

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 IPR2017-01801
Patent 8,995,433 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 1–5, 7–12, 14–17, 25, and 26 of U.S. Patent No. 8,995,433 B2 (Ex. 1001, “the ’433 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 1–5, 7–12, 14–17, 25, and 26 of the ’433 patent are unpatentable.

II. BACKGROUND

A. Procedural History

Petitioner filed its Petition for *inter partes* review on July 20, 2017. Paper 1 (“Pet.”). Upon consideration of the Petition and Patent Owner’s Preliminary Response (Paper 6), we issued, on February 6, 2018, a Decision on Institution. Paper 8 (“Dec. on Inst.”). We determined that Petitioner had demonstrated a reasonable likelihood of prevailing in its challenge of all claims and all grounds. *Id.* at 26–27. Patent Owner filed a Patent Owner Response. Paper 12 (“PO Resp.”). Petitioner filed a Reply. Paper 16 (“Reply”). Patent Owner further filed a Motion to Exclude deposition testimony objected to as being outside the scope of permissible deposition topics. Paper 20 (“Motion”). Petitioner opposes the Motion. Paper 23 (“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 claims of the ’433 patent. Paper 26. 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 the ’433 patent and related patents 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 30 (“Tr.”).

B. Related Matters

The parties indicate that the ’433 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. 1–5, Paper 4, 2. The ’433 patent also has been the subject of multiple *inter partes* review petitions, and was the subject of Case IPR2017-00225 (where Apple Inc., Facebook, Inc., Snap Inc., and WhatsApp, Inc. constitute the Petitioner), in which we issued a Final Written Decision concluding that claims 1–6 and 8 of the ’433 patent were not shown to be unpatentable. *Final Written Decision*, Case IPR2017-00225, Paper 29, 47 (May 23, 2018 PTAB). We have also issued Final Written Decisions concerning the ’433 patent in IPR2017-01427 and IPR2017-01428, concluding that claims 1–12, 14–17, 25, and 26 are unpatentable. *Final Written Decision*, Case IPR2017–01427, Paper 46 (Nov. 30, 2018 PTAB) (consolidated with IPR2017-01428).¹

¹ At the time of issuing this Final Written Decision, the appeal filed concerning the Final Written Decisions in IPR2017-00225, is unresolved. Furthermore, at the time of issuing this Decision, it is unclear whether the

III. THE '433 PATENT AND PRESENTED CHALLENGES

C. The '433 Patent

The '433 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, 1:19–23. The '433 patent acknowledges that “instant text messaging is [] known” in the VoIP and public switched telephone network (“PSTN”) 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 2:35–42. In one embodiment, such as depicted in Figure 2 (reproduced below), the system of the '433 patent involves an instant voice message (“IVM”) server and IVM clients. *Id.* at 7:21–22.

Final Written Decisions in IPR2017-01427 and IPR2017-01428, also addressing the '433 patent, will be appealed. Therefore, we do not apply collateral estoppel to the challenged claims of the '433 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)).

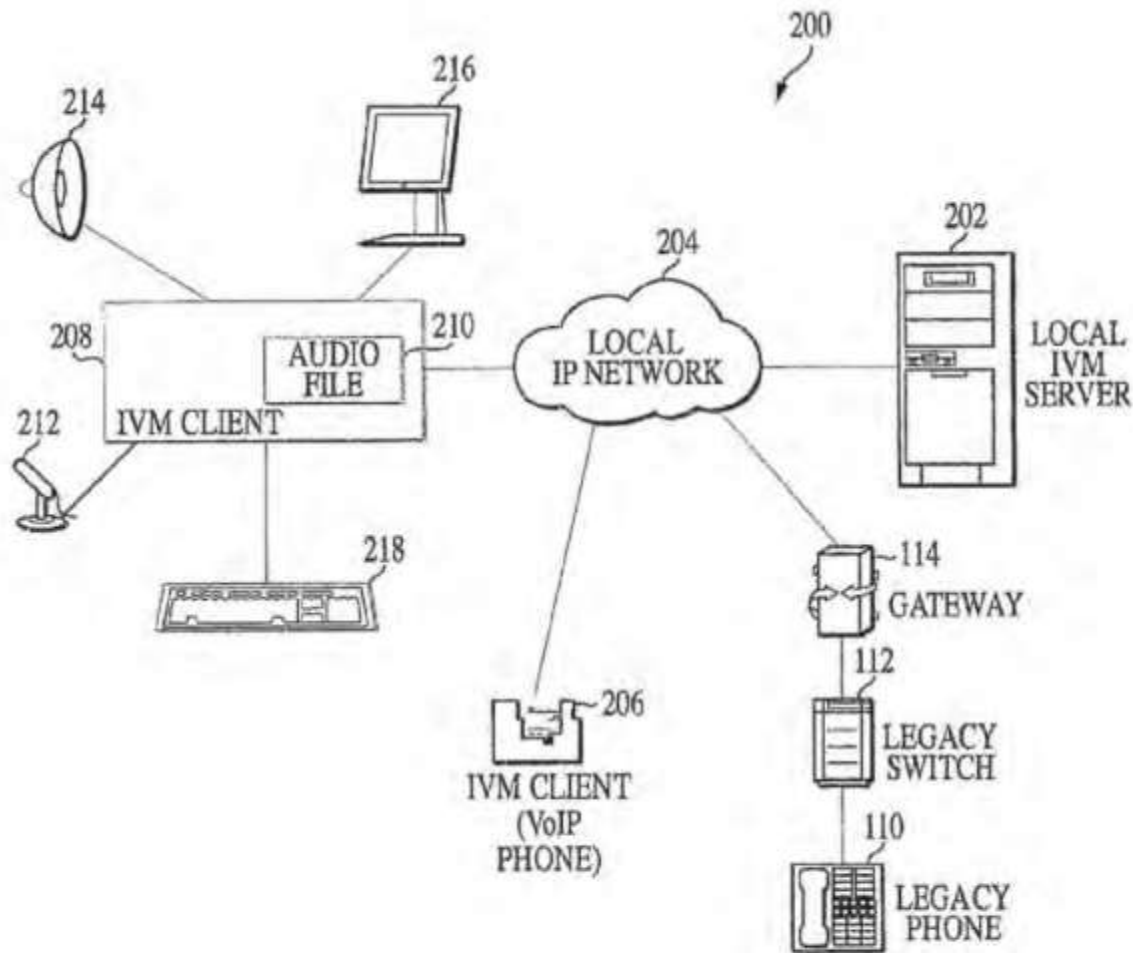


FIG. 2

Figure 2 illustrates IVM client 206 interconnected via network 204 to 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 7:27–49. 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 7:49–53. In one embodiment, when in “record mode,” the user of an IVM client selects one or more IVM recipients from a list. *Id.* at 8:2–5. The IVM client listens to the input audio device and records the user’s speech into a digitized audio file at the IVM client. *Id.* at



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