UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,
Petitioner,

v.

UNILOC USA, INC.,
Patent Owner.

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Case IPR2017-02082
Patent 7,535,890 B2

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

BISK, Administrative Patent Judge.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Google LLC[1], filed a Petition requesting *inter partes* review of claims 1–6, 9, 10, 12, 14, 16–20, 23, 24, 26, 40–43, 46, 47, 49, 51–54, 57, 58, and 60 of U.S. Patent No 7,535,890 B2, issued on May 19, 2009 (Ex. 1001, "the '890 patent") pursuant to 35 U.S.C. §§ 311–319. Paper 2 ("Pet."). Uniloc USA, Inc. filed a Preliminary Response. Paper 8 ("Prelim. Resp."). Petitioner filed a Reply to Patent Owner's Preliminary Response, upon authorization of the Board, 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.

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." Having considered the Petition and the Preliminary Response, we determine that the information presented does not show that there is a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of any of the challenged claims of the '890 patent. For the reasons given below, we deny institution of an *inter partes* review.

A. Related Matters

Petitioner and Patent Owner represent that the '890 patent is asserted in numerous actions before the U.S. District Court for the Eastern District of Texas, including actions filed against Petitioner (Case Nos. 2:17-cv-465,

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[1] Subsequent to filing this Petition, Google, Inc. changed its name to Google LLC. Paper 5.

2:17-cv-466, 2:17-cv-467, 2:17-cv-231, 2:17-cv-224, 2:17-cv-214). Pet. 1–2; Paper 3, 2–3.

In addition, the '890 patent is the subject of several *inter partes* review proceedings before the Office. In IPR2017-00221, filed by Apple Inc., the Board instituted *inter partes* review of claims 1–6, 14, 15, 17–20, 28, 29, 31–34, 40–43, 51–54, 62–65, and 68 of the '890 patent on May 25, 2017. *Apple Inc. v. Uniloc USA, Inc.*, Case IPR2017-00221 (PTAB May 25, 2017) (Paper 9).   Moreover, on September 11, 2017—concurrent with this Petition—Petitioner filed IPR2017-02083 and IPR2017-02084, which challenge different subsets of claims of the '890 patent. *Google, Inc. v. Uniloc Luxembourg S.A.*, Cases IPR2017-02083, IPR2017-02084 (PTAB), Paper 2.

The '890 patent was also previously the subject of IPR2017-00220, IPR2017-01523, IPR2017-01524, and IPR2017-01802, in which the Board denied institution. *See Apple, Inc. v. Uniloc USA, Inc.*, Case IPR2017-00220 (PTAB)[2], Paper 9; *Facebook, Inc. v. Uniloc USA, Inc.*, Case IPR2017-01523, IPR2017-01524 (PTAB), Paper 7; *Samsung Elecs. Am., Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-01802 (PTAB), Paper 8.

A. The '890 Patent

The '890 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, 2:11–35.

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[2] IPR2017-01612 filed by Snap Inc. and IPR2017-01636 filed by Facebook, Inc. and WhatsApp Inc. were joined with IPR2017-00221. *See Snap Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-01612 (PTAB Oct. 3, 2017) (Paper 11); *Facebook, Inc. v. Uniloc Luxembourg S.A.*, Case IPR2017-01636 (PTAB Oct. 3, 2017) (Paper 10).

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 2:23–35. According to the '890 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 1:6–11, 2:36–48, 6:37–39.

In one embodiment, the '890 patent discloses local instant voice messaging ("IVM") system 200, depicted in Figure 2 below. *Id.* at 6:12–14.
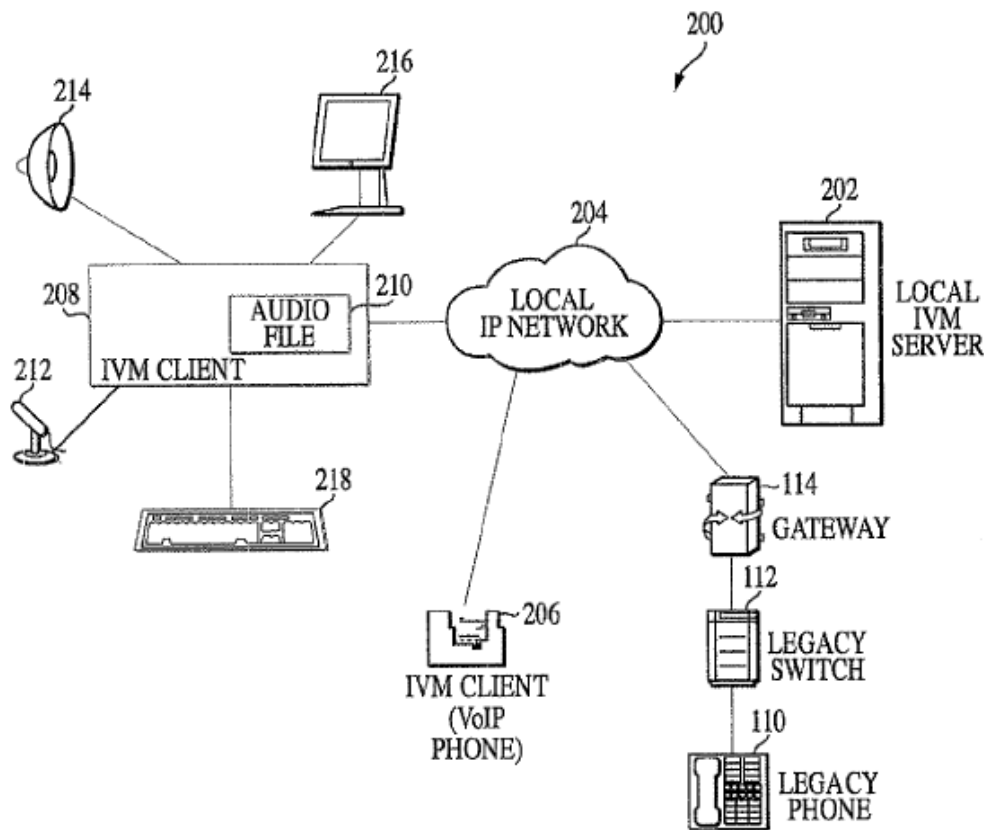

FIG. 2

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 6:40–61; *see id.* at 7:13–14, 7:51–55. Local IVM server 202 enables instant voice messaging functionality over network 204. *Id*. at 7:53–55.

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 7:47–49, 7:55–61. 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 7:61–8:1.

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 8:5−19. "[O]nly the available IVM recipients, currently connected to . . . IVM server 202, will receive the instant voice message." *Id.* at 8:23−25. 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 8:24–29; *see id.* at 9:7–11. Upon receiving the instant voice message, the recipients can audibly play the message. *Id.* at 8:19–22.

B. Illustrative Claim

Of the challenged claims, claims 1, 12, 14, 26, 40, 49, 51, and 60 are independent. Claim 1 is illustrative of the claims at issue and is reproduced below:

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