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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC 2017 LLC,
Patent Owner.

Case IPR2017-01799
Patent 8,199,747 B2

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

BISK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Samsung Electronics America, Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claims 1–3, 12, and 13 ("challenged claims") of U.S. Patent No. 8,199,747 B2 (Ex. 1001, "the '747 patent").

Paper 1 ("Pet."). Uniloc 2017, LLC ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). We instituted this review as to all challenged claims. Paper 9 ("Inst. Dec.") (instituting claims 2 and 12); Paper 16 ("Post-SAS Order") (modifying the institution decision to include all challenged claims).

Subsequent to institution, Patent Owner filed a Patent Owner Response. Paper 21 ("PO Resp."). Petitioner filed a Reply. Paper 24 ("Reply"). Patent Owner also filed a Motion to Exclude (Paper 28), Petitioner opposed (Paper 31), and Patent Owner filed a Reply (Paper 32). A transcript of the oral hearing held on October 30, 2018, has been entered into the record as Paper 39 ("Tr.").

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). For the reasons that follow, Petitioner has demonstrated by a preponderance of the evidence that claims 1–3, 12, and 13 of the '747 patent are unpatentable.

A. *Related Matters*

Petitioner represents that the '747 patent is the subject of numerous ongoing actions before the U.S. District Court for the Eastern District of Texas, including an action filed against Petitioner (Case No. 2-16-cv-00638). Pet. 1–5; *see* Paper 3, 2–3; Paper 14, 1; Paper 15, 1; Paper 26, 1–2.

Before the Office, the '747 patent also was the subject of Cases IPR2017-01257 and IPR2017-02085, in which we denied institution, and Case IPR2018-00748, in which we terminated the Petition prior to a decision on institution. IPR2017-01257, Paper 8 (Dec. 4, 2017); IPR2017-02085, Paper 11 (April 16, 2018); IPR2018-00748, Paper 13 (Sept. 7, 2018).

B. *The '747 Patent*

The '747 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], 1:14–18. The '747 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 2:18–42. In prior art instant text messaging systems, according to the '747 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 2:30–42. According to the '747 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 2:43–47. The invention of the '747 patent is thus directed to such a system and method. *Id.* at 1:15–18, 6:43–45.

In one embodiment, the '747 patent discloses local instant voice messaging ("IVM") system 200, depicted in Figure 2 below. *Id.* at 6:18–20.

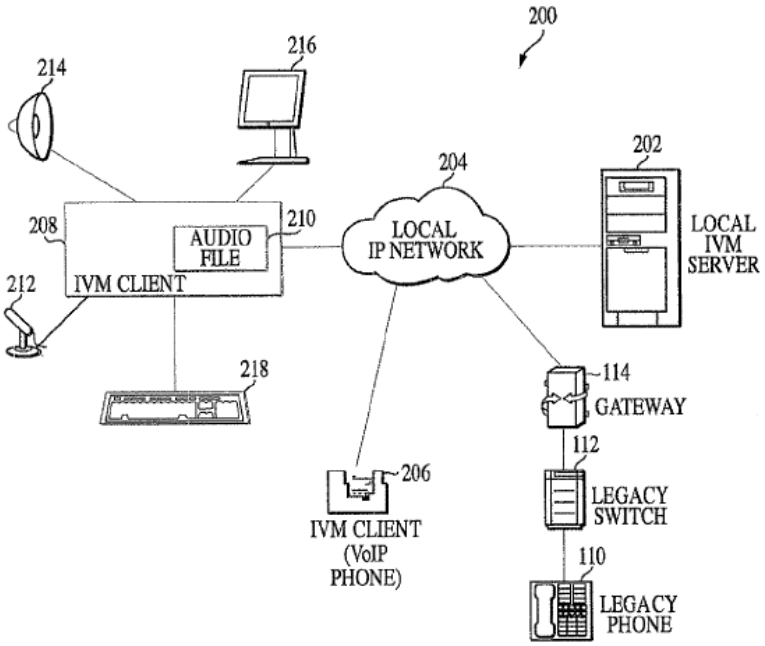

FIG. 2

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 6:46–65; *see id.* at 7:19–20, 7:57–61. Local IVM server 202 enables IVM functionality over network 204. *Id.* at 7:57–61.

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. *Id.* at 7:53–55, 7:61–67. 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 8:1–7.

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 8:11–25. "[O]nly the available

IVM recipients, currently connected to . . . IVM server 202, will receive the instant voice message." *Id.* at 8:29–30. 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 8:30–35; *see id.* at 9:13–17. Upon receiving the instant voice message, the recipients can audibly play the message. *Id.* at 8:25–28.

C. Illustrative Claims

Of the challenged claims, claims 1–3 are independent. Those claims are reproduced below:

> 1. A method for instant voice messaging over a packet-switched network, the method comprising:
> generating an instant voice message, wherein generating includes recording the instant voice message in an audio file and attaching one or more files to the audio file;
> transmitting the instant voice message having one or more recipients;
> receiving an instant voice message when a recipient is available; and
> receiving a temporarily stored instant voice message when a recipient becomes available, wherein the instant voice message is temporarily stored when at least one recipient is unavailable.
>
> 2. A method for instant voice messaging over a packet-switched network, the method comprising:
> receiving a list of nodes within the packet-switched network, the list of nodes including a connectivity status of each node, said connectivity status being available and unavailable, wherein a node within the list is adapted to be selected as a recipient of an instant voice message;
> displaying said list of nodes;
> transmitting the instant voice message having one or more recipients;

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