patent, however, because the claim recites attaching to an "instant voice message," we are not concerned with what form or structure the "instant voice message" would have, as the claim does not require an audio file.

The discussion above brings us to the issue Patent Owner raises of whether attachment must be to the data content itself. PO Supplemental Br. 5. Patent Owner seeks to construe the "attachment to" phrase (and its variants) very narrowly, as in the sense of a physical appendage or the joining together of items. For instance, Patent Owner argues that attaching to the data content is different than attaching to a structure that is used to transport the data content. *Id.* Because the specification describes

"attaching" broadly, however, as making linkages and flagging, we are not persuaded that the "attachment" language recited in claim 27 of the '622 patent is confined to attachment *to the data content (audio file) itself* as Patent Owner argues. *See id.* at 4. Even though we have construed "instant voice message" as data content, an attachment to the "instant voice message" cannot be more limiting than the specification supports. The specification's linkage and flagging cause the system to handle the one or more files *as attachments* of the "instant voice message." The tangible difference between an "instant voice message" with an attachment and one without seems to be in whether the document handler has sufficiently linked the attachment and whether the flags inform the client system to associate the attachment for effective transmission to the server. Thus, as long as the client has sufficient information that the "instant voice message" has an attachment, the recited "attachment" is performed. Whether links or flags, or other like information is used, is not relevant to the particulars of the independent claims, as such details are not recited expressly.

Based on our review of the claim language, the specification, and the parties' arguments on claim construction, we determine that Patent Owner has not shown that the specification supports its narrow position that the recited attachment to an "instant voice message" involves a direct attachment to only the data content. Giving the term its plain and ordinary meaning in the context of the specification, as explained above, we construe "attaches . . . to the instant voice message" (and its variants in related patents) to mean indicating that another file (or files) is associated with the "instant voice message."

3. Instant Voice Messaging Application and Client Platform System

Petitioner proposes constructions for the terms "instant voice messaging application" and "client platform system." 1667 Pet. 6–10 (arguing for each element that the construction should be "hardware and/or software"). Patent Owner argues that Petitioner's proposed constructions are deficient because these terms are directed to only software. 1667 PO Resp. 6–10. Petitioner replies that excluding hardware from the construction is inconsequential because the Petition maps each term (the "instant voice messaging application" and the "client platform system") to software. 1667 Reply 8–9. We agree with Petitioner. Though we doubt the merits of Patent Owner's arguments excluding hardware, we need not expressly construe the term as urged, because excluding hardware from the scope of these terms is immaterial to the parties' dispute regarding unpatentability. That is, we find no argument by Patent Owner meaningfully distinguishing the prior art based on the construction of these terms, and Petitioner has mapped these elements to Zydney's software agent.

Based on our review of the record, we determine that "instant voice messaging application" and "client platform system" do not require an express construction to exclude hardware, as argued by Patent Owner.

B. Analysis of the Asserted Grounds

1. General Principles

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are "such

that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art;[8] and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations).[9] *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

2. Scope and Content of the Prior Art

a. Overview of Zydney

Zydney relates to packet communication systems that provide for voice exchange and voice distribution between users of computer networks.

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[8] Citing the testimony of Dr. Lavian, Petitioner asserts that a person of ordinary skill in the art for purposes of the '622 patent "would have possessed at least a bachelor's degree in computer science, computer engineering, or electrical engineering with at least two years of experience in development and programming relating to network communication systems (or equivalent degree or experience)." *See, e.g.*, 1667 Pet. 6 (citing Ex. 1002 ¶¶ 13–15). Patent Owner cites Mr. Easttom as providing a similar definition, noting also that "Mr. Easttom believes Dr. Lavian's opinions concerning a [person of ordinary skill in the art] are essentially the same as his, and any differences are inconsequential to the dispute before the Board." PO Resp. 5 (citing Ex. 2001 ¶¶ 13, 15). For purposes of this Decision and to the extent necessary, we adopt Petitioner's assessment.

[9] The parties do not address secondary considerations, which, therefore, do not constitute part of our analysis.

Ex. 1003, [54], [57], 1:4–5. While acknowledging that e-mail and instant messaging systems were well-known text-based communication systems utilized by users of online services, and that it was possible to attach files for the transfer of non-text formats via those systems, Zydney states that the latter technique "lack[ed] a method for convenient recording, storing, exchanging, responding and listening to voices between one or more parties, independent of whether or not they are logged in to their network." *Id.* at 1:7–17. Zydney thus describes a method in which "voice containers"—i.e., "container object[s] that . . . contain[] voice data or voice data and voice data properties"—can be "stored, transcoded and routed to the appropriate recipients instantaneously or stored for later delivery." *Id.* at 1:19–22; 12:6–8. Figure 1A of Zydney is reproduced below.

FIG. 1A

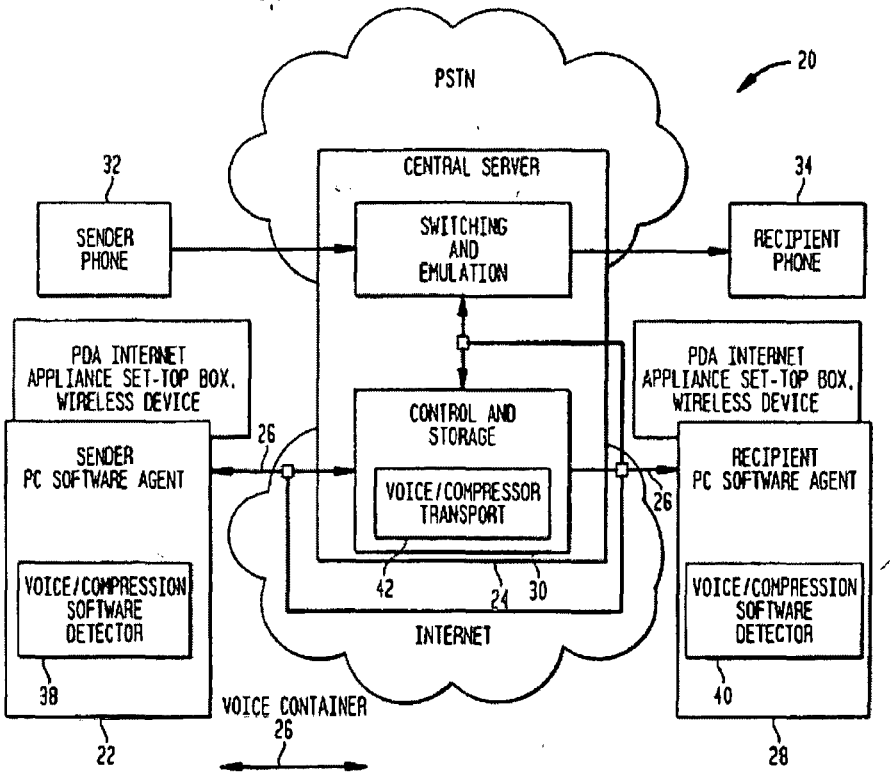

Figure 1A, above, illustrates a high level functional block diagram of Zydney's system for voice exchange and voice distribution. *Id.* at 10:19–20. Referring to Figure 1A, system 20 allows software agent 22, with a user interface, in conjunction with central server 24, to send messages using voice containers illustrated by transmission line 26 to another software agent 28, as well as to receive and store such messages, in a "pack and send" mode of operation. *Id.* at 10:20–11:1. Zydney explains that a pack and send mode of operation "is one in which the message is first acquired, compressed and then stored in a voice container 26 which is then sent to its destination(s)." *Id.* at 11:1–3. The system has the ability to store messages

both locally and centrally at server 24 whenever the recipient is not available for a prescribed period of time. *Id.* at 11:3–6.

In the use of Zydney's system and method, the message originator selects one or more intended recipients from a list of names that have been previously entered into the software agent. *Id.* at 14:17–19. The agent permits distinct modes of communication based on the status of the recipient, including the "core states" of whether the recipient is online or offline and "related status information" such as whether the recipient does not want to be disturbed. *Id.* at 14:19–15:1. Considering the core states, the software agent offers the originator alternative ways to communicate with the recipient, the choice of which can be either dictated by the originator or automatically selected by the software agent, according to stored rules. *Id.* at 15:3–6. If the recipient is online, the originator can either begin a real-time "intercom" call, which simulates a telephone call, or a voice instant messaging session, which allows for an interruptible conversation. *Id.* at 15:8–10. If the recipient is offline, the originator can either begin a voice mail conversation that will be delivered the next time the recipient logs in or can be delivered to the recipient's e-mail as a digitally encoded Multipurpose Internet Mail Extension ("MIME") attachment. *Id.* at 15:15–17. Zydney explains that the choice of the online modes "depends on the activities of both parties, the intended length of conversation and the quality of the communication path between the two individuals, which is generally not controlled by either party," and that the choice of the offline delivery options "is based on the interests of both parties and whether the recipient is

sufficiently mobile that access to the registered computer is not always available." *Id.* at 15:10–14, 15:17–19.

Once the delivery mode has been selected, the originator digitally records messages for one or more recipients using a microphone-equipped device and the software agent. *Id.* at 16:1–3. The software agent compresses the voice and stores the file temporarily on the PC if the voice will be delivered as an entire message. *Id.* at 16:3–4. If the real-time "intercom" mode has been invoked, a small portion of the digitized voice is stored to account for the requirements of the Internet protocols for retransmission and then transmitted before the entire conversation has been completed. *Id.* at 16:4–7. Based on status information received from the central server, the agent then decides on whether to transport the voice containers to a central file system and/or sends it directly to another software agent using the IP address previously stored in the software agent. *Id.* at 16:7–10. If the intended recipient has a compatible active software agent on line after log on, the central server downloads the voice recording almost immediately to the recipient. *Id.* at 16:10–12. The voice is uncompressed and the recipient can hear the recording through the speakers or headset attached to its computer. *Id.* at 16:12–14. The recipient can reply in a complementary way, allowing for near real-time communications. *Id.* at 16:14–15. If the recipient's software agent is not on line, the voice recording is stored in the central server until the recipient's software agent is active. *Id.* at 16:15–17. In both cases, the user is automatically notified of available messages once the voice recordings have been downloaded to storage on their computer. *Id.* at 16:17–19. The central server coordinates

with software agents on all computers continuously, updating addresses, uploading and downloading files, and selectively retaining voice recordings in central storage. *Id.* at 16:19–21.

Zydney discloses that the voice container also has the ability to have other data types attached to it. *Id.* at 19:6–7. Formatting the container using MIME format, for example, "allows non-textual messages and multipart message bodies attachments [sic] to be specified in the message headers." *Id.* at 19:7–10.

Figure 3 of Zydney is reproduced below.

FIG. 3

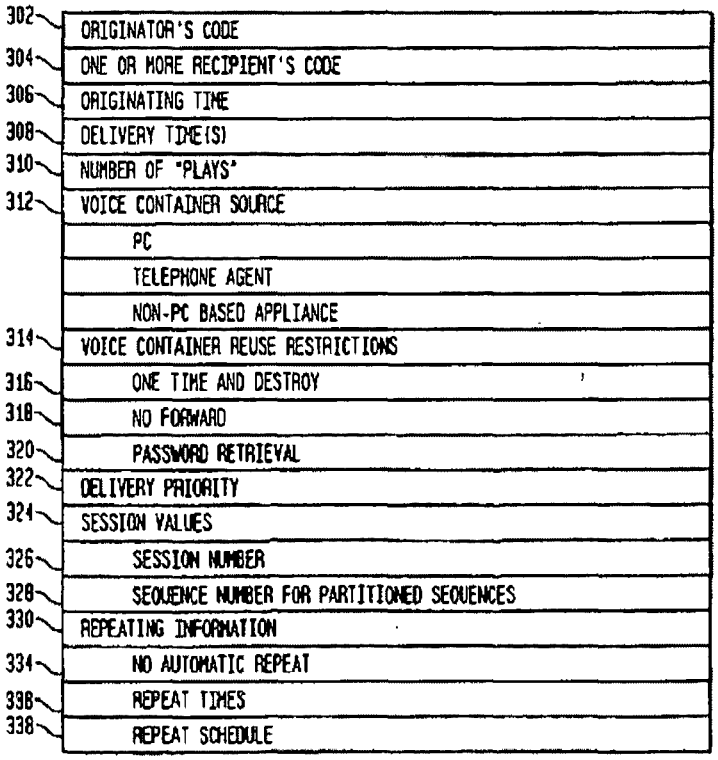

Figure 3, above, illustrates an exemplary embodiment of Zydney's voice container having voice data and voice data properties components. *Id.* at 2:19, 23:1–2. Referring to Figure 3, voice container components include:

> [O]riginator's code 302 (which is a unique identifier), one or more recipient's code 304, originating time 306, delivery time(s) 308, number of "plays" 310, voice container source 312 which may be a PC, telephone agent, non-PC based appliance, or other, voice container reuse restrictions 314 which may include one time and destroy 316, no forward 318, password retrieval 320, delivery priority 322, session values 324, session number 326, sequence number for partitioned sequences[] 328, repeating information 330, no automatic repeat 332, repeat times 334, and a repeat schedule 336.

Id. at 23:2–10.

b. Overview of Shinder

Shinder provides an overview of the "fundamentals of computer networking concepts and implementation." Ex. 1014, 5. According to Shinder, it is "becom[ing] vital to business interests that a LAN be able to communicate with the outside" and, thus, to connect to a wide area network ("WAN"), such as the Internet. *Id.* at 31.

c. Overview of Clark

Clark, titled "System for Managing and Organizing Stored Electronic Messages," is directed to systems for managing and organizing electronic messages. Ex. 1008, [54], 1:8–9. According to Clark,

> A computer-based system catalogs and retrieves electronic messages saved in a message store. The system automatically organizes each saved message into multiple folders based on the

contents and attributes of the message, and implements improved methods for manually organizing messages.

Id. at [57]. A particularly relevant embodiment in Clark is shown in Figure 4A, reproduced below.

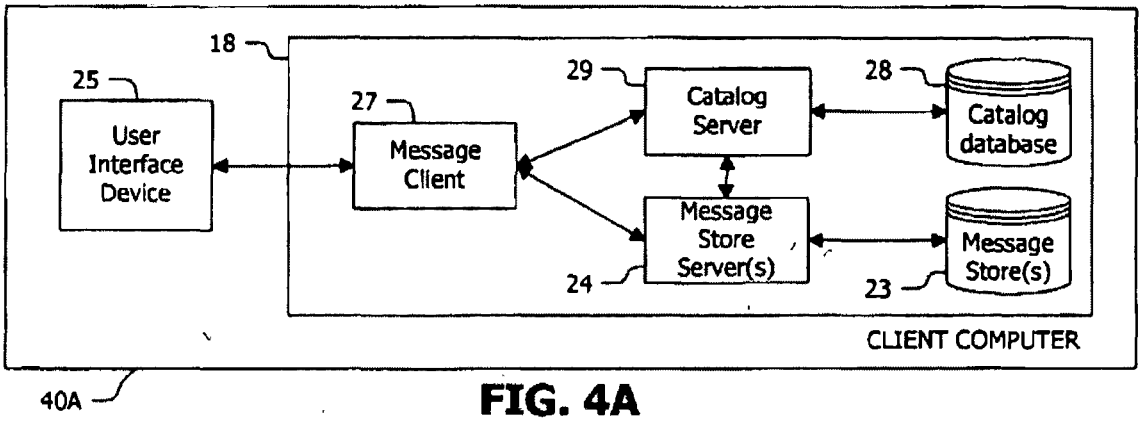

FIG. 4A

Figure 4A illustrates system 40A with client computer 18 implementing catalog server 29 and catalog database 28, and also including message client 27, message store 23, and message store server 24. *Id.* at 10:29–33. Each message store 23 comprises a memory, file, or database structure that provides temporary or permanent storage for the contained messages. *Id.* at 9:13–16. Clark describes the invention as providing catalog database 28 (and preferably catalog server 29) to organize the contents of one or more message stores 23. *Id.* at 9:54–57. Catalog database 28 and message store 23 may be separate from one another or may be integrated in a single integrated message store. *Id.* at 11:1–3. In the embodiment where they are separate from each other, illustrated in

Figure 5A (reproduced below), catalog database 28 may be linked to a separate external message store 23. *Id.* at 11:3–7.

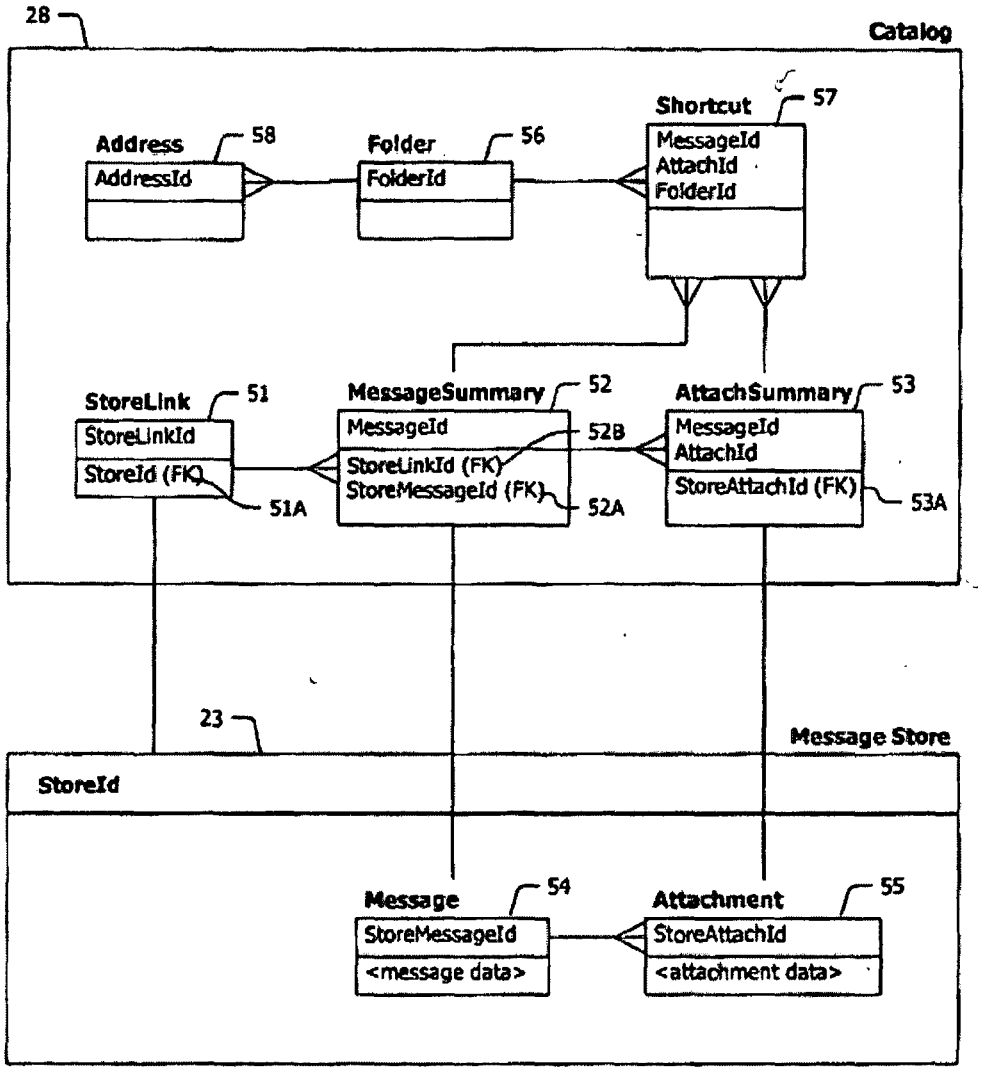

FIG. 5A

Figure 5A depicts the linking between catalog database 28 and external message store 23, where StoreLink table 51 contains rows, each

with a StoreId pointing to a linked message store 23, and catalog database 28 includes MessageSummary table 52, which contains StoreMessageId 52A of messages in message store 23. *Id.* at 11:25–33. The Figure 5A embodiment also shows that messages 22 are stored in Message table 54 in message store 23 and that attachments are stored in Attachment table 55 in message store 23. *Id.* at 35–37.

d. Overview of Appelman

Appelman, titled "User Definable On-line Co-user Lists," describes a real-time notification system that enables a user to define "buddy lists" to track co-users of an online or network system. Ex. 1004, [54], [57]. The system tracks for the user the log-on status of the co-users and displays that information in real time to the tracking user in a graphical interface. *Id.* at [57]. When the user logs on to a system, the user's set of buddy lists is presented to a buddy list system, which attempts to match co-users currently logged into the system with the entries on the user's buddy list, and any matches are displayed to the user. *Id.* As co-users log on and log off, the user's buddy list is updated to reflect the changes. *Id.*

Figure 2a of Appelman is reproduced below.

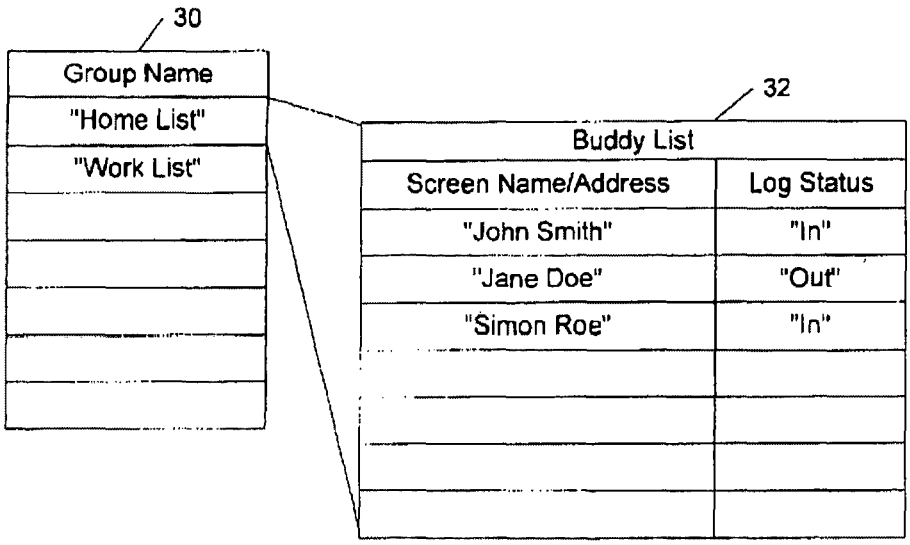

FIG. 2a

Figure 2a, above, illustrates "a set of symbolic data records showing the basic types of data used by one embodiment of [Appelman's] invention for a buddy list[] and the conceptual relationship of data elements." *Id.* at 2:15–18. With reference to Figure 2a, Group Name table 30 stores user-defined group names for buddy lists. *Id.* at 3:36–37. Each user may define multiple buddy lists by group names. *Id.* at 3:38. Two buddy lists, "Home List" and "Work List," are shown in Group Name table 30. *Id.* at 3:39. Each group name in Group Name table 30 has an associated Buddy List table 32, comprising multiple records that each correspond to a co-user (or "buddy") that the user wishes to track. *Id.* at 3:39–43. Each record may include data elements for the screen name (or address, such as an Internet address) of a particular co-user to be tracked, and the logon status of that user (e.g., codes for "In" or "Out"). *Id.* at 3:43–47.

Figure 11 of Appelman is reproduced below.

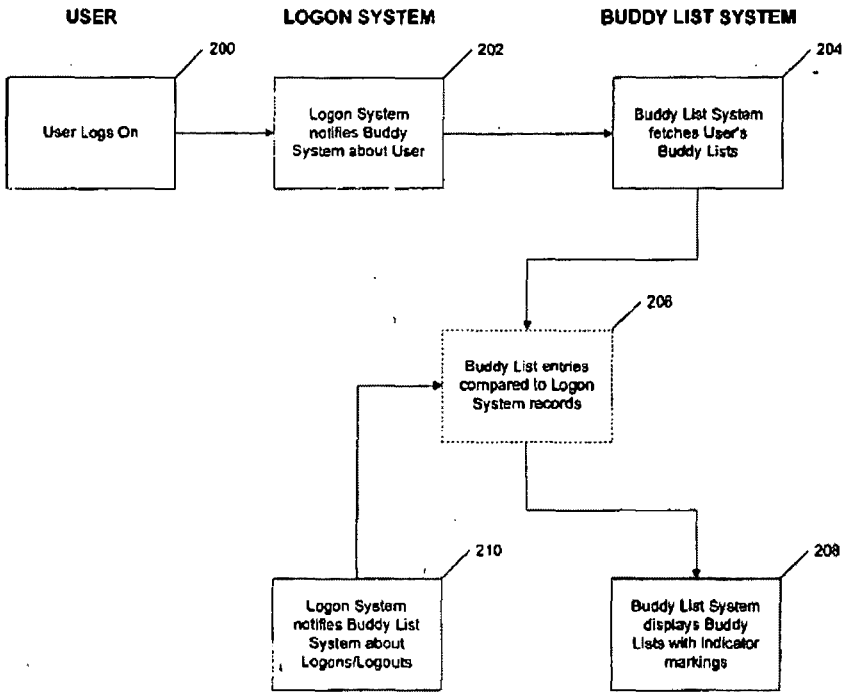

FIG. 11

Figure 11, above, is a flowchart showing an implementation of Appelman's invention. *Id.* at 2:41–42. In the illustrated implementation, a user logs into a Logon System (Step 200), which notifies the Buddy List System about the User (i.e., passes the User's ID, address, or screen name to the Buddy List System) (Step 202). *Id.* at 6:53–58. The Buddy List System accesses the user's buddy lists from a database, which may be, for example, on the user's own station (Step 204). *Id.* at 6:58–60. The entries in the user's buddy lists then are compared to the records of the Logon System (Step 206). *Id.* at 6:60–62. Appelman explains that this step is shown in dotted outline to indicate that the comparison can be done by passing records from the Logon

System to the Buddy List System, or vice versa, or could be done by a separate system. *Id.* at 6:62–65. The Buddy List System then displays a buddy list window showing the status (i.e., logged in or not) of the co-users on the user's buddy lists with any of various indicator markings (Step 208). *Id.* at 6:66–7:2. Thereafter, while the user's buddy list window is open, the Logon System notifies the Buddy List System about new logons/logoffs of co-users (Step 210), causing a new compare of the user's buddy list entries to the Logon System records (Step 206). *Id.* at 7:3–7. Appelman explains that the Logon System may, for example, maintain a copy of a user's buddy lists and notify the Buddy List System only upon a logon status change for a co-user on the user's buddy lists. *Id.* at 7:8–11. The Buddy List System then updates the indicated status of the displayed co-users (Step 208). *Id.* at 7:11–12.

e. Overview of Hethmon

Hethmon provides a guide to Hypertext Transfer Protocol ("HTTP"), focusing primarily on version HTTP/1.1. Ex. 1109, 1; *see also id.* at 9–13 (briefly describing historical versions HTTP/0.9 and HTTP/1.0). Hethmon explains that HTTP is the protocol used to send and receive messages between Web clients and servers over the Internet. *Id.* at 10. Hethmon describes HTTP as a "request-response" type of protocol, in which a client application sends a request to the server and then the server responds to the request. *Id.* According to Hethmon, the "Request Message" sent by a client to a server to request a resource in HTTP/1.1 included a "Request-Line and possibly a set of header lines," with the following overall syntax:

```
Request       =Request-Line
                *(    General-Header
                  |   Request-Header
                  |   Entity-Header   )
                CRLF
                [ Entity-Body ]
Request-Line = Method SP Request-URI SP HTTP-Version CRLF
```

Id. at 51. Hethmon explains that "[t]he request line is the message sent by the client to the server to request a resource or an action to take place" and that "[a]ll request lines begin with a Method," where the "Method" is "a keyword such as GET or POST which indicate[s] the type [of] action the request is asking the server to execute." *Id.* at 51–52. Hethmon further explains that there were seven basic methods available in HTTP/1.1: OPTIONS, GET, HEAD, POST, PUT, DELETE, and TRACE. *Id.* at 52.

f. Overview of Microsoft

The 1991 edition of "Microsoft Press Computer Dictionary" provides "definitions for computer-related terms and acronyms." Ex. 1118, 3. Microsoft provides, for example, the following definitions for the terms "autopolling" and "polling":

> **autopolling** Also called polling. The process of periodically determining the status of each device in a set so that the active program can process events generated through each device. The process can be used to determine the status of a range of events such as whether a key or a mouse button was pressed or whether new data is available at a serial port. Autopolling can be compared with event-driven processing, in which a low-level routine in the operating system alerts a program or routine to an event occurring in a device with an interrupt or message, rather than requiring the program to check each device in turn.

. . . .

polling *See* autopolling.

Id. at 5–7.

g. Overview of Moghe

Moghe, titled "Adaptive Polling Rate Algorithm for SNMP-based Network Monitoring," is directed to a "rate adaptive polling method sensitive to network congestion." Ex. 1119, [54], [57]. Moghe discloses, among other things, "a method for efficient polling of network hosts and resources and the network manager for implementing the same." *Id.* at 1:6–9. According to Moghe,

> Typically one host on the network is assigned the task of network manager ("NM") 10, running appropriate software, while the remaining hosts and resources are identified as agents. The manager 10 will periodically request information from the agents using one of a variety of protocols . . . , and expect a response from each agent using the same protocol. This process is referred to as "polling."
>
> Efficient polling is becoming increasingly important with new bandwidth-intensive applications such as conferencing and web-push applications.

Id. at 1:14–25.

3. Analysis of Claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39

Petitioner points to Zydney as disclosing all limitations of independent claims 3, 27, and 38, except that it relies on "Zydney, alone and in combination with Shinder," as rendering obvious the "network interface" recited in each of those claims and on Shinder's disclosure that "[a]n

example of a packet-switched network is the Internet" (Ex, 1014, 19) as rendering obvious that the Internet (as disclosed in Zydney) would have been a packet-switched network. 1667 Pet. 18–33, 50–57. We address first whether Petitioner has demonstrated by a preponderance of the evidence that claims 3, 27, and 38 would have been obvious over the combination of Zydney and Shinder and then turn to the dependent claims.

a. Discussion of Independent Claim 3

-i-

As reproduced above, claim 3 recites, in part, "a network interface connected to a packet-switched network." Petitioner alleges that Zydney, alone and in combination with Shinder, discloses and renders obvious the claimed "network interface." 1667 Pet. 19. In particular, Petitioner contends that Zydney's client system includes a software agent that can transmit a voice container over the Internet to a central server and that Zydney's Figure 1A depicts transmission lines 26 connecting the client systems to the central server through the Internet. *Id.* (citing Ex. 1003, 10:21–23, 13:1–6, 13:12–18, 14:6–13, Figs. 1A, 4, 8). Relying on the testimony of Dr. Lavian, Petitioner argues that although Zydney does not describe the specific hardware used by the central server to connect to the Internet, it would have been obvious that it included a "network interface," as claimed, "because the central server would have needed such an interface in order to connect to the Internet as shown in Figure 1A." *Id.* at 20 (citing Ex. 1002 ¶¶ 114–118). Petitioner further contends that the recited "network interface" would have been obvious in view of Shinder, which states, among

other things, that "[t]he most basic piece of hardware required to network computers is the NIC [network interface card]" and that "[s]ome sort of network interface is always required to communicate over a network." *Id.* at 21 (citing Ex. 1014, 195–96). Relying on Dr. Lavian's testimony, Petitioner still further contends it would have been obvious to a person of ordinary skill in the art to combine Zydney with Shinder, motivated by Shinder's disclosure, and that it would have been within the basic knowledge of persons of ordinary skill in the art to include a network interface to connect the central server of Zydney to the Internet. *Id.* at 21–22 (citing Ex. 1002 ¶¶ 116–118). Regarding the further limitation that the network interface is "connected to a packet-switched network," Petitioner points out that Zydney discloses transmission of voice containers over the Internet, which, as evidenced by Shinder and Dr. Lavian's testimony, and also confirmed by the '622 patent itself, was known to persons of ordinary skill in the art to be a packet-switched network. *Id.* at 23 (citing Ex. 1003, 10:21–23, Fig. 1A; Ex. 1002 ¶¶ 119–121; Ex. 1024, 170 ("An example of a packet-switched network is the Internet"); Ex. 1001, 1:37–40 (referring to "a packet-switched network (e.g., Internet)")). Still further, because Shinder explains that the network interface serves as the point of connection through which incoming and outgoing data flows to and from a networked computer, Petitioner contends it would have been obvious to a person of ordinary skill in the art that the network interface itself would be connected to the packet-switched network. *Id.* at 23–24 (citing Ex. 1014, 195–196; Ex. 1002 ¶ 122). Patent Owner does not provide any substantive counterargument with regard to these limitations.

After full consideration of Petitioner's arguments and cited evidence, we are persuaded, for the reasons stated by Petitioner and discussed above, that Petitioner has established by a preponderance of the evidence that it would have been obvious to a person of ordinary skill in the art to include a "network interface connected to a packet-switched network" in Zydney's system in view of Zydney's and Shinder's teachings.

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Claim 3 further recites "a messaging system communicating with a plurality of instant voice message client systems via the network interface." Ex. 1001, 24:15–17. Petitioner contends that this limitation is rendered obvious by Zydney and Shinder. 1667 Pet. 24–28. Pointing again to Figure 1A of Zydney, Petitioner argues, first, that Zydney shows a messaging system, as recited, within central server 24. *Id.* at 24–25. Petitioner quotes Zydney as "explain[ing] that '[t]he central server in conjunction with the software agent controls, stores and switches the voice containers to the appropriate recipients.'" *Id.* at 25 (emphasis omitted) (quoting Ex. 1003, 14:6–13). Petitioner further contends Zydney discloses that the central server includes a number of subcomponents, including a "message server" and a "transport server" that Petitioner identifies as being the claimed "messaging server." *Id.* at 25–26 (citing Ex. 1003, Fig. 2). In particular, according to Petitioner, Zydney discloses that messages are "sent to the message server" when a client system sends a voice container to a recipient that is not logged on, that "[t]he message server will download all messages to the software agent and/or retain copies of the messages," and that the transport server "is responsible for receiving and sending voice containers"

using a standard transport protocol. *Id.* at 26–27 (citing Ex. 1003, 23:11–12, 25:1–9, 27:15–16, 29:1–2, 30:6–7, 31:1–3, 33:1–2). Petitioner further contends that the devices running sender software agent 22 and recipient software agent 28 shown in Fig. 1A are "instant voice message client systems," as recited in the claim. *Id.* at 27. According to Petitioner, "Zydney explains that each of these devices may be 'a personal computer, wireless handheld computer such a [sic] personal data assistant (PDA), digital telephone, or beeper'"; each is shown in Figure 1A as being connected to the central server; and the clients are, specifically, "instant voice message client systems" because they send and receive voice containers in "a voice instant messaging session." *Id.* at 27–28. Lastly, referring back to its arguments concerning the "network interface" limitation discussed above, Petitioner argues that the central server in Zydney can include a "network interface" that "provides the server's connection to the Internet" and that "[t]he central server's messaging system, therefore, communicates with the client systems using the network interface." *Id.* at 28. Patent Owner does not provide any substantive counterargument with regard to this limitation.

After full consideration of Petitioner's arguments and cited evidence, we are persuaded, for the reasons stated by Petitioner and discussed above, that Petitioner has established by a preponderance of the evidence that Zydney teaches a messaging system communicating with a plurality of instant voice message client systems and that it would have been obvious to person of ordinary skill in the art that such communication would have been via the network interface.

Claim 3 further recites "a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems." Ex. 1001, 24:18–22. Petitioner contends Zydney teaches this limitation. 1667 Pet. 28–30. In particular, Petitioner argues, "each of the 'instant voice message client systems' in Zydney runs a software agent used for instant voice messaging," "[t]he central server in Zydney tracks the connectivity status of these software agents," and "[t]he claimed 'communication platform system' in Zydney is the system within the central server that tracks and maintains this status." *Id.* at 28–29 (emphasis omitted) (citing Ex. 1003, 13:12–14, 14:6–9). Petitioner points specifically to a "notification server" disclosed by Zydney as a component of its central server, as well as to "server storage" for recording client connection information. *Id.* at 29 (citing Ex. 1003, 24:15–16, 25:4–7, 31:13–15, 32:12–15, Fig. 2). Petitioner contends, moreover, that this status information "qualifies as 'connection information for each of the plurality of instant voice message client systems,' because the status information includes the 'core state' of whether the client is online or offline." *Id.* at 29–30 (emphasis omitted) (citing Ex. 1003, 14:20–15:1, 25:4–7, 32:12–15). Patent Owner does not provide any substantive counterargument with regard to this limitation.

After full consideration of Petitioner's arguments and cited evidence, we are persuaded, for the reasons stated by Petitioner and discussed above, that Petitioner has established by a preponderance of the evidence that

Zydney teaches the recited communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems.

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Claim 3 recites "wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems." Ex. 1001, 24:23–25. Petitioner contends Zydney teaches this limitation. 1667 Pet. 30–31. Pointing once again to Figure 1A of Zydney, Petitioner argues that figure expressly shows Zydney's central server, including the components identified above as corresponding to the recited messaging system, receiving a voice container from a sending client system. *Id.* at 30 (citing Ex. 1003, 16:7–12, Fig. 1). Moreover, Petitioner contends, "Zydney confirms that the 'message server' component of the central server . . . receives the voice container," because, for example, Zydney discloses that the message server receives and stores the voice container if the recipient is not currently online. *Id.* at 30–31 (citing Ex. 1003, 25:1–2, 27:15–16, 33:1–2).

Patent Owner again does not provide any substantive counterargument, and after full consideration of Petitioner's arguments and cited evidence, we again are persuaded, for the reasons stated by Petitioner and discussed above, that Petitioner has established by a preponderance of the evidence that Zydney teaches the recited limitation. With respect specifically to the recitation of an "instant voice message," we find that Zydney's voice container is an "instant voice message" as we have

construed the term: data content that includes a representation of the audio message. As Zydney explains, the software agent in the originator (sender) device, equipped with a microphone, "digitally records messages for one or more recipients" and stores the file in the PC. Ex. 1003, 16:1–4. Zydney additionally describes "creat[ing] a message" by stating that it "address[es], pack[s] and send[s] the message in a voice container." *Id.* at 14:2–5. Indeed, Zydney defines the voice container as containing either "voice data" or "voice data and voice data properties." *Id.* at 12:6–8. That is, the voice container, when defined by Zydney as "voice data," is the digital recording of the user's voice message or audio file, which constitutes data content. And we find that when the voice container is defined as "voice data and voice data properties," the digital recording of the user's voice or audio file (data content) is packaged together with additional data. In either situation, the voice container constitutes data content that includes the representation of the audio message. The format of the data content or how it is packaged (i.e., structure) is not relevant, as we focus on whether the voice container is data content notwithstanding additional data and structure that ensures adequate transport or delivery of the data content.

-v-

Lastly, claim 3 recites "wherein the instant voice message includes an object field including a digitized audio file." Ex. 1001, 24:26–27. Petitioner contends Zydney teaches this limitation. 1667 Pet. 31–33. As an initial matter, Petitioner contends that, although the '622 patent does not expressly define the term "object field," the meaning of that term "is reasonably clear from the specification, which explains that '[t]he content of the object field

is a block of data being carried by the message object, which may be, for example, a digitized instant voice message.'" *Id.* at 31 (emphasis omitted) (quoting Ex. 1001, 14:37–40). Relying on Dr. Lavian's testimony as to what a person of ordinary skill in the art would have understood from that disclosure, Petitioner argues Zydney discloses the object field in at least two independent ways. *Id.* (citing Ex. 1002 ¶¶ 137–138, 141–144).

First, according to Petitioner, "Zydney expressly refers to [its] voice container"—which Petitioner maps to the recited instant voice message—"as an 'object' that contains voice data: 'The term "voice containers" as used throughout this application refers to a container object that contains no methods, but contains voice data or voice data and voice data properties.'" *Id.* at 31–32 (emphasis omitted) (quoting Ex. 1003, 12:6–8). While conceding that Zydney does not use the specific word "field" in relation to storage of voice data, Petitioner asserts that a person of ordinary skill in the art "would have understood that the voice data is contained in a field of the voice container." *Id.* at 32 (citing Ex. 1002 ¶¶ 137–138). Petitioner further contends it would also have been obvious that the Zydney voice container would contain an object field "because, without one, the recipient device could not separate the voice data from the other fields of data in the voice container and play back the voice data for the user – a capability the recipient in Zydney has." *Id.* (citing Ex. 1002 ¶ 138 n.13).

Second, Petitioner argues, Zydney discloses that voice containers can be encoded using the industry-standard MIME format, "which 'allows non-textual messages and multipart message bodies [sic] attachments to be specified in the message headers,'" and Zydney also specifically refers to

and incorporates by reference Request for Comments ("RFC") 1521 (Ex. 1006), which "explains that a MIME message can contain audio or voice data in the 'body,' the field of the message containing the content being conveyed." 1667 Pet. 32 (emphasis omitted) (citing Ex. 1002 ¶ 143; Ex. 1003, 19:7–10, 19:13–20:9; Ex. 1006). Relying on Dr. Lavian's testimony, Petitioner contends that because Zydney itself discloses that voice containers can be encoded using MIME and directly cites to RFC 1521, "it would have been plainly obvious to a person of ordinary skill in the art to provide the receiving software agent with the ability to format the voice container according to RFC 1521, thus encoding the voice data in the body (an 'object field') of the message." *Id.* at 32–33 (emphasis omitted) (citing Ex. 1002 ¶¶ 141–144).

Patent Owner responds that Petitioner errs by relying on Zydney's voice container for this limitation, contending that "Zydney distinguishes its voice container from its voice message" and that "[t]he claim language . . . expressly refers to structure of 'the instant voice message' itself." 1667 PO Resp. 21 (emphasis omitted) (citing Pet. 31; Ex. 2001 ¶ 76). According to Patent Owner, "[t]he dispute here does not turn on whether the instant voice message is correctly characterized as audio data only (particularly given that the claim language refers to 'a digitized audio *file*' and therefore connotes structure beyond just *audio data* in the abstract)," but "[r]ather, the deficiency of the Petition arises from the failure to identify any element in *Zydney* (or any other cited reference) that renders obvious[] each and every structural limitation for the claimed 'instant voice message.'" *Id.* at 21 n.11.

Further, Patent Owner contends, Petitioner's "conclusory speculation" that "a person of ordinary skill in the art would have understood that the voice data is contained in a field of the voice container" "should be rejected for each . . . of . . . numerous reasons." *Id.* at 22.

First, according to Patent Owner, Petitioner's statements concerning the knowledge of a person of ordinary skill in the art are based on "mere speculation or conjecture." *Id.*

Second, Patent Owner points out that the claim language does not recite "'a field' in the abstract," but instead "identifies a *specific type* of field—namely, an '*object* field,'" "reflect[ing] teachings in the '622 patent addressing a significant number of different types of fields, each serving its respective and distinct purpose." *Id.* at 22–23.

Third, "*Zydney* does not use the word 'field' at all in relation to its voice container," and indeed, "[w]hile *Zydney* describes the 'voice container structural components' with reference to Figure 3, notably absent from the list of *twenty-five* structural components (elements 302 through 338) is anything resembling 'an object field including a digitized audio file.'" *Id.* at 23 (citing Ex. 1003, 23:1–12). According to Patent Owner, "Petitioner appears to raise an inherency argument that *Zydney's* voice container *necessarily* includes 'a digitized audio file' in a distinct 'object field,'" but "[i]f such a feature had been a necessary component of the voice container, surely *Zydney* would so state." *Id.* Further, according to Patent Owner, "Zydney's alleged disclosure that the voice container may be formatted according to the MIME format does not save Petitioner['s] inherency argument," because "[m]erely specifying something in a message header

does not expressly or inherently disclose that the header itself is an 'object field' that contains the 'digitized audio file.'" *Id.* at 23–24 (emphasis omitted). Still further, Patent Owner contends, notwithstanding Petitioner's citation to RFC 1521 in support of its arguments (*see* Pet. 32), "the Petition and its attached declaration fail to identify any portion of RFC 1521 . . . equating the so-called 'body' of a message to an 'object field', let alone that one that must include an 'audio file' (as opposed to just audio data)." 1667 PO Resp. 24 (emphasis omitted). According to Patent Owner, "the RFC 1521 reference . . . uses the word 'fields' only in connection with 'headers' that merely specify information types and that are distinct from the 'body' of the message . . . ." *Id.* at 24–25. Thus, Patent Owner contends, "the RFC 1521 reference states its 'fields' merely describe the data in a distinct message body . . . [and] does not . . . state that any of the identified 'fields' itself includes the data in a message body." *Id.* at 25.

Fourth, Patent Owner contends, "Petitioner[']s mapping further breaks down because the Petition presents inconsistent theories under the guise of allegedly 'independent' theories." *Id.* at 25.

> For example, the Petition initially argues that *Zydney's voice container itself* has the structure that maps onto the claimed "object field including a digitized audio file." Pet. 31–32 ("the voice data is contained in *a field of the voice container.*") (emphasis added). However, in presenting its arguments with respect to the "MIME message" disclosed in RFC 1521, the Petition argues, instead, that the *message itself* has the structure that maps onto the claimed "object field including a digitized audio file." *Id.* 32–33 (referring, instead, to "*the field of the message*"). Petitioners cannot have it both ways; and the presentation of inconsistent theories only undermines both. . . .

> Petitioners compound their error by conflating their divergent theories into one when addressing the term "digitized audio file." Pet. 33. The Petition ambiguously states that "Zydney further discloses that the object field includes a 'digitized audio file'" (Pet. 33), without specifying which one of Petitioner's theories it had intended to rely on for the "object field" limitation—i.e., whether *the voice container itself* or, instead, *the MIME message itself*, has the structure allegedly mapping onto the "object field" term. The Board and Patent Owner should not be required to guess how Petitioners' obviousness theory for "digitized audio file" fits into each one of Petitioners' divergent theories for an "object field" which must itself include the claimed file.
>
> Given that the Petition mentions "voice data *for the voice container*" and quotes *Zydney's* disclosure that "[t]he software agent compresses the voice and stores the file temporarily on the PC," it appears the section of the Petition addressing the term "digitized audio file" (Pet. 33) focuses exclusively on Petitioner's *voice container* theory, without presenting any corresponding argument for Petitioner's separate *MIME message* theory. This results in at least a tacit abandonment of Petitioners' *MIME message* theory.

Id. at 25–26 (footnote omitted).

Fifth, Patent Owner contends, Zydney "refutes Petitioner['s] speculation that Zydney must have used an undisclosed 'structural component' dedicated exclusively to an 'audio digital file.'" *Id.* at 26 (emphasis omitted). More particularly, according to Patent Owner, "Figure 3 of Zydney and its accompanying description . . . provide no less than four different examples of 'structural components' that each group together multiple items of information." *Id.* at 26–27 (emphasis omitted). "Clearly," Patent Owner contends, "Zydney did not share Petitioner['s] contrived concern about a recipient client being unable to separate different

items of information that are structurally grouped together." *Id.* at 27 (emphasis omitted).

Sixth, Patent Owner contends, "the distinction between Zydney's 'structural components' and the claimed 'object field' is not mere semantics but rather reflects fundamentally different technologies." *Id.* (emphasis omitted). More specifically, "[a] person of ordinary skill in the art . . . would have recognized the word 'field' as a term of art in the context of packet-switched networks, particularly in light of the teachings of the '622 patent," and "would have recognized that network packets have headers with various fields describing things such as source address, destination address, port, protocol, etc." *Id.* (emphasis omitted) (citing Ex. 2001 ¶ 77).

Seventh and finally, Patent Owner contends, "Zydney does not enable, and indeed could not even have functioned as described, using packet-switched fields of hypertext transfer protocol ('HTTP'), as it existed in [sic] August 7, 2000 (Zydney's filing date)." *Id.* at 27–28 (emphasis omitted) (citing Ex. 2001 ¶ 80).

In its Reply, Petitioner responds that "Patent Owner recycles nearly verbatim several arguments already considered and rejected by the Board." 1667 Reply 11 (citing 1667 Dec. on Inst. 18–20). According to Petitioner, "Patent Owner does not address the Board's reasoning, let alone identify any error in it, and does not submit any new evidence on the issue." *Id.* Petitioner further responds that, whereas Patent Owner in its Response "appears to assume an unstated narrow claim interpretation of the term 'object field,'" Patent Owner "does not propose any specific claim construction," "proposed [in co-pending litigation] to construe 'object field'

broadly as 'a block of data being carried by the message object,'" and "does not demonstrate any basis for the Board to adopt any narrower interpretation in this proceeding." *Id.* at 11–12 (emphasis omitted) (citing 1667 PO Resp. 22–23; Ex. 1001, 14:37–38; Ex. 1024, 9). "Under either the plain and ordinary meaning informed by the specification or under the construction Patent Owner proposed in litigation," Petitioner contends, "Zydney discloses and renders obvious that the instant voice message (voice container) contains an object field (block of data) including an audio file, for the reasons explained in the Petition and discussed in detail by the Board in its institution decision." *Id.* at 12 (citing Pet. 31–33; 1667 Dec. on Inst. 16–17, 20).

Petitioner further contends that Patent Owner incorrectly suggests that Petitioner relies only on inherency for the "object field limitation," whereas the Petition makes a showing of obviousness, and that Patent Owner improperly attacks the references individually by arguing that RFC 1521 itself does not describe that the message body includes an audio file, whereas the Petition instead explains that it would have been obvious to incorporate the voice audio "file" disclosed by Zydney into the MIME format, rendering obvious that the object field (i.e., message body) includes that audio file. *Id.* at 13–14 (citing Pet. 32–33). Still further, Petitioner argues Patent Owner incorrectly asserts that Petitioner presents inconsistent mappings to the instant voice message, despite Petitioner's consistent identification of Zydney's voice container as corresponding to the recited instant voice message. *Id.* at 14 (citing Pet. 31–33). Finally, Petitioner contends that Patent Owner's argument that Zydney does not enable using

packet-switched fields of HTTP as it existed in August 2000 (1667 PO Resp. 27–28) "appears to be based on incorrectly reading Zydney to *require* data compression when transmitting voice containers," whereas Patent Owner has not identified any such disclosure in Zydney. 1667 Reply 15. Even if Zydney did require compression, Petitioner contends, "HTTP *did* support data compression as of August 2000," as described in Hethmon. *Id.* at 15–16 (citing Ex. 1009, 39). According to Petitioner, "Hethmon makes clear that HTTP can be used to transfer various types of data, including data that has been compressed separately from the HTTP protocol itself, such as transmitting files in the well-known 'zip' and 'gif' compression formats," and it is, accordingly, "irrelevant whether HTTP itself had built-in compression protocols." *Id.* at 16 (citing Ex. 1009, 44).

After full consideration of the parties' arguments and cited evidence, we are persuaded that Petitioner has established by a preponderance of the evidence that Zydney renders obvious an instant voice message including "an object field including a digitized audio file," as recited in claim 3, and that Patent Owner does not persuasively rebut Petitioner's evidence. Notwithstanding Patent Owner's arguments, for example, that Petitioner's statements are based on "mere speculation or conjecture" and that an object field is a "specific type of field" (1667 PO Resp. 22–23 (emphasis omitted)), we are persuaded by Petitioner's evidence, including Dr. Lavian's testimony, that it would have been obvious to a person of ordinary skill in the art at the time of the alleged invention to include an object field in Zydney's voice container for storage of voice data. *See, e.g.*, Ex. 1002 ¶ 138. In this regard, we credit Dr. Lavian's testimony that, "[w]ithout some

logically identified 'field' in the voice container containing the voice data, in fact, the recipient device in Zydney could not separate the voice data from the other fields in the voice container (including the fields shown in Figure 3)." *Id.* ¶ 138 n.13. Zydney expressly discloses voice data is transmitted in a voice container, where the term "'voice container[]' . . . refers to a container *object*" that may be formatted according to industry standards such as MIME format. Ex. 1003, 12:6–7 (emphasis added), 19:6–20:9 (citing, e.g., Ex. 1006). Moreover, although Zydney describes Figure 3 as "illustrat[ing] an exemplary embodiment of the voice container having voice data and voice data properties components" (*id.* at 23:1–2), we find that only the latter "voice data properties components" are actually depicted in the figure (*see id.* Fig. 3 (components 302–336)). Because the "voice data"—expressly disclosed by Zydney as being part of the voice container (*see id.* at 23:1–1)—is not depicted, it is apparent that Figure 3 is not intended to be an exhaustive illustration of all components of Zydney's voice container. Accordingly, we do not ascribe any particular significance to the fact that Zydney's Figure 3 does not depict "anything resembling 'an object field including a digitized audio file'" (*cf.* 1667 PO Resp. 23). Still further, although Zydney does not utilize the term "field" *ipsissimis verbis*, we credit Dr. Lavian's unrebutted testimony, supported by RFC 1521, that when in MIME format, Zydney's voice container would contain the digitized audio file—i.e., the voice data—in an object field. Ex. 1002 ¶¶ 141–144.

In conclusion, we have reviewed the arguments and evidence in the record and determine that Petitioner has demonstrated by a preponderance of the evidence that claim 3 of the '622 patent is unpatentable as obvious over Zydney in view of Shinder.

b. Discussion of Independent Claim 27

Independent claim 27 differs from independent claim 3 principally in its recitations of (1) the network interface being coupled "to the client device," rather than to the server, and connecting "the client device," again rather than the server, to the network; (2) "an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message"; (3) the messaging system being included in the instant voice messaging application installed on the client device, rather than being a system residing on the server; and (4) the instant voice messaging application "includ[ing] a document handler system for attaching one or more files to the instant voice message." Petitioner relies on essentially the same arguments and evidence for the "client device" and "network interface" limitations of independent claim 27 as discussed above with regard to claim 3. 1667 Pet. 50–52 (citing Ex. 1003, 11:16–18, 14:2–3; Ex. 1014, 195–96, Ex. 1002 ¶¶ 113–118). We address the additional limitations of claim 27 below.

Regarding the recited "network interface" being coupled "to the client device" and connecting "the client device to the packet-switched network," Petitioner contends, first, that "th[e] requirement of a network interface applies equally to the *client* in Zydney as it does to the *server*," and "[t]he claimed 'network interface' in claim 27[] is therefore obvious for the same reasons as the 'network interface' of claim 3[]." 1667 Pet. 51 (citing Ex. 1002 ¶¶ 113–118, 202). Second, Petitioner points to disclosure in Zydney of a cable modem, which Petitioner contends is "a particular type of network interface," as providing a "separate and independent basis for satisfying this limitation." *Id.* (citing Ex. 1003, 17:5–9; Ex. 1002 ¶ 203). Relying on Dr. Lavian's testimony, Petitioner contends "[a] person of ordinary skill in the art therefore would have understood and found it obvious that the client system would have contained a network interface, such as a cable modem to enable higher bandwidth and quality, to provide connectivity to the network." *Id.* at 51–52 (citing Ex. 1002 ¶¶ 203–204).

Patent Owner does not provide any substantive counterargument with regard to this limitation.

After full consideration of Petitioner's arguments and cited evidence, we are persuaded, for the reasons stated by Petitioner and discussed above, that Petitioner has established by a preponderance of the evidence that it would have been obvious to a person of ordinary skill in the art to include a "network interface coupled to the client device and connecting the client device to a packet-switched network" in Zydney's system in view of Zydney's and Shinder's teachings.

Regarding the recited "instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message," Petitioner contends that the "instant voice messaging application" in Zydney takes the form of the software (including a software agent) installed on the computing device of the sending (originating) client device, and that the software agent in Zydney includes a client platform system for generating the instant voice message (voice container). 1667 Pet. 52 (citing Ex. 1003, 11:16–18, 13:2–6, 14:2–12; also referring to arguments at 1667 Pet. 43–44 (citing Ex. 1003, 13:2–6, 14:2–12, 13:19–22, 14:14–16, 11:16–18)). Relying further on Dr. Lavian's testimony, Petitioner additionally contends that "the client platform system in Zydney is thus disclosed by the portions of the software agent on the client of the sending (originating) user responsible for creating the instant voice message," and that "Zydney thus discloses an instant voice messaging application that includes a client platform system for 'generating an instant voice message,' as claimed." *Id.* at 52–53 (citing Ex. 1002 ¶¶ 180, 207–208). Patent Owner does not provide any substantive counterargument with regard to this limitation, and after full consideration of Petitioner's arguments and cited evidence, we are persuaded, for the reasons stated by Petitioner and discussed above, that Petitioner has established by a preponderance of the evidence that Zydney teaches the recited "instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message."

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Finally, regarding the recited "document handler system for attaching one or more files to the instant voice message," Petitioner relies on Zydney's disclosure of software functionality for attaching files—such as a "digitized greeting card" or "other data types"—to the voice container (i.e., the instant voice message), to be "transported to the recipient." 1667 Pet. 54 (citing Ex. 1003, 19:1–7 (stating that an important part of voice exchange and distribution is "attaching other media to the voice container" and that voice containers may have "digitized greeting cards appended to them"). Petitioner also describes "attachment" as "associating" in referring to Zydney's Figure 6, which discloses that the software agent asks the user "what multimedia file *to associate* [to] this voice container." *Id.* at 54–55 (citing Ex. 1003, Fig. 6) (emphasis added). Figures 16–18 of Zydney, according to Petitioner, "similarly provide a three-part description of the generation and transmission of a voice container with multimedia attachments" and "confirm that the multimedia file is attached to the voice container on the originator's client system before the voice container and attachment are transmitted to the central server." *Id.* at 55 (citing Ex. 1003, 35:15–22; Figs. 16–18). Relying on Dr. Lavian's testimony, Petitioner contends that, although "Zydney does not appear to explicitly describe which part of the software on the client system attaches files to voice containers," a person of ordinary skill in the art "would have found it obvious that the software agent that generates and transmits the voice container (the 'instant voice messaging application') could also handle attachment of files to the voice container, given that the software agent

performs the various other functions for generating and transmitting voice containers." *Id.* at 55–56 (citing Ex. 1002 ¶¶ 216–217).

We agree with Petitioner that these disclosures of Zydney teach that the software agent ("instant voice messaging application") attaches one or more files to the voice container ("instant voice message"). We are also persuaded that the software agent is responsible for the attachment of files, because Zydney describes that the software agent is responsible for the generating and transmitting of the voice containers and that the association of the file with the voice container (as shown in Figure 16) occurs at the "originator" at the request of the user. *Id.* at 54–56 (citing Ex. 1003, 19:1–7, 22:19–20, 35:15–22, Figs. 16–18; Ex. 1002 ¶¶ 216–217).

We are further persuaded by Petitioner's reliance on a specific standard for effecting attachments of multimedia files to voice containers. 1667 Pet. 56. In particular, Petitioner points out Zydney's disclosure of formatting voice containers using the Multipurpose Internet Mail Extension ("MIME") format, which allows attachment of files to be specified in a message header. *Id.* at 34 (citing Ex. 1003, 19:6–12). According to this embodiment then, a voice container would be formatted under the MIME standard, where a header identifies the file or files attached to the MIME-formatted voice container. Ex. 1003, 19:6–12. We find that this MIME-formatted voice container, which includes the voice data or digitized audio, includes the information necessary in the header to link the files that the user has attached to the voice container. The claim requires attaching the one or more files to the instant voice message, and because we have

construed the attachment to mean that the files are associated to the instant voice message, the identification of the files in the header performs the necessary association. Again, because the association is performed at the originator (*see* Zydney's Figure 16), we understand Zydney to teach or suggest that the software agent of the originator would also perform the MIME formatting. In this manner, the software agent controls the formatting and linking necessary for the audio message to reach the recipient, together with the user-specified attachments. There is no other software in Zydney to which the "associating" function is attributed, and Zydney does not describe file associations occurring elsewhere in the system. Per Dr. Lavian's testimony, which we credit, the client's software agent performs the attachments, regardless of whether the attachment is performed as a multimedia file attachment using the MIME standard. *See* Ex. 1002 ¶¶ 210–218.

Patent Owner argues that the MIME disclosures in Zydney "are directed to the voice container itself being a MIME attachment to an email, and not the voice container, let alone the instant voice message, having a MIME attachment." 1667 PO Resp. 19. We do not agree with Patent Owner's characterization of Zydney in this regard. Zydney describes the MIME format as the standard for formatting the voice container to include the header that identifies the attachments of multimedia files. Ex. 1003, 19:6–12. This disclosure provides additional detail of the technology that Zydney uses to format the voice container to identify attachments of files. We acknowledge that Zydney also teaches the use of MIME for another purpose: to construct an email message with the "voice mail conversation"

as a digitally-encoded MIME attachment. Ex. 1003, 15:15–17, 17:2–4. There is no argument, however, in the Petition, that Zydney teaches the required attachment of a file to an instant voice message by using the MIME format to make *the voice container itself* an attachment to an email. Instead, we find that Zydney describes two different uses for the MIME standard. The first, and the one relevant to our discussion, is the use of MIME formatting to include a header for the necessary associations of files to the voice container. The second, not relevant to our discussion, is the use of MIME encoding to attach voice containers to an email message as a way to transport undelivered voice containers via email or to have voice conversations with email recipients. We have discussed above the first use of MIME as being particularly instructive in providing the technical details of how Zydney actually performs the attachment. *See also* Ex. 2001 ¶ 51 (Mr. Easttom stating that the MIME format may be used to format the voice container so that attachments may be associated with it). Patent Owner's arguments about MIME use for email attachments are unpersuasive, as they address the second use of MIME, on which Petitioner does not rely.

Patent Owner also argues Zydney does not attach files to the instant voice message itself, but, "[a]t most, . . . attaches 'media' to only the encapsulating package, i.e., the voice container," which, Patent Owner contends, "encapsulates and transports," but is "distinct from[,] the voice message." 1667 PO Resp. 15–18; *see also* PO Supplemental Br. 8 (arguing Zydney does not teach or suggest the "instant voice message" because Zydney discloses attachments to a "voice container," as distinguishable from "attaching . . . to the distinct and separately-generated voice data or message

contained within the voice container"). According to Patent Owner, Zydney's teaching of attachment to the voice container "is inapposite because the claim language requires that the one or more files be attached to the instant voice message *itself*, not to a distinct container for that message." 1667 PO Resp. 15. These arguments thus focus on an alleged distinction between the message content and the container—a distinction we have rejected with regard to the constructions of both the "instant voice message" and the "attaching" limitations. *See supra* Sections IV.A.1, IV.A.2.

As already stated, the data content that includes a representation of an audio message is paramount to our construction, not the format or packaging of that data content. Zydney's voice container, regardless of its structure, is data content that includes a representation of the audio message, and, thus, teaches the "instant voice message" as we have construed the term. Further, as we stated above, the attachment of files to the "instant voice message" is effected by associating the files, such as by linking or setting flags. We are not persuaded that the claim requires a restrictive "attachment" or appendage to a particular structure of the "instant voice message." As long as the software agent produces information that allows Zydney's system to associate the voice message with its attachments, it is irrelevant that the "voice container" is not the voice data itself, but rather the "container" or data structure that packages the voice data for transport. *See* Ex. 1003, 12:6 ("The voice data is transmitted in a voice container."). Neither the plain reading of the claim nor our construction leaves room for exalting differences between the format of the voice container and the data content that it carries. What is important is that Zydney's voice container is data

content. Whether the data content is packaged in a certain manner, and with other data, for transport is not germane to the claim construction. Zydney's software agent associates the multimedia file with the voice container, which accomplishes the required association of the attachment with the instant voice message. Further, in the portions cited by Petitioner, Zydney accomplishes "attachments" in the same manner as the '622 patent, by making an association between the instant voice message and the file attachment. Figure 6 of Zydney explicitly discloses making such an association. Figure 16 of Zydney also explicitly states "associating" the multimedia file with the sender's voice container. We also are persuaded by Dr. Lavian's testimony that a person of ordinary skill in the art would have found it obvious that attaching files to a voice container would have been part of the process of packing the message into a voice container. Ex. 1002 ¶¶ 216–217. Thus, Patent Owner's arguments that Zydney's teaching of attaching media to the voice container does not render obvious attaching files "to an instant voice message," based on an alleged distinction in Zydney between the voice message and the voice container, are unpersuasive. What matters for purposes of meeting the claim limitation is that the software agent associates the "one or more files" with the voice container ("instant voice message"). As stated above, we find that Zydney teaches this.

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In conclusion, we have reviewed the arguments and evidence in the record and determine that Petitioner has demonstrated by a preponderance of

the evidence that claim 27 of the '622 patent is unpatentable as obvious over Zydney in view of Shinder.

c. Discussion of Independent Claim 38

Independent claim 38 differs from independent claim 27 in its omission of the "document handler system" limitation and inclusion instead of "a display displaying a list of one or more potential recipients for an instant voice message." *Compare* Ex. 1001, 27:11–23, *with id.* at 26:17–30. Petitioner relies on the same arguments and evidence for the common limitations between claims 27 and 38. 1667 Pet. 57. With respect to the added "display" limitation, Petitioner relies on Zydney, pointing particularly to Zydney's disclosure that an originator "select[s] one or more recipients from a list maintained by the originator and presented visually by the agent." Pet. 57 (emphasis omitted) (quoting Ex. 1003, 14:18–19) (citing Ex. 1003, Fig. 7). Relying on Dr. Lavian's testimony, Petitioner further contends that a person of ordinary skill in the art "would have understood that this list would be 'presented visually' on the display of the client device." *Id.* (emphasis omitted) (quoting Ex. 1002 ¶ 226).

Notwithstanding a subheading in its Response stating "No proof of obviousness for 'a display [at the client device] displaying a list of one or more potential recipients' (claims 38–39)" (1667 PO Resp. 38 (emphasis omitted)) and a conclusory statement that "[f]or the foregoing reasons, Petitioners have failed to meet their obligation to prove that claim 38 . . . would have been obvious at the time of the invention" (*id.* at 44), Patent Owner does not provide any substantive challenge to Petitioner's mapping

of Zydney and Shinder to the limitations of claim 38. *See generally id.* at 38–44. Rather, the intervening pages of the Response between the quoted subheading and conclusion statement set forth Patent Owner's contentions that Appelman, cited only against claims 22 and 39 and discussed below, fails to teach an additional limitation recited in claim 39. *See generally id.* Although claim 39 depends from claim 38, Patent Owner's contentions regarding Appelman vis-à-vis the additional limitation of claim 39 do not persuasively rebut Petitioner's arguments and evidence regarding claim 38.

In its Reply, Petitioner points out that Patent Owner's arguments concerning claims 38 and 39 are repeated essentially verbatim from its Preliminary Response. 1667 Reply 23. Petitioner further argues that, although claim 39 recites "display[ing] an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message," "there is plainly nothing recited in claim 38 that adds a limitation requiring the capability to select potential recipients that are currently unavailable." *Id.* at 23–24 (emphasis omitted).

After full consideration of the parties' arguments and cited evidence, we are persuaded, for the reasons stated by Petitioner and discussed above, that Petitioner has established by a preponderance of the evidence that Zydney teaches "a display displaying a list of one or more potential recipients for an instant voice message" and that the subject matter of claim 38 as a whole would have been obvious over Zydney and Shinder. We agree with Petitioner, in particular, that Zydney describes its software agent as providing a visual presentation of a list of potential recipients that

may be selected (*see* Ex. 1003, 14:18–19, Fig. 7 (step 1.1.2)) and, therefore, teaches displaying a list of one or more potential recipients for an instant voice message. We also agree with Petitioner that claim 38 does not require capability to select potential recipients that are currently unavailable. 1667 Reply 24.

In conclusion, we have reviewed the arguments and evidence in the record and determine that Petitioner has demonstrated by a preponderance of the evidence that claim 38 of the '622 patent is unpatentable as obvious over Zydney in view of Shinder.

d. Discussion of Dependent Claims 6–8, 10, 11, 13, 18–21, 23, and 32–35

Claim 6 depends from claim 3 and further recites "wherein the instant voice message includes an identifier field including a unique identifier associated with the instant voice message." Ex. 1001, 24:36–38. Petitioner contends that Zydney discloses several examples of "unique identifiers" that meet the claim language. 1667 Pet. 34–35. For example, Petitioner argues, "Zydney explains that '[e]ach message will have a unique identifier that will encode,' among other things, 'the sending software agent[']s identifier . . .,'" which "is stored as the 'originator's code 302 (which is a (unique identifier)' as shown in Figure 3." *Id.* at 34 (emphasis omitted) (quoting Ex. 1003, 34:4–8, 23:2–3). According to Petitioner, "[b]ecause the originator's code (302) is encoded as part of the voice container, it is clearly 'associated with' the instant voice message." *Id.* (emphasis omitted) (Ex. 1002 ¶ 148). We agree and also note that Patent Owner does not argue dependent claim 6 separately from claim 3. Based on Petitioner's arguments and cited

evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney and Shinder renders obvious claim 6.

Claim 7 depends from claim 3 and further recites:

> wherein the instant voice message includes a source field including a unique identifier associated with at least one of a given one of the plurality of instant voice message client systems that created the instant voice message and a given one of the plurality of users using the given one of the plurality of instant voice message client systems.

Ex. 1001, 24:39–45. Petitioner contends this limitation is met by Zydney's "unique address" or "unique id," which is assigned by a registration server and uniquely identifies the software agent of the originator (sender) of a message. 1667 Pet. 35 (citing Ex. 1003, 23:18–24). According to Petitioner, "Zydney also makes clear that this unique identifier can be carried in the voice container (the 'instant voice message')," because "Zydney explains that the 'voice container components include an originator code 302 (which is a unique identifier).'" *Id.* (emphasis omitted) (quoting Ex. 1003, 23:1–3) (citing Ex. 1003, 34:4–8). Petitioner concedes that "Zydney does not provide additional detail about the 'originator's code,'" but further contends, relying on Dr. Lavian's testimony, that "it would have been obvious to a person of ordinary skill in the art that the originator's code would have been the 'unique id' (or 'unique address') that the server in Zydney assigned to the sending (originating) software agent," because Zydney explains that "'[t]he registration server assigns the software agent a unique address,' and in the next sentence, explains that 'this address is used

for all communications from the software agent to the server. . . .'" *Id.* at 36 (quoting Ex. 1003, 23:18–19) (citing Ex. 1002 ¶ 152). Petitioner also points out that "Zydney later states that '[e]ach message will have a unique identifier that will encode the sending software agent[']s identifier', and the only field of the voice container in Figure 3 that meets that description is the originator code (302) field." *Id.* (emphasis omitted) (quoting Ex. 1003, 34:4–5). Petitioner further contends that the originating code is associated with both the "client system[] that created the instant voice message" and the operating "user[] using the given one of the plurality of instant voice message client systems," because the sending software agent is running on a client system operated by the logged-in user of the system. *Id.* at 37. We agree and also note that Patent Owner does not argue dependent claim 7 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney and Shinder renders obvious claim 7.

Claim 8 depends from claim 3 and further recites:

> wherein the instant voice message includes a destination field including a unique identifier associated with at least one of a given one of the plurality of instant voice message client systems identified as a recipient of the instant voice message and a given one of the plurality of users using the given one of the plurality of instant voice message client systems.

Ex. 1001, 24:46–52. Petitioner points out that claim 8 is similar to claim 7, with the exception that claim 8 recites a "destination field" instead of a "source field" and, thus, requires that it be associated with a recipient client

system rather than the originator client system. 1667 Pet. 38. Petitioner relies on similar arguments for claim 8 as for claim 7, but maps Zydney's "recipient's code 304" rather than "originator's code 302" to the recited destination field. *Id.* at 38–39 (citing Ex. 1003, Fig. 3; Ex. 1002 ¶¶ 152, 157–158, 161–164). We agree and also note that Patent Owner does not argue dependent claim 8 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney and Shinder renders obvious claim 8.

Claim 10 depends from claim 3 and recites that the system further comprises "a message database storing the instant voice messages received from the instant voice message client systems." Ex. 1001, 24:58–60. Petitioner maps Zydney's "message server," including its "message store," "depicted as a cylinder conventionally representing a database" in Figure 2 of Zydney, to the recited "message database." 1667 Pet. 39 (citing Ex. 1003, Fig. 2; Ex. 1002 ¶ 167). Further, Petitioner points to disclosure in Zydney that the message server is used to store voice containers. *Id.* at 39–40 (citing Ex. 1003, 25:1–3 ("The message server will be the repository for messages sent to software agents that are not logged onto the system."), 30:6–8 ("A successful log-in will result in all of the user messages waiting in the message server being downloaded to the software agent. The user may have elected to retain copies on the message server."); Fig. 4 ("if recipient is not online, client sends voice container to server file.")). We agree and also note that Patent Owner does not argue dependent claim 10 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are

persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney and Shinder renders obvious claim 10.

Claim 11 depends from claim 3 and further recites:

> wherein, upon receipt of an instant voice message, the communication platform system determines if there is the current connection to one of the plurality of instant voice message client systems identified as a recipient of the instant voice message, and if there is no connection with the one of the plurality of instant voice message client system identified as the recipient, the instant voice message is stored and delivered when the one of the plurality of instant voice message client systems identified as the recipient re-established a connection.

Ex. 1001, 24:61–25:3. Petitioner relies on Zydney's disclosure that its central server (which Petitioner maps to the "communication platform system" of claim 3) "track[s] and maintain[s] the status of all software agents," which status, Petitioner points out, includes "the core states of whether the recipient is online or offline." 1667 Pet. 40 (citing Ex. 1003, 13:12–14, 14:6–9, 14:17–15:1). Petitioner contends, "[t]he communication platform system in Zydney therefore 'determines if there is a current connection to one of the plurality of instant voice message client systems,' for the same reasons as claim 3[] above." *Id.* (emphasis omitted). Petitioner further points to disclosure in Zydney of "uploading the voice container(s) to a central file server" and subsequently "[1] notifying an available software agent on the recipient's computer of the arrival of a new message in near real-time or, [2] notifying the software agent on the recipient's computer when it first becomes available of voice containers in the central storage." *Id.* at 41–42 (quoting Ex. 1003, Fig. 8 (steps 1.2.3, 1.2.5)). Petitioner

argues, "[b]ecause deciding whether to take action [1] or action [2] depends on whether the recipient is currently 'available,' Zydney confirms that the communication platform system makes a determination, 'upon receipt of an instant voice message [voice container],' whether there is a 'current connection' to the recipient client." *Id.* at 42 (emphasis omitted) (citing Ex. 1002 ¶ 173). For the second conditional branch of claim 11 (i.e., "if there is no connection . . ."), Petitioner additionally points to disclosure in Zydney of the message server being the repository for messages sent to software agents that are not logged onto the system and of messages stored on the message server being sent to the appropriate software agent once a software agent has been authenticated, as well as disclosure of downloading voice recordings to the recipient's computer after it first becomes available. *Id.* at 42–43 (citing Ex. 1003, 25:1–4, Fig. 8 (steps 1.2.5, 1.2.6)). We agree and also note that Patent Owner does not argue dependent claim 11 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney and Shinder renders obvious claim 11.

Claim 13 depends from claim 3 and further recites "wherein each of the instant voice message client systems comprises an instant voice messaging application generating an instant voice message and transmitting the instant voice message over the packet-switched network to the messaging system." Ex. 1001, 25:9–13. Petitioner maps Zydney's software agents utilized by sending and receiving devices to the recited "instant voice messaging application." 1667 Pet. 43 (citing Ex. 1003, 11:16–18, 13:2–6,

13:19–22, 14:2–12, 14:14–16). Petitioner contends, in particular, that the software agent running on Zydney's sending client system can generate and transmit instant voice messages in the form of voice containers. *Id.* at 43–45 (citing Ex. 1003, 13:2–6, 13:19–22, 14:2–5, 33:1–2, Fig. 4; Ex. 1002 ¶ 180). We agree and also note that Patent Owner does not argue dependent claim 13 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney and Shinder renders obvious claim 13.

Claims 18 and 32 depend from claims 13 and 27, respectively, and each further recite "wherein the instant voice messaging application includes an audio file creation system creating an audio file for the instant voice message based on input received via an audio input device coupled to the client device." Ex. 1001, 25:31–35, 26:48–52. Petitioner relies on Zydney's disclosure of the originator digitally recording messages for one or more recipients using a microphone-equipped device and the software agent. 1667 Pet. 45–46 (citing Ex. 1003, 16:1–4, 20:11–14, 21:14–16, Fig. 7 (step 1.1.3)). For instance, Zydney states that the software agent stores the compressed voice file temporarily on the personal computer. *Id.* We agree and also note that Patent Owner does not argue dependent claims 18 and 32 separately from claims 3 (from which claim 13 depends) and 27. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney and Shinder renders obvious claims 18 and 32.

Claims 19 and 33 depend from claims 13 and 27, respectively, and each further recite "wherein the instant voice messaging application includes an encryption/decryption system for encrypting the instant voice messages to be transmitted over the packet-switched network and decrypting the instant voice messages received over the packet-switched network." Ex. 1001, 25:36–41, 26:53–58. With respect to claim 19, Petitioner points out that Zydney, at Figure 2, discloses the software agent as including "compression data encryption/protocols" to encrypt the instant voice message. 1667 Pet. 46–47. Petitioner further argues that Zydney discloses a "standard codec" used in transmitting and receiving voice containers and that it would have been obvious to a person of ordinary skill in the art that the "standard codec" would have been used to encrypt voice containers being transmitted and to decrypt voice containers being received by the software agent. *Id.* at 47–48 (citing Ex. 1003, 27:1–6; Ex. 1002 ¶ 187). Petitioner relies on the same arguments and evidence for claim 33. *Id.* at 56. We agree and also note that Patent Owner does not argue dependent claims 19 and 33 separately from claims 3 (from which claim 13 depends) and 27. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney and Shinder renders obvious claims 19 and 33.

Claims 20 and 34 depend from claims 13 and 27, respectively, and each further recite "wherein the instant voice messaging application includes a compression/decompression system for compressing the instant voice messages to be transmitted over the packet-switched network and decompressing the instant voice messages received over the packet-switched

network." Ex. 1001, 25:42–47, 26:59–64. With respect to claim 20, Petitioner points out that Zydney, at Figure 2, discloses the software agent as including "compression data encryption/protocols." 1667 Pet. 48. Petitioner further argues that Zydney makes clear that the sending (originating) software agent compresses voice containers that are to be sent, and the receiving agent decompresses voice containers that are received. *Id.* at 48–49 (citing Ex. 1003, Fig. 7 (step 1.1.5), Fig. 9 (step 1.3.4); Ex. 1002 ¶¶ 189–191). Petitioner relies on the same arguments and evidence for claim 34. *Id.* at 56. We agree and also note that Patent Owner does not argue dependent claims 20 and 34 separately from claims 3 (from which claim 13 depends) and 27. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney and Shinder renders obvious claims 20 and 34.

Claim 21 depends from claim 13 and further recites "wherein the instant voice messaging application displays a list of one or more potential recipients for the instant voice message." Ex. 1001, 25:48–50. Petitioner points to Zydney as disclosing this limitation. 1667 Pet. 49. In particular, Petitioner contends Zydney discloses that the software agent on the client system displays a list of potential recipients, wherein the originator "select[s] one or more recipients from a list maintained by the originator and presented visually by the agent." *Id.* (emphasis omitted) (quoting Ex. 1003, Fig. 7 (step 1.1.2)) (citing Ex. 1003, 14:18–19). We agree with Petitioner that Zydney, thus, describes its software agent as displaying a list of potential recipients. We agree and also note that Patent Owner does not argue dependent claim 21 separately from claim 3, from which claim 13 depends.

Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney and Shinder renders obvious claim 21.

Claims 23 and 35 depend from claims 13 and 27, respectively, and each further recite "wherein the instant voice message application generates an audible or visual effect indicating receipt of an instant voice message." Ex. 1001, 25:56–58, 26:65–67. As cited by Petitioner, Figure 9 of Zydney discloses "launching a software agent," "automatically receiving . . . voice containers," and then "identifying and presenting the list of voice containers." Ex. 1003, Fig. 7 (steps 1.3.1–1.3.3) (cited at 1667 Pet. 49–50). Petitioner contends, "[t]he 'list of voice containers' presented in Step 1.3.3. discloses the software agent on the receiving client system providing the claimed 'visual effect' because it indicates to the recipient that an instant voice message has been received." 1667 Pet. 50 (emphasis omitted). Petitioner relies on the same arguments and evidence for claim 35. *Id.* at 56. We agree and also note that Patent Owner does not argue dependent claims 23 and 35 separately from claims 3 (from which claim 13 depends) and 27. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney and Shinder renders obvious claims 23 and 35.

e. Discussion of Dependent Claims 14 and 28

Claims 14 and 28 depend from claims 13 and 27, respectively, and each further recite "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." Ex. 1001, 25:14–18, 26:31–35. Petitioner concedes that "Zydney does not use the term 'message database' to describe storage of instant voice messages on the client system, and does not describe a 'database record including a unique identifier,'" but, Petitioner contends, "these limitations would have been obvious in view of Clark." 1667 Pet. 58–59 (emphasis omitted). Petitioner relies, in particular, on Clark's message store 23, which comprises a database structure for temporary or permanent storage of messages. *Id.* at 59 (citing Ex. 1008, 9:11–15). Petitioner argues, and we agree, that Clark specifically describes the message store as a "database" and that the database can be located on a client system. *Id.* at 59–60 (citing Ex. 1008, 8:31–44, 10:27–33, 11:1–5, Fig. 4A). Clark, for example, describes an embodiment in Figure 4A, reproduced below, in which the user's computer contains the message client and the message store. *Id.*; Ex. 1008, Fig. 4A.

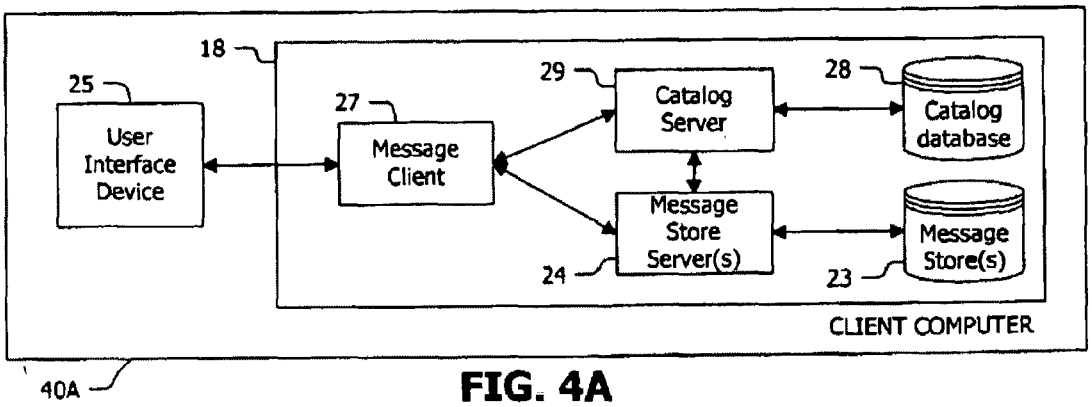

FIG. 4A

Figure 4A depicts an embodiment of a physical configuration of the client computer 18 on which electronic messages are received and stored. Ex. 1008, 5:1–3, 4:25–27. The electronic messages of Clark are not limited

to e-mails, as it describes that it is known for electronic messages to include instant messaging and that the electronic message may have attachments. *Id.* at 1:37–39, 8:36–44. Clark organizes the stored electronic messages in the database of message store 23 using a catalog database 28, which organizes the messages into different folders. *Id.* at 9:54–60; *see also* 10:11–19 (describing the various elements of an electronic message shown in Figure 3 and that the elements can be the basis for associating the message with one or more folders). Notwithstanding Clark's use of the catalog database for further organizing the messages into folders, Clark describes a message store 23 as a database for storing the messages, which teaches the required "message database."

Petitioner further points out that Clark discloses storing both outgoing (sent) and incoming (received) messages in message store 23. 1667 Pet. 60–61 (citing Ex. 1008, 16:50–53, 17:9–22). On this point we agree that Clark describes information about the messages stored in the database as including the dates and times for received and sent messages. Ex. 1008, 17:9–22.

For the limitation that the instant voice message be "represented by a database record including a unique identifier," Petitioner relies on Clark's disclosure of assigning a unique StoreMessageId to the message when the message is added to message store 24. 1667 Pet. 61 (citing Ex. 1008, 11:50–54). Petitioner also points out that "StoreMessageId . . . may comprise number[s], or other identifiers, assigned to the messages and attachments respectively by message store server 24." *Id.* (quoting Ex. 1008, 11:21–24). Petitioner argues that the "unique identifier" of Clark,

i.e. StoreMessageId, is stored in a database record. *Id.* (citing Ex. 1008, 11:31–32 ("MessageSummary table 52 [] contains the StoreMessageId 52A of messages in message store 23.")). From the discussion above, we agree that, in Petitioner's asserted combination, Zydney's voice containers are stored in the message store of Clark, and each voice container is identified by a StorageMessageId that is a unique identifier. We also find that Clark's MessageSummary table 52 includes a record that contains the StorageMessageId unique identifier, and, thus, that record with the StorageMessageId represents the stored voice container. Therefore, we are persuaded that Clark teaches that the "instant voice message is represented by a database record including a unique identifier."

The Petition states various reasons for combining Zydney's and Clark's teachings. 1667 Pet. 61–64. Petitioner argues, for example, and we agree, that Clark provides compelling reasons for why a person of ordinary skill in the art would use a message database in messaging client software, such as the software agent of Zydney. *Id.* On this point, Clark explains that existing prior art electronic message systems did not provide sufficiently effective ways to store, organize, and search electronic messages. Ex. 1008, 1:20–4:8. And Clark's invention provides not only the message store or database, but also the cataloging of messages that accomplishes the desired organization. *Id.* at 4:25–39. Particularly relevant to our analysis is Clark's description of its invention as "advantageously [] integrated with messaging client software . . . to facilitate the organization of electronic messages." *Id.* at 4:36–38. Thus, Clark informs us that it would have been advantageous to include a message database in messaging client software to organize further

electronic messages, including instant messages. Dr. Lavian testifies, and we credit this testimony, that Clark's teachings would have encouraged a person of ordinary skill in the art to integrate Clark's client message database with Zydney's system to store and organize sent and received instant voice messages, including attachments. Ex. 1002 ¶ 257. Using the message database of Clark would have been an improvement of Zydney's client system. *Id.*

Thus, Petitioner has shown that it would have been obvious to combine Zydney and Clark for the reasons articulated by Clark. We find that given Clark's teachings, a person of ordinary skill in the art looking to improve Zydney's software agent capabilities of storing messages would have looked to Clark's method and system for organizing electronic messages using a message store. *See KSR*, 550 U.S. at 417 ("[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill."). We are persuaded that application of Clark's teachings to Zydney's system would not have been beyond the skill of a person of ordinary skill in the art. *See* Ex. 1002 ¶ 262.

Patent Owner argues that Clark's message store does not store "instant voice messages." 1667 PO Resp. 29–30. As we understand Patent Owner's argument, Clark allegedly focuses on storing voicemail messages, which the '622 patent distinguishes from an instant voice message. *Id.* at 29. While we recognize that there is a difference between a voicemail message and an instant voice message, the combination of teachings described above relies

on Clark's use of the message store to store Zydney's voice containers. This argument does not address the combined teachings of the references (which relies on Zydney's voice containers, not Clark's voicemail messages). And nothing in Clark has been shown to limit the message store to only storing voicemail messages. Indeed, we read Clark's description of the message store broadly and not limited to a particular type of message, such as voicemail messages as Patent Owner argues. *See* Ex. 1008, 8:31–44 (cited at 1667 Pet. 62; 1667 Reply 18). Clark describes, on this point, that the organization methods it describes "can be applied to organizing any sort of electronic messages which are to be temporarily or permanently stored" and "could also be applied to any other present or future types of electronic messages," including messages having attachments such as sound media. *Id.*

Patent Owner also argues that neither Clark nor Zydney teaches the message store as part of the client side "instant voice messaging application." 1667 PO Resp. 30. We are not persuaded by this argument. As stated above, Clark expressly teaches incorporating the message store in the client computer as part of the client messaging software. *See* 1667 Pet. 60 (citing Ex. 1008, 10:27–33, Fig. 4A). This teaches the message store would be in software such as Zydney's software agent, which is the client-side "instant voice messaging application" as discussed above.

Patent Owner additionally raises several arguments in an attempt to show that Clark does not teach the "database record" limitation. First, Patent Owner argues that claims 14 and 28 require the "database record" to be a record of the "message database." 1667 PO Resp. 30. Relying primarily on the claim language itself, Patent Owner contends that by

reciting the word "database" as part of both terms ("message database" and "database record"), the terms are interrelated so that a person of ordinary skill in the art would have concluded that the claims require storing the instant voice message *and* the unique identifier in the *same* message database. *Id.* at 30–31 (citing Ex. 2003 (Lavian Deposition Tr.), 88:6–89:6). More importantly for Patent Owner's second argument, the specification describes the *database record* as comprising *both* a message identifier and the instant voice message. *Id.* at 31 (citing Ex. 1001, 12:34–38). Patent Owner points to the specification's statement that the instant voice messages are "represented" as database records, such that the specification implies a meaning of "represented" to refer to the content of the database record. *Id.* at 31–32. In sum, Patent Owner contends that the claims require a *single* database record, in a *single* message database, where the record includes both the instant voice message and the unique identifier. Because the arguments from Patent Owner attempt to distinguish Clark based on the single-database-record argument, our analysis below focuses on that issue.

Based on the single-database-record characterization, Patent Owner argues that Clark's message is stored in one database record and the StoreMessageId is stored in a different database record. *Id.* at 32–34. Specifically, Patent Owner highlights that the unique identifier is stored in MessageSummary table 52 (in the catalog database), purposely separate from message store 23, which stores the message. *Id.* at 32–33 (citing Ex. 1008, 16:64–17:23, Fig. 5A, tables 52 and 54; Ex. 2001 ¶ 80; Ex. 2003, 42–43, 44:20–45:6).

We begin by ascertaining whether Patent Owner's characterization of the claim scope as requiring a single database record is proper. Claims 14 and 28 recite "wherein the instant voice message is represented by a database record including a unique identifier." Two things are evident from this plain language: (1) the instant voice message is *represented* by a database record; and (2) the same database record includes a unique identifier. Neither of these two features requires *storing* the instant voice message in the same database record that includes the unique identifier. Instead, by using the word "represented," the claim language seems to reject a requirement of *storing* the instant voice message in a database record. We conclude that this is the correct claim scope because, among other things, the claim uses the word *storing* elsewhere to expressly require *storing the instant voice message in the message database.* If it were a requirement to store the instant voice message in the database record of the message database, the applicant could have specifically claimed *storing* rather than requiring a "representative" relationship between the instant voice message and the database record. In a way, Patent Owner asks us to read the claim as if it stated "a message database storing the instant voice message in a database record including a unique identifier." *But see K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1364 (Fed. Cir. 1999) ("Courts do not rewrite claims; instead, we give effect to the terms chosen by the patentee."); *Tex. Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) ("[C]ourts can neither broaden nor narrow claims to give the patentee something different than what he has set forth.") (internal quotes omitted). We also view Patent Owner's request as urging that we read

limitations into the claim from an embodiment of a database record comprising the instant voice message. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004) ("We have cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.").

Finally on the issue of claim scope, we note that the specification uses the word "represented" in connection with another embodiment of a database record that does not support Patent Owner's argument. That embodiment states that "the users are *represented in the database as records*, each record comprising a user name, a password, and a contact list . . . and other data relating to the user." Ex. 1001, 13:63–66 (emphasis added). That embodiment also describes a *representative* relationship that does not require storing the "users" in the database record—such a requirement would be nonsensical. Only information pertaining to the user is stored in the record. The same *representative* relationship is encompassed by the claim language at issue. We are, therefore, not persuaded that the claims are as narrow as Patent Owner argues, and that Clark's "separate-table" disclosure is fatal to Petitioner's position.

Here, Petitioner has identified StoreMessageId, which is stored in a MessageSummary table of the catalog database, as having the required representative relationship to the stored message. 1667 Pet. 61. We agree that the representative relationship is satisfied, as the StoreMessageId pertains uniquely to the stored message. For the reasons discussed above regarding the proper scope of the claim, it is not relevant that the

StoreMessageId, in some embodiments of Clark, may be in a record (row of the MessageSummary table (*see* Ex. 1008, 16:58–60)) separate from the record that stores the message in message store.

But even under Patent Owner's narrow reading of the claim, we note that Petitioner persuasively *rebuts* Patent Owner's single-record distinctions because the unique identifier of Clark's StoreMessageId is not limited to being stored in a record that is separate from the record that contains the message in the message store. 1667 Reply 22 (arguing that the record that contains the message (Message table 54) includes both the message and the unique identifier.

Accordingly, based on the evidence provided by Petitioner, we find unpersuasive Patent Owner's arguments that Clark does not teach "wherein the instant voice message is represented by a database record including a unique identifier," even under Patent Owner's claim scope arguments, which we have rejected as improper.

Lastly, Patent Owner challenges the rationale to combine Clark and Zydney. First, Patent Owner argues that Clark teaches away from including the message data in the same table as MessageSummary table 52. 1667 PO Resp. 34–35. This argument is not persuasive. Petitioner's asserted combination does not rely on modifying Clark's MessageSummary table to include the message data. As we explained above, we do not view the claim scope as requiring that a single database record include both the instant voice message and the unique identifier. Therefore, an argument that Clark precludes a single-database-record modification is not commensurate with the claim scope.

Second, Patent Owner argues that the combination of Zydney and Clark would result in messages being deleted once they are sent to the server. 1667 PO Resp. 36–38. In particular, Patent Owner contends the combination would result in erasing the voice container from the sender device, thereby defeating the stated rationale, running counter to Clark's stated goal of cataloging electronic messages, and rendering the combination inoperable for its intended purpose. *Id.* None of these challenges to Petitioner's rationale to combine are persuasive. Although Zydney deletes the sent message from the sender's device temporary storage, Patent Owner does not show any disclosure in Zydney that would *teach away* from a person of ordinary skill in the art seeking and achieving the use and purpose of Clark's message store. The disclosure in Zydney of a "reserved temporary storage" does not discourage or discredit the use of other, more permanent types of storage altogether or from the purposes disclosed in Clark for storing and cataloging messages on a more persistent basis. Indeed, we find that the opposite is the case, because Clark describes its usefulness not only for permanent storage, but for temporary storage as well. *See* Ex. 1008, 9:13–15 ("Each message store 23 comprises a memory, file or database structure that provides temporary or permanent storage for the contained messages 22."). This teaching of Clark contradicts Patent Owner's bare assertion that Clark would not work simply because of the use and release of temporary storage. 1667 Reply 22–23. We find, therefore, that Clark is entirely compatible with temporary storage and that Clark says nothing about discouraging the use of the disclosed organization of electronic messages in temporary storage.

Furthermore, the arguments by Patent Owner are not persuasive because they imply that Zydney precludes permanent storage of the sent and received voice containers. The fact that Zydney uses temporary storage does not preclude the use of permanent storage. And Patent Owner does not argue any teaching in Zydney that would be contrary to the applicability of organized permanent storage in Zydney's system, in addition to the use of temporary storage. Accordingly, we are not persuaded by Patent Owner's arguments that a person of ordinary skill in the art would not combine the teachings of Zydney and Clark as asserted by Petitioner.

Based on the foregoing, we conclude that Petitioner has shown by a preponderance of the evidence that the subject matter of claims 14 and 28 would have been obvious over the combination of Zydney and Shinder, as applied to claims 13 and 27, in further view of Clark.

f. Discussion of Dependent Claims 15 and 29

Claim 15 depends from claim 14 and further recites "wherein the message database includes a plurality of instant voice messages recorded by a user of the client device and instant voice messages received over the packet-switched network." Ex. 1001, 25:19–22. Claim 29 depends from claim 28 and further recites "wherein the instant voice message stored in the message database include a plurality of instant voice messages recorded by a user of the client device and instant voice messages received over the packet-switched network." *Id.* at 26:36–40. Petitioner contends that, as explained for claim 14, the "message database" of the Zydney/Clark combination stores outgoing voice containers and voice containers received

over the Internet (i.e., packet-switched network). 1667 Pet. 64–65. Petitioner further relies on Zydney as teaching that the outgoing messages would be "recorded by a user of the client device," such as by using a microphone. *Id.* at 65 (citing Ex. 1003, 16:1–3, Fig. 7 (steps 1.1.3, 1.1.5)), *see also id.* at 68 (relying for claim 29 on arguments with respect to claim 15). We agree and also note that Patent Owner does not argue dependent claims 15 and 29 separately from claims 14 and 28. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney, Shinder, and Clark renders obvious claims 15 and 29.

g. Discussion of Dependent Claims 16 and 30

Claim 16 depends from claim 15 and further recites "wherein the instant voice messaging application displays at least one of the plurality of instant voice messages stored in the message database." Ex. 1001, 25:23–26. Claim 30 depends from claim 29 and further recites "a display displaying at least one of the plurality of instant voice messages stored in the message database." *Id.* at 26:41–43.

Petitioner relies on Figure 9 of Zydney that states "presenting the list of voice containers" to the recipient. 1667 Pet. 65 (citing Ex. 1003, Fig. 9 (step 1.3.3)); *see also id.* at 68 (relying for claim 30 on arguments with respect to claim 16). Petitioner also relies on Clark's disclosure of the user interface with display 60, as shown in Figure 6, reproduced below. *Id.* at 65–66 (citing Ex. 1008, 12:8–10, 12:63–13:2, Fig. 6; Ex. 1002 ¶¶ 276–279), 68.

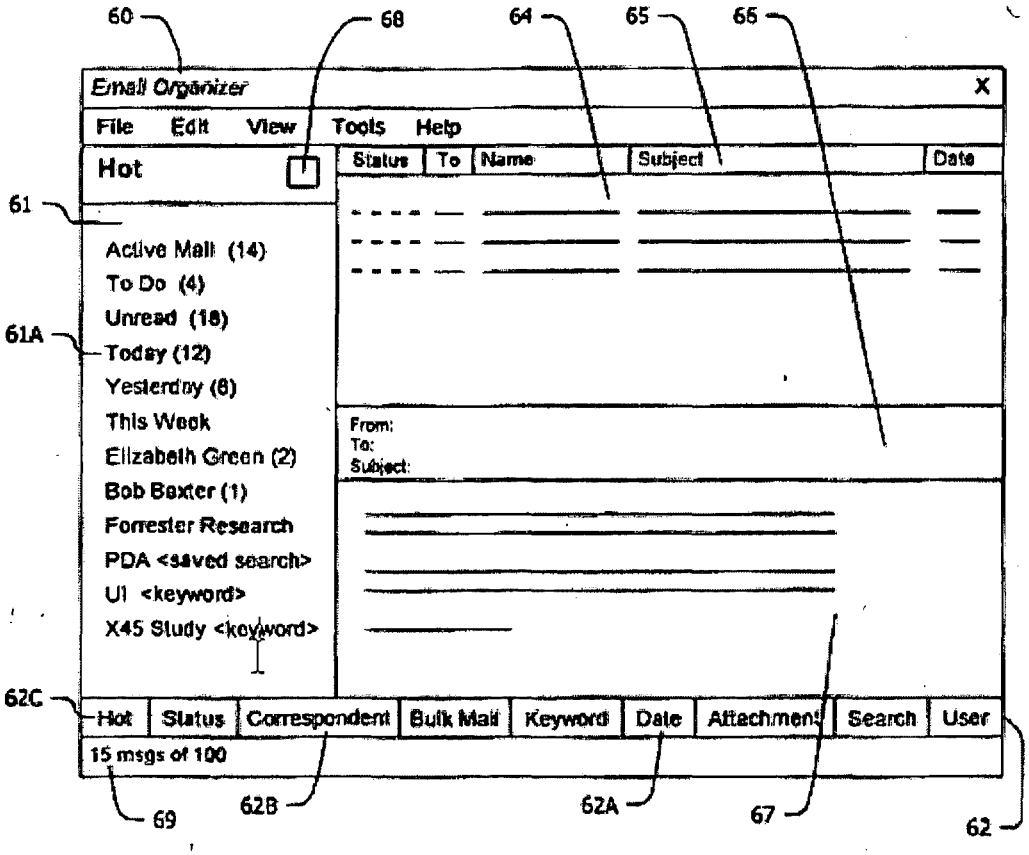

FIG. 6

Figure 6 of Clark, reproduced above, illustrates a screen display for a user interface that shows folders and messages in multiple views. Ex. 1008, 5:10–11. As explained by Clark, "[d]isplay 60 includes a message header display panel 66 and a message contents display panel 67." *Id.* at 12:63–64. "When the interface detects that a user has selected a specific message, . . . then the interface displays selected information about the associated message in message header panel 66 and displays the body of the associated message in the message contents panel 67." *Id.* at 12:64–13:2.

We agree with Petitioner and also note that Patent Owner does not argue dependent claims 16 and 30 separately from claims 14 and 28. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney, Shinder, and Clark renders obvious claims 16 and 30.

h. Discussion of Dependent Claims 17 and 31

Claim 17 depends from claim 14 and further recites "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." Ex. 1001, 25:27–30. Claim 31 depends from claim 28 and further recites "wherein the instant voice messaging application includes a file manager system storing, deleting and retrieving the instant voice messages from the message database in response to a user request." *Id.* at 26:44–47.

Petitioner contends that, although these claim limitations only require the file manager to perform "at least one" of storing, deleting, and retrieving instant voice messages from the message database (in response to a user request, in the case of claim 31), Zydney and Clark *each* disclose the performance of *each* of those actions. 1667 Pet. 66. First, according to Petitioner, "Zydney discloses that a sending (originating) user can specify that the message will be delivered as part of a single instant voice message, which causes the voice container to be stored." *Id.* at 67 (citing Ex. 1003, 16:1–4, 30:15–16). Relying on Dr. Lavian's testimony, Petitioner contends

"[i]t would have been obvious that in order for the software agent in Zydney to store the voice container file, the client would have included a system that services requests from the agent to create and write files." *Id.* (citing Ex. 1002 ¶ 284). Second, Petitioner argues, Zydney discloses retrieving instant voice messages, because, for example, Zydney discloses that the originator's software agent "provid[es] visual means to control and monitor the recording quality in the originator's agent" and that the recipient's software agent "provid[es] visual means for adjusting the quality and speed of playback of each recording through the software agent." *Id.* (quoting Ex. 1003, Figs. 7, 9). Relying on Dr. Lavian's testimony, Petitioner contends that "[a] person of ordinary skill in the art would have understood that playing a recorded voice message would require retrieving that message from storage" and "would have understood from the disclosure of 'visual means' that the user is provided with controls that respond to user requests." *Id.* (emphasis omitted) (citing Ex. 1002 ¶ 285). Third, Petitioner alleges that Zydney also describes controls on the client computer for deleting instant voice messages, as well as saving or sending them to additional recipients. *Id.* at 68 (citing Ex. 1003, Fig. 9). While admitting that Zydney "does not appear to explicitly describe a 'message database,'" Petitioner contends, "this aspect of the claim limitation would have been obvious in view of Clark," both for the reasons described in connection with claim 14 and because Clark "also discloses that the user can store, retrieve, and delete messages from the message database." *Id.* (citing Ex. 1002 ¶¶ 287–294; Ex. 1008, 4:25–27, 8:65–9:1, 9:15–19, 12:63–13:2, 18:25–29, Figs. 2, 6). Petitioner additionally contends that the recited functions of the file manager

in claim 17 would have been plainly obvious even in the absence of the above teachings of Zydney and Clark. *Id.* In particular, relying on Dr. Lavian's testimony, Petitioner contends that "[a]ny user of a database system for storing messages, including the Clark system as implemented with Zydney's system, would have expected the ability to store, delete, and retrieve the messages, as these functions would have been fundamental to the purpose of any such database." *Id.* (citing Ex. 1002 ¶ 297). We agree with and adopt the reasoning and evidentiary support Petitioner provides for why either Zydney or Clark teaches these limitations of claims 17 and 31.

As to the additional limitation in claim 31 that the file manager system performs the recited functions "in response to a user request," Petitioner argues that "Zydney discloses that the instant message delivery mode can be selected by the user, and that selection causes the storage of the voice container, so the storage can occur in response to a user request." *Id.* at 69 (citing Ex. 1003, 15:4–6). Petitioner also argues that "Zydney also discloses user controls for saving, retrieving, and deleing voice containers," and "Clark also discloses that its file manager system can store, retrieve, and delete messages in response to a user request, as discussed for claim 17. *Id.* (citing Ex. 1003, Fig. 9; Ex. 1002 ¶¶ 284–294); *see also* Ex. 1008, 4:25–27, 8:65–9:1, 9:15–19, 12:63–13:2, 18:25–29, Figs. 2, 6 (previously cited for claim 17). We again agree with and adopt the reasoning and evidentiary support Petitioner provides for why Zydney or Clark teaches this limitation of claim 31.

Patent Owner does not argue dependent claims 17 and 31 separately from claims 14 and 28.[10] Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney, Shinder, and Clark renders obvious claims 17 and 31.

i. Discussion of Dependent Claims 22 and 39

Claim 22 depends from claim 21 and further recites "wherein the instant voice messaging application displays an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message." Ex. 1001, 25:51–55. Claim 39 depends from claim 38 and further recites "wherein the display includes an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message." *Id.* at 27:24–27.

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[10] We note in this regard that Patent Owner raised challenges to Petitioner's arguments and evidence concerning substantially the same limitation in claim 1 of U.S. Patent No. 8,995,433, in *Facebook, Inc. v. Uniloc 2017 LLC*, IPR2017-01427 ("the 1427 case"). As we cautioned in the Scheduling Order entered in the present cases, any arguments for patentability not raised in the Patent Owner Response are deemed waived. IPR2017-01667, Paper 9, 3; IPR2017-01668, Paper 9, 3. In any event, irrespective of waiver, such challenges would not have altered our conclusions here, even if they had been presented in the present cases, for at least the reasons set forth in our Final Written Decision entered in the 1427 case. *See* IPR2017-01427, slip op. at 58–63 (PTAB Nov. 30, 2018) (Paper 46).

Petitioner relies the combination of Zydney, Shinder, and Appelman for these claims. 1667 Pet. 69–75. In particular, Petitioner relies on Zydney's disclosure of tracking and maintaining the status of all software agents, including the "core states" of whether each potential recipient is online or offline, as well as the recipient does not want to be disturbed, and frequently conveying that information to the software agent by the central server. *Id.* at 69–70 (citing Ex. 1003, 13:12–14, 14:6–9, 14:17–15:1). Petitioner argues, and we agree, that the software agent receives from the server the maintained status of each recipient and provides a mode of communicating with the recipients depending on the status. *Id.* at 70 (citing Ex. 1003, 14:17–22). Petitioner acknowledges that Zydney, however, does not teach displaying an "indicia" for each recipient indicating whether the potential recipient is currently available. *Id.* For this indicia limitation, Petitioner relies on Appelman's disclosure of buddy lists that identify particular users and the status for each user. *Id.* at 70–71 (citing Ex. 1004, 3:44–46, 4:4–7, Fig. 3). Figure 3 of Appelman is reproduced below.

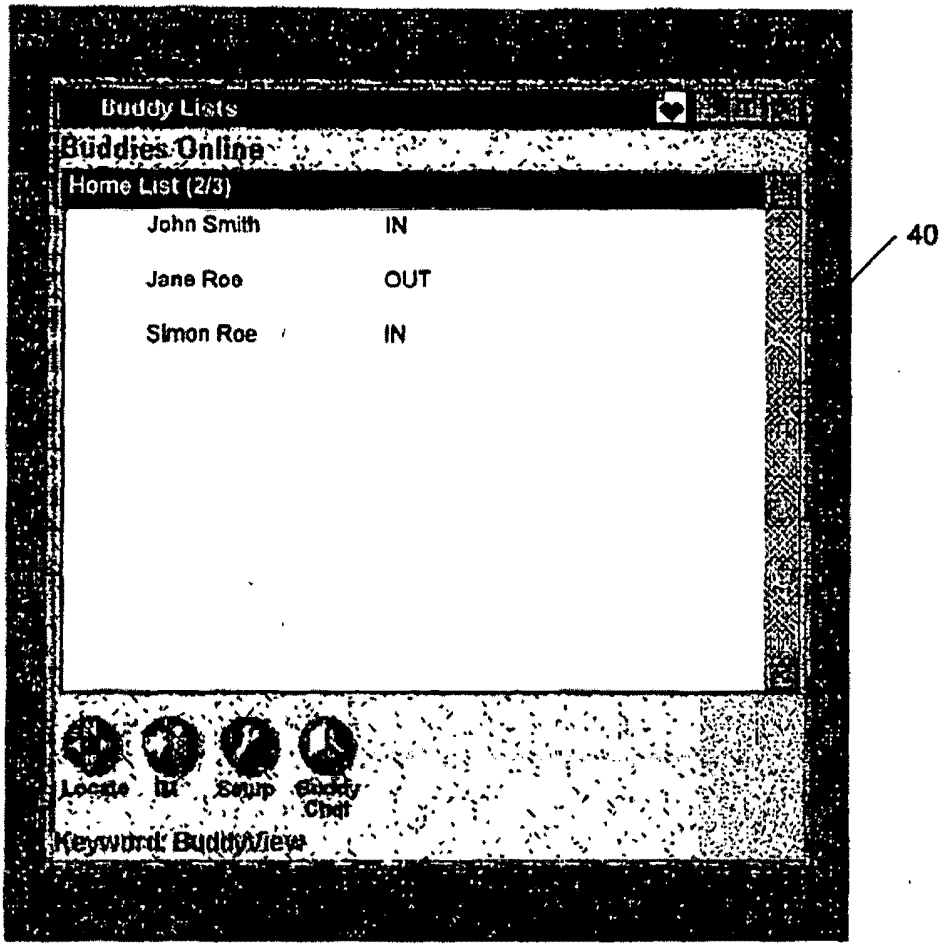

FIG. 3

Figure 3 depicts an implementation of a buddy list window. Ex. 1004, 2:23–24. As shown in Figure 3, the buddy list window displays co-users that the user wishes to track ("buddies") with the particular logon status for that user (i.e. IN or OUT). *See* Ex. 1004, 3:41–47, 4:2–12. We agree with Petitioner that Appelman discloses the claimed indicia, in the form of the displayed status "IN" or "OUT" for each of the potential recipients ("buddies" in the Buddy List). We also agree with Petitioner that it would

have been obvious to combine the teachings of the Appelman indicia as illustrated in the Buddy List window with the teachings of Zydney's software agent functionality of tracking status for the potential recipients and determining modes of communicating with those recipients according to the status. 1667 Pet. 72–75. In particular, we are persuaded that a person of ordinary skill in the art would have appreciated the convenient and straightforward interface of Appelman for use with Zydney's software agent, to quickly view the online/offline status of the users in the Buddy List. *Id.* at 74 (citing Ex. 1004, 4:33–36, Fig. 3; Ex. 1002 ¶ 237). We also credit Dr. Lavian's testimony explaining that the Appelman Buddy List display originated with America Online ("AOL") and that it was well known and ubiquitous in instant messaging systems prior to 2003, such that market considerations would have compelled an ordinarily skilled artisan to consider using a buddy list for instant messaging. Ex. 1002 ¶ 238. As *KSR* explains, "[w]hen a work is available in one field of endeavor, design incentive, and other market forces can prompt variations of it, either in the same field or a different one." 550 U.S. at 417. And "[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its unpatentability." *Id.* In short, this is a situation where the Buddy List window and the display of status of information were well-known at the time of the invention, and given the desirability of the feature for quick access to potential recipients of instant voice messages, a person of ordinary skill in the art would have been motivated to use the Buddy List window concept and apply it to Zydney's already robust instant voice messaging client software and infrastructure. Indeed, Appelman stresses the

importance of this feature by stating that knowledge of users of the system and tracking the relationship is an important aspect of online communication systems. 1667 Pet. 72–73 (citing Ex. 1004, 1:12–16, 1:37–39). We are further persuaded that Zydney, by also disclosing the use of the "buddy list" (*see, e.g.*, Ex. 1003, 30:13–15), explicitly provides evidence of a design incentive to look to Appelman's Buddy List Window with the displayed indicia. *See KSR*, 550 U.S. at 421 ("When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp."); *see also* Ex. 1002 ¶ 236 (opining that both Zydney and Appelman have common goals and seek to address the same problem such that it would have been natural for a person of ordinary skill in the art to apply the Buddy List of Appelman to Zydney to provide the claimed indicia).

Patent Owner argues that claim 39[11] requires an indication that some of the potential recipients of the instant voice messages are unavailable. 1667 PO Resp. 35. Appelman, according to Patent Owner, although displaying offline buddies in the Buddy List window, does not display buddies that can be selected for instant messaging when they are offline. *Id.* at 35–36 (citing Ex. 1004, 6:2–5; Ex. 2001 ¶ 94). There are two problems

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[11] Notably, Patent Owner does not expressly challenge Petitioner's assertions with respect to claim 22, despite that claim's having nearly the identical limitation as claim 39. Regardless, our conclusions here apply equally to claim 22 as to claim 39.

with Patent Owner's arguments. First, even if we accept Patent Owner's reading of Appelman, all of Patent Owner's arguments are premised on its interpretation of claim 39 as requiring the indication of the possibility that some of the intended recipients would be unavailable. Claim 39, however, recites that the indicia indicates "whether the potential recipient is *currently available* to receive an instant voice message." From the plain reading of that claim, a showing that the Buddy List displays recipients available to receive an instant voice message meets the claim limitation. *See* 1667 Reply 24. Second, Patent Owner's arguments do not respond to the challenge of unpatentability. Petitioner has relied on Appelman's Buddy List window embodiment solely for the indicia that is displayed indicating the status of each potential recipient. *Id.* at 25 (citing 1667 Pet. 70–72). The inclusion of the status displayed as "IN" or "OUT" does not change the reliance by Petitioner on Zydney's functionality to track the status of users and to permit a number of distinct modes of communication based on the status of the recipient. 1667 Pet. 69–70. This would include selecting an offline potential recipient (indicated in Appelman with the status "OUT"). Accordingly, Patent Owner's arguments are not persuasive to overcome Petitioner's evidence and arguments.

Patent Owner's further arguments of a failed rationale to combine and that the proposed combination would render Zydney unsatisfactory for an intended purpose are similarly unpersuasive. 1667 PO Resp. 36–41. Those arguments are based on the premise that Appelman would be unable to send a message to an offline recipient, which, again, does not address that Petitioner's combination of teachings relies on Appelman solely for the

indicia, not for the modes of communication and transmission with the selected potential recipients.

Based on the foregoing, we are persuaded that Petitioner has demonstrated by a preponderance of the evidence that claims 22 and 39 are unpatentable as obvious over the combination of Zydney, Shinder, and Appelman.

4. Analysis of Claims 4, 5, 12, and 24–26

a. Discussion of Dependent Claims 4 and 5

Claim 4 depends from claim 3 and further recites "wherein the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user." Ex. 1001, 24:28–30. Claim 5 depends from claim 4. *Id.* at 24:31–35. Petitioner relies on IIethmon, in combination with Zydney and Shinder, as teaching the additional limitation of claim 4. 1668 Pet. 37–45. Petitioner concedes that Zydney "does not appear to explicitly describe" that the instant voice message contains such a "field," but contends that this feature "would have been obvious over Zydney in view of Hethmon." *Id.* at 37 (emphasis omitted). More specifically, Petitioner contends that the HTTP/1.1 Request-Line, as described by Hethmon, discloses "an action field identifying one of a predetermined set of permitted actions requested by the user." *Id.* at 39 (emphasis omitted) (citing Ex. 1102 ¶ 308). According to Petitioner:

> Hethmon illustrates how the Method in the Request-Line identifies a permitted action requested by the user. For example, "[t]he POST method is used as a way for a client application to submit data to a resource on a server application." ([Ex. 1109,

> 75].) The data to be transmitted is contained in the "Entity-Body" field in the request message. (*Id.* [at 51].) Specifically, "[u]sing the POST method, the client sends an entity body to the server for processing." (*Id.* [at 75].) "This allows for data submission via HTTP to accomplish various goals, such as database updating or order entry." (*Id.* [at 55].) The POST method may be used to transmit data of various types. (*See id.* [at 75]; [Ex. 1102] ¶309.)

1668 Pet. 39. Thus, according to Petitioner, an HTTP message with a POST method provides an example of an action field, as recited in claim 4, and "[i]n fact, the '622 patent expressly refers to a 'post message' as one of the permitted actions that can be in the 'action field.'" *Id.* at 40 (emphasis omitted) (citing Ex. 1101, 14:6–10).

Patent Owner responds that "explicit teachings in Zydney . . . would lead a person of ordinary skill in the art away from the proposed combination." 1668 PO Resp. 18 (emphasis omitted). Pointing in particular to Zydney's definition of "voice container" as, in part, "a container object that contains no methods," Patent Owner argues that, "[c]ontrary to the definitive statement that *Zydney's* container—by intended design—*contains no methods*, Petitioner's proposed modification would further require containment of 'a "Method" that identifies an action to be taken on a resource,' as allegedly disclosed in *Hethmon*." *Id.* at 19 (citing Ex. 2001 ¶ 53). Patent Owner further contends that Petitioner fails to explain "how *Zydney's* voice container (specifically designed *to contain no methods*) would still be satisfactory for its intended purpose if it was modified as proposed." *Id.* Finally, Patent Owner contends that "[t]his explicit teach away cannot be avoided by focusing on the disclosure in *Hethmon* of a

keyword that merely *identifies* a method," because "*Zydney* expressly distinguishes its *voice container* from its the content (e.g., *voice message*) contained therein," and "[t]he structural components of the voice container described in *Zydney* with reference to Figure 3 identify and define *the content* of the voice container." *Id.* at 19–20. According to Patent Owner, "[g]iven that the voice container is explicitly defined as containing *no method*s, there would be no motivation to modify *Zydney* to include a keyword that identifies and defines an *irrelevant and nonexistent* method that is not—and indeed by definition cannot be—included as content within *Zydney's* voice container." *Id.* at 20.

In its Reply, Petitioner argues that "Patent Owner's 'teach away' argument is meritless for multiple reasons." 1668 Reply 11. First, according to Petitioner, "Patent Owner's argument misstates the proposed obviousness combination," as "[t]he combination would not result in the voice container itself containing any methods." *Id.* Rather, Petitioner contends, "the Petition explains that it would have been obvious to transport the voice containers in Zydney as the 'payload' contained in HTTP 1.1 messages as taught by Hethmon." *Id.* (citing Pet. 40–42). "Using HTTP 1.1, the voice container would be contained as the 'entity body' in an HTTP POST message, for example." *Id.* (citing Pet. 39–40; Ex. 1109, 54, 78). Because "[t]he Request-Line in the HTTP message is distinct from the Entity-Body 'payload' of the message," Petitioner further contends, "the Zydney voice container, transported as the payload of an HTTP message disclosing the claimed 'instant voice message,' would not contain any methods." *Id.* Furthermore, Petitioner argues, "even if the combination

would result in the voice container itself containing the Request-Line (which it would not), that would not amount to any 'teach away' as Patent Owner contends, as there is no 'clear discouragement of that combination.'" *Id.* at 11–12.

After full consideration of the parties' arguments and cited evidence, we conclude that Petitioner has not carried its burden to show by a preponderance of the evidence that claim 4 is unpatentable over the combination of Zydney, Shinder, and Hethmon.

As an initial matter, we recognize that we determined in our Institution Decision in IPR2017-01668 that Petitioner had established a reasonable likelihood of succeeding in its challenge to claim 4 at the institution stage, notwithstanding Patent Owner's arguments in its Preliminary Response, now repeated in Patent Owner's Response, that Zydney would teach away from the proposed combination. *See* 1668 Dec. on Inst. 24–25; *also compare* 1668 Prelim. Resp. 17–18, *with* 1668 PO Resp. 18–19. In particular, we explained that we understood the "Method" field of the HTTP/1.1 Request-Line described by Hethmon "merely to be a keyword *identifying* a method, rather than as actually being a method," on the record then before us that, and that we did not understand that to be "the sort of 'method' that Zydney's container object is intended to exclude." 1668 Dec. on Inst. 24. On that basis, we stated that we were not persuaded that Zydney teaches away from the proposed combination of Hethmon with Zydney and Shinder and noted that the parties would have the opportunity to brief this issue more fully during trial." *Id.* at 24–25.

We are not bound, however, by the determination in the Institution Decision. *See TriVascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016) ("[T]he Board is not bound by any findings made in its Institution Decision. At that point, the Board is considering the matter preliminarily without the benefit of a full record. The Board is free to change its view of the merits after further development of the record, and *should do so* if convinced its initial inclinations were wrong."). With the greater clarity provided by the full record now before us, the parties' post-institution arguments bring to light a different shortcoming in Petitioner's contentions. 1668 PO Resp. 19–20; 1668 Reply 11–12. Specifically, claim 4 recites "wherein the instant voice message includes an action field . . . ." That is significant because Petitioner clarifies in its Reply that it is not relying on the combination of Zydney, Shinder, and Hethmon to result in the voice container *itself containing the Request-Line*, but rather that Zydney's voice container in the proposed combination would be "transport[ed] . . . as the 'payload' contained in HTTP 1.1 messages"—i.e., "as the 'entity body' in an HTTP POST message"—and thus "distinct from" the "Request-Line in the HTTP message." 1668 Reply 11. Petitioner, however, consistently relies on Zydney's voice container as being the recited "instant voice message" of claim 3, from which claim 4 depends. *See, e.g.*, 1668 Pet. 33 (reciting "a 'voice container' (instant voice message)"). Thus, even if we were to agree with Petitioner that the HTTP/1.1 Request-Line, as described by Hethmon, "discloses an action field identifying one of a predetermined set of permitted actions requested by the user" (*id.* at 39), the combination of Hethmon with Zydney and Shinder would result in "instant voice message" being "distinct

from" such "action field" (*see* 1668 Reply 11) rather than "includ[ing]" the action field as claim 4 explicitly recites. Petitioner does not explain how an instant voice message distinct from an action field would have rendered obvious an instant voice message including an action field.

For the foregoing reasons, we conclude that Petitioner has not shown by a preponderance of the evidence that either claim 4 or claim 5, dependent therefrom, is unpatentable over the combination of Zydney, Shinder, and Hethmon.

b. Discussion of Independent Claims 24

In a similar manner as for claim 3, Petitioner relies on Shinder as teaching the "network interface" and "packet-switched network" recited in claim 24 and on Zydney for the messaging system and communication platform system limitations of claim 24. 1668 Pet. 46. With respect to the further limitations of claim 24, "wherein the messaging system receives connection object messages from the plurality of instant voice message client systems" and "wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems," Petitioner relies again on Hethmon's description of the HTTP POST method, discussed previously with respect to claim 4, in the "Method" field of the HTTP/1.1 Request-Line. *Id.* at 47–50. Relying on Dr. Lavian's testimony, Petitioner contends that "[a] person of ordinary skill in the art would have understood and found it obvious to use a POST method . . . as the vehicle to provide the client's status information to the central server." *Id.* at 48 (emphasis

omitted) (citing Ex. 1102 ¶ 328; Ex. 1109, 75 ("The POST method is used as a way for a client application to submit data to a resource on a server application.")). Further, "[t]he POST message under the combination of Zydney and Hethmon also contains data representing the state of the connection, i.e., data indicating the client's status as disclosed in Zydney." *Id.* (emphasis omitted) (citing Ex. 1102 ¶ 331; Ex. 1003, 14:2–4).[12] Petitioner also presents an alternative mapping based of "logical connection" to Hethmon, based on Hethmon's description of HTTP/1.1's "persistent connections" feature, in which a connection is established between a client and server that remains open until a "close" value is provided in a request header. *Id.* at 50–51 (citing Ex. 1109, 15, 86, 148).

In response to Petitioner's contentions regarding claim 24, Patent Owner raises a similar argument as with respect to claim 4, namely, that Zydney teaches away from combination with Hethmon because Zydney's voice container is stated to contain "no methods," whereas the proposed combination with Hethmon would require containment of one or more methods. 1668 PO Resp. 20–21. Patent Owner further contends that Zydney teaches away from using HTTP and that Zydney's transport mechanism would not have worked with HTTP. *Id.* at 21–23.

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[12] Citations to Zydney and Shinder in the parties' briefs in IPR2017-01668 refer to Exhibits 1103 and 1114. However, for consistency throughout this Decision, and in light of the consolidated record, we cite to Zydney and Shinder as filed in IPR2018-01667 as Exhibits 1003 and 1014.

In its Reply, Petitioner responds that Patent Owner's argument that Zydney teaches away from the use of HTTP misstates the references and their teachings. 1668 Reply 14. Petitioner contends, "claim 24 does not recite that the instant voice message itself contains connection object messages, and the Petition does not rely upon the transmission of a voice container in Zydney as disclosing the transmission of the connection object message." *Id.* at 16. Rather, Petitioner explains, its mapping of the cited references to the claim "relies upon the connection status messages communicated by client devices in Zydney, which are distinct from the voice messages recorded and transmitted by users." *Id.* Petitioner further contends, "Patent Owner misstates Zydney's teachings when it asserts that Zydney discloses that its 'container object' must be 'used in transporting all messages' and 'is specifically designed to contain no methods.'" *Id.* (citing 1668 PO Resp. 21). To the contrary, according to Petitioner, "Zydney does not state or suggest that all messages must be transported using a container object that contains no methods," and "[i]n fact, Zydney does not use the term 'container object' outside of the single sentence defining a 'voice container.'" *Id.* at 16–17. Further,

> Zydney also does not disclose that the connection status messages must be transmitted using voice containers (which would make no sense, because the voice containers contain users' voice recordings that would not be part of the status message). Rather, as noted above, Zydney merely states, as a matter of neutral definition, that the "[t]he term 'voice containers' as used throughout this application refers to a container object that contains no methods." ([Ex. 1003], 12:6–8.) Nothing about this definition of "voice container" has any

> bearing on the connection object messages disclosed and rendered obvious by Zydney in view of Hethmon.

Id. at 17.

Finally, Petitioner contends Patent Owner's arguments that Zydney would not have used HTTP as disclosed by Hethmon (1668 PO Resp. 21–23) are baseless. 1668 Reply 17–18. First, according to Petitioner, "Dr. Lavian testified, unrebutted, that '[b]ecause HTTP is built on top of TCP/IP, it would have been straightforward to use HTTP to facilitate voice container delivery from clients to the central server.'" *Id.* at 17 (quoting Ex. 1102 ¶ 319). Second, according to Petitioner, Patent Owner's argument that Zydney was not consistent with HTTP "appears to be based on incorrectly reading Zydney to require data compression when transmitting voice containers," whereas Patent Owner has not identified any such disclosure in Zydney. *Id.* at 18. As set forth in the discussion of claim 3 above, Petitioner contends that even if Zydney *did* require compression, HTTP support for compression was described in Hethmon. *Id.* at 18–19 (citing Ex. 1109, 39). And as also set forth in the discussion of claim 3, Petitioner contends it is "irrelevant whether HTTP itself had built-in compression protocols" because "Hethmon makes clear that HTTP can be used to transfer various types of data, including data that has been compressed separately from the HTTP protocol itself, such as transmitting files in the well-known 'zip' and 'gif' compression formats." *Id.* at 19–20 (citing Ex. 1109, 44).

After full consideration of the parties' arguments and cited evidence, we are persuaded, for the reasons stated by Petitioner and discussed above, that Petitioner has established by a preponderance of the evidence that the

subject matter of claim 24 would have been obvious to a person of ordinary skill in the art over the combination of Zydney, Shinder, and Hethmon. Although Patent Owner accurately cites Zydney as describing its "voice container" as referring to a container object that contains no methods (1668 PO Resp. 19–20), we agree with Petitioner that claim 24 does not require that the recited "connection objects" be included within the recited instant voice message itself (1668 Reply 16; *see* Ex. 1001, 25:59–26:8). Accordingly, even if the HTTP/1.1 Request-Line Method field is properly understood to include a "method" within the meaning of that term as used in Zydney's definition of a voice container, we disagree with Patent Owner's argument that Zydney teaches away from a combination in which the HTTP POST method described by Hethmon would be used as a vehicle to provide client status information to Zydney's central server, as Petitioner proposes. 1668 Pet. 48. We also credit Dr. Lavian's testimony, relied upon by Petitioner and not persuasively rebutted by Patent Owner, that, in the proposed combination, "when the client in Zydney transmits an HTTP POST message to the central server to report the client's status (*e.g.*, 'ONLINE')," the POST message would contain "data representing the state of the connection, i.e., data indicating the client's status," as well as code "for establishing and maintaining the logical connections between an instant voice messaging server and instant voice messaging clients." Ex. 1102 ¶ 331 (emphasis omitted). We further credit Dr. Lavian's testimony, again not persuasively rebutted by Patent Owner, that "a person of ordinary skill in the art would have perceived no significant technical obstacle in implementing the combination of Zydney and Hethmon," as "Zydney

discloses using standard [Transmission Control Protocol/Internet Protocol ("TCP/IP")] techniques to transport a voice container to the server," and, "[b]ecause HTTP is built on top of TCP/IP," —which, we observe, Patent Owner recognizes Zydney describes as "[t]he transport mechanism for all communications" (see 1668 PO Resp. 22 (quoting Ex. 1003, 29:1–3))—"it would have been straightforward to use HTTP to facilitate voice container delivery from clients to the central server." Ex. 1102 ¶ 319.

c. Discussion of Dependent Claims 25 and 26

Claim 25 depends from claim 24 and further recites "wherein the connection object messages identifies [sic] at least one of a socket, a size of data to be transferred and a priority of the data." Ex. 1001, 26:9–11. Petitioner contends that the HTTP/1.1 POST message, discussed above in connection with claim 24, identifies a size of data to be transferred, specifically citing Hethmon's disclosure that HTTP messages include a Content-Length field "used to specify the byte length of the entity body being sent." 1668 Pet. 54 (quoting Ex. 1109, 86). In one example, Petitioner contends, "Hethmon discloses an exemplary POST having a 'Content-Length: 23' field, specifying that 23 bytes are being transmitted." *Id.* (citing Ex. 1109, 78; Ex. 1102 ¶¶ 337, 346). We agree and also note that Patent Owner does not argue dependent claim 25 separately from claim 24. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney, Shinder, and Hethmon renders obvious claim 25.

Claim 26 depends from claim 24 and further recites "wherein the communication platform system populates a connection list for the plurality of instant voice message client systems with the data in the connection object messages received from each of the plurality of instant voice message client systems." Ex. 1001, 26:12–16. Petitioner points for this limitation to Zydney's disclosure that the central server tracks and maintains connection status information for all client systems, and particularly, that the central server "will maintain the current list of agents" identifying correspondents for each software agent. 1668 Pet. 54 (quoting Ex. 1003, 26:10–14). Petitioner further contends Zydney's system "also tracks 'who else is on line in the users "buddy list"'" "[b]ased on tracking the connectivity status of all software agents." *Id.* at 55 (quoting Ex. 1003, 30:14–15). Relying on Dr. Lavian's testimony, Petitioner contends that although "Zydney does not appear to explicitly describe that the status information provided by the client systems to the central server . . . is used to populate a 'connection list' in the communication platform system as recited in claim 26," it would have been obvious in view of Zydney and the knowledge of a person of ordinary skill in the art that the communication platform system in the central server tracks and maintains the status information in the form of a "list," including to maintain the agents' connection status information in "list" form. *Id.* (citing Ex. 1102 ¶¶ 350–351). We agree, and credit Dr. Lavian's cited testimony that a "connection list" would have been one of a finite number of well-known and predictable techniques for organizing status information and that "the choice of a 'list' would have been particularly obvious here considering that, as noted, Zydney discloses that its server already maintains

the identity of software agents in 'lists.'" Ex. 1102 ¶ 351. We also note that Patent Owner does not argue dependent claim 26 separately from claim 24. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney, Shinder, and Hethmon renders obvious claim 26.

d. Discussion of Dependent Claim 12

Claim 12 depends from claim 3 and further recites "wherein the communication platform system updates the connection information for each of the instant voice message client systems by periodically transmitting a connection status request to the given one of the plurality of instant voice message client systems." Ex. 1001, 25:4–8. Petitioner concedes that "Zydney does not appear to explicitly describe the underlying details of how the central server tracks and maintains the status of all software agents," but, relying on the testimony of Dr. Lavian, Petitioner contends that a person of ordinary skill in the art would have been familiar with several well-known ways of updating the connectivity status. Pet. 57–58 (citing Ex. 1102 ¶ 353). Petitioner asserts that "[o]ne such well-known technique was polling, where one system periodically polls other systems (e.g., periodically requests that status from the other systems) to determine and update the status of each system." *Id.* at 58 (emphasis omitted) (citing Ex. 1102 ¶ 353). Petitioner cites Microsoft as defining "polling" as, in part, "[t]he process of periodically determining the status of each device in a set so that the active program can process events generated through each device." *Id.* at 58 (citing Ex. 1118, 5–6). Petitioner additionally cites Microsoft's definition of

"polling cycle" as "[t]he time and sequence required for a program to poll each of its devices or network nodes," as evincing that polling can be performed on "network nodes." *Id.* at 59 (citing Ex. 1118, 7). Petitioner further cites Moghe, as "explain[ing] that polling provides a technique for requesting the status of other devices or resources on a network. *Id.* at 59–60 (emphasis omitted) (citing Ex. 1119, 1:14–22). Lastly, Petitioner contends that it would have been obvious to adapt well-known polling techniques, as described in Microsoft and Moghe, to the system of Zydney, asserting that the combination "would have predictably resulted in the instant voice messaging system of Zydney in which the system of the central server . . . periodically transmits a connection status request to the software agent on each client inquiring about its current status, in order to update the system's connection information." *Id.* at 60 (citing Ex. 1102 ¶ 356). Patent Owner does not argue claim 12 separately from claim 3. Based on Petitioner's arguments and cited evidence, we are persuaded that Petitioner has shown by a preponderance of the evidence that the combination of Zydney, Shinder, Microsoft, and Moghe renders obvious claim 12.

C. Summary

Upon due consideration of the trial record, we conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 3, 6–8, 10–23–35, 38, and 39 of the '622 patent are unpatentable on the grounds presented but has not demonstrated by a preponderance of the evidence that claims 4 and 5 are unpatentable on any of the asserted grounds.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 3, 6–8, 10–35, 38, and 39 of the '622 patent are held unpatentable;

FURTHER ORDERED that claims 4 and 5 of the '622 patent have not been shown to be unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:18-cv-00290	7/13/2018	Eastern District of Texas

PLAINTIFF	DEFENDANT
Uniloc USA, Inc.; Uniloc Luxembourg S.A. and Uniloc 2017, LLC	Amazon.com, Inc.; Amazon Web Services, Inc.; Amazon Digital Services, LLC.; Amazon Digital Services, Inc.; and Amazon Fulfillment Services, Inc.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2			
3			
4			
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

Trials@uspto.gov
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Paper 13
Entered: August 21, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,[1]
Patent Owner.

Case IPR2018-00580
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review and
Grant of Motion for Joinder
35 U.S.C. § 314(a); 37 C.F.R. § 42.122(b)

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[1] Uniloc Luxembourg S.A., formerly identified as Patent Owner, filed an Updated Mandatory Notice pursuant to 37 C.F.R. § 42.8(a)(2) on August 9, 2018, stating that Uniloc 2017 LLC is now the Patent Owner. Paper 12. The caption has been updated accordingly.

I. INTRODUCTION

Apple Inc. ("Apple" or "Petitioner") filed a Petition requesting *inter partes* review of claims 4, 5, 12, and 24–26 of U.S. Patent No. 8,724,622 B2 (Ex. 1101, "the '622 patent"). Paper 3 ("Pet."). Petitioner also filed a Motion for Joinder, seeking joinder as a petitioner in *Facebook, Inc. v. Uniloc Luxembourg S.A.*, Case No. IPR2017-01668 ("the 1668 IPR"). Paper 2 ("Mot."). Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response (Paper 11, "Prelim. Resp."), as well as an Objection to Petitioner's Motion for Joinder (Paper 8, "Obj.").

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 4, 5, 12, and 24–26 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. Apple Inc.*, No. 2:16-cv-00638-JRG (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern District of Texas. Pet. 3–4; Paper 6, 3.

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, Inc. and WhatsApp Inc.), 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; Cases IPR2017-02080 and IPR2017-02081 (filed by Google, Inc.), which we denied; and Case IPR2017-02090 (filed by LG Electronics, Inc. and Huawei Device Co., Ltd.), in which we instituted *inter partes* review on March 6, 2018, and granted a motion to join LG and Huawei as petitioners in IPR2017-01667. In addition, concurrently with the filing of the instant Petition, Petitioner filed a petition requesting *inter partes* review of claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 of the '622 patent (Case IPR2018-00579) along with a motion for joinder with IPR2017-01667.

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. 1101, [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. 1101, 6:22–24.

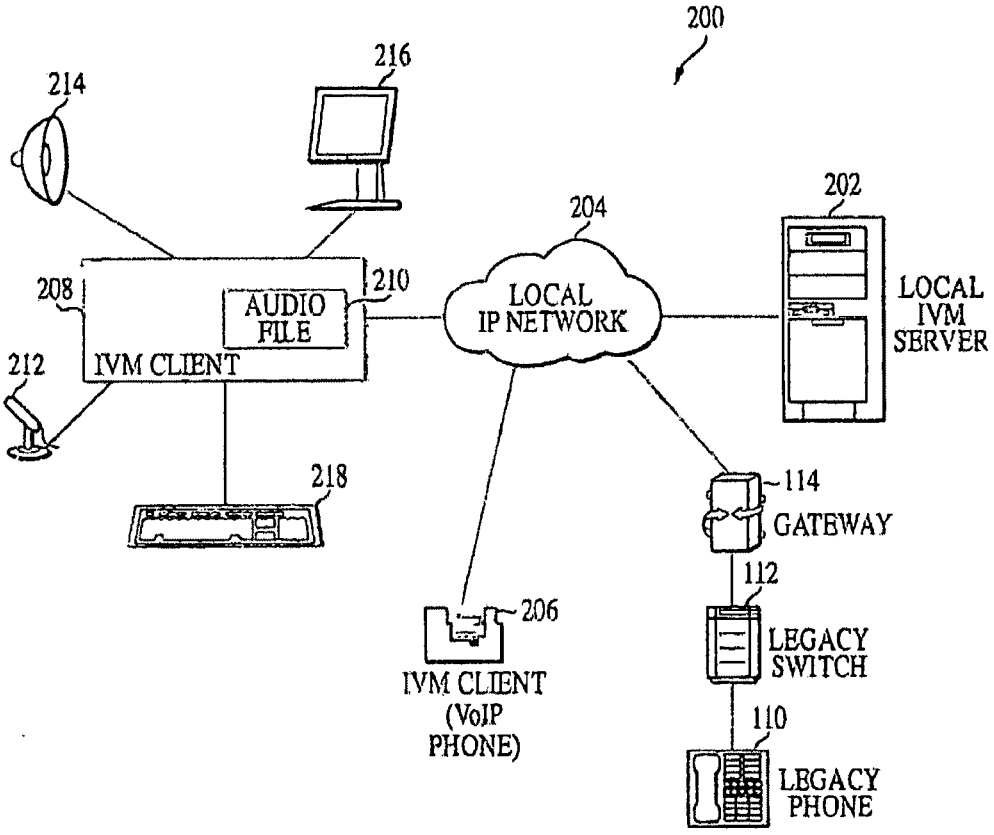

FIG. 2

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. 1101, 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. 1101, 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.

C. Illustrative Claims

Of the challenged claims, only claim 24 is independent. Challenged claims 25 and 26 depend directly from claim 24, and the remaining challenged claims depend directly or indirectly from independent claim 3, which is not challenged in the instant proceeding. Unchallenged claim 3 and challenged claims 4 and 24 are illustrative and are reproduced below.

3. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current

connection to each of the plurality of instant voice message client systems,

wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and

wherein the instant voice message includes an object field including a digitized audio file.

4. The system according to claim 3, wherein the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user.

24. A system comprising:

a network interface connected to a packet-switched network;

a messaging system communicating with a plurality of instant voice message client systems via the network interface; and

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

wherein the messaging system receives connection object messages from the plurality of instant voice message client systems, wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems.

Ex. 1101, 24:12–30, 25:59–26:8.

III. INSTITUTION OF *INTER PARTES* REVIEW

On January 19, 2018, we instituted *inter partes* review in the 1668 IPR based on the following prior art and grounds of unpatentability (IPR2017-01668 IPR, slip op. at 29 (PTAB Jan. 19, 2018) (Paper 8)):

Challenged Claim(s)	Basis	References
4, 5, 24–26	§ 103(a)	Zydney,[2] Shinder,[3] and Hethmon[4]
12	§ 103(a)	Zydney, Shinder, Microsoft,[5] and Moghe[6]

The Petition in this proceeding asserts the same grounds as those on which we instituted an *inter partes* review in the 1668 IPR. Pet. 66; *see also* Mot. 1. Petitioner asserts that the Petition relies on the same arguments and evidentiary record as in the 1668 IPR, including a Declaration of Tal Lavian, Ph.D., filed as Exhibit 1102 ("Lavian Declaration"), previously filed in the 1668 IPR. Pet. 66; Mot. 1, 4.

Patent Owner's instant Preliminary Response differs substantively from its preliminary response filed in the 1668 IPR in several regards: First, as in its Objection to Petitioner's Motion for Joinder, Patent Owner points out that the Board previously denied institution of another petition that also challenged claims of the '622 patent based on the Zydney reference at issue here. Prelim. Resp. 1 (citing IPR2017-02080). Second, Patent Owner adds several new arguments as to why it alleges Zydney does not disclose or

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[2] Zydney et al., WO 01/11824 A2, published Feb. 15, 2001 (filed with line numbers added by Petitioner as Exhibit 1103).

[3] Excerpts from Debra Littlejohn Shinder, *Computer Networking Essentials* (2002) (Ex. 1114).

[4] Excerpts from Paul S. Hethmon, *Illustrated Guide to HTTP* (1997) (Ex. 1109).

[5] Excerpts from Microsoft Press Computer Dictionary (1991) (Ex. 1118).

[6] Moghe, US 6,173,323 B1, issued Jan. 9, 2001 (Ex. 1119).

suggest "wherein the instant voice message includes an object field including a digitized audio file," as recited in independent claim 3 and Hethmon teaches away from "the instant voice message includ[ing] an action field identifying one of a predetermined set of permitted actions requested by the user," as recited in challenged claims 4 and 5. Prelim. Resp. 9–16, 19–20.

We have considered Patent Owner's newly presented arguments, but conclude that they do not compel denial of the Petition under the circumstances presented here, where the instant Petition is essentially identical to that in the 1668 IPR already instituted, and Petitioner seeks joinder as a party to that proceeding. In view of the identicalness of the issues in the instant Petition and the petition in the 1668 IPR and the already-considered arguments from Patent Owner made in the 1668 IPR, we determine that this proceeding warrants institution on the grounds presented in the Petition for the same reasons stated in our Decision on Institution in the 1668 IPR.

IV. GRANT OF MOTION FOR JOINDER

Joinder in *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

> (c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter parties review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder

should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See* Frequently Asked Question H5, https://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0.

We find Petitioner timely filed its motion for joinder concurrently with the Petition and not later than one month after institution of the 1668 IPR, in accordance with 35 U.S.C. § 315(c). We also find that Petitioner has met its burden of showing that joinder is appropriate. For the challenged claims, the Petition here is substantively identical to the petition in the 1668 IPR. The substantive evidence also is identical, including reliance on essentially the same Lavian Declaration.[7]

Petitioner further has shown that the trial schedule will not be affected by joinder. Mot. 5. No changes in the schedule are anticipated or necessary, and the limited participation, if at all, of Petitioner will not impact the timeline of the ongoing trial.

In its Objection to Petitioner's Motion for Joinder, Patent Owner contends that the discretionary institution factors set forth in the Board's decision in *Blue Coat Systems LLC v. Finjan, Inc.*, IPR2016-01443 (PTAB

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[7] Petitioner provided, as Exhibit 1121, a "redlined" version of the Lavian Declaration, showing differences between the version filed as Exhibit 1102 and the version filed in the 1668 IPR. Pet. vii. Apart from edits to the case caption and page headers, changing the names of the parties where applicable, and replacing "Petitioners" in several instances with "Petitioner," there do not appear to be any differences. *See, e.g.*, Ex. 1121, 1, 15, 108.

Jan. 23, 2017) (Paper 13) and later precedential decision in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19) "weigh heavily against institution and, therefore, joinder." Obj. 1, 6–11. Patent Owner points out that Petitioner has now filed six petitions against claims of the '622 patent, including, *inter alia*, a petition in IPR2017-01805 that relied on the same references as the instant Petition. *Id.* at 1, 5. Patent Owner contends that the Board already agreed in IPR2017-01804 that the *Blue Coat Systems/General Plastic* factors weigh against institution, and further contends that "Petitioner should not be able to use joinder as an end run around principles designed to prevent abuse of IPR proceedings." *Id.* at 6.

We have considered Patent Owner's arguments but disagree that the *Blue Coat Systems/General Plastic* factors compel denial under the present circumstances. Whereas Patent Owner correctly points out that we exercised discretion to deny Petitioner's petition in IPR2017-01804 based, in part, on those factors, and we similarly denied the petition in IPR2017-01805, essentially identical to the instant Petition, the petition in IPR2017-01805 was, critically, not accompanied by a motion for joinder. Here, in contrast, the Petition is accompanied by a timely filed Motion for Joinder in which Petitioner affirmatively agrees to assume a "passive understudy role" and to adhere to the existing schedule in the 1668 IPR (*see* Mot. 6–7), effectively neutralizing the *General Plastic* factors. For example, joinder of Petitioner to the 1668 IPR will not put a significant additional burden on the Board or jeopardize the Board's ability to issue a final written decision in the 1668 IPR, and this is not a case in which a petitioner has used prior preliminary responses or decisions of the Board to tailor its substantive

arguments. We also decline, under the particular circumstances presented, to hold against Petitioner the time elapsed between the filing of its petition in IPR2017-01805 and the filing of the essentially identical instant Petition, where we denied that earlier petition expressly "without prejudice to Petitioner's ability to file a new petition accompanied by a request for joinder pursuant to and within the time period permitted by 37 C.F.R. § 42.122(b)" (IPR2017-01805, slip op. 6–7 (Jan. 19, 2018) (Paper 9)), as Petitioner has done here. As we explained in our decision granting Huawei and LG's petition and motion for joinder to co-pending IPR2017-01667 in IPR2017-02090, "joined cases avoid the multiplicity that Patent Owner criticizes." IPR2017-02090, slip op. at 9 (PTAB Mar. 6, 2018) (Paper 9).

Going forward, Petitioner shall adhere to the existing schedule of the 1668 IPR and the "passive understudy role" it has agreed to assume. Mot. 6–7. More specifically, so long as any current petitioner in the 1668 IPR (i.e., Facebook and WhatsApp) is a party to the 1668 IPR, all filings of Petitioner in the 1668 IPR shall be consolidated with the filings of the current 1668 IPR petitioners. The page limits set forth in 37 C.F.R. § 42.24 will apply to all consolidated filings.

Petitioner shall be bound by any discovery agreements between Patent Owner and the current petitioners in the 1668 IPR and shall not seek any additional discovery. Patent Owner shall not be required to provide any additional discovery or deposition time as a result of joinder. In addition, all petitioners in the 1668 IPR shall collectively designate attorneys to present at the oral hearing, currently scheduled for August 30, 2018 (*see* IPR2017-01668, Paper 28), in a consolidated argument.

The Board expects Petitioner to attempt to resolve any disputes among the entities involved and to contact the Board only if such matters cannot be resolved. This arrangement promotes the just and efficient administration of the ongoing trial and the interests of Petitioner and Patent Owner.

V. ORDER

In view of the foregoing, it is

ORDERED that an *inter partes* review is instituted as to claims 4, 5, 12, and 24–26 of the '622 patent on the following grounds:

(1) Claims 4, 5, and 24–26 under 35 U.S.C. § 103(a) as unpatentable over Zydney, Shinder, and Hethmon, and

(2) Claim 12 under 35 U.S.C. § 103(a) as unpatentable over Zydney, Shinder, Microsoft, and Moghe;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2017-01668 is *granted*, and Apple is hereby joined as a petitioner in IPR2017-01668;

FURTHER ORDERED that IPR2018-00580 is terminated under 37 C.F.R. § 42.72 and all future filings are to be made only in IPR2017-01668;

FURTHER ORDERED that the grounds on which *inter partes* review was instituted in Case IPR2017-01668 remain unchanged, and no other grounds are instituted in the joined proceedings;

FURTHER ORDERED that Petitioner here (i.e., Apple) will be bound in IPR2017-01668 by all substantive and procedural filings and representations of current Petitioner in IPR2017-01668 (i.e., Facebook and WhatsApp), without a separate opportunity to be heard, whether orally or in

writing, unless and until the proceeding is terminated with respect to each of Facebook and WhatsApp;

FURTHER ORDERED that Petitioner here is bound by any discovery agreements between Patent Owner and the current Petitioner in IPR2017-01668, and that Petitioner here shall not seek any additional discovery;

FURTHER ORDERED that the Scheduling Order entered in IPR2017-01668 shall remain in effect and govern the proceeding, subject to any schedule changes authorized by the Board in IPR2017-01668 pursuant to the Scheduling Order;

FURTHER ORDERED that the Petitioner entities in IPR2017-01668 shall collectively designate attorneys to present at the oral hearing in a consolidated argument;

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2017-01668; and

FURTHER ORDERED that the case caption in IPR2017-01668, from now on, shall reflect joinder of Apple as a party, in accordance with the attached example.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01668[8]
Patent 8,724,622 B2

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[8] Apple Inc., which filed a petition in Case IPR2018-00580, has been joined as a petitioner in this proceeding.

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-989	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	HTC AMERICA, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-990	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	KYOCERA AMERICA, INC. and § KYOCERA COMMUNICATIONS, INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
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DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

Trials@uspto.gov
Tel: 571-272-7822

Paper 10
Entered: March 29, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-02081
Patent 8,724,622 B2

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, 42.122; 35 U.S.C. §§ 315(d), 325(d)

I. INTRODUCTION

Google, Inc., now known as Google LLC[1] ("Petitioner"), filed a Petition requesting *inter partes* review of claims 1, 2, and 24–39 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 8 ("Prelim. Resp."). With authorization from the Board, Petitioner additionally filed a Reply to Patent Owner's Preliminary Response, 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 Petitioner's Reply, and for reasons discussed below, we deny the Petition and do not institute *inter partes* review of claims 1, 2, and 24–39 of the '622 patent.

II. BACKGROUND

A. Related Matters

Concurrently with the instant Petition, Petitioner additionally filed a petition requesting *inter partes* review of claims 3–23 of the '622 patent (Case IPR2017-02080). IPR2017-02080, 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 Co., Ltd., Huawei Technologies Co., Ltd., and Huawei Device (Dongguan) Co., Ltd. as additional real parties in interest. *See* Pet. 1; IPR2017-02080,

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[1] *See* Paper 5.

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. 1–2; Paper 3, 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.

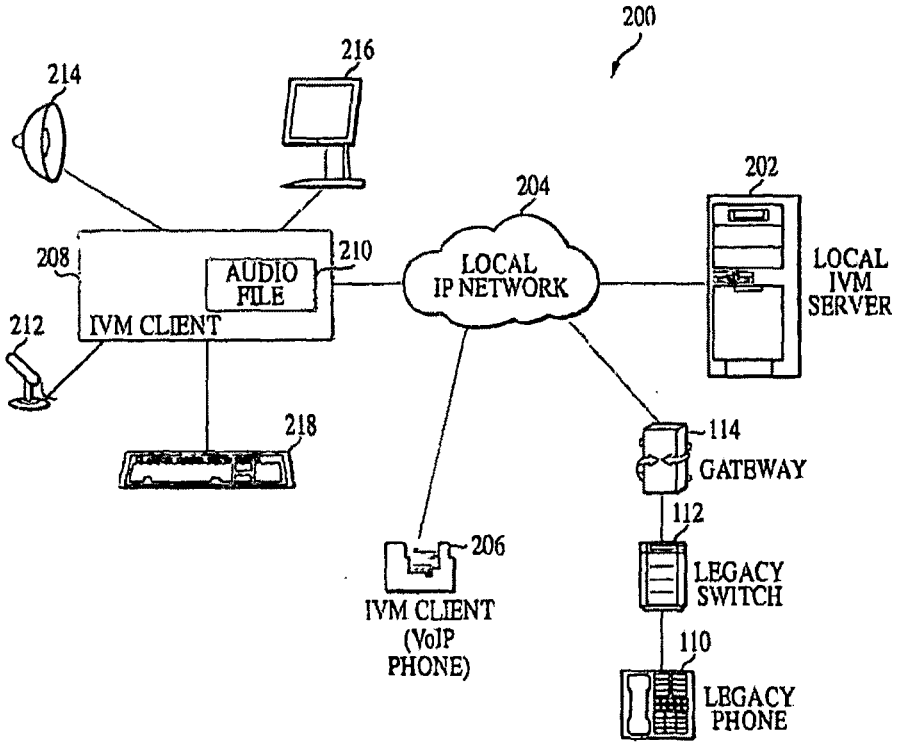

FIG. 2

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

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.

C. Illustrative Claims

Of the challenged claims, claims 1, 24, 27, and 38 are independent. Independent claims 1 and 27 are illustrative of the claims discussed below and are reproduced below.

1. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface;
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems; and
   a user database storing user records identifying users of the plurality of instant voice message client systems, wherein each of the user records includes a user name, a password and a list of other users selected by a user.

27. A system comprising:
   a client device;
   a network interface coupled to the client device and connecting the client device to a packet-switched network; and

an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,

wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message.

Ex. 1001, 23:62–24:9, 26:17–30.

D. Asserted Grounds of Unpatentability

Petitioner asserts six grounds of unpatentability (Pet. 6–7):

Challenged Claim(s)	Basis	Reference(s)
1	§ 103(a)	Zydney[2] and Appelman[3]
2	§ 103(a)	Zydney, Appelman, and Boneh[4]
24–26	§ 103(a)	Zydney and RFC793[5]
27, 32–34, 36–38	§ 102(b)	Zydney
27, 32–39	§ 103(a)	Zydney and Enete[6]

[2] Zydney et al., WO 01/11824 A2, published Feb. 15, 2001 (Ex. 1005).

[3] Appelman, US 6,750,881 B1, issued June 15, 2004 (Ex. 1015).

[4] Boneh et al., US 2002/0112167 A1, published Aug. 15, 2002 (Ex. 1014).

[5] "Transmission Control Protocol," *Request for Comments 793, DARPA Internet Program*, Defense Advanced Research Projects Agency (Sept. 1991) (Ex. 1007).

[6] Enete et al., US 2003/0208543 A1, published Nov. 6, 2003 (Ex. 1009).

Challenged Claim(s)	Basis	Reference(s)
28–31	§ 103(a)	Zydney, Enete, and Stern[7]

Petitioner also relies on a Declaration of Paul S. Min, Ph.D., filed as Exhibit 1003.

III. DISCRETIONARY AUTHORITY: 35 U.S.C §§ 315(d) and 325(d)

Section 325(d) states that "[i]n determining whether to institute . . . the Director may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office." In this proceeding, Patent Owner argues that the same or substantially the same prior art has been presented to the Office previously because Zydney has been asserted in multiple *inter partes* reviews. Prelim. Resp. 3–4. Specifically, Zydney previously was asserted against various claims of the '622 patent by different petitioners in IPR2017-01667 and IPR2017-01668, in which we instituted on January 19, 2018; IPR2017-01797 and IPR2017-01798, in which we instituted on February 6, 2018; and IPR2017-01804 and IPR2017-01805, in which we denied institution on January 19, 2018 ("the previous IPRs"); as well as in subsequent petitions filed against claims of the '622 patent in IPR2017-02090, IPR2018-00579, and IPR2018-00580. In several of those cases, namely, IPR2017-01667, IPR2017-01804, IPR2017-02090, and IPR2018-00579, the cited Appelman reference also has been asserted.

Petitioner responds that we should not exercise our discretion because, *inter alia*, the Petition presents different combinations of Zydney with other

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[7] Stern, WO 98/47252, published Oct. 22, 1998 (Ex. 1006).

references than earlier IPRs. Reply 2. Petitioner also proffers that it has not filed any previous petition challenging the '622 patent, thus precluding the characterization of this proceeding as a follow-on petition. *Id.* at 1–2. Finally, Petitioner argues that claims 1, 2, 36, and 37 have never before been challenged, and that where, as here, the Petitioner is different from any petitioner of previously filed petitions based on Zydney, the facts weigh heavily against a discretionary denial. *Id.* at 1–3. We are not persuaded by Petitioner's arguments.

There is no question that Zydney have been previously presented to the Office in previous IPRs challenging many of the same claims of the '622 patent. The question is whether, based on this fact, we should exercise our discretion and deny the Petition. Applicability of § 325(d) is not limited to situations where the *same petitioner* has filed a follow-on petition. The statute allows for the exercise of discretion upon consideration only of whether the same or substantially the same prior art or arguments were presented previously to the Office. Further, the statutory authority to deny the petition based on the same previously presented prior art is not tied to the format of how that prior art is presented or whether every aspect of the asserted grounds is identical in both petitions. Therefore, we have statutory authority to deny this Petition because Zydney was previously presented to the Office in the previous IPRs, notwithstanding that Petitioner is not a party to the previous IPRs and the asserted grounds here are not exactly the same as the previous IPRs.

We further note that under the current circumstances, where the patent-at-issue is involved in ongoing trials,[8] we also have discretionary authority, under 37 C.F.R. § 42.122, to issue "any appropriate order regarding the additional matter[, i.e., this proceeding,] including providing for the stay, transfer, consolidation, or termination or any such matter." *See* 35 U.S.C. § 315(d). We recognize that in exercising our discretion we determine the proper course of conduct in a proceeding (37 C.F.R. § 42.5) in a manner consistent with securing the just, speedy, and inexpensive resolution of the proceeding (37 C.F.R. § 42.1(b)).

Here, our exercise of discretion to deny institution under §§ 315(d) and 325(d) is warranted for several reasons. To start with, IPR2017-01667, IPR2017-01668, and the present Petition rely on Zydney as the primary reference against which the majority of the claim limitations are mapped. IPR2017-01797 and IPR2017-01798 also rely on Zydney as teaching or suggesting numerous limitations of the challenged claims. Petitioner has proffered no reasoning regarding how it has relied on Zydney in any way that *differs materially* from the previous IPRs. And Petitioner's reliance on different secondary references does not remedy this shortcoming. Moreover, Petitioner, here, does not explain whether the secondary references in this case are used in a different manner or add anything materially different to the secondary references used in the previous IPRs.

Further, Zydney is being considered on the merits in pending IPRs. In fact, four trials against the '622 patent are ongoing, with Zydney being used

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[8] Trials in IPR2017-01667, IPR2017-01668, IPR2017-01797, and IPR2017-01798 are pending as of the issuance of this Decision.

as a prior art reference in every instituted ground in those trials. *See* IPR2017-01667, IPR2017-01668, IPR2017-01797, and IPR2017-01798. Under these circumstances, we look to Petitioner to provide some reason that convinces us to institute yet another trial that features Zydney as prominently as the previously presented IPRs. Again, if there was a manner in which Petitioner here distinguishably relied on Zydney, Petitioner did not proffer that fact explicitly.

Moreover, the time of filing of this Petition leads us to conclude that Petitioner gained the benefit of Patent Owner's preliminary response, filed March 3, 2017, and our decision denying institution, entered May 25, 2017, in IPR2017-00223—i.e., more than three months before Petitioner filed the instant Petition. Petitioner, as the party with the knowledge of this fact, failed to allege that it did not gain the benefit of the preliminary response and decision denying institution in that previous IPR.[9] We look to Petitioner to explain its delay in its filing. Petitioner provides no reason here.

Finally, we are not just concerned with ensuring consistency across proceedings. We are also concerned with the significant resources of the Board that would be consumed reconciling arguments, issues, and evidence across proceedings.[10]

With regard to the non-overlap of claims between the previous IPRs and those challenged in this Petition, we recognize the interests of Petitioner

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[9] In this regard, in contrast, we acknowledge that Petitioner expressly asserts non-reliance on our decision denying institution in IPR2017-00224, entered the same day as the decision in IPR2017-00223. *See* Reply 2 (contending "IPR2017-00224 was denied on a procedural issue that never provided a substantive 'roadmap' for the instant Petition").

[10] *See MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373 (Fed. Cir. 2018).

in challenging claims that are not challenged in the previous IPRs (i.e., claims 1, 2, 36, and 37). The interest of Petitioner in this regard weigh heavily against our exercise of discretion. But we can exercise our discretion in a manner that balances the interests of Petitioner in challenging different claims here with the concern for duplication of Board resources and repeated challenges against the same claims of the same patents over Zydney, either alone or in combination with other references.

Therefore, based on the foregoing and to secure the just, speedy, and inexpensive resolution of the dispute, we exercise our discretion under §§ 315(d) and 325(d), and deny institution of all challenged claims that overlap with the previous IPRs, namely, claims 24–35, 38, and 39. We do not exercise our discretion to deny institution with respect to the claims that have not been challenged in the previous IPRs: claims 1, 2, 36, and 37.

IV. DISCUSSION OF CONSIDERED GROUNDS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim interpretation standard to be applied in *inter partes* reviews). We presume a claim term carries its plain meaning, which is the meaning customarily used by those of skill in the relevant art at the time of the invention. *Trivascular, Inc. v. Samuels,* 812 F.3d 1056, 1062 (Fed. Cir. 2016). We note that only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v.*

Zhongshan Broad Ocean Motor Co., 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Neither Petitioner nor Patent Owner proffers a construction for any claim term. Pet. 10–11; Prelim. Resp. 19–20. Based on our review of the record and the dispositive issues in our determination of whether to institute *inter partes* review, we determine that no claim terms require an express construction to resolve the issues presented by the patentability challenges.

B. Analysis of Asserted Grounds of Unpatentability

1. Principles of Law

A claim is anticipated under 35 U.S.C. § 102 "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Moreover,

> unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1371 (Fed. Cir. 2008); *accord In re Arkley*, 455 F.2d 586, 587 (CCPA 1972).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying

factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art;[11] and (4) objective evidence of nonobviousness, i.e., secondary considerations.[12] *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). "To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). We analyze the asserted grounds with the principles stated above in mind.

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[11] Petitioner's declarant, Dr. Min, opines that a person of ordinary skill in the art of the '622 patent "would have had at least an undergraduate degree in computer science, electrical engineering, or a related field, and at least two years of experience in the field of telecommunications devices and systems, or an equivalent advanced education in the field of telecommunications systems." Ex. 1003 ¶ 24. Patent Owner's declarant, William Easttom II, proffers substantially the same opinion as to the educational background of the person of ordinary skill in the art, but opines that such a person's post-educational experience would be "in computer programming and software development, including the development of software for communication with other computers over a network." Ex. 2001 (Easttom Declaration) ¶ 13. To the extent there is any substantive difference between the declarants' assessments, we adopt Dr. Min's assessment for purposes of this Decision.

[12] Patent Owner does not contend in its Preliminary Response that any such secondary considerations are present.

2. Obviousness of Claim 1 over Zydney and Appelman

a. Overview of Zydney

Zydney, titled "Method and System for Voice Exchange and Voice Distribution," relates to packet communication systems that provide for voice exchange and voice distribution between users of computer networks. Ex. 1005, [54], [57], 1:4–5. While acknowledging that e-mail and instant messaging systems were well-known text-based communication systems utilized by users of online services and that it was possible to attach files for the transfer of non-text formats via those systems, Zydney states that the latter technique "lack[ed] a method for convenient recording, storing, exchanging, responding and listening to voices between one or more parties, independent of whether or not they are logged in to their network." *Id.* at 1:7–17. Zydney thus describes a method in which "voice containers"—i.e., "container object[s] that . . . contain[] voice data or voice data and voice data properties"—can be "stored, transcoded and routed to the appropriate recipients instantaneously or stored for later delivery." *Id.* at 1:19–22; 12:6–8. Figure 1 of Zydney is reproduced below.

FIG. 1

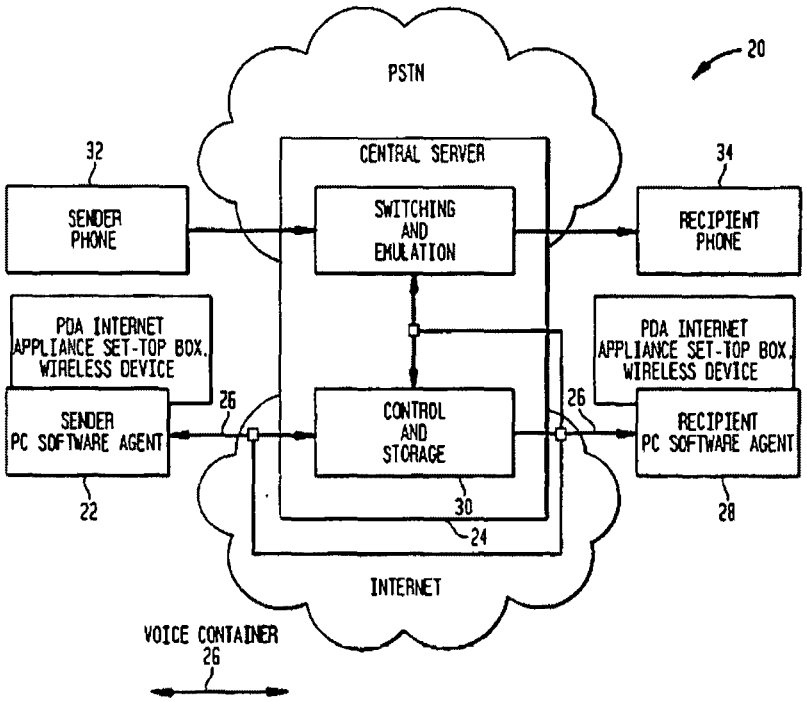

Figure 1, above, illustrates a high-level functional block diagram of Zydney's system for voice exchange and voice distribution. *Id.* at 10:19–20. Referring to Figure 1, system 20 allows software agent 22, with a user interface, in conjunction with central server 24 to send messages using voice containers illustrated by transmission line 26 to another software agent 28, as well as to receive and store such messages, in a "pack and send" mode of operation. *Id.* at 10:20–11:1. Zydney explains that a pack and send mode of operation "is one in which the message is first acquired, compressed and then stored in a voice container 26 which is then sent to its destination(s)." *Id.* at 11:1–3. The system has the ability to store messages both locally and centrally at server 24 whenever the recipient is not available for a prescribed period. *Id.* at 11:3–6.

In the use of Zydney's system and method, the message originator selects one or more intended recipients from a list of names that have been previously entered into the software agent. Ex. 1005, 14:17–19. The agent permits distinct modes of communication based on the status of the recipient, including the "core states" of whether the recipient is online or offline and "related status information" such as whether the recipient does not want to be disturbed. *Id.* at 14:19–15:1. Considering the core states, the software agent offers the originator alternative ways to communicate with the recipient, the choice of which can be either dictated by the originator or automatically selected by the software agent, according to stored rules. *Id.* at 15:3–6. If the recipient is online, the originator can either begin a real-time "intercom" call, which simulates a telephone call, or a voice instant messaging session, which allows for an interruptible conversation. *Id.* at 15:8–10. If the recipient is offline, the originator can either begin a voice mail conversation that will be delivered the next time the recipient logs in or can be delivered to the recipient's e-mail as a digitally encoded Multipurpose Internet Mail Extension ("MIME") attachment. *Id.* at 15:15–17. Zydney explains that the choice of the online modes "depends on the activities of both parties, the intended length of conversation and the quality of the communications path between the two individuals, which is generally not controlled by either party," and that the choice of the offline delivery options "is based on the interests of both parties and whether the recipient is sufficiently mobile that access to the registered computer is not always available." *Id.* at 15:10–14, 15:17–19.

Once the delivery mode has been selected, the originator digitally records messages for one or more recipients using a microphone-equipped

device and the software agent. Ex. 1005, 16:1–3. The software agent compresses the voice and stores the file temporarily on the PC if the voice will be delivered as an entire message. *Id.* at 16:3–4. If the real-time "intercom" mode has been invoked, a small portion of the digitized voice is stored to account for the requirements of the Internet protocols for retransmission and then transmitted before the entire conversation has been completed. *Id.* at 16:4–7. Based on status information received from the central server, the agent then decides whether to transport the voice container to a central file system and/or to send it directly to another software agent using the IP address previously stored in the software agent. *Id.* at 16:7–10. If the intended recipient has a compatible active software agent online after log on, the central server downloads the voice recording almost immediately to the recipient. *Id.* at 16:10–12. The voice is uncompressed and the recipient can hear the recording through the speakers or headset attached to its computer. *Id.* at 16:12–14. The recipient can reply in a complementary way, allowing for near real-time communications. *Id.* at 16:14–15. If the recipient's software agent is not online, the voice recording is stored in the central server until the recipient's software agent is active. *Id.* at 16:15–17. In both cases, the user is automatically notified of available messages once the voice recordings have been downloaded to storage on their computer. *Id.* at 16:17–19. The central server coordinates with software agents on all computers continuously, updating addresses, uploading and downloading files, and selectively retaining voice recordings in central storage. *Id.* at 16:19–21.

Zydney discloses that the voice container also has the ability to have other data types attached to it. Ex. 1005, 19:6–7. Formatting the container

using MIME format, for example, "allows non-textual messages and multipart message bodies attachments [sic] to be specified in the message headers." *Id.* at 19:7–10.

Figure 3 of Zydney is reproduced below.

FIG. 3

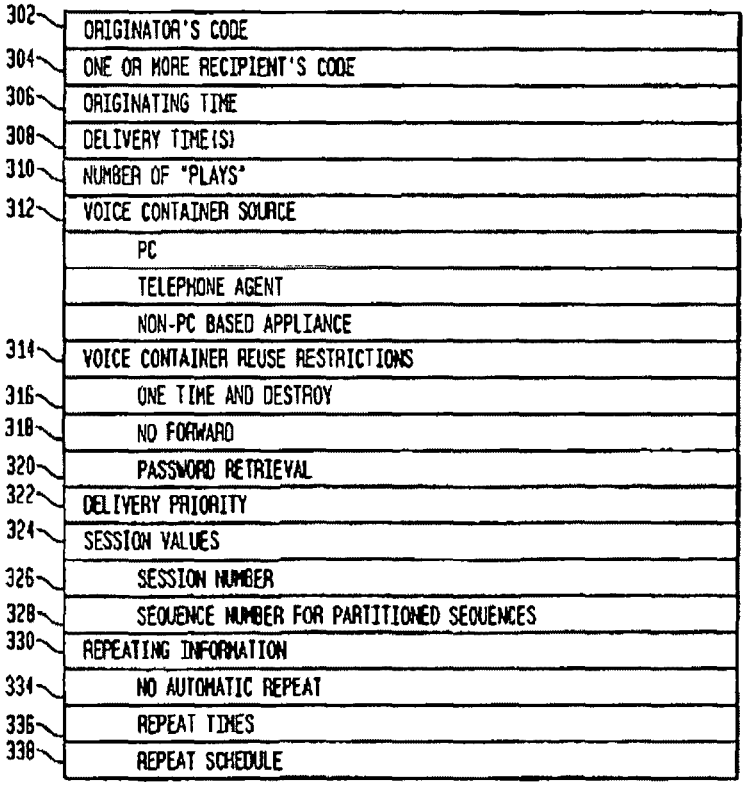

Figure 3, above, illustrates an exemplary embodiment of Zydney's voice container structure, including voice data and voice data properties components. Ex. 1005, 2:19, 23:1–2. Referring to Figure 3, voice container components include:

> [O]riginator's code 302 (which is a unique identifier), one or more recipient's code 304, originating time 306, delivery time(s) 308, number of "plays" 310, voice container source 312 which may be a PC, telephone agent, non-PC based appliance, or other, voice container reuse restrictions 314 which may include one time and destroy 316, no forward 318, password

> retrieval 320, delivery priority 322, session values 324, session number 326, sequence number for partitioned sequences[] 328, repeating information 330, no automatic repeat 332, repeat times 334, and a repeat schedule 336.

Id. at 23:2–10.

b. Overview of Appelman

Appelman, titled "User Definable On-line Co-user Lists," describes a real-time notification system that enables a user to define "buddy lists" to track co-users of an online or network system. Ex. 1015, [54], [57]. The system tracks for the user the log-on status of the co-users and displays that information in real time to the tracking user in a graphical interface. *Id.* at [57]. When the user logs on to a system, the user's set of buddy lists is presented to a buddy list system, which attempts to match co-users currently logged into the system with the entries on the user's buddy list, and any matches are displayed to the user. *Id.* As co-users log on and log off, the user's buddy list is updated to reflect the changes. *Id.*

Figure 2a of Appelman is reproduced below.

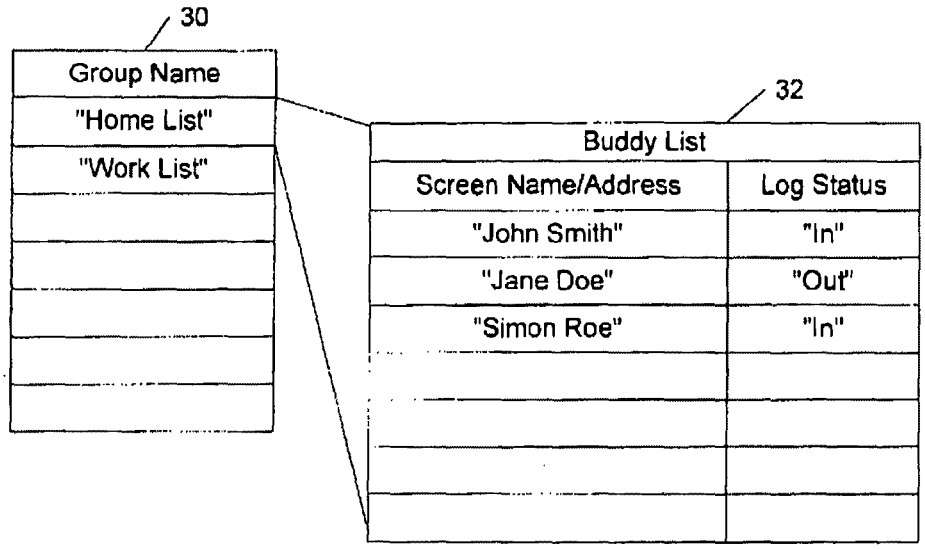

FIG. 2a

Figure 2a, above, illustrates "a set of symbolic data records showing the basic types of data used by one embodiment of [Appelman's] invention for a buddy list[] and the conceptual relationship of data elements." *Id.* at 2:15–18. With reference to Figure 2a, Group Name table 30 stores user-defined group names for buddy lists. *Id.* at 3:36–37. Each user may define multiple buddy lists by group names. *Id.* at 3:38. Two buddy lists, "Home List" and "Work List," are shown in Group Name table 30. *Id.* at 3:39. Each group name in Group Name table 30 has an associated Buddy List table 32, comprising multiple records that each correspond to a co-user (or "buddy") that the user wishes to track. *Id.* at 3:39–43. Each record may include data elements for the screen name (or address, such as an Internet address) of a particular co-user to be tracked, and the logon status of that user (e.g., codes for "In" or "Out"). *Id.* at 3:43–47.

Figure 11 of Appelman is reproduced below.

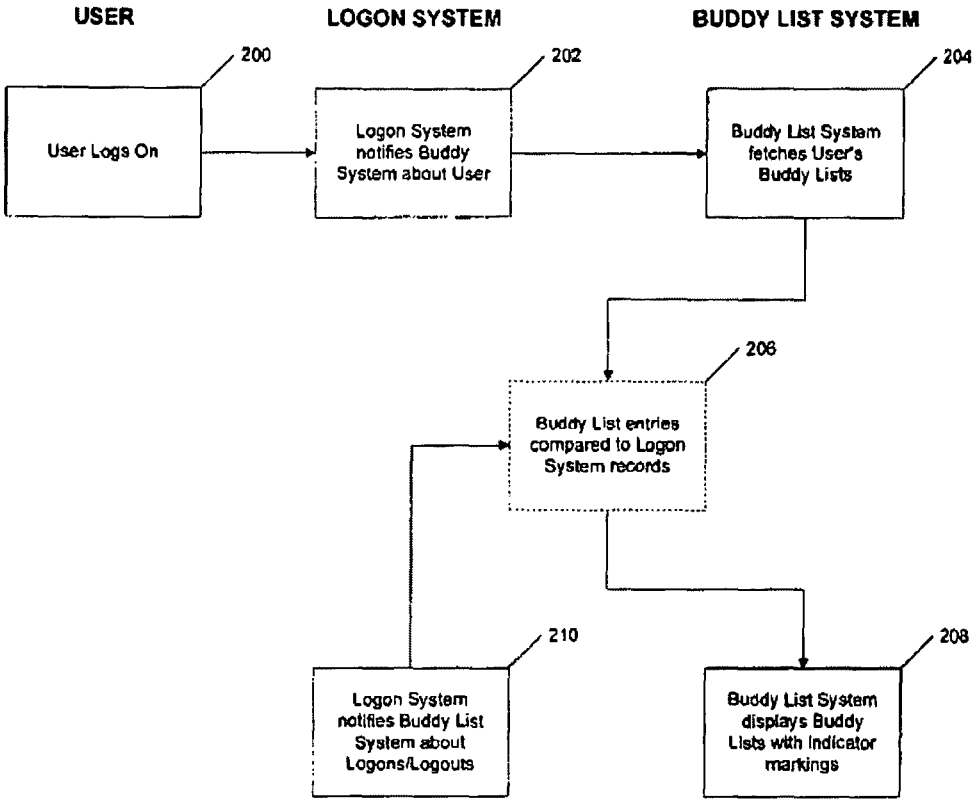

FIG. 11

Figure 11, above, is a flowchart showing an implementation of Appelman's invention. *Id.* at 2:41–42. In the illustrated implementation, a user logs into a Logon System (Step 200), which notifies the Buddy List System about the User (i.e., passes the User's ID, address, or screen name to the Buddy List System) (Step 202). *Id.* at 6:53–58. The Buddy List System accesses the user's buddy lists from a database, which may be, for example, on the user's own station (Step 204). *Id.* at 6:58–60. The entries in the user's buddy lists then are compared to the records of the Logon System (Step 206). *Id.* at 6:60–62. Appelman explains that this step is shown in dotted outline to indicate that the comparison can be done by passing records from the Logon

System to the Buddy List System, or vice versa, or could be done by a separate system. *Id.* at 6:62–65. The Buddy List System then displays a buddy list window showing the status (i.e., logged in or not) of the co-users on the user's buddy lists with any of various indicator markings (Step 208). *Id.* at 6:66–7:2. Thereafter, while the user's buddy list window is open, the Logon System notifies the Buddy List System about new logons/logoffs of co-users (Step 210), causing a new compare of the user's buddy list entries to the Logon System records (Step 206). *Id.* at 7:3–7. Appelman explains that the Logon System may, for example, maintain a copy of a user's buddy lists and notify the Buddy List System only upon a logon status change for a co-user on the user's buddy lists. *Id.* at 7:8–11. The Buddy List System then updates the indicated status of the displayed co-users (Step 208). *Id.* at 7:11–12.

c. Arguments and Analysis

As reproduced above, independent claim 1 of the '622 patent recites, *inter alia*, "a user database storing user records identifying users of [a] plurality of instant voice message client systems, wherein each of the user records includes a user name, a password and a list of other users selected by a user." Ex. 1001, 24:6–9. In asserting that claim 1 is unpatentable, Petitioner contends that the combination of Zydney in view of Appelman teaches these elements. Pet. 17.

In particular, according to Petitioner, "Zydney discloses an 'authentication server' that uses a database to authenticate users who log on to Zydney's centralized voice instant messaging server," whereas Appelman's Buddy List System 26 "maintains a database 28 for storing user information" that "stores user records identifying end users of the instant

messaging platform." *Id.* (citing Ex. 1005, 24:1–4, 31:1–12, 32:1–8, Fig. 15; Ex. 1015, 3:34–62). Petitioner contends that a person of ordinary skill in the art "would have been motivated to implement Appelman's teachings in Zydney's voice instant messaging system" and "would have had an expectation that the combination would have worked for its intended purpose." *Id.* at 17–18 (citing Ex. 1003 ¶ 65).

Petitioner further contends that "Zydney's authentication server authenticates software agents using a 'user identifier' and a password that were 'established during [an] initial registration process,'" and that "Zydney teaches that its servers maintain user records identifying a list of other users selected by a user . . . ." *Id.* at 18. According to Petitioner, a person of ordinary skill in the art "would have recognized that storing these user records in [a] database would have been a predictable option as late as 2003." *Id.* (citing Ex. 1003 ¶ 67). Further, Petitioner contends, "[e]ven if Zydney did not expressly disclose this element, Appelman demonstrates that this was a known feature of instant messaging systems at the time." *Id.* (citing Ex. 1003 ¶¶ 68–69). Specifically, Petitioner argues, Appelman's database 28 stores Buddy Lists, which identify "'co-users' ('buddies') 'that the user wishes to track,'" and "Permissions List 34," which "identifies, for each user, whether any other users in a linked 'Exclusion List 36' or 'Inclusion List 38' are permitted to add that user to their buddy lists." *Id.* at 18–19 (citing Ex. 1015, 3:26–27, 3:36–43, 3:48–63, Figs. 1, 2a, 2b). Still further, Petitioner argues, "Appelman also discusses a 'Logon System 24' that maintains user names and passwords for users to logon to the 'Buddy List System 26,' and suggests that the user names are linked to the 'Buddy Lists' stored in database 28." *Id.* at 20 (citing Ex. 1015, 6:54–59, Fig. 11).

Petitioner contends a person of ordinary skill in the art "would have known that the user records in Appelman's system, including user names, passwords, and lists of selected users (e.g., 'Buddy Lists' and 'Permissions List 34'), would be maintained in a database that is decentralized at least between the 'Logon System 24' and the 'Buddy List System 26,'" but that "a centralized database that combined the two would also have been a predictable option at the time." *Id.* at 21 (citing Ex. 1015, 3:27–29; Ex. 1003 ¶ 69.

Patent Owner disputes Petitioner's evidence with regard to the recited limitation "wherein each of the user records includes a user name, a password and a list of other users selected by a user" ("the user records limitation"). Prelim. Resp. 20–22. Patent Owner points out that, although the Petition initially purports to rely on Zydney alone for this limitation, the Petition does not show that Zydney discloses a database having user records that include all three of (1) a user name, (2) a password, and (3) a list of other users selected by a user. *Id.* at 20. Patent Owner further argues that the Petition also fails to show that Appelman, either by itself or in combination with Zydney, discloses a user database having user records that include all three of those elements. *Id.* In particular, Patent Owner contends, "[t]he Petition fails to show or explain any disclosure by either *App[el]man* or *Zydney* of a user record including either a user name data or password data . . . ." *Id.* at 21. Patent Owner argues that, although "the Petition expressly acknowledges that *App[el]man*'s 'Logon System' merely 'passes the User's ID, address, or screen name to the Buddy List System,'" "[t]here is no mention of any user records associated with the 'Logon System' by the [P]etition, and there is no indication that a 'user name' is a

part of any user record in *App[el]man*'s Buddy List System." *Id.* Moreover, Patent Owner asserts, whereas the Petition states that creating the patented invention would have been obvious despite neither Zydney nor Appelman expressly disclosing user records including user names and passwords, the expert testimony cited as purported support "merely parrots the Petition's conclusory statements **verbatim**, providing no substance or rational underpinning of its own." *Id.* at 21–22.

We agree with Patent Owner that Petitioner has not demonstrated a reasonable likelihood of showing that the combination of Zydney and Appelman teaches or suggests "a user database storing user records identifying users of [a] plurality of instant voice message client systems, wherein each of the user records includes a user name, a password and a list of other users selected by a user," as recited in claim 1. Even if we credit Petitioner's assertions that Zydney's authentication server uses a database to authenticate users and that the authentication server *also* uses a user identifier and a password established during an initial registration process to authenticate users (*see* Pet. 18), Petitioner does not demonstrate that the user identifier and password are stored in the referenced database. Moreover, despite Petitioner's assertion that Zydney teaches that its servers maintain "user records" identifying a list of other users selected by a user (*id.*), the portion of Zydney cited in support of that assertion merely states that "[t]he server will maintain a unique set of lists for each software agent," that "[t]hese lists will contain the identifiers of the other software agents that are permitted to send and receive voice containers and other media types," and that "[t]he server will maintain the current list of agents and be able to create delete, and modify those lists based on software agent requests or web based

administration" (Ex. 1005, 26:10–14). We are not persuaded that the cited passage supports Petitioner's contention that Zydney teaches or suggests the claimed user records.

Nor do the portions of Appelman cited by Petitioner supply the lacking teaching or suggestion. Even if we accept both (1) that Appelman's logon system 24 maintains user names and passwords that allow users to log on to Buddy List System 26, and (2) that Buddy Lists are stored in database 28, as alleged by Petitioner (Pet. 18), that does not suggest that user names and passwords are stored in database 28. To the contrary, Figure 1 of Appelman, reproduced below, shows logon system 24 as separate and distinct from Buddy List System 26 and database 28.

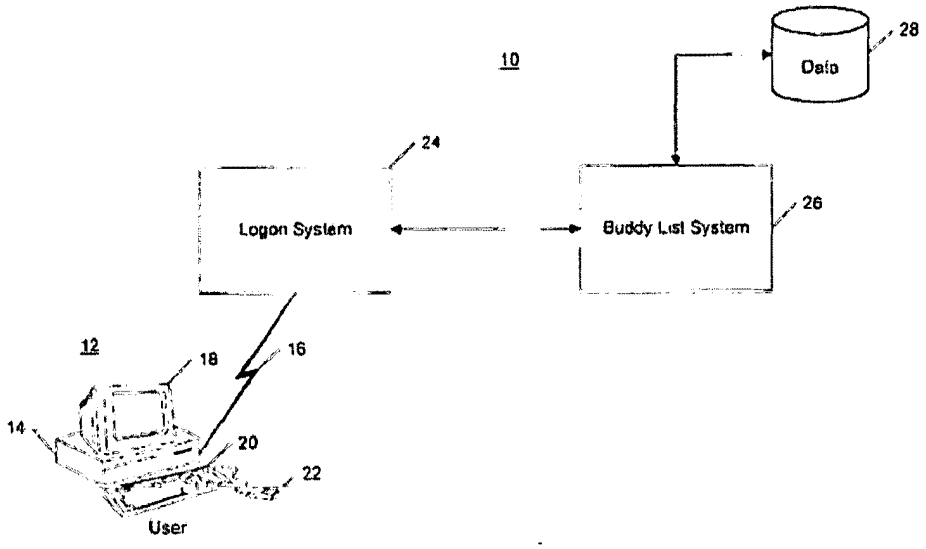

FIG. 1

Figure 1 of Appelman, above, is an exemplary block diagram of "a typical network system 10 in which [Appelman's] invention can be implemented." Ex. 1015, 3:10–12. Although Appelman contemplates that database 28 may be centralized or distributed, it discloses in the latter case that the database "may be stored at least in part on each user's own station 12" (*id.* at 3:27–

30; *see also id.* at 6:58–60 (stating that "[t]he Buddy List System accesses [a] User's Buddy Lists from a database, which may be, for example, on the user's station 12)), and Petitioner presents no evidence that database 28 may reside on logon system 24 or that user names and passwords allegedly maintained by logon system 24 would otherwise be stored in a database.

In summary, we are not persuaded that the information presented in the Petition demonstrates a reasonable likelihood of showing that the combination of Zydney and Appelman teaches or suggests "a user database storing user records identifying users of [a] plurality of instant voice message client systems, wherein each of the user records includes a user name, a password and a list of other users selected by a user." Accordingly, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in its contention that claim 1 is unpatentable over the combination of Zydney and Appelman.

3. Obviousness of Claim 2 over Zydney, Appelman, and Boneh

Claim 2 depends from independent claim 1 and further recites "wherein at least part of each of the user records is encrypted." Ex. 1001, 24:28–52, 24:61–25:3, 25:9–13, 25:31–50. Petitioner contends that claim 2 is unpatentable over the combined teachings of Zydney, Appelman, and Boneh. Pet. 23–25. Petitioner relies on Boneh as teaching a technique for encrypting passwords in a user database. *Id.* at 23. Petitioner, however, does not rely on Boneh as teaching or suggesting the user records limitation of claim 1 that we determine to be lacking from Zydney and Appelman. *See id.* Accordingly, for the reasons stated in our analysis above of Petitioner's contentions with respect to claim 1, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in its contention that

claim 2 is unpatentable over the combination of Zydney, Appelman, and Boneh.

4. Anticipation of Claims 36 and 37 by Zydney

Claim 37 depends from claim 36, which depends from independent claim 27. Ex. 1001, 27:1–10. As reproduced above, claim 27 recites, *inter alia*, "wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message." *Id.* at 26:28–30. With respect to this limitation, Petitioner contends that "Zydney teaches that the software agent used by the originator of an instant voice message can include 'other Internet and file based information, by including that in the data elements of the [voice container] format," and that certain passages and Figures 6 and 16 of Zydney, as well as the corresponding textual descriptions of those figures, illustrate the attachment of multimedia files to a voice container. Pet. 39 (alteration in original) (quoting Ex. 1005, 16:22–23, 19:3) (citing Ex. 1005, 19:1–20:9, 28[:9], 34[:16–18], 35[:15–17], Figs. 6, 16; Ex. 1003 ¶ 132). Petitioner concludes, "[t]hus, Zydney plainly discloses that its software agent includes functionality for a document handler system that attaches one or more files to an instant voice message," as recited in claim 27. *Id.*

Patent Owner responds, *inter alia*, that Zydney contains no explicit or inherent disclosure that its software agent is the element that attaches one or more files to Zydney's voice container. Prelim. Resp. 25. Pointing specifically to Zydney's descriptions of Figures 6 and 16 cited by Petitioner, Patent Owner contends that "nothing in the respective *single-sentence* descriptions of Figure[s] 6 and 16 expressly or inherently attributes any functionality to the 'Software Agent' in particular, let alone to the claimed

'instant voice messaging application' *which must itself include* 'a document handler system for attaching one or more files to the instant voice message.'" *Id.* (citing Ex. 1005, 34:16–18; 35:15–17).

We agree with Patent Owner that Petitioner has not demonstrated a reasonable likelihood of showing that Zydney discloses the "instant voice messaging application includ[ing] *a document handler system* for attaching one or more files to the instant voice message," as recited in claim 27 (emphasis added), and by virtue of their dependency from claim 27, in claims 36 and 37. Simply put, Petitioner's contention merely that Zydney's software agent "includes functionality for" a document handler system falls short of showing that Zydney sufficiently discloses a document handler system to establish *anticipation*.

We recognize that we previously instituted trial with respect to claim 27 over the combined teachings of Zydney and other references in Cases IPR2017-01667 and IPR2017-01797. In those cases, however, the respective petitioners proffered expert testimony and advanced arguments, materially different from those presented here, which when analyzed together with the information presented in the preliminary response we deemed sufficient to establish a reasonable likelihood that the claimed document handler system would have been obvious to a person of ordinary skill in the art.

5. Obviousness of Claims 36 and 37 over Zydney and Enete

Petitioner advances an alternative theory that independent claim 27 and dependent claims 36 and 37, among others, are unpatentable over the combined teachings of Zydney and Enete. Pet. 47–51, 54–56. In particular, Petitioner relies on Zydney and Enete in combination as teaching "a network

interface," as recited in claim 27, to the extent that Zydney alone does not explicitly disclose that element. *Id.* at 48–51. Regarding the document handler system limitation of claim 27, however, Petitioner relies only on its arguments presented in connection with its assertion that Zydney anticipates claim 27. *Id.* at 51. For the reasons stated in our discussion of those arguments above, we also conclude that Petitioner has not demonstrated a reasonable likelihood of prevailing in establishing that claims 36 and 37, which depend from claim 27, are unpatentable over the combined teachings of Zydney and Enete.

V. ADDITIONAL PATENT OWNER ARGUMENTS

Patent Owner has advanced a variety of additional arguments concerning an alleged failure on the part of Petitioner to name all real parties in interest and the constitutionality of *inter partes* review proceedings. Prelim. Resp. 10–16, 31–32. We have considered those arguments, but in view of our determination not to institute trial on the basis of 35 U.S.C. §§ 315(d) and 325(d) and Petitioner's substantive grounds, we do not address those arguments further herein.

VI. CONCLUSION

In summary, we do not institute *inter partes* review on any challenged claim as shown below:

Ground	**Basis**	**Claim(s) Challenged**	**Claims Instituted**
1	§ 103 Zydney and Appelman	1	none
2	§ 103 Zydney, Appelman, and Boneh	2	none
3	§ 103 Zydney and RFC793	24–26	none
4	§ 102 Zydney	27, 32–34, 36–38	none
5	§ 103 Zydney and Enete	27, 32–39	none
6	§ 103 Zydney, Enete, and Stern	28–31	none
Summary		1, 2, 24–39	none

VII. ORDER

Upon consideration of the record before us, it is, therefore,

ORDERED that the Petition is *denied*, and no trial or *inter partes* review is instituted on any asserted ground.

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Paper 10
Entered: March 19, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-02080
Patent 8,724,622 B2

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[1] ("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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[1] *See* Paper 6, 2.

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.

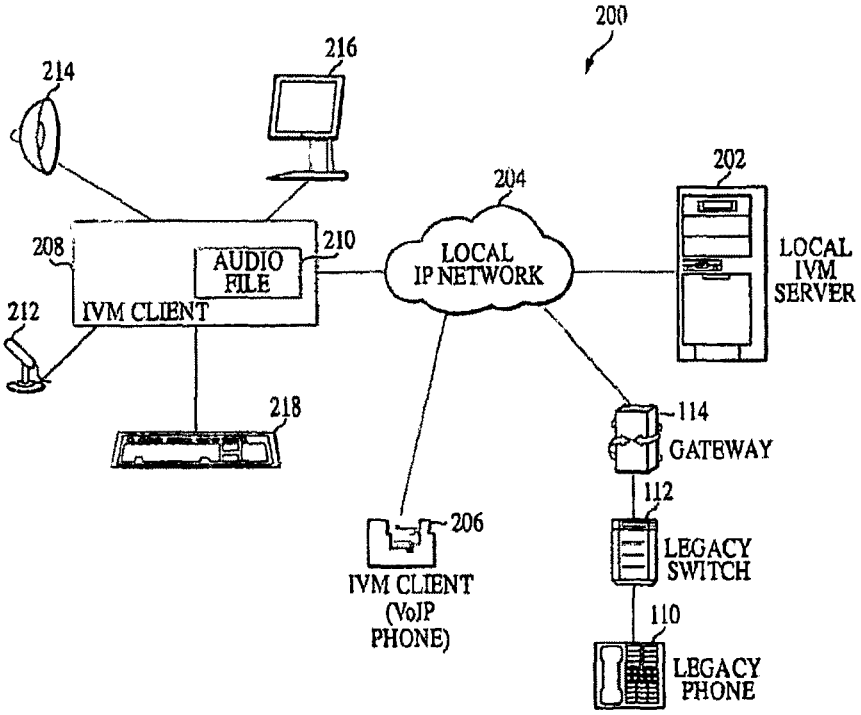

FIG. 2

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

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.

C. Illustrative Claim

Independent claim 3 is illustrative of the challenged claims and is reproduced below.

3. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,
   wherein the messaging system receives an instant voice message from one of the plurality of instant voice message clicnt systems, and
   wherein the instant voice message includes an object field including a digitized audio file.

Ex. 1001, 24:12–27.

D. Asserted Grounds of Unpatentability

Petitioner asserts five grounds of unpatentability (Pet. 6):

Challenged Claim(s)	Basis	Reference(s)
3–8, 11, 13, 18–21	§ 102(b)	Zydney[2]
3–8, 11, 13, 18–23	§ 103(a)	Zydney and Enete[3]
10, 14–17	§ 103(a)	Zydney, Enete, and Stern[4]
12	§ 103(a)	Zydney, Enete, and Coussement[5]
9	§ 103(a)	Zydney, Enete, and RFC2131[6]

Petitioner also relies on a Declaration of Paul S. Min, Ph.D., filed as Exhibit 1003.

III. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the

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[2] Zydney et al., WO 01/11824 A2, published Feb. 15, 2001 (Ex. 1005).

[3] Enete et al., US 2003/0208543 A1, published Nov. 6, 2003 (Ex. 1009).

[4] Stern, WO 98/47252, published Oct. 22, 1998 (Ex. 1006).

[5] Coussement, US 2002/0055967 A1, published May 9, 2002 (Ex. 1008).

[6] R. Droms, "Dynamic Host Configuration Protocol," *Request for Comments 2131, Standards Track*, Internet Engineering Task Force Network Working Group, 1–45 (March 1997) (Ex. 1012).

patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim interpretation standard to be applied in *inter partes* reviews). Under the broadest reasonable interpretation standard, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We note that only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Neither Petitioner nor Patent Owner proffers a construction for any claim term. Pet. 10; Prelim. Resp. 19. Based on our review of the record and the dispositive issues in our determination of whether to institute *inter partes* review, we determine that no claim terms require an express construction to resolve the issues presented by the patentability challenges.

B. Analysis of Asserted Grounds of Unpatentability

1. Principles of Law

A claim is anticipated under 35 U.S.C. § 102 "only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Moreover,

> unless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of

> the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.

Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1371 (Fed. Cir. 2008); *accord In re Arkley*, 455 F.2d 586, 587 (CCPA 1972).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art;[7] and (4) objective evidence of nonobviousness, i.e., secondary considerations.[8] *Graham v. John Deere Co.*,

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[7] Petitioner's declarant, Dr. Min, opines that a person of ordinary skill in the art of the '622 patent "would have had at least an undergraduate degree in computer science, electrical engineering, or a related field, and at least two years of experience in the field of telecommunications devices and systems, or an equivalent advanced education in the field of telecommunications systems." Ex. 1003 ¶ 24. Patent Owner's declarant, William Easttom II, proffers substantially the same opinion as to the educational background of the person of ordinary skill in the art, but opines that such a person's post-educational experience would be "in computer programming and software development, including the development of software for communication with other computers over a network." Ex. 2001 (Easttom Declaration) ¶ 14. To the extent there is any substantive difference between the declarants' assessments, we adopt Dr. Min's assessment for purposes of this Decision.

[8] Patent Owner does not contend in its Preliminary Response that any such

383 U.S. 1, 17–18 (1966). "To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). We analyze the asserted grounds with the principles stated above in mind.

2. *Ground 1: Anticipation by Zydney (Claims 3–8, 11, 13, and 18–21)*

a. *Overview of Zydney*

Zydney, titled "Method and System for Voice Exchange and Voice Distribution," relates to packet communication systems that provide for voice exchange and voice distribution between users of computer networks. Ex. 1005, [54], [57], 1:4–5. While acknowledging that e-mail and instant messaging systems were well-known text-based communication systems utilized by users of online services and that it was possible to attach files for the transfer of non-text formats via those systems, Zydney states that the latter technique "lack[ed] a method for convenient recording, storing, exchanging, responding and listening to voices between one or more parties, independent of whether or not they are logged in to their network." *Id.* at 1:7–17. Zydney thus describes a method in which "voice containers"—i.e., "container object[s] that . . . contain[] voice data or voice data and voice data properties"—can be "stored, transcoded and routed to the appropriate recipients instantaneously or stored for later delivery." *Id.* at 1:19–22; 12:6–8. Figure 1 of Zydney is reproduced below.

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secondary considerations are present.

FIG. 1

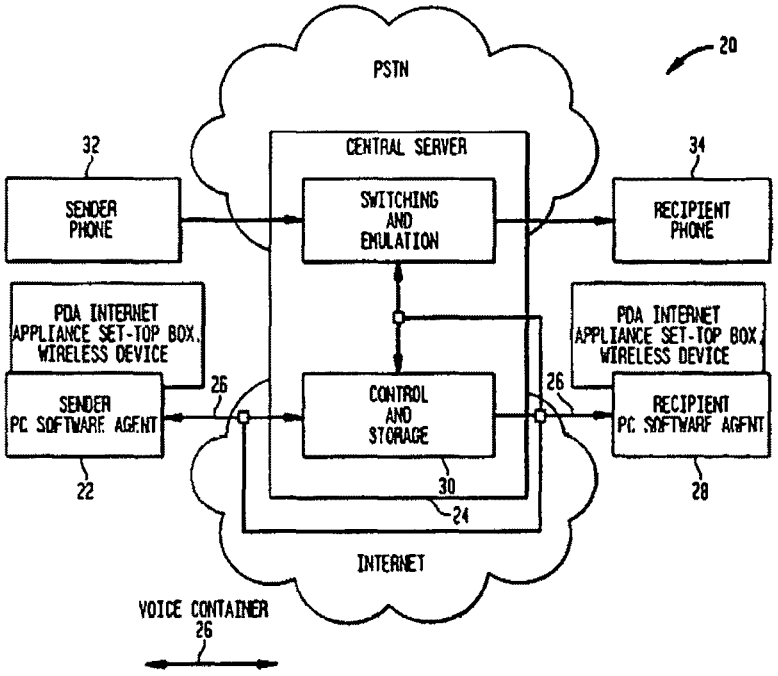

Figure 1, above, illustrates a high-level functional block diagram of Zydney's system for voice exchange and voice distribution. *Id.* at 10:19–20. Referring to Figure 1, system 20 allows software agent 22, with a user interface, in conjunction with central server 24 to send messages using voice containers illustrated by transmission line 26 to another software agent 28, as well as to receive and store such messages, in a "pack and send" mode of operation. *Id.* at 10:20–11:1. Zydney explains that a pack and send mode of operation "is one in which the message is first acquired, compressed and then stored in a voice container 26 which is then sent to its destination(s)." *Id.* at 11:1–3. The system has the ability to store messages both locally and centrally at server 24 whenever the recipient is not available for a prescribed period. *Id.* at 11:3–6.

In the use of Zydney's system and method, the message originator selects one or more intended recipients from a list of names that have been previously entered into the software agent. Ex. 1005, 14:17–19. The agent permits distinct modes of communication based on the status of the recipient, including the "core states" of whether the recipient is online or offline and "related status information" such as whether the recipient does not want to be disturbed. *Id.* at 14:19–15:1. Considering the core states, the software agent offers the originator alternative ways to communicate with the recipient, the choice of which can be either dictated by the originator or automatically selected by the software agent, according to stored rules. *Id.* at 15:3–6. If the recipient is online, the originator can either begin a real-time "intercom" call, which simulates a telephone call, or a voice instant messaging session, which allows for an interruptible conversation. *Id.* at 15:8–10. If the recipient is offline, the originator can either begin a voice mail conversation that will be delivered the next time the recipient logs in or can be delivered to the recipient's e-mail as a digitally encoded Multipurpose Internet Mail Extension ("MIME") attachment. *Id.* at 15:15–17. Zydney explains that the choice of the online modes "depends on the activities of both parties, the intended length of conversation and the quality of the communications path between the two individuals, which is generally not controlled by either party," and that the choice of the offline delivery options "is based on the interests of both parties and whether the recipient is sufficiently mobile that access to the registered computer is not always available." *Id.* at 15:10–14, 15:17–19.

Once the delivery mode has been selected, the originator digitally records messages for one or more recipients using a microphone-equipped

device and the software agent. Ex. 1005, 16:1–3. The software agent compresses the voice and stores the file temporarily on the PC if the voice will be delivered as an entire message. *Id.* at 16:3–4. If the real-time "intercom" mode has been invoked, a small portion of the digitized voice is stored to account for the requirements of the Internet protocols for retransmission and then transmitted before the entire conversation has been completed. *Id.* at 16:4–7. Based on status information received from the central server, the agent then decides whether to transport the voice container to a central file system and/or to send it directly to another software agent using the IP address previously stored in the software agent. *Id.* at 16:7–10. If the intended recipient has a compatible active software agent online after log on, the central server downloads the voice recording almost immediately to the recipient. *Id.* at 16:10–12. The voice is uncompressed and the recipient can hear the recording through the speakers or headset attached to its computer. *Id.* at 16:12–14. The recipient can reply in a complementary way, allowing for near real-time communications. *Id.* at 16:14–15. If the recipient's software agent is not online, the voice recording is stored in the central server until the recipient's software agent is active. *Id.* at 16:15–17. In both cases, the user is automatically notified of available messages once the voice recordings have been downloaded to storage on their computer. *Id.* at 16:17–19. The central server coordinates with software agents on all computers continuously, updating addresses, uploading and downloading files, and selectively retaining voice recordings in central storage. *Id.* at 16:19–21.

Zydney discloses that the voice container also has the ability to have other data types attached to it. Ex. 1005, 19:6–7. Formatting the container

using MIME format, for example, "allows non-textual messages and multipart message bodies attachments [sic] to be specified in the message headers." *Id.* at 19:7–10.

Figure 3 of Zydney is reproduced below.

FIG. 3

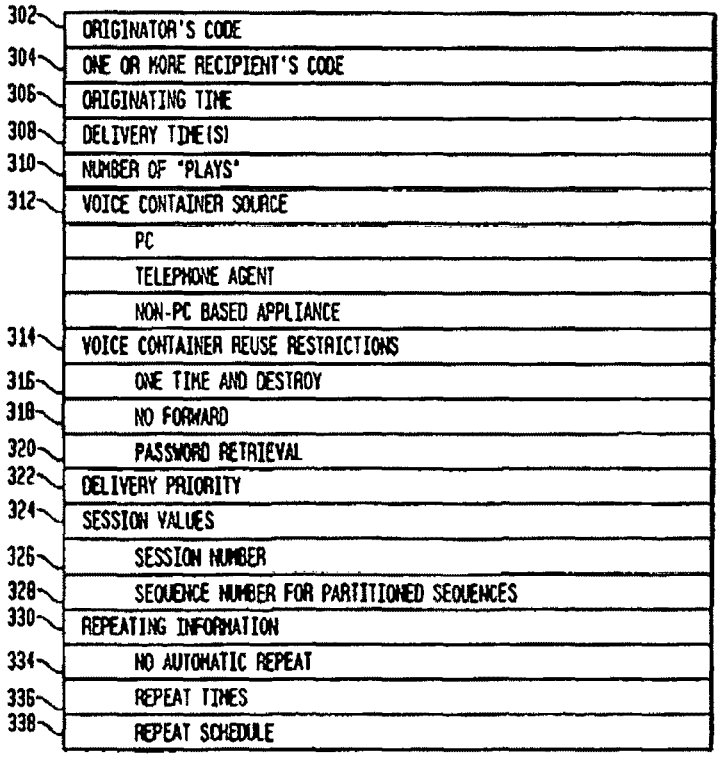

Figure 3, above, illustrates an exemplary embodiment of Zydney's voice container structure, including voice data and voice data properties components. Ex. 1005, 2:19, 23:1–2. Referring to Figure 3, voice container components include:

> [O]riginator's code 302 (which is a unique identifier), one or more recipient's code 304, originating time 306, delivery time(s) 308, number of "plays" 310, voice container source 312 which may be a PC, telephone agent, non-PC based appliance, or other, voice container reuse restrictions 314 which may include one time and destroy 316, no forward 318, password

> retrieval 320, delivery priority 322, session values 324, session number 326, sequence number for partitioned sequences[] 328, repeating information 330, no automatic repeat 332, repeat times 334, and a repeat schedule 336.

Id. at 23:2–10.

b. Independent Claim 3

As reproduced above, independent claim 3 of the '622 patent recites a messaging system that receives an "instant voice message" from one of a plurality of instant voice message client systems, "wherein the instant voice message includes an object field including a digitized audio file." Ex. 1001, 24:23–27. In asserting that Zydney anticipates claim 3, Petitioner maps Zydney's voice container to the recited "instant voice message" and Zydney's digitized voice message to the recited "digitized audio file." *See* Pet. 14–19.

With respect specifically to the limitation "wherein the instant voice message includes an object field including a digitized audio file" (the "object field limitation"), Petitioner contends that Zydney teaches that the voice container "includes a 'body,' which . . . holds the digitized voice message" and "corresponds to the claimed 'object field' in an instant voice message to carry a digitized audio file." *Id.* at 19 (citing Ex. 1005, 23:1–2, 34:4–7, Fig. 7). Pointing to Figure 3 and corresponding text of Zydney, Petitioner alleges that "Zydney teaches an arrangement of fields 302–338 for the 'voice data properties components' of a voice container" and that "[t]he voice container carries data organized in a set of fields." *Id.* (citing Ex. 1005, 23:1–12, Fig. 3). Petitioner concedes that "Figure 3 does not expressly show the 'body' of the voice container that carries the digitized voice message," but contends that "Zydney teaches elsewhere that the voice container

includes a 'body,' which is in addition to the voice data properties components shown in Figure 3." *Id.* Relying on Dr. Min's testimony, Petitioner further contends that a person of ordinary skill in the art "would have appreciated that providing the digitized voice message in an object field (e.g., body) of the voice container would allow the recipient software agent to locate and extract the digitized voice message from other data stored in the voice container." *Id.* (citing Ex. 1003 ¶ 62).

Patent Owner disputes Petitioner's evidence with regard to the object field limitation. Prelim. Resp. 20–27. Patent Owner argues, *inter alia*, that, "[w]hile the Petition points . . . to an alleged 'arrangement of fields' in Figure 3 of *Zydney*, . . . *Zydney* does not use the word 'field' *at all* in relation to its structural description of the voice container." *Id.* at 22. "[E]ven if *Zydney* had described elements 302 through 338 of Figure 3 as fields," Patent Owner contends, "none of [those] *twenty-five* 'voice data components' . . . is an 'object field *including a digitized audio file.*'" *Id.* (citing Ex. 2001 ¶¶ 43–57). Further, Patent Owner contends, "[t]here is likewise no merit to Petitioner's suggestion that *Zydney's* use of the word 'body' somehow anticipates the 'object field' as claimed." *Id.* at 23. Patent Owner points out that although Zydney recites the word "body" two times, nothing in those recitations characterizes the body as an "object field," and "[i]ndeed, *Zydney* provides no detail on the structure of the 'body.'" *Id.* (citing Ex. 1005, 34:4–10; Ex. 2001 ¶¶ 56–57). Patent Owner also argues that, to the extent Petitioner intended implicitly to rely on an inherency argument, such argument fails because Petitioner has not shown that Zydney "*necessarily* requires its 'voice container' to include a specific 'object field including a digitized audio file.'" *Id.* at 26–27.

We agree with Patent Owner that Petitioner has not demonstrated a reasonable likelihood of showing that the object field limitation of claim 3 is disclosed by Zydney. We recognize that we previously instituted trial with respect to claim 3 over the combined teachings of Zydney and other references in Cases IPR2017-01667 and IPR2017-01797. In those cases, however, the respective petitioners proffered expert testimony and advanced arguments, different from those presented here, sufficient to establish a reasonable likelihood that the claimed object field would have been obvious to a person of ordinary skill in the art. There is insufficient evidence on the record to support Petitioner's contention that Zydney's disclosure of a message "body," without any disclosure of the structure of that body, expressly discloses the recited object field.

We also agree with Patent Owner that Petitioner has not established a reasonable likelihood of showing that the claimed object field is inherently anticipated by Zydney. *See* Prelim. Resp. 27–28. Although Zydney discloses that its voice container includes "voice data" and "information concerning codec type, size, sample rate, and data," in addition to the "voice data properties components" depicted in Figure 3 (*see* Ex. 1005, 23:1–2, 23:10–12), and we understand that Figure 3, therefore, does not provide a "comprehensive . . . list" of voice container components (*cf.* Prelim. Resp. 27), we agree with Patent Owner that Petitioner has not shown that voice data necessarily would be included in an "object field" (*see id.* at 26–27).

For the foregoing reasons, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in its contention that claim 3 is anticipated by Zydney.

c. Dependent Claims 4–8, 11, 13, and 18–21

Claims 4–8, 11, 13, and 18–21 depend directly or indirectly from independent claim 3. Ex. 1001, 24:28–52, 24:61–25:3, 25:9–13, 25:31–50. Accordingly, the deficiency in Petitioner's anticipation showing for independent claim 3, discussed above, also applies to these claims. Petitioner's arguments directed to the additional limitations of these dependent claims do not cure the deficiencies. *See* Pet. 19–33.

3. Ground 2: Obviousness over Zydney and Enete (Claims 3 8, 11, 13, and 18–23)

a. Independent Claim 3

Petitioner advances an alternative theory that claim 3 is unpatentable over the combined teachings of Zydney and Enete. Pet. 33–38. In particular, Petitioner relies on Enete as "confirm[ing] that an instant voice messaging system having a central server . . . that communicates with instant voice message client systems via a network interface was a predictable option before the '622 patent" (*id.* at 34) and as demonstrating that the features of a central server maintaining connection information for client software agents (corresponding to the "communication platform system" and "instant voice message client systems" recited in claim 3, respectively) were well-known in instant voice messaging systems before the invention of the '622 patent (*id.* at 35). Regarding the object field limitation of claim 3, however, Petitioner relies only on its arguments presented in connection with its assertion that Zydney anticipates claim 3. *Id.* at 38. For the reasons stated in our discussion of those arguments above, we also conclude that Petitioner has not demonstrated a reasonable likelihood of prevailing in

establishing that claim 3 is unpatentable over the combined teachings of Zydney and Enete.

b. Dependent Claims 4–8, 11, 13, and 18–23

Claims 4–8, 11, 13, and 18–23 depend directly or indirectly from independent claim 3. Ex. 1001, 24:28–52, 24:61–25:3, 25:9–13, 25:31–58. Accordingly, the deficiency in Petitioner's obviousness showing for independent claim 3, discussed above, also applies to these claims. Petitioner's arguments directed to the additional limitations of these dependent claims do not cure the deficiencies. *See* Pet. 38–46.

4. Remaining Grounds (Claims 9, 10, 12, and 14–17)

Claims 9, 10, 12, and 14–17 depend directly or indirectly from independent claim 3. Petitioner contends that claim 9 is unpatentable over the combined teachings of Zydney, Enete, and RFC2131; that claims 10 and 14–17 are unpatentable over the combined teachings of Zydney, Enete, and Stern; and that claim 12 is unpatentable over the combined teachings of Zydney, Enete, and Coussement. Pet. 46–68. Petitioner, however, does not rely on any of RFC2131, Stern, and Coussement as teaching or suggesting the object field limitation of claim 3 that we conclude Zydney and Enete lack. Accordingly, for the reasons stated in our analysis above of Petitioner's contentions with respect to claim 3, we determine that Petitioner does not show a reasonable likelihood of prevailing in establishing that any of claims 9, 10, 12, and 14–17 are unpatentable on the respective grounds presented.

C. Additional Considered Arguments

Patent Owner has advanced a variety of additional arguments concerning the repeated challenges to the '622 patent and related patents asserted by other parties, an alleged failure on the part of Petitioner to name all real parties in interest, and the constitutionality of *inter partes* review proceedings. Prelim. Resp. 1–15, 31–32. We have considered those arguments, but in view of our determination not to institute trial on the basis of Petitioner's substantive grounds, we do not address those arguments further herein.

IV. CONCLUSION

In summary, we do not institute *inter partes* review on any challenged claim as shown below:

Ground	**Basis**	**Claims Challenged**	**Claims Instituted**
1	§ 102 Zydney	3–8, 11, 13, 18–21	none
2	§ 103 Zydney and Enete	3–8, 11, 13, 18–23	none
3	§ 103 Zydney, Enete, and Stern	10, 14–17	none
4	§ 103 Zydney, Enete, and Coussement	12	none
5	§ 103 Zydney, Enete, and RFC2131	9	none
Summary		3–23	none

V. ORDER

Upon consideration of the record before us, it is, therefore,

ORDERED that the Petition is *denied*, and no trial or *inter partes* review is instituted on any asserted ground.

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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.

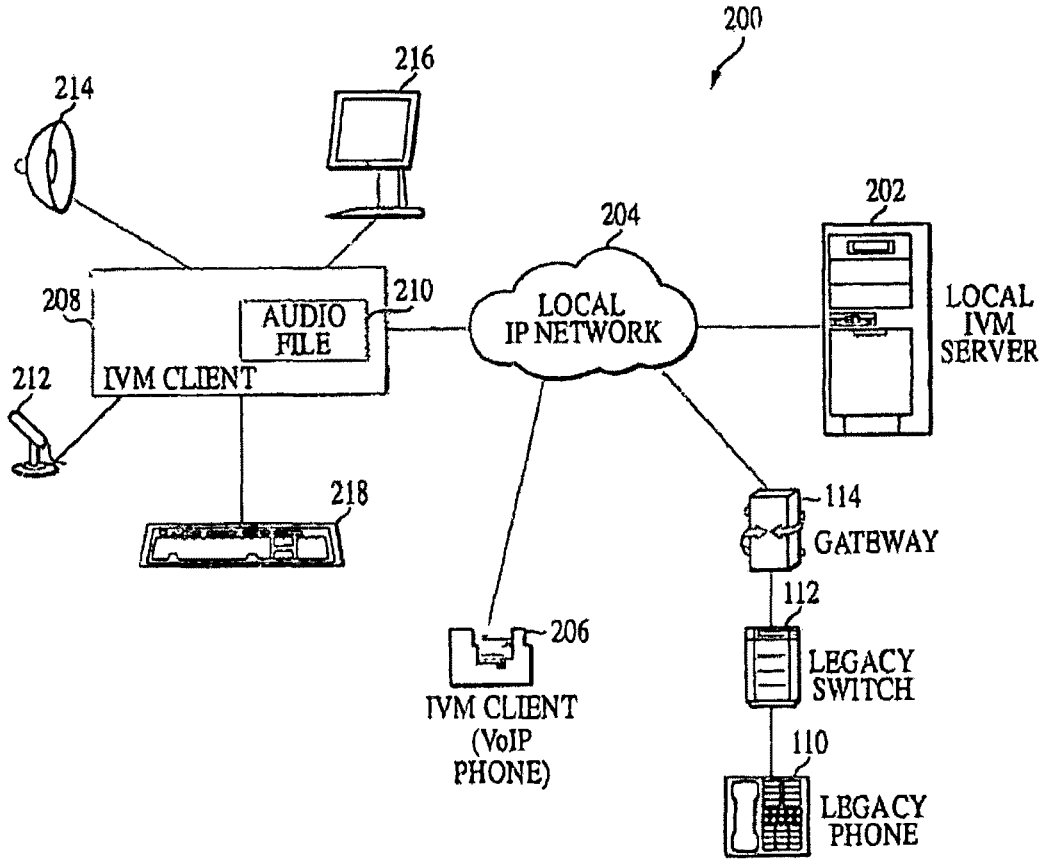

FIG. 2

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.

C. Illustrative Claims

Of the challenged claims, claims 3, 27, and 38 are independent. Claims 3 and 27 are illustrative of the challenged claims and are reproduced below.

3. A system comprising:
a network interface connected to a packet-switched network;
a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,
wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and
wherein the instant voice message includes an object field including a digitized audio file.

27. A system comprising:
a client device;
a network interface coupled to the client device and connecting the client device to a packet-switched network; and
an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,
wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message.

Ex. 1001, 24:12–27, 26:17–30.

III. INSTITUTION OF *INTER PARTES* REVIEW

On January 19, 2018, we instituted *inter partes* review in Case IPR2017-01667 based on the following prior art and grounds of unpatentability (Facebook 1667 IPR, slip op. at 38 (PTAB Jan. 19, 2018) (Paper 8)):

Challenged Claims	Basis	References
3, 6–8, 10, 11, 13, 18–21, 23, 27, 32–35, 38	§ 103(a)	Zydney[2] and Shinder[3]
14–17, 28–31	§ 103(a)	Zydney, Shinder, and Clark[4]
22, 39	§ 103(a)	Zydney, Shinder, and Appelman[5]

The Petition in this proceeding asserts the same grounds as those we instituted in the Facebook 1667 IPR. Pet. 1, 6; *see also* Mot. 1. Petitioner relies also on a Declaration of Tal Lavian, Ph.D., filed as Exhibit 1002 ("Lavian Declaration"). Petitioner asserts that the Lavian Declaration is identical to the Lavian Declaration filed in the Facebook 1667 IPR. Mot. 1.

Patent Owner's Preliminary Response presents three procedural arguments not presented in the Facebook 1667 IPR. We address those arguments here. First, Patent Owner argues that we should deny the instant Petition because Petitioner fails to identify all related administrative matters.

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[2] Zydney et al., WO 01/11824 A2, published Feb. 15, 2001 (filed with line numbers added by Petitioner as Exhibit 1003).

[3] Excerpts from Debra Littlejohn Shinder, *Computer Networking Essentials* (2002) (Ex. 1014).

[4] Clark et al., US 6,725,228 B1, issued Apr. 20, 2004 (Ex. 1008).

[5] Appelman, US 6,750,881 B1, issued June 15, 2004 (Ex. 1004).

Prelim. Resp. 1–4. Specifically, Patent Owner points out that the Petition does not mention at least seven petitions for *inter partes* review filed against U.S. Patent No. 8,995,433, a patent that issued from a continuation of the application for the '622 patent, or other petitions filed against other related patents. *Id.* The omission, according to Patent Owner, violates the Board's rule regarding mandatory notices (37 C.F.R. § 42.8(b)(2)) and the relevant statutory requirement in 35 U.S.C. § 312(a)(4). Prelim. Resp. 4.

Second, Patent Owner alleges that Petitioner failed to identify all real parties in interest under 37 C.F.R. § 42.8(b)(1). Prelim. Resp. 5–6. In particular, Patent Owner alleges that the unnamed real parties in interest pertain to the collection of co-defendants that, together with Petitioner, filed joint invalidity contentions in the district court litigation. *Id.* at 5 (referring to Exhibits 2002 and 2003). Patent Owner also argues that Huawei has coordinated with Google and Motorola to file petitions in Cases IPR2017-02080 and IPR2017-02081, in which, as noted above, Google identified Motorola, Petitioner Huawei, and other Huawei entities as real parties in interest. *Id.* at 5–6; *see supra* § II.A.

Third, Patent Owner proffers that Huawei challenges the '622 patent in two other petitions, i.e., in Cases IPR2017-02080 and IPR2017-02081, and, therefore, Huawei has presented the same or substantially similar arguments relying on Zydney. Prelim. Resp. 6–8. According to Patent Owner, the "redundancy" presented by this third petition on the overlapping grounds based on Zydney is sufficient to deny the Petition under 35 U.S.C. § 325(d), in light of the factors set forth in the Board's precedential decision in *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19). *Id.* at 8–10.

We do not agree with any of Patent Owner's arguments. Under the circumstances of this case, the alleged failure to identify either related matters or real parties in interest, alone,[6] does not compel denial of the Petition. First, mandatory notices are updateable on an ongoing basis. 37 C.F.R. § 42.8(a)(3). Second, identification of real parties in interest is not a jurisdictional issue and may be corrected. *See Lumentum Holdings, Inc., v. Capella Photonics, Inc.*, Case IPR2015-00739, slip op. at 5 (PTAB Mar. 4, 2016) (Paper 38) (precedential). Further, an allegation that defendants in district court filed joint invalidity contentions is not sufficient to show that all co-defendants are real parties in interest. *See, e.g., Azure Gaming Mac., Ltd., v. MGT Gaming, Inc.*, Case IPR2014-01288, slip op. at 11–12 (PTAB Feb. 20, 2015) (Paper 13) (describing that the real party in interest is the relationship between a party and a proceeding not the relationship between parties). Finally, the instant Petition is intentionally identical to the Facebook IPR previous petition as it seeks joinder on the same grounds instituted therein. There is no "redundancy" or "multiple bites of the apple" as Patent Owner alleges. Indeed, joined cases avoid the multiplicity that Patent Owner criticizes. Accordingly, we decline Patent Owner's request to deny the Petition based on the proffered procedural arguments.

We have reviewed the Preliminary Response and find that the remaining arguments were presented and that we considered them in connection with the Facebook 1667 IPR. In view of the identicalness of the issues in the instant Petition and in the Facebook 1667 IPR and the

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[6] For example, Patent Owner does not allege any prejudice sufficient to consider the alleged deficiencies worthy of redress via denial of the Petition.

already-considered arguments from Patent Owner proffered in the Facebook 1667 IPR, we institute *inter partes* review in this proceeding on the grounds presented in the Petition for the same reasons stated in our Decision on Institution in the Facebook 1667 IPR.

IV. GRANT OF MOTION FOR JOINDER

Joinder in *inter partes* review is subject to the provisions of 35 U.S.C. § 315(c):

> (c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter parties review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See* Frequently Asked Question H5, https://www.uspto.gov/patents-application-process/appealing-patent-decisions/trials/patent-review-processing-system-prps-0.

Petitioner asserts it has grounds for standing because, in accordance with 35 U.S.C. § 315(c), Petitioner filed a motion for joinder concurrently with the Petition and not later than one month after institution of the Facebook 1667 IPR. Mot. 1. Patent Owner did not file an opposition to the Motion for Joinder. We find that the Motion for Joinder is timely. We also find that Petitioner has met its burden of showing that joinder is appropriate.

For the challenged claims, the Petition here is substantively identical to the petition in the Facebook 1667 IPR. *Id.* at 5–7; Pet. 6. The evidence also is identical, including reliance on the same Lavian Declaration. Mot. 1–2, 5, 7.

Petitioner further has shown that the trial schedule will not be affected by joinder. Mot. 5–6. No changes in the schedule are anticipated or necessary, and the limited participation, if at all, of Petitioner will not impact the timeline of the ongoing trial.

Going forward, Petitioner shall adhere to the existing schedule of IPR2017-01667 and the "second-chair" role it has agreed to assume. *Id.* More specifically, so long as any Facebook 1667 Petitioner entity is a party to IPR2017-01667, all filings of Petitioner in IPR2017-01667 shall be consolidated with the filings of the Facebook 1667 Petitioner. The page limits set forth in 37 C.F.R. § 42.24 will apply to all consolidated filings.

Petitioner shall be bound by any discovery agreements between Patent Owner and the Facebook 1667 Petitioner in IPR2017-01667, and shall not seek any additional discovery. Patent Owner shall not be required to provide any additional discovery or deposition time as a result of joinder. In addition, if an oral hearing is requested and scheduled, Petitioners in IPR2017-01667 shall collectively designate attorneys to present at the oral hearing in a consolidated argument.

The Board expects Petitioner to attempt to resolve any disputes among the entities involved and to contact the Board only if such matters cannot be resolved. This arrangement promotes the just and efficient administration of the ongoing trial and the interests of Petitioner and Patent Owner.

V. ORDER

In view of the foregoing, it is

ORDERED that an *inter partes* review is instituted as to claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 of the '622 patent on the following grounds:

(1) Claims 3, 6–8, 10, 11, 13, 18–21, 23, 27, 32–35, and 38 under 35 U.S.C. § 103(a) as unpatentable over Zydney and Shinder,

(2) Claims 14–17 and 28–31 under 35 U.S.C. § 103(a) as unpatentable over Zydney, Shinder, and Clark, and

(3) Claims 22 and 39 under 35 U.S.C. § 103(a) as unpatentable over Zydney, Shinder, and Appelman;

FURTHER ORDERED that Petitioner's Motion for Joinder with IPR2017-01667 is *granted*, and Huawei and LG are hereby joined as petitioners in IPR2017-01667;

FURTHER ORDERED that IPR2017-02090 is terminated under 37 C.F.R. § 42.72 and all future filings are to be made only in IPR2017-01667;

FURTHER ORDERED that the grounds on which *inter partes* review was instituted in Case IPR2017-01667 remain unchanged, and no other grounds are instituted in the joined proceedings;

FURTHER ORDERED that Petitioner here (i.e., Huawei and LG) will be bound in IPR2017-01667 by all substantive and procedural filings and representations of current Petitioner in IPR2017-01667 (i.e., Facebook and WhatsApp), without a separate opportunity to be heard, whether orally or in writing, unless and until the proceeding is terminated with respect to Facebook and WhatsApp;

FURTHER ORDERED that Petitioner here is bound by any discovery agreements between Patent Owner and the current Petitioner in IPR2017-01667, and that Petitioner here shall not seek any additional discovery;

FURTHER ORDERED that the Scheduling Order entered in IPR2017-01667 shall remain in effect and govern the proceeding, subject to any schedule changes agreed to by the parties in IPR2017-01667 pursuant to the Scheduling Order;

FURTHER ORDERED that the Petitioner entities in IPR2017-01667 shall collectively designate attorneys to present at the oral hearing in a consolidated argument;

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2017-01667; and

FURTHER ORDERED that the case caption in IPR2017-01667, from now on, shall reflect joinder of Huawei and LG as parties in accordance with the attached example.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

UNILOC LUXEMBOURG S.A.
Patent Owner.

Case IPR2017-01667[7]
Patent 8,724,622 B2

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[7] Huawei Device Co., Ltd. and LG Electronics, Inc., which filed a petition in Case IPR2017-02090, have been joined as petitioners in this proceeding.

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Paper No. 8
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SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01797
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge.*

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

I. INTRODUCTION

Samsung Electronics America, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 3, 4, 6–8, 10–13, 18, 21–23, 27, 32, 34, 35, 38, and 39 of U.S. Patent No. 8,724,622 B2 (Ex. 1001, "the '622 patent"). Pet. 1. Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

We have authority to determine whether to institute *inter partes* review under 35 U.S.C. § 314. Upon considering the record developed thus far, for reasons discussed below, we institute *inter partes* review as to all challenged claims.

II. BACKGROUND

A. Related Matters

The parties indicate that the '622 patent is involved in *Uniloc USA, Inc. v. Samsung Electronics America, Inc.*, No. 2:16-cv-00642-JRG (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern District of Texas. Pet. 1–3; Paper 3, 2.

Concurrently with the instant Petition, Petitioner additionally filed a petition requesting *inter partes* review of claims 14–17, 19, 24–26, 28–31, and 33 of the '622 patent (Case IPR2017-01798). IPR2017-01798, Paper 1. The '622 patent also has been the subject of four earlier requests for *inter partes* review—two filed by Apple Inc. ("Apple") (Cases IPR2017-00223 and IPR2017-00224) and two filed by Facebook Inc. and WhatsApp Inc. (Cases IPR2017-01667 and IPR2017-01668)—as well as later requests filed by Apple (Cases IPR2017-01804 and IPR2017-01805), Google Inc. (Cases IPR2017-02080 and IPR2017-02081), and Huawei Device Co., Ltd. (Case IPR2017-02090).

B. Overview of 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.

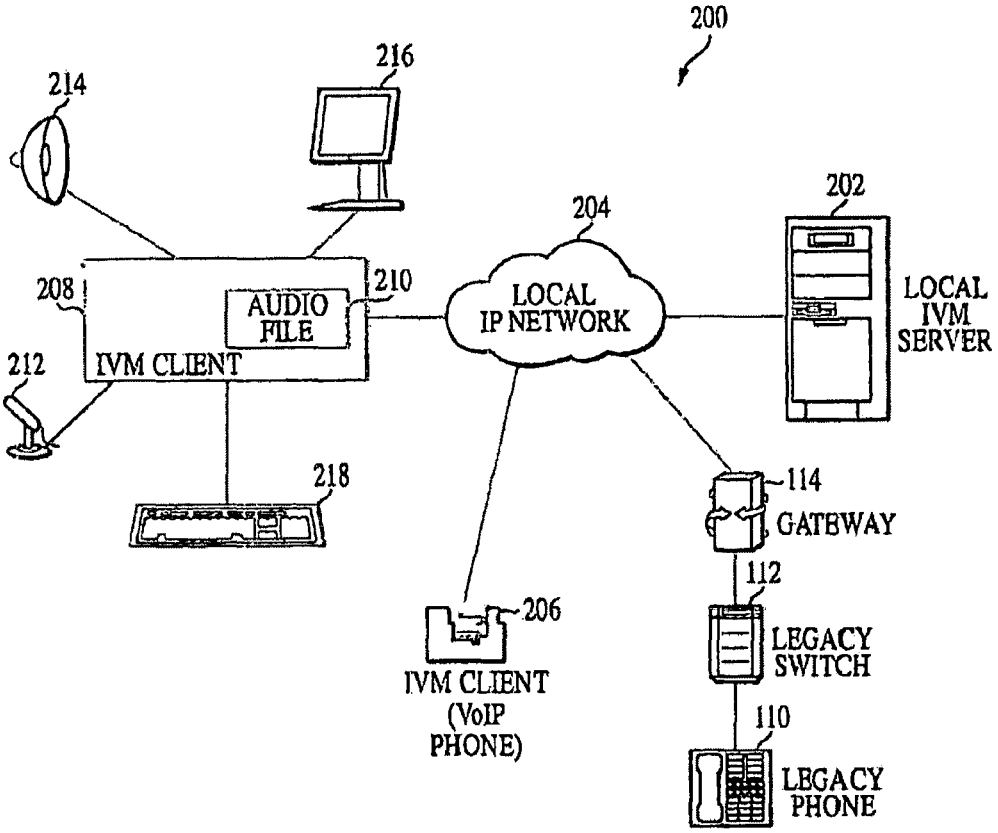

FIG. 2

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., instant voice message)." *Id.* at 8:4–10.

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.

C. Illustrative Claims

Of the challenged claims, claims 3, 27, and 38 are independent. Claims 3 and 27 are illustrative of the challenged claims and are reproduced below.

3. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,
   wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and
   wherein the instant voice message includes an object field including a digitized audio file.

27. A system comprising:
a client device;
a network interface coupled to the client device and connecting the client device to a packet-switched network; and
an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,
wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message.

Ex. 1001, 24:12–27, 26:17–30.

D. Asserted Ground of Unpatentability

Petitioner asserts three grounds of unpatentability (Pet. 6–7):

Challenged Claim(s)	Basis	References
3, 4, 6–8, 10, 11, 13, 18, 21–23, 27, 32, 34, 35, 38, 39	§ 103(a)	Griffin[1] and Zydney[2]
12	§ 103(a)	Griffin, Zydney, and Aravamudan[3]
11	§ 103(a)	Griffin, Zydney, and Vuori[4]

Petitioner also relies on a Declaration of Zygmunt J. Haas, Ph.D., filed as Exhibit 1002.

[1] Griffin et al., US 8,150,922 B2, issued April 3, 2012 (Ex. 1005).

[2] Zydney et al., WO 01/11824 A2, published February 15, 2001 (Ex. 1006).

[3] Aravamudan et al., US 6,301,609 B1, issued October 9, 2001 (Ex. 1009).

[4] Vuori, US 2002/0146097 A1, published October 10, 2002 (Ex. 1015).

III. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim construction standard to be applied in an *inter partes* review proceeding). Under the broadest reasonable interpretation standard, claim terms generally are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We note that only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Petitioner contends that the Board need not construe the challenged claims for resolution of the controversy in this case and that the challenged claims should be given their plain and ordinary meaning under the broadest reasonable interpretation standard. Pet. 8–9. Neither Petitioner nor Patent Owner proposes a construction for any claim term at this time. We agree with Petitioner that no terms require express construction for purposes of this Decision.

B. Analysis of Asserted Grounds of Unpatentability

1. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art;[5] and (4) objective evidence of

[5] Citing Dr. Haas's testimony, Petitioner proposes an assessment of the level of skill in the art with respect to the '622 patent, contending that "[a] person of ordinary skill in the art at the time of the alleged invention of the '622 Patent ('POSA') would have had at least a bachelor's degree in computer science, computer engineering, electrical engineering, or the equivalent and at least two years of experience in the relevant field, e.g., network communication systems," and that "[m]ore education can substitute for practical experience and vice versa." Pet. 8 (citing Ex. 1002 ¶¶ 15–16). Although Patent Owner does not respond to this assessment or propose an alternative assessment in the Preliminary Response, we note that Patent Owner's expert William C. Easttom II offers a similar assessment in his declaration testimony in this case, opining that a person having ordinary skill in the art "would be someone with a baccalaureate degree related to computer technology and 2 years of experience with network communications technology, or 4 years of experience without a baccalaureate degree." Ex. 2001 (Easttom Declaration) ¶ 17. For purposes of this Decision and to the extent necessary, we adopt Petitioner's assessment.

nonobviousness, i.e., secondary considerations.[6] *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). "To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). We analyze the asserted grounds with the principles stated above in mind.

2. *Overview of Asserted Prior Art*

a. *Griffin*

Griffin, titled "Voice and Text Group Chat Display Management Techniques for Wireless Mobile Terminals," relates to a technique of managing the display of "real-time speech and text conversations (e.g., chat threads) on limited display areas." Ex. 1005, [54], 1:9–11. Griffin discloses a wireless mobile terminal as shown in Figure 1, reproduced below.

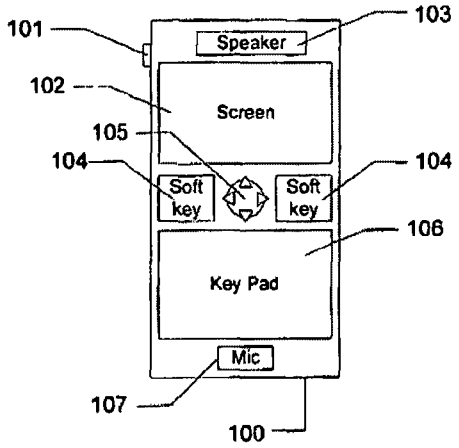

FIG. 1

[6] Patent Owner does not contend in its Preliminary Response that such secondary considerations are present.

Figure 1, above, depicts mobile terminal 100 comprising speaker 103, which renders signals such as received speech audible; display 102 for rendering text and graphical elements visible; navigation rocker 105, which allows a user to navigate a list or menu displayed on the screen; microphone 107, for capturing the user's speech; and push-to-talk button 101, which allows the user to initiate recording and transmission of audio. *Id.* at 3:14–30. Griffin also describes, in connection with Figure 2, reproduced below, the overall system architecture of a wireless communication system where the mobile terminals communicate with a chat server complex. *Id.* at 3:49–51.

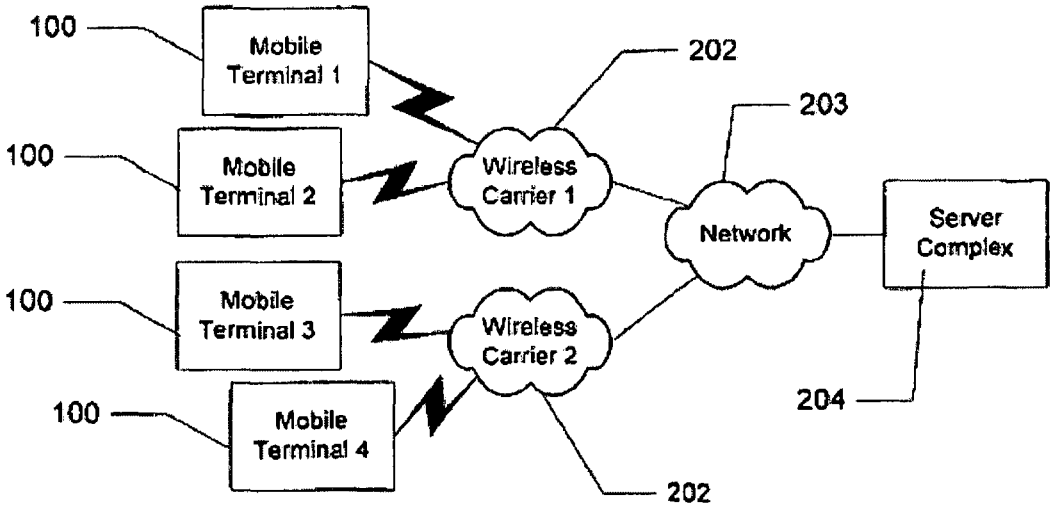

FIG. 2

Figure 2, above, illustrates wireless carrier infrastructures 202, which support wireless communications with mobile terminals 100, such that the mobile terminals wirelessly transmit data to a corresponding infrastructure 202 for sending the data packets to communication network 203, which forwards the packets to chat server complex 204. *Id.* at 3:49–61.

Communication network 203 is described as a "packet-based network, [which] may comprise a public network such as the Internet or World Wide Web, a private network such as a corporate intranet, or some combination of public and private network elements." *Id.* at 3:61–65.

Griffin's chat server complex 204 receives encoded data comprising text, speech, and/or graphical messages (or some combination thereof), when a plurality of users chat together (i.e., send chat messages from one terminal 100 to another). *Id.* at 4:11–15; 4:62–65. An outbound chat message, for example, is decomposed to locate the list of recipients, and the recipient's current status is determined. *Id.* at 5:9–15. Griffin describes presence status 702 as "an indicator of whether the recipient is ready to receive the particular type of message, speech and/or text messages only, etc.)." *Id.* "When presence status 702 changes, the presence manager 302 [of server complex 204] sends a buddy list update message 600 to all the subscribers listed in the subscriber identifier field 706 of the corresponding presence record 700." *Id.* at 5:27–30.

Figure 4 of Griffin is reproduced below.

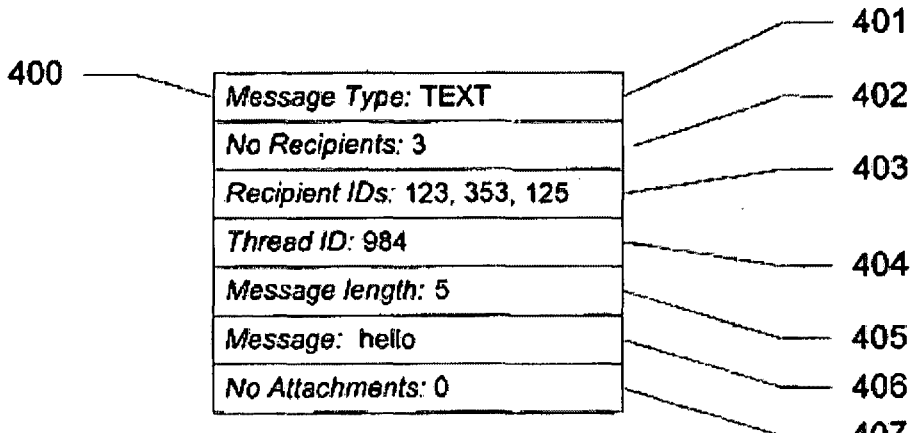

FIG. 4

Figure 4, above, is a schematic illustration of an outbound text message 400 sent by terminal 100 in accordance with Griffin's invention. *Id.* at 2:51–52, 6:38–39. As shown in Figure 4, outbound chat message 400 includes, among other fields, fields for message type 401 and message content 406. *Id.* at 6:39–44.

Griffin provides a buddy list display illustrated in Figure 9, reproduced below. *Id.* at 8:15–16.

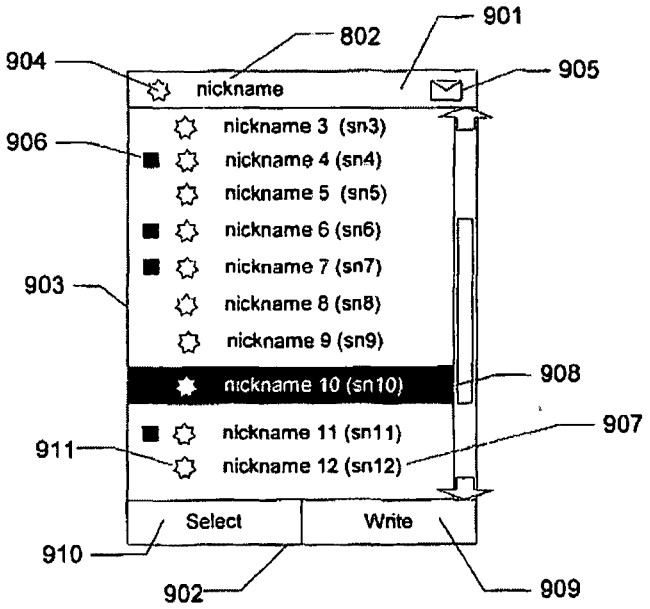

FIG. 9

Figure 9, above, depicts title bar 901, where inbound chat message indicator 905 is an icon accompanied by an audible sound when the icon is first displayed, indicating to the user that there is at least one unheard or unread inbound chat message that has arrived at terminal 100. *Id.* at 8:17–18, 8:28–32. Left softkey 910 labeled "Select" permits selection of a particular buddy for chatting, selection of which is indicated with selection indicator 906. *Id.* at 8:45–52, 8:60–67, 9:1–5. "If the user pushes-to-talk,

the display switches to the chat history, and the user is able to record and transmit a speech message and consequently start a new thread with the selected buddies." *Id.* at 9:27–31.

b. Zydney

Zydney, titled "Method and System for Voice Exchange and Voice Distribution," relates to packet communication systems that provide for voice exchange and voice distribution between users of computer networks. Ex. 1006, [54], [57], 1:4–5. While acknowledging that e-mail and instant messaging systems were well-known text-based communication systems utilized by users of online services and that it was possible to attach files for the transfer of non-text formats via those systems, Zydney states that the latter technique "lack[ed] a method for convenient recording, storing, exchanging, responding and listening to voices between one or more parties, independent of whether or not they are logged in to their network." *Id.* at 1:7–17. Zydney thus describes a method in which "voice containers"—i.e., "container object[s] that . . . contain[] voice data or voice data and voice data properties"—can be "stored, transcoded and routed to the appropriate recipients instantaneously or stored for later delivery." *Id.* at 1:19–22, 12:6–8. Figure 1 of Zydney is reproduced below.

FIG. 1

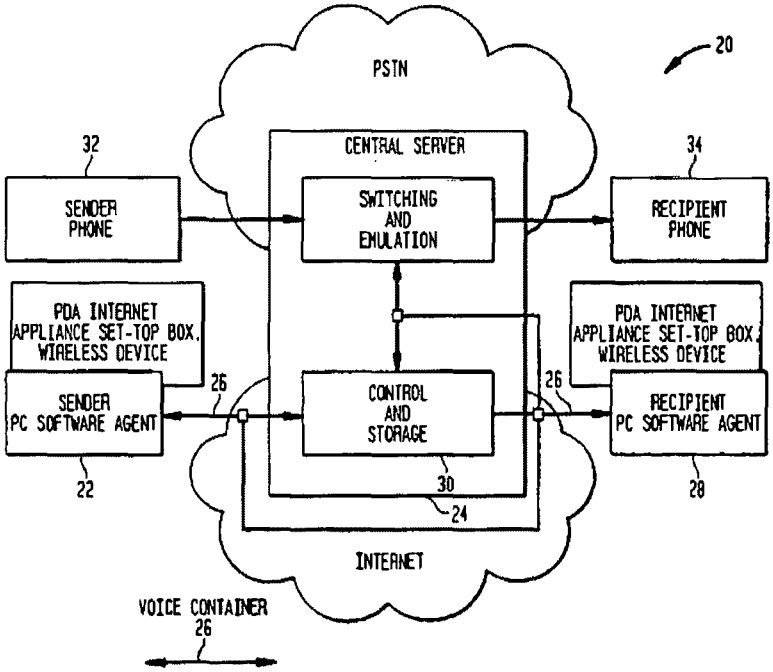

Figure 1, above, illustrates a high-level functional block diagram of Zydney's system for voice exchange and voice distribution. *Id.* at 10:19–20. Referring to Figure 1, system 20 allows software agent 22, with a user interface, in conjunction with central server 24 to send messages using voice containers illustrated by transmission line 26 to another software agent 28, as well as to receive and store such messages, in a "pack and send" mode of operation. *Id.* at 10:20–11:1. Zydney explains that a pack and send mode of operation "is one in which the message is first acquired, compressed and then stored in a voice container 26 which is then sent to its destination(s)." *Id.* at 11:1–3. The system has the ability to store messages both locally and centrally at server 24 whenever the recipient is not available for a prescribed period of time. *Id.* at 11:3–6.

In the use of Zydney's system and method, the message originator selects one or more intended recipients from a list of names that have been previously entered into the software agent. Ex. 1006, 14:17–19. The agent permits distinct modes of communication based on the status of the recipient, including the "core states" of whether the recipient is online or offline and "related status information" such as whether the recipient does not want to be disturbed. *Id.* at 14:19–15:1. Considering the core states, the software agent offers the originator alternative ways to communicate with the recipient, the choice of which can be either dictated by the originator or automatically selected by the software agent, according to stored rules. *Id.* at 15:3–6. If the recipient is online, the originator can either begin a real-time "intercom" call, which simulates a telephone call, or a voice instant messaging session, which allows for an interruptible conversation. *Id.* at 15:8–10. If the recipient is offline, the originator can either begin a voice mail conversation that will be delivered the next time the recipient logs in or can be delivered to the recipient's e-mail as a digitally encoded Multipurpose Internet Mail Extension ("MIME") attachment. *Id.* at 15:15–17. Zydney explains that the choice of the online modes "depends on the activities of both parties, the intended length of conversation and the quality of the communications path between the two individuals, which is generally not controlled by either party," and that the choice of the offline delivery options "is based on the interests of both parties and whether the recipient is sufficiently mobile that access to the registered computer is not always available." *Id.* at 15:10–14, 15:17–19.

Once the delivery mode has been selected, the originator digitally records messages for one or more recipients using a microphone-equipped

device and the software agent. Ex. 1006, 16:1–3. The software agent compresses the voice and stores the file temporarily on the PC if the voice will be delivered as an entire message. *Id.* at 16:3–4. If the real-time "intercom" mode has been invoked, a small portion of the digitized voice is stored to account for the requirements of the Internet protocols for retransmission and then transmitted before the entire conversation has been completed. *Id.* at 16:4–7. Based on status information received from the central server, the agent then decides whether to transport the voice container to a central file system and/or to send it directly to another software agent using the IP address previously stored in the software agent. *Id.* at 16:7–10. If the intended recipient has a compatible active software agent online after log on, the central server downloads the voice recording almost immediately to the recipient. *Id.* at 16:10–12. The voice is uncompressed and the recipient can hear the recording through the speakers or headset attached to its computer. *Id.* at 16:12–14. The recipient can reply in a complementary way, allowing for near real-time communications. *Id.* at 16:14–15. If the recipient's software agent is not online, the voice recording is stored in the central server until the recipient's software agent is active. *Id.* at 16:15–17. "In both cases, the user is automatically notified of available messages once the voice recordings have been downloaded to storage on their computer." *Id.* at 16:17–19. The central server coordinates with software agents on all computers continuously, updating addresses, uploading and downloading files, and selectively retaining voice recordings in central storage. *Id.* at 16:19–21.

Zydney discloses that the voice container also has the ability to have other data types attached to it. Ex. 1006, 19:6–7. Formatting the container

using MIME format, for example, "allows non-textual messages and multipart message bodies attachments [sic] to be specified in the message headers." *Id.* at 19:7–10.

Figure 3 of Zydney is reproduced below.

FIG. 3

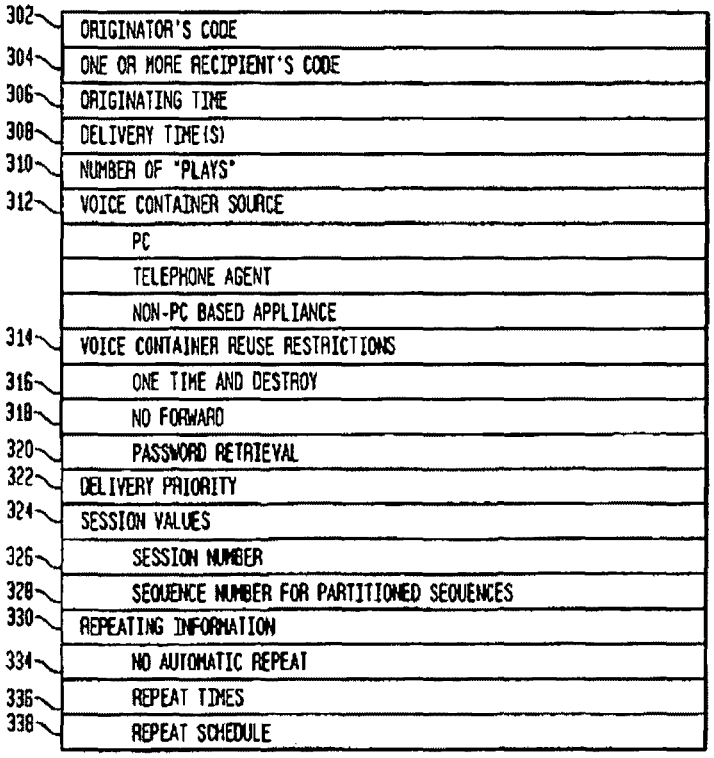

Figure 3, above, illustrates an exemplary embodiment of Zydney's voice container structure, including voice data and voice data properties components. Ex. 1003, 2:19, 23:1–2. Referring to Figure 3, voice container components include:

> [O]riginator's code 302 (which is a unique identifier), one or more recipient's code 304, originating time 306, delivery time(s) 308, number of "plays" 310, voice container source 312 which may be a PC, telephone agent, non-PC based appliance, or other, voice container reuse restrictions 314 which may include one time and destroy 316, no forward 318, password

> retrieval 320, delivery priority 322, session values 324, session number 326, sequence number for partitioned sequences[] 328, repeating information 330, no automatic repeat 332, repeat times 334, and a repeat schedule 336.

Id. at 23:2–10.

c. Aravamudan

Aravamudan, titled "Assignable Associate Priorities for User-Definable Instant Messaging Buddy Groups," describes an instant messaging services platform in which a user is able to define rules for responding to received data and communications. Ex. 1009, [54], [57]. Figure 1 of Aravamudan is reproduced below.

FIG. 1

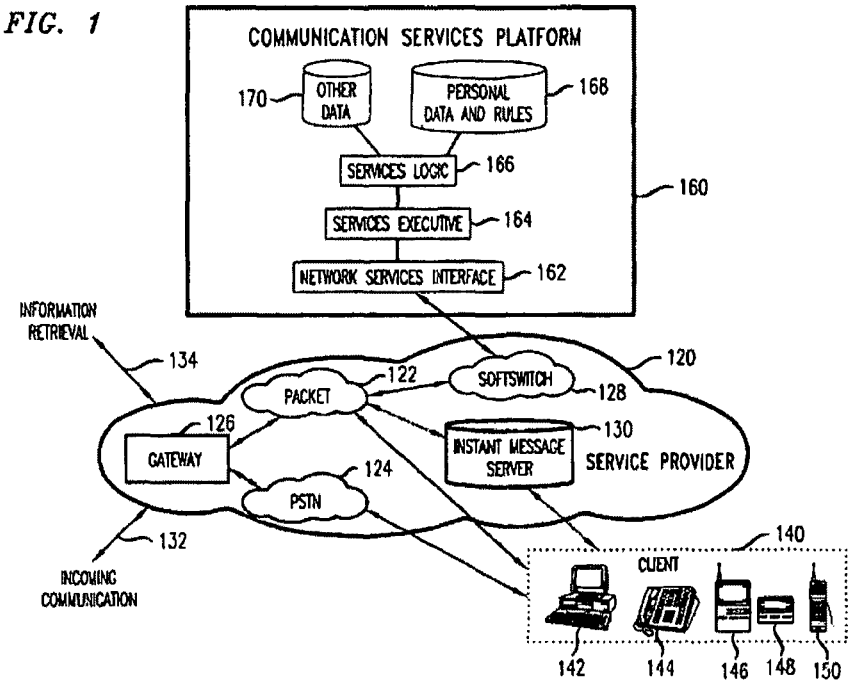

Figure 1, above, is a block diagram illustrating an exemplary architectural configuration of Aravamudan. *Id.* at 2:55–58. With reference to Figure 1, communications services platform 160 comprises a number of client devices 140 connected to instant message ("IM") server 130. *Id.*

at 4:59–64. Each client device's connection status (e.g., online/offline) is maintained on a database located on platform 160. *Id.* at 8:5–10.

Figure 7 of Aravamudan is reproduced below.

FIG. 7

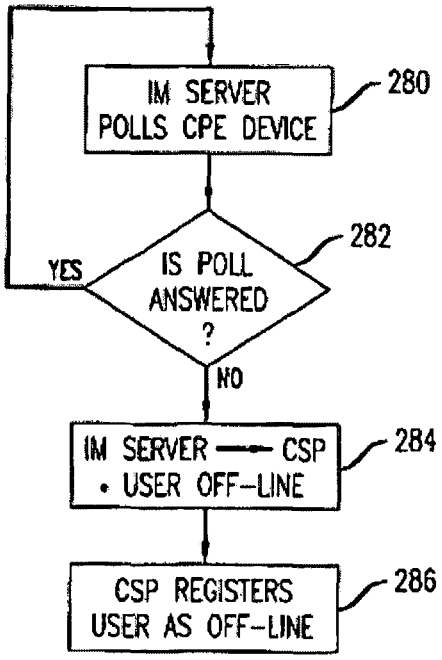

Figure 7, above, is a flow diagram of an exemplary method utilized to determine termination of a network session and update a Communication Services Platform (CSP) in accordance with Aravamudan's invention. *Id.* at 3:10–13. Specifically, to determine whether a user is online, IM server 130 periodically polls each client device 140. *Id.* at 8:5–19, Fig. 7 (step 280). If a user is online, the user's client device 140 returns a response. *Id.* at 8:19–21; Fig. 7 (step 282). If no response is returned, IM server 130 determines that client device 140 is offline and updates the

database to reflect the offline status of the device. *Id.* at 8:21–31, Fig. 7 (steps 284, 286).

d. Vuori

Vuori, titled "Short Voice Message (SVM) Service Method, Apparatus and System," discloses a method for sending voice-type short messages using an SVM service. Ex. 1015, [54], [57], ¶ 31. Vuori teaches that SVMs are "recorded in the sending terminal and sent to a[n] SVM service center (SVMSC)," and a "second terminal may then commence a bidirectional communication so that an instant voice message session can be established." *Id.* at [57].

In one embodiment, a user initiates a short voice message by pressing a menu key on a user equipment, which prepares to receive the message and may emit a sound to alert the user to commence speaking. *Id.* ¶ 32, Figs. 1–2. The user equipment then receives and stores the short voice message. *Id.* Next, the user "select[s] one or more intended recipients" and initiates the transfer. *Id.* ¶ 33. The short voice message is then sent to the SVMSC, which "check[s]" and "determines the availability of the one or more intended recipients." *Id.* ¶¶ 34, 50; *see id.* ¶ 37. The SVMSC sends the short voice message "immediately to the intended recipients who are available." *Id.* ¶ 34; *see id.* ¶ 50. For recipients who are not available, however, the SVMSC "temporarily stor[es]" the message and "continue[s] attempting to send [the message] . . . until the[recipients] become available or until a time out occurs." *Id.* ¶¶ 34, 51. Upon delivery of the short voice message, the recipient may play back the message. *Id.* ¶ 35, Figs. 1–2.

Vuori teaches that the SVM service may be carried out in a Global System for Mobile communications ("GSM") network as shown in Figure 3, reproduced below. *Id.* ¶ 37.

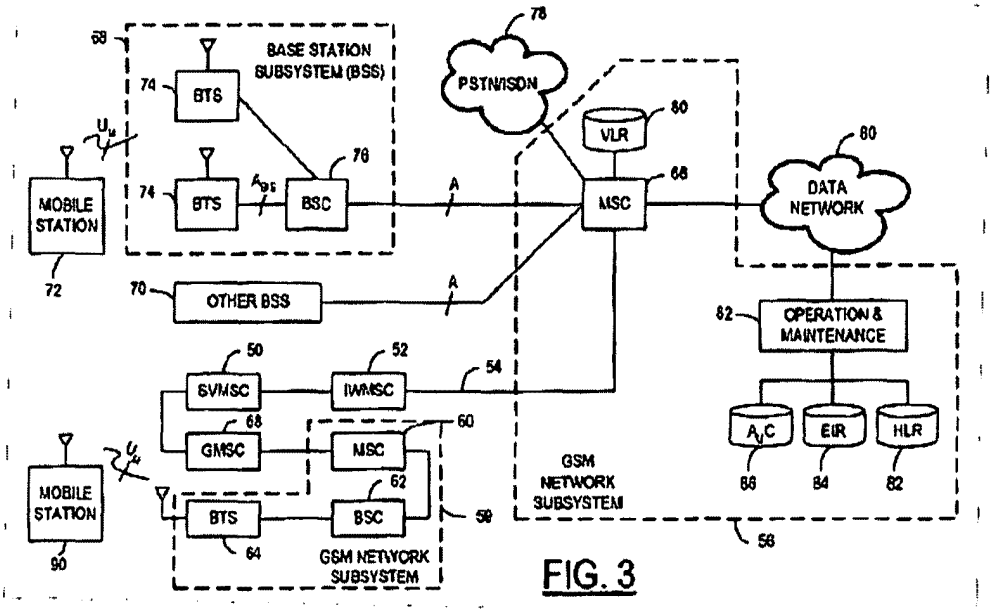

FIG. 3

Figure 3 of Vuori

In Figure 3, SVMSC 50 is shown along with interworking mobile switching center ("MSC") 52 connected by line 54 to GSM Network Subsystem 56. *Id.* Gateway 58 is provided for interworking between SVMSC 50 and MSC 58 of another GSM network 59. *Id.* Vuori explains that GSM Network Subsystem 56 also includes MSC 66 connected to a base station subsystem ("BSS") 68 as well as other base station subsystems 70 for communication with a plurality of mobile stations, but that only one mobile station 72 is shown in Figure 3. *Id.* According to Vuori, MSC 66 is also connected to public switched telephone network ("PSTN")/Integrated Services Digital Network ("ISDN") network 78 for allowing mobile stations to communicate with wired telephone sets in a circuit-switched manner, as

well as to a plurality of databases that may in turn be connected directly to MSC 66 or via data network 80 and operation and maintenance center 82. *Id.*

3. Arguments and Analysis

Petitioner contends Griffin discloses all limitations of independent claims 3, 27, and 38, with the exception of "a communication platform system maintaining connection information . . . indicating whether there is a current connection to each of the plurality of instant voice message client systems" and the instant voice message including an object field "including a digitized audio file," as recited in claim 3, and "a document handler system for attaching one or more files to the instant voice message," as recited in claim 27, for which limitations Petitioner relies on the combined teachings of Griffin and Zydney.[7] Pet. 9–30, 61–67, 70–71. Petitioner supports its arguments, including reasons that a person of ordinary skill in the art would have combined the teachings of Griffin and Zydney, with Dr. Haas's testimony.

We have reviewed the Petition and the evidence cited in support thereof and are persuaded that, at this juncture, Petitioner has established a reasonable likelihood of prevailing in its contention that claims 3, 4, 6–8, 10, 11, 13, 18, 21–23, 27, 42, 34, 35, 38, and 39 of the '622 patent are unpatentable as obvious over Griffin and Zydney; that claim 12 of the '622 is unpatentable as obvious over Griffin, Zydney, and Aravamudan; and that

[7] Petitioner also relies on Zydney's disclosure of agents 22, 28 and server 24 as being "directly connected to a packet-switched network (e.g., Internet)," as an alternative in the event claims 3, 27, and 38 were to be construed to require a "direct" connection to a packet-switched network. Pet. 12–16.

claim 11 would be unpatentable as obvious over Griffin, Zydney, and Vuori if not obvious over Griffin and Zydney alone. Patent Owner's arguments presented on the current record have not persuaded us to the contrary. Specifically, Patent Owner has not persuaded us that the following arguments are supported by facts sufficient to overcome the evidence presented in the Petition:

i. Griffin does not disclose an "instant voice message," as recited in claims 3, 27, and 38 (Prelim. Resp. 24–30);

ii. Griffin and Zydney do not disclose a "network interface" connected to a "packet-switched network," as recited in claims 3, 27, and 38 (Prelim. Resp. 30–36);

iii. Griffin and Zydney do not render obvious "wherein the instant voice message includes an object field including a digitized audio file," as recited in claim 3 (*id.* at 37–41);

iv. Griffin and Zydney do not render obvious "wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message," as recited in claim 27 (*id.* at 41–44) and

v. Griffin would not have been combined with Zydney (*id.* at 44–59).

We address these arguments in turn below.

i

With regard to the "instant voice message" argument, Patent Owner focuses on whether Griffin's disclosures are for "text messages" and whether speech chat messages are in "real-time." *Id.* at 26–27. On this record, none of these arguments overcome the express disclosure in Griffin of "managing the display of a plurality of *real-time speech* and text

conversations (e.g., chat threads) on limited display areas." Ex. 1005, 1:9–11 (emphasis added). Further, Griffin describes both inbound and outbound *messages* as either text or speech. *Id.* at 6:39–41, 11:48–50. Additionally, although Griffin describes "queuing" an inbound speech message, Griffin explains that the message is nevertheless received at the terminal, and the queuing is only for automatic playback. *Id.* at 11:50–67. In other words, with the evidence available, we do not agree with Patent Owner's characterization of Griffin as indicating that a terminal is configured to "receive a message at some point in the future." *See* Prelim. Resp. 29–30 (arguing that "available" status does not result in the terminal receiving the message because of "queuing"). Consequently, we are not persuaded by Patent Owner's arguments that Griffin's speech chats do not disclose instant voice messages.

ii

Patent Owner's argument that Griffin does not disclose a network interface connected to a packet-switched network, premised on the contention that Griffin "illustrates a system in which each terminal includes a network interface that is the point of interconnection between the terminal and the wireless carrier infrastructure," where that "wireless carrier infrastructure" is not a packet-switched network (Prelim. Resp. 31–33), is also unpersuasive. As Petitioner points out, the challenged claims recite that the claimed network interface must be "connected" to a packet-switched network" but do not recite that it must be "directly connected." Pet. 12–13 (citing Ex. 1002 ¶ 105). On the record before us, we are persuaded that Griffin discloses a network interface through which Griffin's mobile terminals are connected to a packet-switched network. In particular, as

pointed out by Petitioner and explained in the summary of Griffin in Section III.B.2.a. above, Figure 2 of Griffin describes that all encoded speech messages are delivered through communication network 203, which may be the Internet. Ex. 1005, 3:49–65; Pet. 11. Moreover, whether Griffin teaches the recited "packet-switched network" is an issue of fact where Patent Owner has proffered only testimonial evidence challenging Petitioner's contention that Griffin discloses the limitation. The conflicting testimonial evidence has created a genuine issue of material fact that we do not resolve at this juncture, but instead is viewed "in the light most favorable to the petitioner solely for purposes of deciding whether to institute an *inter partes* review." 37 C.F.R. § 42.108(c). Consequently, Patent Owner's arguments and evidence are not persuasive at this time.

iii

With respect to the disputed claim 3 limitation "wherein the instant voice message includes an object field including a digitized audio file," Petitioner contends that, although Griffin does not expressly disclose that the data contained in field 406 when message 400 is a speech message is a "digitized audio file," it would have been obvious to a person of ordinary skill in the art to modify Griffin to include such a digitized audio file in view of Zydney's teaching, for example, that a client software agent in a sender device generates a voice message by "digitally recording," compressing, and storing the user's speech as an MP3 audio file before packing that audio file into a voice container. Pet. 28–29 (citing Ex. 1002 ¶¶ 150–156; Ex. 1006, 12:6–8, 14:2–5, 16:1–4, 21:15–18, 23:1–11, 39:16). Petitioner points out that Zydney also explains that the voice container can be formatted using the MIME standard, "which 'allows for non-textual messages and multipart

message bodies [sic] attachments to be specified in the message headers.'" *Id.* at 29 (quoting Ex. 1006, 19:7–10) (citing *id.* at 19:13–20:9). Relying on Dr. Haas's testimony, Petitioner contends that, "[i]n view of these teachings and the knowledge of a POSA, a POSA would have been motivated to modify Griffin's system/process such that outbound message 400 ('instant voice message') includes an object field (similar to field 406) having a digital audio file of speech data, similar to as described in Zydney," and that "[a] POSA would have recognized that such a modification would have been nothing more than a simple substitution of one known and commonly-used technology for another (e.g., a digital audio file in place of other forms of data) to achieve [a] predictable result." *Id.* (emphasis omitted) (citing Ex. 1002 ¶¶ 151–153).

Patent Owner responds that Petitioner errs by relying on Zydney's voice container for this limitation, contending that "*Zydney* distinguishes its *voice container* from its *voice message*." Prelim. Resp. 37. Further, Patent Owner contends, Petitioner's "conclusory speculation" that "a person [of ordinary skill in the art] would have been motivated to modify *Griffin's* system/process, so that the speech chat message 400 . . . includes *an object field . . . including a digital audio file of speech data*" "should be rejected for at least . . . six reasons." *Id.* at 38–41 (quoting Ex. 1002 ¶¶ 152–153).

Patent Owner does not persuasively rebut Petitioner's evidence. Specifically, whereas Patent Owner's arguments focus on whether *Zydney's voice container* would be understood to include an object field containing voice data (*see id.* at 37–41), we are sufficiently persuaded at this stage by Petitioner's evidence, including Dr. Haas's testimony, that *Griffin's message data* field 406 teaches the claimed object field, and that it would have been

obvious to a person of ordinary skill in the art at the time of the alleged invention to include a digitized audio file as taught by Zydney in that object field.

iv

Regarding the "document handler system for attaching one or more files to the instant voice message" limitation of claim 27, Petitioner concedes that Griffin does not explicitly describe attaching files to a speech message, but contends that it would have been obvious to a person of ordinary skill in the art to modify Griffin to do so in view of Zydney's teachings of a software agent that operates to address, pack, and send a message in a voice container that may include attachments in addition to a voice message recorded using a microphone. Pet. 65–66 (citing Ex. 1002 ¶¶ 248–251; Ex. 1006, 4:7–9, 10:20–11:3, 14:2–5, 16:1–4, 19:1–20:9, 20:11–14, 21:14–16, 22:19–20, 35:15–22, Figs. 6, 16–18). Relying on Dr. Haas's testimony, Petitioner contends that a person of ordinary skill in the art would have been motivated to modify Griffin's system/process "such that the software (and related components) enables the attachment of files to a speech message (like described in *Zydney*)," because "it would have enhanced the capabilities and convenience of *Griffin*'s system/process by providing users with the ability to collectively send and receive files with a speech message, instead of needing to send the files and message separately," and that a person of ordinary skill "would have recognized that such a modification would have been nothing more than a straightforward combination of known technologies by known methods without changing their respective functions to achieve a predictable result, and would have

been well within the capabilities of such a person." *Id.* at 66 (citing Ex. 1002 ¶¶ 249–250).

In response to Petitioner's contentions, Patent Owner argues that Zydney's teaching of attaching files to a voice container "is inapposite because the claim language requires that the one or more files be attached to the instant voice message *itself*." Prelim. Resp. 42. Patent Owner contends that the '622 patent "repeatedly and consistently states that the 'instant voice message' is recorded in the audio file," whereas Zydney's disclosures "confirm that *Zydney*'s *voice container* and *voice message* are not one and the same." *Id.* Further, Patent Owner alleges, Zydney does not disclose a "document handler system," and "Petitioner does not point to any specific portion of *Zydney* that might be equated with the claimed document handler system; Petitioner simply states that files may be attached to a voice message and this can be obviously combined with Griffin." *Id.* at 43–44.

We are not persuaded by Patent Owner's arguments on the record developed at this stage of the proceeding. Patent Owner's arguments disputing Petitioner's mapping of Zydney's voice container to the claimed instant voice message are premised on an implied construction of "instant voice message" as encompassing *only* the voice message and excluding all else. This is an argument of claim construction that is underdeveloped at this juncture and has been presented only in connection with arguments distinguishing Zydney. On the present record, we do not have sufficient evidence or argument from either party to render even a preliminary construction for the term "instant voice message." Accordingly, at this time, Patent Owner's arguments distinguishing the prior art with regard to the scope of the "instant voice message" are unpersuasive. Similarly, Patent

Owner's arguments disputing Zydney's teaching or suggestion of a "document handler system" are likewise premised on an unstated construction of that term for which the record before us is insufficient to render any determination. The parties will have an opportunity during trial to present fully claim construction briefing for the terms "instant voice message" and "document handler system."

v

Lastly, with regard to the combinability of Griffin and Zydney, Patent Owner contends that such combination would be inoperable (Prelim. Resp. 47–50), would render Zydney inoperable for its intended purpose (*id.* at 50–52), would result in Zydney's messages being lost (*id.* at 52–54), and would require changing the principle of operation of at least one of the two references (*id.* at 54–59). The underlying premise of Patent Owner's arguments is that Zydney is a peer-to-peer system that requires a transmitting device to know that the receiving device is available at the time of communication to communicate speech messages instantaneously, whereas Griffin supports text-only buddies that lack speech messaging capability, and the connectivity status in each reference has a different meaning. Patent Owner contends, for example, that "[a] [t]ext-only buddy connected to [Griffin's] server complex 204 would be considered 'available' as understood by *Zydney* . . . and would therefore be available for selection as a recipient of a speech message," but "*Griffin* does not disclose or even contemplate[] what would happen if a text-only buddy were to be selected to receive a speech message." *Id.* at 48. According to Patent Owner, "connectivity status" in Griffin and Zydney "mean entirely different things," because "*Zydney* requires status to include 'the *core states* of whether the

recipient is online or offline,'" whereas "*Griffin* does not know and does not care whether a recipient is actually online (i.e., whether the recipient currently has the chat history displayed)." *Id.* at 52. Patent Owner characterizes Griffin as delivering the message *only* if the user has the "chat history display" visible on the user interface, and even then only the most recently received speech message is available, whereas Zydney "is concerned with routing *all* messages 'to the appropriate recipients instantaneously or stored for later delivery.'" *Id.* at 50, 52. This discrepancy, Patent Owner reasons, would render Zydney unsatisfactory for its intended purpose and would result in Zydney's messages being lost. *Id.* at 50–53.

We are not persuaded by Patent Owner's arguments. Griffin expressly discloses "managing the display of a plurality of *real-time speech* and text conversations (e.g., chat threads) on limited display areas." Ex. 1005, 1:9–11 (emphasis added). Further, Griffin describes both inbound and outbound *messages* as either text or speech. *Id.* at 6:39–41, 11:48–50. Although Griffin describes "queuing" an inbound speech message, Griffin explains that the message is nevertheless received at the terminal, and the queuing is only for automatic playback. *Id.* at 11:50–67. Accordingly, we do not agree that the record at this time supports Patent Owner's characterization of Griffin's queuing disclosure as meaning that the message is not received at the terminal—the queuing only affects whether the most recently received speech message is *played automatically* upon receipt. The portions of Griffin Patent Owner cites do not support sufficiently the arguments that the terminal does not receive the speech message in real-time or that only the last received speech message is available. Therefore, Patent

Owner's arguments that rest on the characterization of Griffin's queuing as incompatible with Zydney are not persuasive at this time.[8]

In summary, having reviewed the information presented by the parties at this juncture, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claims 3 and 27 are unpatentable over Griffin and Zydney.

Patent Owner does not argue claims 4, 6–8, 10, 11–13, 18, 21–23, 32, 34, 35, 38, and 39 separately from claims 3 and 27. For the same reasons as stated regarding claims 3 and 27, and based on our review of Petitioner's arguments and evidence directed to the additional limitations of those claims, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contentions that claims 4, 6–8, 10, 11, 13, 18, 21–23, 32, 34, 35, 38, and 39 are unpatentable for obviousness over Griffin and Zydney; that claim 11 is also unpatentable over Griffin, Zydney, and Vuori; and that claim 12 is unpatentable for obviousness over Griffin, Zydney, and Aravamudan.

C. Patent Owner's Argument That Inter Partes *Review Proceedings Are Unconstitutional*

Patent Owner contends:

> The Supreme Court is currently considering the constitutionality of *inter partes* review proceedings. *Oil States Energy Servs.,*

[8] We also find unpersuasive the argument that Griffin and Zydney are not combinable for "text-only" buddy situation. Prelim. Resp. 47–50. None of Petitioner's contentions rely on "text-only" buddy features. And Griffin is silent as to how that feature operates, in the event of a speech chat directed to a text-only buddy, even without considering Zydney. Accordingly, the scenario that Patent Owner presents is speculative and is supported only with conclusory declaration testimony that is entitled to little or no weight.

> *LLC v. Greene's Energy Grp., LLC*, 137 S. Ct. 2239 (2017). The constitutional challenge is primarily based on the argument that adversarial challenges to an issued patent—like *inter partes* reviews— are "Suits at common law" for which the Seventh Amendment guarantees a jury trial. U.S. Const. amend. VII; *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996). Further, because patents are private property rights, disputes concerning their validity must be litigated in an Article III court, not before an executive branch agency. *McCormick Harvesting Mach. Co. v. C. Aultman & Co.*, 169 U.S. 606, 609 (1898). Out of an abundance of caution, Patent Owner hereby adopts this constitutional challenge now to preserve the issue pending the Supreme Court's decision.

Prelim. Resp. 59–60.

Although, as Patent Owner notes, the constitutionality of *inter partes* reviews is currently being considered by the Supreme Court, "administrative agencies do not have jurisdiction to decide the constitutionality of congressional enactments," and we are bound by the existing decisions of our reviewing court that have consistently rejected constitutional challenges substantially similar to those raised by Patent Owner. *See MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1288–92 (Fed. Cir. 2015), *cert. denied* 137 S. Ct. 292 (2016)); *Cooper v. Square, Inc.*, 645 F. App'x 1014 (Fed. Cir. 2016), *cert. denied* 137 S. Ct. 475 (2016); *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 639 Fed. App'x 639 (Fed. Cir. 2016); *Riggin v. Office of Senate Fair Emp't Practices*, 61 F.3d 1563, 1569 (Fed. Cir. 1995); *Apple Inc. v. Smartflash LLC*, Case CBM2015-00028, slip op. at 23–24 (PTAB May 26, 2016) (Paper 44); *see also Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1710 (TTAB 1999) ("[T]he Board has no authority . . . to declare provisions of the Trademark

Act unconstitutional."); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1082 n.1 (TTAB 2014).

D. Additional Considered Arguments

Patent Owner has advanced a variety of additional arguments concerning the repeated challenges of unpatentability asserted by other parties. For instance, Patent Owner argues that the Petition is "redundant" in light of the other petitions filed by Petitioner as well as other petitions filed against Patent Owner's patents by other parties. Prelim. Resp. 1–11. Patent Owner also argues that Zydney and Vuori both are duplicative of prior art cited during prosecution, and that should exercise our discretion and deny the petition under 35 U.S.C. § 314(a) and § 325(d). *Id.* at 7 n.4, 11–13, 19–24.

We have considered Patent Owner's arguments and have found they are underdeveloped and unpersuasive, and will not be subject to further substantive discussion. We acknowledge that the instant Petition and the petition in Case IPR2017-01798 together represent a third round of challenges to the '622 patent. Although we understand the purposes of §§ 314(a) and 325(d), vis-à-vis repeated challenges, we also recognize the purpose of the availability of *inter partes* review to parties accused of infringement. And while Zydney has been the basis of grounds presented in a previous petition by a different petitioner, Zydney is not the primary focus of the grounds here; Griffin is. Patent Owner's complaint about the multiple *inter partes* review petitions filed against the '622 patent is not persuasive when the volume appears to be a direct result of its own litigation activity. The discretion to deny petitions is for the panel to wield under

certain conditions, but not in every situation where a Patent Owner complains of repeated challenges against its patents.

IV. CONCLUSION

In summary, based on our review of the arguments and evidence in the Petition and Preliminary Response, we institute *inter partes* review of the challenged claims of the '622 patent on the following grounds:

Ground	Basis	Claims Challenged	Claims Instituted
1	§ 103 Griffin and Zydney	3, 4, 6–8, 10, 11, 13, 18, 21–23, 27, 32, 34, 35, 38, 39	3, 4, 6–8, 10, 11, 13, 18, 21–23, 27, 32, 34, 35, 38, 39
2	§ 103 Griffin, Zydney, and Aravamudan	12	12
3	§ 103 Griffin, Zydney, and Vuori	11	11
Summary		3, 4, 6–8, 10, 11–13, 18, 21–23, 27, 32, 34, 35, 38, 39	3, 4, 6–8, 10, 11–13, 18, 21–23, 27, 32, 34, 35, 38, 39

V. ORDER

Upon consideration of the record before us, it is, therefore,

ORDERED that an *inter partes* review is instituted as to claims 3, 4, 6–8, 10, 11–13, 18, 21–23, 27, 32, 34, 35, 38, and 39 of the '622 patent on the following grounds:

(1) Claims 3, 4, 6–8, 10, 11–13, 18, 21–23, 27, 32, 34, 35, 38, and 39 under 35 U.S.C. § 103(a) as unpatentable over Griffin and Zydney,

(2) Claim 12 under 35 U.S.C. § 103(a) as unpatentable over Griffin, Zydney, and Aravamudan, and

(3) Claim 11 under 35 U.S.C. § 103(a) as unpatentable over Griffin, Zydney, and Vuori;

FURTHER ORDERED that no other grounds are authorized; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), inter partes review of the '622 patent is hereby instituted commencing on the entry date of this Decision, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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Paper No. 8
Entered: February 6, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01798
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge*.

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

I. INTRODUCTION

Samsung Electronics America, Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 14–17, 19, 24–26, 28–31, and 33 of U.S. Patent No. 8,724,622 B2 (Ex. 1001, "the '622 patent"). Pet. 1. Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

We have authority to determine whether to institute *inter partes* review under 35 U.S.C. § 314. Upon considering the record developed thus far, for reasons discussed below, we institute *inter partes* review as to all challenged claims.

II. BACKGROUND

A. Related Matters

The parties indicate that the '622 patent is involved in *Uniloc USA, Inc. v. Samsung Electronics America, Inc.*, No. 2:16-cv-00642-JRG (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern District of Texas. Pet. 1–3; Paper 3, 2.

Concurrently with the instant Petition, Petitioner additionally filed a petition requesting *inter partes* review of claims 3, 4, 6–8, 10–13, 18, 21–23, 27, 32, 34, 35, 38, and 39 of the '622 patent (Case IPR2017-01797). IPR2017-01797, Paper 1. The '622 patent also has been the subject of four earlier requests for *inter partes* review—two filed by Apple Inc. ("Apple") (Cases IPR2017-00223 and IPR2017-00224) and two filed by Facebook Inc. and WhatsApp Inc. (Cases IPR2017-01667 and IPR2017-01668)—as well as later requests filed by Apple (Cases IPR2017-01804 and IPR2017-01805), Google Inc. (Cases IPR2017-02080 and IPR2017-02081), and Huawei Device Co., Ltd. (Case IPR2017-02090).

B. Overview of 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.

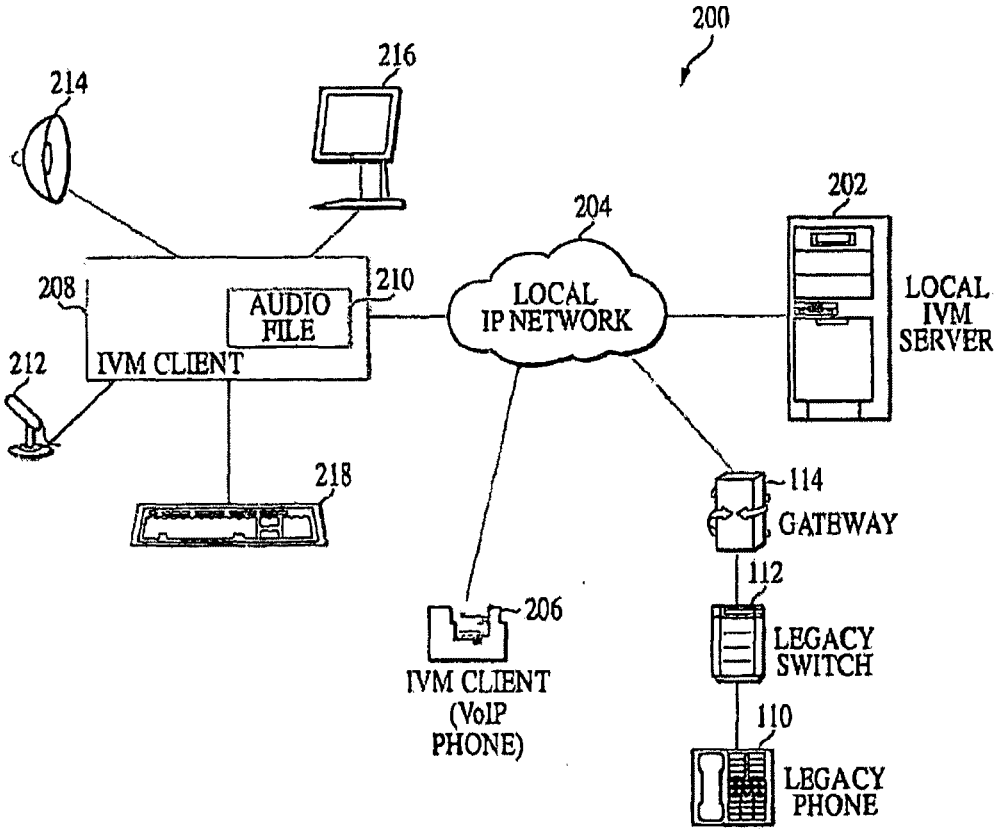

FIG. 2

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., instant voice message)." *Id.* at 8:4–10.

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.

C. Illustrative Claims

Of the challenged claims, only claim 24 is independent. Challenged claims 25 and 26 depend directly from claim 24, and the remaining challenged claims depend directly or indirectly from independent claims 3 and 27, neither of which is challenged in the instant proceeding. Unchallenged claims 3 and 13 and challenged claims 14 and 24 are illustrative and are reproduced below.

3. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,
   wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and

wherein the instant voice message includes an object field including a digitized audio file.

13. The system according to claim 3, wherein each of the instant voice message client systems comprises an instant voice messaging application generating an instant voice message and transmitting the instant voice message over the packet-switched network to the messaging system.

14. The system according to claim 13, 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.

24. A system comprising:

a network interface connected to a packet-switched network; and

a messaging system communicating with a plurality of instant voice message client systems via the network interface; and

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

wherein the messaging system receives connection object messages from the plurality of instant voice message client systems, wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems.

Ex. 1001, 24:12–27, 25:9–18, 25:59–26:8.

D. Asserted Ground of Unpatentability

Petitioner asserts three grounds of unpatentability (Pet. 6–7):

Challenged Claims	Basis	References
14–17, 28–31	§ 103(a)	Griffin,[1] Zydney,[2] and Clark[3]
19, 33	§ 103(a)	Griffin, Zydney, and Väänänen[4]
24–26	§ 103(a)	Griffin, Zydney, and Low[5]

Petitioner also relies on a Declaration of Zygmunt J. Haas, Ph.D., filed as Exhibit 1002.

III. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim construction standard to be applied in an *inter partes* review proceeding). Under the broadest reasonable interpretation standard, claim terms generally are given their ordinary and customary meaning as would be understood by one of

[1] Griffin et al., US 8,150,922 B2, issued April 3, 2012 (Ex. 1005).

[2] Zydney et al., WO 01/11824 A2, published February 15, 2001 (Ex. 1006).

[3] Clark et al., US 6,725,228 B1, issued Apr. 20, 2004 (Ex. 1007).

[4] Väänänen, WO 02/17650 A1, published February 28, 2002 (Ex. 1008).

[5] Low et al., US 2003/0018726 A1, published January 23, 2003 (Ex. 1010).

ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We note that only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Petitioner contends that the Board need not construe the challenged claims for resolution of the controversy in this case and that the challenged claims should be given their plain and ordinary meaning under the broadest reasonable interpretation standard. Pet. 13. Neither Petitioner nor Patent Owner proposes a construction for any claim term at this time. We agree with Petitioner that no terms require express construction for purposes of this Decision.

B. Analysis of Asserted Grounds of Unpatentability

1. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art;

(3) the level of skill in the art;[6] and (4) objective evidence of nonobviousness, i.e., secondary considerations.[7] *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). "To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). We analyze the asserted grounds with the principles stated above in mind.

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[6] Citing Dr. Haas's testimony, Petitioner proposes an assessment of the level of skill in the art with respect to the '622 patent, contending that "[a] person of ordinary skill in the art at the time of the alleged invention of the '622 Patent ('POSA') would have had at least a bachelor's degree in computer science, computer engineering, electrical engineering, or the equivalent and at least two years of experience in the relevant field, e.g., network communication systems," and that "[m]ore education can substitute for practical experience and vice versa." Pet. 8 (citing Ex. 1002 ¶¶ 15–16). Although Patent Owner does not respond to this assessment or propose an alternative assessment in the Preliminary Response, we note that Patent Owner's expert William C. Easttom II offers a similar assessment in his declaration testimony in this case, opining that a person having ordinary skill in the art "would be someone with a baccalaureate degree related to computer technology and 2 years of experience with network communications technology, or 4 years of experience without a baccalaureate degree." Ex. 2001 (Easttom Declaration) ¶ 17. For purposes of this Decision and to the extent necessary, we adopt Petitioner's assessment.

[7] Patent Owner does not contend in its Preliminary Response that such secondary considerations are present.

2. Overview of Asserted Prior Art

a. Griffin

Griffin, titled "Voice and Text Group Chat Display Management Techniques for Wireless Mobile Terminals," relates to a technique of managing the display of "real-time speech and text conversations (e.g., chat threads) on limited display areas." Ex. 1005, [54], 1:9–11. Griffin discloses a wireless mobile terminal as shown in Figure 1, reproduced below.

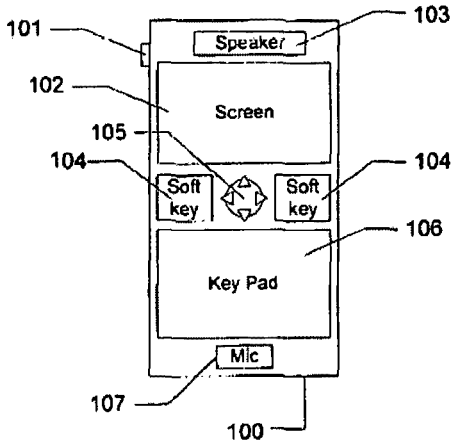

FIG. 1

Figure 1, above, depicts mobile terminal 100 comprising speaker 103, which renders signals such as received speech audible; display 102 for rendering text and graphical elements visible; navigation rocker 105, which allows a user to navigate a list or menu displayed on the screen; microphone 107, for capturing the user's speech; and push-to-talk button 101, which allows the user to initiate recording and transmission of audio. *Id.* at 3:14–30. Griffin also describes, in connection with Figure 2, reproduced below, the overall system architecture of a wireless communication system where the mobile terminals communicate with a chat server complex. *Id.* at 3:49–51.

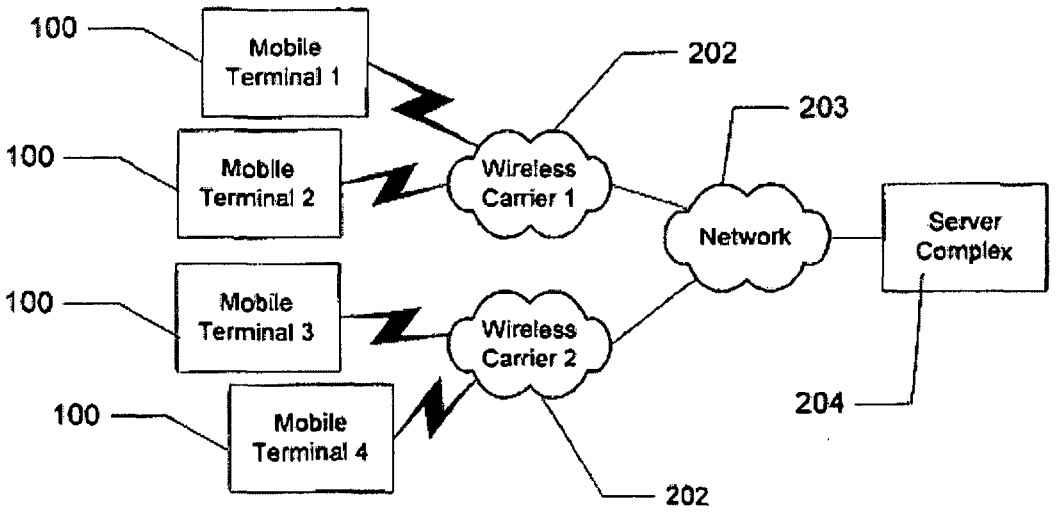

FIG. 2

Figure 2, above, illustrates wireless carrier infrastructures 202, which support wireless communications with mobile terminals 100, such that the mobile terminals wirelessly transmit data to a corresponding infrastructure 202 for sending the data packets to communication network 203, which forwards the packets to chat server complex 204. *Id.* at 3:49–61. Communication network 203 is described as a "packet-based network, [which] may comprise a public network such as the Internet or World Wide Web, a private network such as a corporate intranet, or some combination of public and private network elements." *Id.* at 3:61–65.

Griffin's chat server complex 204 receives encoded data comprising text, speech, and/or graphical messages (or some combination thereof), when a plurality of users chat together (i.e., send chat messages from one terminal 100 to another). *Id.* at 4:11–15; 4:62–65. An outbound chat message, for example, is decomposed to locate the list of recipients, and the recipient's current status is determined. *Id.* at 5:9–15. Griffin describes

presence status 702 as "an indicator of whether the recipient is ready to receive the particular type of message, speech and/or text messages only, etc.)." *Id.* "When presence status 702 changes, the presence manager 302 [of server complex 204] sends a buddy list update message 600 to all the subscribers listed in the subscriber identifier field 706 of the corresponding presence record 700." *Id.* at 5:27–30.

Figure 4 of Griffin is reproduced below.

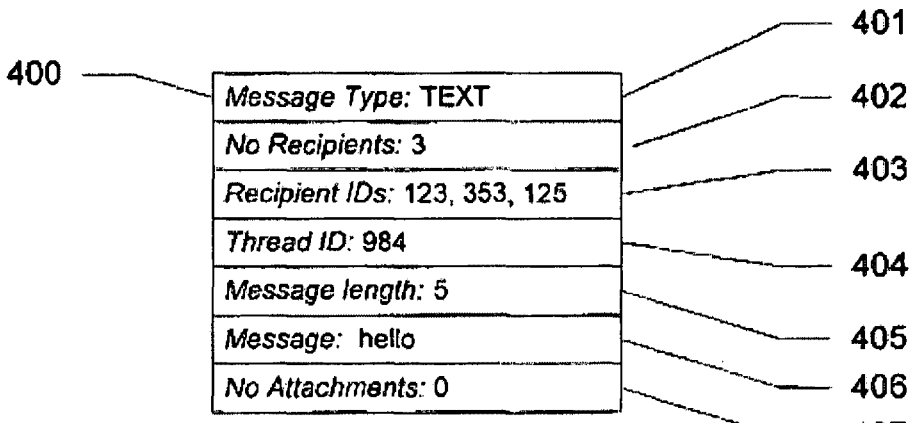

FIG. 4

Figure 4, above, is a schematic illustration of an outbound text message 400 sent by terminal 100 in accordance with Griffin's invention. *Id.* at 2:51–52, 6:38–39. As shown in Figure 4, outbound chat message 400 includes, among other fields, fields for message type 401 and message content 406. *Id.* at 6:39–44.

Griffin provides a buddy list display illustrated in Figure 9, reproduced below. *Id.* at 8:15–16.

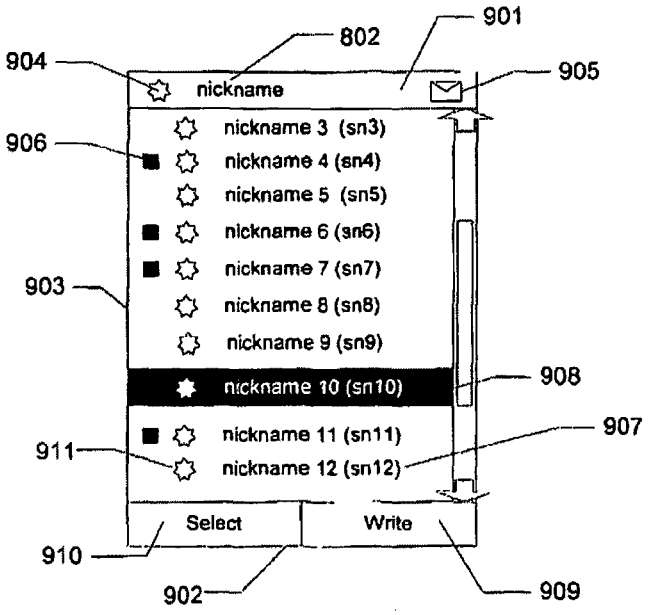

FIG. 9

Figure 9, above, depicts title bar 901, where inbound chat message indicator 905 is an icon accompanied by an audible sound when the icon is first displayed, indicating to the user that there is at least one unheard or unread inbound chat message that has arrived at terminal 100. *Id.* at 8:17–18, 8:28–32. Left softkey 910 labeled "Select" permits selection of a particular buddy for chatting, selection of which is indicated with selection indicator 906. *Id.* at 8:45–52, 8:60–67, 9:1–5. "If the user pushes-to-talk, the display switches to the chat history, and the user is able to record and transmit a speech message and consequently start a new thread with the selected buddies." *Id.* at 9:27–31.

b. Zydney

Zydney, titled "Method and System for Voice Exchange and Voice Distribution," relates to packet communication systems that provide for voice exchange and voice distribution between users of computer networks.

Ex. 1006, [54], [57], 1:4–5. While acknowledging that e-mail and instant messaging systems were well-known text-based communication systems utilized by users of online services and that it was possible to attach files for the transfer of non-text formats via those systems, Zydney states that the latter technique "lack[ed] a method for convenient recording, storing, exchanging, responding and listening to voices between one or more parties, independent of whether or not they are logged in to their network." *Id.* at 1:7–17. Zydney thus describes a method in which "voice containers"—i.e., "container object[s] that . . . contain[] voice data or voice data and voice data properties"—can be "stored, transcoded and routed to the appropriate recipients instantaneously or stored for later delivery." *Id.* at 1:19–22, 12:6–8. Figure 1 of Zydney is reproduced below.

FIG. 1

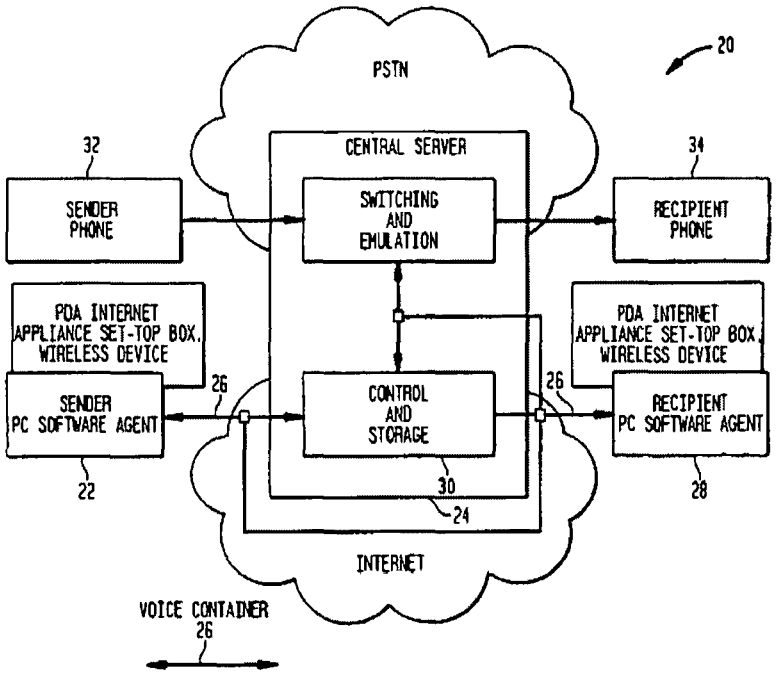

Figure 1, above, illustrates a high-level functional block diagram of Zydney's system for voice exchange and voice distribution. *Id.* at 10:19–20. Referring to Figure 1, system 20 allows software agent 22, with a user interface, in conjunction with central server 24 to send messages using voice containers illustrated by transmission line 26 to another software agent 28, as well as to receive and store such messages, in a "pack and send" mode of operation. *Id.* at 10:20–11:1. Zydney explains that a pack and send mode of operation "is one in which the message is first acquired, compressed and then stored in a voice container 26 which is then sent to its destination(s)." *Id.* at 11:1–3. The system has the ability to store messages both locally and centrally at server 24 whenever the recipient is not available for a prescribed period of time. *Id.* at 11:3–6.

In the use of Zydney's system and method, the message originator selects one or more intended recipients from a list of names that have been previously entered into the software agent. Ex. 1006, 14:17–19. The agent permits distinct modes of communication based on the status of the recipient, including the "core states" of whether the recipient is online or offline and "related status information" such as whether the recipient does not want to be disturbed. *Id.* at 14:19–15:1. Considering the core states, the software agent offers the originator alternative ways to communicate with the recipient, the choice of which can be either dictated by the originator or automatically selected by the software agent, according to stored rules. *Id.* at 15:3–6. If the recipient is online, the originator can either begin a real-time "intercom" call, which simulates a telephone call, or a voice instant messaging session, which allows for an interruptible conversation. *Id.* at 15:8–10. If the recipient is offline, the originator can either begin a voice

mail conversation that will be delivered the next time the recipient logs in or can be delivered to the recipient's e-mail as a digitally encoded Multipurpose Internet Mail Extension ("MIME") attachment. *Id.* at 15:15–17. Zydney explains that the choice of the online modes "depends on the activities of both parties, the intended length of conversation and the quality of the communications path between the two individuals, which is generally not controlled by either party," and that the choice of the offline delivery options "is based on the interests of both parties and whether the recipient is sufficiently mobile that access to the registered computer is not always available." *Id.* at 15:10–14, 15:17–19.

Once the delivery mode has been selected, the originator digitally records messages for one or more recipients using a microphone-equipped device and the software agent. Ex. 1003, 16:1–3. The software agent compresses the voice and stores the file temporarily on the PC if the voice will be delivered as an entire message. *Id.* at 16:3–4. If the real-time "intercom" mode has been invoked, a small portion of the digitized voice is stored to account for the requirements of the Internet protocols for retransmission and then transmitted before the entire conversation has been completed. *Id.* at 16:4–7. Based on status information received from the central server, the agent then decides whether to transport the voice container to a central file system and/or to send it directly to another software agent using the IP address previously stored in the software agent. *Id.* at 16:7–10. If the intended recipient has a compatible active software agent online after log on, the central server downloads the voice recording almost immediately to the recipient. *Id.* at 16:10–12. The voice is uncompressed and the recipient can hear the recording through the speakers

or headset attached to its computer. *Id.* at 16:12–14. The recipient can reply in a complementary way, allowing for near real-time communications. *Id.* at 16:14–15. If the recipient's software agent is not online, the voice recording is stored in the central server until the recipient's software agent is active. *Id.* at 16:15–17. "In both cases, the user is automatically notified of available messages once the voice recordings have been downloaded to storage on their computer." *Id.* at 16:17–19. The central server coordinates with software agents on all computers continuously, updating addresses, uploading and downloading files, and selectively retaining voice recordings in central storage. *Id.* at 16:19–21.

Zydney discloses that the voice container also has the ability to have other data types attached to it. Ex. 1006, 19:6–7. Formatting the container using MIME format, for example, "allows non-textual messages and multipart message bodies attachments [sic] to be specified in the message headers." *Id.* at 19:7–10.

Figure 3 of Zydney is reproduced below.

FIG. 3

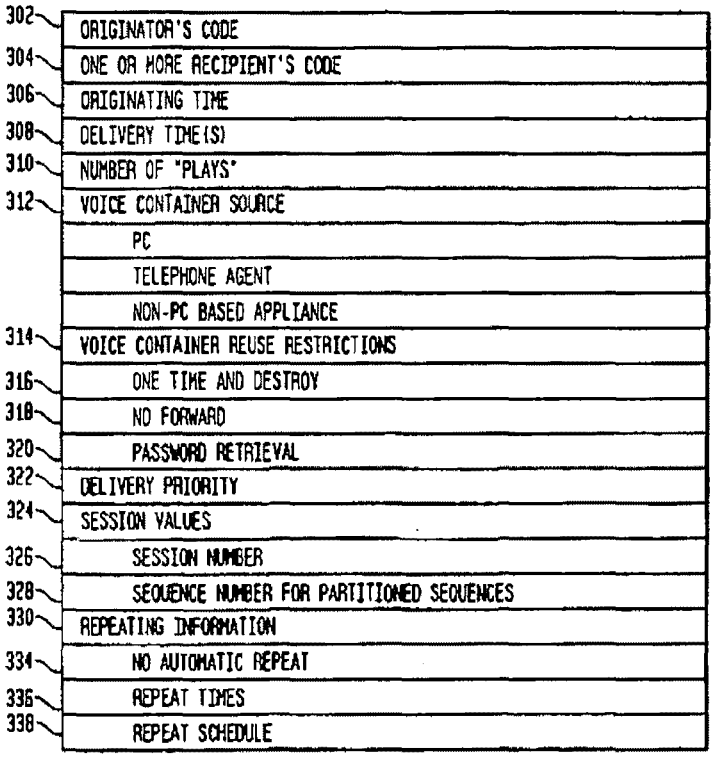

Figure 3, above, illustrates an exemplary embodiment of Zydney's voice container structure, including voice data and voice data properties components. Ex. 1006, 2:19, 23:1–2. Referring to Figure 3, voice container components include:

> [O]riginator's code 302 (which is a unique identifier), one or more recipient's code 304, originating time 306, delivery time(s) 308, number of "plays" 310, voice container source 312 which may be a PC, telephone agent, non-PC based appliance, or other, voice container reuse restrictions 314 which may include one time and destroy 316, no forward 318, password retrieval 320, delivery priority 322, session values 324, session number 326, sequence number for partitioned sequences[] 328, repeating information 330, no automatic repeat 332, repeat times 334, and a repeat schedule 336.

Id. at 23:2–10.

c. Clark

Clark, titled "System for Managing and Organizing Stored Electronic Messages," is directed to systems for managing and organizing electronic messages. Ex. 1007, [54], 1:8–9. According to Clark,

> A computer-based system catalogs and retrieves electronic messages saved in a message store. The system automatically organizes each saved message into multiple folders based on the contents and attributes of the message, and implements improved methods for manually organizing messages.

Id. at [57]. A particularly relevant embodiment in Clark is shown in Figure 4A, reproduced below.

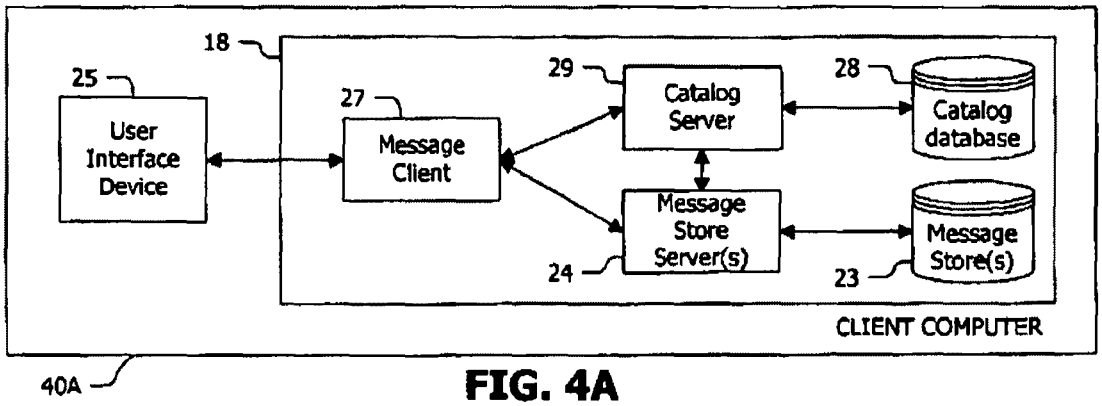

FIG. 4A

Figure 4A illustrates system 40A with client computer 18 implementing catalog server 29 and catalog database 28, and also including message client 27, message store 23, and message store server 24. *Id.* at 10:29–33. "Each message store 23 comprises a memory, file, or database structure that provides temporary or permanent storage for the contained messages." *Id.* at 9:13–15. Clark describes the invention as providing catalog database 28 (and preferably catalog server 29) to organize the

contents of one or more message stores 23. *Id.* at 9:54–56. "[C]atalog database 28 and message store 23 may be separate from one another or may be integrated in a single integrated message store." *Id.* at 11:1–3. In the embodiment where they are separate from each other, illustrated in Figure 5A (reproduced below), catalog database 28 may be linked to a separate external message store 23. *Id.* at 11:3–7.

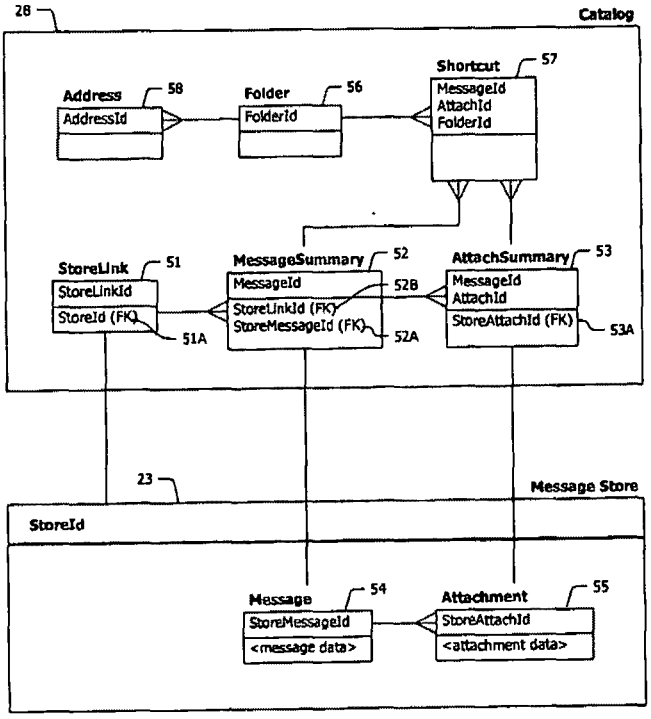

FIG. 5A

Figure 5A depicts the linking between catalog database 28 and external message store 23, where StoreLink table 51 contains rows, each with a StoreId pointing to a linked message store 23, and catalog database 28 includes MessageSummary table 52, which contains StoreMessageId 52A of messages in message store 23. *Id.* at 11:25–33. The Figure 5A embodiment also shows that messages 22 are stored in Message table 54 in message

store 23 and that attachments are stored in Attachment table 55 in message store 23. *Id.* at 35–37.

d. Väänänen

Väänänen discloses a "voicemail short messaging method," particularly including methods and means for instantaneous packet-switched voicemail between Internet-compatible computers, personal digital assistants, telephones, and mobile stations, in which subscriber and client terminals and a network server communicate over a network such as the Internet. Ex. 1008, [57], 1:3–9, 5:1–30. In one disclosed method, a terminal user can record and save a voice message as a data file for transmission to a one or more recipients over a network. *Id.* at 6:29–7:5. According to Väänänen, cryptography methods may be employed with the data file, and the file may be decrypted for automatic playback upon receipt. *Id.* at 2:24–30, 18:4–7.

e. Low

Low, titled "Instant Messaging," describes an instant messaging ("IM") process executed by an IM gateway in a communications network. Ex. 1010, [54], [57]. Figure 1 of Low is reproduced below.

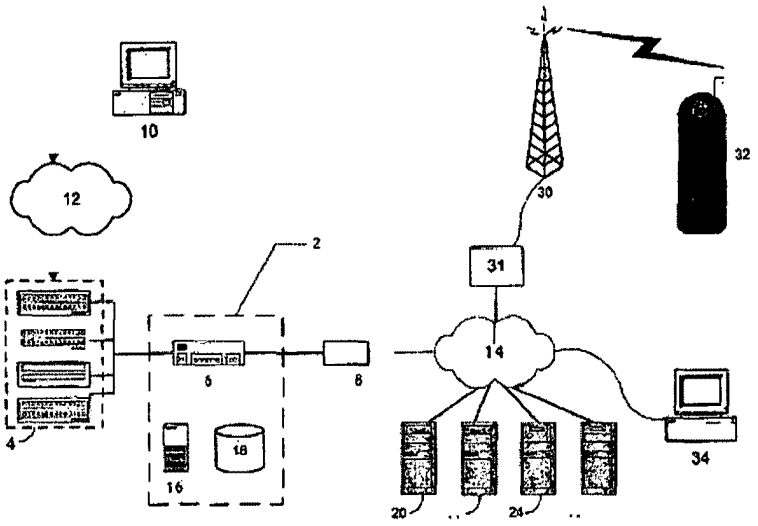

FIG. 1

Figure 1, above, illustrates an embodiment of an IM gateway within a network access system. *Id.* ¶ 20. As shown in Figure 1, IM gateway 2 is connected to communications network 14, such as the Internet, and is connected between IM clients (e.g., computer 10) and IM servers 20, 22, 24, 26 on network 14. *Id.* ¶¶ 27, 29. Low's system allows IM client users to monitor the presence of other users on the system in order to exchange messages and files. *Id.* ¶¶ 4, 27, 29. "IM gateway 2 processes the IM packets received from different IM clients in order to allow them to communicate with one another, notwithstanding the fact that they use a different IM protocol." *Id.* ¶ 29. The IM clients can send commands to IM gateway 2 to change "the user's state or presence" on the IM network, such to log into and out from the network. *Id.* ¶¶ 39, 42. An IM state change process in IM gateway 2 then forwards the commands to switch 6 in IM gateway 2, which in turn sends the command to an appropriate IM server (e.g., authentication server 20). *Id.* ¶ 42.

3. Arguments and Analysis

a. Claims 14–17, 19, 28–31, and 33

Claim 14 depends from claim 13, which in turn depends from claim 3. Claim 14 further recites "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*." Ex. 1001, 25:14–18 (emphases added). Claim 15 depends from claim 14 and further recites "wherein the message database includes a plurality of instant voice messages recorded by a user of the client device and instant voice messages received over the packet-switched network." *Id.* at 25:19–22. Claim 16 depends from claim 15 and further recites "wherein the instant voice messaging application displays at least one of the plurality of instant voice messages stored in the message database." *Id.* at 25:23–26. Claim 17 depends from claim 14 and further recites "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." Claim 19 depends from claim 13 and further recites "wherein the instant voice messaging application includes an encryption/decryption system for encrypting the instant voice messages to be transmitted over the packet-switched network and decrypting the instant voices messages received over the packet-switched network." *Id.* at 25:36–41. Claims 28–31 and 33 recite substantially the same limitations as dependent claims 14–17 and 19, respectively, but depend from claim 27 rather than claim 3. *Id.* at 26:31–47.

Petitioner contends Griffin disclose all limitations of independent claims 3 and 27, from which claims 14–17, 19, 28–31, and 33 ultimately

depend, except that it relies on the combined teachings of Griffin and Zydney for the teaching of "a communication platform system maintaining connection information . . . indicating whether there is a current connection to each of the plurality of instant voice message client systems" and the instant voice message including an object field "including a digitized audio file," as recited in claim 3, and "a document handler system for attaching one or more files to the instant voice message," as recited in claim 27.[8] Pet. 13–44. Petitioner concedes that Griffin does not explicitly disclose that its messages each are represented by a "database record including a unique identifier," as recited in claims 14 and 28, or an "encryption/decryption system," as recited in claims 19 and 33, but contends that it would have been obvious to modify the Griffin-Zydney combination to implement such features in further view of Clark and Väänänen, respectively. Pet. 46, 61–62. Petitioner argues, for example, that Clark's message store 23 and catalog 28 are illustrated by Clark as separate databases and integrated databases, and that each message 22 is represented by a "Message" record in message store 23 and is uniquely identified by a "StoreMessageId" or "MessageId." *Id.* at 48 (citing Ex. 1007, 11:5–12:6). According to Petitioner, "[b]y storing each message in one or more database records and associating a unique identifier with each record, *Clark's* system can easily catalog, retrieve, and manipulate messages." *Id.* at 49 (citing Ex. 1007, 11:38–40, 13:66–14:3, 16:50–17:23). Petitioner supports its arguments,

[8] Petitioner also relies on Zydney's disclosure of agents 22, 28 and server 24 as being "directly connected to a packet-switched network (e.g., Internet)," as an alternative in the event claims 3 and 27 were to be construed to require a "direct" connection to a packet-switched network. Pet. 17–20.

including reasons that a person of ordinary skill in the art would have combined the teachings of Griffin, Zydney, and Clark, with Dr. Haas's testimony. *Id.* at 46–51 (citing Ex. 1002 ¶¶ 283–293).

We have reviewed the Petition and the evidence cited in support thereof and are persuaded that, at this juncture, Petitioner has established a reasonable likelihood of prevailing in its contentions that claims 14–17 and 28–31 of the '622 patent are unpatentable as obvious over Griffin, Zydney, and Clark and that claims 19 and 33 are unpatentable over Griffin, Zydney, and Väänänen. Patent Owner's arguments presented on the current record have not persuaded us to the contrary. Specifically, Patent Owner has not persuaded us that the following arguments are supported by facts sufficient to overcome the evidence presented in the Petition:

i. Griffin does not disclose an "instant voice message," as recited in claims 3 and 27 (Prelim. Resp. 17–23);

ii. Griffin and Zydney do not disclose a "network interface" connected to a "packet-switched network," as recited in claims 3 and 27 (Prelim. Resp. 23–28);

iii. Griffin and Zydney do not render obvious "wherein the instant voice message includes an object field including a digitized audio file," as recited in claim 3 (*id.* at 28–33);

iv. Griffin and Zydney do not render obvious "wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message," as recited in claim 27 (*id.* at 33–36);

v. Griffin would not have been combined with Zydney (*id.* at 36–48);

vi. Griffin, Zydney, and Clark lack "a database record of a message database including a unique identifier and an instant voice message" (*id.* at 48–52);

vii. Clark teaches away from the proposed combination, and therefore there could have been no motivation to combine Griffin plus Zydney with Clark in the manner Petitioner proposes (*id.* at 52–56); and

viii. The combination of Griffin and Clark does not disclose the "file manager system storing, retrieving, and deleting the instant voice message," as recited in claims 17 and 31 (*Id.* at 56–60).

We address these arguments in turn below.

i

With regard to the "instant voice message" argument, Patent Owner focuses on whether Griffin's disclosures are for "text messages" and whether speech chat messages are in "real-time." *Id.* at 17–19. On this record, none of these arguments overcome the express disclosure in Griffin of "managing the display of a plurality of *real-time speech* and text conversations (e.g., chat threads) on limited display areas." Ex. 1005, 1:9–11 (emphasis added). Further, Griffin describes both inbound and outbound *messages* as either text or speech. *Id.* at 6:39–41, 11:48–50. Additionally, although Griffin describes "queuing" an inbound speech message, Griffin explains that the message is nevertheless received at the terminal, and the queuing is only for automatic playback. *Id.* at 11:50–67. In other words, with the evidence available, we do not agree with Patent Owner's characterization of Griffin as indicating that a terminal is interested only in whether a terminal is configured to be able to "receive a message at

some arbitrary point in the future." *See* Prelim. Resp. 21–22 (arguing that "available" status does not result in the terminal receiving the message because of "queuing"). Consequently, we are not persuaded by Patent Owner's arguments that Griffin's speech chats do not disclose instant voice messages.

ii

Patent Owner's argument that Griffin does not disclose a network interface connected to a packet-switched network, premised on the contention that Griffin "illustrates a system in which each terminal includes a network interface that is the point of interconnection between the terminal and the wireless carrier infrastructure," where that "wireless carrier infrastructure" is not a packet-switched network (Prelim. Resp. 23–27), is also unpersuasive. As Petitioner points out, the challenged claims recite that the claimed network interface must be "connected" to a packet-switched network" but do not recite that it must be "directly connected." Pet. 17 (citing Ex. 1002 ¶ 105). On the record before us, we are persuaded that Griffin discloses a network interface through which Griffin's mobile terminals are connected to a packet-switched network. In particular, as pointed out by Petitioner and explained in the summary of Griffin in Section III.B.2.a. above, Figure 2 of Griffin describes that all encoded speech messages are delivered through communication network 203, which may be the Internet. Ex. 1005, 3:49–65; Pet. 16. Moreover, whether Griffin teaches the recited "packet-switched network" is an issue of fact where Patent Owner has proffered only testimonial evidence challenging Petitioner's contention that Griffin discloses the limitation. The conflicting testimonial evidence has created a genuine issue of material fact that we do

not resolve at this juncture, but instead is viewed "in the light most favorable to the petitioner solely for purposes of deciding whether to institute an *inter partes* review." 37 C.F.R. § 42.108(c). Consequently, Patent Owner's arguments and evidence are not persuasive at this time.

iii

With respect to the disputed claim 3 limitation "wherein the instant voice message includes an object field including a digitized audio file," Petitioner contends that, although Griffin does not expressly disclose that the data contained in field 406 when message 400 is a speech message is a "digitized audio file," it would have been obvious to a person of ordinary skill in the art to modify Griffin to include such a digitized audio file in view of Zydney's teaching, for example, that a client software agent in a sender device generates a voice message by "digitally recording," compressing, and storing the user's speech as an MP3 audio file before packing that audio file into a voice container. Pet. 33–34 (citing Ex. 1002 ¶¶ 150–156; Ex. 1005, 6:39–44; Ex. 1006, 12:6–8, 14:2–5, 16:1–4, 21:15–18, 23:1–11, 39:16). Petitioner points out that Zydney also explains that the voice container can be formatted using the MIME standard, "which 'allows for non-textual messages and multipart message bodies [sic] attachments to be specified in the message headers.'" *Id.* at 34 (quoting Ex. 1006, 19:7–10) (citing *id.* at 19:13–20:9). Relying on Dr. Haas's testimony, Petitioner contends that, "[i]n view of these teachings and the knowledge of a POSA, a POSA would have been motivated to modify *Griffin's* system/process such that speech chat message 400 ('instant voice message') includes an object field (similar to message content field 406) having a digital audio file of speech data, similar to as described in Zydney," and that "[a] POSA would have

recognized that such a modification would have been nothing more than a simple substitution of one known and commonly-used technology for another (e.g., a digital audio file in place of other forms of data) to achieve [a] predictable result." *Id.* (emphasis omitted) (citing Ex. 1002 ¶¶ 151–153).

Patent Owner responds that Petitioner errs by relying on Zydney's voice container for this limitation, contending that "*Zydney* distinguishes its *voice container* from its *voice message*." Prelim. Resp. 29. Further, Patent Owner contends, Petitioner's "conclusory speculation" that "a person [of ordinary skill in the art] would have been motivated to modify *Griffin's* system/process, so that the speech chat message 400 . . . includes *an object field . . . including a digital audio file of speech data*" "should be rejected for several reasons." *Id.* at 30–33 (quoting Ex. 1002 ¶¶ 152–153).

Patent Owner does not persuasively rebut Petitioner's evidence. Specifically, whereas Patent Owner's arguments focus on whether *Zydney's voice container* would be understood to include an object field containing voice data (*see id.* at 29–33), we are sufficiently persuaded at this stage by Petitioner's evidence, including Dr. Haas's testimony, that *Griffin's message data* field 406 teaches the claimed object field, and that it would have been obvious to a person of ordinary skill in the art at the time of the alleged invention to include a digitized audio file as taught by Zydney in that object field.

iv

Regarding the "document handler system for attaching one or more files to the instant voice message" limitation of claim 27, Petitioner concedes that Griffin does not explicitly describe attaching files to a speech message, but contends that it would have been obvious to a person of

ordinary skill in the art to modify Griffin to do so in view of Zydney's teachings of a software agent that operates to address, pack, and send a message in a voice container that may include attachments in addition to a voice message recorded using a microphone. Pet. 42–43 (citing Ex. 1002 ¶¶ 248–251; Ex. 1006, 4:7–9, 10:20–11:3, 14:2–5, 16:1–4, 19:1–20:9, 20:11–14, 21:14–16, 22:19–20, 35:15–22, Figs. 6, 16–18). Relying on Dr. Haas's testimony, Petitioner contends that a person of ordinary skill in the art would have been motivated to modify Griffin's system/process "such that the software (and related components) enables the attachment of one or more files to a speech chat message (like described in *Zydney*)," because "it would have enhanced the capabilities and convenience of *Griffin*'s system/process by providing users with the ability to collectively send and receive one or more files with a speech chat message, instead of needing to send the files and message separately," and that a person of ordinary skill "would have recognized that such a modification would have been nothing more than a straightforward combination of known technologies by known methods without changing their respective functions to achieve a predictable result, and would have been well within the capabilities of such a person." *Id.* at 43–44 (citing Ex. 1002 ¶¶ 249–250).

In response to Petitioner's contentions, Patent Owner argues that Zydney's teaching of attaching files to a voice container "is inapposite because the claim language requires that the one or more files be attached to the instant voice message *itself*." Prelim. Resp. 33. Patent Owner contends that the '622 patent "repeatedly and consistently states that the 'instant voice message' is recorded in the audio file," whereas "*Zydney*'s *voice container* and *voice message* are not one and the same." *Id.* at 33–34. Further, Patent

Owner alleges, Zydney does not disclose a "document handler system," and "Petitioner does not point to any specific portion of *Zydney* that might be equated with the claimed document handler system; Petitioner simply states that files may be attached to a voice message and this can be obviously combined with *Griffin*." *Id.* at 34.

We are not persuaded by Patent Owner's arguments on the record developed at this stage of the proceeding. Patent Owner's arguments disputing Petitioner's mapping of Zydney's voice container to the claimed instant voice message are premised on an implied construction of "instant voice message" as encompassing *only* the voice message and excluding all else. This is an argument of claim construction that is underdeveloped at this juncture and has been presented only in connection with arguments distinguishing Zydney. On the present record, we do not have sufficient evidence or argument from either party to render even a preliminary construction for the term "instant voice message." Accordingly, at this time, Patent Owner's arguments distinguishing the prior art with regard to the scope of the "instant voice message" are unpersuasive. Similarly, Patent Owner's arguments disputing Zydney's teaching or suggestion of a "document handler system" are likewise premised on an unstated construction of that term for which the record before us is insufficient to render any determination. The parties will have an opportunity during trial to present fully claim construction briefing for the terms "instant voice message" and "document handler system."

v

With regard to the combinability of Griffin and Zydney, Patent Owner contends that such combination would be inoperable (Prelim. Resp. 36–40),

would render Zydney inoperable for its intended purpose (*id.* at 41–43), would result in Zydney's messages being lost (*id.* at 43), and would require changing the principle of operation of at least one of the two references (*id.* at 43–48). The underlying premise of Patent Owner's arguments is that Zydney is a peer-to-peer system that requires a transmitting device to know that the receiving device is available at the time of communication to communicate speech messages instantaneously, whereas Griffin supports text-only buddies that lack speech messaging capability, and the connectivity status in each reference has a different meaning. Patent Owner contends, for example, that "[a] [t]ext-only buddy connected to [Griffin's] server complex 204 would be considered 'available' as understood by *Zydney* . . . and would therefore be available for selection as a recipient of a speech message," but "*Griffin* does not disclose or even contemplate what would happen if a text-only buddy were to be selected to receive a speech message." *Id.* at 39. According to Patent Owner, "connectivity status" in Griffin and Zydney "mean entirely different things," because "*Zydney* requires status to include 'the *core states* of whether the recipient is online or offline,'" whereas "*Griffin* does not know and does not care whether a recipient is actually online (i.e., whether the recipient currently has the chat history displayed)." *Id.* at 42–43. Patent Owner characterizes Griffin as delivering the message *only* if the user has the "chat history display" visible on the user interface, and even then only the most recently received speech message is available, whereas Zydney "is concerned with routing *all* messages 'to the appropriate recipients instantaneously or stored for later delivery.'" *Id.* at 41, 43. This discrepancy, Patent Owner reasons, would

render Zydney unsatisfactory for its intended purpose and would result in Zydney's messages being lost. *Id.* at 41–43.

We are not persuaded by Patent Owner's arguments. Griffin expressly discloses "managing the display of a plurality of *real-time speech* and text conversations (e.g., chat threads) on limited display areas." Ex. 1005, 1:9–11 (emphasis added). Further, Griffin describes both inbound and outbound *messages* as either text or speech. *Id.* at 6:39–41, 11:48–50. Although Griffin describes "queuing" an inbound speech message, Griffin explains that the message is nevertheless received at the terminal, and the queuing is only for automatic playback. *Id.* at 11:50–67. Accordingly, we do not agree that the record at this time supports Patent Owner's characterization of Griffin's queuing disclosure as meaning that the message is not received at the terminal—the queueing only affects whether the most recently received speech message is *played automatically* upon receipt. The portions of Griffin Patent Owner cites do not support sufficiently the arguments that the terminal does not receive the speech message in real-time or that only the last received speech message is available. Therefore, Patent Owner's arguments that rest on the characterization of Griffin's queuing as incompatible with Zydney are not persuasive at this time.[9]

vi

[9] We also find unpersuasive the argument that Griffin and Zydney are not combinable for "text-only" buddy situation. Prelim. Resp. 38–40. None of Petitioner's contentions rely on "text-only" buddy features. And Griffin is silent as to how that feature operates, in the event of a speech chat directed to a text-only buddy, even without considering Zydney. Accordingly, the scenario that Patent Owner presents is speculative and is supported only with conclusory declaration testimony that is entitled to little or no weight.

Finally, Patent Owner's arguments regarding Clark are not persuasive at this time to rebut Petitioner's showing. Patent Owner's arguments are premised on an interpretation of the claim language requiring that: (1) the instant voice message is stored in the recited database record; and (2) the message database includes the database record. Neither requirement is expressly recited in the claim language. And the record at this juncture is devoid of briefing of the parties' claim construction positions for this phrase, such that we could determine, even preliminarily, that the scope of claim 14 includes these two alleged requirements. Accordingly, guided by the plain reading of the claim language, we do not agree with Patent Owner that Petitioner has failed to proffer institution-sufficient evidence that Clark discloses the recited "message database" and the "database record including a unique identifier."

vii

With regard to Patent Owner's contention that Clark teaches away from the proposed combination, Patent Owner argues that Petitioner's proposed combination would result in inoperability and teaching away from the claimed invention. Prelim. Resp. 52–56. In particular, Patent Owner argues that because Zydney teaches deleting the sent instant voice message from the client's temporary storage, any combination with Clark would result in Clark deleting the messages from the client, thereby running counter to Clark's stated goal of cataloging electronic messages. *Id.* at 54–55. We are not persuaded by this argument on the present record. We understand the Petition to combine the teachings of Clark's message store for the purpose that Clark gives for such use: to catalog and retrieve messages saved in a message store. Ex. 1007, [57]. Although Zydney

deletes the sent message from the temporary storage, Patent Owner does not show any disclosure in Zydney that would teach away from seeking and achieving the use and purpose of Clark's message store. The disclosure in Zydney of a "reserved temporary storage" does not teach away from using a different storage altogether (a message store) or from the purposes disclosed in Clark for storing and cataloging messages on a more persistent basis.

viii

Finally, we address the arguments concerning the "file manager system performing at least one of storing, deleting and retrieving the instant voice messages," as recited in claims 17 and 31. For this limitation, Petitioner relies on Griffin as disclosing, for example, "retrieving" because a displayed message can be selected for playback. Pet. 56 (citing, e.g., Ex. 1005, 10:20–25, 12:38–42). As an alternative, Petitioner also relies on various disclosures of Clark as disclosing adding, changing, or deleting a message. Pet. 57. For instance, Petitioner cites Clark: "Message client 27 will typically generate requests in response to user input such as requests to message store sever 24 to add, change or delete a message." *Id.* (citing Ex. 1007, 18:25–29).

Patent Owner argues that the claim language requires the sending device to include the message database. Prelim. Resp. 57–58. Accordingly, Patent Owner reasons that Griffin's sender does not store a copy of the message sent, and, therefore, Griffin does not disclose "storing" as recited in the claim. *Id.* at 58. This argument, however, does not address that Petitioner reasonably relies on Griffin for the "retrieving" function of the file manager system, at the sending device. As for Petitioner's reliance on Clark's disclosures, Patent Owner argues that Clark describes requests being

passed from component to component, but that none of those requests is a "user request," and neither of the components between which the requests are passed is the "message store 23" that Petitioner alleges to be the claimed message database. *Id.* at 59–60.

Patent Owner's arguments are not persuasive at this juncture. Claims 17 and 31 do not require any particular location for the "message database," and, therefore, neither Griffin's retrieved messages nor Clark's message store needs to be located strictly at the sending device as Patent Owner argues. Nevertheless, because Clark stores *sent* messages in the message store, Petitioner's allegations reasonably apply to a *sending* device retrieving the stored messages. *See, e.g.*, Ex. 1007, 17:12–17 (stating that displayed information for sent messages includes the send date/time). Finally, Petitioner has shown that Clark contemplates deleting a message at the request of a user. Pet. 57 (citing Ex. 1007, 18:25–29). Accordingly, Patent Owner's arguments that Clark only shows component-to-component requests, and not "user requests," is unpersuasive.

In summary, having reviewed the information presented by the parties at this juncture, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claims 14, 17, 28, and 31 are unpatentable over Griffin, Zydney, and Clark.

Patent Owner does not argue dependent claims 15, 16, 19, 29, 30, and 33 separately from claims 14 and 28. For the same reasons as stated regarding claims 14 and 28, and based on our review of Petitioner's arguments and evidence directed to the additional limitations of claims 15, 16, 19, 29, 30, and 33, we also determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claims 15, 16, 29,

and 30 are unpatentable over Griffin, Zydney, and Clark, and that claims 19 and 33 are unpatentable over Griffin, Zydney, and Väänänen.

b. Claims 24–26

In a similar manner as for claim 3, Petitioner relies on the combined teachings of Griffin and Zydney for the "communication platform system" and "network interface" limitations of claim 24 and relies on Griffin alone for the "messaging system" limitation of claim 24. Pet. 64–65. With respect to the further limitations of claim 24, "wherein the messaging system receives connection object messages from the plurality of instant voice message client systems" and "wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems," Petitioner relies on Low's disclosure that data packets transmitted from IM clients may include commands establishing and maintaining the logical connections between an client and a server and well as data representing the state of the connection. *Id.* at 67. In particular, Petitioner contends, "*Low* explains that IM clients send commands to the IM gateway that change 'the user's state or presence' on the IM network," where "[t]hese include commands initiating the user's login/logout from the network (i.e., commands (e.g., code) establishing and maintaining the logical connections) and commands indicating that the IM client user is "away, idle, or does not wish to be disturbed" (i.e., data representing the state of the connection)." *Id.* (citing Ex. 1010 ¶¶ 36–39, 42, 45, 46, 50). Relying on Dr. Haas's testimony, Petitioner contends that Low accordingly "discloses an instant messaging system where IM clients send data and commands (e.g., code) to a server that represent the state of the connection with the server and for

establishing and maintaining their logical connections with the server, like the 'connection object' described in the specification of the '622 Patent" (*id.* at 69 (citing Ex. 1001, 14:47–63; Ex. 1002 ¶ 339)), and that in view of the teachings of Low and the knowledge of a person of ordinary skill in the art, "it would have been obvious to a POSA to modify the *Griffin-Zydney* system/process such that broadcaster 303 receives data and/or commands from each terminal 100 representing the state of the connection with server complex 204 and for establishing and maintaining the logical connection with server complex 204" (*id.*).

In response to Petitioner's contentions regarding claim 24, Patent Owner does not expressly dispute that Low teaches the recited connection objects, but asserts that Zydney expressly teaches away from the proposed combination. Prelim. Resp. 60–61. In particular, Patent Owner contends that, because Zydney's voice container is stated to contain "no methods," whereas the proposed combination with Low "would require containment of 'commands . . . commands . . . and commands . . . ,'" Zydney teaches away from the combination and cannot be modified as proposed. *Id.* (ellipses in original) (citing Ex. 1006, 12:6–8; Pet. 67).

On the limited record before us, we are persuaded by Petitioner's arguments and evidence with respect to claim 24. Although Patent Owner accurately cites Zydney as stating that "voice container" refers to a container object that contains no methods (*see* Ex. 1006, 12:6–8), we are not persuaded on this record that the "commands" described by Low are "methods," as that term is used by Zydney. Moreover, even assuming *arguendo* that the "commands" recited by Low are properly understood to be "methods" within the meaning of that term as used in Zydney's definition of

a voice container, the record is not yet developed at this juncture with respect to whether claim 24 requires the recited "connection objects" to be included within the recited instant voice message itself. Consequently, we are not persuaded at this juncture that Zydney teaches away from the proposed combination of Low with Griffin and Zydney. The parties will have an opportunity to brief this issue more fully during trial.

For the foregoing reasons, we determine that on this record, Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claim 24 is unpatentable as obvious over Griffin, Zydney, and Low. Patent Owner does not argue dependent claims 25 and 26 separately from claim 24. For the same reasons as stated regarding claim 24, and based on our review of Petitioner's arguments and evidence directed to the additional limitations of claims 25 and 26, we also determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that those claims are unpatentable over Griffin, Zydney, and Low.

C. *Patent Owner's Argument That* Inter Partes *Review Proceedings Are Unconstitutional*

Patent Owner contends:

> The Supreme Court is currently considering the constitutionality of *inter partes* review proceedings. *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 137 S. Ct. 2239 (2017). The constitutional challenge is primarily based on the argument that adversarial challenges to an issued patent—like *inter partes* reviews— are "Suits at common law" for which the Seventh Amendment guarantees a jury trial. U.S. Const. amend. VII; *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996). Further, because patents are private property rights, disputes concerning their validity must be litigated in an Article III court, not before an executive branch agency.

> *McCormick Harvesting Mach. Co. v. C. Aultman & Co.*, 169 U.S. 606, 609 (1898). Out of an abundance of caution, Patent Owner hereby adopts this constitutional challenge now to preserve the issue pending the Supreme Court's decision.

Prelim. Resp. 61–62.

Although, as Patent Owner notes, the constitutionality of *inter partes* reviews is currently being considered by the Supreme Court, "administrative agencies do not have jurisdiction to decide the constitutionality of congressional enactments," and we are bound by the existing decisions of our reviewing court that have consistently rejected constitutional challenges substantially similar to those raised by Patent Owner. *See MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1288–92 (Fed. Cir. 2015), *cert. denied* 137 S. Ct. 292 (2016)); *Cooper v. Square, Inc.*, 645 F. App'x 1014 (Fed. Cir. 2016), *cert. denied* 137 S. Ct. 475 (2016); *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 639 Fed. App'x 639 (Fed. Cir. 2016); *Riggin v. Office of Senate Fair Emp't Practices*, 61 F.3d 1563, 1569 (Fed. Cir. 1995); *Apple Inc. v. Smartflash LLC*, Case CBM2015-00028, slip op. at 23–24 (PTAB May 26, 2016) (Paper 44); *see also Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1710 (TTAB 1999) ("[T]he Board has no authority . . . to declare provisions of the Trademark Act unconstitutional."); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1082 n.1 (TTAB 2014).

D. Additional Considered Arguments

Patent Owner has advanced a variety of additional arguments concerning the repeated challenges of unpatentability asserted by other parties. For instance, Patent Owner argues that the Petition is "redundant" in light of the other petitions filed by Petitioner as well as other petitions filed

against Patent Owner's patents by other parties. Prelim. Resp. 1–9. Patent Owner also argues that Zydney is duplicative of prior art cited during prosecution and that Väänänen was cited during prosecution of the '622 patent, and that should exercise our discretion and deny the petition under 35 U.S.C. § 314(a) and § 325(d). *Id.* at 9–11, 14–17.

We have considered Patent Owner's arguments and have found they are underdeveloped and unpersuasive, and will not be subject to further substantive discussion. We acknowledge that the instant Petition and the petition in Case IPR2017-01797 together represent a third round of challenges to the '622 patent. Although we understand the purposes of §§ 314(a) and 325(d), vis-à-vis repeated challenges, we also recognize the purpose of the availability of *inter partes* review to parties accused of infringement. And while Zydney has been the basis of grounds presented in a previous petition by a different petitioner, Zydney is not the primary focus of the grounds here; Griffin is. Patent Owner's complaint about the multiple *inter partes* review petitions filed against the '622 patent is not persuasive when the volume appears to be a direct result of its own litigation activity. The discretion to deny petitions is for the panel to wield under certain conditions, but not in every situation where a Patent Owner complains of repeated challenges against its patents.

IV. CONCLUSION

In summary, based on our review of the arguments and evidence in the Petition and Preliminary Response, we institute *inter partes* review of the challenged claims of the '622 patent on the following grounds:

Ground	Basis	Claims Challenged	Claims Instituted
1	§ 103 Griffin, Zydney, and Clark	14–17, 28–31	14–17, 28–31
2	§ 103 Griffin, Zydney, and Väänänen	19, 33	19, 33
3	§ 103 Griffin, Zydney, and Low	24–26	24–26
Summary		14–17, 19, 24–26, 28–31, 33	14–17, 19, 24–26, 28–31, 33

V. ORDER

Upon consideration of the record before us, it is, therefore,

ORDERED that an *inter partes* review is instituted as to claims 14–17, 19, 24–26, 28–31, and 33 of the '622 patent on the following grounds:

(1) Claims 14–17 and 28–31 under 35 U.S.C. § 103(a) as unpatentable over Griffin, Zydney, and Clark,

(2) Claims 19 and 33 under 35 U.S.C. § 103(a) as unpatentable over Griffin, Zydney, and Väänänen, and

(3) Claims 24–26 under 35 U.S.C. § 103(a) as unpatentable over Griffin, Zydney, and Low;

FURTHER ORDERED that no other grounds are authorized; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), inter partes review of the '622 patent is hereby instituted commencing on the entry date of this Decision, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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Paper 8
Entered: January 19, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01804
Patent 8,724,622 B2

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

Apple Inc. ("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 2 ("Pet."). Uniloc Luxembourg S.A. ("Patent Owner")[1] filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

We have authority under 35 U.S.C. § 314. Based on the particular circumstances presented, we exercise our discretion under 37 C.F.R. § 42.108 and do not institute an *inter partes* review in this case.

II. DISCUSSION

A. Related Matters

The parties indicate that the '622 patent is involved in *Uniloc USA, Inc. v. Apple Inc.*, No. 2:16-cv-00638-JRG (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. The '622 patent also was the subject of two requests for *inter partes* review filed by Petitioner on November 14, 2016

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[1] Patent Owner's Mandatory Notice filed pursuant to 37 C.F.R. § 42.8 identifies Uniloc Luxembourg S.A. as the owner of the challenged patent and identifies Uniloc USA, Inc. only as exclusive licensee and additional real party in interest. Paper 4, 1. Accordingly, we have removed Uniloc USA, Inc. from the case caption as Patent Owner. We note, however, that this identification varies from earlier cases involving the challenged patent and certain related patents, in which Uniloc USA, Inc. and Uniloc Luxembourg S.A. both were identified in mandatory notices as "Patent Owner." *See, e.g.*, IPR2017-00221, Paper 4, 1; IPR2017-00222, Paper 4, 1; IPR2017-00225, Paper 4, 1; IPR2017-01427, Paper 4, 1; IPR2017-01428, Paper 4, 1. The parties are reminded of their ongoing obligation under 37 C.F.R. § 42.8(a)(3) to keep mandatory notices updated.

(Cases IPR2017-00223 and IPR2017-00224), both of which were denied. *See* IPR2017-00223, Paper 7 (PTAB May 25, 2017); IPR2017-00224, Paper 7 (PTAB May 25, 2017).

Concurrently with filing of the instant Petition on July 20, 2017, Petitioner additionally filed a petition requesting *inter partes* review of claims 4, 5, 12, and 24–26 of the '622 patent (Case IPR2017-01805). IPR2017-01805, Paper 2. By Petitioner's own admission, the instant Petition and the petition filed in Case IPR2017-01805 are "substantively identical" to petitions filed June 22, 2017, by Facebook, Inc. and WhatsApp Inc. (collectively, "Facebook") in Cases IPR2017-01667 and IPR2017-01668, respectively, apart from the inclusion of two new sections addressing such identicality. *See* Pet. 76; IPR2017-01805, Paper 2, 65. Earlier today, the Board instituted *inter partes* review in Cases IPR2017-01667 and IPR2017-01668. IPR2017-01667, Paper 8 (PTAB Jan. 19, 2018); IPR2017-01668, Paper 8 (PTAB Jan. 19, 2018).

Further, Samsung Electronics America, Inc. also filed two requests for *inter partes* review of certain claims of the '622 patent on July 20, 2017 (Cases IPR2017-01797 and IPR2017-01798); Huawei Device Co., Ltd. ("Huawei") filed a request for *inter partes* review of the same claims as the instant Petition and the petition in Case IPR2017-01668 on September 11, 2017 (Case IPR2017-02090); and Google Inc. filed two requests for *inter partes* review of certain claims of the '622 patent on September 12, 2017 (Cases IPR2017-02080 and IPR2017-02081). Huawei additionally filed a motion for joinder to Case IPR2017-01667 concurrently with its petition in Case IPR2017-02090. IPR2017-02090, Paper 3.

B. Discretionary Non-institution

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. "In determining whether to institute or order a proceeding under . . . Chapter 31 [of Title 35 of the U.S. Code, providing for *inter partes* review], the Director may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d).

In this case, as noted in the previous section, Petitioner admits that the Petition is substantively identical to Facebook's petition in Case IPR2017-01667 ("the '1667 IPR"), which challenges the same claims on the same grounds, aside from the addition of new "sections VII–VIII." Pet. 76. Moreover, the new "sections VII–VIII" referenced by Petitioner do not alter the substance of the asserted grounds. Rather, Section VII represents that "Petitioner has limited its grounds to those in [the '1667 IPR], including the same analysis, prior art and declaration"; that "any differences are shown in Exhibit 1020";[2] and that Petitioner will request joinder with the '1667 IPR "when appropriate." *Id.* Petitioner further represents that "[i]f joined, Petitioner will accept a limited capacity unless Facebook terminates as a party," and "[i]f not [joined], Petitioner consents to coordinating schedules." *Id.* In Section VIII of the Petition, titled "The Board should institute in view

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[2] We note that in addition to the redlined petition that Petitioner filed as Exhibit 1020, showing differences relative to Facebook's petition in the '1667 IPR, Petitioner also filed a redlined version of Facebook's supporting expert declaration of Tal Lavian, Ph.D. from that case, as Exhibit 1021. *See* Pet. ix. Our review of Exhibits 1020 and 1021 confirms Petitioner's representation that Petitioner has limited its ground in this case to those in the '1667 IPR.

of §325(d)," Petitioner contends that "the eight §325(d) factors have marginal relevance here because Petitioner does not present grounds beyond" the '1667 IPR, and that "the eight factors in *Blue Coat Systems v. Finjan*, IPR2016-01443, Paper 13, pp. 8–9, support this subsequent petition." *Id.* at 76–77.

Notwithstanding Petitioner's contentions regarding § 325(d),[3] we exercise our discretion under 37 C.F.R. § 42.108(a) to deny the Petition, based on the *complete identity* of prior art and arguments to those presented to the Office in the '1667 IPR. We recognize that the Board often institutes *inter partes* review on petitions substantively identical to earlier successful petitions, where the second petition is accompanied by an unopposed or

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[3] It is unclear whether Petitioner, in its reference to "eight §325(d) factors hav[ing] marginal relevance here," intends to refer to the same "eight factors in *Blue Coat Systems*" that allegedly "support this subsequent petition." Pet. 76. Of the eight factors presented in the cited *Blue Coat Systems* proceeding, only the eighth factor, "whether the same or substantially the same prior art or arguments previously were presented to the Office," directly relates to § 325(d). Notably, Petitioner does not persuasively address that eighth factor. *See id.* at 76–77 (arguing with respect to "Factors 3–5 and 8," collectively, only that "Courts and the PTAB have differentiated between art that should be known by a 'skilled searcher conducing a diligent search,' as opposed to 'a scorched-earth search,'" and that "[b]efore filing earlier petitions, Petitioner performed a reasonable prior art search that did not uncover" the particular prior art cited in the Petition, neither of which arguments has any discernible bearing on § 325(d)). The remaining seven factors articulated in *Blue Coat Systems*, while relevant to the Board's more general discretion under 35 U.S.C. § 314(a), do not enter into the determination under § 325(d) "whether . . . the same or substantially the same prior art or arguments previously were presented." In any event, we agree with Patent Owner's arguments that the factors set forth in *Blue Coat Systems*, to the extent applicable, do not weigh in Petitioner's favor in this case. *See* Prelim. Resp. 8–11.

unpersuasively opposed request for joinder pursuant to 37 C.F.R. § 42.112(b), in which cases the filer of the second petition is then joined as a petitioner in the first proceeding and the second proceeding is immediately terminated. *See, e.g.*, IPR2017-01636, slip op. at 14–16 (PTAB Oct. 3, 2017) (Paper 10) (instituting *inter partes* review in Case IPR2017-01636; joining Facebook, Inc. and WhatsApp, Inc. as petitioners in Case IPR2017-00221, *Apple Inc. v. Uniloc USA, Inc.*, a pending review involving the same asserted grounds of unpatentability; and then terminating Case IPR2017-01636). That, however, is not the posture of this case. Petitioner has not filed a request for joinder with the '1667 IPR, but merely has represented that it will do so at some unspecified time "when appropriate." Pet. 76. If we were to institute trial at this time, Patent Owner would be required to participate in duplicative proceedings with different petitioners, each having its own counsel, until such time, if ever, as Petitioner deemed it "appropriate" to request joinder. Further, because we are required to enter a decision on institution within three months of Patent Owner's filing of its Preliminary Response on November 8, 2017—i.e., by February 8, 2018—35 U.S.C. § 314(b) ("The Director shall determine whether to institute an inter partes review . . . within 3 months after . . . receiving a preliminary response to the petition . . . ."), there would be insufficient time for briefing to be completed before entry of our decision on institution even if Petitioner were to file a motion for joinder immediately, *see* 37 C.F.R. § 42.25(a)(1) (providing that an opposition is due one month after service of a motion).

Accordingly, under the circumstances, the Petition is denied, without prejudice to Petitioner's ability to file a new petition accompanied by a

request for joinder pursuant to and within the time period permitted by 37 C.F.R. § 42.122(b).

III. CONCLUSION

In summary:

Ground	Basis	Claims Challenged	Claims Instituted
1	§ 103 Zydney[4] and Shinder[5]	3, 6–8, 10, 11, 13, 18–21, 23, 27, 32–35, 38	None
2	§ 103 Zydney, Shinder, and Clark[6]	14–17, 28–31	None
3	§ 103 Zydney, Shinder, and Appelman[7]	22, 39	None
Summary		3, 6–8, 10, 11, 13–23, 27–35, 38, 39	None

IV. ORDER

Upon consideration of the record before us, it is, therefore,

ORDERED that the Petition is *denied*, and no trial or *inter partes* review is instituted on any asserted ground.

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[4] Zydney et al., WO 01/11824 A2, published Feb. 15, 2001 (filed with line numbers added as Exhibit 1003).

[5] Excerpts from Debra Littlejohn Shinder, *Computer Networking Essentials* (2002) (Ex. 1014).

[6] Clark et al., US 6,725,228 B1, issued Apr. 20, 2004 (Ex. 1008).

[7] Appelman, US 6,750,881 B1, issued June 15, 2004 (Ex. 1004).

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Paper 9
Entered: January 19, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01805
Patent 8,724,622 B2

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

Apple Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claims 4, 5, 12, and 24–26 of U.S. Patent No. 8,724,622 B2 (Ex. 1001, "the '622 patent"). Paper 2 ("Pet."). Uniloc Luxembourg S.A. ("Patent Owner")[1] filed a Preliminary Response. Paper 7 ("Prelim. Resp.").

We have authority under 35 U.S.C. § 314. Based on the particular circumstances presented, we exercise our discretion under 37 C.F.R. § 42.108 and do not institute an *inter partes* review in this case.

II. DISCUSSION

A. Related Matters

The parties indicate that the '622 patent is involved in *Uniloc USA, Inc. v. Apple Inc.*, No. 2:16-cv-00638-JRG (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. The '622 patent also was the subject of two requests for *inter partes* review filed by Petitioner on November 14, 2016 (Cases IPR2017-00223 and IPR2017-00224), both of which were denied.

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[1] Patent Owner's Mandatory Notice filed pursuant to 37 C.F.R. § 42.8 identifies Uniloc Luxembourg S.A. as the owner of the challenged patent and identifies Uniloc USA, Inc. only as exclusive licensee and additional real party in interest. Paper 4, 1. Accordingly, we have removed Uniloc USA, Inc. from the case caption as Patent Owner. We note, however, that this identification varies from earlier cases involving the challenged patent and certain related patents, in which Uniloc USA, Inc. and Uniloc Luxembourg S.A. both were identified in mandatory notices as "Patent Owner." *See, e.g.*, IPR2017-00221, Paper 4, 1; IPR2017-00222, Paper 4, 1; IPR2017-00225, Paper 4, 1; IPR2017-01427, Paper 4, 1; IPR2017-01428, Paper 4, 1. The parties are reminded of their ongoing obligation under 37 C.F.R. § 42.8(a)(3) to keep mandatory notices updated.

See IPR2017-00223, Paper 7 (PTAB May 25, 2017); IPR2017-00224, Paper 7 (PTAB May 25, 2017).

Concurrently with filing of the instant Petition on July 20, 2017, Petitioner additionally filed a petition requesting *inter partes* review of claims 3, 6–8, 10, 11, 13–23, 27–35, 38, 39 of the '622 patent (Case IPR2017-01804). IPR2017-01804, Paper 2. By Petitioner's own admission, the instant Petition and the petition filed in Case IPR2017-01804 are "substantively identical" to petitions filed June 22, 2017, by Facebook, Inc. and WhatsApp Inc. (collectively, "Facebook") in Cases IPR2017-01668 and IPR2017-01667, respectively, apart from the inclusion of two new sections addressing such identicality. *See* Pet. 65; IPR2017-01804, Paper 2, 76. Earlier today, the Board instituted *inter partes* review in Cases IPR2017-01667 and IPR2017-01668. IPR2017-01667, Paper 8 (PTAB Jan. 19, 2018); IPR2017-01668, Paper 8 (PTAB Jan. 19, 2018).

Further, Samsung Electronics America, Inc. also filed two requests for *inter partes* review of certain claims of the '622 patent on July 20, 2017 (Cases IPR2017-01797 and IPR2017-01798); Huawei Device Co., Ltd. ("Huawei") filed a request for *inter partes* review of the same claims as the petitions in Cases IPR2017-01667 and IPR2017-01804 on September 11, 2017 (Case IPR2017-02090); and Google Inc. filed two requests for *inter partes* review of certain claims of the '622 patent on September 12, 2017 (Cases IPR2017-02080 and IPR2017-02081). Huawei additionally filed a motion for joinder to Case IPR2017-01667 concurrently with its petition in Case IPR2017-02090. IPR2017-02090, Paper 3.

B. Discretionary Non-institution

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. "In determining whether to institute or order a proceeding under . . . Chapter 31 [of Title 35 of the U.S. Code, providing for *inter partes* review], the Director may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d).

In this case, as noted in the previous section, Petitioner admits that the Petition is substantively identical to Facebook's petition in Case IPR2017-01668 ("the '1668 IPR"), which challenges the same claims on the same grounds, aside from the addition of new "sections VII–VIII." Pet. 65. Moreover, the new "sections VII–VIII" referenced by Petitioner do not alter the substance of the asserted grounds. Rather, Section VII represents that "Petitioner has limited its grounds to those in [the '1668 IPR], including the same analysis, prior art and declaration"; that "any differences are shown in Exhibit 1120";[2] and that Petitioner will request joinder with the '1668 IPR "when appropriate." *Id.* Petitioner further represents that "[i]f joined, Petitioner will accept a limited capacity unless Facebook terminates as a party," and "[i]f not [joined], Petitioner consents to coordinating schedules." *Id.* In Section VIII of the Petition, titled "The Board should institute in view

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[2] We note that in addition to the redlined petition that Petitioner filed as Exhibit 1120, showing differences relative to Facebook's petition in the '1668 IPR, Petitioner also filed a redlined version of Facebook's supporting expert declaration of Tal Lavian, Ph.D. from that case, as Exhibit 1121. *See* Pet. ix. Our review of Exhibits 1120 and 1121 confirms Petitioner's representation that Petitioner has limited its ground in this case to those in the '1668 IPR.

of §325(d)," Petitioner contends that "the eight §325(d) factors have marginal relevance here because Petitioner does not present grounds beyond" the '1668 IPR, and that "the eight factors in *Blue Coat Systems v. Finjan*, IPR2016-01443, Paper 13, pp. 8–9, support this subsequent petition." *Id.* at 65–66.

Notwithstanding Petitioner's contentions regarding § 325(d),[3] we exercise our discretion under 37 C.F.R. § 42.108(a) to deny the Petition, based on the *complete identity* of prior art and arguments to those presented to the Office in the '1668 IPR. We recognize that the Board often institutes *inter partes* review on petitions substantively identical to earlier successful petitions, where the second petition is accompanied by an unopposed or

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[3] It is unclear whether Petitioner, in its reference to "eight §325(d) factors hav[ing] marginal relevance here," intends to refer to the same "eight factors in *Blue Coat Systems*" that allegedly "support this subsequent petition." Pet. 65. Of the eight factors presented in the cited *Blue Coat Systems* proceeding, only the eighth factor, "whether the same or substantially the same prior art or arguments previously were presented to the Office," directly relates to § 325(d). Notably, Petitioner does not persuasively address that eighth factor. *See id.* at 65–66 (arguing with respect to "Factors 3–5 and 8," collectively, only that "Courts and the PTAB have differentiated between art that should be known by a 'skilled searcher conducing a diligent search,' as opposed to 'a scorched-earth search,'" and that "[b]efore filing earlier petitions, Petitioner performed a reasonable prior art search that did not uncover" the particular prior art cited in the Petition, neither of which arguments has any discernible bearing on § 325(d)). The remaining seven factors articulated in *Blue Coat Systems*, while relevant to the Board's more general discretion under 35 U.S.C. § 314(a), do not enter into the determination under § 325(d) "whether . . . the same or substantially the same prior art or arguments previously were presented." In any event, we agree with Patent Owner's arguments that the factors set forth in *Blue Coat Systems*, to the extent applicable, do not weigh in Petitioner's favor in this case. *See* Prelim. Resp. 7–10.

unpersuasively opposed request for joinder pursuant to 37 C.F.R. § 42.112(b), in which cases the filer of the second petition is then joined as a petitioner in the first proceeding and the second proceeding is immediately terminated. *See, e.g.*, IPR2017-01636, slip op. at 14–16 (PTAB Oct. 3, 2017) (Paper 10) (instituting *inter partes* review in Case IPR2017-01636; joining Facebook, Inc. and WhatsApp, Inc. as petitioners in Case IPR2017-00221, *Apple Inc. v. Uniloc USA, Inc.*, a pending review involving the same asserted grounds of unpatentability; and then terminating Case IPR2017-01636). That, however, is not the posture of this case. Petitioner has not filed a request for joinder with the '1668 IPR, but merely has represented that it will do so at some unspecified time "when appropriate." Pet. 65. If we were to institute trial at this time, Patent Owner would be required to participate in duplicative proceedings with different petitioners, each having its own counsel, until such time, if ever, as Petitioner deemed it "appropriate" to request joinder. Further, because we are required to enter a decision on institution within three months of Patent Owner's filing of its Preliminary Response on November 8, 2017—i.e., by February 8, 2018—35 U.S.C. § 314(b) ("The Director shall determine whether to institute an inter partes review . . . within 3 months after . . . receiving a preliminary response to the petition . . . ."), there would be insufficient time for briefing to be completed before entry of our decision on institution even if Petitioner were to file a motion for joinder immediately, *see* 37 C.F.R. § 42.25(a)(1) (providing that an opposition is due one month after service of a motion).

Accordingly, under the circumstances, the Petition is denied, without prejudice to Petitioner's ability to file a new petition accompanied by a

request for joinder pursuant to and within the time period permitted by 37 C.F.R. § 42.122(b).

III. CONCLUSION

In summary:

Ground	Basis	Claim(s) Challenged	Claims Instituted
1	§ 103 Zydney,[4] Shinder,[5] and Hethmon[6]	4, 5, 24–26	None
2	§ 103 Zydney, Shinder, Microsoft,[7] and Moghe[8]	12	None
Summary		4, 5, 12, 24–26	None

IV. ORDER

Upon consideration of the record before us, it is, therefore,

ORDERED that the Petition is *denied*, and no trial or *inter partes* review is instituted on any asserted ground.

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[4] Zydney et al., WO 01/11824 A2, published Feb. 15, 2001 (filed with line numbers added as Exhibit 1103).

[5] Excerpts from Debra Littlejohn Shinder, *Computer Networking Essentials* (2002) (Ex. 1114).

[6] Excerpts from Paul S. Hethmon, *Illustrated Guide to HTTP* (1997) (Ex. 1109).

[7] Excerpts from Microsoft Press Computer Dictionary (1991) (Ex. 1118).

[8] Moghe, US 6,173,323 B1, issued Jan. 9, 2001 (Ex. 1119).

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Paper 8
Entered: January 19, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01668
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
37 C.F.R. § 42.108

I. INTRODUCTION

The above-captioned Petitioner (Facebook, Inc. and WhatsApp Inc.) filed a Petition requesting *inter partes* review of claims 4, 5, 12, and 24–26 of U.S. Patent No. 8,724,622 B2 (Ex. 1101, "the '622 patent"). Paper 2 ("Pet."). Uniloc Luxembourg S.A. ("Patent Owner")[1] filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

We have authority under 35 U.S.C. § 314. Upon considering the record developed thus far, for reasons discussed below, we institute *inter partes* review of claims 4, 5, 12, and 24–26 of the '622 patent.

II. BACKGROUND

A. Related Matters

The parties indicate that the '622 patent is involved in *Uniloc USA, Inc. v. Facebook, Inc.*, No. 2:16-cv-00728-JRG (E.D. Tex.), and *Uniloc USA, Inc. v. WhatsApp Inc.*, No. 2:16-cv-00645-JRG (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern District of Texas. Pet. 1–3; Paper 3, 2. The '622 patent also was the subject

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[1] Patent Owner's Mandatory Notice filed pursuant to 37 C.F.R. § 42.8 identifies Uniloc Luxembourg S.A. as the owner of the challenged patent and identifies Uniloc USA, Inc. only as licensee and additional real party in interest. Paper 4, 1. Accordingly, we have removed Uniloc USA, Inc. from the case caption as Patent Owner. We note, however, that this identification varies from earlier cases involving the challenged patent and certain related patents, in which Uniloc USA, Inc. and Uniloc Luxembourg S.A. both were identified in mandatory notices as "Patent Owner." *See, e.g.*, IPR2017-00221, Paper 4, 1; IPR2017-00222, Paper 4, 1; IPR2017-00225, Paper 4, 1; IPR2017-01427, Paper 4, 1; IPR2017-01428, Paper 4, 1. The parties are reminded of their ongoing obligation under 37 C.F.R. § 42.8(a)(3) to keep mandatory notices updated.

of two requests for *inter partes* review filed by Apple Inc. ("Apple") on November 14, 2016 (Cases IPR2017-00223 and IPR2017-00224), both of which were denied. *See* IPR2017-00223, Paper 7 (PTAB May 25, 2017); IPR2017-00224, Paper 7 (PTAB May 25, 2017).

Concurrently with the instant Petition, Petitioner additionally filed a petition requesting *inter partes* review of claims 3, 6, 8, 10, 11, 13–23, 27–35, 38, and 39 of the '622 patent (Case IPR2017-01667). IPR2017-01667, Paper 2. Further, Samsung Electronics America, Inc. filed two requests for *inter partes* review of certain claims of the '622 patent on July 20, 2017 (Cases IPR2017-01797 and IPR2017-01798); Apple filed two additional requests for *inter partes* review, also on July 20, 2017, challenging the same claims as the petition in Case IPR2017-01667 and the instant Petition, respectively (Cases IPR2017-01804 and IPR2017-01805); Huawei Device Co., Ltd. ("Huawei") filed a request for *inter partes* review of the same claims as the petition in Case IPR2017-01667 on September 11, 2017 (Case IPR2017-02090); and Google Inc. filed two requests for *inter partes* review of certain claims of the '622 patent on September 12, 2017 (Cases IPR2017-02080 and IPR2017-02081). Apple indicated in its petition in Case IPR2017-01805 that it intends to seek joinder with the instant proceeding "when appropriate." IPR2017-01805, Paper 2, 65.

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. 1101, [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. 1101, 6:22–24.

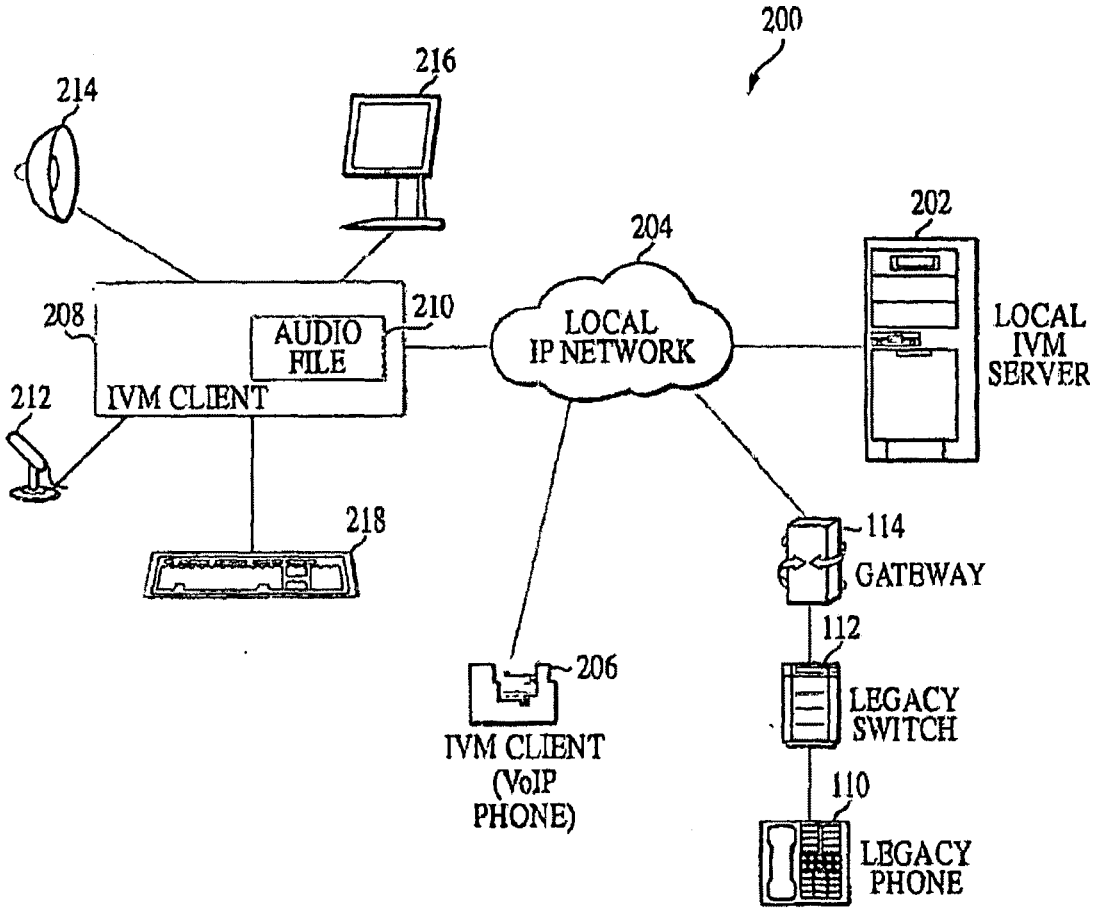

FIG. 2

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. 1101, 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. 1101, 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.

C. Illustrative Claims

Of the challenged claims, only claim 24 is independent. Challenged claims 25 and 26 depend directly from claim 24, and the remaining challenged claims depend directly or indirectly from independent claim 3, which is not challenged in the instant proceeding. Unchallenged claim 3 and challenged claims 4 and 24 are illustrative and are reproduced below.

3. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and

wherein the instant voice message includes an object field including a digitized audio file.

4. The system according to claim 3, wherein the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user.

24. A system comprising:

a network interface connected to a packet-switched network; and

a messaging system communicating with a plurality of instant voice message client systems via the network interface; and

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

wherein the messaging system receives connection object messages from the plurality of instant voice message client systems, wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems.

Ex. 1101, 24:12–30, 25:59–26:8.

D. Asserted Grounds of Unpatentability

Petitioner asserts two grounds of unpatentability (Pet. 5):

Challenged Claim(s)	Basis	References
4, 5, 24–26	§ 103(a)	Zydney,[2] Shinder,[3] and Hethmon[4]
12	§ 103(a)	Zydney, Shinder, Microsoft,[5] and Moghe[6]

Petitioner also relies on a Declaration of Tal Lavian, Ph.D., filed as Exhibit 1102.

III. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim interpretation standard to be applied in *inter partes* reviews). Under the broadest

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[2] Zydney et al., WO 01/11824 A2, published Feb. 15, 2001 (filed with line numbers added by Petitioner as Exhibit 1103).

[3] Excerpts from Debra Littlejohn Shinder, *Computer Networking Essentials* (2002) (Ex. 1114).

[4] Excerpts from Paul S. Hethmon, *Illustrated Guide to HTTP* (1997) (Ex. 1109).

[5] Excerpts from Microsoft Press Computer Dictionary (1991) (Ex. 1118).

[6] Moghe, US 6,173,323 B1, issued Jan. 9, 2001 (Ex. 1119).

reasonable interpretation standard, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We note that only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Petitioner proposes constructions for the terms "connection object messages," as recited in claim 24, and "communication platform system," as recited in claims 3 and 24. Pet. 7–9. Patent Owner points out alleged deficiencies in Petitioner's proposed construction of the latter term and proposes an alternative construction. Prelim. Resp. 6–8. Because our determination to institute review in this case does not turn on the construction of any of the terms for which the parties offer a construction, we do not construe expressly any term at this time.

B. Analysis of Asserted Grounds of Unpatentability

1. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying

factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art;[7] and (4) objective evidence of nonobviousness, i.e., secondary considerations.[8] *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). "To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). We analyze the asserted grounds with the principles stated above in mind.

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[7] Citing the testimony of Dr. Lavian, Petitioner asserts that a person of ordinary skill in the art for purposes of the '622 patent "would have possessed at least a bachelor's degree in computer science, computer engineering, or electrical engineering with at least two years of experience in development and programming relating to network communication systems (or equivalent degree or experience)." Pet. 6 (citing Ex. 1102 ¶¶ 13–15). Patent Owner acknowledges Petitioner's assertion and states that "[t]o simply [sic] the issues before the Board at this preliminary stage, Patent Owner does not presently offer a different definition for a person of ordinary skill in the art." Prelim. Resp. 5–6. Patent Owner further states that the opinion of its own expert, William Easttom II, is "essentially the same as that of Dr. Lavian." *Id.* at 6 (citing Ex. 2001 ¶¶ 14–15). For purposes of this Decision and to the extent necessary, we adopt Petitioner's assessment.

[8] Patent Owner does not contend in its Preliminary Response that any such secondary considerations are present.

2. Ground 1: Obviousness over Zydney, Shinder, and Hethmon (Claims 4, 5, and 24–26)

a. Overview of Zydney

Zydney, titled "Method and System for Voice Exchange and Voice Distribution," relates to packet communication systems that provide for voice exchange and voice distribution between users of computer networks. Ex. 1103, [54], [57], 1:4–5. While acknowledging that e-mail and instant messaging systems were well-known text-based communication systems utilized by users of online services and that it was possible to attach files for the transfer of non-text formats via those systems, Zydney states that the latter technique "lack[ed] a method for convenient recording, storing, exchanging, responding and listening to voices between one or more parties, independent of whether or not they are logged in to their network." *Id.* at 1:7–17. Zydney thus describes a method in which "voice containers"—i.e., "container object[s] that . . . contain[] voice data or voice data and voice data properties"—can be "stored, transcoded and routed to the appropriate recipients instantaneously or stored for later delivery." *Id.* at 1:19–22; 12:6–8. Figure 1 of Zydney is reproduced below.

FIG. 1

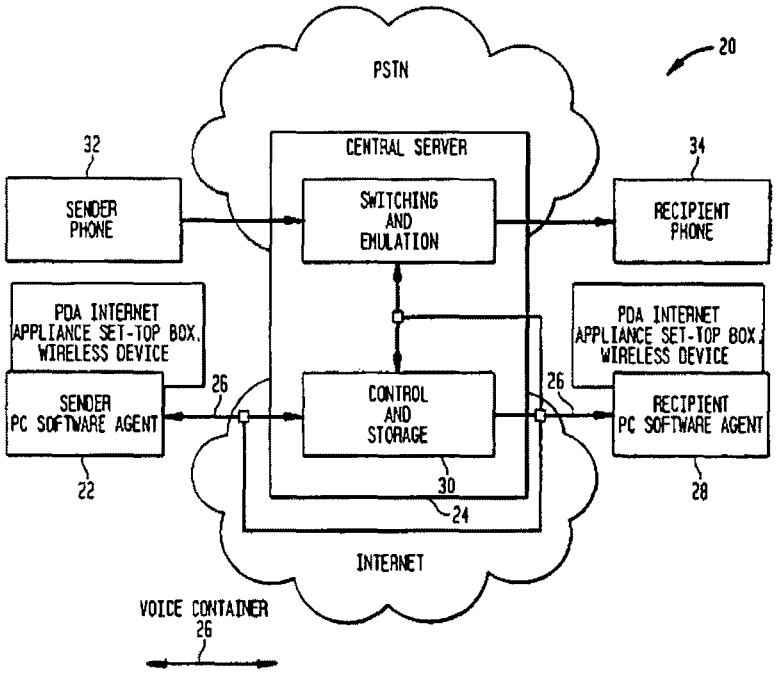

Figure 1, above, illustrates a high-level functional block diagram of Zydney's system for voice exchange and voice distribution. *Id.* at 10:19–20. Referring to Figure 1, system 20 allows software agent 22, with a user interface, in conjunction with central server 24 to send messages using voice containers illustrated by transmission line 26 to another software agent 28, as well as to receive and store such messages, in a "pack and send" mode of operation. *Id.* at 10:20–11:1. Zydney explains that a pack and send mode of operation "is one in which the message is first acquired, compressed and then stored in a voice container 26 which is then sent to its destination(s)." *Id.* at 11:1–3. The system has the ability to store messages both locally and centrally at server 24 whenever the recipient is not available for a prescribed period of time. *Id.* at 11:3–6.

In the use of Zydney's system and method, the message originator selects one or more intended recipients from a list of names that have been previously entered into the software agent. Ex. 1103, 14:17–19. The agent permits distinct modes of communication based on the status of the recipient, including the "core states" of whether the recipient is online or offline and "related status information" such as whether the recipient does not want to be disturbed. *Id.* at 14:19–15:1. Considering the core states, the software agent offers the originator alternative ways to communicate with the recipient, the choice of which can be either dictated by the originator or automatically selected by the software agent, according to stored rules. *Id.* at 15:3–6. If the recipient is online, the originator can either begin a real-time "intercom" call, which simulates a telephone call, or a voice instant messaging session, which allows for an interruptible conversation. *Id.* at 15:8–10. If the recipient is offline, the originator can either begin a voice mail conversation that will be delivered the next time the recipient logs in or can be delivered to the recipient's e-mail as a digitally encoded Multipurpose Internet Mail Extension ("MIME") attachment. *Id.* at 15:15–17. Zydney explains that the choice of the online modes "depends on the activities of both parties, the intended length of conversation and the quality of the communications path between the two individuals, which is generally not controlled by either party," and that the choice of the offline delivery options "is based on the interests of both parties and whether the recipient is sufficiently mobile that access to the registered computer is not always available." *Id.* at 15:10–14, 15:17–19.

Once the delivery mode has been selected, the originator digitally records messages for one or more recipients using a microphone-equipped

device and the software agent. Ex. 1103, 16:1–3. The software agent compresses the voice and stores the file temporarily on the PC if the voice will be delivered as an entire message. *Id.* at 16:3–4. If the real-time "intercom" mode has been invoked, a small portion of the digitized voice is stored to account for the requirements of the Internet protocols for retransmission and then transmitted before the entire conversation has been completed. *Id.* at 16:4–7. Based on status information received from the central server, the agent then decides whether to transport the voice container to a central file system and/or to send it directly to another software agent using the IP address previously stored in the software agent. *Id.* at 16:7–10. If the intended recipient has a compatible active software agent online after log on, the central server downloads the voice recording almost immediately to the recipient. *Id.* at 16:10–12. The voice is uncompressed and the recipient can hear the recording through the speakers or headset attached to its computer. *Id.* at 16:12–14. The recipient can reply in a complementary way, allowing for near real-time communications. *Id.* at 16:14–15. If the recipient's software agent is not online, the voice recording is stored in the central server until the recipient's software agent is active. *Id.* at 16:15–17. "In both cases, the user is automatically notified of available messages once the voice recordings have been downloaded to storage on their computer." *Id.* at 16:17–19. The central server coordinates with software agents on all computers continuously, updating addresses, uploading and downloading files, and selectively retaining voice recordings in central storage. *Id.* at 16:19–21.

Zydney discloses that the voice container also has the ability to have other data types attached to it. Ex. 1103, 19:6–7. Formatting the container

using MIME format, for example, "allows non-textual messages and multipart message bodies attachments [sic] to be specified in the message headers." *Id.* at 19:7–10.

Figure 3 of Zydney is reproduced below.

FIG. 3

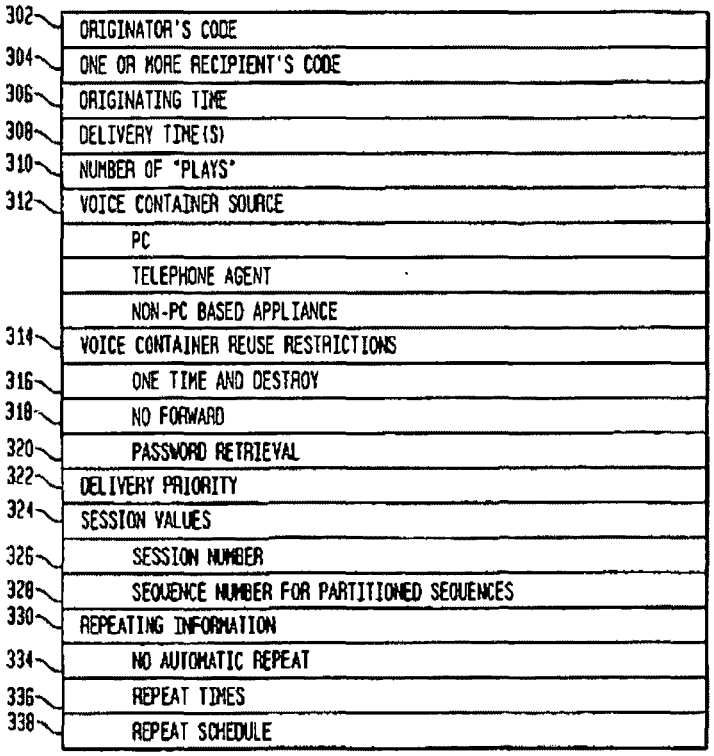

Figure 3, above, illustrates an exemplary embodiment of Zydney's voice container structure, including voice data and voice data properties components. Ex. 1103, 2:19, 23:1–2. Referring to Figure 3, voice container components include:

> [O]riginator's code 302 (which is a unique identifier), one or more recipient's code 304, originating time 306, delivery time(s) 308, number of "plays" 310, voice container source 312 which may be a PC, telephone agent, non-PC based appliance, or other, voice container reuse restrictions 314 which may include one time and destroy 316, no forward 318, password

> retrieval 320, delivery priority 322, session values 324, session number 326, sequence number for partitioned sequences[] 328, repeating information 330, no automatic repeat 332, repeat times 334, and a repeat schedule 336.

Id. at 23:2–10.

b. Overview of Shinder

Shinder provides an overview of the "fundamentals of computer networking concepts and implementation." Ex. 1114, 5. According to Shinder, it is "becom[ing] vital to business interests that a LAN be able to communicate with the outside" and, thus, to connect to a wide area network ("WAN"), such as the Internet. *Id.* at 31.

c. Overview of Hethmon

Hethmon provides a guide to Hypertext Transfer Protocol ("HTTP"), focusing primarily on version HTTP/1.1. Ex. 1109, 1; *see also id.* at 9–13 (briefly describing historical versions HTTP/0.9 and HTTP/1.0). Hethmon explains that HTTP is the protocol used to send and receive messages between Web clients and servers over the Internet. *Id.* at 10. Hethmon describes HTTP as a "request-response" type of protocol, in which a client application sends a request to the server and then the server responds to the request. *Id.* According to Hethmon, the "Request Message" sent by a client to a server to request a resource in HTTP/1.1 included a "Request-Line and possibly a set of header lines," with the following overall syntax:

```
Request       =Request-Line
                *(    General-Header
                 |    Request-Header
                 |    Entity-Header   )
                CRLF
                [ Entity-Body ]
Request-Line = Method SP Request-URI SP HTTP-Version CRLF
```

Ex. 1109, 51. Hethmon explains that "[t]he request line is the message sent by the client to the server to request a resource or an action to take place" and that "[a]ll request lines begin with a Method," where the "Method" is "a keyword such as GET or POST which indicate the type [of] action the request is asking the server to execute." *Id.* at 51–52. Hethmon further explains that there were seven basic methods available in HTTP/1.1: OPTIONS, GET, HEAD, POST, PUT, DELETE, and TRACE. *Id.* at 52.

d. Arguments and Analysis

i. Claims 4 and 5

Petitioner points to Zydney as disclosing all limitations of independent claim 3, from which, as noted above, claims 4 and 5 directly or indirectly depend, except that it relies on Shinder's disclosure of network interface controllers ("NICs") (Ex. 1114, 42–43) as rendering obvious the "network interface" recited in claim 3 and on Shinder's disclosure that "[a]n example of a packet-switched network is the Internet" (*id.* at 19) as rendering obvious that the Internet as disclosed in Zydney would have been a packet-switched network, also as recited in claim 3. Pet. 21–36. Petitioner additionally relies on Hethmon, in combination with Zydney and Shinder, for the further limitation of claim 4, "wherein the instant voice message includes an action field identifying one of a predetermined set of permitted

actions requested by the user." Pet. 37–45. Patent Owner disputes Petitioner's evidence, arguing in particular that Zydney does not render obvious the claim 3 limitation "wherein the instant voice message includes an object field," and that Zydney teaches away from the claim 4 limitation "wherein the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user." Prelim. Resp. 10–18. Notwithstanding Patent Owner's arguments, we are persuaded for the reasons that follow that Petitioner has established a reasonable likelihood of prevailing in showing that claims 4 and 5 are unpatentable over Zydney, Shinder, and Hethmon.

With respect to the claim 3 limitation "wherein the instant voice message includes an object field," Petitioner contends that, although the '622 patent does not expressly define the term "object field," the meaning of that term "is reasonably clear from the specification, which explains that '[t]he content of the object field is a block of data being carried by the message object, which may be, for example, a digitized instant voice message.'" Pet. 34 (emphasis omitted) (quoting Ex. 1101, 14:37–40). Relying on Dr. Lavian's testimony as to what a person of ordinary skill in the art would have understood from that disclosure, Petitioner argues Zydney discloses the object field in at least two independent ways. *Id.* at 34–36 (citing Ex. 1102 ¶¶ 137–138, 141–144).

First, according to Petitioner, "Zydney expressly refers to [its] voice container," which Petitioner maps to the recited instant voice message, "as an 'object' that contains voice data: 'The term "voice containers" as used throughout this application refers to a container object that contains no methods, but contains voice data or voice data and voice data properties.'"

Pet. 34–35 (emphasis omitted) (quoting Ex. 1103, 12:6–8). While conceding that Zydney does not use the specific word "field" in relation to storage of voice data, Petitioner asserts that a person of ordinary skill in the art "would have understood that the voice data is contained in a field of the voice container." *Id.* at 35 (citing Ex. 1102 ¶¶ 137–138). Petitioner further contends it would also have been obvious that the Zydney voice container would contain an object field "because, without one, the recipient device could not separate the voice data from the other fields of data in the voice container and play back the voice data for the user – a capability the recipient in Zydney has." *Id.* (citing Ex. 1102 ¶ 138 n.13).

Second, Petitioner argues, Zydney discloses that voice containers can be encoded using the industry-standard MIME format, "which 'allows non-textual messages and multipart message bodies [sic] attachments to be specified in the message headers,'" and Zydney also specifically refers to and incorporates by reference Request for Comments ("RFC") 1521 (Ex. 1106), which "explains that a MIME message can contain audio or voice data in the 'body,' the field of the message containing the content being conveyed." Pet. 35–36 (emphasis omitted) (citing Ex. 1102 ¶ 143; Ex. 1103, 19:7–10, 19:13–20:9; Ex. 1106). Relying on Dr. Lavian's testimony, Petitioner contends that because Zydney itself discloses that voice containers can be encoded using MIME and directly cites to RFC 1521, "it would have been plainly obvious to a person of ordinary skill in the art to provide the receiving software agent with the ability to format the voice container according to RFC 1521, thus encoding the voice data in the body (an 'object field') of the message." *Id.* at 36 (emphasis omitted) (citing Ex. 1102 ¶¶ 141–144).

With regard to the further limitation of claim 4, "wherein the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user," Petitioner concedes that Zydney "does not appear to explicitly describe" that the instant voice message contains such a "field," but contends that this feature "would have been obvious over Zydney in view of Hethmon." *Id.* at 37 (emphasis omitted). More specifically, Petitioner contends that the HTTP/1.1 Request-Line, as described by Hethmon, discloses "an action field identifying one of a predetermined set of permitted actions requested by the user." *Id.* at 39 (emphasis omitted) (citing Ex. 1102 ¶ 308). According to Petitioner:

> Hethmon illustrates how the Method in the Request-Line identifies a permitted action requested by the user. For example, "[t]he POST method is used as a way for a client application to submit data to a resource on a server application." ([Ex. 1109, 75].) The data to be transmitted is contained in the "Entity-Body" field in the request message. (*Id.* [at 51].) Specifically, "[u]sing the POST method, the client sends an entity body to the server for processing." (*Id.* [at 75].) "This allows for data submission via HTTP to accomplish various goals, such as database updating or order entry." (*Id.* [at 55].) The POST method may be used to transmit data of various types. (*See id.* [at 75]; [Ex. 1002] ¶309.)

Pet. 39. Thus, according to Petitioner, an HTTP message with a POST method provides an example of an action field, as recited in claim 4, and "[i]n fact, the '622 patent expressly refers to a 'post message' as one of the permitted actions that can be in the 'action field.'" *Id.* at 40 (emphasis omitted) (citing Ex. 1101, 14:6–10).

Patent Owner responds that Petitioner errs by relying on Zydney's voice container for the claimed "instant voice message," contending that "Zydney distinguishes voice containers from voice messages." Prelim.

Resp. 10 (emphasis omitted). Further, Patent Owner contends, Petitioner's "conclusory speculation" that "a person of ordinary skill in the art would have understood that the voice data is contained in a field of the voice container" "should be rejected for at least . . . six reasons." *Id.* at 12. First, according to Patent Owner, Petitioner's statements are based on "mere speculation or conjecture." *Id.* at 12–13. Second, the claim language does not recite "'a field' in the abstract," but instead "identifies a *specific type* of field—namely, an '*object* field.'" *Id.* at 13. Third, "Zydney does not use the word 'field' at all in relation to its voice container," and "[w]hile Zydney describes the 'voice container structural components' with reference to Figure 3, notably absent from the list of twenty-five structural components (elements 302 through 338) is anything resembling 'an object field including a digitized audio file.'" *Id.* at 13–14 (emphasis omitted) (citing Ex. 1103, 23:1–12). Fourth, Patent Owner contends Zydney itself "refutes Petitioner's speculation that Zydney must have used an undisclosed 'structural component' dedicated exclusively to an 'audio digital file.'" *Id.* at 14 (emphasis omitted). More particularly, according to Patent Owner, "Figure 3 of Zydney and its accompanying description . . . provide no less than four different examples of 'structural components' that each group together multiple items of information." *Id.* (emphasis omitted). Fifth, Patent Owner contends, "the distinction between Zydney's 'structural components' and the claimed 'object field' is not mere semantics but rather reflects fundamentally different technologies." *Id.* at 15 (emphasis omitted). More specifically, "[a] person of ordinary skill in the art . . . would have recognized the word 'field' as a term of art in the context of packet-switched networks, particularly in light of the teachings of the '622 patent," and

"would have recognized that network packets have headers with various fields describing things such as source address, destination address, port, protocol, etc." *Id.* (emphasis omitted) (citing Ex. 2001 ¶ 48). Sixth, Patent Owner contends, "Zydney does not enable, and indeed could not even have functioned as described, using packet-switched fields of hypertext transfer protocol ('HTTP'), as it existed in August 7, 2000 (Zydney's filing date)." *Id.* at 16 (emphasis omitted) (citing Ex. 2001 ¶ 51).

Regarding Petitioner's contention that the claim 4 limitation "wherein the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user" is taught by the combination of Hethmon with Zydney and Shinder, Patent Owner contends "explicit teachings in Zydney . . . would lead a person of ordinary skill in the art away from the proposed combination." Prelim. Resp. 17 (emphasis omitted). Pointing in particular to Zydney's definition of "voice container" as, in part, "a container object that contains no methods," Patent Owner argues that, "[c]ontrary to the definitive statement that *Zydney's* container—by intended design—*contains no methods*, Petitioner's proposed modification would further require containment of 'a "Method" that identifies an action to be taken on a resource,' as allegedly disclosed in *Hethmon*." *Id.* Patent Owner further contends that Petitioner fails to explain "how *Zydney's* voice container (specifically designed *to contain no methods*) would still be satisfactory for its intended purpose if it was modified as proposed." *Id.* at 18.

Having considering the parties' respective arguments and evidence, we are persuaded that Petitioner sufficiently demonstrates a reasonable likelihood at this juncture that claim 4 is unpatentable over the combination

of Zydney, Shinder, and Hethmon. As a preliminary matter, although Patent Owner disputes Petitioner's mapping of Zydney's voice container to the claimed instant voice message (Prelim. Resp. 10), we find Petitioner's evidence sufficient at this stage of the proceeding. Patent Owner's arguments are premised on an implied construction of "instant voice message" as encompassing *only* the voice message and excluding all else. Indeed, Patent Owner's expert testimony makes a distinction between Zydney's voice container and the "instant voice message" that appears to be rooted in characterizing the "instant voice message" as audio data only. *Id.* at 10–11 (citing Ex. 2001 ¶¶ 44–45). This is an argument of claim construction that is underdeveloped at this juncture and has been presented only in connection with arguments distinguishing Zydney. On the present record, we do not have sufficient evidence or argument from either party to render even a preliminary construction for the term "instant voice message." Accordingly, at this time, none of Patent Owner's arguments distinguishing the prior art with regard to the scope of the "instant voice message" are persuasive. The parties will have an opportunity during trial to present fully claim construction briefing for the term "instant voice message."

Regarding the instant voice message including "an object field including a digitized audio file," Patent Owner does not persuasively rebut Petitioner's evidence. Notwithstanding Patent Owner's arguments that Petitioner's statements are based on "mere speculation or conjecture" and that an object field is a "specific type of field" (Prelim. Resp. 12–13 (emphasis omitted)), we are sufficiently persuaded at this stage by Petitioner's evidence, including Dr. Lavian's testimony, that it would have been obvious to a person of ordinary skill in the art at the time of the alleged

invention to include an object field in Zydney's voice container for storage of voice data. Zydney expressly discloses voice data is transmitted in a voice container, where the term voice container "refers to a container *object*" that may be formatted according to industry standards such as MIME format. Ex. 1103, 12:6–7 (emphasis added), 19:6–20:9 (citing, e.g., Ex. 1106). Although Zydney does not utilize the term "field" *ipssisimis verbis*, at this time we credit Dr. Lavian's testimony, supported by RFC1521 and unrebutted on the record before us, that when in MIME format, Zydney's voice container would contain the digitized audio file in an object field. Ex. 1102 ¶¶ 141–144.

Finally, we are sufficiently persuaded for purposes of institution that inclusion of an action field identifying one of a predetermined set of permitted actions requested by the user in an instant voice message, as recited in claim 4, would have been obvious over Zydney in view of Hethmon, and that a person of ordinary skill in the art would have had reason to combine the references' teachings. Although Patent Owner accurately cites Zydney as stating that "voice container" refers to a container object that contains no methods (Prelim. Resp. 17), we are not persuaded on this record that the "Method" field of the HTTP/1.1 Request-Line described by Hethmon is the sort of "method" that Zydney's container object is intended to exclude. Rather, on the limited record before us, and based on the cited portions of Hethmon's disclosure, we understand the Request-Line "Method" merely to be a keyword *identifying* a method, rather than as actually *being* a method. *See, e.g.*, Ex. 1109, 52 ("All request lines being with a Method. *This is a keyword* . . . which indicate[s] [a] type [of] action the request is asking the server to execute." (emphasis added)). Based on

that understanding, we are not persuaded at this juncture that Zydney teaches away from the proposed combination of Hethmon with Zydney and Shinder. The parties will have an opportunity to brief this issue more fully during trial.

Accordingly, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claim 4 is unpatentable over Zydney, Shinder, and Hethmon. Patent Owner does not argue dependent claim 5 separately from claim 4. For the same reasons as stated regarding claim 4 and based on our review of Petitioner's arguments and evidence directed to the additional limitations of claim 5, we also determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claim 5 is unpatentable over Zydney, Shinder, and Hethmon.

ii. Claims 24–26

In a similar manner as for claim 3, Petitioner relies on Shinder as teaching the "network interface" and "packet-switched network" recited in claim 24 and on Zydney for the messaging system and communication platform system limitations of claim 24. Pet. 46. With respect to the further limitations of claim 24, "wherein the messaging system receives connection object messages from the plurality of instant voice message client systems" and "wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems," Petitioner relies again on Hethmon's description of the HTTP POST method, discussed previously with respect to claim 4, in the "Method" field of the HTTP/1.1 Request-Line. *Id.* at 47–50. Relying on Dr. Lavian's testimony, Petitioner

contends that "[a] person of ordinary skill in the art would have understood and found it obvious to use a POST method . . . as the vehicle to provide the client's status information to the central server." *Id.* at 48 (emphasis omitted) (citing Ex. 1102 ¶ 328; Ex. 1109, 75 ("The POST method is used as a way for a client application to submit data to a resource on a server application.")). Further, "[t]he POST message under the combination of Zydney and Hethmon also contains data representing the state of the connection, i.e., data indicating the client's status as disclosed in Zydney." *Id.* (emphasis omitted) (citing Ex. 1102 ¶ 331; Ex. 1103, 14:2–4). Petitioner also presents an alternative mapping based of "logical connection" to Hethmon, based on Hethmon's description of HTTP/1.1's "persistent connections" feature, in which a connection is established between a client and server that remains open until a "close" value is provided in a request header. *Id.* at 50–51 (citing Ex. 1109, 15, 86, 148).

In response to Petitioner's contentions regarding claim 24, Patent Owner raises essentially the same argument as with respect to claim 4, namely, that Zydney teaches away from combination with Hethmon because Zydney's voice container is stated to contain "no methods," whereas the proposed combination with Hethmon would require containment of one or more methods. Prelim. Resp. 19–20. For the reasons set forth in our above discussion of claim 4, we are not persuaded by Patent Owner's argument. *See supra* Section III.B.2.d.i. Moreover, even assuming *arguendo* that the HTTP/1.1 Request-Line Method field is properly understood to include a method within the meaning of that term as used in Zydney's definition of a voice container, the record is not yet developed at this juncture with respect

to whether claim 24 requires the recited "connection objects" to be included within the recited instant voice message itself.

We also are unpersuaded on the present record by a second set of arguments raised by Patent Owner, specifically that Zydney teaches away from using HTTP and that Zydney's transport mechanism would not have worked with HTTP. Prelim. Resp. 20–22. We instead credit the testimony of Dr. Lavian proffered by Petitioner, which Patent Owner does not persuasively rebut at this juncture, that "a person of ordinary skill in the art would have perceived no significant technical obstacle in implementing the combination of Zydney and Hethmon," as "Zydney discloses using standard [Transmission Control Protocol/Internet Protocol ("TCP/IP")] techniques to transport a voice container to the server," and "[b]ecause HTTP is built on top of TCP/IP, it would have been straightforward to use HTTP to facilitate voice container delivery from clients to the central server." Ex. 1102 ¶ 319.

Accordingly, we determine that on this record, Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claim 24 is unpatentable as obvious over Zydney, Shinder, and Hethmon. Patent Owner does not argue dependent claims 25 and 26 separately from claim 24. For the same reasons as stated regarding claim 24 and based on our review of Petitioner's arguments and evidence directed to the additional limitations of claims 25 and 26, we also determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that those claims are unpatentable over Zydney, Shinder, and Hethmon.

3. Ground 2: Obviousness over Zydney, Shinder, Microsoft, and Moghe (Claim 12)

Claim 12 depends from claim 3 and further recites "wherein the communication platform system updates the connection information for each of the instant voice message client systems by periodically transmitting a connection status request to the given one of the plurality of instant voice message client systems." Ex. 1101, 25:4–8. Petitioner concedes that "Zydney does not appear to explicitly describe the underlying details of how the central server tracks and maintains the status of all software agents," but Petitioner contends that a person of ordinary skill in the art would have been familiar with several well-known ways of updating the connectivity status. Pet. 57–58 (citing Ex. 1102 ¶ 353). Petitioner asserts that "[o]ne such well-known technique was polling, where one system periodically polls other systems (e.g., periodically requests that status from the other systems) to determine and update the status of each system." *Id.* at 58 (emphasis omitted) (citing Ex. 1102 ¶ 353). Petitioner cites Microsoft as defining "polling" as, in part, "[t]he process of periodically determining the status of each device in a set so that the active program can process events generated through each device." *Id.* at 58 (citing Ex. 1118, 5–6). Petitioner additionally cites Microsoft's definition of "polling cycle" as "[t]he time and sequence required for a program to poll each of its devices or network nodes," as evincing that polling can be performed on "network nodes." *Id.* at 59 (citing Ex. 1118, 7). Petitioner further cites Moghe, as "explain[ing] that polling provides a technique for requesting the status of other devices or resources on a network. *Id.* at 59–60 (emphasis omitted) (citing Ex. 1119, 1:14–22). Lastly, Petitioner contends that it would have been obvious to adapt well-known polling techniques, as described in Microsoft and Moghe,

to the system of Zydney, asserting that the combination "would have predictably resulted in the instant voice messaging system of Zydney in which the system of the central server . . . periodically transmits a connection status request to the software agent on each client inquiring about its current status, in order to update the system's connection information." *Id.* at 60. Patent Owner does not argue claim 12 separately from claim 3.

Having reviewed the information presented by the parties at this juncture, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claim 12 is unpatentable over Zydney, Shinder, Microsoft, and Moghe.

IV. CONCLUSION

In summary, based on our review of the arguments and evidence in the Petition and Preliminary Response, we institute *inter partes* review of the challenged claims of the '622 patent on the following grounds:

Ground	**Basis**	**Claims Challenged**	**Claims Instituted**
1	§ 103 Zydney, Shinder, and Hethmon	4, 5, 24–26	4, 5, 24–26
2	§ 103 Zydney, Shinder, Microsoft, and Moghe	12	12
Summary		4, 5, 12, 24–26	4, 5, 12, 24–26

V. ORDER

Upon consideration of the record before us, it is, therefore,

ORDERED that an *inter partes* review is instituted as to claims 4, 5, 12, and 24–26 of the '622 patent on the following grounds:

(1) Claims 4, 5, and 24–26 under 35 U.S.C. § 103(a) as unpatentable over Zydney, Shinder, and Hethmon, and

(2) Claim 12 under 35 U.S.C. § 103(a) as unpatentable over Zydney Shinder, Microsoft, and Moghe;

FURTHER ORDERED that no other grounds are authorized; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '622 patent is hereby instituted commencing on the entry date of this Decision, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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Paper 8
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and WHATSAPP INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-01667
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
37 C.F.R. § 42.108

I. INTRODUCTION

The above-captioned Petitioner (Facebook, Inc. and WhatsApp Inc.) 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 2 ("Pet."). Uniloc Luxembourg S.A. ("Patent Owner")[1] filed a Preliminary Response. Paper 6 ("Prelim. Resp.").

We have authority under 35 U.S.C. § 314. Upon considering the record developed thus far, 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.

II. BACKGROUND

A. Related Matters

The parties indicate that the '622 patent is involved in *Uniloc USA, Inc. v. Facebook, Inc.*, No. 2:16-cv-00728-JRG (E.D. Tex.), and *Uniloc USA, Inc. v. WhatsApp Inc.*, No. 2:16-cv-00645-JRG (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern

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[1] Patent Owner's Mandatory Notice filed pursuant to 37 C.F.R. § 42.8 identifies Uniloc Luxembourg S.A. as the owner of the challenged patent and identifies Uniloc USA, Inc. only as licensee and additional real party in interest. Paper 4, 1. Accordingly, we have removed Uniloc USA, Inc. from the case caption as Patent Owner. We note, however, that this identification varies from earlier cases involving the challenged patent and certain related patents, in which Uniloc USA, Inc. and Uniloc Luxembourg S.A. both were identified in mandatory notices as "Patent Owner." *See, e.g.*, IPR2017-00221, Paper 4, 1; IPR2017-00222, Paper 4, 1; IPR2017-00225, Paper 4, 1; IPR2017-01427, Paper 4, 1; IPR2017-01428, Paper 4, 1. The parties are reminded of their ongoing obligation under 37 C.F.R. § 42.8(a)(3) to keep mandatory notices updated.

District of Texas. Pet. 1–3; Paper 4, 2. The '622 patent also was the subject of two requests for *inter partes* review filed by Apple Inc. ("Apple") on November 14, 2016 (Cases IPR2017-00223 and IPR2017-00224), both of which were denied. *See* IPR2017-00223, Paper 7 (PTAB May 25, 2017); IPR2017-00224, Paper 7 (PTAB May 25, 2017).

Concurrently with the instant Petition, Petitioner additionally filed a petition requesting *inter partes* review of claims 4, 5, 12, and 24–26 of the '622 patent (Case IPR2017-01668). IPR2017-01668, Paper 2. Further, Samsung Electronics America, Inc. filed two requests for *inter partes* review of certain claims of the '622 patent on July 20, 2017 (Cases IPR2017-01797 and IPR2017-01798); Apple filed two additional requests for *inter partes* review, also on July 20, 2017, challenging the same claims as the instant Petition and the petition in Case IPR2017-01668, respectively (Cases IPR2017-01804 and IPR2017-01805); Huawei Device Co., Ltd. ("Huawei") filed a request for *inter partes* review of the same claims as the instant Petition on September 11, 2017 (Case IPR2017-02090); and Google Inc. filed two requests for *inter partes* review of certain claims of the '622 patent on September 12, 2017 (Cases IPR2017-02080 and IPR2017-02081). Huawei additionally filed a motion for joinder to the instant proceeding concurrently with its petition in Case IPR2017-02090, and Apple indicated in its petition in Case IPR2017-01804 that it intends to seek joinder with the instant proceeding "when appropriate." IPR2017-02090, Paper 3; IPR2017-01804, Paper 2, 76.

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.

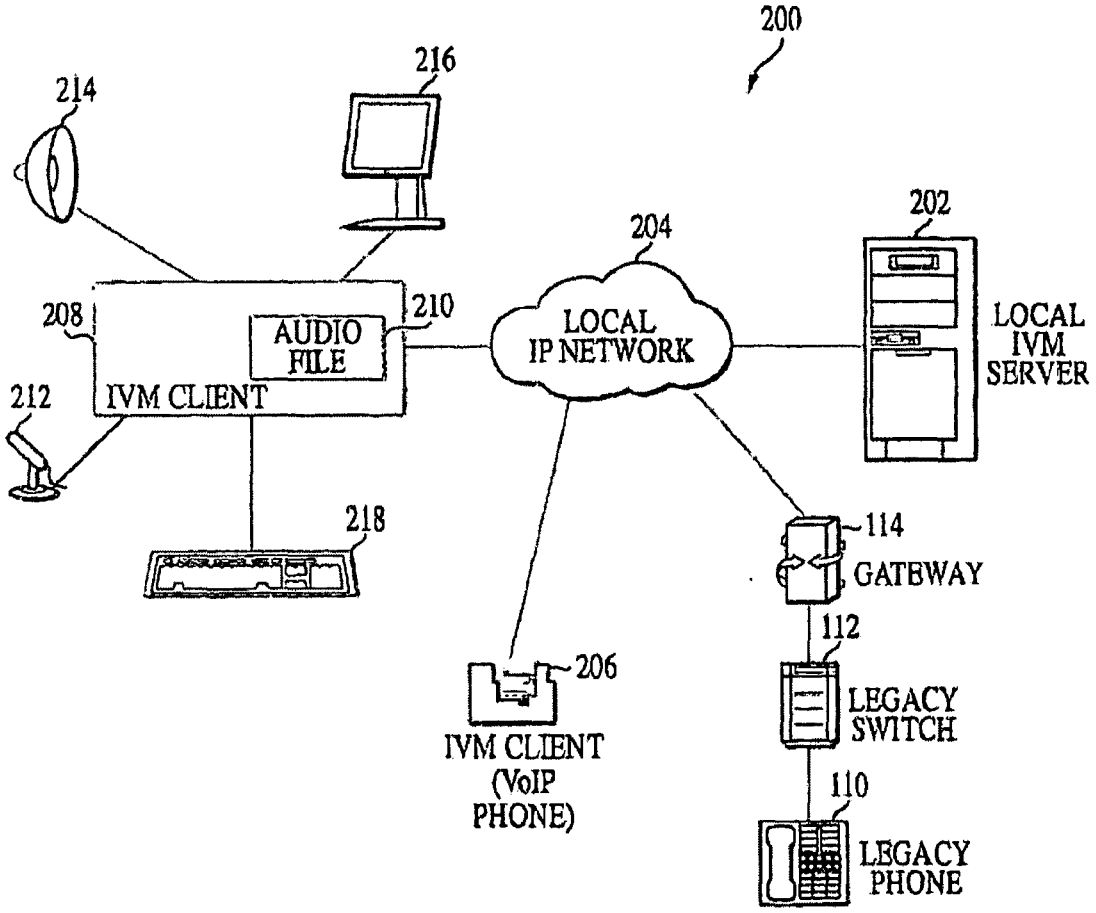

FIG. 2

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.

C. Illustrative Claims

Of the challenged claims, claims 3, 27, and 38 are independent. Claims 3 and 27 are illustrative of the challenged claims and are reproduced below.

3. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,
   wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and

wherein the instant voice message includes an object field including a digitized audio file.

27. A system comprising:
a client device;
a network interface coupled to the client device and connecting the client device to a packet-switched network; and
an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,
wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message.

Ex. 1001, 24:12–27, 26:17–30.

D. Asserted Grounds of Unpatentability

Petitioner asserts three grounds of unpatentability (Pet. 5):

Challenged Claims	Basis	References
3, 6–8, 10, 11, 13, 18–21, 23, 27, 32–35, 38	§ 103(a)	Zydney[2] and Shinder[3]
14–17, 28–31	§ 103(a)	Zydney, Shinder, and Clark[4]

[2] Zydney et al., WO 01/11824 A2, published Feb. 15, 2001 (filed with line numbers added by Petitioner as Exhibit 1003).

[3] Excerpts from Debra Littlejohn Shinder, *Computer Networking Essentials* (2002) (Ex. 1014).

[4] Clark et al., US 6,725,228 B1, issued Apr. 20, 2004 (Ex. 1008).

Challenged Claims	Basis	References
22, 39	§ 103(a)	Zydney, Shinder, and Appelman[5]

Petitioner also relies on a Declaration of Tal Lavian, Ph.D., filed as Exhibit 1002.

III. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim interpretation standard to be applied in *inter partes* reviews). Under the broadest reasonable interpretation standard, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We note that only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

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[5] Appelman, US 6,750,881 B1, issued June 15, 2004 (Ex. 1004).

Petitioner proposes constructions for the terms "instant voice messaging application," as recited in claims 13, 27, and 38; "client platform system," as recited in claims 27 and 38; and "communication platform system," as recited in claim 3. Pet. 6–11. Patent Owner points out alleged deficiencies in Petitioner's proposed constructions and proposes alternative constructions for each. Prelim. Resp. 7–16. Because our determination to institute review in this case does not turn on the construction of any of the terms for which the parties offer a construction, we do not construe expressly any term at this time.

B. Analysis of Asserted Grounds of Unpatentability

1. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are "such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art;[6] and (4) objective evidence of

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[6] Citing the testimony of Dr. Lavian, Petitioner asserts that a person of ordinary skill in the art for purposes of the '622 patent "would have possessed at least a bachelor's degree in computer science, computer engineering, or electrical engineering with at least two years of experience in development and programming relating to network communication systems (or equivalent degree or experience)." Pet. 6 (citing Ex. 1002 ¶¶ 13–15).

nonobviousness, i.e., secondary considerations.[7] *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). "To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). We analyze the asserted grounds with the principles stated above in mind.

2. Ground 1: Obviousness over Zydney and Shinder (Claims 3, 6–8, 10, 11, 13, 18–21, 23, 27, 32–35, and 38)

a. Overview of Zydney

Zydney, titled "Method and System for Voice Exchange and Voice Distribution," relates to packet communication systems that provide for voice exchange and voice distribution between users of computer networks. Ex. 1003, [54], [57], 1:4–5. While acknowledging that e-mail and instant messaging systems were well-known text-based communication systems utilized by users of online services and that it was possible to attach files for

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Patent Owner acknowledges Petitioner's assertion and states that "[t]o simplify the issues before the Board at this preliminary stage, Patent Owner does not presently offer a different definition for a person of ordinary skill in the art." Prelim. Resp. 6. Patent Owner further cites its own expert, William Easttom II, as providing a slightly different definition, but notes that "Mr. Easttom believes Dr. Lavian's opinions concerning the [person of ordinary skill in the art] are essentially the same as his, and any differences are inconsequential to the dispute before the Board. *Id.* (citing Ex. 2001 ¶ 21). For purposes of this Decision and to the extent necessary, we adopt Petitioner's assessment.

[7] Patent Owner does not contend in its Preliminary Response that any such secondary considerations are present.

the transfer of non-text formats via those systems, Zydney states that the latter technique "lack[ed] a method for convenient recording, storing, exchanging, responding and listening to voices between one or more parties, independent of whether or not they are logged in to their network." *Id.* at 1:7–17. Zydney thus describes a method in which "voice containers"—i.e., "container object[s] that . . . contain[] voice data or voice data and voice data properties"—can be "stored, transcoded and routed to the appropriate recipients instantaneously or stored for later delivery." *Id.* at 1:19–22; 12:6–8. Figure 1 of Zydney is reproduced below.

FIG. 1

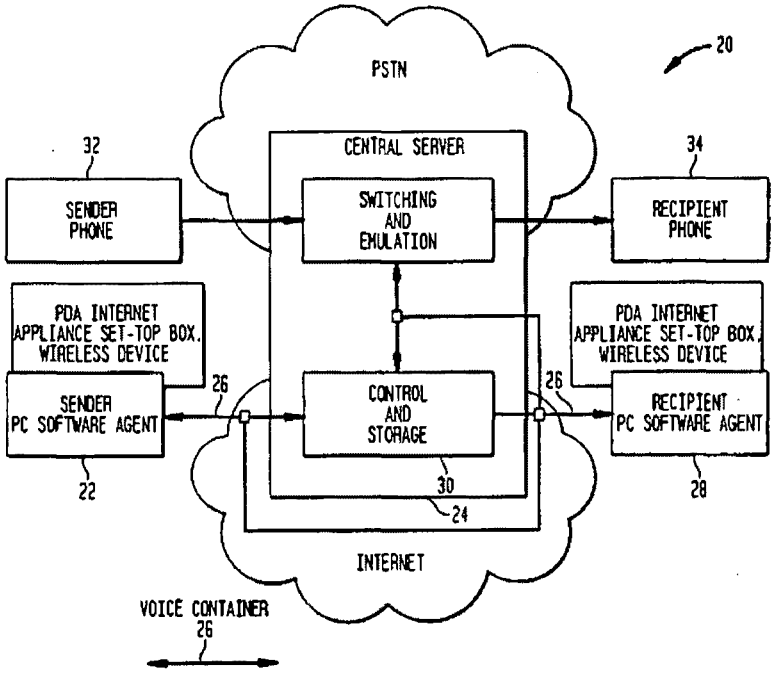

Figure 1, above, illustrates a high-level functional block diagram of Zydney's system for voice exchange and voice distribution. *Id.* at 10:19–20. Referring to Figure 1, system 20 allows software agent 22, with a user interface, in conjunction with central server 24 to send messages using voice

containers illustrated by transmission line 26 to another software agent 28, as well as to receive and store such messages, in a "pack and send" mode of operation. *Id.* at 10:20–11:1. Zydney explains that a pack and send mode of operation "is one in which the message is first acquired, compressed and then stored in a voice container 26 which is then sent to its destination(s)." *Id.* at 11:1–3. The system has the ability to store messages both locally and centrally at server 24 whenever the recipient is not available for a prescribed period of time. *Id.* at 11:3–6.

In the use of Zydney's system and method, the message originator selects one or more intended recipients from a list of names that have been previously entered into the software agent. Ex. 1003, 14:17–19. The agent permits distinct modes of communication based on the status of the recipient, including the "core states" of whether the recipient is online or offline and "related status information" such as whether the recipient does not want to be disturbed. *Id.* at 14:19–15:1. Considering the core states, the software agent offers the originator alternative ways to communicate with the recipient, the choice of which can be either dictated by the originator or automatically selected by the software agent, according to stored rules. *Id.* at 15:3–6. If the recipient is online, the originator can either begin a real-time "intercom" call, which simulates a telephone call, or a voice instant messaging session, which allows for an interruptible conversation. *Id.* at 15:8–10. If the recipient is offline, the originator can either begin a voice mail conversation that will be delivered the next time the recipient logs in or can be delivered to the recipient's e-mail as a digitally encoded Multipurpose Internet Mail Extension ("MIME") attachment. *Id.* at 15:15–17. Zydney explains that the choice of the online modes "depends on the

activities of both parties, the intended length of conversation and the quality of the communications path between the two individuals, which is generally not controlled by either party," and that the choice of the offline delivery options "is based on the interests of both parties and whether the recipient is sufficiently mobile that access to the registered computer is not always available." *Id.* at 15:10–14, 15:17–19.

Once the delivery mode has been selected, the originator digitally records messages for one or more recipients using a microphone-equipped device and the software agent. Ex. 1003, 16:1–3. The software agent compresses the voice and stores the file temporarily on the PC if the voice will be delivered as an entire message. *Id.* at 16:3–4. If the real-time "intercom" mode has been invoked, a small portion of the digitized voice is stored to account for the requirements of the Internet protocols for retransmission and then transmitted before the entire conversation has been completed. *Id.* at 16:4–7. Based on status information received from the central server, the agent then decides whether to transport the voice container to a central file system and/or to send it directly to another software agent using the IP address previously stored in the software agent. *Id.* at 16:7–10. If the intended recipient has a compatible active software agent online after log on, the central server downloads the voice recording almost immediately to the recipient. *Id.* at 16:10–12. The voice is uncompressed and the recipient can hear the recording through the speakers or headset attached to its computer. *Id.* at 16:12–14. The recipient can reply in a complementary way, allowing for near real-time communications. *Id.* at 16:14–15. If the recipient's software agent is not online, the voice recording is stored in the central server until the recipient's software agent is

active. *Id.* at 16:15–17. "In both cases, the user is automatically notified of available messages once the voice recordings have been downloaded to storage on their computer." *Id.* at 16:17–19. The central server coordinates with software agents on all computers continuously, updating addresses, uploading and downloading files, and selectively retaining voice recordings in central storage. *Id.* at 16:19–21.

Zydney discloses that the voice container also has the ability to have other data types attached to it. Ex. 1003, 19:6–7. Formatting the container using MIME format, for example, "allows non-textual messages and multipart message bodies attachments [sic] to be specified in the message headers." *Id.* at 19:7–10.

Figure 3 of Zydney is reproduced below.

FIG. 3

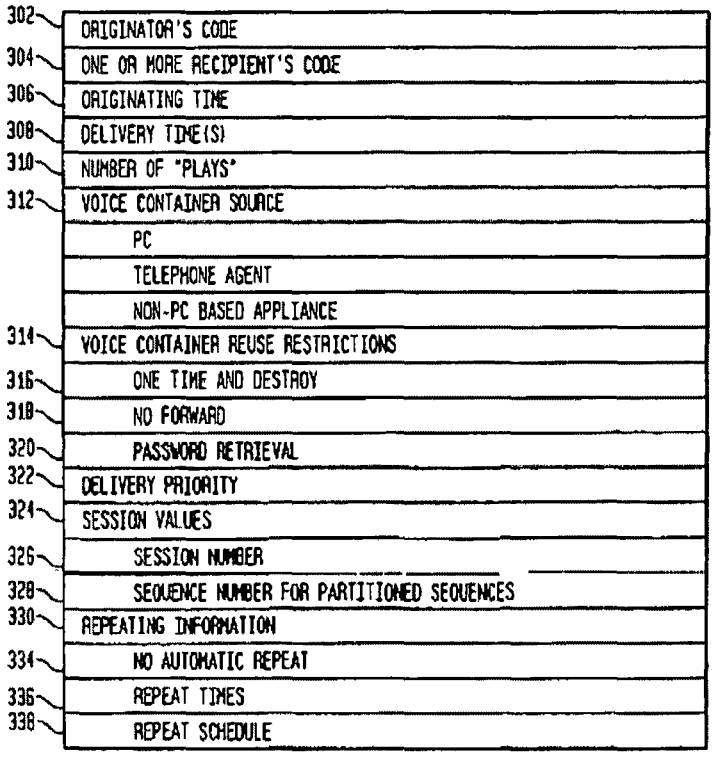

Figure 3, above, illustrates an exemplary embodiment of Zydney's voice container structure, including voice data and voice data properties components. Ex. 1003, 2:19, 23:1–2. Referring to Figure 3, voice container components include:

> [O]riginator's code 302 (which is a unique identifier), one or more recipient's code 304, originating time 306, delivery time(s) 308, number of "plays" 310, voice container source 312 which may be a PC, telephone agent, non-PC based appliance, or other, voice container reuse restrictions 314 which may include one time and destroy 316, no forward 318, password retrieval 320, delivery priority 322, session values 324, session number 326, sequence number for partitioned sequences[] 328, repeating information 330, no automatic repeat 332, repeat times 334, and a repeat schedule 336.

Id. at 23:2–10.

b. Overview of Shinder

Shinder provides an overview of the "fundamentals of computer networking concepts and implementation." Ex. 1014, 5. According to Shinder, it is "becom[ing] vital to business interests that a LAN be able to communicate with the outside" and, thus, to connect to a wide area network ("WAN"), such as the Internet. *Id.* at 31.

c. Arguments and Analysis

i. Claims 3, 6–8, 10, 11, 13, 18–21, and 23

Petitioner points to Zydney as disclosing all limitations of independent claim 3, as well as dependent claims 6–8, 10, 11, 13, 18–21, and 23, except that it relies on Shinder's disclosure of network interface controllers ("NICs") (Ex. 1014, 42–43) as rendering obvious the "network interface" recited in claim 3 and on Shinder's disclosure that "[a]n example

of a packet-switched network is the Internet" (*id.* at 19) as rendering obvious that the Internet as disclosed in Zydney would have been a packet-switched network, also as recited in claim 3. Pet. 18–50.

Patent Owner disputes Petitioner's evidence with regard to claim 3, arguing in particular that Zydney does not render obvious the claim 3 limitation "wherein the instant voice message includes an object field." Prelim. Resp. 22–26. Notwithstanding Patent Owner's arguments, we are persuaded for the reasons that follow that Petitioner has established a reasonable likelihood of prevailing in showing that claims 3, 6–8, 10, 11, 13, 18–21, and 23 are unpatentable over Zydney and Shinder.

With respect to the disputed claim 3 limitation "wherein the instant voice message includes an object field," Petitioner contends that, although the '622 patent does not expressly define the term "object field," the meaning of that term "is reasonably clear from the specification, which explains that '[t]he content of the object field is a block of data being carried by the message object, which may be, for example, a digitized instant voice message.'" Pet. 31 (emphasis omitted) (quoting Ex. 1001, 14:37–40). Relying on Dr. Lavian's testimony as to what a person of ordinary skill in the art would have understood from that disclosure, Petitioner argues Zydney discloses the object field in at least two independent ways. *Id.* (citing Ex. 1002 ¶¶ 137–138, 141–144).

First, according to Petitioner, "Zydney expressly refers to [its] voice container," which Petitioner maps to the recited instant voice message, "as an 'object' that contains voice data: 'The term "voice containers" as used throughout this application refers to a container object that contains no methods, but contains voice data or voice data and voice data properties.'"

Pet. 31–32 (emphasis omitted) (quoting Ex. 1003, 12:6–8). While conceding that Zydney does not use the specific word "field" in relation to storage of voice data, Petitioner asserts that a person of ordinary skill in the art "would have understood that the voice data is contained in a field of the voice container." *Id.* at 32 (citing Ex. 1002 ¶¶ 137–138). Petitioner further contends it would also have been obvious that the Zydney voice container would contain an object field "because, without one, the recipient device could not separate the voice data from the other fields of data in the voice container and play back the voice data for the user – a capability the recipient in Zydney has." *Id.* (citing Ex. 1002 ¶ 138 n.13).

Second, Petitioner argues, Zydney discloses that voice containers can be encoded using the industry-standard MIME format, "which 'allows non-textual messages and multipart message bodies [sic] attachments to be specified in the message headers,'" and Zydney also specifically refers to and incorporates by reference Request for Comments ("RFC") 1521 (Ex. 1006), which "explains that a MIME message can contain audio or voice data in the 'body,' the field of the message containing the content being conveyed." Pet. 32 (emphasis omitted) (citing Ex. 1002 ¶ 143; Ex. 1003, 19:7–10, 19:13–20:9; Ex. 1006). Relying on Dr. Lavian's testimony, Petitioner contends that because Zydney itself discloses that voice containers can be encoded using MIME and directly cites to RFC 1521, "it would have been plainly obvious to a person of ordinary skill in the art to provide the receiving software agent with the ability to format the voice container according to RFC 1521, thus encoding the voice data in the body (an 'object field') of the message." *Id.* at 32–33 (emphasis omitted) (citing Ex. 1002 ¶¶ 141–144).

Patent Owner responds that Petitioner errs by relying on Zydney's voice container for this limitation, contending that "Zydney distinguishes its voice container from its voice message." Prelim. Resp. 22 (emphasis omitted). Further, Patent Owner contends, Petitioner's "conclusory speculation" that "a person of ordinary skill in the art would have understood that the voice data is contained in a field of the voice container" "should be rejected for at least . . . six reasons." *Id.* at 22–23. First, according to Patent Owner, Petitioner's statements are based on "mere speculation or conjecture." *Id.* at 23. Second, the claim language does not recite "'a field' in the abstract," but instead "identifies a *specific type* of field—namely, an '*object* field.'" *Id.* Third, "Zydney does not use the word 'field' at all in relation to its voice container," and "[w]hile Zydney describes the 'voice container structural components' with reference to Figure 3, notably absent from the list of twenty-five structural components (elements 302 through 338) is anything resembling 'an object field including a digitized audio file.'" *Id.* at 23–24 (emphasis omitted) (citing Ex. 1003, 23:1–12). Fourth, Patent Owner contends Zydney itself "refutes Petitioner['s] speculation that Zydney must have used an undisclosed 'structural component' dedicated exclusively to an 'audio digital file.'" *Id.* at 24 (emphasis omitted). More particularly, according to Patent Owner, "Figure 3 of Zydney and its accompanying description . . . provide no less than four different examples of 'structural components' that each group together multiple items of information." *Id.* (emphasis omitted). Fifth, Patent Owner contends, "the distinction between Zydney's 'structural components' and the claimed 'object field' is not mere semantics but rather reflects fundamentally different technologies." *Id.* at 25 (emphasis omitted).

More specifically, "[a] person of ordinary skill in the art . . . would have recognized the word 'field' as a term of art in the context of packet-switched networks, particularly in light of the teachings of the '622 patent," and "would have recognized that network packets have headers with various fields describing things such as source address, destination address, port, protocol, etc." *Id.* (emphasis omitted) (citing Ex. 2001 ¶ 77). Sixth, Patent Owner contends, "Zydney does not enable, and indeed could not even have functioned as described, using packet-switched fields of hypertext transfer protocol ('HTTP'), as it existed in August 7, 2000 (Zydney's filing date)." *Id.* at 26 (emphasis omitted) (citing Ex. 2001 ¶ 80).

Having considering the parties' respective arguments and evidence, we are persuaded that Petitioner sufficiently demonstrates a reasonable likelihood at this juncture that claim 3 is unpatentable over the combination of Zydney and Shinder. As a preliminary matter, although Patent Owner disputes Petitioner's mapping of Zydney's voice container to the claimed instant voice message (Prelim. Resp. 22), we find Petitioner's evidence sufficient at this stage of the proceeding. Patent Owner's arguments are premised on an implied construction of "instant voice message" as encompassing *only* the voice message and excluding all else. Indeed, Patent Owner's expert testimony makes a distinction between Zydney's voice container and the "instant voice message" that appears to be rooted in characterizing the "instant voice message" as audio data only. *Id.* (citing Ex. 2001 ¶ 76). This is an argument of claim construction that is underdeveloped at this juncture and has been presented only in connection with arguments distinguishing Zydney. On the present record, we do not have sufficient evidence or argument from either party to render even a

preliminary construction for the term "instant voice message." Accordingly, at this time, none of Patent Owner's arguments distinguishing the prior art with regard to the scope of the "instant voice message" are persuasive. The parties will have an opportunity during trial to present fully claim construction briefing for the term "instant voice message."

Regarding the instant voice message including "an object field including a digitized audio file," Patent Owner does not persuasively rebut Petitioner's evidence. Notwithstanding Patent Owner's arguments that Petitioner's statements are based on "mere speculation or conjecture" and that an object field is a "specific type of field" (Prelim. Resp. 23 (emphasis omitted)), we are sufficiently persuaded at this stage by Petitioner's evidence, including Dr. Lavian's testimony, that it would have been obvious to a person of ordinary skill in the art at the time of the alleged invention to include an object field in Zydney's voice container for storage of voice data. Zydney expressly discloses voice data is transmitted in a voice container, where the term voice container "refers to a container *object*" that may be formatted according to industry standards such as MIME format. Ex. 1003, 12:6–7 (emphasis added), 19:6–20:9 (citing, e.g., Ex. 1006). Although Zydney does not utilize the term "field" *ipssisimis verbis*, at this time we credit Dr. Lavian's testimony, supported by RFC1521 and unrebutted on the record before us, that when in MIME format, Zydney's voice container would contain the digitized audio file in an object field. Ex. 1002 ¶¶ 141–144.

Accordingly, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claim 3 is unpatentable over Zydney and Shinder. Patent Owner does not argue

dependent claims 6–8, 10, 11, 13, 18–21, and 23 separately from claim 3. For the same reasons as stated regarding claim 3 and based on our review of Petitioner's arguments and evidence directed to the additional limitations of claims 6–8, 10, 11, 13, 18–21, and 23, we also determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that those claims are unpatentable over Zydney and Shinder.

ii. Claims 27 and 32–35

In a similar manner as for claim 3 and its dependent claims, Petitioner relies on Shinder as teaching the "network interface" and "packet-switched network" recited in claim 27 and on Zydney for all other limitations of claims 27 and 32–35. Pet. 50–56. Petitioner maps the "instant voice messaging application" of claim 27 to the software agent running on a client computer of the sending user of Zydney. Pet. 52 (citing Ex. 1003, 11:16–18, 13:2–6, 14:2–12); *see also id.* at 43–44 (regarding the same limitation in dependent claim 13). For the "client platform system" and "messaging system" of claim 27, Petitioner relies on Zydney's disclosure of the software agent function of recording a voice container and transport process, respectively. *Id.* at 52–53 (citing Ex. 1003, 13:2–6, 14:2–5, Figs. 1A, 4).

According to Petitioner, the "document handler system for attaching one or more files to the instant voice message," recited in claim 27, "in Zydney takes the form of software functionality for attaching files to the voice container." *Id.* at 54. Petitioner points to a passage of Zydney that states: "Another important application of the present invention system and method for voice exchange and voice distribution is attaching other media to the voice containers." *Id.* (emphasis omitted) (quoting Ex. 1103, 19:1–7). Petitioner also proffers Zydney's Figures 6 and 16–18 as showing that after

the client builds a voice container with the voice message, the user is asked "what multimedia file to associate this voice container," and the originator associates the multimedia file with the voice container. Pet. 54–55. Relying on Dr. Lavian's testimony, Petitioner contends that, although "Zydney does not appear to explicitly describe which part of the software on the client system attaches files to voice containers," a person of ordinary skill in the art "would have found it obvious that the software agent that generates and transmits the voice container (the 'instant voice messaging application') could also handle attachment of files to the voice container, given that the software agent performs the various other functions for generating and transmitting voice containers." *Id.* at 55–56 (citing Ex. 1002 ¶¶ 216–217). Petitioner also offers as a separate basis for finding this limitation in Zydney that Zydney also describes attaching files to voice containers using the MIME format. *Id.* at 56 (citing Ex. 1002 ¶ 215; Ex. 1003, 19:6–12).

In response to Petitioner's contentions regarding claim 27, Patent Owner argues that Zydney "does not render obvious 'wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message.'" Prelim. Resp. 18 (emphasis omitted). In particular, according to Patent Owner, Zydney's teaching of attaching files to a voice container, pointed to by Petitioner for this limitation, "is inapposite because the claim language requires that the one or more files be attached to the instant voice message *itself*." *Id.* Patent Owner contends that the '622 patent "repeatedly and consistently equates the 'instant voice message' to the recorded audio file," whereas "Zydney . . . expressly distinguishes 'voice containers' from the 'voice messages' contained therein." *Id.* at 18–19 (emphasis omitted). Further, Patent Owner

alleges, Zydney does not disclose or suggest a "document handler system," "there is no disclosure in *Zydney* to support [Petitioner's] speculation and the Petition provides no support for such speculation," and "there is likewise no merit to Petitioner['s] alternative reliance on *Zydney's* disclosure that a particular format may be used." *Id.* at 20–21.

We are not persuaded by any of Patent Owner's arguments on the record developed at this stage of the proceeding. As discussed above with respect to claim 3, Patent Owner's arguments disputing Petitioner's mapping of Zydney's voice container to the claimed instant voice message are premised on an implied construction of "instant voice message" as encompassing *only* the voice message and excluding all else. Again, this is an argument of claim construction that is underdeveloped at this juncture and has been presented only in connection with arguments distinguishing Zydney. On the present record, we do not have sufficient evidence or argument from either party to render even a preliminary construction for the term "instant voice message." Accordingly, at this time, none of Patent Owner's arguments distinguishing the prior art with regard to the scope of the "instant voice message" are persuasive. Similarly, Patent Owner's arguments disputing Zydney's teaching or suggestion of a "document handler system" are likewise premised on an unstated construction of that term for which the record before us is insufficient to render any determination. The parties will have an opportunity during trial to present fully claim construction briefing for the terms "instant voice message" and "document handler system."

Accordingly, we determine that on this record, Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that

claim 27 is unpatentable as obvious over Zydney and Shinder. Patent Owner does not argue dependent claims 32–35 separately from claim 27. For the same reasons as stated regarding claim 27 and based on our review of Petitioner's arguments and evidence directed to the additional limitations of claims 32–35, we also determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that those claims are unpatentable over Zydney and Shinder.

iii. Claim 38

Claim 38 omits the "document handler system" limitation of claim 27 but additionally recites "a display displaying a list of one or more potential recipients for an instant voice message." Ex. 1001, 27:11–23. Petitioner relies on Zydney as disclosing that additional limitation, pointing particularly to Zydney's disclosure that an originator "select[s] one or more recipients from a list maintained by the originator and presented visually by the agent." Pet. 57 (emphasis omitted) (quoting Ex. 1003, 14:18–19) (citing Ex. 1003, Fig. 7). Relying on Dr. Lavian's testimony, Petitioner contends that a person of ordinary skill in the art "would have understood that this list would be 'presented visually' on the **display** of the client device." *Id.* (quoting Ex. 1002 ¶ 226).

Apart from a subheading in the Preliminary Response stating "No *prima facie* obviousness for 'a display [at the client device] displaying a list of one or more potential recipients' (claims 38-39)" (Prelim. Resp. 35 (emphasis omitted)) and a conclusory statement that "[f]or the foregoing reasons, Petitioners have failed to meet its [sic] obligation to present prima facie evidence that claim 38 would have been obvious at the time of the invention" (*id.* at 41), Patent Owner does not appear to dispute Petitioner's

mapping of Zydney and Shinder to the limitations of claim 38 at this stage of the proceeding. *See generally id.* at 35–41. The intervening pages of the Preliminary Response between the quoted subheading and conclusion statement set forth Patent Owner's contentions that Appelman, cited only against claims 22 and 39 in Ground 3 of the Petition, fails to teach an additional limitation recited in claim 39. *See generally id.* Although claim 39 depends from claim 38, Patent Owner's contentions regarding Appelman vis-à-vis that limitation of claim 39 do not persuasively rebut Petitioner's arguments and evidence regarding claim 38.

Accordingly, we determine that on this record, Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claim 38 is unpatentable as obvious over Zydney and Shinder.

3. Ground 2: Obviousness over Zydney, Shinder, and Clark (Claims 14–17 and 28–31)

a. Overview of Clark

Clark is directed to systems for managing and organizing electronic messages. Ex. 1008, [54], 1:8–9. According to Clark,

> A computer-based system catalogs and retrieves electronic messages saved in a message store. The system automatically organizes each saved message into multiple folders based on the contents and attributes of the message, and implements improved methods for manually organizing messages.

Id. at [57]. A particularly relevant embodiment in Clark is shown in Figure 4A, reproduced below.

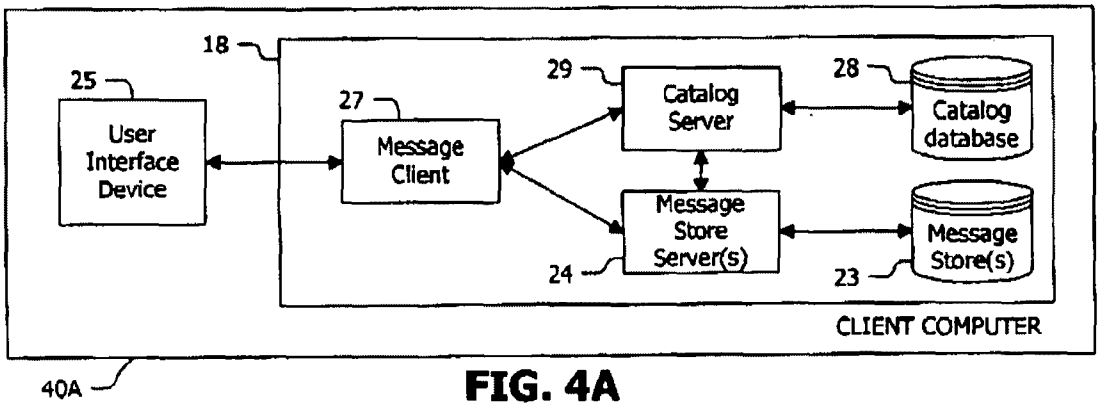

FIG. 4A

Figure 4A illustrates system 40A with client computer 18 implementing catalog server 29 and catalog database 28, and also including message client 27, message store 23, and message store server 24. *Id.* at 10:29–33. Each message store 23 comprises a memory, file, or database structure that provides temporary or permanent storage for the contained messages. *Id.* at 9:13–16. Clark describes the invention as providing catalog database 28 (and preferably catalog server 29) to organize the contents of one or more message stores 23. *Id.* at 9:54–57. Catalog database 28 and message store 23 may be separate from one another or may be integrated in a single integrated message store. *Id.* at 11:1–3. In the embodiment where they are separate from each other, illustrated in Figure 5A (reproduced below), catalog database 28 may be linked to a separate external message store 23. *Id.* at 11:3–7.

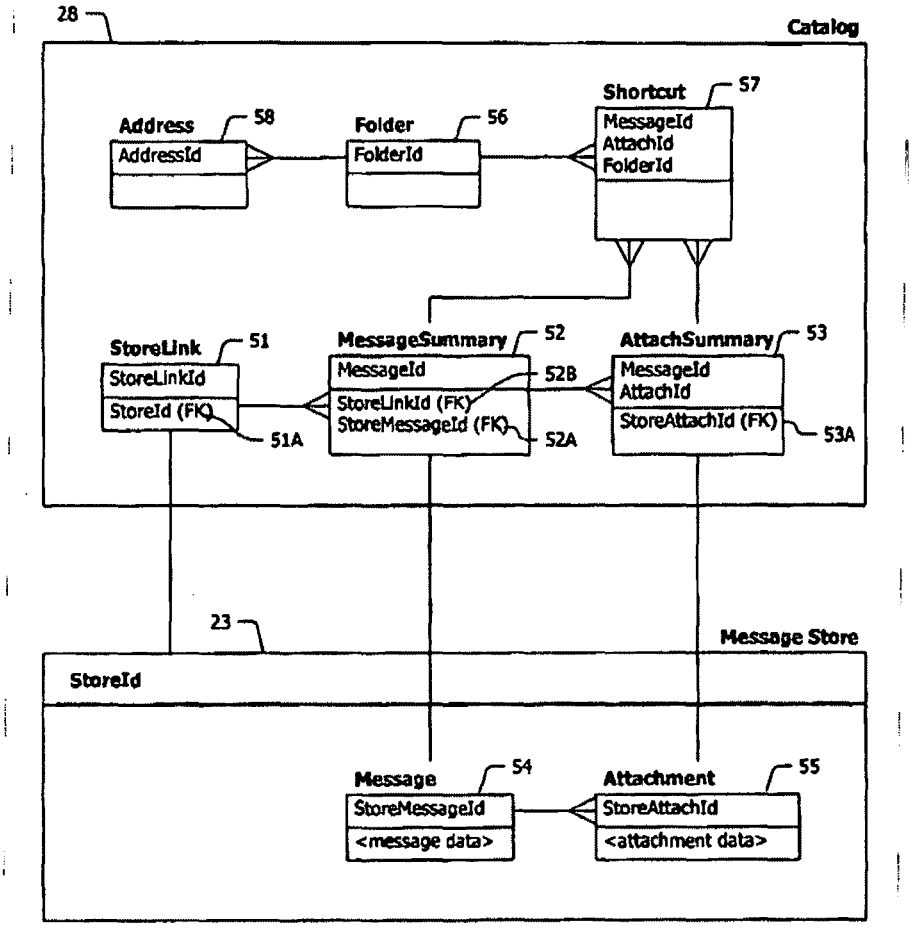

FIG. 5A

Figure 5A depicts the linking between catalog database 28 and external message store 23, where StoreLink table 51 contains rows, each with a StoreID pointing to a linked message store 23, and catalog database 28 includes MessageSummary table 52, which contains StoreMessageId 52A of messages in message store 23. *Id.* at 11:25–33. The Figure 5A embodiment also shows that messages 22 are stored in Message table 54 in message store 23 and that attachments are stored in Attachment table 55 in message store 23. *Id.* at 35–37.

b. Arguments and Analysis

Claim 14 depends indirectly from claim 3 and further recites "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*." Ex. 1001, 25:14–18 (emphases added). Claims 15–17 depend from claim 14. *Id.* at 25:19–30. Claims 28–31 recite substantially the same limitations as dependent claims 14–17, respectively, but depend from claim 27 rather than claim 3. *Id.* at 26:31–47. Petitioner concedes that "Zydney does not use the term 'message database' to describe storage of instant voice messages on the client system, and does not describe a 'database record including a unique identifier," as recited in claims 14 and 28, but contends that "these limitations would have been obvious in view of Clark." Pet. 58–59. Petitioner argues that Clark's message store 23 discloses a message database and that Clark's StorageMessageId is the recited "unique identifier." *Id.* at 59–61 (emphasis omitted). Petitioner points out that each electronic message in message store 23 is represented by a database record including a unique identifier, relying on the following disclosure of Clark: "[W]hen a message is added to a message store 23, the message store server 24 assigns a unique StoreMessageId to the message and generates an event which informs catalog server 29 of the newly added message." *Id.* at 61 (emphasis omitted) (citing Ex. 1008, 11:50–54).

Patent Owner challenges Petitioner's assertions as failing to show "that a single database record in *Clark* includes both a unique identifier and an instant voice message," because Clark discloses that the MessageSummary table and the Message table are in separate data stores.

Prelim. Resp. 28–29. Patent Owner also argues that although the catalog database and message store may be combined, as shown in Figure 5B of Clark, none of the tables shown in Figure 5B of Clark includes the StoreMessageID, which Petitioner maps to the unique identifier. *Id.* at 29–30. Further, based on Clark's disclosures that the message is stored in a message store while the StoreMessageID is stored at the catalog, Patent Owner argues that Clark teaches away from including the message data in the same database record as the unique identifier. *Id.* at 30–32.

Patent Owner's arguments are not persuasive at this time to rebut Petitioner's showing. Patent Owner's arguments are premised on an interpretation of the claim language requiring that: (1) the instant voice message is stored in the recited database record; and (2) the message database includes the database record. Neither requirement is expressly recited in the claim language. And the record at this juncture is devoid of briefing of the parties' claim construction positions for this phrase, such that we could determine, even preliminarily, that the scope of claim 14 includes these two alleged requirements. Accordingly, guided by the plain reading of the claim language, we do not agree with Patent Owner that Petitioner has failed to proffer institution-sufficient evidence that Clark discloses the recited "message database" and the "database record including a unique identifier."

With regard to the motivation to combine, Patent Owner argues that Petitioner's proposed combination would result in inoperability and teaching away from the claimed invention. *Id.* at 32–34. In particular, Patent Owner argues that because Zydney teaches deleting the sent instant voice message from the client's temporary storage, any combination with Clark would

result in Clark deleting the messages from the client, thereby running counter to Clark's stated goal of cataloging electronic messages. *Id.* at 32–33. We are not persuaded by this argument on the present record. We understand the Petition to combine the teachings of Clark's message store for the purpose that Clark gives for such use: to catalog and retrieve messages saved in a message store. Ex. 1008, [57]. Although Zydney deletes the sent message from the temporary storage, Patent Owner does not show any disclosure in Zydney that would teach away from seeking and achieving the use and purpose of Clark's message store. The disclosure in Zydney of a "reserved temporary storage" does not teach away from using a different storage altogether (a message store) or from the purposes disclosed in Clark for storing and cataloging messages on a more persistent basis.

Having reviewed the information presented by the parties at this juncture, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claim 14 is unpatentable over Zydney, Shinder, and Clark.

Patent Owner does not argue dependent claims 15–17 or 28–31 separately from claim 14. For the same reasons as stated regarding claim 14 and based on our review of Petitioner's arguments and evidence directed to the additional limitations of claims 15–17 and 28–31, we also determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that those claims are unpatentable over Zydney, Shinder, and Clark.

4. Ground 3: Obviousness over Zydney, Shinder, and Appelman (Claims 22 and 39)

a. Overview of Appelman

Appelman, titled "User Definable On-line Co-user Lists," describes a real-time notification system that enables a user to define "buddy lists" to track co-users of an online or network system. Ex. 1004, [54], [57]. The system tracks for the user the log-on status of the co-users and displays that information in real time to the tracking user in a graphical interface. *Id.* at [57]. When the user logs on to a system, the user's set of buddy lists is presented to a buddy list system, which attempts to match co-users currently logged into the system with the entries on the user's buddy list, and any matches are displayed to the user. *Id.* As co-users log on and log off, the user's buddy list is updated to reflect the changes. *Id.*

Figure 2a of Appelman is reproduced below.

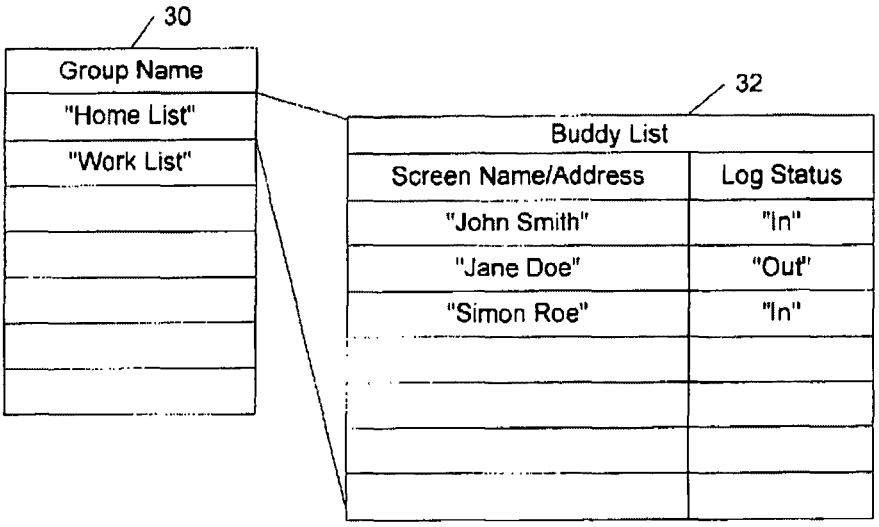

FIG. 2a

Figure 2a, above, illustrates "a set of symbolic data records showing the basic types of data used by one embodiment of [Appelman's] invention

for a buddy list[] and the conceptual relationship of data elements." *Id.* at 2:15–18. With reference to Figure 2a, Group Name table 30 stores user-defined group names for buddy lists. *Id.* at 3:36–37. Each user may define multiple buddy lists by group names. *Id.* at 3:38. Two buddy lists, "Home List" and "Work List," are shown in Group Name table 30. *Id.* at 3:39. Each group name in Group Name table 30 has an associated Buddy List table 32, comprising multiple records that each correspond to a co-user (or "buddy") that the user wishes to track. *Id.* at 3:39–43. Each record may include data elements for the screen name (or address, such as an Internet address) of a particular co-user to be tracked, and the logon status of that user (e.g., codes for "In" or "Out"). *Id.* at 3:43–47.

Figure 11 of Appelman is reproduced below.

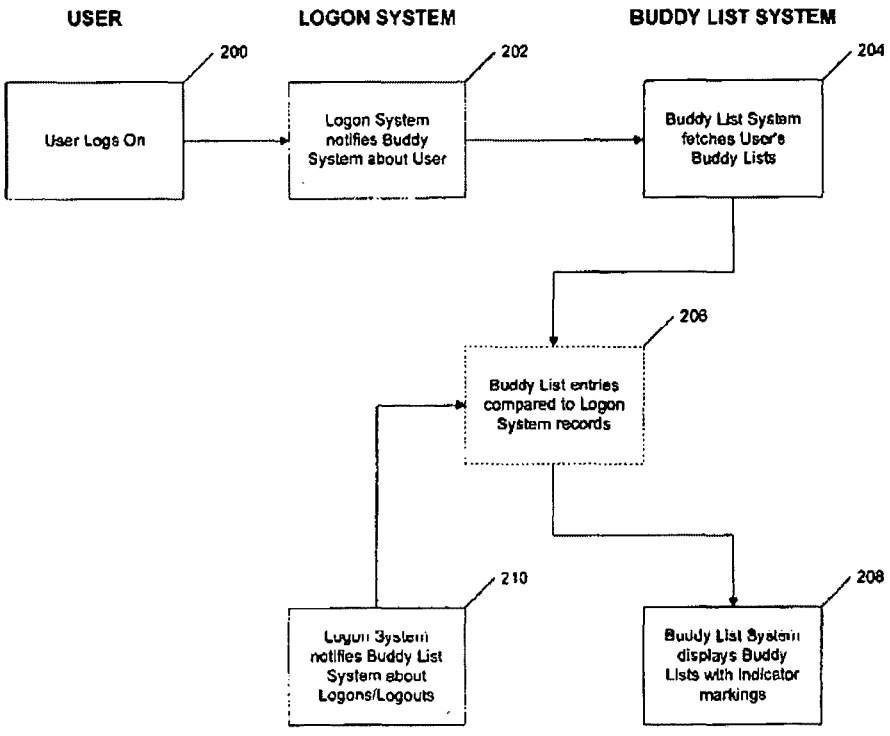

FIG. 11

Figure 11, above, is a flowchart showing an implementation of Appelman's invention. *Id.* at 2:41–42. In the illustrated implementation, a user logs into a Logon System (Step 200), which notifies the Buddy List System about the User (i.e., passes the User's ID, address, or screen name to the Buddy List System) (Step 202). *Id.* at 6:53–58. The Buddy List System accesses the user's buddy lists from a database, which may be, for example, on the user's own station (Step 204). *Id.* at 6:58–60. The entries in the user's buddy lists then are compared to the records of the Logon System (Step 206). *Id.* at 6:60–62. Appelman explains that this step is shown in dotted outline to indicate that the comparison can be done by passing records from the Logon System to the Buddy List System, or vice versa, or could be done by a separate system. *Id.* at 6:62–65. The Buddy List System then displays a buddy list window showing the status (i.e., logged in or not) of the co-users on the user's buddy lists with any of various indicator markings (Step 208). *Id.* at 6:66–7:2. Thereafter, while the user's buddy list window is open, the Logon System notifies the Buddy List System about new logons/logoffs of co-users (Step 210), causing a new compare of the user's buddy list entries to the Logon System records (Step 206). *Id.* at 7:3–7. Appelman explains that the Logon System may, for example, maintain a copy of a user's buddy lists and notify the Buddy List System only upon a logon status change for a co-user on the user's buddy lists. *Id.* at 7:8–11. The Buddy List System then updates the indicated status of the displayed co-users (Step 208). *Id.* at 7:11–12.

b. Arguments and Analysis

Claim 39 depends from claim 38 and further recites "wherein the display includes an indicia for each of the one or more potential recipients

indicating whether the potential recipient is currently available to receive an instant voice message." Ex. 1001, 27:24–27. Claim 22 recites substantially the same limitation as claim 39, but depends indirectly from claim 3 rather than from claim 38. *Id.* at 25:51–55. Petitioner concedes that "Zydney does not use the term 'message database' to describe storage of instant voice messages on the client system, and does not describe a 'database record including a unique identifier," as recited in claims 14 and 28, but contends that "these limitations would have been obvious in view of Clark." Pet. 58–59 (emphasis omitted). Petitioner contends that Zydney "clearly discloses the ability to communicate to the client device, for each potential recipient, 'whether the potential recipient is currently available to receive an instant voice message,'" as recited in claims 22 and 39, and that "[t]his status information is conveyed to the client." Pet. 69–70 (emphasis omitted) (citing Ex. 1003, 13:12–14, 14:6–9, 14:17–15:1). Petitioner further contends that, although "Zydney does not appear to describe that the client system also displays an 'indicia' for each recipient indicating whether the potential recipient is currently available to receive an instant voice message," "this feature would have been obvious in view of Appelman." *Id.* at 70 (emphasis omitted). Petitioner relies, in particular, on Appelman's buddy lists as providing such "indicia." *Id.* at 70–72 (citing Ex. 1004, [57], 3:43–47, 4:4–7, 4:29–32, 6:1–16, 6:66–7:2, Fig. 3).

Patent Owner disputes Petitioner's evidence with respect to claim 39. Prelim. Resp. 35–41. Patent Owner argues, more particularly, that "the plain language of Claim 39 confirms it must be at least possible for some of the potential recipients of the instant voice message to be unavailable." *Id.* at 35 (emphasis omitted). Appelman, however, according to Patent Owner,

"clearly states that only online buddies can be selected for instant messaging and that offline buddies, while perhaps displayed in a Buddy List window, are not available for instant messaging while they are offline." *Id.* (citing Ex. 1004, 6:2–5;[8] Ex. 2001 ¶ 95).

In support of its arguments, Patent Owner relies, in part, on Appelman's statement that "[o]nce a co-user is displayed on a user's buddy list, indicating that the co-user is currently logged into the network system, the preferred embodiment of the invention enables a simple way of communicating with that co-user." Ex. 1004, 6:2–5. Even if we were to accept Patent Owner's reading of that statement as limiting instant messaging to online buddies, which we decline to do on the present record, all of Patent Owner's arguments are premised on Patent Owner's interpretation of claim 39 as requiring the indication of the possibility that some of the intended recipients would be unavailable but still displayed. Claim 39 recites, however, that the indicia indicates "whether the potential recipient is currently available to receive an instant voice message." From the plain reading of this claim, at this juncture, a showing that the buddy list displays recipients available to receive a message reasonably meets the claim under the institution threshold. Arguments that Appelman's buddy list does not (or would not) display offline recipients (or does not or would not permit messages to be sent to offline buddies) appear, at this juncture, not to be commensurate with the claim scope. Patent Owner will have an

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[8] The Preliminary Response includes a citation to column 6, lines 2–5 of Exhibit 1008. Based on the textual reference to Appelman and the quoted language from Appelman in the corresponding parenthetical, however, we understand that Patent Owner intended to refer to Appelman, Exhibit 1004.

opportunity to develop further its claim construction position regarding claim 39 during trial.

Having reviewed the information presented by the parties, we determine that Petitioner has demonstrated a reasonable likelihood that it will prevail in establishing that claim 39, as well as claim 22 not separately argued by Patent Owner, is unpatentable over Zydney, Shinder, and Appelman.

C. Patent Owner's Argument That Inter Partes *Review Proceedings Are Unconstitutional*

Patent Owner contends that we "should deny institution because this proceeding would violate Patent Owner's constitutional rights." Prelim. Resp. 41. In particular, Patent Owner contends:

> Adversarial challenges to an issued patent—like *inter partes reviews*—are "Suits at common law" for which the Seventh Amendment guarantees a jury trial. U.S. Const. amend. VII; *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 377 (1996). Moreover, because patents are private property rights, disputes concerning their validity must be litigated in an Article III court, not before an executive branch agency. *McCormick Harvesting Mach. Co. v. C. Aultman & Co.*, 169 U.S. 606, 609 (1898). The Supreme Court is currently considering the constitutionality of *inter partes* reviews. *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 137 S. Ct. 2239 (2017). Patent Owner presents this constitutional challenge now to preserve the issue pending the Supreme Court's decision.

Id.

Although, as Patent Owner notes, the constitutionality of *inter partes* reviews is currently being considered by the Supreme Court, "administrative agencies do not have jurisdiction to decide the constitutionality of

congressional enactments," and we are bound by the existing decisions of our reviewing court that have consistently rejected constitutional challenges substantially similar to those raised by Patent Owner. *See MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1288–92 (Fed. Cir. 2015), *cert. denied* 137 S. Ct. 292 (2016)); *Cooper v. Square, Inc.*, 645 F. App'x 1014 (Fed. Cir. 2016), *cert. denied* 137 S. Ct. 475 (2016); *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 639 Fed. App'x 639 (Fed. Cir. 2016); *Riggin v. Office of Senate Fair Emp't Practices*, 61 F.3d 1563, 1569 (Fed. Cir. 1995); *Apple Inc. v. Smartflash LLC*, Case CBM2015-00028, slip op. at 23–24 (PTAB May 26, 2016) (Paper 44); *see also Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1710 (TTAB 1999) ("[T]he Board has no authority . . . to declare provisions of the Trademark Act unconstitutional."); *Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080, 1082 n.1 (TTAB 2014).

IV. CONCLUSION

In summary, based on our review of the arguments and evidence in the Petition and Preliminary Response, we institute *inter partes* review of the challenged claims of the '622 patent on the following grounds:

Ground	Basis	Claims Challenged	Claims Instituted
1	§ 103 Zydney and Shinder	3, 6–8, 10, 11, 13, 18–21, 23, 27, 32–35, 38	3, 6–8, 10, 11, 13, 18–21, 23, 27, 32–35, 38
2	§ 103 Zydney, Shinder, and Clark	14–17, 28–31	14–17, 28–31
3	§ 103 Zydney, Shinder, and Appelman	22, 39	22, 39
Summary		3, 6–8, 10, 11, 13–23, 27–35, 38, 39	3, 6–8, 10, 11, 13–23, 27–35, 38, 39

V. ORDER

Upon consideration of the record before us, it is, therefore,

ORDERED that an *inter partes* review is instituted as to claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 of the '622 patent on the following grounds:

(1) Claims 3, 6–8, 10, 11, 13, 18–21, 23, 27, 32–35, and 38 under 35 U.S.C. § 103(a) as unpatentable over Zydney and Shinder,

(2) Claims 14–17 and 28–31 under 35 U.S.C. § 103(a) as unpatentable over Zydney Shinder, and Clark, and

(3) Claims 22 and 39 under 35 U.S.C. § 103(a) as unpatentable over Zydney, Shinder, and Appelman;

FURTHER ORDERED that no other grounds are authorized; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '622 patent is hereby instituted commencing on the entry date of this Decision, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

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AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-639	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	BLACKBERRY CORPORATION & BLACKBERRY LIMITED

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
ORDERED that all claims and counterclaims made by Uniloc and BlackBerry against each other in this action are DISMISSED WITH PREJUDICE. Each party shall bear its own attorney fees and costs. The Clerk is directed to CLOSE member case 2:16-cv-639

CLERK	(BY) DEPUTY CLERK	DATE
David A. O'Toole	ch	7/21/17

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-722	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	AOL INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-722	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	AOL INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-694	6/30/2016	Eastern District of Texas

PLAINTIFF	DEFENDANT
UNILOC USA, INC. and UNILOC LUXEMBOURG, S.A.	TENCENT AMERICA LLC and TENCENT HOLDINGS LIMITED

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4	8,199,747	6/12/2012	Uniloc Luxembourg S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above---entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1---Upon initiation of action, mail this copy to Director Copy 3---Upon termination of action, mail this copy to Director
Copy 2---Upon filing document adding patent(s), mail this copy to Director Copy 4---Case file copy

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-990	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	KYOCERA AMERICA, INC. and § KYOCERA COMMUNICATIONS, INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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DECISION/JUDGEMENT

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AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 **Director of the U.S. Patent and Trademark Office** **P.O. Box 1450** **Alexandria, VA 22313-1450**	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-694	6/30/2016	Eastern District of Texas

PLAINTIFF	DEFENDANT
UNILOC USA, INC. and UNILOC LUXEMBOURG, S.A.	TENCENT AMERICA LLC and TENCENT HOLDINGS LIMITED

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4	8,199,747	6/12/2012	Uniloc Luxembourg S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

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PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-725	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	BEETALK PRIVATE LTD.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
Any and all claims by Uniloc against Defendant BeeTalk Private Limited ("BeeTalk") in Case No. 2:16-cv-725 are DISMISSED WITH PREJUDICE.

CLERK	(BY) DEPUTY CLERK	DATE
David A. O'Toole	Nakisha Love	5/16/17

Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:17-cv-347	4/21/2017	Eastern District of Texas

PLAINTIFF	DEFENDANT
UNILOC USA, INC. and UNILOC LUXEMBOURG, S.A.	KIK INTERACTIVE, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4	8,199,747	6/12/2012	Uniloc Luxembourg S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading		
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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:17-cv-349	4/21/2017	Eastern District of Texas

PLAINTIFF	DEFENDANT
UNILOC USA, INC. and UNILOC LUXEMBOURG, S.A.	HIKE LTD.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4	8,199,747	6/12/2012	Uniloc Luxembourg S.A.
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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-992	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	MOTOROLA MOBILITY LLC

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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AO 120 (Rev. 08/10)

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-993	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	ZTE (USA), INC. and ZTE (TX), INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-994	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	HUAWEI DEVICE USA, INC. and HUAWEI TECHNOLOGIES USA, INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

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Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:17-cv-347	4/21/2017	Eastern District of Texas

PLAINTIFF	DEFENDANT
UNILOC USA, INC. and UNILOC LUXEMBOURG, S.A.	KIK INTERACTIVE, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4	8,199,747	6/12/2012	Uniloc Luxembourg S.A.
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In the above---entitled case, the following patent(s)/ trademark(s) have been included:

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DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:17-cv-349	4/21/2017	Eastern District of Texas

PLAINTIFF	DEFENDANT
UNILOC USA, INC. and UNILOC LUXEMBOURG, S.A.	HIKE LTD.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4	8,199,747	6/12/2012	Uniloc Luxembourg S.A.
5			

In the above---entitled case, the following patent(s)/ trademark(s) have been included:

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In the above---entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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AO 120 (Rev. 08/10)

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-779	7/15/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	SHORETEL, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
Any and all claims by Uniloc USA, Inc. and Uniloc Luxembourg S.A. (collectively, "Uniloc") against ShoreTel, Inc. ("ShoreTel") are DISMISSED WITH PREJUDICE

CLERK	(BY) DEPUTY CLERK	DATE
David A. O'Toole	Nakisha Love	4/19/17

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-641	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	LINE EURO-AMERICAS CORP. & LINE CORPORATION

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
Any and all claims by Uniloc against Line Euro-Americas Corporation and Line Corporation (together, "Line") are DISMISSED WITH PREJUDICE

CLERK	(BY) DEPUTY CLERK	DATE
David A. O'Toole	Nakisha Love	4/18/17

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Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:17-cv-0231-JRG	3/26/2017	Eastern District of Texas

PLAINTIFF	DEFENDANT
Uniloc USA, Inc. and Uniloc Luxembourg S.A.	Google, Inc.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4			
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

Trials@uspto.gov
571-272-7822

Paper No. 7
Entered: May 25, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,[1]

Case IPR2017-00223
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge.*

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

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[1] Patent Owner's Mandatory Notice filed pursuant to 37 C.F.R. § 42.8 identifies Uniloc USA, Inc. and Uniloc Luxembourg S.A. as Patent Owner and as real parties in interest. Paper 4 at caption, 1. Therefore, we adjust the case caption to include Uniloc USA, Inc.

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 3, 4, 6–8, 10–19, 21–23, and 38 ("the challenged claims") of U.S. Patent No. 8,724,622 B2 (Ex. 1001, "the '622 patent"). Pet. 2. Uniloc USA, Inc. and Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response. Paper 6 ("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 and on this record, we are not persuaded that Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of any of the challenged claims on the asserted grounds. Accordingly, we *deny* Petitioner's request to institute an *inter partes* review.

II. BACKGROUND

A. Related Matters

Petitioner indicates that the '622 patent is involved in *Uniloc USA, Inc. v. Apple Inc.*, No. 2:16-cv-00638 (E.D. Tex.) and twenty-six other actions in the U.S. District Court for the Eastern District of Texas. Pet. 71–73. The '622 patent also is the subject of Case IPR2017-00224, which Petitioner filed concurrently with the instant proceeding. *See* Pet. 2–3; Prelim. Resp. 1 & n.1.

B. Overview of the '622 Patent

The '622 patent explains that "[v]oice messaging" and "instant text messaging" in both the Voice over Internet Protocol ("VoIP") and public switched telephone network environments are known. Ex. 1001, 2:22–46.

In prior art instant text messaging systems, a server presents a user of a client terminal with a "list of persons who are currently 'online' and ready to receive text messages," the user "select[s] one or more" recipients and types the message, and the server immediately sends 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. *Id.* at 6:22–24.

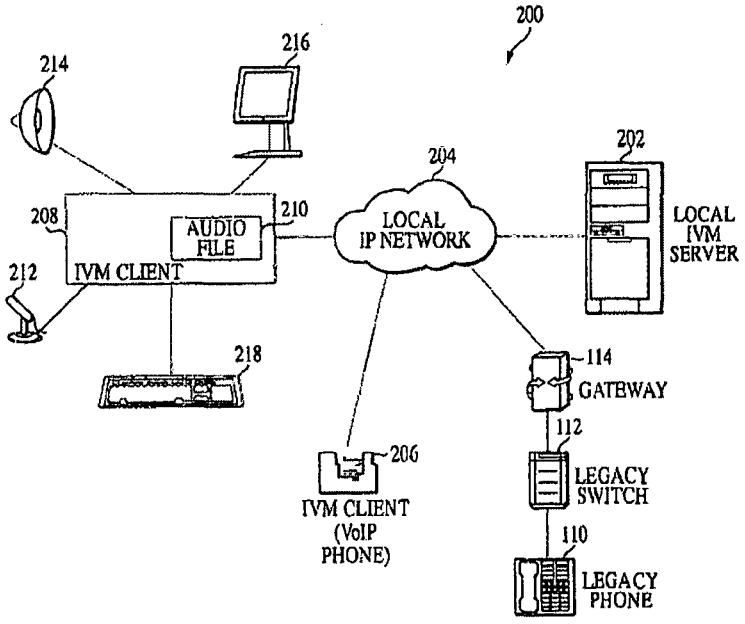

FIG. 2

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, exemplified as a VoIP softphone in Figure 2, "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. *Id.* at 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. *Id.* at 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.

C. Illustrative Claims

Of the challenged claims, claims 3 and 38 are independent. Those two independent claims, which are reproduced below, are illustrative of the recited subject matter:

3. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and

wherein the instant voice message includes an object field including a digitized audio file.

38. A system comprising:

a client device;

a network interface coupled to the client device and connecting the client device to a packet-switched network; and

an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,

a display displaying a list of one or more potential recipients for an instant voice message.

Ex. 1001, 24:12–27, 27:11–23.

D. References Relied Upon

Petitioner relies on the following references:

Vuori	US 2002/0146097 A1	Oct. 10, 2002 (Ex. 1005)
Holtzberg	US 6,625,261 B2	Sept. 23, 2003 (Ex. 1007)
Väänänen	US 7,218,919 B2	May 15, 2007 (Ex. 1008)

European Telecommunications Standards Institute (ETSI), *Technical Specification (TS) 123 040 v3.5.0 (2000-07): Universal Mobile Telecommunications System (UMTS); Technical realization of the Short Message Service (SMS)* ("SMSS"; Ex. 1006)

Pet. 2. Petitioner also relies on a declaration of Leonard J. Forys, Ph.D. (Ex. 1003).

E. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 3, 4, 6–8, 10–19, 21–23, and 38 under 35 U.S.C. § 103 on the following grounds:

Reference(s)	**Claim(s) Challenged**
Vuori and SMSS	3, 4, 6–8, 11–13, 18, and 21–23
Vuori, SMSS, and Holtzberg	10 and 14–17
Vuori, SMSS, and Väänänen	19
Vuori	38

Pet. 2.

III. DISCUSSION

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim construction standard to be applied in an *inter partes* review proceeding). Under the broadest reasonable interpretation standard, claim terms generally are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner proposes constructions for "object field," as recited in independent claim 3; "action field," as recited in dependent claim 4; "identifier field," as recited in dependent claim 6; "source field," as recited in dependent claim 7; "destination field," as recited in dependent claim 8;

and "display[ing] at least one of the plurality of instant voice messages," as recited in dependent claim 16. Pet. 6–8.[2] Patent Owner does not proffer any terms for construction, but contends that Petitioner's construction of "object field" "risks rending other claim language superfluous" and "should also be rejected as seeking to eviscerate the expressly recited 'object' qualifier." Prelim. Resp. 20–23. Patent Owner contends, however, that regardless whether we adopt Petitioner's proposed construction of "object field," Petitioner fails to meet its burden with respect to the asserted grounds. *Id.* at 23–24.

Based on our review of the record before us, we determine that no claim terms require an express construction to resolve the issues presented by the patentability challenges in this case. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (holding that only claim terms that "are in controversy" need to be construed and "only to the extent necessary to resolve the controversy"). Our determination *infra* that Petitioner has not demonstrated a reasonable likelihood of prevailing with respect to any challenged claim does not turn on the construction of any disputed claim term.

B. Analysis of Asserted Grounds of Unpatentability

1. Principles of Law

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are "such

[2] In the Petition, Petitioner identifies each of "object field," "action field," "identifier field," "source field," and "destination field" as being recited in claim 1. Pet. 6–7. As Patent Owner points out, however, claim 1 is not challenged in the Petition, and in any event, none of those terms is recited in claim 1. Prelim. Resp. 20.

that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art;[3] and (4) objective evidence of nonobviousness, i.e., secondary considerations.[4] *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). "To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness." *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Wc analyze the asserted grounds with the principles stated above in mind.

2. Obviousness over Vuori and SMSS (Claims 3, 4, 6–8, 11–13, 18, and 21–23) or Vuori alone (Claim 38)

Petitioner contends that Vuori teaches or suggests all limitations of claims 3, 4, 6–8, 11–13, 18, 21–23, and 38 of the '622 patent. Pet. 12–19, 21–22, 24–25, 27, 29, 31, 33–34, 36–47, 65–71. Petitioner further contends, however, that, "[t]o the extent Patent Owner argues" Vuori does not explicitly teach or suggest "wherein the instant voice message includes an

[3] Petitioner proposes an assessment of the level of skill in the art with respect to the '622 patent. Pet. 5. Patent Owner does not challenge this assessment or propose an alternative assessment. For purposes of this Decision and to the extent necessary, we adopt Petitioner's assessment.
[4] Patent Owner does not contend in its Preliminary Response that such secondary considerations are present.

object field including a digitized audio file," as recited in independent claim 3, and certain limitations recited in claims 4 and 6–8, those limitations are taught or suggested by SMSS. *Id.* at 19–20, 22–23, 25, 27–30, 32, 34–35.

Patent Owner raises several arguments in its Preliminary Response, including that the Petition does not identify anything in Vuori that satisfies the "network interface" limitations of independent claims 3 and 38. Prelim. Resp. 25–26, 35–37.

We begin with a brief overview of Vuori and relevant legal principles and then address the parties' arguments.

a. Overview of Vuori

Vuori is titled "Short Voice Message (SVM) Service Method, Apparatus and System." Ex. 1005, [54]. Vuori discloses a method for sending voice-type short messages using an SVM service. Ex. 1005, [57], ¶ 31. Vuori teaches that SVMs "are recorded in the sending terminal and sent to an SVM service center (SVMSC)," and a "second terminal may then commence a bidirectional communication so that an instant voice message session can be established." *Id.* ¶ 31.

In one embodiment, a user initiates a short voice message by pressing a menu key on a user equipment, which prepares to receive the message and may emit a sound to alert the user to commence speaking. *Id.* ¶ 32, Figs. 1–2. The user equipment then receives and stores the short voice message. *Id.* Next, the user "select[s] one or more intended recipients" and initiates the transfer. *Id.* ¶ 33. The short voice message is then sent to the SVMSC, which "check[s]" and "determines the availability of the one or more intended recipients." *Id.* ¶¶ 34, 50; *see id.* ¶ 37. The SVMSC sends the

short voice message "immediately to the intended recipients who are available." *Id.* ¶ 34; *see id.* ¶ 50. For recipients who are not available, however, the SVMSC "temporarily stor[es]" the message and "continue[s] attempting to send [the message] . . . until the[recipients] become available or until a time out occurs." *Id.* ¶¶ 34, 50. Upon delivery of the short voice message, the recipient may play back the message. *Id.* ¶ 35, Figs. 1–2.

Vuori teaches that the SVM service may be carried out in a Global System for Mobile communications ("GSM") network as shown in Figure 3, reproduced below. *Id.* ¶ 37.

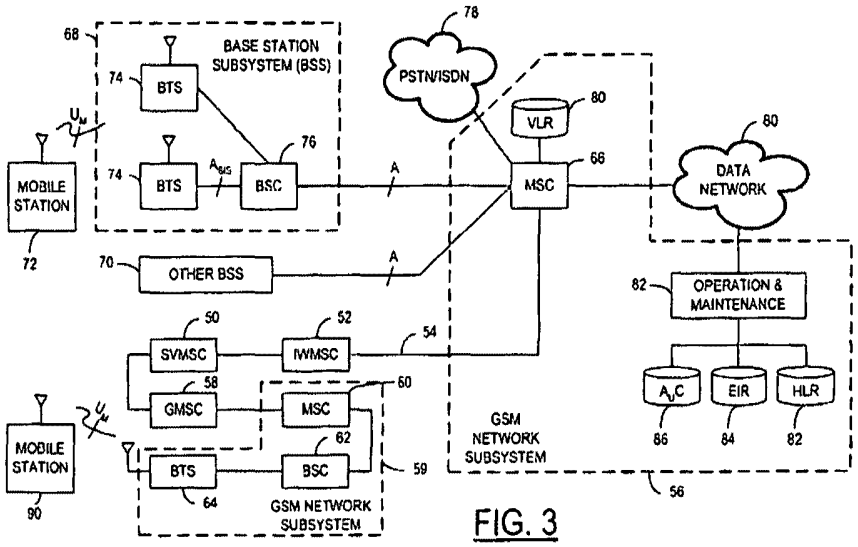

FIG. 3

Figure 3 of Vuori.

In Figure 3, SVMSC 50 is shown along with interworking mobile switching center ("MSC") 52 connected by line 54 to GSM Network Subsystem 56. *Id.* Gateway 58 is provided for interworking between

SVMSC 50 and "MSC 58"[5] of another GSM network 59. *Id.* Vuori explains that GSM Network Subsystem 56 also includes MSC 66 connected to a base station subsystem ("BSS") 68 as well as other base station subsystems 70 for communication with a plurality of mobile stations, but that only one mobile station 72 is shown in Figure 3. *Id.* According to Vuori, MSC 66 is also connected to public switched telephone network ("PSTN")/Integrated Services Digital Network ("ISDN") network 78 for allowing mobile stations to communicate with wired telephone sets in a circuit-switched manner, as well as to a plurality of databases that may in turn be connected directly to MSC 66 or via data network 80 and operation and maintenance center 82. *Id.*

b. Analysis

As reproduced above, independent claim 3 recites, in part, "a network interface connected to a packet-switched network" and "a messaging system communicating with a plurality of instant voice message client systems via the network interface." Ex. 1001, 24:13–17. Independent claim 38 similarly recites "a network interface coupled to [a] client device and connecting the client device to a packet-switched network." *Id.* at 27:13–14.

In support of its contention that the combination of Vuori and SMSS renders claim 3 unpatentable, Petitioner contends "Vuori teaches or suggests a network interface (i.e., interconnected interfaces) connected to a

[5] It appears from Figure 3 that Vuori may have intended to refer instead to "MSC 60," which is within the dotted line encompassing GSM Network Subsystem 59.

packet-switched network (i.e., a GPRS infrastructure)." Pet. 13 (citing Ex. 1003 ¶¶ 123–125). According to Petitioner:

> For example, in FIG. 3, reproduced below, Vuori provides that:
>
> > At the subscriber side, ***a user equipment 124 is connected by one or more radio links*** (Uu) to one or more corresponding Node Bs 126 which are in turn connected (Iub) to corresponding radio network controllers (RNCs) 128... ***The RNCs 128 are connected to the UMTS infrastructure 120 via Iu interfaces to a third generation-serving [General Packet Radio Service] GPRS support node*** (3G-SGSN) 140... It may also be connected to an SVM service 146 similar to the SVM service center 50 of FIG. 3, according to the present invention for connection to a GSM Network Subsystem, to another UMTS infrastructure, to ***a GPRS infrastructure***, or similar.

([Ex. 1005 ¶ 40].) A General Packet Radio Service ("GPRS") infrastructure, as disclosed in Vuori, is a packet-switched network. ([Ex. 1003] ¶ 124.) Further, the interconnected interfaces that provide a connection between the radio network controllers and the data network act as a network interface. (*Id.*)

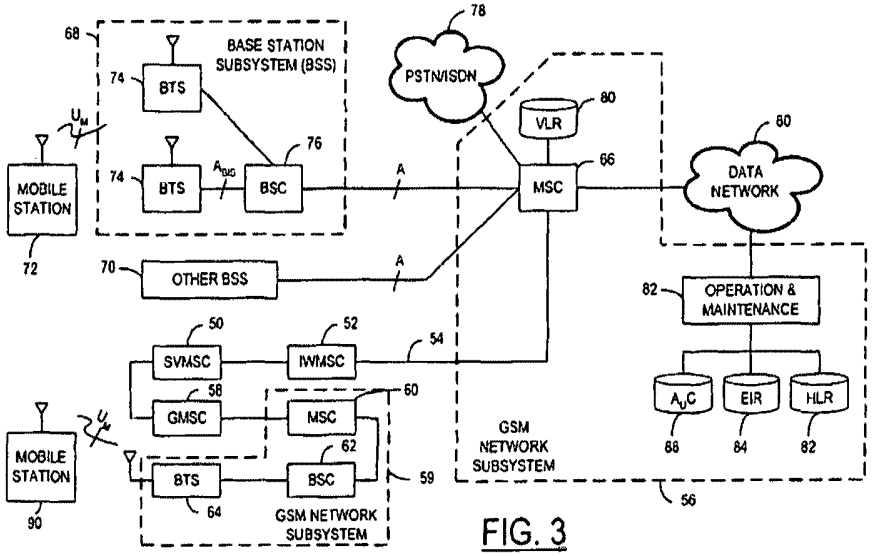

FIG. 3

([Ex. 1005], FIG. 3.)

> Thus, Vuori teaches or suggests a network interface connected to a packet-switched network ([Ex. 1003] ¶ 125.).

Pet. 13–14 (alterations in block quote in Petition).

In connection with the "messaging system" limitation of claim 3, Petitioner additionally points to Figure 11 of Vuori and contends that "FIG. 11 illustrates a plurality of instant voice message client systems connected to the messaging system via the network interface." *Id.* at 15 (citing Ex. 1003 ¶ 127). According to Petitioner, "[i]n FIG. 11, . . . Vuori discloses that the 'SVM [short voice message] is recorded in the sending terminal and sent to a SVM service center (SVMSC). The SVMSC may notify the intended recipient of the arrival of the SVM and await acceptance before sending it.'" *Id.* at 14 (third alteration in original) (quoting Ex. 1005, Abstract).

With respect to the "network interface" limitation of claim 38, Petitioner makes substantially the same arguments as for the corresponding limitation of claim 3, relying again on the same portion of paragraph 40 and Figure 3 of Vuori. Pet. 66–67 (quoting Ex. 1005 ¶ 40) (citing Ex. 1003 ¶¶ 317–319; Ex. 1005, Fig. 3).

In the Preliminary Response, Patent Owner argues that "[i]ndependent Claim 3 introduces the term 'network interface' in the recitation 'a network interface connected to a packet-switched network,'" and "[t]hus, the 'messaging system' and 'network interface' limitations collectively require, on their face, 'a messaging system communicating with a plurality of instant voice message client systems via the network interface [connected to the packet-switched network].'" Prelim. Resp. 25–26 (third alteration in original). Patent Owner further argues that "[t]he Petition does not identify

anything in *Vuori* that satisfies the above claim language." *Id.* at 26. According to Patent Owner, "[w]hile the Petition points to Figure 11 of *Vuori* . . . , *Vuori* discloses that the SVMSC (50) interfaces with the 1st and 2nd user terminals over dedicated circuits of respective ***circuit-switched*** GSM networks, neither of which is a ***packet-switched network***." *Id.* Patent Owner further points out that, contrary to Petitioner's assertions, paragraph 40 of Vuori block-quoted by the Petition does not describe Figure 3 of Vuori. *Id.* at 28. Moreover, according to Patent Owner,

> Even if Petitioner had, instead, relied on another figure of *Vuori*, the Petition nevertheless fails to articulate a theory that satisfies all limitations of the claimed "network interface" of a "messaging system." While Petitioner alleges "the interconnected interfaces that provide a connection between the radio network controllers and the data network act as a network interface," *Vuori* does not disclose "communicating with a plurality of instant voice message client systems via" that interface (and Petitioner does not argue otherwise). On the contrary, Figure 5 of *Vuori* clearly illustrates the identified "interface" as connecting RNCs (128) to UMTS infrastructure (120), whereas "[a]t the subscriber side, a user equipment 124 is connected by one or more radio links (Uu) to one or more corresponding Node Bs 126 which are in turn connected (Iub) to corresponding radio network controllers (RNCs) 128. Ex. 1005, [0040].

Prelim. Resp. 28–29. Patent Owner makes similar arguments with respect to the "network interface" limitation of claim 38. *Id.* at 35–37.

On the record before us, we are not persuaded by Petitioner's arguments and evidence that Vuori teaches or suggests "a network interface connected to a packet-switched network," as recited in claim 3, or "a network interface . . . connecting [a] client device to a packet-switched network," as recited in claim 38. We agree with Patent Owner that, although

the Petition cites paragraph 40 and Figure 3 of Vuori as teaching or suggesting those limitations, the Petition fails to identify precisely what, within that figure and cited text, constitutes the claimed "network interface." *See* Prelim. Resp. 35.[6] Accordingly, the Petition does not identify with particularity "the evidence that supports the grounds for the challenge to each claim," 35 U.S.C. § 312(a)(3), or "specify where each element of the claim is found in the prior art patents or printed publications relied upon," 37 C.F.R. § 42.104(b)(4). Petitioner asserts, without identifying any particular element or elements depicted in Figure 3 or described in paragraph 40, that "the interconnected interfaces that provide a connection between the radio network controllers and the data network act as a network interface." Pet. 13 (citing Ex. 1003 ¶ 124); *see also id.* at 66 (similar argument regarding claim 38; citing Ex. 1003 ¶ 317). The only purported support Petitioner provides for that assertion, namely, paragraph 124 of Dr. Forys's declaration, simply repeats, word for word, the Petition's arguments and quotation of paragraph 40 of Vuori, adding only the prefatory phrases "[t]his excerpt is significant" and "a POSITA would have understood" at the beginning of two sentences. Ex. 1003 ¶¶ 124, 318.[7] That testimonial

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[6] Although Patent Owner makes this argument in connection with claim 38, it applies equally to claim 3.

[7] Although Petitioner includes an "*Id.*" citation in support of its assertion with respect to claim 38 that ostensibly refers to paragraph 317 of Dr. Forys's declaration (Pet. 66), that paragraph merely states "Vuori teaches or suggests a network interface coupled to the client device and connecting the client device to a packet-switched network" (Ex. 1003 ¶ 317). We assume that Petitioner intended instead to cite paragraph 318 of Dr. Forys's declaration, which states, *inter alia*, "a POSITA would have understood that the interconnected interfaces that provide a connection

evidence provides no disclosure of the underlying facts on which the stated opinions are based, and accordingly, is entitled to little or no weight. *See* 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.").

Further, notwithstanding Petitioner's assertions, we do not understand Figure 3 to show any connections with a "packet-switched network" at all, and accordingly, we discern in Figure 3 of Vuori nothing that could be termed a "network interface connected to a packet-switched network." Vuori describes Figure 3 as showing an "SVM service method . . . applied to GSM network subsystems." Ex. 1005 ¶ 21; *see also id.* ¶¶ 37, 39, Fig. 3 (describing and illustrating elements 56 and 59 labelled as "GSM Network Subsystem[s]"). Paragraph 37 of Vuori explains that mobile switching center (MSC) 58 is "connected to a public switched telephone network (PSTN) and/or ISDN network 78 for allowing mobile stations to communicate with wired telephone sets *in a circuit-switched manner*." Ex. 1005 ¶ 37 (emphasis added). Moreover, we understand Vuori to distinguish the GSM-based embodiment shown in Figure 3 from packet-based systems, which Vuori characterizes as a *development* over GSM:

> In addition to carrying out the present invention on the GSM network subsystems 56, 59 of FIG. 3, it should be realized that *other approaches are possible*, especially considering the *development of GSM networks into a packet-based infrastructure*

---

between the radio network controllers, user equipment, and the data network act as a network interface." *Id.* ¶ 318.

> via the General Packet Radio Service (GPRS) and subsequently the Universal Mobile Telecommunication System (UMTS).

Id. ¶ 39 (emphases added).

Paragraph 40 of Vuori, cited by Petitioner, describes a UMTS (packet-based) embodiment, but despite Petitioner's assertions (Pet. 13), that paragraph relates to Figure 5 of Vuori, not to Figure 3. Ex. 1005 ¶ 40; *see also id.* ¶ 23 ("FIG. 5 shows the SVM service method of the present invention applied to a UMTS system."). We agree with Patent Owner, moreover, that even if Petitioner had cited and relied upon Figure 5 instead of Figure 3, Figure 5 merely illustrates the identified "interface" as connecting radio network controllers (RNCs) 128 to UMTS infrastructure 120, whereas "at the subscriber side, [] user equipment 124 is connected by one or more radio links (Uu) to one or more corresponding Node Bs 126 which are in turn connected (Iub) to corresponding radio network controllers (RNCs) 128," and that Vuori does not disclose "communicating with a plurality of instant voice message client systems via" that interface. Prelim. Resp. 28; Ex. 1005 ¶ 40.

For the reasons given, we are not persuaded by Petitioner's evidence that Vuori teaches or suggests the "network interface" limitations of claims 3 and 38. Although Petitioner challenges claim 3 as obvious over the combination of Vuori and SMSS, Petitioner does not cite SMSS as teaching or suggesting this limitation of claim 3. *See* Pet. 13–15. Accordingly, we conclude that Petitioner has not established a reasonable likelihood that it would prevail in showing that independent claims 3 and 38—or claims 4, 6–8, 11–13, 18, and 21–23, which directly or indirectly depend from claim 3—are unpatentable on the proffered grounds.

3. Obviousness over Vuori, SMSS, and Holtzberg (Claims 10 and 14–17) or Vuori, SMSS, and Väänänen (Claim 19)

Each of claims 10, 14–17, and 19 depends directly or indirectly from claim 3. Petitioner contends that Holtzberg teaches certain limitations of claims 10 and 14–17 and that Väänänen teaches certain limitations of claim 19 not taught or suggested by Vuori and SMSS, and that a person of ordinary skill in the art would have had reason to combine Holtzberg or Väänänen with Vuori and SMSS. Pet. 47–64. Petitioner, however, does not allege in the Petition that either Holtzberg or Väänänen teaches or suggests the "network interface" limitation of claim 3. Accordingly, for the same reasons as set forth in Section III.B.2 with respect to claim 3, we conclude that Petitioner has not established a reasonable likelihood that it would prevail in showing that claims 10, 14–17, and 19 are unpatentable on the proffered grounds.

C. Conclusion

For the reasons discussed above, Petitioner has not established a reasonable likelihood that it would prevail with respect to any of the claims challenged in the Petition.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied*, and no trial or *inter partes* review is instituted on any asserted ground.

For PETITIONER:

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Paper No. 7
Entered: May 25, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,[1]

Case IPR2017-00224
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge*.

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

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[1] Patent Owner's Mandatory Notice filed pursuant to 37 C.F.R. § 42.8 identifies Uniloc USA, Inc. and Uniloc Luxembourg S.A. as Patent Owner and as real parties in interest. Paper 4 at caption, 1. Therefore, we adjust the case caption to include Uniloc USA, Inc.

I. INTRODUCTION

Apple Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 3, 4, 6–8, 10–19, 21–23, and 38 ("the challenged claims") of U.S. Patent No. 8,724,622 B2 (Ex. 1001, "the '622 patent"). Pet. 2. Uniloc USA, Inc. and Uniloc Luxembourg S.A. ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp."). Based on the particular circumstances of this case, we exercise our discretion under 35 U.S.C. § 325(d) and 37 C.F.R. § 42.108 and do not institute an *inter partes* review of the challenged claims.

II. BACKGROUND

A. Related Matters

Petitioner indicates that the '622 patent is involved in *Uniloc USA, Inc. v. Apple Inc.*, No. 2:16-cv-00638 (E.D. Tex.) and twenty-six other actions in the U.S. District Court for the Eastern District of Texas. Pet. 51–52. The '622 patent also is the subject of Case IPR2017-00223, which Petitioner filed concurrently with the instant proceeding. *See* Pet. 2–3; Prelim. Resp. 1 & n.1.

B. Overview of the '622 Patent

The '622 patent explains that "[v]oice messaging" and "instant text messaging" in both the Voice over Internet Protocol ("VoIP") and public switched telephone network environments are known. Ex. 1001, 2:22–46. In prior art instant text messaging systems, a server presents a user of a client terminal with a "list of persons who are currently 'online' and ready to receive text messages," the user "select[s] one or more" recipients and types the message, and the server immediately sends 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. *Id.* at 6:22–24.

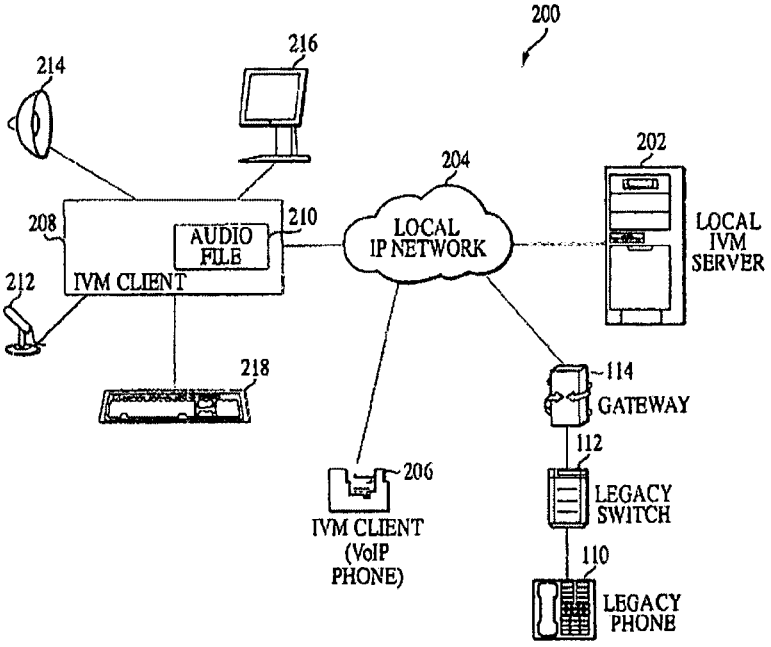

FIG. 2

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, exemplified as a VoIP softphone in Figure 2, "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. *Id.* at 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. *Id.* at 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.

C. Illustrative Claims

Of the challenged claims, claims 3 and 38 are independent. Those two independent claims, which are reproduced below, are illustrative of the recited subject matter:

3. A system comprising:
   a network interface connected to a packet-switched network;
   a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
   a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,
   wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and
   wherein the instant voice message includes an object field including a digitized audio file.

38. A system comprising:
a client device;
a network interface coupled to the client device and connecting the client device to a packet-switched network; and
an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,
a display displaying a list of one or more potential recipients for an instant voice message.

Ex. 1001, 24:12–27, 27:11–23.

D. References Relied Upon

Petitioner relies on the following references:

Hogan	US 5,619,554	Apr. 8, 1997 (Ex. 1010)
Logan	US 5,732,216	Mar. 24, 1998 (Ex. 1011)
Dahod ("the Dahod application")	US 2004/0022208 A1	Feb. 5, 2004 (Ex. 1009)

Pet. 2. Petitioner also relies on a declaration of Leonard J. Forys, Ph.D. (Ex. 1003).

E. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 3, 4, 6–8, 10–19, 21–23, and 38 under 35 U.S.C. § 103 on the following grounds:

Reference(s)	**Claim(s) Challenged**
the Dahod application	3, 4, 7, 8, 11–13, 18, 21–23, and 38
the Dahod application and Hogan	6, 10, and 14–17
the Dahod application and Logan	19

Pet. 2.

III. DISCUSSION

A. Discretionary Non-Institution Under 35 U.S.C. § 325(d)

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. Our discretion as to whether to institute an *inter partes* review is guided, in part, by 35 U.S.C. § 325(d), which provides that "[i]n determining whether to institute or order a proceeding . . . the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d).

Our discretion under § 325(d) involves a balance between several competing interests. *See Neil Ziegman, N.P.Z., Inc. v. Stephens*, Case IPR2015-01860, slip op. at 12–13 (PTAB Feb. 24, 2016) (Paper 11) ("While petitioners may have sound reasons for raising art or arguments similar to those previously considered by the Office, the Board weighs petitioners' desires to be heard against the interests of patent owners, who seek to avoid harassment and enjoy quiet title to their rights." (citing H.R. Rep. No. 112-98, pt. 1, at 48 (2011))). "On the one hand, there are the interests in conserving the resources of the Office and granting patent owners repose on issues and prior art that have been considered previously." *Fox Factory, Inc. v. SRAM, LLC*, Case IPR2016-01876, slip op. 7 (PTAB Apr. 3, 2017) (Paper 8). "On the other hand, there are the interests of giving petitioners the opportunity to be heard and correcting any errors by the Office in allowing a patent—in the case of an *inter partes* review—over prior art patents and printed publications." *Id.*

Patent Owner contends in the Preliminary Response that the facts in this case "present a textbook-worthy scenario for applying the discretion set

forth in § 325(d)." Prelim. Resp. 9. In particular, Patent Owner points out, the Examiner during prosecution of the application that issued as the '622 patent twice rejected and then ultimately allowed the '622 patent claims over U.S. Patent No. 7,372,826 to Dahod et al. (Ex. 3001, "the Dahod patent")—i.e., *the patent that issued from the Dahod application relied upon by Petitioner in each asserted ground in the Petition. Id.* at 10 (citing Ex. 1002, 139 (setting forth non-final rejection under 35 U.S.C. § 102(e) over the Dahod patent), 97–100 (setting forth final rejections under 35 U.S.C. § 102(e) over the Dahod patent and under 35 U.S.C. § 103(a) over the Dahod patent in combination with other references), 36–42 (Notice of Allowance stating reasons for allowance of the issued claims of the '622 patent over the Dahod patent)).

Given the evidence and arguments presented here, we exercise our discretion under § 325(d) and decline to institute an *inter partes* review based on any ground asserted in the Petition, all of which rely primarily on the teachings of the Dahod application. *See generally* Pet. 2, 9–50. We find that substantially the same arguments regarding the unpatentability of the claimed subject matter over the Dahod application were presented previously to the Office with respect to the Dahod patent.

As Patent Owner points out (Prelim. Resp. 9), Petitioner appears to recognize the applicability of § 325(d) to its Petition (*see* Pet. 1 (acknowledging that "[i]n the Notice of Allowance dated March 6, 2014, the Examiner stated the claims were allowable over the art cited in this Petition, Dahod"), 4 (Petitioner attempting to distinguish the Dahod application from the "Vuori" reference relied upon in concurrently filed IPR2017-00223 on the basis that the latter "is not susceptible to a potential §325(d) attack")),

but makes no meaningful effort to explain why we should not exercise our discretion to deny the Petition on that basis. Petitioner contends that the Examiner "erroneously issued" the '622 patent (*id.* at 1); that "the Examiner stated the claims were allowable over . . . Dahod, because the Examiner wrongly believed: 'applicant's instant voice message system that has an object field including a digitized audio file, nor does the instant voice messaging system include displaying a list of recipients for an instant voice message'" (*id.*); that "[t]he Examiner apparently did not understand that the 'object field including a digitized audio file' was rendered obvious in view of Dahod, where Dahod states that 'the new [voice instant message] VIM may optionally include or attach the original VIM'" (*id.*); and that "the Examiner overlooked key elements of Dahod . . . [f]or example, the Examiner failed to understand that Dahod provides: . . . 'the new VIM may optionally include or attach the original VIM . . .'" (*id.* at 16 (quoting Ex. 1009 ¶ 90) (emphasis omitted)). But those arguments, which essentially amount only to speculation that the Examiner failed to read the entirety of the Dahod patent despite his express reliance thereupon in twice rejecting the claims, do not persuade us that the Examiner misapprehended the reference and do not justify disturbing Patent Owner's repose with respect to prior art substantively considered by the Office during prosecution.

Although Petitioner now relies upon the Dahod *application* (*e.g.*, Pet. 2) whereas the Examiner relied upon the Dahod *patent* (*e.g.*, Ex. 1002, 139) that distinction is inconsequential. Petitioner provides no explicit explanation for its reliance on the Dahod application rather than the Dahod patent. Regardless, the Dahod patent issued directly from the application published as the Dahod application, and apart from different formatting and

differences in claim language apparently resulting from amendments made after publication of the Dahod application,[2] we discern no substantive differences in their disclosures. *Compare* Ex. 1009, *with* Ex. 3001. And indeed, Petitioner itself equates the Dahod application and Dahod patent, stating that "the Examiner stated the claims were allowable over *the art cited in this Petition*, Dahod." Pet. 1 (emphasis added).

We also ascribe little significance to the fact that the Examiner rejected certain claims *under 35 U.S.C. § 102(e) as anticipated* by the Dahod patent, whereas Petitioner asserts that claims 3, 4, 7, 8, 11–13, 18, 21–23, and 38 are *unpatentable under § 103* over the Dahod application. First, none of the claims rejected under § 102(e) during prosecution ultimately issued in the '622 patent, but were each amended prior to allowance. Second, in stating the reasons for allowance, the Examiner explicitly stated "[n]o obvious combination of references found would have taught one of ordinary skill in the art to make applicant's system as claimed." Ex. 1002, 41. We understand that statement to contemplate patentability under § 103. *See also Arctic Cat, Inc. v. Polaris Indus. Inc.*, Case IPR2017-00199, slip op. 8 (PTAB Apr. 17, 2017) (Paper 8) (finding unpersuasive petitioner's assertion that § 325(d) did not apply where reference was previously set forth in an anticipation rejection whereas petition set forth obviousness ground of unpatentability).

Lastly, although Petitioner cites two additional references, Hogan and Logan, that appear not to have been before the Examiner, Petitioner cites

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[2] In any event, Petitioner does not rely on any teachings set forth in the claims of the Dahod application in support of its arguments in the Petition. *See generally* Pet. 9–32, 36–37, 41–43, 45–46.

those only for certain dependent claims and does not allege that they teach the limitations that the Examiner expressly found are not taught by Dahod. *See* Pet. 32–50; Ex. 1002, 41. On this record, we are not persuaded that these references add to or alter the information regarding the teachings of the Dahod patent considered in detail by the Examiner during prosecution.

B. Conclusion

For the foregoing reasons, we exercise our discretion and decline to institute *inter partes* review of claims 3, 4, 6–8, 10–19, 21–23, and 38 of the '622 patent on the grounds presented in this proceeding. *See* 35 U.S.C. §§ 314(a), 325(d); 37 C.F.R. § 42.108.

IV. ORDER

Accordingly, it is

ORDERED that the Petition is *denied*, and no trial or *inter partes* review is instituted on any asserted ground.

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AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:17-cv-0231-JRG	3/26/2017	Eastern District of Texas

PLAINTIFF	DEFENDANT
Uniloc USA, Inc. and Uniloc Luxembourg S.A.	Google, Inc.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4			
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above---entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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Mail Stop 8 **Director of the U.S. Patent and Trademark Office** **P.O. Box 1450** **Alexandria, VA 22313-1450**	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-642	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	SAMSUNG ELECTRONICS AMERICA, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/31/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
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AO 120 (Rev. 08/10)

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-645	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	WHATSAPP, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
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DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-644	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	VOXERNET LLC

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
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2:16-cv-643	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	VIBER MEDIA S.A.R.L.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
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AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-641	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	LINE EURO-AMERICAS CORP. & LINE CORPORATION

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-640	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	KAKAO CORPORATION

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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AO 120 (Rev. 08/10)

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Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-639	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	BLACKBERRY CORPORATION & BLACKBERRY LIMITED

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

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PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-638	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	APPLE INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8,724,622	5/31/2014	UNILOC LUXEMBOURG, S.A.
4	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-696	6/30/2016	Eastern District of Texas

PLAINTIFF	DEFENDANT
UNILOC USA, INC. and UNILOC LUXEMBOURG, S.A.	SNAPCHAT, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4	8,199,747	6/12/2012	Uniloc Luxembourg S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-1313	11/28/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	HEYWIRE, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading		
	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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AO 120 (Rev. 08/10)

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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-644	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	VOXERNET LLC

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
Any and all claims by Uniloc against Voxernet are dismissed with prejudice.

CLERK	(BY) DEPUTY CLERK	DATE
David A. O'Toole	Nakisha Love	12/28/16

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Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-892	8/11/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	TELEGRAM MESSENGER, LLP

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-733	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	TANGOME, INC. d/b/a TANGO

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-722	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	AOL INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-696	6/30/2016	Eastern District of Texas

PLAINTIFF	DEFENDANT
UNILOC USA, INC. and UNILOC LUXEMBOURG, S.A.	SNAPCHAT, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4	8,199,747	6/12/2012	Uniloc Luxembourg S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-694	6/30/2016	Eastern District of Texas

PLAINTIFF	DEFENDANT
UNILOC USA, INC. and UNILOC LUXEMBOURG, S.A.	TENCENT AMERICA LLC and TENCENT HOLDINGS LIMITED

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4	8,199,747	6/12/2012	Uniloc Luxembourg S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-728	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	FACEBOOK, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
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CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-731	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	GREEN TOMATO LIMITED

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-732	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	SONY INTERACTIVE ENTERTAINMENT LLC

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
3	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-893	8/11/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	VONAGE HOLDINGS CORP. & VONAGE AMERICAS, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/31/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

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Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:17-cv-0214-JRG	3/20/2017	Eastern District of Texas

PLAINTIFF	DEFENDANT
Uniloc USA, Inc. and Uniloc Luxembourg S.A.	Google, Inc.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
4	8,199,747	6/12/2012	Uniloc Luxembourg S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above---entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:17-cv-0224-JRG	3/22/2017	Eastern District of Texas

PLAINTIFF	DEFENDANT
Uniloc USA, Inc. and Uniloc Luxembourg S.A.	Google, Inc.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	Uniloc Luxembourg S.A.
2	8,995,433	5/31/2015	Uniloc Luxembourg S.A.
3	7,535,890	5/19/2009	Uniloc Luxembourg S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above---entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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Copy 2---Upon filing document adding patent(s), mail this copy to Director Copy 4---Case file copy

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-640	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	KAKAO CORPORATION

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
Kakao Corp. ("Kakao") should be DISMISSED WITH PREJUDICE

CLERK	(BY) DEPUTY CLERK	DATE
David A. O'Toole	ch	3/17/17

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-643	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	VIBER MEDIA S.A.R.L.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
Having considered the Stipulation, the Court finds that the case should be DISMISSED under Federal Rule of Civil Procedure 41.

CLERK	(BY) DEPUTY CLERK	DATE
David A. O'Toole	M. Martin	1/19/17

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-733	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	TANGOME, INC. d/b/a TANGO

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
ORDER OF DISMISSAL WITH PREJUDICE OF ALL CLAIMS BY UNILOC AGAINST TANGOME, INC. d/b/a TANGO

CLERK	(BY) DEPUTY CLERK	DATE
David A. O'Toole	Nakisha Love	1/11/17

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AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 **Director of the U.S. Patent and Trademark Office** **P.O. Box 1450** **Alexandria, VA 22313-1450**	

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-994	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	HUAWEI DEVICE USA, INC. and HUAWEI TECHNOLOGIES USA, INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading		
	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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Mail Stop 8 **Director of the U.S. Patent and Trademark Office** **P.O. Box 1450** **Alexandria, VA 22313-1450**	

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-994	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	HUAWEI DEVICE USA, INC. and HUAWEI TECHNOLOGIES USA, INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading		
	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-993	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	ZTE (USA), INC. and ZTE (TX), INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
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Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-992	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	MOTOROLA MOBILITY LLC

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

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AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 **Director of the U.S. Patent and Trademark Office** **P.O. Box 1450** **Alexandria, VA 22313-1450**	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-991	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	LG ELECTRONICS U.S.A., INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-893	8/11/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	VONAGE HOLDINGS CORP. & VONAGE AMERICAS, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/31/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading		
	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT
Defendants Vonage Holdings Corp. and Vonage Americas, Inc. are dismissed with prejudice

CLERK	(BY) DEPUTY CLERK	DATE
David A. O'Toole	ch	11/17/16

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/546,673	07/11/2012	Michael J. Rojas	UN-NP-IT-195

CONFIRMATION NO. 9648

96051
Uniloc USA Inc.
Legacy Town Center
7160 Dallas Parkway
Suite 380
Plano, TX 75024

POA ACCEPTANCE LETTER

Date Mailed: 09/23/2016

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/15/2016.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

Questions about the contents of this notice and the requirements it sets forth should be directed to the Office of Data Management, Application Assistance Unit, at **(571) 272-4000** or **(571) 272-4200** or **1-888-786-0101**.

/mnguyen/

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/546,673	07/11/2012	Michael J. Rojas	EMP0024-US

CONFIRMATION NO. 9648

POWER OF ATTORNEY NOTICE

67050
KASHA LAW LLC
14532 Dufief Mill Road
North Potomac, MD 20878

Date Mailed: 09/23/2016

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/15/2016.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

Questions about the contents of this notice and the requirements it sets forth should be directed to the Office of Data Management, Application Assistance Unit, at **(571) 272-4000** or **(571) 272-4200** or **1-888-786-0101**.

/mnguyen/

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-989	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	HTC AMERICA, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-990	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	KYOCERA AMERICA, INC. and § KYOCERA COMMUNICATIONS, INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

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Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-991	9/6/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	LG ELECTRONICS U.S.A., INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

PTO/AIA/81A (02-15)
Approved for use through 01/31/2018. OMB 0651-0035
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995 no persons are required to respond to a collection of information unless it displays a valid OMB control number

PATENT - POWER OF ATTORNEY OR REVOCATION OF POWER OF ATTORNEY WITH A NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

Patent Number	8,724,622
Issue Date	May 13, 2014
First Named Inventor	Michael J. ROJAS
Title	SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING
Attorney Docket No.	UN-NP-IT-195

I hereby revoke all previous powers of attorney given in the above-identified patent.

☐ A Power of Attorney is submitted herewith.

OR

☒ I hereby appoint Practitioner(s) associated with the Customer Number identified in the box at right as my/our attorney(s) or agent(s) with respect to the patent identified above, and to transact all business in the United States Patent and Trademark Office connected therewith: 96051

OR

☐ I hereby appoint Practitioner(s) named below as my/our attorney(s) or agent(s) with respect to the patent identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

Practitioner(s) Name	Registration Number

Please recognize or change the correspondence address for the above-identified patent to:

☒ The address associated with the above-identified Customer Number.

OR

☐ The address associated with the Customer Number identified in the box at right:

OR

☐ Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone		Email			

I am the:

☐ Applicant.

OR

☒ Patent owner.

Statement under 37 CFR 3.73(c) (Form PTO/AIA/96) submitted herewith or filed on _____.

SIGNATURE of Applicant or Patent Owner

Signature		Date	
Name	Craig S.Etchegoyen	Telephone	
Title and Company	CEO of Uniloc Luxembourg S.A.		

NOTE: Signatures of all the applicants or patent owners of the entire interest or their representative(s) are required. If more than one signature is required, submit multiple forms, check the box below, and identify the total number of forms submitted in the blank below.

☑ A total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32, and 1.33. The information is required to obtain or retain a benefit by the public, which is to update (and by the USPTO to process) the file of a patent or reexamination proceeding. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/47 (03-09)
Approved for use through 05/31/2015. OMB 0651-0016
U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

"FEE ADDRESS" INDICATION FORM

Address to:
Mail Stop M Correspondence
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

- OR -

Fax to:
571-273-6500

INSTRUCTIONS: The issue fee must have been paid for application(s) listed on this form. In addition, only an address represented by a Customer Number can be established as the fee address for maintenance fee purposes (hereafter, fee address). A fee address should be established when correspondence related to maintenance fees should be mailed to a different address than the correspondence address for the application. **When to check the first box below**: If you have a Customer Number to represent the fee address. **When to check the second box below**: If you have no Customer Number representing the desired fee address, in which case a completed Request for Customer Number (PTO/SB/125) must be attached to this form. For more information on Customer Numbers, see the Manual of Patent Examining Procedure (MPEP) § 403.

For the following listed application(s), please recognize as the "Fee Address" under the provisions of 37 CFR 1.363 the address associated with:

☑ Customer Number: 96051

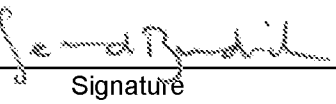
OR

☐ The attached Request for Customer Number (PTO/SB/125) form.

PATENT NUMBER (if known)	APPLICATION NUMBER
8,724,622	13/546,673

Completed by (check one):

☐ Applicant/Inventor



Signature

☑ Attorney or Agent of record 51,513 (Reg. No.)

Sean D. Burdick
Typed or printed name

☑ Assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

972-905-9580 x227
Requester's telephone number

☐ Assignee recorded at Reel _____ Frame_____

September 15, 2016
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more that one signature is required, see below*.

☑ * Total of _____ forms are submitted.

This collection of information is required by 37 CFR 1.363. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1. 11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313- 1450. DO NOT SEND COMPLETED FORMS TO THIS ADDRESS.
SEND TO: Mail Stop M Correspondence, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.
If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/96 (07-09)
Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Uniloc Luxembourg S.A.

Application No./Patent No.: 8,724,622 Filed/Issue Date: May 13, 2014

Titled: SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING

Uniloc Luxembourg S.A. , a corporation

(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.

states that it is:

1. ☑ the assignee of the entire right, title, and interest in;

2. ☐ an assignee of less than the entire right, title, and interest in (The extent (by percentage) of its ownership interest is _____ %); or

3. ☐ the assignee of an undivided interest in the entirety of (a complete assignment from one of the joint inventors was made)

the patent application/patent identified above, by virtue of either:

A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy therefore is attached.

OR

B. ☑ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: Michael J. ROJAS To: Ayalogic, Inc.

The document was recorded in the United States Patent and Trademark Office at
Reel 014827 , Frame 0059 , or for which a copy thereof is attached.

2. From: Ayalogic, Inc. To: Empire IP LLC

The document was recorded in the United States Patent and Trademark Office at
Reel 030922 , Frame 0335 , or for which a copy thereof is attached.

3. From: Empire IP LLC To: Uniloc Luxembourg S.A.

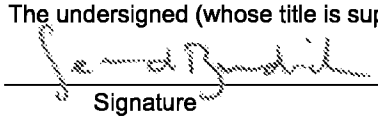
The document was recorded in the United States Patent and Trademark Office at
Reel 038963 , Frame 0343 , or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet(s).

☑ As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (*i.e.*, a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.



Signature

September 15, 2016
Date

Sean D. Burdick
Printed or Typed Name

IP Counsel for Uniloc Luxembourg S.A.
Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Electronic Acknowledgement Receipt

EFS ID:	26942730
Application Number:	13546673
International Application Number:	
Confirmation Number:	9648
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Customer Number:	67050
Filer:	Sean Dylan Burdick/Kris Pangan
Filer Authorized By:	Sean Dylan Burdick
Attorney Docket Number:	EMP0024-US
Receipt Date:	15-SEP-2016
Filing Date:	11-JUL-2012
Time Stamp:	19:11:39
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Power of Attorney	IT-195_Executed_POA.pdf	37603 96664533004c3bd29fc80a478b337015f2d27020	no	1

Warnings:

Information:					
2	Change of Address	IT-195_Fee_Address_Indication_Form.pdf	268644 b00880619c66c728a974f43d70fb3e7b345c2d66	no	1
Warnings:					
Information:					
3	Assignee showing of ownership per 37 CFR 3.73	IT-195_Statement_Under_37_CFR.pdf	527623 087ec51cace562a9d981a1580ed2f2568947016e	no	1
Warnings:					
Information:					
			Total Files Size (in bytes):	833870	

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-638	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	APPLE INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8,724,622	5/31/2014	UNILOC LUXEMBOURG, S.A.
4	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-722	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	AOL INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy

AO 120 (Rev. 08/10)

TO:	**Mail Stop 8** **Director of the U.S. Patent and Trademark Office** **P.O. Box 1450** **Alexandria, VA 22313-1450**	**REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK**

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-725	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	BEETALK PRIVATE LTD.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	**Mail Stop 8** **Director of the U.S. Patent and Trademark Office** **P.O. Box 1450** **Alexandria, VA 22313-1450**	**REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK**

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-893	8/11/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	VONAGE HOLDINGS CORP. & VONAGE AMERICAS, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/31/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-892	8/11/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	TELEGRAM MESSENGER, LLP

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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AO 120 (Rev. 08/10)

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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-645	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	WHATSAPP, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

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AO 120 (Rev. 08/10)

TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-641	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	LINE EURO-AMERICAS CORP. & LINE CORPORATION

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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TO:	Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-639	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	BLACKBERRY CORPORATION & BLACKBERRY LIMITED

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-728	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	FACEBOOK, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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AO 120 (Rev. 08/10)

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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-644	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	VOXERNET LLC

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-643	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	VIBER MEDIA S.A.R.L.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
4	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
5	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-642	6/14/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	SAMSUNG ELECTRONICS AMERICA, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	8,724,622	5/31/2014	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
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Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-732	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	SONY INTERACTIVE ENTERTAINMENT LLC

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
3	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-779	7/15/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	SHORETEL, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
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In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
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TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-777	7/15/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	AVAYA INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
5	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK	(BY) DEPUTY CLERK	DATE

Copy 1—Upon initiation of action, mail this copy to Director **Copy 3—Upon termination of action, mail this copy to Director**
Copy 2—Upon filing document adding patent(s), mail this copy to Director **Copy 4—Case file copy**

AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	

In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court Eastern District of Texas, Marshall Division on the following

☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-733	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	TANGOME, INC. d/b/a TANGO

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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AO 120 (Rev. 08/10)

TO:	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-731	7/5/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	GREEN TOMATO LIMITED

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,199,747	6/12/2012	UNILOC LUXEMBOURG, S.A.
3	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
4	8, 724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
5	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
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AO 120 (Rev. 08/10)

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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-777	7/15/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	AVAYA INC.,

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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3	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
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☐ Trademarks or ☑ Patents. (☐ the patent action involves 35 U.S.C. § 292.):

DOCKET NO.	DATE FILED	U.S. DISTRICT COURT
2:16-cv-779	7/15/2016	Eastern District of Texas, Marshall Division

PLAINTIFF	DEFENDANT
UNILOC USA, INC., and UNILOC LUXEMBOURG, S.A.	SHORETEL, INC.

	PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1	7,535,890	5/19/2009	UNILOC LUXEMBOURG, S.A.
2	8,995,433	3/31/2015	UNILOC LUXEMBOURG, S.A.
3	8,724,622	5/13/2014	UNILOC LUXEMBOURG, S.A.
4	8,243,723	8/14/2012	UNILOC LUXEMBOURG, S.A.
5			

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY ☐ Amendment ☐ Answer ☐ Cross Bill ☐ Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	ISSUE DATE	PATENT NO.	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/546,673	05/13/2014	8724622	EMP0024-US	9648

67050 7590 04/23/2014

KASHA LAW LLC
14532 Dufief Mill Road
North Potomac, MD 20878

ISSUE NOTIFICATION

The projected patent number and issue date are specified above.

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment is 0 day(s). Any patent to issue from the above-identified application will include an indication of the adjustment on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Application Assistance Unit (AAU) of the Office of Data Management (ODM) at (571)-272-4200.

APPLICANT(s) (Please see PAIR WEB site http://pair.uspto.gov for additional applicants):

Michael J. Rojas, North Canton, OH;

The United States represents the largest, most dynamic marketplace in the world and is an unparalleled location for business investment, innovation, and commercialization of new technologies. The USA offers tremendous resources and advantages for those who invest and manufacture goods here. Through SelectUSA, our nation works to encourage and facilitate business investment. To learn more about why the USA is the best country in the world to develop technology, manufacture products, and grow your business, visit SelectUSA.gov.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: Mail **Mail Stop ISSUE FEE**
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
or Fax (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

67050 7590 03/06/2014
KASHA LAW LLC
14532 Dufief Mill Road
North Potomac, MD 20878

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission
I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/546,673	07/11/2012	Michael J. Rojas	EMP0024-US	9648

TITLE OF INVENTION: SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	$480	$0	$0	$480	06/06/2014

EXAMINER	ART UNIT	CLASS-SUBCLASS
SMITH, CREIGHTON H	2656	370-352000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).
- ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
- ☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list
(1) The names of up to 3 registered patent attorneys or agents OR, alternatively,
(2) The name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 John R. Kasha
2 Kelly L. Kasha
3 Kasha Law LLC

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE: Empire IP LLC

(B) RESIDENCE: (CITY and STATE OR COUNTRY): Austin, TX

Please check the appropriate assignee category or categories (will not be printed on the patent) : ☐ Individual ☒ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:
- ☒ Issue Fee
- ☐ Publication Fee (No small entity discount permitted)
- ☐ Advance Order - # of Copies _____

4b. Payment of Fee(s): **(Please first reapply any previously paid issue fee shown above)**
- ☐ A check is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☒ The Director is hereby authorized to charge the required fee(s), any deficiency, or credits any overpayment, to Deposit Account Number 504075 (enclose an extra copy of this form).

5. **Change in Entity Status** (from status indicated above)
- ☐ Applicant certifying micro entity status. See 37 CFR 1.29 — NOTE: Absent a valid certification of Micro Entity Status (see forms PTO/SB/15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.
- ☐ Applicant asserting small entity status. See 37 CFR 1.27 — NOTE: If the application was previously under micro entity status, checking this box will be taken to be a notification of loss of entitlement to micro entity status.
- ☐ Applicant changing to regular undiscounted fee status. — NOTE: Checking this box will be taken to be a notification of loss of entitlement to small or micro entity status, as applicable.

NOTE: This form must be signed in accordance with 37 CFR 1.31 and 1.33. See 37 CFR 1.4 for signature requirements and certifications.

Authorized Signature /Kelly L. Kasha/ Date 03/25/2014

Typed or printed name Kelly L. Kasha Registration No. 47,743

Electronic Patent Application Fee Transmittal

Application Number:	13546673
Filing Date:	11-Jul-2012
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Filer:	John Kasha
Attorney Docket Number:	EMP0024-US

Filed as Small Entity

Utility under 35 USC 111(a) Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Utility Appl Issue Fee	2501	1	480	480
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Miscellaneous:				
		Total in USD ($)		**480**

Electronic Acknowledgement Receipt

EFS ID:	18571970
Application Number:	13546673
International Application Number:	
Confirmation Number:	9648
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Customer Number:	67050
Filer:	John Kasha
Filer Authorized By:	
Attorney Docket Number:	EMP0024-US
Receipt Date:	25-MAR-2014
Filing Date:	11-JUL-2012
Time Stamp:	12:33:36
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	$480
RAM confirmation Number	10737
Deposit Account	504075
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.16 (National application filing, search, and examination fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.17 (Patent application and reexamination processing fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.19 (Document supply fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.20 (Post Issuance fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Issue Fee Payment (PTO-85B)	EMP0024-US_iss_fee_trans.pdf	87500 aa88859ea0cfef6d59a2cce38be3c99141157434	no	1
Warnings:					
Information:					
2	Fee Worksheet (SB06)	fee-info.pdf	30082 2859d0b57ae84d071f0dced2f923252db80f21b0	no	2
Warnings:					
Information:					
		Total Files Size (in bytes):	117582		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

<u>New Applications Under 35 U.S.C. 111</u>
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

<u>National Stage of an International Application under 35 U.S.C. 371</u>
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

<u>New International Application Filed with the USPTO as a Receiving Office</u>
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

NOTICE OF ALLOWANCE AND FEE(S) DUE

67050 7590 03/06/2014

KASHA LAW LLC
14532 Dufief Mill Road
North Potomac, MD 20878

EXAMINER
SMITH, CREIGHTON H

ART UNIT	PAPER NUMBER
2656	

DATE MAILED: 03/06/2014

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/546,673	07/11/2012	Michael J. Rojas	EMP0024-US	9648

TITLE OF INVENTION: SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	$480	$0	$0	$480	06/06/2014

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the ENTITY STATUS shown above. If the ENTITY STATUS is shown as SMALL or MICRO, verify whether entitlement to that entity status still applies.

If the ENTITY STATUS is the same as shown above, pay the TOTAL FEE(S) DUE shown above.

If the ENTITY STATUS is changed from that shown above, on PART B - FEE(S) TRANSMITTAL, complete section number 5 titled "Change in Entity Status (from status indicated above)".

For purposes of this notice, small entity fees are 1/2 the amount of undiscounted fees, and micro entity fees are 1/2 the amount of small entity fees.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: Mail **Mail Stop ISSUE FEE**
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
or Fax (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

67050 7590 03/06/2014
KASHA LAW LLC
14532 Dufief Mill Road
North Potomac, MD 20878

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Certificate of Mailing or Transmission
I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/546,673	07/11/2012	Michael J. Rojas	EMP0024-US	9648

TITLE OF INVENTION: SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING

APPLN. TYPE	ENTITY STATUS	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	SMALL	$480	$0	$0	$480	06/06/2014

EXAMINER	ART UNIT	CLASS-SUBCLASS
SMITH, CREIGHTON H	2656	370-352000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).
- ❑ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
- ❑ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list
(1) The names of up to 3 registered patent attorneys or agents OR, alternatively,
(2) The name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.
1 _____
2 _____
3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE (B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) : ❑ Individual ❑ Corporation or other private group entity ❑ Government

4a. The following fee(s) are submitted:
- ❑ Issue Fee
- ❑ Publication Fee (No small entity discount permitted)
- ❑ Advance Order - # of Copies _____

4b. Payment of Fee(s): **(Please first reapply any previously paid issue fee shown above)**
- ❑ A check is enclosed.
- ❑ Payment by credit card. Form PTO-2038 is attached.
- ❑ The Director is hereby authorized to charge the required fee(s), any deficiency, or credits any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. **Change in Entity Status** (from status indicated above)
- ❑ Applicant certifying micro entity status. See 37 CFR 1.29 — NOTE: Absent a valid certification of Micro Entity Status (see forms PTO/SB/15A and 15B), issue fee payment in the micro entity amount will not be accepted at the risk of application abandonment.
- ❑ Applicant asserting small entity status. See 37 CFR 1.27 — NOTE: If the application was previously under micro entity status, checking this box will be taken to be a notification of loss of entitlement to micro entity status.
- ❑ Applicant changing to regular undiscounted fee status. — NOTE: Checking this box will be taken to be a notification of loss of entitlement to small or micro entity status, as applicable.

NOTE: This form must be signed in accordance with 37 CFR 1.31 and 1.33. See 37 CFR 1.4 for signature requirements and certifications.

Authorized Signature _____ Date _____

Typed or printed name _____ Registration No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/546,673	07/11/2012	Michael J. Rojas	EMP0024-US	9648

67050 7590 03/06/2014

KASHA LAW LLC
14532 Dufief Mill Road
North Potomac, MD 20878

EXAMINER	
SMITH, CREIGHTON H	

ART UNIT	PAPER NUMBER
2656	

DATE MAILED: 03/06/2014

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 0 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 0 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

OMB Clearance and PRA Burden Statement for PTOL-85 Part B

The Paperwork Reduction Act (PRA) of 1995 requires Federal agencies to obtain Office of Management and Budget approval before requesting most types of information from the public. When OMB approves an agency request to collect information from the public, OMB (i) provides a valid OMB Control Number and expiration date for the agency to display on the instrument that will be used to collect the information and (ii) requires the agency to inform the public about the OMB Control Number's legal significance in accordance with 5 CFR 1320.5(b).

The information collected by PTOL-85 Part B is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Notice of Allowability	Application No. 13/546,673	Applicant(s) ROJAS, MICHAEL J.	
	Examiner CREIGHTON SMITH	Art Unit 2656	AIA (First Inventor to File) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to *AF amendment &Terminal Disclaimer filed on 28 FEB '14*.
   ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on_____.
2. ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.
3. ☒ The allowed claim(s) is/are *2,5-11,13-20 and 22-44*. As a result of the allowed claim(s), you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov .
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   Certified copies:

   a) ☐ All b) ☐ Some *c) ☐ None of the:
   1. ☐ Certified copies of the priority documents have been received.
   2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
   3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
   ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

   Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____
3. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
4. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____ .
5. ☐ Examiner's Amendment/Comment
6. ☒ Examiner's Statement of Reasons for Allowance
7. ☐ Other _____.

The present application is being examined under the pre-AIA first to invent provisions.

REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance: The prior art fails to disclose applicant's instant voice messaging system that has a database of user records where each record includes a user's name, password, and a list of other users selected by a user. Neither does the prior art teach applicant's instant voice messaging system that has an object field including a digitized audio file, nor does the instant voice messaging system include displaying a list of recipients for an instant voice message. No obvious combination of references found would have taught one of ordinary skill in the art to make applicant's system as claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CREIGHTON SMITH whose telephone number is (571)272-7546. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on 27499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CREIGHTON SMITH/
Primary Examiner, Art Unit 2656 03 MAR ‘14

Issue Classification	Application/Control No.	Applicant(s)/Patent Under Reexamination
	13546673	ROJAS, MICHAEL J.
	Examiner	**Art Unit**
	CREIGHTON SMITH	2656

CPC		
Symbol	**Type**	**Version**

CPC Combination Sets				
Symbol	**Type**	**Set**	**Ranking**	**Version**

NONE		Total Claims Allowed:	
(Assistant Examiner)	(Date)	39	
/CREIGHTON SMITH/ Primary Examiner.Art Unit 2656	03 MAR '14	O.G. Print Claim(s)	O.G. Print Figure
(Primary Examiner)	(Date)	1	1

Issue Classification	Application/Control No.	Applicant(s)/Patent Under Reexamination
	13546673	ROJAS, MICHAEL J.
	Examiner	**Art Unit**
	CREIGHTON SMITH	2656

US ORIGINAL CLASSIFICATION		INTERNATIONAL CLASSIFICATION										
CLASS	SUBCLASS	CLAIMED					NON-CLAIMED					
370	352	H	0	4	L	12 / 66 (2006.01.01)						

CROSS REFERENCE(S)					
CLASS	SUBCLASS (ONE SUBCLASS PER BLOCK)				
709	206				
379	88.17				

NONE		Total Claims Allowed:	
(Assistant Examiner)	(Date)	39	
/CREIGHTON SMITH/ Primary Examiner.Art Unit 2656	03 MAR '14	O.G. Print Claim(s)	O.G. Print Figure
(Primary Examiner)	(Date)	1	1

Issue Classification	Application/Control No.	Applicant(s)/Patent Under Reexamination
	13546673	ROJAS, MICHAEL J.
	Examiner	**Art Unit**
	CREIGHTON SMITH	2656

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47

Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original	Final	Original
1	2	11	18	13	34										
	3	12	19	14	35										
	4	27	20	15	36										
2	5		21	16	37										
3	6	28	22	17	38										
4	7	29	23	18	39										
5	8	30	24	19	40										
6	9	31	25	20	41										
7	10	32	26	21	42										
8	11	33	27	22	43										
	12	37	28	23	44										
24	13	38	29												
25	14	39	30												
26	15	35	31												
9	16	36	32												
10	17	37	33												

NONE (Assistant Examiner)	(Date)	**Total Claims Allowed:** 39	
/CREIGHTON SMITH/ Primary Examiner.Art Unit 2656 (Primary Examiner)	03 MAR '14 (Date)	O.G. Print Claim(s) 1	O.G. Print Figure 1

Search Notes	Application/Control No.	Applicant(s)/Patent Under Reexamination
	13546673	ROJAS, MICHAEL J.
	Examiner	Art Unit
	CREIGHTON SMITH	2656

CPC- SEARCHED		
Symbol	Date	Examiner

CPC COMBINATION SETS - SEARCHED		
Symbol	Date	Examiner

US CLASSIFICATION SEARCHED			
Class	Subclass	Date	Examiner
379	88.17	03.03.14	chs
709	206	"	"
370	352	"	"

SEARCH NOTES		
Search Notes	Date	Examiner
EAST	06.03.13	chs
"	18.11.13	"
"	03.03.14	"

INTERFERENCE SEARCH			
US Class/ CPC Symbol	US Subclass / CPC Group	Date	Examiner
EAST		03.03.14	chs

Index of Claims	Application/Control No.	Applicant(s)/Patent Under Reexamination
	13546673	ROJAS, MICHAEL J.
	Examiner	**Art Unit**
	CREIGHTON SMITH	2656

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☒ T.D. ☐ R.1.47

CLAIM		DATE								
Final	Original	06/03/2013	11/18/2013	03/03/2014						
13	34			=						
14	35			=						
15	36			=						
16	37			=						
17	38			=						
18	39			=						
19	40			=						
20	41			=						
21	42			=						
22	43			=						
23	44			=						
1	2		✓	=						
	3		✓	-						
	4		✓	-						
2	5		✓	=						
3	6		✓	=						
4	7		✓	=						
5	8		✓	=						
6	9		✓	=						
7	10		✓	=						
8	11		✓	=						
	12		✓	-						
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12	19		✓	=						
27	20		✓	=						
	21		✓	-						
28	22		✓	=						
29	23		✓	=						
30	24		✓	=						
31	25		✓	=						
32	26		✓	=						

Index of Claims	Application/Control No.	Applicant(s)/Patent Under Reexamination
	13546673	ROJAS, MICHAEL J.
	Examiner	Art Unit
	CREIGHTON SMITH	2656

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☒ T.D. ☐ R.1.47

CLAIM		DATE								
Final	Original	06/03/2013	11/18/2013	03/03/2014						
33	27		✓	=						
34	28		✓	=						
38	29		✓	=						
39	30		✓	=						
35	31		✓	=						
36	32		✓	=						
37	33		✓	=						
	1	✓	-	-						

EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	0	((@ad<="20031218") or (@rlad<="20031218")) and display$3 with list with instant adj voice adj message	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2014/03/03 11:46

EAST Search History (Interference)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L2	0	((@ad<="20031218") or (@rlad<="20031218")) and display$3 with list with instant adj voice adj message.clm.	US-PGPUB; USPAT; UPAD	OR	OFF	2014/03/03 11:47

3/3/2014 11:48:43 AM
C:\Users\csmith1\Documents\EAST\Workspaces\12974648.wsp

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	
MICHAEL J. ROJAS	Confirmation No.: 9648
Serial No.: 13/546,673	Art Unit: 2656
Filed: July 11, 2012	Examiner: Creighton H. Smith
For: SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING	

AMENDMENT AFTER FINAL REJECTION UNDER 37 C.F.R. § 1.116

MAIL STOP: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action of November 29, 2013, please amend the above-identified application as follows:

Any fee necessary for consideration of this response is hereby authorized to be charged to Deposit Account Number 50-4075.

Amendments to the Claims are reflected in the listing of claims that begins on page 2 of this paper.

Remarks begin on page 9 of this paper.

Please enter this AF amendment. CHS 03 MAR '14

Amendments to the Claims:

This listing of claims replaces all prior versions and listings of claims in this application.

Listing of the Claims:

1. (Cancelled).

2. (Currently amended): A system comprising:

a network interface connected to a packet-switched network;

a messaging system communicating with a plurality of instant voice message client systems via the network interface; ~~and~~

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems; and

a user database storing user records identifying users of the plurality of instant voice message client systems, wherein each of the user records includes a user name, a password and a list of other users selected by a user.

3. (Cancelled).

4. (Cancelled).

5. (Currently amended): The system according to claim [[4]] 2, wherein at least part of each of the user records is encrypted.

6. (Currently amended): A system comprising:

a network interface connected to a packet-switched network;

a messaging system communicating with a plurality of instant voice message client systems via the network interface; and

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

~~The system according to claim 2,~~ wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and

wherein the instant voice message includes an object field including a digitized audio file.

7. (Previously presented): The system according to claim 6, wherein the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user.

8. (Currently amended): The system according to claim 7, wherein the predetermined set of permitted actions includes at least one of a connection request, a disconnection request, a subscription request, an unsubscription request, a message transmission request, and a set status request.

9. (Previously presented): The system according to claim 6, wherein the instant voice message includes an identifier field including a unique identifier associated with the instant voice message.

10. (Previously presented): The system according to claim 6, wherein the instant voice message includes a source field including a unique identifier associated with at least one of a given one of the plurality of instant voice message client systems that created the instant voice

message and a given one of the plurality of users using the given one of the plurality of instant voice message client systems.

11. (Previously presented): The system according to claim 6, wherein the instant voice message includes a destination field including a unique identifier associated with at least one of a given one of the plurality of instant voice message client systems identified as a recipient of the instant voice message and a given one of the plurality of users using the given one of the plurality of instant voice message client systems.

12. (Cancelled).

13. (Currently amended): A system comprising:

a network interface connected to a packet-switched network;

a messaging system communicating with a plurality of instant voice message client systems via the network interface; and

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

~~The system according to claim 2,~~ wherein the messaging system receives connection object messages from the plurality of instant voice message client systems, wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems.

14. (Previously presented): The system according to claim 13, wherein the connection object messages identifies at least one of a socket, a size of data to be transferred and a priority of the data.

15. (Previously presented): The system according to claim 13, wherein the communication platform system populates a connection list for the plurality of instant voice message client systems with the data in the connection object messages received from each of the plurality of instant voice message client systems.

16. (Currently amended): The system according to claim [[2]] 6, wherein the communication platform system assigns an IP address to each of the instant voice message client systems when the communication platform receives a connection request from each of the instant voice message client systems.

17. (Currently amended): The system according to claim [[2]] 6, further comprising: a message database storing the instant voice messages received from the instant voice message client systems.

18. (Currently amended): The system according to claim [[2]] 6, wherein, upon receipt of an instant voice message, the communication platform system determines if there is the current connection to one of the plurality of instant voice message client systems identified as a recipient of the instant voice message, and if there is no connection with the one of the plurality of instant voice message client system identified as the recipient, the instant voice message is stored and delivered when the one of the plurality of instant voice message client systems identified as the recipient re-established a connection.

19. (Currently amended): The system according to claim [[2]] 6, wherein the communication platform system updates the connection information for each of the instant voice message client systems by periodically transmitting a connection status request to the given one of the plurality of instant voice message client systems.

20. (Currently amended): A system comprising:

a client device;

a network interface coupled to the client device and connecting the client device to a packet-switched network; and

an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,

wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message.

21. (Cancelled).

22. (Previously presented): The system according to claim 20, wherein the instant voice messaging application includes a message database storing the instant voice message, wherein the instant voice messages is represented by a database record including a unique identifier.

23. (Previously presented): The system according to claim 22, wherein the instant voice message stored in the message database include a plurality of instant voice messages recorded by a user of the client device and instant voice messages received over the packet-switched network.

24. (Previously presented): The system according to claim 23, further comprising: a display displaying at least one of the plurality of instant voice messages stored in the message database.

25. (Previously presented): The system according to claim 22, wherein the instant voice messaging application includes a file manager system storing, deleting and retrieving the instant voice messages from the message database in response to a user request.

26. (Previously presented): The system according to claim 20, wherein the instant voice messaging application includes an audio file creation system creating an audio file for the instant voice message based on input received via an audio input device coupled to the client device.

27. (Previously presented): The system according to claim 20, wherein the instant voice messaging application includes an encryption/decryption system for encrypting the instant voice messages to be transmitted over the packet-switched network and decrypting the instant voices messages received over the packet-switched network.

28. (Previously presented): The system according to claim 20, wherein the instant voice messaging application includes a compression/decompression system for compressing the instant voice messages to be transmitted over the packet-switched network and decompressing the instant voice messages received over the packet-switched network.

29. (Currently amended): A system comprising:

a client device;

a network interface coupled to the client device and connecting the client device to a packet-switched network; and

an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,

~~The system according to claim 20, further comprising:~~ a display displaying a list of one or more potential recipients for an instant voice message.

30. (Previously presented): The system according to claim 29, wherein the display includes an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message.

31. (Previously presented): The system according to claim 20, wherein the instant voice message application generates an audible or visual effect indicating receipt of an instant voice message.

32. (Previously presented): The system according to claim 20, wherein the instant voice message application communicates in an intercom mode when a recipient of the instant voice message is currently available to receive the instant voice message and communicates in a record mode when the recipient of the instant voice message is currently unavailable to receive the instant voice message.

33. (Previously presented): The system according to claim 32, wherein the instant voice message application utilizes the intercom mode as a default communication mode.

34. (New) The system according to claim 6, wherein each of the instant voice message client systems comprises an instant voice messaging application generating an instant voice message

and transmitting the instant voice message over the packet-switched network to the messaging system.

35. (New): The system according to claim 34, 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.

36. (New): The system according to claim 35, wherein the message database includes a plurality of instant voice messages recorded by a user of the client device and instant voice messages received over the packet-switched network.

37. (New): The system according to claim 36, wherein the instant voice messaging application displays at least one of the plurality of instant voice messages stored in the message database.

38. (New): The system according to claim 35, 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.

39. (New): The system according to claim 34, wherein the instant voice messaging application includes an audio file creation system creating an audio file for the instant voice message based on input received via an audio input device coupled to the client device.

40. (New): The system according to claim 34, wherein the instant voice messaging application includes an encryption/decryption system for encrypting the instant voice messages to be transmitted over the packet-switched network and decrypting the instant voices messages received over the packet-switched network.

41. (New): The system according to claim 34, wherein the instant voice messaging application includes a compression/decompression system for compressing the instant voice messages to be transmitted over the packet-switched network and decompressing the instant voice messages received over the packet-switched network.

42. (New): The system according to claim 34, wherein the instant voice messaging application displays a list of one or more potential recipients for the instant voice message.

43. (New): The system according to claim 42, wherein the instant voice messaging application displays an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message.

44. (New): The system according to claim 34, wherein the instant voice message application generates an audible or visual effect indicating receipt of an instant voice message.

REMARKS

By this amendment, claims 3, 4, 12, and 21 have been cancelled, claims 2, 5, 6, 13, 16-20, and 29 have been amended, and new claims 34-44 have been added. No new matter is introduced. Claims 2, 5-11, 13-20 and 22-44 will remain pending herein upon entry of this Response. For the reasons stated below, the Applicant respectfully submits that all claims pending in this application are in condition for allowance. Reconsideration of this application is respectfully requested in view of the following remarks.

The subject matter of new claim 34 is described in the specification at, for example, page 13, line 15 – page 14, line 17.

The subject matter of new claim 35 is described in the specification at, for example, page 25, lines 6-8.

The subject matter of new claim 36 is described in the specification at, for example, page 35, lines 6-8.

The subject matter of new claim 37 is described in the specification at, for example, page 14, lines 12-14.

The subject matter of new claim 38 is described in the specification at, for example, page 25, lines 8-10.

The subject matter of new claim 39 is described in the specification at, for example, page 25, lines 10-12.

The subject matter of new claim 40 is described in the specification at, for example, page 25, lines 14-15.

The subject matter of new claim 41 is described in the specification at, for example, page 25, lines 15-17.

The subject matter of new claim 42 is described in the specification at, for example, page 13, line 15 – page 14, line 17.

The subject matter of new claim 43 is described in the specification at, for example, page 29, line 18 – page 30, line 7.

The subject matter of new claim 44 is described in the specification at, for example, page 16, line 23 – page 17, line 2.

Entry of the above amendments is proper under 37 C.F.R. § 1.116 because the amendments (1) place the claims in better form for appeal if needed; and (2) do not introduce any elements requiring further search by the Examiner.

Double Patenting Rejections

Claims 2-33 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-70 of U.S. Patent No. 7,535,890 (hereinafter the "'890 patent").

Claims 3, 4, 12, and 21 have been cancelled, rendering the rejection of these claims moot.

The Applicants file herewith a Terminal Disclaimer over the '890 patent. As set forth in the MPEP, a Terminal Disclaimer may be used to overcome a rejection based on obviousness-type double patenting (MPEP § 804.02(II)). Further, in legal principle, the filing of a Terminal Disclaimer simply serves the statutory function of removing the rejection of obviousness-type double patenting, and does not raise a presumption on the merits of the rejection. It is improper

to view the simple expedient of "obviation" as an admission or acquiescence on the merits. *Ortho Pharmaceutical Corp. v. Smith*, 22 USPQ2d 1119, 1124 (Fed. Cir. 1992) citing *Quad Envtl. Technologies Corp. v. Union Sanitary Dist.,* 946 F.2d 870, 874, 20 USPQ2d 1392, 1394-95 (Fed. Cir. 1991).

Withdrawal of the rejection of claims 2, 5-11, 13-20, and 22-33 based on the judicially created doctrine of double patenting is respectfully requested.

35 U.S. C. § 102(e) Rejections

Claims 2-3, 6, 11, 17-18, 20, 22-23, 26, and 32-33 stand rejected under 35 U.S.C. § 102(e) as unpatentable over U.S. Patent No. 7,372,826 to Dahod et al. ("Dahod"). This rejection is respectfully traversed. However, to move prosecution forward, the Applicant incorporates the allowable subject matter of claims 4, 12, 13, 21, and 29 into independent claims, as described below. The Applicant reserves the right to pursue previously filed claims in a continuation application, and this amendment does not indicate express or implicit agreement with the Examiner's rejections of previously presented claims.

Claim 3 has been cancelled, rendering the rejection of this claim moot.

Independent claim 2 has been amended to incorporate the subject matter of claims 3 and 4. Since the Examiner indicated that claim 4, which depended from claims 2 and 3, would be allowable if rewritten in independent form, it is respectfully submitted that amended independent claim 2 and claim 5 (which depends from claim 2) are allowable.

Claim 6 has been rewritten in independent form incorporating the subject matter of claims 2 and 12. Since the Examiner indicated that claim 12, which depended from claims 2 and

6, would be allowable if rewritten in independent form, it is respectfully submitted that amended independent claim 6 and claims 7-11 and 16-19 (which depend from claim 6) are allowable.

Claim 13 has been rewritten in independent form incorporating the subject matter of claim 2. Since the Examiner indicated that claim 13, which depended from claim 2, would be allowable if rewritten in independent form, it is respectfully submitted that amended independent claim 13 and claims 14-15 (which depend from claim 13) are allowable.

Independent claim 20 has been amended to incorporate the subject matter of claim 21. Since the Examiner indicated that claim 21, which depended from claim 20, would be allowable if rewritten in independent form, it is respectfully submitted that amended independent claim 20 and claims 22-28 and 31-33 (which depend from claim 20) are allowable.

Claim 29 has been rewritten in independent form incorporating the subject matter of claim 20. Since the Examiner indicated that claim 29, which depended from claim 20, would be allowable if rewritten in independent form, it is respectfully submitted that amended independent claim 29 and claim 30 (which depends from claim 29) are allowable.

Withdrawing of the rejection of claims 2, 6, 11, 17-18, 20, 22-23, 26, and 32-33 under 35 U.S.C. § 102(e) is respectfully requested.

New claims 34-44 depend directly or indirectly from allowable amended claim 6. Thus, it is respectfully submitted that new claims 34-44 are allowable at least for the reasons that amended claim 6 is allowable.

Conclusion

Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone the Applicant's undersigned representative at the number listed below.

KASHA LAW LLC
14532 Dufief Mill Rd.
North Potomac, MD 20878
Tel. 240-423-8431
Date: February 28, 2014

Respectfully submitted,

By: /Kelly L. Kasha/
Kelly L. Kasha
Registration No. 47,743

Customer No. 67050

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	
MICHAEL J. ROJAS	Confirmation No.: 9648
Serial No.: 13/546,673	Art Unit: 2656
Filed: July 11, 2012	Examiner: Creighton H. Smith
For: SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING	

AMENDMENT AFTER FINAL REJECTION UNDER 37 C.F.R. § 1.116

MAIL STOP: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action of November 29, 2013, please amend the above-identified application as follows:

Any fee necessary for consideration of this response is hereby authorized to be charged to Deposit Account Number 50-4075.

Amendments to the Claims are reflected in the listing of claims that begins on page 2 of this paper.

Remarks begin on page 9 of this paper.

Amendments to the Claims:

This listing of claims replaces all prior versions and listings of claims in this application.

Listing of the Claims:

1. (Cancelled).

2. (Currently amended): A system comprising:

a network interface connected to a packet-switched network;

a messaging system communicating with a plurality of instant voice message client systems via the network interface; ~~and~~

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems; and

a user database storing user records identifying users of the plurality of instant voice message client systems, wherein each of the user records includes a user name, a password and a list of other users selected by a user.

3. (Cancelled).

4. (Cancelled).

5. (Currently amended): The system according to claim [[4]] 2, wherein at least part of each of the user records is encrypted.

6. (Currently amended): A system comprising:

a network interface connected to a packet-switched network;

a messaging system communicating with a plurality of instant voice message client systems via the network interface; and

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

~~The system according to claim 2,~~ wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems, and

wherein the instant voice message includes an object field including a digitized audio file.

7. (Previously presented): The system according to claim 6, wherein the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user.

8. (Currently amended): The system according to claim 7, wherein the predetermined set of permitted actions includes at least one of a connection request, a disconnection request, a subscription request, an unsubscription request, a message transmission request, and a set status request.

9. (Previously presented): The system according to claim 6, wherein the instant voice message includes an identifier field including a unique identifier associated with the instant voice message.

10. (Previously presented): The system according to claim 6, wherein the instant voice message includes a source field including a unique identifier associated with at least one of a given one of the plurality of instant voice message client systems that created the instant voice

message and a given one of the plurality of users using the given one of the plurality of instant voice message client systems.

11. (Previously presented): The system according to claim 6, wherein the instant voice message includes a destination field including a unique identifier associated with at least one of a given one of the plurality of instant voice message client systems identified as a recipient of the instant voice message and a given one of the plurality of users using the given one of the plurality of instant voice message client systems.

12. (Cancelled).

13. (Currently amended): A system comprising:

a network interface connected to a packet-switched network;

a messaging system communicating with a plurality of instant voice message client systems via the network interface; and

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems,

~~The system according to claim 2,~~ wherein the messaging system receives connection object messages from the plurality of instant voice message client systems, wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems.

14. (Previously presented): The system according to claim 13, wherein the connection object messages identifies at least one of a socket, a size of data to be transferred and a priority of the data.

15. (Previously presented): The system according to claim 13, wherein the communication platform system populates a connection list for the plurality of instant voice message client systems with the data in the connection object messages received from each of the plurality of instant voice message client systems.

16. (Currently amended): The system according to claim [[2]] 6, wherein the communication platform system assigns an IP address to each of the instant voice message client systems when the communication platform receives a connection request from each of the instant voice message client systems.

17. (Currently amended): The system according to claim [[2]] 6, further comprising: a message database storing the instant voice messages received from the instant voice message client systems.

18. (Currently amended): The system according to claim [[2]] 6, wherein, upon receipt of an instant voice message, the communication platform system determines if there is the current connection to one of the plurality of instant voice message client systems identified as a recipient of the instant voice message, and if there is no connection with the one of the plurality of instant voice message client system identified as the recipient, the instant voice message is stored and delivered when the one of the plurality of instant voice message client systems identified as the recipient re-established a connection.

19. (Currently amended): The system according to claim [[2]] 6, wherein the communication platform system updates the connection information for each of the instant voice message client systems by periodically transmitting a connection status request to the given one of the plurality of instant voice message client systems.

20. (Currently amended): A system comprising:

a client device;

a network interface coupled to the client device and connecting the client device to a packet-switched network; and

an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,

wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message.

21. (Cancelled).

22. (Previously presented): The system according to claim 20, wherein the instant voice messaging application includes a message database storing the instant voice message, wherein the instant voice messages is represented by a database record including a unique identifier.

23. (Previously presented): The system according to claim 22, wherein the instant voice message stored in the message database include a plurality of instant voice messages recorded by a user of the client device and instant voice messages received over the packet-switched network.

24. (Previously presented): The system according to claim 23, further comprising: a display displaying at least one of the plurality of instant voice messages stored in the message database.

25. (Previously presented): The system according to claim 22, wherein the instant voice messaging application includes a file manager system storing, deleting and retrieving the instant voice messages from the message database in response to a user request.

26. (Previously presented): The system according to claim 20, wherein the instant voice messaging application includes an audio file creation system creating an audio file for the instant voice message based on input received via an audio input device coupled to the client device.

27. (Previously presented): The system according to claim 20, wherein the instant voice messaging application includes an encryption/decryption system for encrypting the instant voice messages to be transmitted over the packet-switched network and decrypting the instant voices messages received over the packet-switched network.

28. (Previously presented): The system according to claim 20, wherein the instant voice messaging application includes a compression/decompression system for compressing the instant voice messages to be transmitted over the packet-switched network and decompressing the instant voice messages received over the packet-switched network.

29. (Currently amended): A system comprising:

a client device;

a network interface coupled to the client device and connecting the client device to a packet-switched network; and

an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface,

~~The system according to claim 20, further comprising:~~ a display displaying a list of one or more potential recipients for an instant voice message.

30. (Previously presented): The system according to claim 29, wherein the display includes an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message.

31. (Previously presented): The system according to claim 20, wherein the instant voice message application generates an audible or visual effect indicating receipt of an instant voice message.

32. (Previously presented): The system according to claim 20, wherein the instant voice message application communicates in an intercom mode when a recipient of the instant voice message is currently available to receive the instant voice message and communicates in a record mode when the recipient of the instant voice message is currently unavailable to receive the instant voice message.

33. (Previously presented): The system according to claim 32, wherein the instant voice message application utilizes the intercom mode as a default communication mode.

34. (New) The system according to claim 6, wherein each of the instant voice message client systems comprises an instant voice messaging application generating an instant voice message

and transmitting the instant voice message over the packet-switched network to the messaging system.

35. (New): The system according to claim 34, 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.

36. (New): The system according to claim 35, wherein the message database includes a plurality of instant voice messages recorded by a user of the client device and instant voice messages received over the packet-switched network.

37. (New): The system according to claim 36, wherein the instant voice messaging application displays at least one of the plurality of instant voice messages stored in the message database.

38. (New): The system according to claim 35, 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.

39. (New): The system according to claim 34, wherein the instant voice messaging application includes an audio file creation system creating an audio file for the instant voice message based on input received via an audio input device coupled to the client device.

40. (New): The system according to claim 34, wherein the instant voice messaging application includes an encryption/decryption system for encrypting the instant voice messages to be transmitted over the packet-switched network and decrypting the instant voices messages received over the packet-switched network.

41. (New): The system according to claim 34, wherein the instant voice messaging application includes a compression/decompression system for compressing the instant voice messages to be transmitted over the packet-switched network and decompressing the instant voice messages received over the packet-switched network.

42. (New): The system according to claim 34, wherein the instant voice messaging application displays a list of one or more potential recipients for the instant voice message.

43. (New): The system according to claim 42, wherein the instant voice messaging application displays an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message.

44. (New): The system according to claim 34, wherein the instant voice message application generates an audible or visual effect indicating receipt of an instant voice message.

REMARKS

By this amendment, claims 3, 4, 12, and 21 have been cancelled, claims 2, 5, 6, 13, 16-20, and 29 have been amended, and new claims 34-44 have been added. No new matter is introduced. Claims 2, 5-11, 13-20 and 22-44 will remain pending herein upon entry of this Response. For the reasons stated below, the Applicant respectfully submits that all claims pending in this application are in condition for allowance. Reconsideration of this application is respectfully requested in view of the following remarks.

The subject matter of new claim 34 is described in the specification at, for example, page 13, line 15 – page 14, line 17.

The subject matter of new claim 35 is described in the specification at, for example, page 25, lines 6-8.

The subject matter of new claim 36 is described in the specification at, for example, page 35, lines 6-8.

The subject matter of new claim 37 is described in the specification at, for example, page 14, lines 12-14.

The subject matter of new claim 38 is described in the specification at, for example, page 25, lines 8-10.

The subject matter of new claim 39 is described in the specification at, for example, page 25, lines 10-12.

The subject matter of new claim 40 is described in the specification at, for example, page 25, lines 14-15.

The subject matter of new claim 41 is described in the specification at, for example, page 25, lines 15-17.

The subject matter of new claim 42 is described in the specification at, for example, page 13, line 15 – page 14, line 17.

The subject matter of new claim 43 is described in the specification at, for example, page 29, line 18 – page 30, line 7.

The subject matter of new claim 44 is described in the specification at, for example, page 16, line 23 – page 17, line 2.

Entry of the above amendments is proper under 37 C.F.R. § 1.116 because the amendments (1) place the claims in better form for appeal if needed; and (2) do not introduce any elements requiring further search by the Examiner.

Double Patenting Rejections

Claims 2-33 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-70 of U.S. Patent No. 7,535,890 (hereinafter the "'890 patent").

Claims 3, 4, 12, and 21 have been cancelled, rendering the rejection of these claims moot.

The Applicants file herewith a Terminal Disclaimer over the '890 patent. As set forth in the MPEP, a Terminal Disclaimer may be used to overcome a rejection based on obviousness-type double patenting (MPEP § 804.02(II)). Further, in legal principle, the filing of a Terminal Disclaimer simply serves the statutory function of removing the rejection of obviousness-type double patenting, and does not raise a presumption on the merits of the rejection. It is improper

to view the simple expedient of "obviation" as an admission or acquiescence on the merits. *Ortho Pharmaceutical Corp. v. Smith*, 22 USPQ2d 1119, 1124 (Fed. Cir. 1992) citing *Quad Envtl. Technologies Corp. v. Union Sanitary Dist.,* 946 F.2d 870, 874, 20 USPQ2d 1392, 1394-95 (Fed. Cir. 1991).

Withdrawal of the rejection of claims 2, 5-11, 13-20, and 22-33 based on the judicially created doctrine of double patenting is respectfully requested.

35 U.S. C. § 102(e) Rejections

Claims 2-3, 6, 11, 17-18, 20, 22-23, 26, and 32-33 stand rejected under 35 U.S.C. § 102(e) as unpatentable over U.S. Patent No. 7,372,826 to Dahod et al. ("Dahod"). This rejection is respectfully traversed. However, to move prosecution forward, the Applicant incorporates the allowable subject matter of claims 4, 12, 13, 21, and 29 into independent claims, as described below. The Applicant reserves the right to pursue previously filed claims in a continuation application, and this amendment does not indicate express or implicit agreement with the Examiner's rejections of previously presented claims.

Claim 3 has been cancelled, rendering the rejection of this claim moot.

Independent claim 2 has been amended to incorporate the subject matter of claims 3 and 4. Since the Examiner indicated that claim 4, which depended from claims 2 and 3, would be allowable if rewritten in independent form, it is respectfully submitted that amended independent claim 2 and claim 5 (which depends from claim 2) are allowable.

Claim 6 has been rewritten in independent form incorporating the subject matter of claims 2 and 12. Since the Examiner indicated that claim 12, which depended from claims 2 and

6, would be allowable if rewritten in independent form, it is respectfully submitted that amended independent claim 6 and claims 7-11 and 16-19 (which depend from claim 6) are allowable.

Claim 13 has been rewritten in independent form incorporating the subject matter of claim 2. Since the Examiner indicated that claim 13, which depended from claim 2, would be allowable if rewritten in independent form, it is respectfully submitted that amended independent claim 13 and claims 14-15 (which depend from claim 13) are allowable.

Independent claim 20 has been amended to incorporate the subject matter of claim 21. Since the Examiner indicated that claim 21, which depended from claim 20, would be allowable if rewritten in independent form, it is respectfully submitted that amended independent claim 20 and claims 22-28 and 31-33 (which depend from claim 20) are allowable.

Claim 29 has been rewritten in independent form incorporating the subject matter of claim 20. Since the Examiner indicated that claim 29, which depended from claim 20, would be allowable if rewritten in independent form, it is respectfully submitted that amended independent claim 29 and claim 30 (which depends from claim 29) are allowable.

Withdrawing of the rejection of claims 2, 6, 11, 17-18, 20, 22-23, 26, and 32-33 under 35 U.S.C. § 102(e) is respectfully requested.

New claims 34-44 depend directly or indirectly from allowable amended claim 6. Thus, it is respectfully submitted that new claims 34-44 are allowable at least for the reasons that amended claim 6 is allowable.

Conclusion

Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone the Applicant's undersigned representative at the number listed below.

KASHA LAW LLC
14532 Dufief Mill Rd.
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Tel. 240-423-8431
Date: February 28, 2014

Respectfully submitted,

By: /Kelly L. Kasha/
Kelly L. Kasha
Registration No. 47,743

Customer No. 67050

Electronic Acknowledgement Receipt

EFS ID:	18332655
Application Number:	13546673
International Application Number:	
Confirmation Number:	9648
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Customer Number:	67050
Filer:	John Kasha
Filer Authorized By:	
Attorney Docket Number:	EMP0024-US
Receipt Date:	28-FEB-2014
Filing Date:	11-JUL-2012
Time Stamp:	12:14:06
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Response After Final Action	EMP0024-US_af_resp_02_28_2014.pdf	130813 1b2c718c8fff1198d626b5030ad57e78dc7e0057	no	15

Warnings:	
Information:	

Total Files Size (in bytes):	130813

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

Doc Code: DIST.E.FILE Document Description: Electronic Terminal Disclaimer - Filed	PTO/SB/26 U.S. Patent and Trademark Office Department of Commerce

Electronic Petition Request	**TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT**
Application Number	13546673
Filing Date	11-Jul-2012
First Named Inventor	Michael Rojas
Attorney Docket Number	EMP0024-US
Title of Invention	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING

☒ Filing of terminal disclaimer does not obviate requirement for response under 37 CFR 1.111 to outstanding Office Action

☒ This electronic Terminal Disclaimer is not being used for a Joint Research Agreement.

Owner	Percent Interest
EMPIRE IP LLC	100%

The owner(s) with percent interest listed above in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of prior patent number(s)

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as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:
- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

◉ Terminal disclaimer fee under 37 CFR 1.20(d) is included with Electronic Terminal Disclaimer request.

○	I certify, in accordance with 37 CFR 1.4(d)(4), that the terminal disclaimer fee under 37 CFR 1.20(d) required for this terminal disclaimer has already been paid in the above-identified application.

Applicant claims the following fee status:

◉ Small Entity

○ Micro Entity

○ Regular Undiscounted

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

I certify, in accordance with 37 CFR 1.4(d)(4) that I am:

◉ An attorney or agent registered to practice before the Patent and Trademark Office who is of record in this application

Registration Number 47743

○ A sole inventor

○ A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors as evidenced by the power of attorney in the application

○ A joint inventor; all of whom are signing this request

Signature	/Kelly L. Kasha/
Name	Kelly L. Kasha

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

Electronic Patent Application Fee Transmittal

Application Number:	13546673
Filing Date:	11-Jul-2012
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Filer:	John Kasha
Attorney Docket Number:	EMP0024-US

Filed as Small Entity

Utility under 35 USC 111(a) Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Statutory or Terminal Disclaimer	1814	1	160	160
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Miscellaneous:				
			Total in USD ($)	**160**

Doc Code: DISQ.E.FILE
Document Description: Electronic Terminal Disclaimer – Approved

Application No.: 13546673

Filing Date: 11-Jul-2012

Applicant/Patent under Reexamination: Rojas et al.

Electronic Terminal Disclaimer filed on February 28, 2014

☒ APPROVED

This patent is subject to a terminal disclaimer

☐ DISAPPROVED

Approved/Disapproved by: Electronic Terminal Disclaimer automatically approved by EFS-Web

U.S. Patent and Trademark Office

Electronic Acknowledgement Receipt

EFS ID:	18333431
Application Number:	13546673
International Application Number:	
Confirmation Number:	9648
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Customer Number:	67050
Filer:	John Kasha
Filer Authorized By:	
Attorney Docket Number:	EMP0024-US
Receipt Date:	28-FEB-2014
Filing Date:	11-JUL-2012
Time Stamp:	12:32:12
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	$160
RAM confirmation Number	11204
Deposit Account	504075
Authorized User	

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Charge any Additional Fees required under 37 C.F.R. Section 1.17 (Patent application and reexamination processing fees)

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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Electronic Terminal Disclaimer-Filed	eTerminal-Disclaimer.pdf	33450 90910199d4fcdd611e5731dafd819f390c18f0b6	no	2
Warnings:					
Information:					
2	Fee Worksheet (SB06)	fee-info.pdf	29956 5e6f4c347567afe3d1a53044fc97cfaed55a3ac9	no	2
Warnings:					
Information:					
		Total Files Size (in bytes):	63406		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

PTO/SB/06 (09-11)
Approved for use through 1/31/2014. OMB 0651-0032
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PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875	Application or Docket Number 13/546,673	Filing Date 07/11/2012	☐ To be Mailed

ENTITY: ☐ LARGE ☒ SMALL ☐ MICRO

APPLICATION AS FILED – PART I

FOR	(Column 1) NUMBER FILED	(Column 2) NUMBER EXTRA	RATE ($)	FEE ($)
☐ BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	
☐ SEARCH FEE (37 CFR 1.16(k), (i), or (m))	N/A	N/A	N/A	
☐ EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	minus 20 =	*	X $ =	
INDEPENDENT CLAIMS (37 CFR 1.16(h))	minus 3 =	*	X $ =	
☐ APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is $310 ($155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).			
☐ MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))				
* If the difference in column 1 is less than zero, enter "0" in column 2.			TOTAL	

APPLICATION AS AMENDED – PART II

AMENDMENT

02/28/2014	(Column 1) CLAIMS REMAINING AFTER AMENDMENT		(Column 2) HIGHEST NUMBER PREVIOUSLY PAID FOR	(Column 3) PRESENT EXTRA	RATE ($)	ADDITIONAL FEE ($)
Total (37 CFR 1.16(i))	* 39	Minus	** 32	= 7	X $40 =	280
Independent (37 CFR 1.16(h))	* 5	Minus	***3	= 2	X $210 =	420
☐ Application Size Fee (37 CFR 1.16(s))						
☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						
					TOTAL ADD'L FEE	**700**

AMENDMENT

	(Column 1) CLAIMS REMAINING AFTER AMENDMENT		(Column 2) HIGHEST NUMBER PREVIOUSLY PAID FOR	(Column 3) PRESENT EXTRA	RATE ($)	ADDITIONAL FEE ($)
Total (37 CFR 1.16(i))	*	Minus	**	=	X $ =	
Independent (37 CFR 1.16(h))	*	Minus	***	=	X $ =	
☐ Application Size Fee (37 CFR 1.16(s))						
☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						
					TOTAL ADD'L FEE	

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

LIE
/KIMBERLY PANNELL/

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
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Sales Receipt for Accounting Date: 03/03/2014

KPANNELL SALE #00000002 Mailroom Dt: 02/28/2014 504075 13546673
01 FC : 2202 280.00 DA

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KASHA LAW LLC
14532 Dufief Mill Road
North Potomac, MD 20878

Courtesy Reminder for
Application Serial No: 13/546,673

Attorney Docket No: EMP0024-US
Customer Number: 67050
Date of Electronic Notification: 11/29/2013

This is a courtesy reminder that new correspondence is available for this application. If you have not done so already, please review the correspondence. The official date of notification of the outgoing correspondence will be indicated on the form PTOL-90 accompanying the correspondence.

An email notification regarding the correspondence was sent to the following email address(es) associated with your customer number:
JOHN.KASHA@KASHALAW.COM

To view your correspondence online or update your email addresses, please visit us anytime at **https://sportal.uspto.gov/secure/myportal/privatepair.** If you have any questions, please email the Electronic Business Center (EBC) at EBC@uspto.gov or call 1-866-217-9197.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/546,673	07/11/2012	Michael J. Rojas	EMP0024-US	9648

67050 7590 11/29/2013

KASHA LAW LLC
14532 Dufief Mill Road
North Potomac, MD 20878

EXAMINER	
SMITH, CREIGHTON H	
ART UNIT	PAPER NUMBER
2656	

NOTIFICATION DATE	DELIVERY MODE
11/29/2013	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

JOHN.KASHA@KASHALAW.COM

Office Action Summary	Application No. 13/546,673	Applicant(s) ROJAS, MICHAEL J.	
	Examiner CREIGHTON SMITH	Art Unit 2656	AIA (First Inventor to File) Status No

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 NOV '13*.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *2-33* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *2-33* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a)☐ All b)☐ Some * c)☐ None of the:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

4) ☐ Other: _____.

DETAILED ACTION

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the claims at issue are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the reference application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO internet Web site contains terminal disclaimer forms which may be used. Please visit http://www.uspto.gov/forms/. The filing date of the

application will determine what form should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to http://www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

Claims 2-33 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-70 of U.S. Patent No. 7,535,890. Although the claims at issue are not identical, they are not patentably distinct from each other because applicant's patent claim1 claims the instant voice messaging system that delivers IM over the Internet (Abstract). The body of the '723 patent's claim 1 claims a server that is connected to the Internet. Applicant's recital of a network interface in the instant application reads upon the patent's server. Applicant's recital of maintaining connection information for each of the client systems reads upon the server storing the instant voice message if one of the selected recipients/clients is unavailable and delivering the instant voice message if the recipient/client is available. Therefore, maintaining connection information is another way of saying whether the recipient/client is available or unavailable.

The following is a quotation of the appropriate paragraphs of pre-AIA 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2, 3, 6, 11, 17, 18, 20, 22, 23, 26, 32, 33 are rejected under pre-AIA 35 U.S.C. 102E as being anticipated by Dahod et al ("Dahod"), U.S. Pat. #7,372,826.

Dahod teaches in col. 8, lines 15 et seq. teaches a media gateway 410A and a softswitch 425A and server 440, any of which are network interfaces. In col. 9, lines 31 et seq. Dahod discloses that media gateway ("IMG") provides for instant voice messaging ("VIM"). VIM is defined by Dahod where a subscriber defines a group of VIM, calls a phone number and records a voice message that is associated with the group VIM ("VG"). Dahod's system will then dial the group's members (the plurality of client systems) and play the recorded message to the client systems/VG. In col. 12, lines 19 et seq. Dahod discloses his system can handle cases like applicant's, if an intended recipient is unavailable to receive an instant voice message, the message is stored in a system mailbox on a system server for future delivery. Therefore, Dahod's system's gateway knows whether an intended recipient of the VIM is available or unavailable by whether or not the recipient phone is on, or if the recipient is busy on another call.

Pertaining to claim 3, Dahod discloses in col. 9, lines 35 et seq. that a subscriber will define a VIM GROUP (VG). The subscriber will then dial a phone number and record a message associated with the pre-defined VG. Dahod's system will dial out to the members of the VG and play the pre-recorded

message. In order to dial out to the group members, the group members' phone number, i.e. user records, will have been previously stored in Dahod's system by the subscriber who makes up the VIM GROUP/VG.

Regarding claim 11, in col. 10, lines 22 et seq. Dahod discloses the user identifies a destination user by keypad entry and the gateway causes the message to be delivered to a gateway corresponding to the other MS.

The following is a quotation of pre-AIA 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9, 10 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Dahod et al in view of Bear et al ("Bear"), USPAP #2004/0223599.

Bear discloses in P.0070 that an incoming data call such as IM or email will also include the source of the communication, i.e. an identifier of who called or sent the message. To have provided Bear's teaching of including an identifier of the source of a call in Dahod's system would have been obvious to a person having ordinary skill in the art because both references are teaching calls.

Claim 16 is rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Dahod et al in view of Hurtta et al ("Hurtta"), USPAP #2005/0117591.

Hurtta discloses in P.0054 Ip addresses that are assigned to users. To have provided Hurtta's teaching of assigning IP addresses in Dahod's messaging system would have been obvious to a person having ordinary skill in the art because both references are teaching messaging in the packet switched network

.

Claim 24 is rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Dahod et al in view of Weiner, USPAP #2013/0279681.

Weiner discloses in P.0103 that an instant voice message (IVM) may be displayed on a handset. To have provided Weiner's teaching of displaying an IVM in Dahod's system would have been obvious to a person having ordinary skill in the art.

Claims 4, 5, 7, 8, 12-15, 19, 21, 25, 27-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory

period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to CREIGHTON SMITH at telephone number (571)272-7546.

/CREIGHTON SMITH/

Primary Examiner, Art Unit 2656 18 NOV '13

Notice of References Cited	Application/Control No. 13/546,673	Applicant(s)/Patent Under Reexamination ROJAS, MICHAEL J.	
	Examiner CREIGHTON SMITH	Art Unit 2656	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2004/0223599	11-2004	Bear et al.	379/207.02
*	B	US-2008/0298309	12-2008	DePietro et al.	370/328
*	C	US-2005/0117591	06-2005	Hurtta et al.	370/401
*	D	US-2013/0279681	10-2013	Weiner, Moshe	379/207.02
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
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	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
L1	0	((@ad<="20031218") or (@rlad<="20031218")) and records with name with password with list near6 other	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 14:16
L2	17	((@ad<="20031218") or (@rlad<="20031218")) and records with name with password with list	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 14:16
L3	28415741	((@ad<="20031218") or (@rlad<="20031218")) andmessag$3 same records with name with password with list	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 14:17
L4	7	((@ad<="20031218") or (@rlad<="20031218")) and messag$3 same records with name with password with list	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 14:17
L5	0	((@ad<="20031218") or (@rlad<="20031218")) and instant near5 voice near5 message$3 with action near3 field	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 14:23
L6	7	((@ad<="20031218") or (@rlad<="20031218")) and instant near5 voice near5 message$3 same action near3 field	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 14:23
L7	0	((@ad<="20031218") or (@rlad<="20031218")) and instant near5 voice near5 message$3 same idenitfier	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 14:24
L8	9	((@ad<="20031218") or (@rlad<="20031218")) and instant near5 voice near5 message$3 same source with IDentifi$7	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 14:44
L9	18	((@ad<="20031218") or (@rlad<="20031218")) and instant near5 voice near5 message$3 same (destination or recipinet or called) with IDentifi$7	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 14:53
L10	7	((@ad<="20031218") or (@rlad<="20031218")) and instant near5 voice near5 message$3 same digitized near4 audio near4 file	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 15:14

L11	7	(((@ad<="20031218") or (@rlad<="20031218")) and instant near5 voice near5 message$3 same digitized near4 audio	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 15:14
L12	29	(((@ad<="20031218") or (@rlad<="20031218")) and messag$3 same connect$3 near5 messages with (plural$3 or multipl$5) with (clients or recipients)	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 15:16
L13	53	(((@ad<="20031218") or (@rlad<="20031218")) and (ip or internet adj protocol or packet near2 switch$3) same assign$3 with (ip or (internet adj protocol)) adj address same (instant adj voice adj messag$3 or im or instant adj messag$3)	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 15:33
L14	34	(((@ad<="20031218") or (@rlad<="20031218")) and (ip or internet adj protocol or packet near2 switch$3) same assign$3 with (ip or (internet adj protocol)) adj address with (instant adj voice adj messag$3 or im or instant adj messag$3)	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 15:34
L15	12	(((@ad<="20031218") or (@rlad<="20031218")) and instant near5 voice near5 message$3 same attach$3 with file	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 15:43
L16	129	(((@ad<="20031218") or (@rlad<="20031218")) and instant near5 voice near5 message$3 same display$3	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 15:48
L17	14	(((@ad<="20031218") or (@rlad<="20031218")) and instant adj voice adj message$3 with display$3	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 15:49
L18	7	(((@ad<="20031218") or (@rlad<="20031218")) and instant adj voice adj message$3 same delet$3 with retriev$3	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 15:58
L19	7	(((@ad<="20031218") or (@rlad<="20031218")) and instant adj voice adj message$3 same encrypt$3 with decrypt$3	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 15:59
L20	8	(((@ad<="20031218") or (@rlad<="20031218")) and instant adj voice adj message$3 same compress$3 with decompress$3	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 16:00
L21	7	(((@ad<="20031218") or (@rlad<="20031218")) and instant adj voice adj message$3 same display$3 with list with recipients	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 16:03
L22	7	(((@ad<="20031218") or	US-	OR	OFF	2013/11/18

		(@rlad<="20031218")) and instant near5 voice near5 message$3 same display$3 with list with recipients	PGPUB; USPAT; EPO; JPO; DERWENT			16:03
L23	0	(((@ad<="20031218") or (@rlad<="20031218")) and instant near5 voice near5 message$3 same (audio or visual) with receipt	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/11/18 16:05

EAST Search History (Interference)

<This search history is empty>

11/18/2013 4:09:21 PM
C:\Users\csmith1\Documents\EAST\Workspaces\12974648.wsp

Search Notes	Application/Control No.	Applicant(s)/Patent Under Reexamination
	13546673	ROJAS, MICHAEL J.
	Examiner	Art Unit
	CREIGHTON SMITH	2656

CPC- SEARCHED		
Symbol	Date	Examiner

CPC COMBINATION SETS - SEARCHED		
Symbol	Date	Examiner

US CLASSIFICATION SEARCHED			
Class	Subclass	Date	Examiner

SEARCH NOTES		
Search Notes	Date	Examiner
EAST	06.03.13	chs
"	18.11.13	"

INTERFERENCE SEARCH			
US Class/ CPC Symbol	US Subclass / CPC Group	Date	Examiner

EAST Search History

EAST Search History (Prior Art)

Ref #	Hits	Search Query	DBs	Default Operator	Plurals	Time Stamp
S1	4	(("8243723") or ("7535890")).PN.	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/06/03 08:05
S2	13	((@ad<="20031218") or (@rlad<="20031218")) and (stor$3 or retain$3) same instant near3 (voice or voip) near3 messag$3 same (unavailable or "not" adj available)	US-PGPUB; USPAT; EPO; JPO; DERWENT	OR	OFF	2013/06/03 09:40

EAST Search History (Interference)

<This search history is empty>

6/3/2013 10:32:22 AM
C:\Users\csmith1\Documents\EAST\Workspaces\12974648.wsp

Index of Claims	Application/Control No.	Applicant(s)/Patent Under Reexamination
	13546673	ROJAS, MICHAEL J.
	Examiner	Art Unit
	CREIGHTON SMITH	2656

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☒ T.D. ☐ R.1.47

CLAIM		DATE								
Final	Original	06/03/2013	11/18/2013							
	2		✓							
	3		✓							
	4		✓							
	5		✓							
	6		✓							
	7		✓							
	8		✓							
	9		✓							
	10		✓							
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	25		✓							
	26		✓							
	27		✓							
	28		✓							
	29		✓							
	30		✓							
	31		✓							
	32		✓							
	33		✓							
	1	✓	-							

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	
MICHAEL J. ROJAS	Confirmation No.: 9648
Serial No.: 13/546,673	Art Unit: 2656
Filed: July 11, 2012	Examiner: Creighton H. Smith
For: SYSTEM AND METHOD FOR INSTANT VOIP MESSAGING	

AMENDMENT

MAIL STOP: AMENDMENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action of June 5, 2013, please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims that begins on page 2 of this paper.

Remarks begin on page 8 of this paper.

Amendments to the Claims:

This listing of claims replaces all prior versions and listings of claims in this application.

Listing of the Claims:

1. (Cancelled).

2. (New) A system comprising:

a network interface connected to a packet-switched network;

a messaging system communicating with a plurality of instant voice message client systems via the network interface; and

a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current connection to each of the plurality of instant voice message client systems.

3. (New) The system according to claim 2, further comprising: a user database storing user records identifying users of the plurality of instant voice message client systems.

4. (New) The system according to claim 3, wherein each of the user records includes a user name, a password and a list of other users selected by a user.

5. (New) The system according to claim 4, wherein at least part of each of the user records is encrypted.

6. (New) The system according to claim 2, wherein the messaging system receives an instant voice message from one of the plurality of instant voice message client systems.

7. (New) The system according to claim 6, wherein the instant voice message includes an action field identifying one of a predetermined set of permitted actions requested by the user.

8. (New) The system according to claim 7, wherein the predetermined set of permitted actions includes a connection request, a disconnection request, a subscription request, an unsubscription request, a message transmission request, and a set status request.

9. (New) The system according to claim 6, wherein the instant voice message includes an identifier field including a unique identifier associated with the instant voice message.

10. (New) The system according to claim 6, wherein the instant voice message includes a source field including a unique identifier associated with at least one of a given one of the plurality of instant voice message client systems that created the instant voice message and a given one of the plurality of users using the given one of the plurality of instant voice message client systems.

11. (New) The system according to claim 6, wherein the instant voice message includes a destination field including a unique identifier associated with at least one of a given one of the plurality of instant voice message client systems identified as a recipient of the instant voice message and a given one of the plurality of users using the given one of the plurality of instant voice message client systems.

12. (New) The system according to claim 6, wherein the instant voice message includes an object field including a digitized audio file.

13. (New) The system according to claim 2, wherein the messaging system receives connection object messages from the plurality of instant voice message client systems, wherein each of the connection object messages includes data representing a state of a logical connection with a given one of the plurality of instant voice message client systems.

14. (New) The system according to claim 13, wherein the connection object messages identifies at least one of a socket, a size of data to be transferred and a priority of the data.

15. (New) The system according to claim 13, wherein the communication platform system populates a connection list for the plurality of instant voice message client systems with the data in the connection object messages received from each of the plurality of instant voice message client systems.

16. (New) The system according to claim 2, wherein the communication platform system assigns an IP address to each of the instant voice message client systems when the communication platform receives a connection request from each of the instant voice message client systems.

17. (New) The system according to claim 2, further comprising: a message database storing the instant voice messages received from the instant voice message client systems.

18. (New) The system according to claim 2, wherein, upon receipt of an instant voice message, the communication platform system determines if there is the current connection to one of the plurality of instant voice message client systems identified as a recipient of the instant voice message, and if there is no connection with the one of the plurality of instant voice message client system identified as the recipient, the instant voice message is stored and delivered when the one of the plurality of instant voice message client systems identified as the recipient re-established a connection.

19. (New) The system according to claim 2, wherein the communication platform system updates the connection information for each of the instant voice message client systems by

periodically transmitting a connection status request to the given one of the plurality of instant voice message client systems.

20. (New) A system comprising:

a client device;

a network interface coupled to the client device and connecting the client device to a packet-switched network; and

an instant voice messaging application installed on the client device, wherein the instant voice messaging application includes a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over the packet-switched network via the network interface.

21. (New) The system according to claim 20, wherein the instant voice messaging application includes a document handler system for attaching one or more files to the instant voice message.

22. (New) The system according to claim 20, wherein the instant voice messaging application includes a message database storing the instant voice message, wherein the instant voice messages is represented by a database record including a unique identifier.

23. (New) The system according to claim 22, wherein the instant voice message stored in the message database include a plurality of instant voice messages recorded by a user of the client device and instant voice messages received over the packet-switched network.

24. (New) The system according to claim 23, further comprising: a display displaying at least one of the plurality of instant voice messages stored in the message database.

25. (New) The system according to claim 22, wherein the instant voice messaging application includes a file manager system storing, deleting and retrieving the instant voice messages from the message database in response to a user request.

26. (New) The system according to claim 20, wherein the instant voice messaging application includes an audio file creation system creating an audio file for the instant voice message based on input received via an audio input device coupled to the client device.

27. (New) The system according to claim 20, wherein the instant voice messaging application includes an encryption/decryption system for encrypting the instant voice messages to be transmitted over the packet-switched network and decrypting the instant voices messages received over the packet-switched network.

28. (New) The system according to claim 20, wherein the instant voice messaging application includes a compression/decompression system for compressing the instant voice messages to be transmitted over the packet-switched network and decompressing the instant voice messages received over the packet-switched network.

29. (New) The system according to claim 20, further comprising: a display displaying a list of one or more potential recipients for an instant voice message.

30. (New) The system according to claim 29, wherein the display includes an indicia for each of the one or more potential recipients indicating whether the potential recipient is currently available to receive an instant voice message.

31. (New) The system according to claim 20, wherein the instant voice message application generates an audible or visual effect indicating receipt of an instant voice message.

32. (New) The system according to claim 20, wherein the instant voice message application communicates in an intercom mode when a recipient of the instant voice message is currently available to receive the instant voice message and communicates in a record mode when the recipient of the instant voice message is currently unavailable to receive the instant voice message.

33. (New) The system according to claim 32, wherein the instant voice message application utilizes the intercom mode as a default communication mode.

REMARKS

Claim 1 is pending in this application. By this amendment, claim 1 is cancelled, and new claims 2-33 are added. Accordingly, claims 2-33 will remain pending herein upon entry of this Response. No new matter is introduced.

The subject matter of new claim 2 is described in the specification at, for example, page 27, line 12 – page 28, line 11.

The subject matter of new claim 3 is described in the specification at, for example, page 28, lines 3-8.

The subject matter of new claim 4 is described in the specification at, for example, page 28, lines 3-8.

The subject matter of new claim 5 is described in the specification at, for example, page 28, lines 9-10.

The subject matter of new claim 6 is described in the specification at, for example, page 28, lines 12-14.

The subject matter of new claim 7 is described in the specification at, for example, page 28, lines 12-17.

The subject matter of new claim 8 is described in the specification at, for example, page 28, lines 13-19.

The subject matter of new claim 9 is described in the specification at, for example, page 28, lines 12-13; 19-20.

The subject matter of new claim 10 is described in the specification at, for example, page 28, lines 12-13 and 20-22.

The subject matter of new claim 11 is described in the specification at, for example, page 29, lines 10-11.

The subject matter of new claim 12 is described in the specification at, for example, page 29, lines 11-13.

The subject matter of new claim 13 is described in the specification at, for example, page 29, lines 18-22.

The subject matter of new claim 14 is described in the specification at, for example, page 30, lines 1-3.

The subject matter of new claim 15 is described in the specification at, for example, page 30, lines 3-7.

The subject matter of new claim 16 is described in the specification at, for example, page 31, lines 2-7.

The subject matter of new claim 17 is described in the specification at, for example, page 45, line 17 – page 46, line 7.

The subject matter of new claim 18 is described in the specification at, for example, page 16, line 21 – page 17, line 7.

The subject matter of new claim 19 is described in the specification at, for example, page 28, lines 15-16.

The subject matter of new claim 20 is described in the specification at, for example, page 13, line 15 – page 14, line 17.

The subject matter of new claim 21 is described in the specification at, for example, page 24, line 23 – page 25, line 6.

The subject matter of new claim 22 is described in the specification at, for example, page 25, lines 6-8.

The subject matter of new claim 23 is described in the specification at, for example, page 25, lines 6-8.

The subject matter of new claim 24 is described in the specification at, for example, page 14, lines 12-14.

The subject matter of new claim 25 is described in the specification at, for example, page 25, lines 8-10.

The subject matter of new claim 26 is described in the specification at, for example, page 25, lines 10-12.

The subject matter of new claim 27 is described in the specification at, for example, page 25, lines 14-15.

The subject matter of new claim 28 is described in the specification at, for example, page 25, lines 15-17.

The subject matter of new claim 29 is described in the specification at, for example, page 16, lines 2-6.

The subject matter of new claim 30 is described in the specification at, for example, page 29, line 18 – page 30, line 7.

The subject matter of new claim 31 is described in the specification at, for example, page 16, line 23 – page 17, line 2.

The subject matter of new claim 32 is described in the specification at, for example, page 23, line 5 – page 24, line 2.

The subject matter of new claim 33 is described in the specification at, for example, page 24, lines 2-4.

Double Patenting Rejection of Claim 1

Claim 1 stands rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-70 of U.S. Patent No. 7,535,890. The Applicant respectfully submits that this rejection of claim 1 is moot in view of the cancellation of claim 1.

35 U.S. C. § 102(e) Rejection of Claim 1

Claim 1 stands rejected under 35 U.S.C. § 102(e) as unpatentable over U.S. Patent No. 7,372,826 to Dahod et al. ("Dahod"). This rejection is respectfully traversed.

First, the Examiner has not indicated how Dahod allegedly anticipates cancelled claim 1, but simply cites to col. 12, lines 19-26.

Second, the Applicant respectfully submits that this rejection of claim 1 is moot in view of the cancellation of claim 1.

Finally, Dahod does not disclose or suggest the limitations of new independent claims 2 and 20, or any of the claims depending therefrom. For example, the cited portion of Dahod does

not disclose or suggest, "a network interface connected to a packet-switched network," as recited in claim 2, or "a network interface coupled to the client device and connecting the client device to a packet-switched network," as recited in claim 20. Therefore, the Applicant respectfully submits that all new claims 2-33 are allowable.

Conclusion

Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone the Applicant's undersigned representative at the number listed below.

KASHA LAW LLC
14532 Dufief Mill Rd.
North Potomac, MD 20878
Tel. 703-867-1886
Date: November 5, 2013

Respectfully submitted,

By: /John R. Kasha/
John R. Kasha
Registration No. 53,100

JRK
Customer No. 67050

Electronic Patent Application Fee Transmittal

Application Number:	13546673
Filing Date:	11-Jul-2012
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Filer:	John Kasha
Attorney Docket Number:	EMP0024-US

Filed as Small Entity

Utility under 35 USC 111(a) Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Pages:				
Claims:				
Claims in excess of 20	2202	12	40	480
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Extension - 2 months with $0 paid	2252	1	300	300
Miscellaneous:				
			Total in USD ($)	**780**

Electronic Acknowledgement Receipt

EFS ID:	17324113
Application Number:	13546673
International Application Number:	
Confirmation Number:	9648
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Customer Number:	67050
Filer:	John Kasha
Filer Authorized By:	
Attorney Docket Number:	EMP0024-US
Receipt Date:	05-NOV-2013
Filing Date:	11-JUL-2012
Time Stamp:	20:30:09
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	$780
RAM confirmation Number	6893
Deposit Account	504075
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

Charge any Additional Fees required under 37 C.F.R. Section 1.16 (National application filing, search, and examination fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.17 (Patent application and reexamination processing fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.19 (Document supply fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.20 (Post Issuance fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Amendment/Req. Reconsideration-After Non-Final Reject	EMP0024-US_resp_11_05_2013.pdf	100813 12f0efc142db47963f33a6aba2b76f0aec14f79c	no	12
Warnings:					
Information:					
2	Fee Worksheet (SB06)	fee-info.pdf	32172 c34516167eb5e5d002ecc9f993161107cddff318	no	2
Warnings:					
Information:					
		Total Files Size (in bytes):	132985		

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

PTO/SB/06 (09-11)
Approved for use through 1/31/2014. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875	Application or Docket Number 13/546,673	Filing Date 07/11/2012	☐ To be Mailed

ENTITY: ☐ LARGE ☒ SMALL ☐ MICRO

APPLICATION AS FILED – PART I

FOR	(Column 1) NUMBER FILED	(Column 2) NUMBER EXTRA	RATE ($)	FEE ($)
☐ BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	
☐ SEARCH FEE (37 CFR 1.16(k), (i), or (m))	N/A	N/A	N/A	
☐ EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	minus 20 =	*	X $ =	
INDEPENDENT CLAIMS (37 CFR 1.16(h))	minus 3 =	*	X $ =	
☐ APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is $310 ($155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).			
☐ MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))				
* If the difference in column 1 is less than zero, enter "0" in column 2.			TOTAL	

APPLICATION AS AMENDED – PART II

AMENDMENT **11/05/2013**

	(Column 1) CLAIMS REMAINING AFTER AMENDMENT		(Column 2) HIGHEST NUMBER PREVIOUSLY PAID FOR	(Column 3) PRESENT EXTRA	RATE ($)	ADDITIONAL FEE ($)
Total (37 CFR 1.16(i))	* 32	Minus	** 20	= 12	X $40 =	480
Independent (37 CFR 1.16(h))	* 2	Minus	***3	= 0	X $210 =	0
☐ Application Size Fee (37 CFR 1.16(s))						
☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						
					TOTAL ADD'L FEE	**480**

AMENDMENT

	(Column 1) CLAIMS REMAINING AFTER AMENDMENT		(Column 2) HIGHEST NUMBER PREVIOUSLY PAID FOR	(Column 3) PRESENT EXTRA	RATE ($)	ADDITIONAL FEE ($)
Total (37 CFR 1.16(i))	*	Minus	**	=	X $ =	
Independent (37 CFR 1.16(h))	*	Minus	***	=	X $ =	
☐ Application Size Fee (37 CFR 1.16(s))						
☐ FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))						
					TOTAL ADD'L FEE	

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".
The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.

LIE
/VERONICA DAY EVERETT/

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/546,673	07/11/2012	Michael J. Rojas	17188YX

CONFIRMATION NO. 9648

POA ACCEPTANCE LETTER

67050
KASHA LAW LLC
14532 Dufief Mill Road
North Potomac, MD 20878

OC000000063829485

Date Mailed: 09/25/2013

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/12/2013.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

/kgebremichael/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/546,673	07/11/2012	Michael J. Rojas	17188YX

CONFIRMATION NO. 9648

POWER OF ATTORNEY NOTICE

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GARDEN CITY, NY 11530

OC000000063829473

Date Mailed: 09/25/2013

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/12/2013.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

/kgebremichael/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

POWER OF ATTORNEY OR REVOCATION OF POWER OF ATTORNEY WITH A NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	13546873
Filing Date	2012-07-11
First Named Inventor	Michael J. Rojas
Title	System and Method for Instant VoIP Messaging
Art Unit	2658
Examiner Name	Creighton H. Smith
Attorney Docket Number	EMP0024-US

I hereby revoke all previous powers of attorney given in the above-identified application.

☐ A Power of Attorney is submitted herewith.

OR

☒ I hereby appoint Practitioner(s) associated with the following Customer Number as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

67050

OR

☐ I hereby appoint Practitioner(s) named below as my/our attorney(s) or agent(s) to prosecute the application identified above, and to transact all business in the United States Patent and Trademark Office connected therewith:

Practitioner(s) Name	Registration Number

Please recognize or change the correspondence address for the above-identified application to:

☒ The address associated with the above-mentioned Customer Number.

OR

☐ The address associated with Customer Number:

OR

☐ Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone		Email			

I am the:

☐ Applicant/Inventor.

OR

☒ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) (Form PTO/SB/96) submitted herewith or filed on _____

SIGNATURE of Applicant or Assignee of Record

Signature		Date	8-27-2013
Name	Daniel Mitry	Telephone	
Title and Company	Principal, Empire IP LLC		

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.31, 1.32 and 1.33. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 3 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Empire IP LLC

Application No./Patent No.: 13/546,673 Filed/Issue Date: 2012-07-11

Titled:
System and Method for Instant VoIP Messaging

Empire IP LLC, a Corporation
(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.

states that it is:

1. [X] the assignee of the entire right, title, and interest in;

2. [ ] an assignee of less than the entire right, title, and interest in
(The extent (by percentage) of its ownership interest is _____ %); or

3. [ ] the assignee of an undivided interest in the entirety of (a complete assignment from one of the joint inventors was made)
the patent application/patent identified above, by virtue of either:

A. [ ] An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or for which a copy therefore is attached.

OR

B. [X] A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: Rojas, Michael J. To: Ayalogic, Inc.
The document was recorded in the United States Patent and Trademark Office at
Reel 014827, Frame 0069, or for which a copy thereof is attached.

2. From: Ayalogic, Inc. To: Empire IP LLC
The document was recorded in the United States Patent and Trademark Office at
Reel 030922, Frame 0335, or for which a copy thereof is attached.

3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

[ ] Additional documents in the chain of title are listed on a supplemental sheet(s).

[ ] As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.

[NOTE: A separate copy (i.e., a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

_____ 9-23-2013
Signature Date

Daniel Mitry Principal
Printed or Typed Name Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Electronic Acknowledgement Receipt

EFS ID:	16835408
Application Number:	13546673
International Application Number:	
Confirmation Number:	9648
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Customer Number:	23389
Filer:	John Kasha
Filer Authorized By:	
Attorney Docket Number:	17188YX
Receipt Date:	12-SEP-2013
Filing Date:	11-JUL-2012
Time Stamp:	13:58:53
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Power of Attorney	EMP0024-US_poa_signed1.pdf	385702 5067c23652b4b9bae306ddaf7325299b9d12c638	no	2

Warnings:	
Information:	

Total Files Size (in bytes):	385702

This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/546,673	07/11/2012	Michael J. Rojas	17188YX

CONFIRMATION NO. 9648

23389
SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

POA ACCEPTANCE LETTER

OC000000063607954

Date Mailed: 09/06/2013

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/27/2013.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

/gbien-aime/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

POWER OF ATTORNEY OR REVOCATION OF POWER OF ATTORNEY WITH A NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

Application Number	13546873
Filing Date	2012-07-11
First Named Inventor	Michael J. Rojas
Title	System and Method for Instant VoIP Messaging
Art Unit	2658
Examiner Name	Creighton H. Smith
Attorney Docket Number	EMP0024-US

I hereby revoke all previous powers of attorney given in the above-identified application.

☐ A Power of Attorney is submitted herewith.

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OR

☐ The address associated with Customer Number:

OR

☐ Firm or Individual Name					
Address					
City		State		Zip	
Country					
Telephone		Email			

I am the:

☐ Applicant/Inventor.

OR

☒ Assignee of record of the entire interest. See 37 CFR 3.71.
Statement under 37 CFR 3.73(b) (Form PTO/SB/96) submitted herewith or filed on _____

SIGNATURE of Applicant or Assignee of Record

Signature		Date	8-27-2013
Name	Daniel Mitry	Telephone	
Title and Company	Principal, Empire IP LLC		

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STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: Empire IP LLC

Application No./Patent No.: 13/546,673 Filed/Issue Date: 2012-07-11

Titled: System and Method for Instant VoIP Messaging

Empire IP LLC, a Corporation

(Name of Assignee) (Type of Assignee, e.g., corporation, partnership, university, government agency, etc.

states that it is:

1. [X] the assignee of the entire right, title, and interest in;

2. [ ] an assignee of less than the entire right, title, and interest in (The extent (by percentage) of its ownership interest is _____ %); or

3. [ ] the assignee of an undivided interest in the entirety of (a complete assignment from one of the joint inventors was made) the patent application/patent identified above, by virtue of either:

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OR

B. [X] A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

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Daniel Mitry Principal
Printed or Typed Name Title

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If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Electronic Acknowledgement Receipt

EFS ID:	16696141
Application Number:	13546673
International Application Number:	
Confirmation Number:	9648
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Customer Number:	23389
Filer:	John Kasha
Filer Authorized By:	
Attorney Docket Number:	17188YX
Receipt Date:	27-AUG-2013
Filing Date:	11-JUL-2012
Time Stamp:	13:44:31
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	no

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Power of Attorney	EMP0024-US_poa_signed1.pdf	385702 5067c23652b4b9bae306ddaf7325299b9d12c638	no	2

Warnings:	
Information:	

Total Files Size (in bytes):	385702

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New Applications Under 35 U.S.C. 111
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National Stage of an International Application under 35 U.S.C. 371
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New International Application Filed with the USPTO as a Receiving Office
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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/546,673	07/11/2012	Michael J. Rojas	17188YX	9648

23389 7590 06/05/2013
SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER	
SMITH, CREIGHTON H	

ART UNIT	PAPER NUMBER
2656	

MAIL DATE	DELIVERY MODE
06/05/2013	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	13/546,673	ROJAS, MICHAEL J.	
	Examiner	Art Unit	
	CREIGHTON SMITH	2656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) *1* is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6)☐ Claim(s) _____ is/are allowed.

7)☒ Claim(s) *1* is/are rejected.

8)☐ Claim(s) _____ is/are objected to.

9)☐ Claim(s) _____ are subject to restriction and/or election requirement.

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10)☐ The specification is objected to by the Examiner.

11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

3) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

4) ☐ Other: _____.

DETAILED ACTION

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-70 of U.S. Patent No. 7,535,890. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the elements of claim 1 are found in the patent's claim 1 and could have been presented along with the '723 claims at the time of filing.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(E) as being anticipated by Dahod et al ("Dahod"), U.S. Pat. #7,372,826.

See col. 12, lines19-26.

Any inquiry concerning this communication should be directed to CREIGHTON SMITH at telephone number (571)272-7546.

/CREIGHTON SMITH/

Primary Examiner, Art Unit 2656 03 JUN '13

Notice of References Cited	Application/Control No. 13/546,673	Applicant(s)/Patent Under Reexamination ROJAS, MICHAEL J.	
	Examiner CREIGHTON SMITH	Art Unit 2656	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-7,372,826	05-2008	Dahod et al.	370/328
*	B	US-2006/0268750	11-2006	Weiner, Moshe	370/260
*	C	US-2008/0298309	12-2008	DePietro et al.	370/328
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Search Notes	Application/Control No.	Applicant(s)/Patent Under Reexamination
	13546673	ROJAS, MICHAEL J.
	Examiner	Art Unit
	CREIGHTON SMITH	2656

SEARCHED			
Class	Subclass	Date	Examiner

SEARCH NOTES		
Search Notes	Date	Examiner
EAST	06.03.13	chs

INTERFERENCE SEARCH			
Class	Subclass	Date	Examiner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	**Michael J. Rojas**	**Examiner:**	**Unassigned**
Serial No:	**Unassigned**	**Art Unit:**	**Unassigned**
Filed:	**Herewith**	**Docket:**	**17188YX**
For:	**SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING**	**Dated:**	**July 10, 2012**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Sir:

In accordance with 37 C.F.R. §§ 1.97 and 1.98, it is requested that the following references, which are also listed on the attached Form PTO-1449, be made of record in the above-identified case.

1. U.S. 6,763,226 dated July 13, 2004 to McZeal, Jr.;
2. U.S. Patent Application Publication 2004/0252679 dated December 16, 2004 to Williams et al;
3. U.S. Patent Application Publication 2004/0122906 dated June 24, 2004 to Goodman et al.;

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this document is being electronically filed in the United States Patent and Trademark Office on the date shown below.

Dated: July 10, 2012

/Seth Weinfeld/
Seth Weinfeld

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /C.S./

4. U.S. Patent Application Publication 2005/0053230 dated March 10, 2005 to Gierachf, K.;

5. U.S. Patent Application Publication 2005/0105697 dated May 19, 2005 to Hollowell et al.;

6. U.S. Patent Application Publication 2003/0087632 dated May 8, 2003 to Sagi et al;

7. U.S. Patent Application Publication 2006/0268750 dated November 30, 2006 to Weiner, M.;

8. U.S. Patent Application Publication 2004/0030046 dated February 12, 2004 to Schultes et al.;

9. U.S. Patent Application Publication 2007/0112925 dated May 17, 2007 to Makik, D.;

10. U.S. Patent Application Publication 2007/0174403 dated July 26, 2007 to Barry, M.;

11. U.S. Patent Application Publication 2006/0167883 dated July 27, 2006 to Boukobza, E.;

12. U.S. Patent Application Publication 2004/0128356 dated July 1, 2004 to Bernstein et al.;

13. U.S. Patent Application Publication 2003/0126207 dated July 3, 2003 to Creamer et al.;

14. http://www.cisco.com/warp/public/cc/pd/nemnsw/callmn/prodlit/cm33_ds.htm; "Data Sheet Cisco CallManager Version 3.3", November 22, 2002;

15. http://www.cisco.com/en/US/products/hw/switches/ps1925/products data sheet 09186a008008a3c3d.html; "Data Sheet Cisco MGX 8000 Series" (Date unknown);

16. http://www.hsteliann.com/english/?zone=3100-V21P; "Teliphone 3100-V21P", 2003;

17. http://www.linuxdevices.com/articles/AT5199947519.html; "Device Profile: snom 100 VoIP phone", (May 15, 2002);

18. http://www.pingtel.com/pr xpressa.jsp; "No limits with the advanced industry standard SIP phone, December 8, 2003; and

19. AudioCoded Enabling Technology Products, TPM-1100 VoP Media Gateway Modules; 2003.

20. U.S. Patent Application Publication No. 2004/0014456 A1 published January 22, 2004 to Väänänen;

21. U.S. Patent Application Publication No. 2010/0070275 A1 published March 18, 2012 to Cast;

22. U.S. Patent Application Publication No. 2004/0179092 A1 published September 16, 2004 to LaPoint;

23. U.S. Patent Application Publication No. 2004/0085456 A1 published May 6, 2004 to Kwag et al.

24. U.S. Patent Application Publication No. 2009/0161664 A1 published June 25, 2009 to Michael J. Rojas;

25. U.S. Patent No. 7,535,890 issued May 19, 2009 to Michael J. Rojas;

26. U.S. Patent No. 8,199,747 issued June 12, 2012 to Michael J. Rojas;

27. U.S. Office Action dated October 18, 2011received in related case, namely, U.S. Serial No. 12/398,063 filed March 4, 2009;

28. U.S. Final Office Action dated January 25, 2012 received in related case, namely, U.S. Serial No. 12/398,063 filed March 4, 2009; and

29. Notice of Allowance dated March 30, 2012 received in related case, namely, U.S. Serial No. 12/398,063 filed March 4, 2009.

Pursuant to 37 C.F.R. §1.98(d), copies of the above listed references are not provided, as references 1-23 were previously submitted in Information Disclosure Statements filed in connection with parent case, U.S. Serial Number: 12/398,063 filed on March 4, 2009. References 24-29 are related to the present application.

Inasmuch as this Information Disclosure Statement is being submitted in accordance with the schedule set out in 37 C.F.R §1.97(b), no statement or fee is required.

Respectfully submitted,

/Seth Weinfeld/

Seth Weinfeld
Registration No. 50,929

Scully, Scott, Murphy & Presser, P.C.
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Garden City, New York 11530
(516) 742-4343
SMW:reg

Form PTO-1449 (REV. 7-80) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	Atty. Docket No. 17188Y	Application No. 13-546673
INFORMATION DISCLOSURE CITATION	Applicant Michael J. Rojas	
(Use several sheets if necessary)	Filing Date Herewith	Group Art Unit

U.S. PATENT DOCUMENTS

EXAMINER INITIAL*		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE (if appropriate)
		6,763,226	07-13-2004	McZeal, Jr.			
		7,535,890	05-19-2009	Michael J. Rojas			
		8,199,747	06-12-2012	Michael J. Rojas			

U.S. PATENT PUBLICATION DOCUMENTS

		2004/0252679	12-16-2004	Williams et al.			
		2004/0122906	06-24-2004	Goodman et al.			
		2005/0053230	03-10-2005	Gierachf, K.			
		2005/0105697	05-19-2005	Hollowell et al.			
		2003/0087632	05-08-2003	Sagi et al.			
		2006/0268750	11-30-2006	Weiner, M.			
		2004/0030046	02-12-2004	Schultes et al.			
		2007/0112925	05-17-2007	Malik, D.			
		2007/0174403	07-26-2007	Barry, M.			
		2006/0167883	07-27-2006	Boukobza, E.			
		2004/0128356	07-01-2004	Bernstein et al.			
		2003/0126207	07-03-2003	Creamer et al.			

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION YES	TRANSLATION NO

OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)

		http://www.cisco.com/warp/public/cc/pd/nemnsw/callmn/prodlit/ cm33_ds.htm; "Data Sheet Cisco CallManager Version 3.3", November 22, 2002;
		http://www.cisco.com/en/US/products/hw/switches/ps1925/products data sheet 09186a00800a3c3d.html; "Data Sheet Cisco MGX 8000 Series" (Date unknown);
		U.S. Office Action dated October 18, 2011received in related case, namely, U.S. Serial No. 12/398,063 filed March 4, 2009

EXAMINER	DATE CONSIDERED
/Creighton Smith/	06/02/2013

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /C.S./

Form PTO-1449 (REV. 7-80) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	Atty. Docket No. (Optional)	Application Number
INFORMATION DISCLOSURE CITATION *(Use several sheets if necessary)*	17188YX	13-546673
	Applicant(s) Michael Rojas	
	Filing Date	**Group Art Unit**

U.S. PATENT PUBLICATION DOCUMENTS

		2004/0014456 A1	2004-01-22	Väänänen			
		2010/0070275 A1	2010-03-18	Cast			
		2004/0179092 A1	2004-09-16	La Point			
		2004/0085456 A1	2004-05-06	Kwag et al.			
		2009/0161664 A1	2009-06-25	Michael J. Rojas			

FOREIGN PATENT DOCUMENTS

	REF	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO

OTHER DOCUMENTS *(Including Author, Title, Date, Pertinent Pages, Etc.)*

		http://www.hsteliann.com/english/?zone=3100-V21P; "Teliphone 3100-V21P", 2003;
		http://www.linuxdevices.com/articles/AT5199947519.html; "Device Profile: snom 100 VoIP phone", May 15, 2002;
		http://www.pingtel.com/pr xpressa.jsp; "No limits with the advanced industry standard SIP phone, December 8, 2003; and
		AudioCoded Enabling Technology Products, TPM-1100 VoP Media Gateway Modules; 2003.
		U.S. Final Office Action dated January 25, 2012 received in related case, namely, U.S. Serial No 12/398,063 filed March 4, 2009
		Notice of Allowance dated March 30, 2012 received in related case, namely, U.S. Serial No. 12/398,063 filed March 4, 2009

EXAMINER	/Creighton Smith/	DATE CONSIDERED	06/02/2013

*** EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.**

J:\Work\1732\17188Z\MISC\1449.doc

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BIB DATA SHEET

CONFIRMATION NO. 9648

SERIAL NUMBER	FILING or 371(c) DATE RULE	CLASS	GROUP ART UNIT	ATTORNEY DOCKET NO.
13/546,673	07/11/2012	370	2656	17188YX

APPLICANTS
Michael J. Rojas, North Canton, OH;

**** CONTINUING DATA ***************************
This application is a CON of 12/398,063 03/04/2009 PAT 8243723
which is a CON of 10/740,030 12/18/2003 PAT 7535890 *
(*)Data provided by applicant is not consistent with PTO records.

**** FOREIGN APPLICATIONS ***************************

**** IF REQUIRED, FOREIGN FILING LICENSE GRANTED **** ** SMALL ENTITY **
07/23/2012

Foreign Priority claimed ☐ Yes ☑ No 35 USC 119(a-d) conditions met ☐ Yes ☑ No Verified and Acknowledged /CREIGHTON H SMITH/ Examiner's Signature	☐ Met after Allowance Initials	STATE OR COUNTRY	SHEETS DRAWINGS	TOTAL CLAIMS	INDEPENDENT CLAIMS
		OH	9	1	1

ADDRESS

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530
UNITED STATES

TITLE

SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING

FILING FEE RECEIVED	FEES: Authority has been given in Paper No._____ to charge/credit DEPOSIT ACCOUNT No._____ for following:	☐ All Fees ☐ 1.16 Fees (Filing) ☐ 1.17 Fees (Processing Ext. of time) ☐ 1.18 Fees (Issue) ☐ Other _____ ☐ Credit
530		

BIB (Rev. 05/07).

Index of Claims	Application/Control No.	Applicant(s)/Patent Under Reexamination
	13546673	ROJAS, MICHAEL J.
	Examiner	Art Unit
	CREIGHTON SMITH	2656

✓	Rejected	-	Cancelled	N	Non-Elected	A	Appeal
=	Allowed	÷	Restricted	I	Interference	O	Objected

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☒ T.D. ☐ R.1.47

CLAIM		DATE								
Final	Original	06/03/2013								
	1	✓								

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APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
13/546,673	07/11/2012	Michael J. Rojas	17188YX

CONFIRMATION NO. 9648

23389
SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

PUBLICATION NOTICE

OC00000057384013

Title:SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING

Publication No.US-2012-0275452-A1
Publication Date:11/01/2012

NOTICE OF PUBLICATION OF APPLICATION

The above-identified application will be electronically published as a patent application publication pursuant to 37 CFR 1.211, et seq. The patent application publication number and publication date are set forth above.

The publication may be accessed through the USPTO's publically available Searchable Databases via the Internet at www.uspto.gov. The direct link to access the publication is currently http://www.uspto.gov/patft/.

The publication process established by the Office does not provide for mailing a copy of the publication to applicant. A copy of the publication may be obtained from the Office upon payment of the appropriate fee set forth in 37 CFR 1.19(a)(1). Orders for copies of patent application publications are handled by the USPTO's Office of Public Records. The Office of Public Records can be reached by telephone at (703) 308-9726 or (800) 972-6382, by facsimile at (703) 305-8759, by mail addressed to the United States Patent and Trademark Office, Office of Public Records, Alexandria, VA 22313-1450 or via the Internet.

In addition, information on the status of the application, including the mailing date of Office actions and the dates of receipt of correspondence filed in the Office, may also be accessed via the Internet through the Patent Electronic Business Center at www.uspto.gov using the public side of the Patent Application Information and Retrieval (PAIR) system. The direct link to access this status information is currently http://pair.uspto.gov/. Prior to publication, such status information is confidential and may only be obtained by applicant using the private side of PAIR.

Further assistance in electronically accessing the publication, or about PAIR, is available by calling the Patent Electronic Business Center at 1-866-217-9197.

Office of Data Managment, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

PATENT APPLICATION FEE DETERMINATION RECORD Substitute for Form PTO-875	Application or Docket Number 13/546,673

APPLICATION AS FILED - PART I

	(Column 1)	(Column 2)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
FOR	NUMBER FILED	NUMBER EXTRA	RATE($)	FEE($)		RATE($)	FEE($)
BASIC FEE (37 CFR 1.16(a), (b), or (c))	N/A	N/A	N/A	95		N/A	
SEARCH FEE (37 CFR 1.16(k), (i), or (m))	N/A	N/A	N/A	310		N/A	
EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))	N/A	N/A	N/A	125		N/A	
TOTAL CLAIMS (37 CFR 1.16(i))	1 minus 20 =	*	x 30 =	0.00	OR		
INDEPENDENT CLAIMS (37 CFR 1.16(h))	1 minus 3 =	*	x 125 =	0.00			
APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is $310 ($155 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).			0.00			
MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))				0.00			
* If the difference in column 1 is less than zero, enter "0" in column 2.			TOTAL	530		TOTAL	

APPLICATION AS AMENDED - PART II

		(Column 1)		(Column 2)	(Column 3)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE($)	ADDITIONAL FEE($)		RATE($)	ADDITIONAL FEE($)
AMENDMENT A	Total (37 CFR 1.16(i))	*	Minus	**	=	x =		OR	x =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=	x =		OR	x =	
	Application Size Fee (37 CFR 1.16(s))									
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							OR		
						TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	

		(Column 1)		(Column 2)	(Column 3)					
		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE($)	ADDITIONAL FEE($)		RATE($)	ADDITIONAL FEE($)
AMENDMENT B	Total (37 CFR 1.16(i))	*	Minus	**	=	x =		OR	x =	
	Independent (37 CFR 1.16(h))	*	Minus	***	=	x =		OR	x =	
	Application Size Fee (37 CFR 1.16(s))									
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							OR		
						TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	

* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20".
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3".
The "Highest Number Previously Paid For" (Total or Independent) is the highest found in the appropriate box in column 1.

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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
13/546,673	07/11/2012	2472	530	17188YX	1	1

CONFIRMATION NO. 9648

23389
SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

FILING RECEIPT

OC000000055542321

Date Mailed: 07/25/2012

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Applicant(s)

Michael J. Rojas, North Canton, OH;

Assignment For Published Patent Application

Ayalogic, Inc., Ravena, OH

Power of Attorney:

Leopold Presser--19827
William Roch--24972
John Sensny--28757
Paul Esatto--30749
Frank DiGiglio--31346
Mark Cohen--32211
Edward Grolz--33705
Steven Fischman--34594
Thomas Spinelli--39533
Peter Bernstein--43497

Domestic Priority data as claimed by applicant

This application is a CON of 12/398,063 03/04/2009 PAT 8243723
which is a CON of 10/740,030 12/18/2003 PAT 7535890 *
(*)Data provided by applicant is not consistent with PTO records.

Foreign Applications (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see http://www.uspto.gov for more information.)

If Required, Foreign Filing License Granted: 07/23/2012
The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 13/546,673**
Projected Publication Date: 11/01/2012
Non-Publication Request: No
Early Publication Request: No

** SMALL ENTITY **

Title

SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING

Preliminary Class

370

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	**Michael J. Rojas**	**Examiner:**	**Unassigned**
Serial No:	**Unassigned**	**Art Unit:**	**Unassigned**
Filed:	**Herewith**	**Docket:**	**17188YX**
For:	**SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING**	**Dated:**	**July 10, 2012**

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT

Sir:

In accordance with 37 C.F.R. §§ 1.97 and 1.98, it is requested that the following references, which are also listed on the attached Form PTO-1449, be made of record in the above-identified case.

1. U.S. 6,763,226 dated July 13, 2004 to McZeal, Jr.;
2. U.S. Patent Application Publication 2004/0252679 dated December 16, 2004 to Williams et al;
3. U.S. Patent Application Publication 2004/0122906 dated June 24, 2004 to Goodman et al.;

CERTIFICATE OF ELECTRONIC TRANSMISSION

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/Seth Weinfeld/
Seth Weinfeld

4. U.S. Patent Application Publication 2005/0053230 dated March 10, 2005 to Gierachf, K.;

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10. U.S. Patent Application Publication 2007/0174403 dated July 26, 2007 to Barry, M.;

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14. http://www.cisco.com/warp/public/cc/pd/nemnsw/callmn/prodlit/cm33_ds.htm; "Data Sheet Cisco CallManager Version 3.3", November 22, 2002;

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16. http://www.hsteliann.com/english/?zone=3100-V21P; "Teliphone 3100-V21P", 2003;

17. http://www.linuxdevices.com/articles/AT5199947519.html; "Device Profile: snom 100 VoIP phone", (May 15, 2002);

18. http://www.pingtel.com/pr xpressa.jsp; "No limits with the advanced industry standard SIP phone, December 8, 2003; and

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27. U.S. Office Action dated October 18, 2011received in related case, namely, U.S. Serial No. 12/398,063 filed March 4, 2009;

28. U.S. Final Office Action dated January 25, 2012 received in related case, namely, U.S. Serial No. 12/398,063 filed March 4, 2009; and

29. Notice of Allowance dated March 30, 2012 received in related case, namely, U.S. Serial No. 12/398,063 filed March 4, 2009.

Pursuant to 37 C.F.R. §1.98(d), copies of the above listed references are not provided, as references 1-23 were previously submitted in Information Disclosure Statements filed in connection with parent case, U.S. Serial Number: 12/398,063 filed on March 4, 2009. References 24-29 are related to the present application.

Inasmuch as this Information Disclosure Statement is being submitted in accordance with the schedule set out in 37 C.F.R §1.97(b), no statement or fee is required.

Respectfully submitted,

/Seth Weinfeld/

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Form PTO-1449 (REV. 7-80) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	Atty. Docket No. 17188Y	Application No.
INFORMATION DISCLOSURE CITATION	Applicant Michael J. Rojas	
(Use several sheets if necessary)	Filing Date Herewith	Group Art Unit

U.S. PATENT DOCUMENTS

EXAMINER INITIAL*		DOCUMENT NUMBER	DATE	NAME	CLASS	SUBCLASS	FILING DATE (if appropriate)
		6,763,226	07-13-2004	McZeal, Jr.			
		7,535,890	05-19-2009	Michael J. Rojas			
		8,199,747	06-12-2012	Michael J. Rojas			

U.S. PATENT PUBLICATION DOCUMENTS

		2004/0252679	12-16-2004	Williams et al.			
		2004/0122906	06-24-2004	Goodman et al.			
		2005/0053230	03-10-2005	Gierachf, K.			
		2005/0105697	05-19-2005	Hollowell et al.			
		2003/0087632	05-08-2003	Sagi et al.			
		2006/0268750	11-30-2006	Weiner, M.			
		2004/0030046	02-12-2004	Schultes et al.			
		2007/0112925	05-17-2007	Malik, D.			
		2007/0174403	07-26-2007	Barry, M.			
		2006/0167883	07-27-2006	Boukobza, E.			
		2004/0128356	07-01-2004	Bernstein et al.			
		2003/0126207	07-03-2003	Creamer et al.			

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO

OTHER PRIOR ART (Including Author, Title, Date, Pertinent Pages, Etc.)

		http://www.cisco.com/warp/public/cc/pd/nemnsw/callmn/prodlit/ cm33_ds.htm; "Data Sheet Cisco CallManager Version 3.3", November 22, 2002;
		http://www.cisco.com/en/US/products/hw/switches/ps1925/products data sheet 09186_a00800a3c3d.html; "Data Sheet Cisco MGX 8000 Series" (Date unknown);
		U.S. Office Action dated October 18, 2011received in related case, namely, U.S. Serial No. 12/398,063 filed March 4, 2009

EXAMINER	DATE CONSIDERED

Form PTO-1449 (REV. 7-80) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	Atty. Docket No. (Optional)	Application Number
INFORMATION DISCLOSURE CITATION *(Use several sheets if necessary)*	17188YX	
	Applicant(s) Michael Rojas	
	Filing Date	**Group Art Unit**

U.S. PATENT PUBLICATION DOCUMENTS

		2004/0014456 A1	2004-01-22	Väänänen			
		2010/0070275 A1	2010-03-18	Cast			
		2004/0179092 A1	2004-09-16	La Point			
		2004/0085456 A1	2004-05-06	Kwag et al.			
		2009/0161664 A1	2009-06-25	Michael J. Rojas			

FOREIGN PATENT DOCUMENTS

	REF	DOCUMENT NUMBER	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
							YES	NO

OTHER DOCUMENTS *(Including Author, Title, Date, Pertinent Pages, Etc.)*

		http://www.hsteliann.com/english/?zone=3100-V21P; "Teliphone 3100-V21P", 2003;
		http://www.linuxdevices.com/articles/AT5199947519.html; "Device Profile: snom 100 VoIP phone", May 15, 2002;
		http://www.pingtel.com/pr xpressa.jsp; "No limits with the advanced industry standard SIP phone, December 8, 2003; and
		AudioCoded Enabling Technology Products, TPM-1100 VoP Media Gateway Modules; 2003.
		U.S. Final Office Action dated January 25, 2012 received in related case, namely, U.S. Serial No 12/398,063 filed March 4, 2009
		Notice of Allowance dated March 30, 2012 received in related case, namely, U.S. Serial No. 12/398,063 filed March 4, 2009

EXAMINER	DATE CONSIDERED

*** EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.**

J:\Work\1732\17188Z\MISC\1449.doc

Electronic Patent Application Fee Transmittal

Application Number:	
Filing Date:	
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Filer:	Paul J. Esatto
Attorney Docket Number:	17188YX

Filed as Small Entity

Utility under 35 USC 111(a) Filing Fees

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Basic Filing:				
Utility filing Fee (Electronic filing)	4011	1	95	95
Utility Search Fee	2111	1	310	310
Utility Examination Fee	2311	1	125	125
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD($)
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				
Miscellaneous:				
			Total in USD ($)	**530**

Electronic Acknowledgement Receipt

EFS ID:	13225033
Application Number:	13546673
International Application Number:	
Confirmation Number:	9648
Title of Invention:	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING
First Named Inventor/Applicant Name:	Michael J. Rojas
Customer Number:	23389
Filer:	Paul J. Esatto
Filer Authorized By:	
Attorney Docket Number:	17188YX
Receipt Date:	11-JUL-2012
Filing Date:	
Time Stamp:	16:46:32
Application Type:	Utility under 35 USC 111(a)

Payment information:

Submitted with Payment	yes
Payment Type	Deposit Account
Payment was successfully received in RAM	$530
RAM confirmation Number	4103
Deposit Account	191013
Authorized User	

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:

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Charge any Additional Fees required under 37 C.F.R. Section 1.17 (Patent application and reexamination processing fees)

Charge any Additional Fees required under 37 C.F.R. Section 1.21 (Miscellaneous fees and charges)					
File Listing:					
Document Number	**Document Description**	**File Name**	**File Size(Bytes)/ Message Digest**	**Multi Part /.zip**	**Pages (if appl.)**
1	Application Data Sheet	17188YXADSpdf.pdf	965500 c4edd0efd3d9ce9dae3a921a237201dae0a5b622	no	5
Warnings:					
Information:					
2		17188X_ApplnAsFiled.pdf	6743692 14046620a81da052c791f46b69c1090f43555315	yes	50
	Multipart Description/PDF files in .zip description				
	Document Description		**Start**	**End**	
	Specification		1	48	
	Claims		49	49	
	Abstract		50	50	
Warnings:					
Information:					
3	Drawings-only black and white line drawings	17188X_formaldrawing.pdf	698217 96cfbc62f9522be906668423600f39729bd93452	no	9
Warnings:					
Information:					
4	Oath or Declaration filed	17188X_declaration.pdf	511844 74e40f6626f4fd937e27d719e8b46b9398dd4445	no	3
Warnings:					
Information:					
5	Information Disclosure Statement (IDS) Form (SB08)	17188X_IDSasfiled.pdf	490884 7572da5f2e817fdfe80a741713f82ba9aead33bd	no	6
Warnings:					
Information:					
This is not an USPTO supplied IDS fillable form					
6	Fee Worksheet (SB06)	fee-info.pdf	32964 ed79165a126bd657e549639b37fa548e2b876ae9	no	2
Warnings:					
Information:					

Total Files Size (in bytes):	9443101

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New Applications Under 35 U.S.C. 111
If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

National Stage of an International Application under 35 U.S.C. 371
If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

New International Application Filed with the USPTO as a Receiving Office
If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

PTO/SB/14 (07-07)
Approved for use through 06/30/2010. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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Application Data Sheet 37 CFR 1.76	Attorney Docket Number	17188YX
	Application Number	
Title of Invention	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING	

The application data sheet is part of the provisional or nonprovisional application for which it is being submitted. The following form contains the bibliographic data arranged in a format specified by the United States Patent and Trademark Office as outlined in 37 CFR 1.76.
This document may be completed electronically and submitted to the Office in electronic format using the Electronic Filing System (EFS) or the document may be printed and included in a paper filed application.

Secrecy Order 37 CFR 5.2

☐ Portions or all of the application associated with this Application Data Sheet may fall under a Secrecy Order pursuant to 37 CFR 5.2 (Paper filers only. Applications that fall under Secrecy Order may not be filed electronically.)

Applicant Information:

Applicant 1 Remove

Applicant Authority ◉ Inventor ○ Legal Representative under 35 U.S.C. 117 ○ Party of Interest under 35 U.S.C. 118

Prefix	Given Name	Middle Name	Family Name	Suffix
	Michael	J.	Rojas	

Residence Information (Select One) ◉ US Residency ○ Non US Residency ○ Active US Military Service

City	North Canton, Stark County	State/Province	OH	Country of Residence i	US

Citizenship under 37 CFR 1.41(b) i: US

Mailing Address of Applicant:

Address 1	2828 Barclay Circle		
Address 2			
City	North Canton, Stark County	State/Province	OH
Postal Code	44720	Country i	US

All Inventors Must Be Listed - Additional Inventor Information blocks may be generated within this form by selecting the **Add** button. Add

Correspondence Information:

Enter either Customer Number or complete the Correspondence Information section below.
For further information see 37 CFR 1.33(a).

☐ **An Address is being provided for the correspondence Information of this application.**

Customer Number	23389		
Email Address		Add Email	Remove Email

Application Information:

Title of the Invention	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING		
Attorney Docket Number	17188YX	Small Entity Status Claimed	☐
Application Type	Nonprovisional		
Subject Matter	Utility		
Suggested Class (if any)		Sub Class (if any)	
Suggested Technology Center (if any)			
Total Number of Drawing Sheets (if any)	9	Suggested Figure for Publication (if any)	

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	17188YX
	Application Number	
Title of Invention	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING	

Publication Information:

☐ Request Early Publication (Fee required at time of Request 37 CFR 1.219)

☐ **Request Not to Publish.** I hereby request that the attached application not be published under 35 U.S.C. 122(b) and certify that the invention disclosed in the attached application **has not and will not** be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing.

Representative Information:

Representative information should be provided for all practitioners having a power of attorney in the application. Providing this information in the Application Data Sheet does not constitute a power of attorney in the application (see 37 CFR 1.32). Enter either Customer Number or complete the Representative Name section below. If both sections are completed the Customer Number will be used for the Representative Information during processing.

Please Select One: ○ Customer Number ◉ US Patent Practitioner ○ Limited Recognition (37 CFR 11.9)

Prefix	**Given Name**	Middle Name	**Family Name**	Suffix	
	Paul	J.	Esatto, Jr.		Remove
Registration Number	30749				
Prefix	**Given Name**	Middle Name	**Family Name**	Suffix	
	Frank	S.	DiGiglio		Remove
Registration Number	31346				
Prefix	**Given Name**	Middle Name	**Family Name**	Suffix	
	Peter	I.	Bernstein		Remove
Registration Number	43497				
Prefix	**Given Name**	Middle Name	**Family Name**	Suffix	
	Mark	J.	Cohen		Remove
Registration Number	32211				

Additional Representative Information blocks may be generated within this form by selecting the **Add** button. Add

Domestic Benefit/National Stage Information:

This section allows for the applicant to either claim benefit under 35 U.S.C. 119(e), 120, 121, or 365(c) or indicate National Stage entry from a PCT application. Providing this information in the application data sheet constitutes the specific reference required by 35 U.S.C. 119(e) or 120, and 37 CFR 1.78(a)(2) or CFR 1.78(a)(4), and need not otherwise be made part of the specification.

Prior Application Status	Pending		Remove
Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
Unassigned	Continuation of	12398063	2009-03-04
Prior Application Status	Pending		Remove

PTO/SB/14 (07-07)
Approved for use through 06/30/2010. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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Application Data Sheet 37 CFR 1.76	Attorney Docket Number	17188YX
	Application Number	
Title of Invention	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING	

Application Number	Continuity Type	Prior Application Number	Filing Date (YYYY-MM-DD)
12398063	Continuation of	10740030	2003-12-18

Additional Domestic Benefit/National Stage Data may be generated within this form by selecting the **Add** button. Add

Foreign Priority Information:

This section allows for the applicant to claim benefit of foreign priority and to identify any prior foreign application for which priority is not claimed. Providing this information in the application data sheet constitutes the claim for priority as required by 35 U.S.C. 119(b) and 37 CFR 1.55(a).

Remove

Application Number	Country [i]	Parent Filing Date (YYYY-MM-DD)	Priority Claimed
			○ Yes ◉ No

Additional Foreign Priority Data may be generated within this form by selecting the **Add** button. Add

Assignee Information:

Providing this information in the application data sheet does not substitute for compliance with any requirement of part 3 of Title 37 of the CFR to have an assignment recorded in the Office.

Assignee 1 Remove

If the Assignee is an Organization check here. ☒

Organization Name	Ayalogic, Inc.		
Mailing Address Information:			
Address 1	P.O. Box 773		
Address 2			
City	Ravena	**State/Province**	OH
Country [i] US		Postal Code	44266
Phone Number		Fax Number	
Email Address			

Additional Assignee Data may be generated within this form by selecting the **Add** button. Add

Signature:

A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature.

Signature	/Paul J. Esatto, Jr. /			Date (YYYY-MM-DD)	2012-07-10
First Name	Paul J. Esatto, Jr.	Last Name		Registration Number	30749

Application Data Sheet 37 CFR 1.76	Attorney Docket Number	17188YX
	Application Number	
Title of Invention	SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING	

This collection of information is required by 37 CFR 1.76. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 23 minutes to complete, including gathering, preparing, and submitting the completed application data sheet form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

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7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING

CROSS REFERENCE TO RELATED APPLICATION

[0001] This application is a continuation of U.S. Application Serial Number 12/398,063 filed March 4, 2009, which is now U.S. Patent Publication Number 2009/0161664 A1, published June 25, 2009, which is a continuation of U.S. Application Serial Number 10/740,030 filed on December 18, 2003, now U.S. Patent Number 7,535,890, issued May 19, 2009, the entire content and disclosure of which is incorporated by reference.

BACKGROUND OF THE INVENTION

Technical Field of the Invention

The present invention generally relates to Internet telephony (IP telephony). More particularly, the present invention is directed to a system and method for enabling local and global instant VoIP messaging over an IP network, such as the Internet, with PSTN support.

Description of the Prior Art

Traditional telephony is based on a public switched telephone network (i.e., "PSTN"). In the PSTN, a telephone terminal is electrically connected to a conventional or legacy switch. The telephone terminal and the legacy switch communicate via a proprietary protocol, which may be different depending on the vendor of the legacy switch. Circuit switching provides a communication path (i.e., dedicated circuit) for a telephone call from the telephone terminal to another device over the PSTN, including another

telephone terminal. During the telephone call, voice communication takes place over that communication path.

An alternative to the PSTN is Voice over Internet Protocol (i.e., "VoIP"), also known as IP telephony or Internet telephony. In the IP telephony, a VoIP terminal device is connected to a packet-switched network (e.g., Internet) and voice communication from the VoIP terminal device is digitized, packetized and transmitted over the packet-switched network to a destination VoIP terminal device, which reconstructs the packets and audibly plays, stores or otherwise processes the transmission. The VoIP terminal device may be a VoIP telephone or a general-purpose personal computer (PC) enabled for IP telephony. More specifically, the PC is programmed with the software and equipped with audio input/output devices (e.g., a combination of microphone and speaker or a headset) to serve as a VoIP terminal device. The PC so enabled and equipped will herein be referred to as a VoIP terminal device or a VoIP softphone.

Figure 1 is an illustrative example of a prior art IP telephony system 100. The IP telephony system 100 comprises a packet-switched IP network 102, such as the Internet, which transmits VoIP traffic from and to a plurality of terminal devices 104, 106 and 110. Terminal device 104 is a VoIP softphone that is enabled for IP telephony over the network 102. Terminal device 106 is a VoIP telephone, which is connected to the network 102 via a softswitch 108. The VoIP softswitch 108 is disposed on the packet-switched network (e.g., Internet) 102 between an origination terminal device (such as VoIP softphone 104) and a destination terminal device (such as VoIP telephone 106), and routes packets

over the packet-switched IP network 102. The softswitch 108 may also manage and perform administrative functions for the terminal device or devices (e.g., VoIP telephone 106) to which it is connected. Whether the terminal device is a VoIP softphone 104 or a VoIP telephone 106, the terminal device is connected to the IP network 102 via a networking standard such as Ethernet, Bluetooth, IEEE 1394 (also known as "Firewire"), IEEE 802.11 (also known as "WiFi"), or networking over serial communication channels such as the Universal Serial Bus (i.e., "USB"). Data communication over the network then takes place using a connection protocol, e.g., transfer control protocol/Internet protocol (i.e., "TCP/IP").

Further regarding Fig. 1, terminal device 110 is a legacy telephone that is connected to a legacy switch 112 for (circuit-switched) voice communications over the PSTN 116 with other terminal devices. A media gateway 114 may be provided between the legacy switch 112 and the packet-switched network 102 to enable IP telephony between the legacy telephone 110 and a VoIP terminal device, such as a VoIP softphone 104 or VoIP telephone 106. More specifically, the media gateway 114 converts the audio signal carried over PSTN to packets carried over the packet-switched IP network 102. In addition, a media gateway 118 may be disposed over the PSTN 116 and connected to a softswitch 120 to convert the audio signal from the legacy telephone 110 to packets routed over the IP network 102 via the softswitch 120.

Voice messaging in both the VoIP and PSTN is known. More specifically, the foregoing systems may be provided with a facility to allow users to leave voice messages for recipients, which is a feature that is familiar to anyone who uses a telephone.

Conventionally, leaving a voice message involves dialing the recipient's telephone number (often without knowing whether the recipient will answer), waiting for the connection to be established, speaking to an operator or navigating through a menu of options, listening to a greeting message, and recording the message for later pickup by the recipient. In that message, the user must typically identify himself or herself in order for the recipient to return the call.

Instant text messaging is likewise known. More specifically, a user is provided with a client terminal, which is typically a general-purpose PC programmed with instant text messaging software and in data communication over an IP network with an instant text-messaging server. The instant text-messaging server presents the user, via the client terminal, with a list of persons who are currently "online" and ready to receive text messages on their own client terminals. The user then uses the client terminal to select one or more persons to whom the message will be sent and types in a text message. The text message is sent immediately via the text-messaging server to the selected one or more persons and is displayed on their respective client terminals.

However, notwithstanding the foregoing advances in the VoIP/PSTN voice communication and voice/text messaging, there is still a need in the art for providing a system and method for providing instant VoIP messaging over an IP network. More particularly, there is a need in the art for providing local and global instant voice messaging over VoIP with PSTN support.

SUMMARY OF THE INVENTION

The present invention is directed to a system and method for enabling local and global instant VoIP messaging over an IP network, such as the Internet.

According to an embodiment of the present invention, there is provided an instant voice messaging system for delivering instant messages over a packet-switched network, the system comprising: a client connected to the network, the client selecting one or more recipients, generating an instant voice message therefor, and transmitting the selected recipients and the instant voice message therefor over the network; and a server connected to the network, the server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message to the selected recipients over the network, the selected recipients being enabled to audibly play the instant voice message.

According to another embodiment of the present invention, there is provided an instant voice messaging system for delivering instant messages over a packet-switched network enabling public switched telephone network (PSTN) support, the system comprising: a PSTN telephone connected to the network for providing input audio; a client connected to the network, the client selecting one or more recipients, generating an instant voice message therefor using the input audio provided by the PSTN telephone, and transmitting the selected recipients and the instant voice message therefor over the network; a server connected to the network, the server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message to the selected recipients

over the network, the selected recipients being enabled to audibly play the instant voice message.

According to a further embodiment of the present invention, there is provided an instant voice messaging system for delivering instant messages over a packet-switched network, the system comprising: a voice-over-internet-protocol (VoIP) telephone connected to the network for providing input audio; a client connected to the network, the client selecting one or more recipients, generating an instant voice message therefor using the input audio provided by the VoIP telephone, and transmitting the selected recipients and the instant voice message therefor over the network; a server connected to the network, the server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message to the selected recipients over the network, the selected recipients being enabled to audibly play the instant voice message.

According to still another embodiment of the present invention, there is provided an instant voice messaging system for delivering instant messages over a plurality of packet-switched networks, the system comprising: a client connected to a local network, the client selecting one or more external recipients connected to an external network outside the local network, generating an instant voice message therefor, and transmitting the selected recipients and the instant voice message therefor over the local network and the external network; and a server connected to the external network, the server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message to the selected recipients over the external network, the selected recipients being

enabled to audibly play the instant voice message.

According to yet another embodiment of the present invention, there is provided an instant voice messaging system for delivering instant messages over a plurality of packet-switched networks enabling public switched telephone network (PSTN) support, the system comprising: a PSTN telephone connected to a local network for providing input audio; a client connected to the local network, the client selecting one or more external recipients connected to an external network outside the local network, generating an instant voice message therefor using the input audio provided by the PSTN telephone, and transmitting the selected recipients and the instant voice message therefor over the local network and the external network; a server connected to the external network, the server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message to the selected recipients over the external network, the selected recipients being enabled to audibly play the instant voice message.

According to yet a further embodiment of the present invention, there is provided an instant voice messaging system for delivering instant messages over a plurality of packet-switched networks, the system comprising: a voice-over-internet-protocol (VoIP) telephone connected to a local network for providing input audio; a client connected to the local network, the client selecting one or more external recipients connected to an external network outside the local network, generating an instant voice message therefor using the input audio provided by the VoIP telephone, and transmitting the selected recipients and the instant voice message therefor over the local network and the external network; an server

connected to the external network, the external server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message to the selected recipients over the external network, the selected recipients being enabled to audibly play the instant voice message.

According to still a further embodiment of the present invention, there is provided an instant voice messaging system for delivering instant messages over a plurality of packet-switched networks, the system comprising: a client connected to an external network, the client selecting one or more recipients connected to a local network, generating an instant voice message therefor, and transmitting the selected recipients and the instant voice message therefor over the external network; an external server system connected to the external network, the external server system receiving the selected recipients and the instant voice message, and routing the selected recipients and the instant voice message over the external network and the local network; a local server connected to the local network, the local server receiving the selected recipients and the instant voice message therefor, and delivering the instant voice message to the selected recipients over the local network, the selected recipients being enabled to audibly play the instant voice message.

According to an embodiment of the present invention, there is provided a method for instant voice messaging over a packet-switched network, the method comprising: selecting one or more recipients for instant voice messaging at a client; generating an instant voice message for the selected recipients at the client; transmitting the selected recipients and the instant voice message therefor over the network from the client to

a server; receiving the selected recipients and the instant voice message therefor at the server; delivering the instant voice message from the server to the selected recipients over the network; and audibly playing the instant voice message at the selected recipients.

According to another embodiment of the present invention, there is provided a method for instant voice messaging over a packet-switched network enabling public switched telephone network (PSTN) support, the method comprising: providing input audio via a PSTN telephone connected over the network; selecting one or more recipients for instant voice messaging at a client; generating an instant voice message using the input audio from the PSTN telephone for the selected recipients at the client; transmitting the selected recipients and the instant voice message therefor over the network from the client to a server; receiving the selected recipients and the instant voice message therefor at the server; delivering the instant voice message from the server to the selected recipients over the network; and audibly playing the instant voice message at the selected recipients.

According to a further embodiment of the present invention, there is provided a method for instant voice messaging over a packet-switched network, the method comprising: providing input audio via a voice-over-internet-protocol (VoIP) telephone connected over the network; selecting one or more recipients for instant voice messaging at a client; generating an instant voice message using the input audio from the VoIP telephone for the selected recipients at the client; transmitting the selected recipients and the instant voice message therefor over the network from the client to a server; receiving the selected recipients and the instant voice message therefor at the server; delivering the instant voice

message from the server to the selected recipients over the network; and audibly playing the instant voice message at the selected recipients.

According to still another embodiment of the present invention, there is provided a method for instant voice messaging over a plurality of packet-switched networks, the method comprising: selecting one or more external recipients for instant voice messaging at a client connected to a local network, the one or more external recipients connected to an external network outside the local network; generating an instant voice message for the selected external recipients at the client; transmitting the selected external recipients and the instant voice message therefor over the local network and the external network; receiving the selected external recipients and the instant voice message therefor at an external server connected to the external network; delivering the instant voice message to the selected external recipients over the external network; and audibly playing the instant voice message at the selected external recipients.

According to yet another embodiment of the present invention, there is provided a method for instant voice messaging system over a plurality of packet-switched networks enabling public switched telephone network (PSTN) support, the method comprising: providing input audio via a PSTN telephone connected to a local network; selecting one or more external recipients for instant voice messaging at a client, the one or more external recipients connected to an external network outside the local network; generating an instant voice message for the one or more external recipients using the input audio provided by the PSTN telephone; transmitting the selected recipients and the instant

voice message therefor over the local network and the external network; receiving the selected recipients and the instant voice message therefor at a server connected to the external network; delivering the instant voice message to the selected recipients from the server over the external network; and audibly playing the instant voice message at the selected recipients.

According to still a further embodiment of the present invention, there is provided a method for instant voice messaging system over a plurality of packet-switched networks, the method comprising: providing input audio via a voice-over-internet-protocol (VoIP) telephone connected to a local network; selecting one or more external recipients for instant voice messaging at a client, the one or more external recipients connected to an external network outside the local network; generating an instant voice message for the one or more external recipients using the input audio provided by the VoIP telephone; transmitting the selected recipients and the instant voice message therefor over the local network and the external network; receiving the selected recipients and the instant voice message therefor at a server connected to the external network; delivering the instant voice message to the selected recipients from the server over the external network; and audibly playing the instant voice message at the selected recipients.

According to yet a further embodiment of the present invention, there is provided a method for instant voice messaging over a plurality of a plurality of packet-switched networks, the method comprising: selecting one or more recipients connected to a local network at a client connected to an external network; generating an instant voice

message for the selected recipients at the client; transmitting the selected recipients and the instant voice message therefor over the external network from the client to an external server system; receiving the selected recipients and the instant voice message at the external server system; routing the selected recipients and the instant voice message over the external network and the local network; receiving the selected recipients and the instant voice message therefor at a local server connected to the local network; delivering the instant voice message to the selected recipients over the local network; audibly playing the instant voice message at the selected recipients.

BRIEF DESCRIPTION OF THE DRAWINGS

The objects, features and advantages of the present invention will become apparent to one skilled in the art, in view of the following detailed description taken in combination with the attached drawings, in which:

Figure 1 illustrates an example of a prior art IP telephony system;

Figure 2 illustrates an exemplary local IVM system for enabling instant voice messaging according to the present invention;

Figure 3 illustrates an exemplary IVM client of Figure 2 for enabling instant voice messaging according to the present invention;

Figure 4 illustrates an exemplary IVM server of Figure 2 for enabling instant voice messaging according to the present invention;

Figure 5 illustrates an exemplary global IVM system comprising a local IVM system and global IVM clients, according to the present invention;

Fig. 6 illustrates an exemplary global IVM server system depicted in Fig. 5,

according to the present invention;

Fig. 7 illustrates an exemplary transport server depicted in Fig. 6, according to the present invention;

Fig. 8 illustrates an exemplary directory server depicted in Fig. 6, according to the present invention; and

Fig. 9 illustrates an exemplary global IVM system comprising a plurality of local IVM systems and global IVM clients, according to the present invention.

DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT OF THE INVENTION

The present invention is directed to a system and method for enabling local and global instant VoIP messaging over an IP network with PSTN support.

Figure 2 is an exemplary illustration of a local instant voice messaging (IVM) system 200 according to the present invention. The instant voice messaging system 200 comprises a local IVM server 202 that provides the core functionality for enabling instant voice messaging with PSTN support according to the present invention. The architecture of the local IVM server 202 will be described in detail hereinbelow with reference to Fig. 4. According to the exemplary IVM system 200, the local IVM server 202 is enabled to provide instant voice messaging to one or more IVM clients 206 and 208, as well support instant voice messaging for PSTN legacy telephones 110. It is noted that although Fig. 2 depicts one of each IVM client 206, 208 and legacy telephone 110 for clarity and brevity, the local IVM server 202 is enabled to support a plurality of each of the foregoing IVM

clients 206, 208 and legacy telephone 110. The local packet-switched IP network 204 interconnects the IVM clients 206, 208 and the legacy telephone 110 to the local IVM server 202 as well as interconnecting the local IVM server 202 to the local IP network 204. The network 204 may be a local area network (LAN), a wide area network (WAN), or the like, which supports both wired and wireless devices. The exemplary IVM client 208 is a VoIP softphone, the architecture of which will be described in detail hereinbelow with reference to Fig. 3. A microphone 212 is connected to the IVM client 208 and enables the recording of an instant voice message according to the present invention into an audio file 210 for transmission to the local IVM server 202 over the network 204. An input device 218 (e.g., a keyboard) is connected to the IVM client 208 to select one or more recipients that are to receive the recorded instant voice message. Although not depicted in Fig. 2, the input device 218 may include a trackball, digitizing pad or mouse, or the like. A display device 216 is connected to the IVM client 208 to display instant voice messages recorded and/or received by a user of the IVM client 208. An audio device 214, such as external speaker, is connected to the IVM client 208 to play received instant voice messages. It is noted that the microphone 212, audio device 214, display device 216 and input device 218 may form integral parts of the IVM client 208.

Further with reference to Fig. 2, IVM client 206 is interconnected via the network 204 to the local IVM server 202. An exemplary IVM client 206 is a VoIP telephone, which comprises a screen display (not shown) capable of displaying instant voice messages recorded and/or received by a user of the IVM client 206 according to the present invention. The VoIP telephone 206 further comprises a handset and/or speakerphone for

recording instant voice messages and listening to instant voice messages received at the VoIP telephone 206 according to the present invention. The VoIP telephones which may be implemented to provide instant voice messaging functionality according to the present invention are commercially available from many vendors, including Alcatel™, Lucent™, NEC™ and Cisco™, to name just a few. In addition to the foregoing IVM clients 206, 208, the IVM system 200 supports a legacy telephone 110 for instant voice messaging according to the present invention. The legacy telephone 110 is connected to a legacy switch 112. The legacy switch 112 is further connected to a media gateway 114. Both the legacy switch 112 and the media gateway 114 interconnect the legacy telephone 110 via the network 204 to the local IVM server 202, thereby facilitating instant voice messaging according to the present invention. The media gateway 114 may be a gateway that supports trunk pack network control (i.e., "TPNCP") protocol, media gateway control protocol (i.e., "MGCP"), or a media gateway control H.428 protocol (i.e., "MEGACO"). As previously mentioned, the media gateway 114 converts the audio signal carried over PSTN to packets to be transmitted over a packet-switched IP network, such as the local network 204.

The implementation of the instant voice messaging for IVM client 208 will be described first and will be followed by the implementations for IVM client 206 and legacy telephone 110, with reference to the local IVM system 200 depicted in Fig. 2. These implementations implement a "record mode" of the instant voice messaging according to the present invention. There will further be described an "intercom mode" of the instant voice messaging according to the present invention. Therefore, in operation of the IVM client 208 according to Fig. 2, the IVM client (IVM softphone) 208 is connected over the network 204

to the IVM server 202, which as aforementioned enables instant voice messaging functionality over the network 204. The IVM client 208 displays a list of one or more IVM recipients on its display 216, provided and stored by the local IVM server 202, as will be particularly described hereinbelow with reference to Fig. 4. The user operates the IVM client 208 by using the input device 218 to indicate a selection of one or more IVM recipients from the list. The user selection is transmitted to the IVM server 202. The user selection also generates a start signal to the IVM client 208 that the user is ready to begin instant voice messaging according to the present invention. In response to the start signal, the IVM client (softphone) 208 listens to the input audio device 212 and records the user's speech into a digitized audio file 210 (i.e., instant voice message) stored on the IVM client 208. The audio file 210 at the IVM client 208 is finalized via a stop signal, which is generated by the user via the input device 218 or a preset time period without speech input via the input audio device 212 on the IVM client 208. 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. The user generates the send signal when the user operates the IVM client 208 via the input device 218, e.g., pressing a key on a keyboard or clicking a button on a mouse. The IVM client 208 transmits the digitized audio file 210 and the send signal to the local IVM server 202. In response to the send signal indicating that the instant voice message is ready to be sent, the IVM client 208 sends the recorded audio file 210 destined for the selected one or more recipients via local IVM server 202. After receiving the audio file 210, the IVM server 202 thereafter delivers the transmitted instant voice message to the selected one or more recipients via the local IP network 204. The one or more recipients are enabled to display an

indication that the instant voice message has been received and audibly play the instant voice message to an associated user. It should be understood that only the available IVM recipients, currently connected to the IVM server 202, will receive the instant voice message. It is noted that if a recipient IVM client is not currently connected to the local IVM server 202 (i.e., is unavailable), 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 202 (i.e., is available).

There are several embodiments for the operation of the IVM client (VoIP telephone) 206 within the IVM system 200, according to the present invention. In the first embodiment, the VoIP telephone 206 is a standalone IVM client 206 enabled for instant voice messaging according to the present invention. In the second embodiment, the VoIP telephone 206 operates synchronously either with the IVM client 208 or IVM server 202 to enable instant voice messaging according to the present invention. Thus, in operation according to the first embodiment in Fig. 2, the IVM client (VoIP telephone) 206 is connected over the network 204 to the IVM server 202, which as aforementioned enables instant voice messaging functionality over the local network 204. The IVM client 206 displays a list of one or more IVM recipients on its associated display provided and stored by the local IVM server 202, as will be particularly described hereinbelow with reference to Fig. 4. The user operates the IVM client 206 by using a keypad on the VoIP telephone 206 to indicate a selection of one or more IVM recipients from the list. The VoIP telephone 206 transmits the selection to the IVM server 202. The user selection also generates a start signal to the IVM client 206 indicating the user is ready to begin instant voice messaging

according to the present invention. The user speaks into the handset of the IVM client 206 or a speakerphone on the IVM client 206. Although not shown in Fig. 2, the VoIP telephone 206 may provide a dedicated storage device, which in response to the start signal records an audio file, similar to the audio file 210 in the IVM client 208. The audio file is finalized via a stop signal. The stop signal is generated when the user presses a button on the keypad, a preset time period without speech input to the VoIP telephone 206, or when the user returns the handset to the cradle of the VoIP telephone 206. Once the recording of the user's speech is complete, a send signal is generated indicating that the instant voice message is ready to be sent to the selected recipients. The user generates the send signal when the user presses a button on the keypad or returns the handset of the VoIP telephone 206 to it cradle (on-hook). In response to the send signal, the IVM client 206 sends the recorded audio to the local IVM server 202 via the network 204. The IVM server 202 thereafter delivers the instant voice message to the selected one or more recipients via the IP network 204. As before, the one or more recipients are enabled to display an indication that the instant voice message has been received and audibly play the instant voice message. As aforementioned, if a recipient IVM client is not currently connected to the local IVM server 202, the IVM server 202 temporarily saves the instant voice message and delivers it to the IVM client when the IVM client connects to the local IVM server 202.

In the second embodiment of the IVM client 206 according to Fig. 2, the VoIP telephone 206 operates synchronously either with the IVM client 208 or the IVM server 202 to enable instant voice messaging according to the present invention. Thus, in operation according to the second embodiment, the IVM client (VoIP telephone) 206 is still

connected over the network 204 to the IVM server 202, which as aforementioned enables instant voice messaging functionality over the local network 204. However, VoIP telephone 206 cooperates with the IVM client 208 or IVM server 202 to record and send an instant voice message. More specifically, the VoIP telephone 206 is only used as a recording/listening device for recording or listing to instant voice messages, while the IVM client 208 is used for displaying and selecting instant voice message recipients as described hereinabove. In operation, the IVM client 208 displays a list of IVM recipients on the display device 216 provided and stored by the local IVM server 202. The user operates the IVM client 208 by using the input device 218 on the IVM client 208 to indicate a selection of one or more IVM recipients from the list. The user selection is transmitted to the IVM server 202. The user selection generates a start signal to the IVM server 202 indicating that the user is ready to begin instant voice messaging according to the present invention. In response to receiving the start signal, the IVM server 202 transmits a ring signal to the VoIP telephone 206, thereby indicating to the user the IVM system 200 is ready to record an instant voice message. The IVM server 202 also signals the IVM client 208 to generate audio file 210 to record the instant voice message. As the user picks up the handset of the VoIP telephone 206 (off-hook), a connection is established via the network 204 between the local IVM server 202 and the VoIP telephone 206. Thereafter, the IVM server 202 forwards the user's speech transmitted from VoIP telephone 206 to the IVM client 208 for storage into digitized audio file 210 on the IVM client 208. The audio file 210 is finalized by returning the handset its cradle (on-hook) or by pressing a designated button on the keypad VoIP telephone 206, which transmits the stop signal to the IVM server 202 and further from the IVM server 202 to the IVM client 208. Returning the handset to its cradle preferably

generates a send signal to the IVM server 202, which transmits the signal to the IVM client 208. The IVM client thereafter transmits the recorded audio file 210 (instant voice message) to IVM server 202 for delivery to the selected one or more IVM recipients. Alternatively, the user may press a key on the keyboard 218 to initiate the send signal. In response to the send signal, the IVM client 206 sends the recorded audio to the local IVM server 202 via the network 204. The IVM server 202 thereafter delivers the instant voice message to the selected one or more recipients via the IP network 204. The one or more recipients are enabled to display an indication that the instant voice message has been received and audibly play the instant voice message. If a recipient IVM client is not currently connected to the local IVM server 202, the IVM server 202 temporarily saves the instant voice message and delivers it to the IVM client when the IVM client connects to the local IVM server 202.

In operation of the legacy telephone 110 according to Fig. 2, the legacy telephone 110 is connected to the local IVM server 202 via media gateway 114 and legacy switch 112. The legacy telephone 110 cooperates with the IVM client 208 to record and send an instant voice message. More specifically, the legacy telephone 110 is used as a recording/listening device for recording or listing to instant voice messages, while the IVM client 208 is used for displaying and selecting instant voice message recipients as described hereinabove. Thus, in operation the IVM client 208 displays a list of IVM recipients on the display device 216 provided and stored by the local IVM server 202. The user operates the IVM client 208 by using the input device 218 on the IVM client 208 to indicate a selection of one or more IVM recipients from the list. The user selection is transmitted to the IVM

server 202. The user selection generates a start signal to the IVM server 202 indicating that the user is ready to begin instant voice messaging according to the present invention. In response to receiving the start signal, the IVM server 202 transmits an emulation code to the legacy telephone 110 to ring, thereby indicating to the user the IVM system 200 is ready to record an instant voice message. As the user picks up the handset of the legacy telephone 110 (off-hook), a connection is established via the network 204 between the legacy telephone 110 and the IVM server 202. Thereafter, the IVM server forwards the user's speech transmitted from the legacy telephone 110 to the IVM client 208 for storage into the digitized audio file 210 (i.e., instant voice message). The audio file on the IVM client 208 is finalized by returning the handset of the legacy telephone 110 to its cradle (on-hook) or by pressing a designated button on the keypad of the legacy telephone 110, which transmits a stop signal to the IVM server 202 and further to the IVM client 208. Returning the handset to its cradle also generates a send signal to the IVM server to transmit the recorded audio file (instant voice message) to the selected one or more IVM recipients. The IVM server 202 thereafter delivers the instant voice message to the selected one or more recipients via the IP network 204. The one or more recipients are enabled to display an indication that the received instant voice message has been received and audibly play the instant voice message. If a recipient IVM client is not currently connected to the local IVM server 202, the IVM server 202 temporarily saves the instant voice message and delivers it to the IVM client when the IVM client connects to the local IVM server 202.

Regarding the operational embodiments described with reference to Fig. 2 for recoding and transmitting an instant voice message according to the present invention, the

digitized audio file is preferably compressed by applying a compression algorithm before sending the audio file to the one or more selected recipients. The audio file is preferably compressed within the IVM clients 206, 208 before forwarding the audio file to the IVM server 202 for subsequent delivery to the one or more selected recipients. Alternatively, the compression may be implemented within the IVM server 202 before the audio file is transmitted to the one or more selected recipients. A Lempel-Ziv compression algorithm is preferably used to compress the audio file according to the present invention. It is noted that many suitable compression algorithms are known to persons of skill in the art, including Huffman encoding, audio compression standards promulgated by the Moving Pictures Experts Group ("MPEG"), G.722 wideband speech encoding standard, fractal compression, and wavelet compression. Any of the foregoing compression algorithms may be implemented within the scope of the present invention.

Further regarding the operational embodiments described with reference to Fig. 2 for recoding and transmitting an instant voice message according to the present invention, the digitized audio file (which may or may not be compressed as described above) is further preferably encrypted via an encryption algorithm before transmitting the audio file to the one or more selected recipients. The encryption is preferably implemented within the IVM clients 206, 208 before forwarding the audio file to the IVM server 202 for subsequent delivery to the one or more selected recipients. Alternatively, the encryption may be implemented within the IVM server 202 before the audio file is transmitted to the one or more selected recipients. An AES (Rijndael) encryption algorithm is preferably used to encrypt the audio file according to the present invention. It is noted that many suitable

encryption algorithms are known to persons skilled in the art, including DES, Triple DES, Blowfish, Twofish, Serpent, and the like. Any of the foregoing encryption algorithms may be implemented within the scope of the present invention.

Lastly with reference to Fig. 2, in addition to the "record mode" of instant voice messaging, the instant voice messaging system 200 also supports an "intercom mode" of voice messaging. The "intercom mode" represents real-time instant voice messaging. In the "intercom mode," instead of creating an audio file 210, one or more buffers (not shown) of a predetermined size are generated in the IVM client 206, 208 or local IVM server 202. The one or more buffers are used to automatically write successive portions of the instant voice message. Once a first buffer is full, i.e., input audio of the predetermined size is written to the buffer, the content of the first buffer is automatically transmitted to the IVM server 202 for transmission to the one or more IVM recipients. A second buffer is meanwhile written with the next successive portion of input audio. Once, the second buffer is full, i.e., input audio of the predetermined size is written to the buffer, the content of the second buffer is transmitted to the IVM server 202 for transmission to the one or more IVM recipients. If the entire instant voice message or a successive portion thereof (such as a last successive portion in the instant voice message) written to either buffer is smaller the predetermined size, then the buffered content of less than the predetermined size is automatically transmitted to the IVM server 202. The foregoing buffering using the first and second buffers is repeated until the entire instant voice message has been transmitted to the IVM server 202 for transmission to the one or more IVM recipients. It is noted that the invention is not limited to a particular number of buffers. The foregoing buffering and

transmission allows a "real-time" instant voice message to be transmitted to the one or more IVM recipients. The "intercom mode" may be designated as a default mode when an IVM recipient is on-line, while the "record mode" may be designated as a default if the IVM recipient is unavailable, i.e., not on-line. The user may easily change the "intercom mode" to the "record mode" on the respective IVM client 206, 208. Finally, the audio contents of the buffers may be signal processed (for clarity), encrypted and compressed before transmission, as will be described in more detail hereinbelow with reference to Fig. 3.

Fig 3. an exemplary illustration of the architecture in the IVM client 208 for enabling instant voice messaging according to the present invention. More specifically, the IVM client 208 comprises a client platform 302 for generating an instant voice message and a messaging system 320 for messaging between the IVM client 208 and the IVM server 202 for enabling instant voice messaging according to the present invention. The IVM client 208 is a general-purpose programmable computer equipped with a network interface (not shown), such as an Ethernet card, to provide connectivity to the network 204. It is noted that any suitable networking protocol, not only Ethernet, could be used to connect the IVM client to a network 204 and thus is considered within the scope of the present invention. The client platform 302 comprises a client engine 304, which controls other components, namely the document handler 306, file manager 308, audio file creation 312, signal processing 314, encryption/decryption 316, and compression/decompression 318. The messaging system 320 and the client engine 304 communicate via standard inter-process communication. The messaging system 320 and client engine 304 also communicate with the IVM server 202 over the network interface via the network 204. The document handler 306 oversees the

retrieving, sending, receiving and storing of one or more documents (or files) attached to instant voice messages from/to the one or more selected IVM recipients that may be communicating with the IVM client 208. More specifically, when an instant voice message is to be transmitted to the one or more IVM recipients, one or more documents may be attached to the instant voice message to be, stored or displayed by the one or more selected IVM recipients. The file manager accesses a message database 310, in which both the received and recorded instant voice messages are represented as database records, each record comprising a message identifier and the instant voice message. The file manager 308 services requests from the user to record, delete or retrieve messages to/from the message database 310. Audio file creation 312 creates an instant voice message as audio file 210, and is responsible for receiving input speech for the instant voice message from audio input device 212 or via network 204 and storing the input speech into audio file 210. Signal processing 314 performs noise removal and signal optimization in the audio file 210. Encryption/decryption 316 provides for respectively encrypting/decrypting of outgoing/incoming audio files (i.e., instant voice messages), and compression/decompression 318 respectively compresses/decompresses the outgoing/incoming audio files.

Further with reference to Fig. 3, the reception of an instant voice message is described as follows. It is assumed that the local IVM server 202 has determined that the IVM client 208 is available to receive an instant voice message by checking the IVM client's 208 current status, i.e., whether the IVM client 208 is "on-line." The local IVM server 202 maintains the current status of the IVM clients connected to the local IVM server

202, i.e., IVM clients 206, 208. It is further assumed that an IVM client has transmitted an instant voice message to the IVM client 208. The local IVM server 202 receives the instant voice message over the local IP network 204 and forwards the instant voice message to the IVM client 208. Upon receipt at the IVM client 208, the instant voice message is decrypted at 316, decompressed at 318, and stored in the message database 310 using the file manager 308. Any files attached to the instant voice message are also stored in the message database 310 using the file manager 308. A visual and/or sound effect is initiated to notify a user of the IVM client 208 that a new instant voice message has been received at the IVM client 208. At this point in time, the instant voice message and any file attachments are available to the user. The user can select the instant voice message from a listing of available instant voice messages displayed on the IVM client 208 and play the newly received instant voice message. The user may also open any file attachments and move or save the files to a separate location on the client using a drag-and-drop process.

Still further with reference to Fig. 3, the generation and transmission of an instant voice message is described as follows. The user selects the available one or more IVM recipients and initiates the creation of an instant voice message as described above with reference to Fig. 2. The client engine 304 detects the start signal and invokes audio file creation 312 of the audio file 210. The audio file 210 is initialized and captures the audio voice message input by the user. Once the client engine 304 detects a stop signal, the instant voice message is finalized in the audio file 210 via audio file creation 312. The audio file 210 is adjusted for gain, and noise is removed via signal processing 314. The audio file 210 is further compressed at 318 and encrypted at 316. The completion of these processes

causes the client engine 304 to inform the user via display 216 that the instant voice message is available to be sent. After the client engine 304 detects the send signal from the user, the instant voice message (audio file 210) is transferred to the local IVM server 202. Before the transmission of the instant voice message (i.e., before the send signal), the user has the option to review the instant voice message, re-record the instant voice message, delete the instant voice, as well as attach one or more files (i.e., documents). The attachment of one or more files is enabled conventionally via a methodology such as "drag-and-drop" and the like, which invokes the document handler 306 to make the appropriate linkages to the one or more files and flags the messaging system 320 that the instant voice message also has the attached one or more files.

Fig 4. an exemplary illustration of the local IVM server 202 for enabling instant voice messaging according to the present invention. The IVM server 202 is a general-purpose programmable computer equipped with a network interface, such as an Ethernet card, to provide connectivity to a network 204. It is noted that any suitable networking protocol may be implemented to connect the IVM server 202 to a network 204. The IVM server 202 comprises a server communication platform 402, a messaging system 436 and a database 414, thereby enabling instant voice messaging according to the present invention. The server communication platform 402 comprises a server engine 404, client manager 406, station manager 408, gateway manager 410, database manager 412 that accesses database 414, supplemental servers 416 (including particular server subsystems 418-424), as well as a control layer 426 (including non-proprietary server subsystems 428, 430 and proprietary server subsystems 432, 434). The messaging system 436 and the server

engine 304 communicate via standard inter-process communication. The messaging system 436 and the server engine are also able to communicate with the IVM clients 206, 208 over the network interface via the network 204. The database 414 stores users (e.g., IVM clients as well as legacy telephone clients) that are known to the IVM server 202 via the database manager 412. The users are represented in the database as records, each record comprising a user name, a password, and a contact list (a list of other users with whom the user wishes to exchange instant voice messages), and other data relating to the user. The database manager 412 services requests to add, update, delete, or retrieve database records to/from the database 414. The password may be stored in the database 414 as plaintext, in encrypted form, or as a hash (e.g., MD5 hash). The messaging system 436 communicates to the server engine 404 via message objects.

A message object comprises an action field, an ID field, a source field, a destination field, and an object field. The content of the action field is selected from a list of permitted actions, which among other actions includes: connect, disconnect, subscribe, unsubscribe, and post message. In addition, the actions include: determining if an IVM client is awake (i.e., pinging), disconnecting from the IVM client, processing an IVM client message, and notifying IVM clients if the IVM server 202 goes down. The client messages include sending an instant voice message portions, checkin message, send message, set status message, send a phone command message, and send control parameters message. The content of the ID field represents a unique identifier for the message object. The content of the source field is a globally unique identifier ("GUID") that uniquely identifies the sender of the message. This unique identifier can be generated by any known way, including the

Globally Unique ID function call available in the Microsoft Windows and Microsoft .NET environments. In some circumstances, the source field is set to a special value to indicate that the sender of the message object is entitled to special privileges. The senders with special privileges are in fact IVM servers. This allows the IVM servers to broadcast messages to one another, subscribe to special events, and directly send messages to specific IVM servers. These privileges can depend upon whether the IVM servers are local servers or global servers. As an example, there can exist more than one local IVM server, each of these local IVM servers automatically has privileges to communicate to other local IVM server. On a global server system, a directory server can communicate with one or more transport servers. The content of the destination field is a GUID of an intended IVM recipient of the instant voice message. The content of the object field is a block of data being carried by the message object, which may be, for example, a digitized instant voice message. Depending on the circumstances in which the message object is sent, some of the message object fields may be left blank or ignored. For example, the message object may merely require an action to be performed based upon the GUID supplied. In this case, the action does not necessarily require any data to be sent or received and some of the message object's fields may be left blank or ignored.

Connection objects maintain the logical connections between the IVM server 202 and IVM clients 206, 208 connected to the IVM server 202. More specifically, a connection object comprises data representing the state of the connection and code (one or more methods) for establishing and maintaining the logical connections between the IVM server 202 and the IVM clients 206, 208 within the IVM system 200 of Fig. 2. The

connection object can contain both data and/or commands, including information that describes the socket, the size of the data to be transferred, and the priority of the transfer (e.g., high, normal, low, unknown). On start up the local IVM server 202 generates and maintains a list for each IVM client 206, 208. The local IVM server 202 then waits to receive connection objects from the IVM clients 206, 208 that are stored in the respective lists, decodes the received connection objects to obtain specific requests, and then services the specific requests from the IVM clients 206, 208.

Further with reference to Fig. 4, the server engine 404 controls all other subsystems in the server communication platform 402, and it is responsible for startup and shutdown of the IVM server 202 and the IVM system 200. The client manager 406 controls the IVM clients 206, 208, providing contact presence (connection) information and message scheduling and delivery. The station manager 408 controls the individual legacy telephone 110 and coordinates its activity to work synchronously with the IVM client 208 and server 202. The gateway manager 410 enables the IVM server 202 to communicate with the legacy telephones, such as legacy telephone 110. The control layer 426 comprises a plurality of server subsystems 428-434, each of which provides translation services to different proprietary and non-proprietary gateways 114, such as TPNCP, MGCP, and MEGACO gateways. The proprietary server subsystems 428, 430 and non-proprietary server subsystems 432, 434 are connected to respective gateways 114 via the local IP network 204. The supplemental server subsystems 416 provide a number of required services such as display manager subsystem 418, dynamic host configuration protocol (i.e., "DHCP") subsystem 420, trivial file transfer protocol (i.e., "TFTP") server subsystem 422,

and hypertext transfer protocol (i.e., "HTTP"). Each of the supplemental servers 418-424 in the subsystem 416 is used during the initial set-up of the IVM system 200. The boot-up process and allocation of IP addresses to IVM clients 206, 208 are performed through an LCD panel (not shown) associated with the local IVM server 202. The LCD manager 418 supports this boot-up process. The DHCP server 420 is used to allocate IP addresses as required and allows the advanced configuration of network settings in the instant voice messaging system. The TFTP server 422 provides a TCP/IP file transfer capability. Lastly, the HTTP server 424 provides services for a web server.

Figure 5 is an exemplary illustration of a global instant voice messaging (IVM) system 500, according to the present invention. In the global IVM system 500, the local IVM system 200 is depicted as a local IVM system 510, which is connected to a packet-switched network 102 (i.e., Internet). The global IVM system 500 comprises the local IVM system 510, global IVM server system 502, and global IVM clients 506 and 508 that are optionally connected via local IP network 504. The global IVM server system 502 is connected to the IP network (i.e., Internet) 102 for enabling the local IVM clients 206, 208 and legacy telephone 110 in the local IVM system 510 to generate and send instant voice messages to the global IVM clients 506, 508, as well as the local IVM clients 206, 208 to receive instant voice messages from the global IVM clients 506, 508. The implementation of the global instant voice messaging for the IVM client 208 will be described first and will be followed by the implementations for IVM client 206 and legacy telephone 110, with reference to the global IVM system 500 depicted in Fig. 5. Thereafter, instant voice messaging for global clients 506 and 508 will be described according to the

present invention. These implementations implement a "record mode" of the instant voice messaging according to the present invention. Thereafter, there will lastly be described an "intercom mode" of the instant voice messaging according to the present invention.

Therefore, in operation of the IVM client 208 according to Fig. 5, the IVM client 208 is connected via the networks 204, 102 to the global IVM server system 502, which enables the global instant voice messaging functionality outside the local IVM system 510 over the network (i.e., Internet) 102. More specifically, the IVM client 208 requests from the global IVM server system 502 a global contact list (not shown) of global one or more IVM recipients with which the IVM client 208 may exchange instant voice messages. For the purposes of illustration, it is assumed that global IVM clients 506, 508 are in the contact list. The global IVM server system 502 stores and maintains this contact list. Thus, the global IVM server system 502 responds by transmitting the contact list to the IVM client 208. The IVM client 208 displays the contact list on its display 216. Alternatively, the global contact list may be replicated to the local IVM server 202 within the local IVM system 510, in which case the local IVM client 208 obtains the global contact list from the local IVM server 202. The user operates the IVM client 208 by using the input device 218 to indicate a selection of one or more IVM recipients from the global contact list. Here, for the purposes of illustration it is again assumed that IVM client 208 selected global IVM clients 506, 508. The user selection is transmitted to the IVM server 202. The user selection also generates a start signal to the IVM client 208 that the user is ready to begin instant voice messaging. In response to the start signal, the IVM client 208 listens to the input audio device 212 and records the user's speech into a digitized audio file 210 (i.e.,

instant voice message) stored on the IVM client 208. The audio file 210 is finalized via a stop signal, which is generated by the user via the input device 218 or a preset time period without speech input via the input audio device 212. Once the recording is finalized, the 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 one or more IVM recipients. The user generates the send signal when the user operates the IVM client 208 via the input device 218. The IVM client 208 transmits the digitized audio file 210 and the send signal to the global IVM server system 502 via the local IP network 204 and the global IP network 102. After receiving the audio file 210, the global IVM server system 502 delivers the transmitted instant voice message to the selected one or more recipients (e.g., IVM clients 506 and 508) via the IP network 102. The one or more recipients are enabled to display an indication that the instant voice message has been received and audibly play the instant voice message to an associated user. It is noted that if a recipient IVM client 506, 508 is not currently connected to the global IVM server system 502, the global IVM server system 502 temporarily saves the instant voice message and delivers it to the global IVM client 506, 508 when the IVM client connects to the global IVM server system 502.

There are several embodiments for the operation of the IVM client (VoIP telephone) 206 within the global IVM system 500 of Fig. 5, according to the present invention. In the first embodiment, the VoIP telephone 206 is a standalone IVM client 206 enabled for instant voice messaging according to the present invention. In the second embodiment, the VoIP telephone 206 operates synchronously with the IVM client 208 to enable instant voice messaging according to the present invention. Thus, in operation

according to the first embodiment in Fig. 5, the IVM client 206 is connected via the networks 204, 102 to the global IVM server system 502, which enables instant voice messaging functionality over the IP network (Internet) 102. As mentioned previously, the IVM client 206 is also connected to the local IVM server 202. The IVM client 208 requests from the global IVM server system 502 a global contact list (not shown) of the global one or more IVM recipients with which the IVM client 206 may exchange instant voice messages. For the purposes of illustration, it is assumed that the global IVM clients 506, 508 are in the contact list. The global IVM server system 502 stores and maintains this contact list. Thus, the global IVM server system 502 responds by transmitting the global contact list to the IVM client 206. Alternatively, the global contact list may be replicated to the local IVM server 202 within the local IVM system 510, in which case the local IVM client 206 obtains the global contact list from the local IVM server 202. The IVM client 206 displays a list of the one or more IVM recipients on its associated display. The user operates the IVM client 206 by using a keypad on the VoIP telephone 206 to indicate a selection of one or more IVM recipients from the list. The VoIP telephone 206 transmits the selection to the global IVM server system 502. The user selection also generates a start signal to the IVM client 206 indicating the user is ready to begin instant voice messaging according to the present invention. The user speaks into the handset of the IVM client 206 or a speakerphone on the IVM client 206. Although not shown in Fig. 5, the VoIP telephone 206 may provide a dedicated storage device, which in response to the start signal records an audio file, similar to the audio file 210 in the IVM client 208. The audio file is finalized via a stop signal. The stop signal is generated when the user presses a button on the keypad, a preset time period without speech input to the VoIP telephone 206, or when the user returns the handset to the

cradle of the VoIP telephone 206. Once the recording of the user's speech is complete, a send signal is generated indicating that the instant voice message is ready to be sent to the selected recipients. The user generates the send signal when the user presses a button on the keypad or returns the handset of the VoIP telephone 206 to it cradle. In response to the send signal, the IVM client 206 sends the recorded audio file (instant voice message) to the global IVM server system 502 via the networks 204, 102 for delivery to the selected one or more IVM recipients. The global IVM server 502 thereafter delivers the instant voice message to the selected one or more recipients (e.g., IVM clients 506 and 508) via the IP network 102. As before, the one or more recipients are enabled to display an indication that the instant voice message has been received and audibly play the instant voice message. If a recipient IVM client is not currently connected to the global IVM server system 502, the global IVM server system 502 temporarily saves the instant voice message and delivers it to the IVM client when the IVM client connects to the global IVM server system 502.

In the second embodiment of the IVM client 206 according to Fig. 5, the VoIP telephone 206 operates synchronously with the IVM client 208 to enable global instant voice messaging according to the present invention. Thus, in operation according to the second embodiment in Fig. 5, the VoIP telephone 206 is connected over the network 204 to the IVM client 208 and the IVM client 208 is connected via the networks 204, 102 to the global IVM server system 502, which enables instant voice messaging functionality over the IP network (Internet) 102. The VoIP telephone 206 cooperates with the IVM client 208 to record and send a global instant voice message outside the local IVM system 510. The IVM client 208 displays a global contact list of IVM recipients (not shown) on the display device

216 provided by the global IVM server system 502, as described hereinabove. Alternatively, the global contact list may be replicated to the local IVM server 202 within the local IVM system 510, in which case the IVM client 208 obtains the global contact list from the local IVM server 202. The user operates the IVM client 208 by using the input device 218 to indicate a selection of one or more IVM recipients from the contact list. The user selection generates a start signal in the IVM client 208 indicating that the user is ready to begin instant voice messaging according to the present invention. In response to the start signal, the IVM client 208 generates audio file 210 to record an instant voice message and transmits a ring signal to the VoIP telephone 206. As the user picks up the handset of the VoIP telephone 206 (off-hook), a connection is established via the network 204 between the local IVM client 208 and the VoIP telephone 206. Thereafter, the VoIP telephone 206 forwards the user's speech to the IVM client 208 for storage into the audio file 210. The audio file 210 is finalized by returning the handset its cradle (on-hook) or by pressing a designated button on the keypad VoIP telephone 206, which transmits the stop signal to the IVM client 208. Returning the handset to its cradle preferably generates a send signal to the IVM client 208. The IVM client thereafter transmits the recorded audio file 210 (instant voice message) to the global IVM server system 502 via networks 204, 102 for delivery to the selected one or more IVM recipients. Alternatively, the user may press a key on the keyboard 218 to initiate the send signal. In response to the send signal, the IVM client 208 sends the recorded audio file to the global IVM server system 502 for delivery to the selected one or more IVM recipients. The global IVM server system 502 thereafter delivers the instant voice message to the selected one or more recipients (e.g., IVM clients 506 and 508) via the IP network 102. As before, the one or more IVM recipients are enabled to

display an indication that the instant voice message has been received and audibly play the instant voice message. If a recipient IVM client is not currently connected to the global IVM server system 502, the global IVM server system 502 temporarily saves the instant voice message and delivers it to the IVM client when the IVM client connects to the global IVM server system 502.

In operation of the legacy telephone 110 according to Fig. 5, the legacy telephone 110 is connected to the local IVM client 208 via media gateway 114, legacy switch 112 and network 204. The legacy telephone 110 cooperates with the IVM client 208 to record and send an instant voice message outside the local IVM system 510. More specifically, the legacy telephone 110 is used as a recording/listening device for recording or listing to instant voice messages, while the IVM client 208 is used for displaying and selecting instant voice message recipients as described hereinabove. Thus, in operation the IVM client 208 requests from the global IVM server system 502 a global contact list of global one or more IVM recipients with which the IVM client 208 may exchange instant voice messages. Alternatively, the global contact list may be replicated to the local IVM server 202 within the local IVM system 510, in which case the IVM client 208 obtains the global contact list from the local IVM server 202. The IVM client 208 displays the global list of IVM recipients, as described hereinabove. The user operates the IVM client 208 to indicate a selection of one or more IVM recipients from the global contact list. The IVM client 208 transmits the user selection to the global IVM server system 502. The user selection generates a start signal in the IVM client 208 indicating that the user is ready to begin instant voice messaging according to the present invention. In response to the start

signal, the IVM client 208 transmits an emulation code to the legacy telephone 110 to ring, thereby indicating to the user the global IVM system 500 is ready to record an instant voice message. As the user picks up the handset of the legacy telephone 110 (off-hook), a connection is established via the network 204 between the legacy telephone 110 and the IVM client 208. Thereafter, the user's speech is transmitted from the legacy telephone 110 to the IVM client 208 for storage into the digitized audio file 210 (i.e., instant voice message). The audio file 210 is finalized by returning the handset of the legacy telephone 110 to its cradle (on-hook) or by pressing a designated button on the keypad of the legacy telephone 110, which transmits a stop signal to the IVM client 208. Returning the handset to its cradle may also generate a send signal to the IVM client 208 to transmit the recorded audio file (instant voice message) to the global IVM server system 502 for delivery to the selected one or more IVM recipients. Alternatively, the send signal is preferably generated from the IVM client 208 as described hereinabove. The global IVM server system 502 thereafter delivers the instant voice message to the selected one or more IVM recipients via the IP network (Internet) 102. The one or more recipients are enabled to display an indication that the instant voice message has been received and audibly play the instant voice message. If a recipient IVM client is not currently connected to the global IVM server system 502, the global IVM server system 502 temporarily saves the instant voice message and delivers it to the IVM client when the IVM client connects to the global IVM server 502.

Further with reference to Fig. 5, the instant voice messaging for global clients 506 and 508 will be described according to the present invention. In a first embodiment,

each of the global IVM clients 506, 508 is enabled to independently send an instant voice message. The IVM clients 506, 508 have like peripheral devices and functionality described respectively with reference to local IVM clients 206, 208 in Fig. 2. In second embodiment described below, the VoIP telephone 506 operates in conjunction with the IVM client 508 to send an instant voice message. Therefore, in operation of the global IVM clients 506 and 508 according the first embodiment in Fig. 5, the IVM clients 506, 508 are connected via the networks 204, 102 to the global IVM server system 502, which enables the global instant voice messaging functionality outside the local IVM system 510 over the network (i.e., Internet) 102. Each of the global IVM clients 506, 508 is enabled to request from the global IVM server system 502 a contact list (not shown) of global one or more IVM recipients with which each of the global IVM client 506, 508 may exchange instant voice messages. For the purposes of this illustration, it is assumed that the IVM clients 206 and 208 within the local IVM system 510 are in the contact list for each global IVM client 506, 508. The global IVM server system 502 stores and maintains the foregoing contact list for each global IVM client 506, 508. Upon request, the global IVM server system 502 responds by transmitting the contact list to each of the IVM clients 506, 508. Each of the IVM clients 506, 508 displays the contact list on its display. The user operates the IVM client 506, 508 to indicate a selection of one or more IVM recipients from the contact list. Each of the global IVM clients 506, 508 transmits the user selection to the global IVM server system 502. The user selection also generates a start signal to the IVM clients 506, 508 that the user is ready to begin instant voice messaging. In response to the start signal, the IVM clients 506, 508 record the user's speech into a digitized audio file (i.e., instant voice message) stored on the global IVM clients 506, 508. The audio file is finalized via a stop signal,

which is generated by the user by operating the global IVM client 506, 508. Once the recording is finalized, the IVM client 506, 508 generates a send signal indicating that the digitized audio file (instant voice message) is ready to be sent to the selected one or more recipients. The user generates the send signal when the user operates the global IVM client 506, 508. The IVM client 208 transmits the digitized audio file and the send signal to the global IVM server system 502. After receiving the audio file, the global IVM server system 502 delivers the transmitted instant voice message to the local IVM server 202 in the local IVM system 510 for delivery to the selected one or more recipients (e.g., local IVM clients 206 and 208) via the local IP network 204. The one or more recipients IVM 206, 208 are enabled to display an indication that the instant voice message has been received and audibly play the instant voice message to an associated user. It is noted that if a recipient IVM client 206, 208 is not currently connected to the local IVM server 202, the IVM server 202 temporarily saves the instant voice message and delivers it to the local IVM client 206, 208 when the IVM client connects to the local IVM server 202.

In the second embodiment of the IVM client 506 according to Fig. 5, the VoIP telephone 506 operates synchronously with the IVM client 508 to enable global instant voice messaging according to the present invention. In this embodiment, the VoIP telephone 506 and the IVM client 508 may be located in a user's residence and be connected to a local IP network 504. This local IP network 504 can be a WiFi network or a local area network (i.e., LAN), which is also within the user's residence. The local IP network 504 may be connected to the IP network (Internet) 102 via a digital subscriber line (i.e., DSL) connection, cable connection, dialup connection, or the like. As noted above, the IVM

clients 506, 508 have like peripheral devices and functionality described respectively with reference to local IVM clients 206, 208 in Fig. 2. Thus, in operation according to this embodiment in Fig. 5, the global IVM client 508 requests from the global IVM server system 502 a contact list of global one or more IVM recipients with which each of the global IVM client 508 may exchange instant voice messages. For the purposes of this illustration, it is assumed that the IVM clients 206 and 208 within the local IVM system 510 are in the contact list for the global IVM client 508. The global IVM server system 502 stores and maintains the foregoing contact list for the global IVM client 508. The IVM client 508 displays a contact list of IVM recipients on the associated display device provided by the global IVM server system 502, as described hereinabove. The user operates the IVM client 508 by using the associated input device to indicate a selection of one or more IVM recipients from the contact list. The user selection generates a start signal in the IVM client 508 indicating that the user is ready to begin instant voice messaging according to the present invention. In response to the start signal, the IVM client 508 generates audio file to record an instant voice message and transmits a ring signal to the VoIP telephone 506 via local IP network 504. As the user picks up the handset of the VoIP telephone 206 (off-hook), a connection is established via the local network 504 between the local IVM client 508 and the VoIP telephone 506. Thereafter, the VoIP telephone 506 forwards the user's speech to the IVM client 508 for storage into the audio file at the IVM client 508. The audio file is finalized by returning the handset its cradle (on-hook) or by pressing a designated button on the keypad associated with the VoIP telephone 506, which transmits the stop signal to the IVM client 508. Returning the handset to its cradle preferably generates a send signal to the IVM client 508. The IVM client thereafter transmits the recorded audio file

(instant voice message) to the global IVM server system 502 for delivery to the selected one or more IVM recipients. Alternatively, the user may press a key on the input device associated with the IVM client 508 to initiate the send signal. In response to the send signal, the IVM client 508 sends the recorded audio file to the global IVM server system 502 for delivery to the selected one or more IVM recipients. The global IVM server system 502 thereafter transmits the instant voice message to the local IVM server 202 for delivery selected one or more recipients (e.g., local IVM clients 206 and 208) via the local IP network 204. As before, the one or more recipients are enabled to display an indication that the instant voice message has been received and audibly play the instant voice message. If a recipient IVM client is not currently connected to the local IVM server 202, the local IVM server 202 temporarily saves the instant voice message and delivers it to the IVM client when the IVM client connects to the local IVM server 202.

Lastly with reference to Fig. 5, in addition to the "record mode" of instant voice messaging as described above, the instant voice messaging system 500 also supports an "intercom mode" of the instant voice messaging. The "intercom mode" represents real-time instant voice messaging. In the "intercom mode," instead of creating an audio file as described hereinabove, one or more buffers (not shown) of a predetermined size are generated. The buffers may be generated in any one of the IVM clients 206, 208, 506 and 508, depending on how the global IVM system 500 is defined. The one or more buffers are used to automatically write successive portions of the instant voice message. Once a first buffer is full, i.e., input audio of the predetermined size is written to the buffer, the content of the first buffer is automatically transmitted. If the transmission is generated at a local

IVM client 206, 208 and destined for one or more local IVM recipients, the content of the first buffer is transmitted to the local IVM server 202 for delivery to the local one or more recipients. If the transmission is generated at a local IVM client 206, 208 and destined for one or more global IVM recipients 506, 508, the content of the first buffer is transmitted to the global IVM server system 502 for delivery to the one or more global recipients. In addition, if the transmission is generated at a global IVM client 506, 508 and destined for the other global IVM clients, the content of the first buffer is transmitted to the global IVM server system 502, such as for example clients 506, 508. Lastly, if the transmission is generated at a global IVM client 506, 508 and destined for the local IVM clients 206, 208, the content of the first buffer is transmitted to the global IVM server system 502 and further transmitted by the global IVM server 502 to the local IVM server 202 for delivery to clients 206, 208 within the local IVM system 510. A second buffer is meanwhile written with the next successive portion of input audio. Once, the second buffer is full, i.e., input audio of the predetermined size is written to the buffer, the content of the second buffer is transmitted in similar fashion to the first buffer. If the entire instant voice message or a successive portion thereof (such as a last successive portion in the instant voice message) written to either buffer is smaller the predetermined size, then the buffered content of less than the predetermined size is automatically transmitted to the IVM server 202. The foregoing buffering using the first and second buffers is repeated until the entire instant voice message has been transmitted as described above. It is noted that the invention is not limited to a particular number of buffers. The foregoing buffering and transmission allows a "real-time" instant voice message to be transmitted to the one or more local, as well as global, IVM recipients. The "intercom mode" may be designated as a default mode when an IVM

recipient is on-line, while the "record mode" may be designated as a default if the IVM recipient is unavailable, i.e., not on-line. The user may easily change the "intercom mode" to the "record mode" on the respective IVM client 206, 208, 506, 508. Finally, the audio contents of the buffers may be signal processed (for clarity), encrypted and compressed before transmission, as was described previously.

Fig. 6 is an exemplary detailed illustration 600 of the global IVM server system 502 depicted in Fig. 5, according to the present invention. More specifically, the local IVM system 510 described in Fig. 5 is connected via the IP network (Internet) 102 to the global IVM server system 502. The global IVM server system 502 comprises an IVM transport server mesh 602 and an IVM directory server 608. The IVM transport server mesh 602 comprises a plurality of interconnected IVM transport servers 604, 606. Although the mesh 602 is depicted as having two IVM transport servers 604, 606, it is to be understood that as many IVM transport servers as are desired or required for redundancy and load balancing may be interconnected in a mesh. The IVM transport servers 604, 606 may be centrally located and configured to communicate (i.e., forward and receive messages) with local IVM clients 206, 208, local IVM server 202 and global IVM client 506, 508 (not depicted in Fig. 6). The plurality of IVM transport servers 604, 606 in the IVM transport server mesh 602 permits load balancing and redundancy in the global IVM system 500. The directory server 608 maintains a transport server list of all the IVM transport servers 604, 606 currently connecting to the mesh 602. Each of the IVM transport servers 604, 606 first connects to the directory server 608. The directory server 608 informs each of the connecting IVM transport servers 604, 606 of all the other IVM transport servers currently

in the mesh 602 based on an active list (not shown) of transport servers 604, 606 in the mesh 602. The connecting IVM transport server then connects to each of the IVM transport servers in the transport server list, resulting in an interconnected mesh 602 of IVM transport servers 604, 606. The IVM transport servers 604, 606 and the IVM directory server 608 communicate via messages.

Further with reference to Fig. 6, the IVM transport servers 604, 606 connected in the mesh 602 share a database (not shown) of IVM clients, so that each IVM transport server 604, 606 refers to the same client database. It is preferable that each IVM transport server 604, 606 maintains its own copy of the client database, which is mirrored and replicated conventionally amongst the IVM transport servers 604, 606 in the mesh 602. The client database may further be replicated to the local IVM server 202. Alternatively, the client database is stored on a separate file server (not shown) in data communication with the IVM transport servers 604, 606 over a network (not shown).

Fig. 7 is an exemplary detailed illustration of a transport server 604, 606 depicted in Fig. 6, according to the present invention. The IVM transport server 604, 606 is a general-purpose programmable computer comprising a network interface (not shown) connected to IP network (Internet) 102, a communication platform 702, a message database 712, and a messaging system 714. The communication platform 702 comprises a server engine 704, which controls a user manager 706, a local server manager 708, and a storage manager 710. The messaging system 714 and the server engine 704 communicate via standard inter-process communication. The storage manager 710 handles retrieving,

sending, and storing of messages, including instant voice messages and attachments thereto, to/from the message database 712. The user manager 706 is responsible for creating/maintaining IVM clients 206, 208, 506, 508, identifying them and relaying their status to the server engine 704. When an IVM client communicates an instant voice message within the global IVM system 500, the user manager 706 notifies the server engine 704 whether the one or more recipients are unavailable, and thereby the instant voice message is saved in the message database 712. When the one or more IVM recipients become available, the user manager 706 notifies the server engine 704, which instructs the storage manager 710 to retrieve any undelivered instant voice messages for the one or more recipients and delivers the instant voice messages to the designated one or more IVM recipients. The local server manager 708 is responsible for creating/maintaining and providing the status of available local IVM servers, such as IVM server 202 in Fig. 2. The availability status of the local IVM servers is checked periodically and updated.

Fig. 8 is an exemplary detailed illustration of a directory server 608 depicted in Fig. 6, according to the present invention. The directory server 608 is a general-purpose programmable computer equipped with a network interface (not shown) connected to IP network (Internet) 102, a messaging system 812, and a communication platform 802. The communication platform 802 comprises a server engine 804, which controls a local server manager 806, a user manager 808, and a transport manager 810. The messaging system 812 and the server engine 804 communicate via standard inter-process communication. The transport manager 810 maintains the status of the IVM transport servers 604, 606 in the IVM transport server mesh 602 within the global IVM system 500 and using a load-

balancing mechanism distributes instant voice messages to available transport server 604, 606 for routing to the one or more IVM recipients. The user manager 808 is responsible for creating/maintaining IVM clients 206, 208, 506, 508, identifying and relaying their status via the server engine 804 to the IVM transport server 604, 606 to be used. The local server manager 806 is responsible for creating/maintaining and providing the status of available local IVM servers, such as IVM server 202 in Fig. 2. The availability status of the local IVM servers is checked periodically and updated.

Fig. 9 illustrates an exemplary a global instant voice messaging (IVM) system 900, which comprises a plurality of local IVM systems and a plurality of global IVM clients, according to the present invention. In the global IVM system 900, there are depicted a plurality of local IVM systems 902, 910 connected to the global IP network 102. The internal representation and functionality of each local IVM system 902, 904 is identical to the local IVM system 510 described with reference to Fig. 5. In global IVM system 900 of Fig. 9, there are also depicted a plurality of global IVM clients 918-928 and a global IVM server system 502 connected to the global IP network (i.e., Internet) 102. The internal representations of the global IVM client 918-928 and the global IVM server system 502 are identical to the respective IVM client 508 (and/or IVM client or 506) and the global IVM server system 502 described with reference to Fig. 5. In the local IVM system 902, each local IVM client 206, 208 is enabled to request local IVM recipients from the local IVM server 202 and global IVM recipients from either the global IVM server system 502 or the local IVM server 202. For example, the local IVM client 1A 208 displays a list 904 to a user, comprising both local and global IVM recipients. More specifically, the list 904

enables IVM client 1A to send instant voice messages according to the present invention to local IVM clients 1B 208 and 1C 206, global IVM client C 922 and global IVM client 2A 208 in the local IVM system 910. Similar lists 906-916 are displayed to the users of the respective IVM clients 1B-1C in local IVM system 902, and 2A-2C in local IVM system 910. In addition, the global clients A-F 918-928 are enabled to request IVM recipients from the global IVM server system 502 and display the respective lists of IVM recipients 930-940 on the respective IVM clients 918-928.

While the invention has been particularly shown and described with regard to preferred embodiments thereof, it will be understood by those skilled in the art that the foregoing and other changes in form and details may be made therein without departing from the spirit and scope of the invention.

CLAIMS:

What is claimed is:

1. A method for instant voice messaging over a packet-switched network, the method comprising:

receiving an instant voice message having one or more recipients;

delivering the instant voice message to the one or more recipients over a packet-switched network;

temporarily storing the instant voice message if a recipient is unavailable; and

delivering the stored instant voice message to the recipient once the recipient becomes available.

ABSTRACT

Methods, systems and programs for instant voice messaging over a packet-switched network are provided. A method for instant voice messaging may comprise receiving an instant voice message having one or more recipients, delivering the instant voice message to the one or more recipients over a packet-switched network, temporarily storing the instant voice message if a recipient is unavailable; and delivering the stored instant voice message to the recipient once the recipient becomes available.

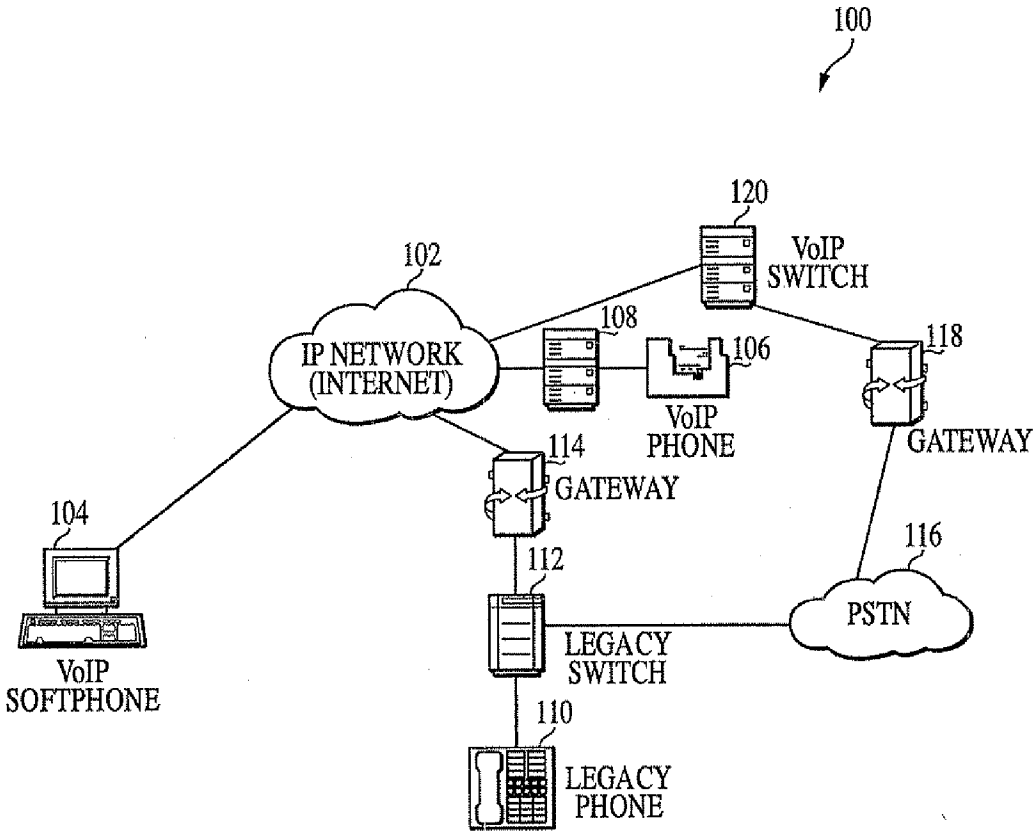

FIG. 1
(PRIOR ART)

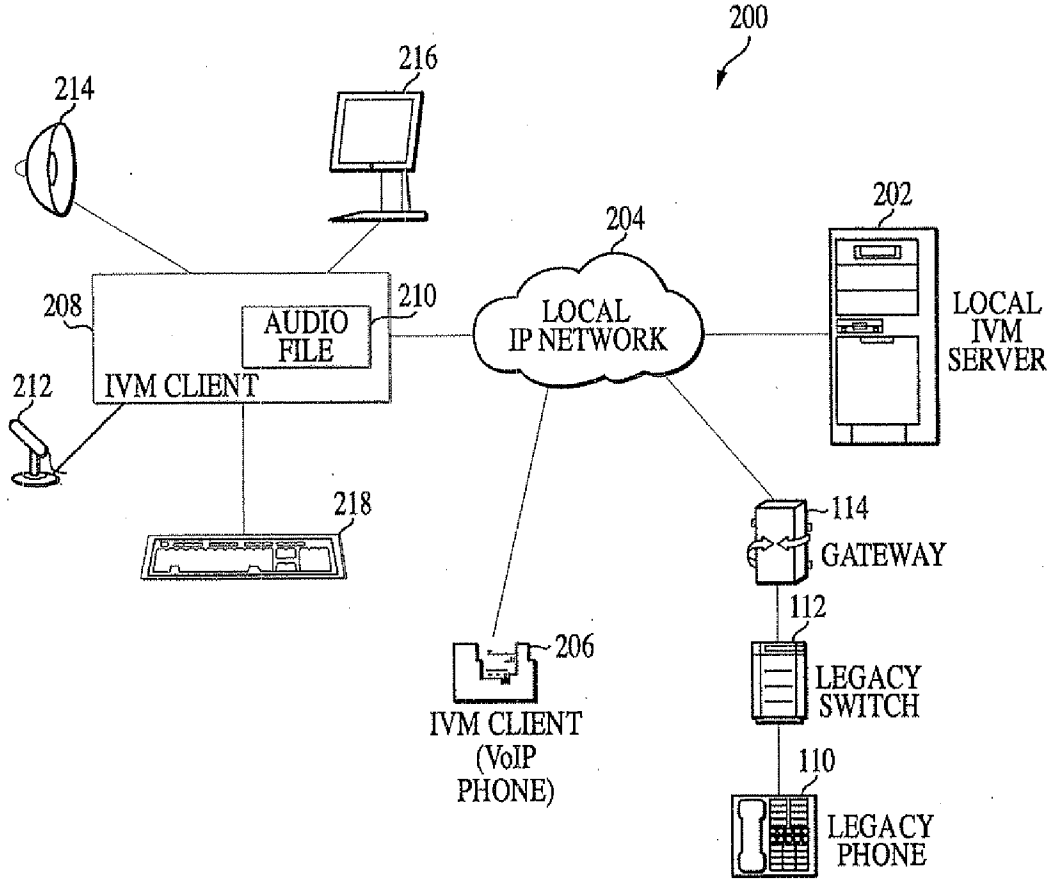
200
216
214
202
204
208
210
AUDIO FILE
LOCAL IP NETWORK
LOCAL IVM SERVER
212
IVM CLIENT
218
114
GATEWAY
112
206
IVM CLIENT (VoIP PHONE)
LEGACY SWITCH
110
LEGACY PHONE

FIG. 2

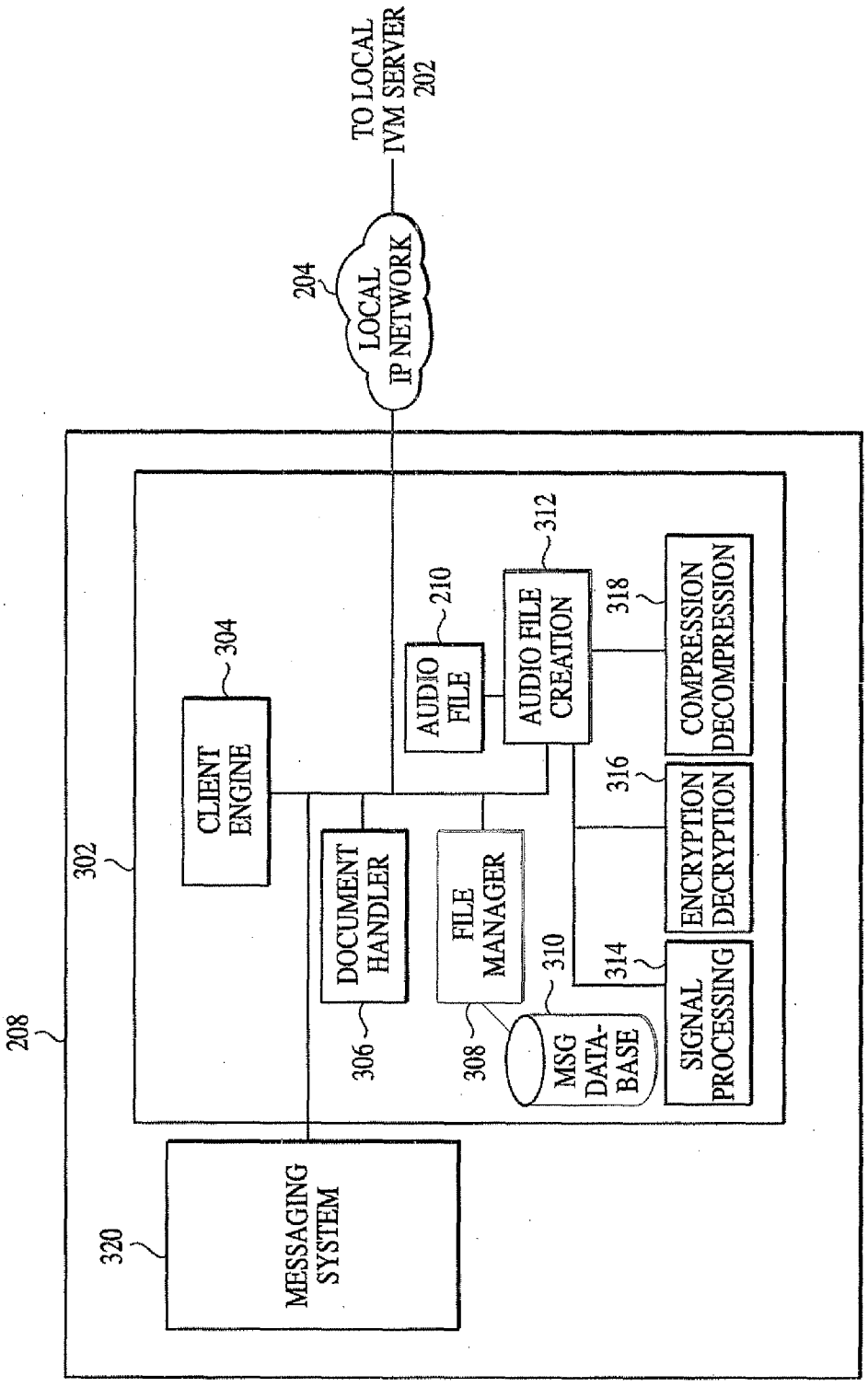
TO LOCAL IVM SERVER 202
204
LOCAL IP NETWORK
208
302
304
CLIENT ENGINE
306
DOCUMENT HANDLER
308
FILE MANAGER
310
MSG DATA-BASE
210
AUDIO FILE
312
AUDIO FILE CREATION
314
316
ENCRYPTION DECRYPTION
318
COMPRESSION DECOMPRESSION
SIGNAL PROCESSING
320
MESSAGING SYSTEM

FIG. 3

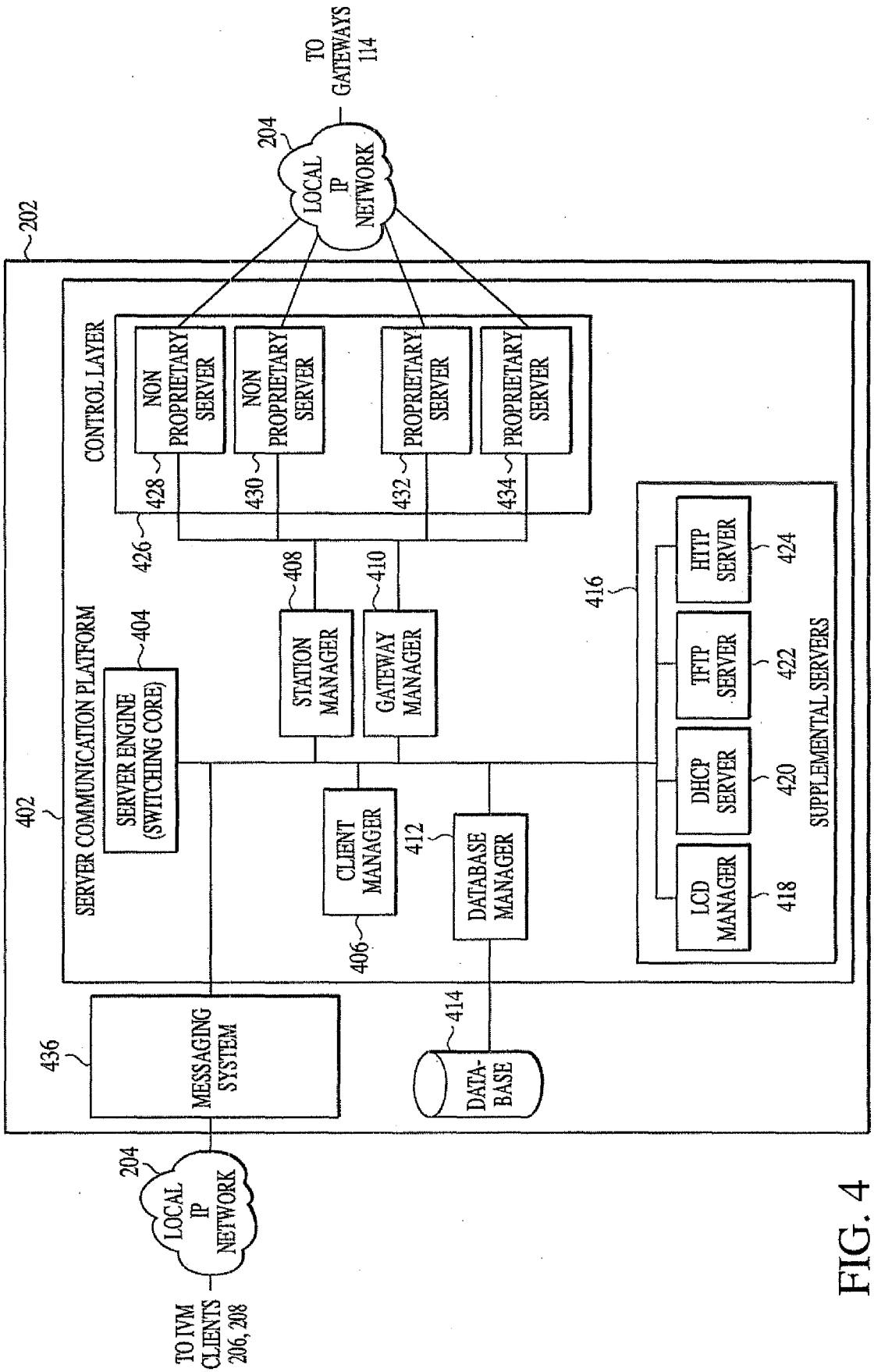
TO GATEWAYS 114
204
LOCAL IP NETWORK
202
CONTROL LAYER
NON PROPRIETARY SERVER
NON PROPRIETARY SERVER
PROPRIETARY SERVER
PROPRIETARY SERVER
428
430
432
434
426
408
410
404
SERVER ENGINE (SWITCHING CORE)
STATION MANAGER
GATEWAY MANAGER
402
SERVER COMMUNICATION PLATFORM
CLIENT MANAGER
412
406
DATABASE MANAGER
416
HTTP SERVER
424
TFTP SERVER
422
DHCP SERVER
420
LCD MANAGER
418
SUPPLEMENTAL SERVERS
436
MESSAGING SYSTEM
414
DATA-BASE
204
LOCAL IP NETWORK
TO IVM CLIENTS 206, 208

FIG. 4

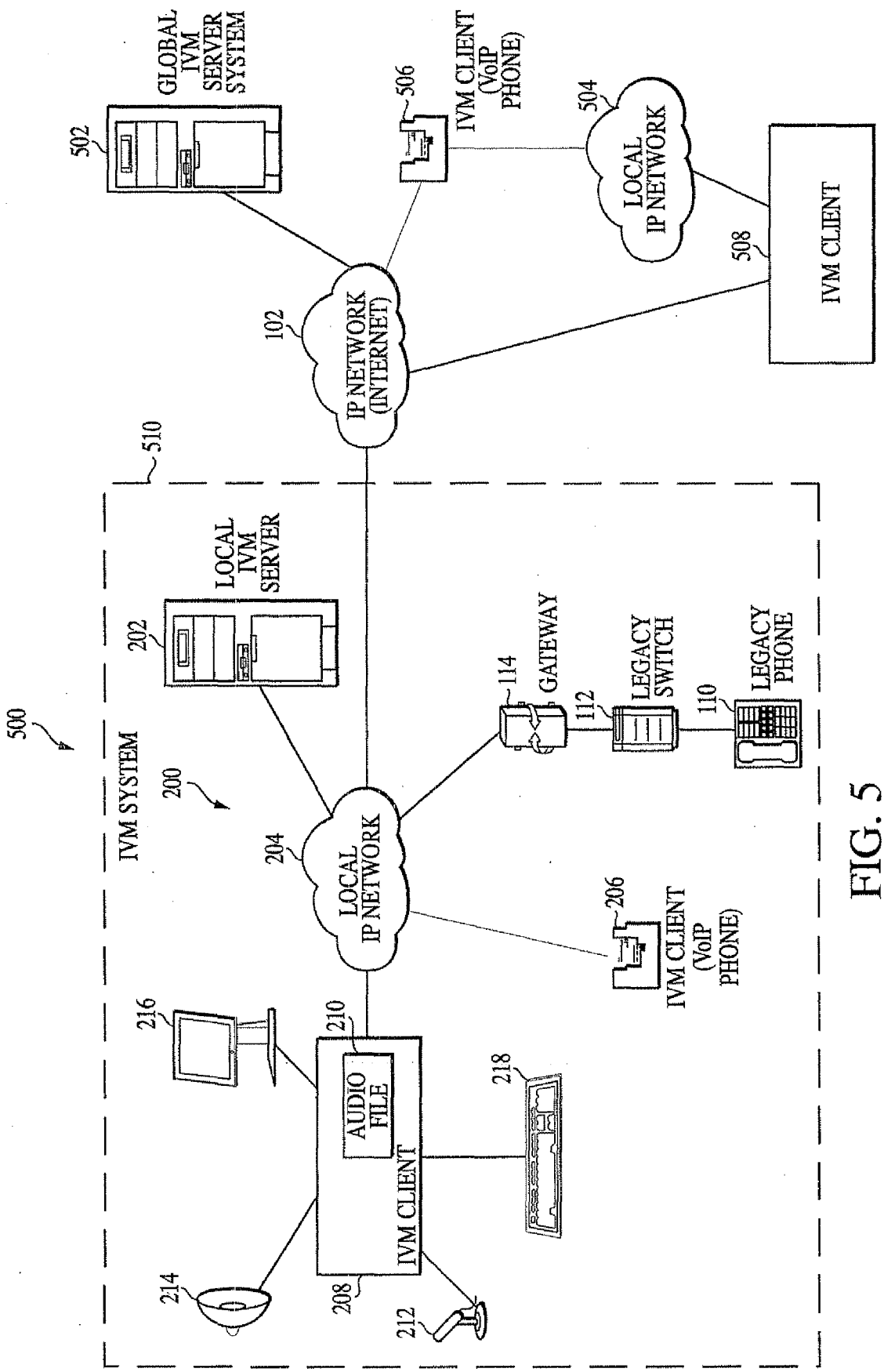
GLOBAL IVM SERVER SYSTEM
502
IVM CLIENT (VoIP PHONE)
506
504
LOCAL IP NETWORK
IVM CLIENT
508
IP NETWORK (INTERNET)
102
510
LOCAL IVM SERVER
202
GATEWAY
114
LEGACY SWITCH
112
LEGACY PHONE
110
500
IVM SYSTEM
200
LOCAL IP NETWORK
204
206
IVM CLIENT (VoIP PHONE)
216
210
AUDIO FILE
IVM CLIENT
218
214
208
212

FIG. 5

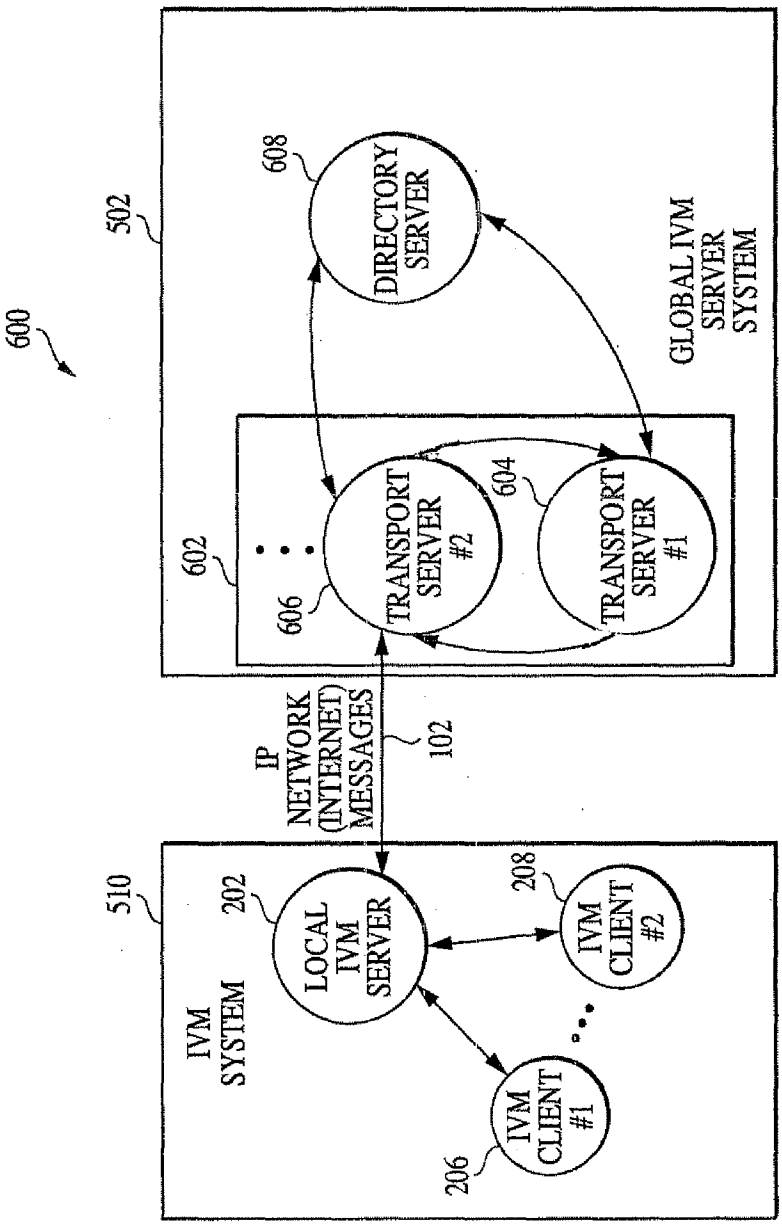
600
502
608
DIRECTORY SERVER
GLOBAL IVM SERVER SYSTEM
602
606
TRANSPORT SERVER #2
604
TRANSPORT SERVER #1
IP NETWORK (INTERNET) MESSAGES
102
510
IVM SYSTEM
202
LOCAL IVM SERVER
208
IVM CLIENT #2
206
IVM CLIENT #1

FIG. 6

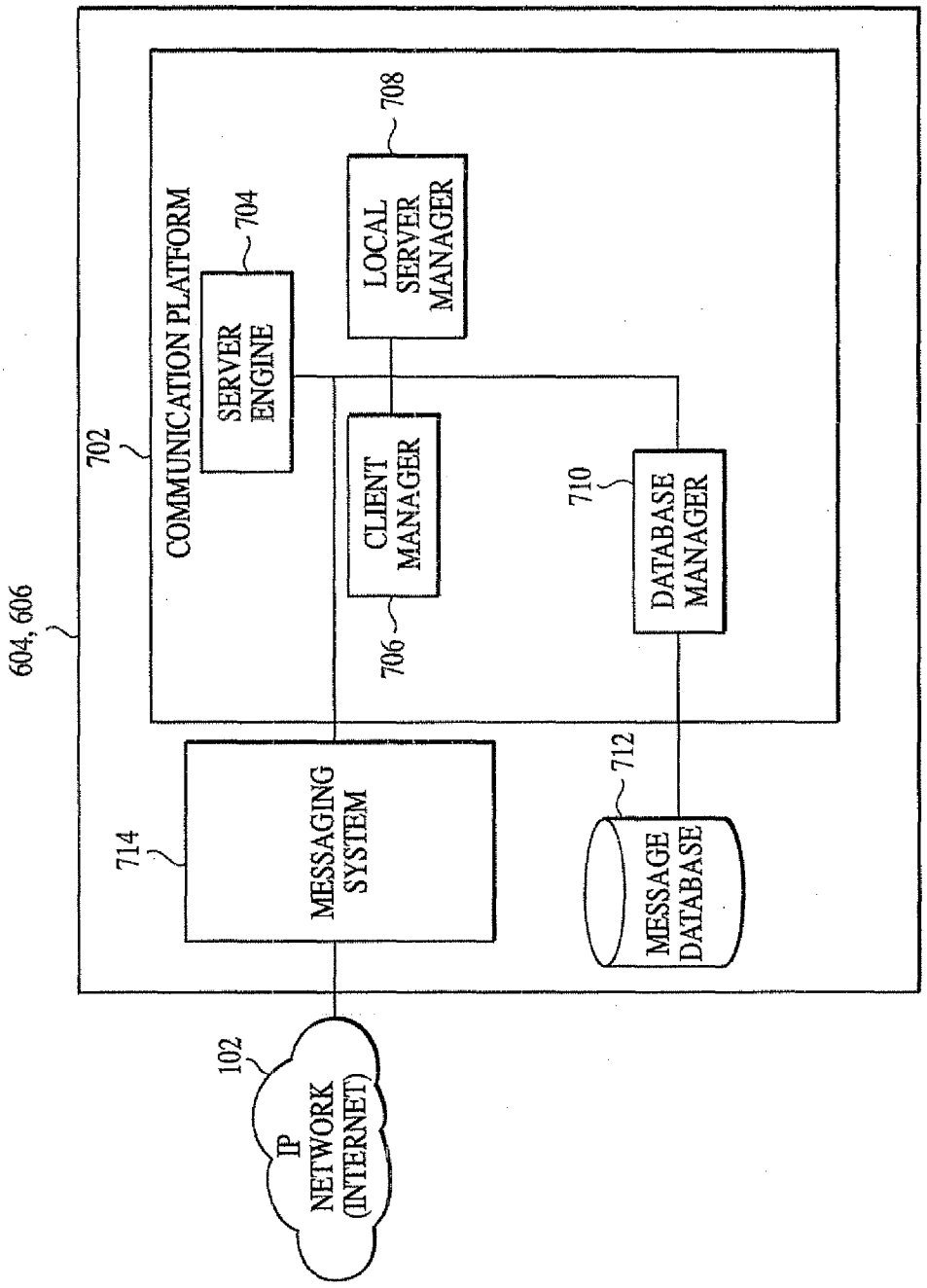
604, 606
702
COMMUNICATION PLATFORM
704
SERVER ENGINE
708
LOCAL SERVER MANAGER
706
CLIENT MANAGER
710
DATABASE MANAGER
714
MESSAGING SYSTEM
712
MESSAGE DATABASE
102
IP NETWORK (INTERNET)

FIG. 7

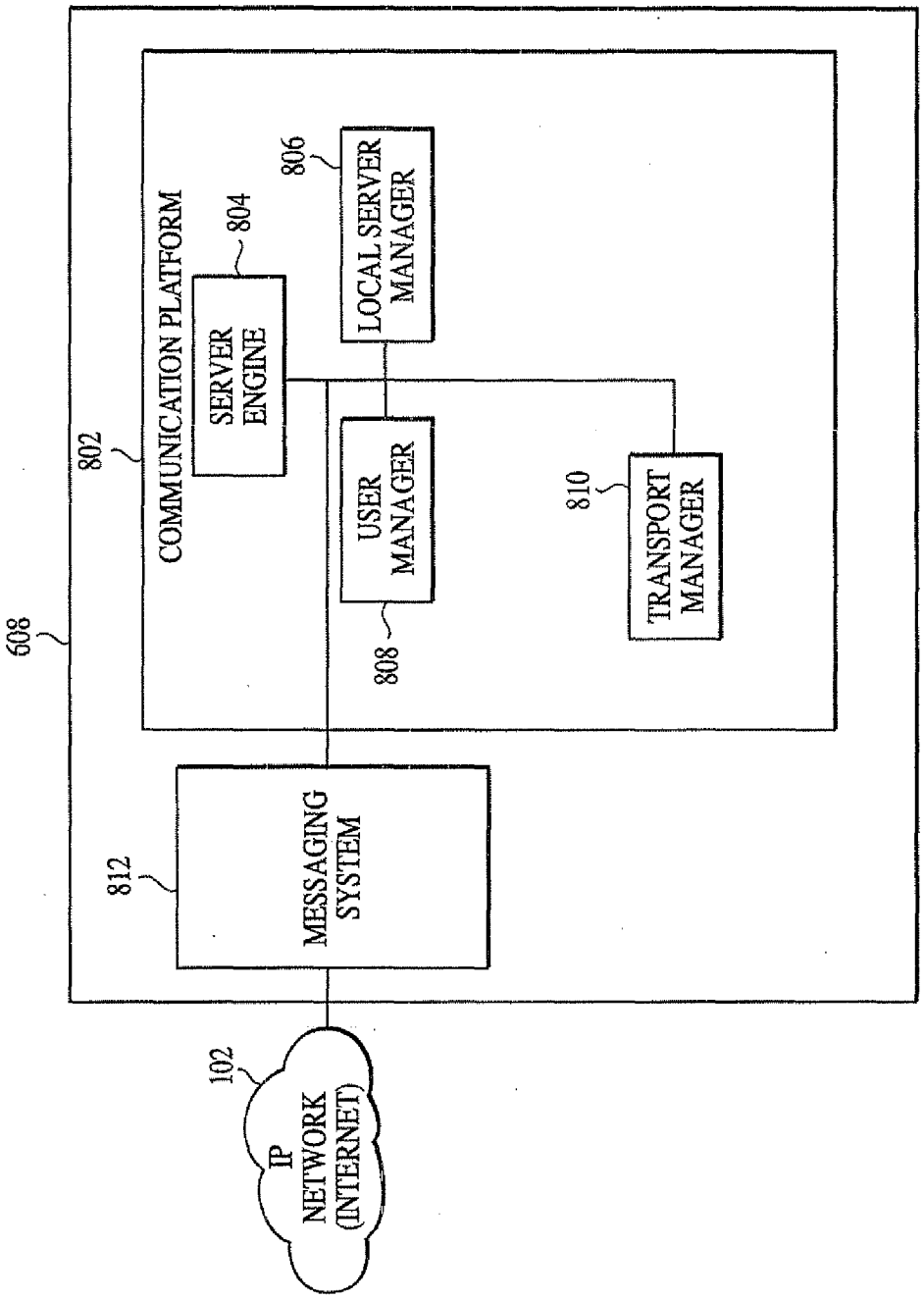
608
802
COMMUNICATION PLATFORM
804
SERVER ENGINE
806
LOCAL SERVER MANAGER
808
USER MANAGER
810
TRANSPORT MANAGER
812
MESSAGING SYSTEM
102
IP NETWORK (INTERNET)

FIG. 8

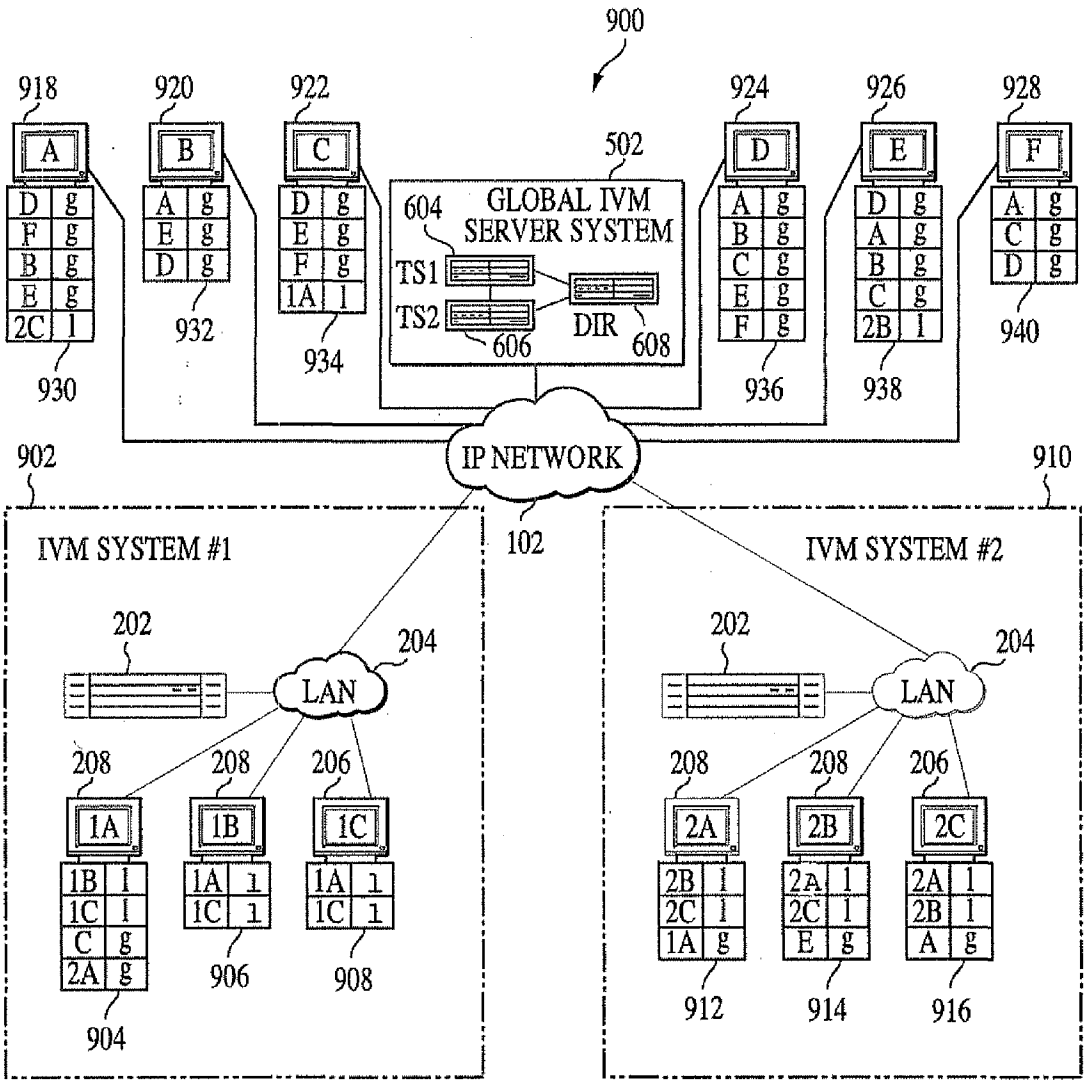
900
918
920
922
924
926
928
A
B
C
D
E
F
D g
F g
B g
E g
2C 1
A g
E g
D g
D g
E g
F g
1A 1
A g
B g
C g
E g
F g
D g
A g
B g
C g
2B 1
A g
C g
D g
930
932
934
936
938
940
502
604
GLOBAL IVM SERVER SYSTEM
TS1
TS2
DIR
606
608
IP NETWORK
102
902
910
IVM SYSTEM #1
IVM SYSTEM #2
202
204
LAN
208
208
206
1A
1B
1C
1B 1
1C 1
C g
2A g
1A 1
1C 1
1A 1
1C 1
904
906
908
2A
2B
2C
2B 1
2C 1
1A g
2A 1
2C 1
E g
2A 1
2B 1
A g
912
914
916

FIG. 9

Docket No.
17188

Declaration and Power of Attorney For Patent Application

English Language Declaration

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name,

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

SYSTEM AND METHOD FOR INSTANT VoIP MESSAGING

the specification of which

(check one)

☒ is attached hereto.

☐ was filed on _____ as United States Application No. or PCT International Application Number _____

and was amended on _____

(If applicable)

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application(s)			Priority Not Claimed
_____ (Number)	_____ (Country)	_____ (Day/Month/Year Filed)	☐
_____ (Number)	_____ (Country)	_____ (Day/Month/Year Filed)	☐
_____ (Number)	_____ (Country)	_____ (Day/Month/Year Filed)	☐

I hereby claim the benefit und r 35 U.S.C. Section 119(e) of any United States provisional application(s) listed below:

(Application Serial No.)	(Filing Date)
(Application Serial No.)	(Filing Date)
(Application Serial No.)	(Filing Date)

I hereby claim the benefit under 35 U. S. C. Section 120 of any United States application(s), or Section 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. Section 112, I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, C. F. R., Section 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application:

(Application Serial No.)	(Filing Date)	(Status) (patented, pending, abandoned)
(Application Serial No.)	(Filing Date)	(Status) (patented, pending, abandoned)
(Application Serial No.)	(Filing Date)	(Status) (patented, pending, abandoned)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

POWER OF ATTORNEY: As a named inventor, I h reby appoint the following attorney(s) and/or agent(s) to prosecute this application and transact all business in the Patent and Trademark Office connected therewith. *(list name and registration number)*

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Second inventor's signature Date
Residence
Citizenship
Post Office Address