

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC. and WHATSAPP INC,  
Petitioner,

v.

UNILOC 2017 LLC,  
Patent Owner.

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IPR2017-01668  
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision on Remand  
Determining All Challenged Claims Unpatentable  
*35 U.S.C. §§ 144, 318*

## I. INTRODUCTION

We address this case on remand after a decision by the U.S. Court of Appeals for the Federal Circuit in *Uniloc 2017 LLC v. Facebook, Inc.*, Nos. 2019-2162, -2159, 2021 WL 5370480 (Fed. Cir. Nov. 18, 2021).

### *A. Background and Summary*

On June 22, 2017, Facebook, Inc. and WhatsApp Inc. (collectively, “Facebook”) filed a Petition requesting *inter partes* review of claims 4, 5, 12, 24–26 of U.S. Patent No. 8,724,622 B2 (“the ’622 patent”). Paper 2 (“Pet.”).<sup>1</sup> Uniloc Luxembourg S.A.<sup>2</sup> filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). On January 19, 2018, we instituted *inter partes* review pursuant to 35 U.S.C. § 314 as to all challenged claims. Paper 8 (“Dec. on Inst.”).

Following institution, Uniloc filed a Patent Owner Response. Paper 16 (“PO Resp.”). Facebook then filed a Reply. Paper 22 (“Reply”). Uniloc also filed a Motion to Exclude (Paper 21), and Facebook filed an Opposition thereto (Paper 24). Also during the pendency of the proceeding,

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<sup>1</sup> That same day, Facebook also filed a petition challenging claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 of the ’622 patent. IPR2017-01667, Paper 2.

<sup>2</sup> Uniloc Luxembourg S.A. was initially identified as the owner of the ’622 patent and Uniloc USA, Inc. was identified as the licensee of the ’622 patent and an additional real party in interest. Paper 3, 1 (Mandatory Notice by Patent Owner). In Updated Mandatory Notices filed August 25, 2018, Uniloc 2017 LLC is identified as the owner of the ’622 patent, and Uniloc USA, Inc. and Uniloc Licensing USA LLC are identified as additional real parties in interest. Paper 28. For convenience, we refer to both Uniloc Luxembourg S.A. and Uniloc 2017 LLC hereinafter simply as “Uniloc.”

Apple Inc. (“Apple”), which filed a petition and motion for joinder in IPR2018-00580, was joined as a petitioner in this proceeding. Paper 27. We held an oral argument in the instant proceeding along with related proceedings IPR2017-01428 and IPR2017-01667 on August 30, 2018. A transcript of the oral hearing (“Tr.”) has been entered into the record as Paper 29. Following the oral hearing, we authorized additional briefing on claim construction with respect to the claim phrase “instant voice message” and its applicability to the asserted prior art, and the parties filed briefs in accordance with that order. *See* Papers 30–34.

On January 16, 2019, following consideration of the full record developed during trial, we issued a Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 in this proceeding and IPR2017-01667, which proceedings were consolidated for purposes of the Decision pursuant to 35 U.S.C. § 315(d). Paper 35 (“Final Dec.”). In the Final Written Decision, we concluded that Facebook had established by a preponderance of the evidence that claims 12 and 24–26 (and also claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 challenged in IPR2017-01667) are unpatentable on the asserted grounds, but that Facebook had not established by a preponderance of the evidence that claims 4 and 5 are unpatentable. *Id.*

Uniloc filed a request for rehearing (Paper 37), which we denied (Paper 38). Facebook then appealed to the Federal Circuit, alleging error in our determination that claims 4 and 5 in this proceeding were not shown to be unpatentable (Paper 38), and Uniloc cross-appealed (Paper 41). While the appeal was pending, Apple entered into a settlement agreement with Uniloc, and Apple and Uniloc jointly moved to voluntarily dismiss Apple as

a party to Uniloc’s appeal and to voluntarily dismiss a cross appeal (Paper 39) that Apple had filed. *See* Ex. 3002. The Federal Circuit granted the joint motion in an Order dated August 13, 2021. Ex. 3003.

In a decision issued on November 18, 2021, the Federal Circuit affirmed our conclusions in the Final Written Decision that claims 12 and 24–26 challenged in this proceeding and claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 challenged in IPR2017-01667 are unpatentable, but held that “the Board misunderstood Facebook’s petition regarding claims 4 and 5” and vacated our decision as to those claims and remanded for further proceedings regarding them. *Uniloc*, 2021 WL 5370480, at \*1.

We held a conference call with counsel for the parties on February 9, 2022, to discuss the procedure on remand. In an Order entered February 14, 2022, we authorized to parties to file additional briefing. Paper 42 (“Order on Remand”). In compliance with that Order, Uniloc filed an Opening Brief on Remand (Paper 43, “PO Opening Remand Br.”), Facebook filed a Response (Paper 44, “Pet. Resp. Remand Br.”), and Uniloc filed a Reply (Paper 45, “PO Reply Remand Br.”).

As we explain above, neither claims 12 and 24–26 challenged in this proceeding nor claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 challenged in IPR2017-01667 are at issue on remand because the Federal Circuit upheld our determination of unpatentability with respect to those claims. Accordingly, the only claims that remain for our consideration are claims 4 and 5.

For the reasons discussed below, after considering the post-remand briefing, as well as the record previously developed during trial and the

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Federal Circuit's decision, we conclude that Facebook has shown by a preponderance of the evidence that claims 4 and 5 are unpatentable.

*B. Related Matters*

The parties have indicated that the '622 patent was involved in *Uniloc USA, Inc. v. WhatsApp Inc.*, No. 2:16-cv-00645 (E.D. Tex.), and *Uniloc USA, Inc. v. Facebook, Inc.*, No. 2:16-cv-00728 (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern District of Texas. *See, e.g.*, Paper 28, 3.

The '622 patent also was the subject of *inter partes* review proceedings in IPR2017-01797 and IPR2017-01798 (filed by Samsung Electronics America, Inc.), in which cases we issued a consolidated final written decision on January 31, 2019, concluding that claims 3, 4, 6–8, 10–19, 21–35, 38, and 39 had been shown to be unpatentable. IPR2017-01797, Paper 32. Our decision in those cases was vacated and remanded to the Board by the Federal Circuit on February 27, 2020, for proceedings consistent with *Arthrex, Inc. v. Smith & Nephew, Inc.*, 941 F.3d 1320 (Fed. Cir. 2019). *Uniloc 2017 LLC v. Samsung Elecs. Am., Inc.*, Nos. 19-2165, -2166, -2167, -2168, -2169 (Fed. Cir. Feb. 27, 2020) (order granting motion to vacate and remand). Prior to issuance of a decision on remand, the parties in those cases settled, and the proceedings were terminated. IPR2017-01797, Paper 39.

Still further, the '622 patent also has been the subject of petitions for *inter partes* review in IPR2017-00223, IPR2017-00224, IPR2017-01804, and IPR2017-01805, filed by Apple, and IPR2017-02080 and IPR2017-02081, filed by Google, Inc., all of which were denied.

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