

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

UNILOC 2017 LLC,¹
Patent Owner.

Case IPR2018-00580
Patent 8,724,622 B2

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

BOUDREAU, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and
Grant of Motion for Joinder
35 U.S.C. § 314(a); 37 C.F.R. § 42.122(b)

¹ Uniloc Luxembourg S.A., formerly identified as Patent Owner, filed an Updated Mandatory Notice pursuant to 37 C.F.R. § 42.8(a)(2) on August 9, 2018, stating that Uniloc 2017 LLC is now the Patent Owner. Paper 12. The caption has been updated accordingly.

I. INTRODUCTION

Apple Inc. (“Apple” or “Petitioner”) filed a Petition requesting *inter partes* review of claims 4, 5, 12, and 24–26 of U.S. Patent No. 8,724,622 B2 (Ex. 1101, “the ’622 patent”). Paper 3 (“Pet.”). Petitioner also filed a Motion for Joinder, seeking joinder as a petitioner in *Facebook, Inc. v. Uniloc Luxembourg S.A.*, Case No. IPR2017-01668 (“the 1668 IPR”). Paper 2 (“Mot.”). Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response (Paper 11, “Prelim. Resp.”), as well as an Objection to Petitioner’s Motion for Joinder (Paper 8, “Obj.”).

We have authority under 35 U.S.C. § 314. Upon considering the information presented in the parties’ papers, for reasons discussed below, we institute *inter partes* review of claims 4, 5, 12, and 24–26 of the ’622 patent and grant Petitioner’s Motion for Joinder.

II. DISCUSSION

A. Related Matters

The parties indicate that the ’622 patent is involved in *Uniloc USA, Inc. v. Apple Inc.*, No. 2:16-cv-00638-JRG (E.D. Tex.), among numerous other actions in the United States District Court for the Eastern District of Texas. Pet. 3–4; Paper 6, 3.

The ’622 patent also has been the subject of petitions for *inter partes* review in Cases IPR2017-00223, IPR2017-00224, IPR2017-01804, and IPR2017-01805 (filed by Apple Inc.), all of which were denied; Cases IPR2017-01667 and IPR2017-01668 (filed by Facebook, Inc. and WhatsApp Inc.), in which we instituted *inter partes* review on January 19, 2018; Cases IPR2017-01797 and IPR2017-01798 (filed by Samsung Electronics

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America, Inc.), in which we instituted *inter partes* review on February 6, 2018; Cases IPR2017-02080 and IPR2017-02081 (filed by Google, Inc.), which we denied; and Case IPR2017-02090 (filed by LG Electronics, Inc. and Huawei Device Co., Ltd.), in which we instituted *inter partes* review on March 6, 2018, and granted a motion to join LG and Huawei as petitioners in IPR2017-01667. In addition, concurrently with the filing of the instant Petition, Petitioner filed a petition requesting *inter partes* review of claims 3, 6–8, 10, 11, 13–23, 27–35, 38, and 39 of the '622 patent (Case IPR2018-00579) along with a motion for joinder with IPR2017-01667.

B. The '622 Patent

The '622 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. 1101, [54], 1:18–22. The '622 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 2:22–46. In prior art instant text messaging systems, according to the '622 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 2:34–46. According to the '622 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 1:18–22, 2:47–59, 6:47–49.

In one embodiment, the '622 patent discloses local instant voice messaging (“IVM”) system 200, depicted in Figure 2 below. Ex. 1101, 6:22–24.

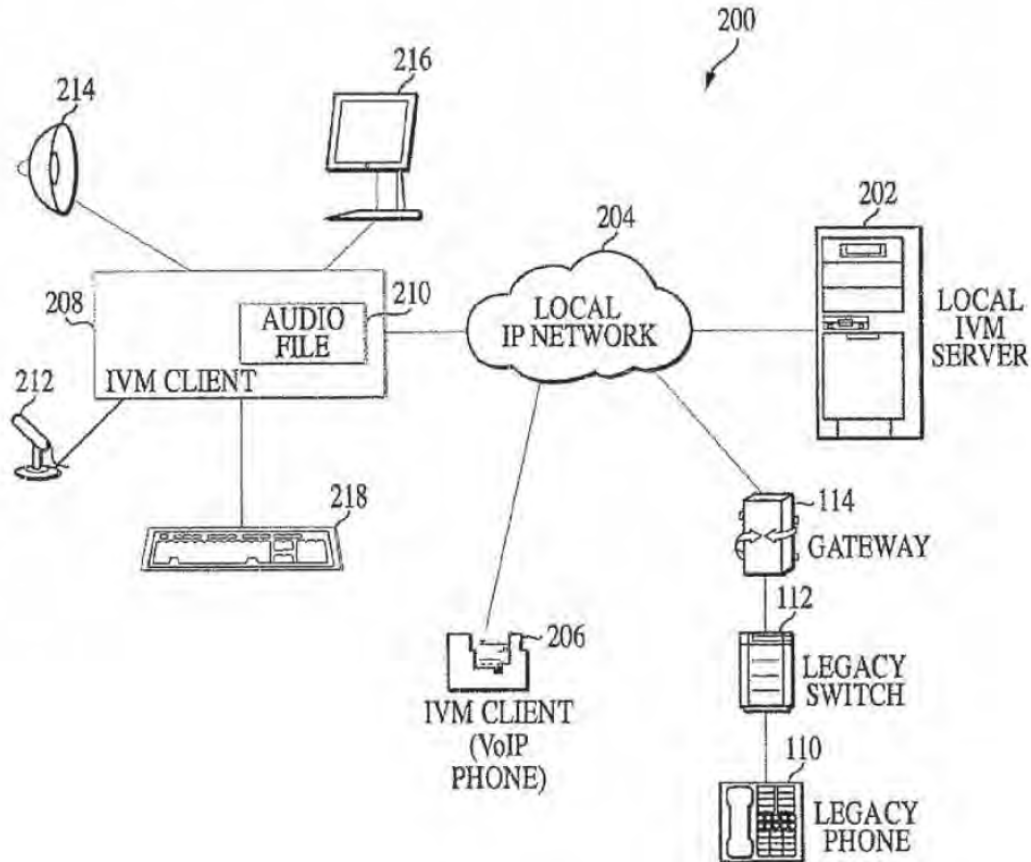


FIG. 2

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 6:50–7:2; *see id.* at 7:23–24, 7:61–65. Local IVM server 202 enables instant voice messaging functionality over network 204. *Id.* at 7:61–65.

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. Ex. 1101, 7:57–59, 7:65–8:4. 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 8:4–11.

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. Ex. 1101, 8:15–29. “[O]nly the available IVM recipients, currently connected to . . . IVM server 202, will receive the instant voice message.” *Id.* at 8:33–34. 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 8:34–39; *see id.* at 9:17–21. Upon receiving the instant voice message, the recipients can audibly play the message. *Id.* at 8:29–32.

C. Illustrative Claims

Of the challenged claims, only claim 24 is independent. Challenged claims 25 and 26 depend directly from claim 24, and the remaining challenged claims depend directly or indirectly from independent claim 3, which is not challenged in the instant proceeding. Unchallenged claim 3 and challenged claims 4 and 24 are illustrative and are reproduced below.

3. A system comprising:
 - a network interface connected to a packet-switched network;
 - a messaging system communicating with a plurality of instant voice message client systems via the network interface; and
 - a communication platform system maintaining connection information for each of the plurality of instant voice message client systems indicating whether there is a current

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