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Paper 34
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.

Case IPR2017-01800
Patent 8,243,723 B2

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

QUINN, *Administrative Patent Judge.*

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

I. INTRODUCTION

We instituted this proceeding for *inter partes* review of claims 1–3 of U.S. Patent No. 8,243,723 B2 (Ex. 1001, "the '723 patent"), owned by Uniloc 2017 LLC ("Patent Owner"), as requested by Samsung Electronics America, Inc. ("Petitioner"). 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, and in view of the full record, Petitioner has shown by a preponderance of the evidence that claims 1–3 of the '723 patent are unpatentable.

II. BACKGROUND

A. Procedural History

Petitioner filed its Petition for *inter partes* review on July 20, 2017. Upon consideration of the Petition and Patent Owner's Preliminary Response (Paper 6), we issued on February 6, 2018, a Decision on Institution, which partially granted the Petition. Paper 8 ("Dec. on Inst."). We determined that Petitioner had demonstrated a reasonable likelihood of prevailing in its challenge of claims 1 and 3, but not of claim 2. *Id*. at 24. On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in a petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1355 (2018). Consistent with *SAS*, we modified our Decision on Institution to institute on all of the challenged claims, including claim 2, on all the grounds presented in the Petition, and we extended the deadline for Patent Owner to file its Response. Paper 12.

Patent Owner filed a Patent Owner Response. Paper 16 ("PO Resp."). Petitioner filed a Reply. Paper 19 ("Reply"). Patent Owner further filed a Motion to Exclude deposition testimony objected to as being outside the scope of permissible deposition topics. Paper 23 ("Motion"). Petitioner opposes the Motion. Paper 26 ("Opp'n").

Before the scheduled hearing in this proceeding, we issued an Order giving the parties notice of claim construction positions of the term "instant voice message," which is a term recited in all of the '723 patent claims. Paper 29. In that Order, we notified the parties that the panel expected to hear the parties' positions concerning the alternative constructions under consideration in IPR2017-01427, IPR2017-01428, IPR2017-01667 and IPR2017-01668 (proceedings involving patents related to the '723 patent and also reciting the term "instant voice message"). *Id.* We heard oral argument on October 30, 2018, the transcript of which is entered in the record. Paper 33 ("Tr.").

B. Related Matters

The parties indicate that the '723 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.). Pet. 1–3, Paper 4, 2. The '723 patent also has been the subject of multiple *inter partes* review petitions, and was the subject of Case IPR2017-00222 (where Apple Inc., Facebook, Inc., and WhatsApp, Inc. constitute the Petitioner), in which we issued a Final Written Decision finding unpatentable claims 1 and 2, but not

finding unpatentable claims 3–8, of the '723 patent. IPR2017-00222, Paper 29.[1]

III. THE '723 PATENT AND PRESENTED CHALLENGES

C. The '723 Patent

The '723 patent relates to Internet telephony, and more particularly, to instant voice over IP ("VoIP") messaging over an IP network, such as the Internet. Ex. 1001, 1:14–18. The '723 patent acknowledges that "instant text messaging is . . . known" in the VoIP and public switched telephone network environments, with its server presenting the user a "list of persons who are currently 'online' and ready to receive text messages on their own client terminals." *Id.* at 2:19, 2:30–37. In one embodiment, such as depicted in Figure 2 (reproduced below) the system of the '723 patent involves an instant voice message (IVM) server and IVM clients. *Id.* at 7:19–24.

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[1] At the time of issuing this Final Written Decision, the appeal filed concerning the Final Written Decision in IPR2017-00222 is unresolved. Therefore, we do not apply collateral estoppel to claims 1 and 2 of the '723 patent. *Cf. MaxLinear Inc. v. CF Crespe LLC*, 880 F.3d 1373, 1376 (Fed. Cir. 2018) ("It is undisputed that as a result of collateral estoppel, a judgment of invalidity in one patent action renders the patent invalid in any later actions based on the same patent." (citing *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 252 F.3d 1306, 1310 (Fed. Cir. 2001)).

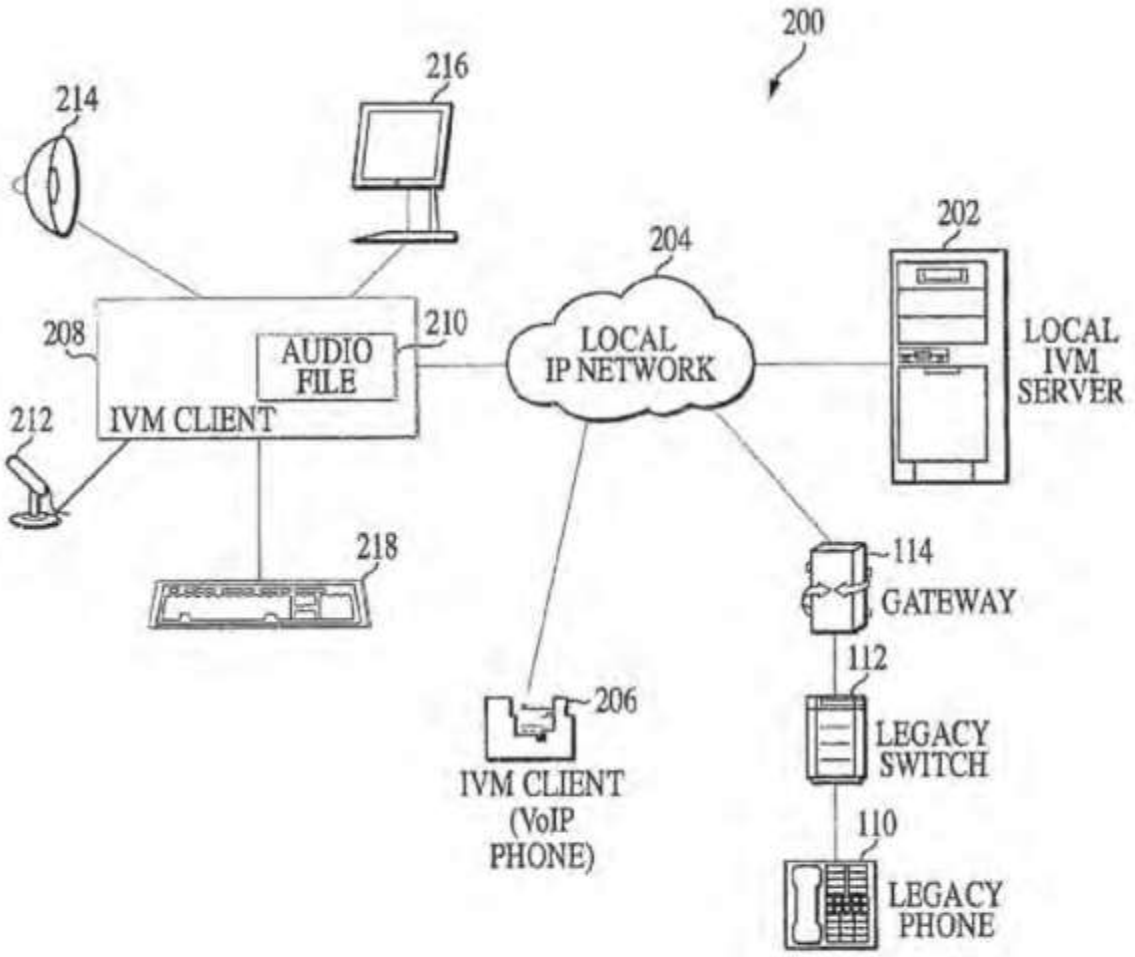

FIG. 2

Figure 2 illustrates IVM client 206 interconnected via network 204 to the local IVM server 202, where IVM client 206 is a VoIP telephone, and where legacy telephone 110 is connected to legacy switch 112 and further to media gateway 114. *Id.* at 7:19–41. The media gateway converts the PSTN audio signal to packets for transmission over a packet switched IP network, such as local network 204. *Id.* at 7:45–48. In one embodiment, when in "record mode," the user of an IVM client selects one or more IVM recipients from a list. *Id.* at 7:53–64. The IVM client listens to the input audio device and records the user's speech into a digitized audio file at the IVM client.

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