

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC. and WHATSAPP INC.,  
Petitioner,

v.

UNILOC USA, INC. and UNILOC LUXEMBOURG S.A.,  
Patent Owner.

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Case IPR2017-01427  
Patent 8,995,433 B2

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Before MIRIAM L. QUINN, KERRY BEGLEY, and  
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

DECISION and ORDER  
Institution of *Inter Partes* Review and Conduct of the Proceeding  
37 C.F.R. § 42.108, § 42.5(a)

## I. INTRODUCTION

The above-captioned Petitioner (Facebook, Inc. and WhatsApp Inc.) filed a Petition requesting *inter partes* review of claims 1–8 of U.S. Patent No. 8,995,433 B2 (Ex. 1001, “the ’433 patent”). Paper 2 (“Pet.”). Uniloc USA, Inc. and Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314. Upon considering the record developed thus far, for reasons discussed below, we institute *inter partes* review of claims 1–8 of the ’433 patent.

### A. Related Matters

The parties indicate that the ’433 patent is involved in *Uniloc USA, Inc. v. Facebook, Inc.* and *Uniloc USA, Inc. v. WhatsApp Inc.*, Case Nos. 2-16-cv-00728-JRG (E.D. Tex.) and 2:16-cv-00645-JRG (E.D. Tex.). Pet. 1–2. The ’433 patent also is the subject of Case IPR2017-00225 (filed by Apple Inc.), in which we instituted *inter partes* review on May 25, 2016. Pet. 75–77; Paper 6. Petitioner additionally filed a Petition and Motion seeking joinder with IPR2017-00225, both which were granted, and, thus, Petitioner has been joined with Apple in IPR2017-00225. *See* Case IPR2017-01634, Paper 10 (PTAB Oct. 3, 2017).

We note that the deadline for issuing the Final Written Decision in IPR2017-00225 is May 25, 2018. Because Petitioner here is joined as a petitioner in IPR2017-00225 (concerning claims 1–6 and 8 of the ’433 patent), Petitioner’s involvement in both *inter partes* reviews would raise the issue of estoppel under 35 U.S.C. § 315(e)(1), which states that “petitioner in an inter partes review of a claim in a patent under this chapter

that results in a final written decision under section 318(a) . . . may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” To ascertain the impact, if any, of § 315(e)(1) to the instant proceeding, the parties to this proceeding shall brief the issue with simultaneous briefing, of no more than 5 pages, due on DUE DATE 6 of IPR2017-00225, currently set for January 25, 2018. This briefing is necessary to determine the proper course of conduct in this proceeding. 37 C.F.R. § 42.5(a).

*B. 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.

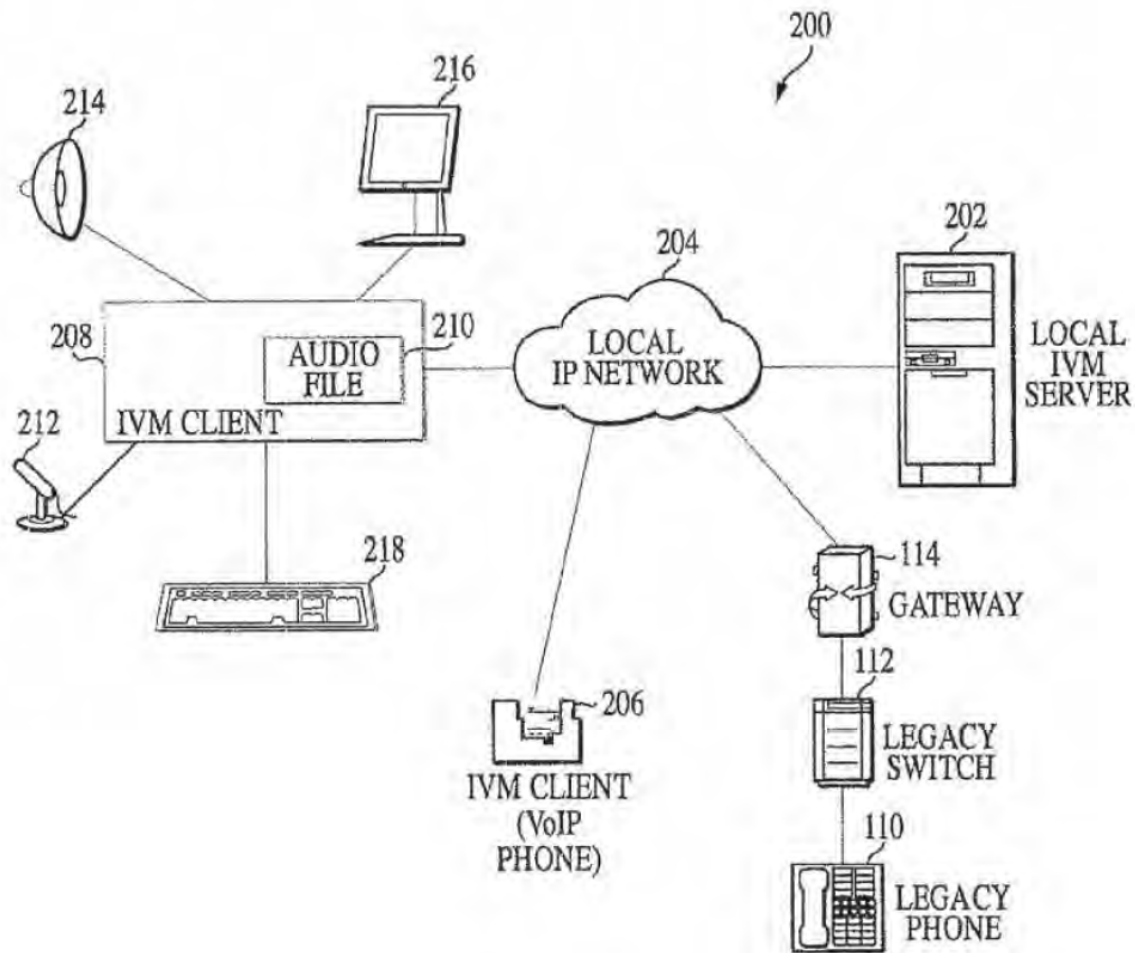


FIG. 2

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

8:12–15. “Once the recording of the user’s speech is finalized, IVM client 208 generates a send signal indicating that the digitized audio file 210 (instant voice message) is ready to be sent to the selected recipients.” *Id.* at 8:19–22. The IVM client transmits the digitized audio file to the local IVM server, which, thereafter, delivers that transmitted instant voice message to the selected recipients via the local IP network. *Id.* at 8:25–26. Only the available IVM recipients, currently connected to the IVM server, will receive the instant voice message. *Id.* at 8:36–38. If a recipient “is not currently connected to the local IVM server 202,” the IVM server temporarily saves the instant voice message and delivers it to the IVM client when the IVM client connects to the local IVM server (i.e., is available). *Id.* at 8:38–43.

The ’433 patent also describes an “intercom mode” of voice messaging. *Id.* at 11:34–37. The specification states that the “intercom mode” represents real-time instant voice messaging. *Id.* at 11:37–38. In this mode, instead of creating an audio file, one or more buffers of a predetermined size are generated in the IVM clients or local IVM servers. *Id.* at 11:38–41. Successive portions of the instant voice message are written to the one or more buffers, which as they fill, automatically transmit their content to the IVM server for transmission to the one or more IVM recipients. *Id.* at 11:41–46. Buffering is repeated until the entire instant voice message has been transmitted to the IVM server. *Id.* at 11:46–59.

*C. Independent Claims*

Of the challenged claims, claim 1 and 6 are independent and are reproduced below. Each of claims 2–5, 7, and 8 depends directly or indirectly from claim 1.

1. A system comprising:

an instant voice messaging application including a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over a packet-switched network via a network interface;

wherein the instant voice messaging application displays a list of one or more potential recipients for the instant voice message;

wherein the instant voice messaging application includes a message database storing the instant voice message, wherein the instant voice message is represented by a database record including a unique identifier; and

wherein the instant voice messaging application includes a file manager system performing at least one of storing, deleting and retrieving the instant voice messages from the message database in response to a user request.

6. A system comprising:

an instant voice messaging application including a client platform system for generating an instant voice message and a messaging system for transmitting the instant voice message over a packet-switched network via a network interface;

wherein the instant voice messaging application displays a list of one or more potential recipients for the instant voice message;

wherein the instant voice messaging application includes a file manager system performing at least one of storing, deleting

and retrieving the instant voice messages from a message database in response to a user request; and

wherein the instant voice messaging application includes a compression/decompression system for compressing the instant voice messages to be transmitted over the packet-switched network and decompressing the instant voice messages received over the packet-switched network.

Ex. 1001, 23:65–24:15, 24:33–51.

*D. Asserted Prior Art and Grounds of Unpatentability*

This proceeding relies on the following prior art references:

- a) *Zydney*: PCT App. Pub. No. WO 01/11824 A2, published Feb. 15, 2001, filed in the record as Exhibit 1003 (with line numbers added by Petitioner);
- b) *Appelman*: U.S. Patent No. US 6,750,881 B1, issued June 15, 2004, filed in the record as Exhibit 1004; and
- c) *Clark*: U.S. Patent No. US 6,725,228 B1, issued Apr. 20, 2004, filed in the record as Exhibit 1008.

Petitioner asserts two grounds of unpatentability (Pet. 4):

Challenged Claim(s)	Basis	References
1–6, 8	§ 103(a)	Zydney and Clark
7	§ 103(a)	Zydney, Clark, and Appelman

Petitioner also relies on a Declaration of Tal Lavian, Ph.D., filed as Exhibit 1002.

## II. DISCUSSION

### A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim interpretation standard to be applied in *inter partes* reviews). Under the broadest reasonable interpretation standard, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). We note that only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Petitioner proposes constructions for the terms “instant voice messaging application” and “client platform system.” Pet. 9–15. Patent Owner points out alleged deficiencies in Petitioner’s proposed constructions, but argues that “neither term requires any contrived construction.” Prelim. Resp. 6–11. For purposes of determining whether to institute review, we need not construe expressly any term at this time.



*B. Overview of Asserted Prior Art*

We discuss more fully certain disclosures in the asserted references in our analysis below. A discussion of those references follows.

1. Zydney

Zydney, titled “Method and System for Voice Exchange and Voice Distribution,” relates to packet communication systems that provide for voice exchange and voice distribution between users of computer networks. Ex. 1003, [54], [57], 1:4–5. While acknowledging that e-mail and instant messaging systems were well-known text-based communication systems utilized by users of on-line services and that it was possible to attach files for the transfer of non-text formats via those systems, Zydney states that the latter technique “lack[ed] a method for convenient recording, storing, exchanging, responding and listening to voices between one or more parties, independent of whether or not they are logged in to their network.” *Id.* at 1:7–17. Zydney thus describes a method in which “voice containers”—i.e., “container object[s] that . . . contain[] voice data or voice data and voice data properties”—can be “stored, transcoded and routed to the appropriate recipients instantaneously or stored for later delivery.” *Id.* at 1:19–22; 12:6–8. Figure 1 of Zydney is reproduced below.

FIG. 1

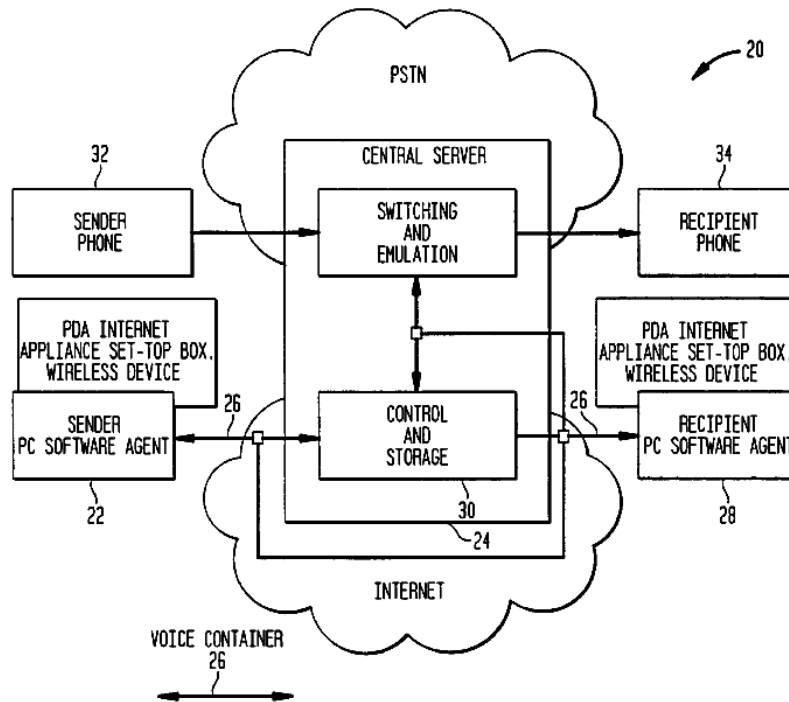


Figure 1, above, illustrates a high level functional block diagram of Zydney's system for voice exchange and voice distribution. *Id.* at 10:19–20. Referring to Figure 1, system 20 allows software agent 22, with a user interface, in conjunction with central server 24 to send messages using voice containers illustrated by transmission line 26 to another software agent 28, as well as to receive and store such messages, in a “pack and send” mode of operation. *Id.* at 10:20–11:1. Zydney explains that a pack and send mode of operation “is one in which the message is first acquired, compressed and then stored in a voice container 26 which is then sent to its destination(s).” *Id.* at 11:1–3. The system has the ability to store messages both locally and centrally at server 24 whenever the recipient is not available for a prescribed period of time. *Id.* at 11:3–6.

In the use of Zydney's system and method, the message originator selects one or more intended recipients from a list of names that have been previously entered into the software agent. *Id.* at 14:17–19. The agent permits distinct modes of communication based on the status of the recipient, including the “core states” of whether the recipient is online or offline and “related status information” such as whether the recipient does not want to be disturbed. *Id.* at 14:19–15:1. Considering the core states, the software agent offers the originator alternative ways to communicate with the recipient, the choice of which can be either dictated by the originator or automatically selected by the software agent, according to stored rules. *Id.* at 15:3–6. If the recipient is online, the originator can either begin a real-time “intercom” call, which simulates a telephone call, or a voice instant messaging session, which allows for an interruptible conversation. *Id.* at 15:8–10. If the recipient is offline, the originator can either begin a voice mail conversation that will be delivered the next time the recipient logs in or can be delivered to the recipient's e-mail as a digitally encoded Multipurpose Internet Mail Extension (“MIME”) attachment. *Id.* at 15:15–17. Zydney explains that the choice of the online modes “depends on the activities of both parties, the intended length of conversation and the quality of the communication path between the two individuals, which is generally not controlled by either party,” and that the choice of the offline delivery options “is based on the interests of both parties and whether the recipient is sufficiently mobile that access to the registered computer is not always available.” *Id.* at 15:10–14, 15:17–19.

Once the delivery mode has been selected, the originator digitally records messages for one or more recipients using a microphone-equipped

device and the software agent. *Id.* at 16:1–3. The software agent compresses the voice and stores the file temporarily on the PC if the voice will be delivered as an entire message. *Id.* at 16:3–4. If the real-time “intercom” mode has been invoked, a small portion of the digitized voice is stored to account for the requirements of the Internet protocols for retransmission and then transmitted before the entire conversation has been completed. *Id.* at 16:4–7. Based on status information received from the central server, the agent then decides on whether to transport the voice containers to a central file system and/or sends it directly to another software agent using the IP address previously stored in the software agent. *Id.* at 16:7–10. If the intended recipient has a compatible active software agent on line after log on, the central server downloads the voice recording almost immediately to the recipient. *Id.* at 16:10–12. The voice is uncompressed and the recipient can hear the recording through the speakers or headset attached to its computer. *Id.* at 16:12–14. The recipient can reply in a complementary way, allowing for near real-time communications. *Id.* at 16:14–15. If the recipient’s software agent is not on line, the voice recording is stored in the central server until the recipient’s software agent is active. *Id.* at 16:15–17. In both cases, the user is automatically notified of available messages once the voice recordings have been downloaded to storage on their computer. *Id.* at 16:17–19. The central server coordinates with software agents on all computers continuously, updating addresses, uploading and downloading files, and selectively retaining voice recordings in central storage. *Id.* at 16:19–21.

Zydney discloses that the voice container also has the ability to have other data types attached to it. *Id.* at 19:6–7. Formatting the container using

MIME format, for example, “allows non-textual messages and multipart message bodies attachments [sic] to be specified in the message headers.” *Id.* at 19:7–10.

Figure 3 of Zydney is reproduced below.

**FIG. 3**

302	ORIGINATOR'S CODE
304	ONE OR MORE RECIPIENT'S CODE
306	ORIGINATING TIME
308	DELIVERY TIME(S)
310	NUMBER OF "PLAYS"
312	VOICE CONTAINER SOURCE
	PC
	TELEPHONE AGENT
	NON-PC BASED APPLIANCE
314	VOICE CONTAINER REUSE RESTRICTIONS
316	ONE TIME AND DESTROY
318	NO FORWARD
320	PASSWORD RETRIEVAL
322	DELIVERY PRIORITY
324	SESSION VALUES
326	SESSION NUMBER
328	SEQUENCE NUMBER FOR PARTITIONED SEQUENCES
330	REPEATING INFORMATION
334	NO AUTOMATIC REPEAT
336	REPEAT TIMES
338	REPEAT SCHEDULE

Figure 3, above, illustrates an exemplary embodiment of Zydney's voice container structure, including voice data and voice data properties components. *Id.* at 2:19, 23:1–2. Referring to Figure 3, voice container components include:

[O]riginator's code 302 (which is a unique identifier), one or more recipient's code 304, originating time 306, delivery time(s) 308, number of “plays” 310, voice container source 312 which may be a PC, telephone agent, non-PC based appliance, or other, voice container reuse restrictions 314 which may include one time and destroy 316, no forward 318, password

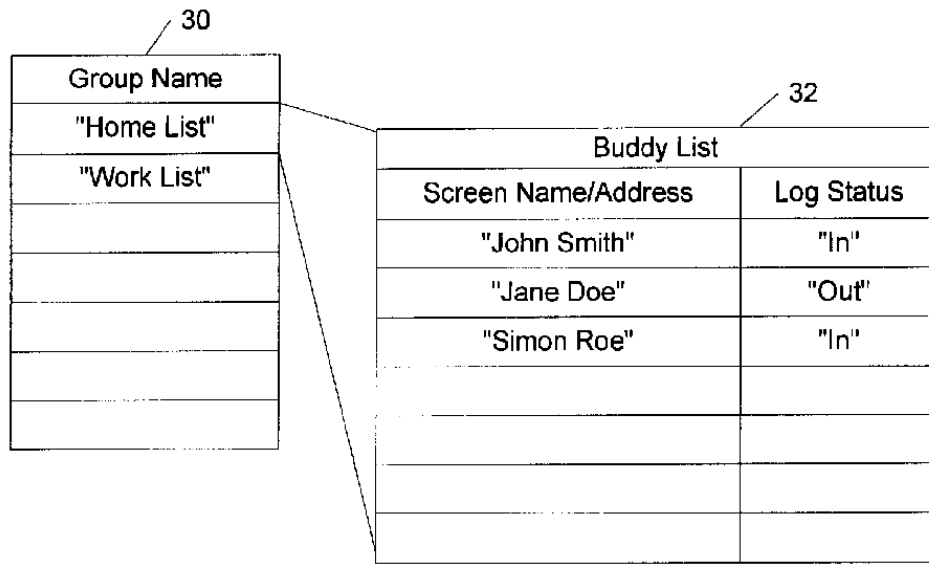
retrieval 320, delivery priority 322, session values 324, session number 326, sequence number for partitioned sequences[] 328, repeating information 330, no automatic repeat 332, repeat times 334, and a repeat schedule 336.

*Id.* at 23:2–10.

## 2. Appelman

Appelman, titled “User Definable On-line Co-user Lists,” describes a real-time notification system that enables a user to define “buddy lists” to track co-users of an online or network system. Ex. 1004, [54], [57]. The system tracks for the user the log-on status of the co-users and displays that information in real time to the tracking user in a graphical interface. *Id.* at [57]. When the user logs on to a system, the user’s set of buddy lists is presented to a buddy list system, which attempts to match co-users currently logged into the system with the entries on the user’s buddy list, and any matches are displayed to the user. *Id.* As co-users log on and log off, the user’s buddy list is updated to reflect the changes. *Id.*

Figure 2a of Appelman is reproduced below.



**FIG. 2a**

Figure 2a, above, illustrates “a set of symbolic data records showing the basic types of data used by one embodiment of [Appelman’s] invention for a buddy list[] and the conceptual relationship of data elements.” *Id.* at 2:15–18. With reference to Figure 2a, Group Name table 30 stores user-defined group names for buddy lists. *Id.* at 3:36–37. Each user may define multiple buddy lists by group names. *Id.* at 3:38. Two buddy lists, “Home List” and “Work List,” are shown in Group Name table 30. *Id.* at 3:39. Each group name in Group Name table 30 has an associated Buddy List table 32, comprising multiple records that each correspond to a co-user (or “buddy”) that the user wishes to track. *Id.* at 3:39–43. Each record may include data elements for the screen name (or address, such as an Internet address) of a particular co-user to be tracked, and the logon status of that user (e.g., codes for “In” or “Out”). *Id.* at 3:43–47.

Figure 11 of Appelman is reproduced below.

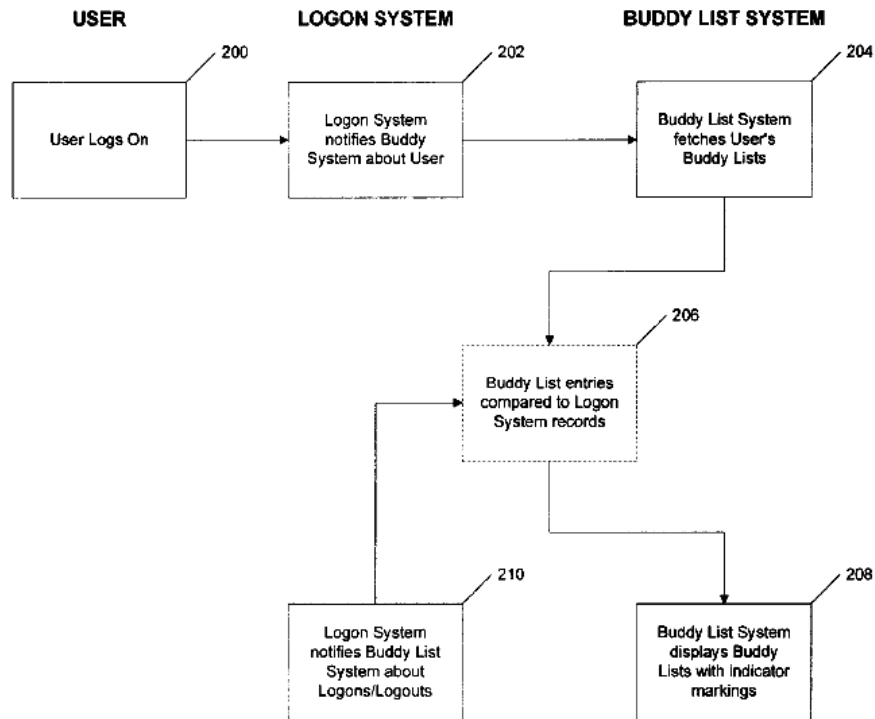


FIG. 11

Figure 11, above, is a flowchart showing an implementation of Appelman's invention. *Id.* at 2:41–42. In the illustrated implementation, a user logs into a Logon System (Step 200), which notifies the Buddy List System about the User (i.e., passes the User's ID, address, or screen name to the Buddy List System) (Step 202). *Id.* at 6:53–58. The Buddy List System accesses the user's buddy lists from a database, which may be, for example, on the user's own station (Step 204). *Id.* at 6:58–60. The entries in the user's buddy lists then are compared to the records of the Logon System (Step 206). *Id.* at 6:60–62. Appelman explains that this step is shown in dotted outline to indicate that the comparison can be done by passing records from the Logon System to the Buddy List System, or vice versa, or could be done by a separate system. *Id.* at 6:62–65. The Buddy List System then displays a buddy list window showing the status (i.e., logged in or not) of the co-users



on the user's buddy lists with any of various indicator markings (Step 208). *Id.* at 6:66–7:2. Thereafter, while the user's buddy list window is open, the Logon System notifies the Buddy List System about new logons/logoffs of co-users (Step 210), causing a new compare of the user's buddy list entries to the Logon System records (Step 206). *Id.* at 7:3–7. Appelman explains that the Logon System may, for example, maintain a copy of a user's buddy lists and notify the Buddy List System only upon a logon status change for a co-user on the user's buddy lists. *Id.* at 7:8–11. The Buddy List System then updates the indicated status of the displayed co-users (Step 208). *Id.* at 7:11–12.

### 3. Clark

Clark, titled “System for Managing and Organizing Stored Electronic Messages,” is directed to systems for managing and organizing electronic messages. Ex. 1008, [54], 1:8–9. According to Clark,

A computer-based system catalogs and retrieves electronic messages saved in a message store. The system automatically organizes each saved message into multiple folders based on the contents and attributes of the message, and implements improved methods for manually organizing messages.

*Id.* at [57]. A particularly relevant embodiment in Clark is shown in Figure 4A, reproduced below.

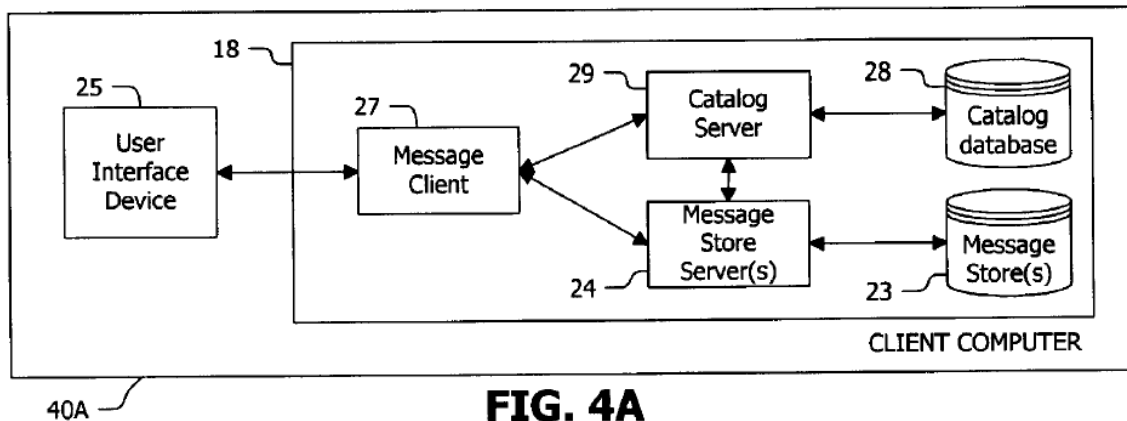
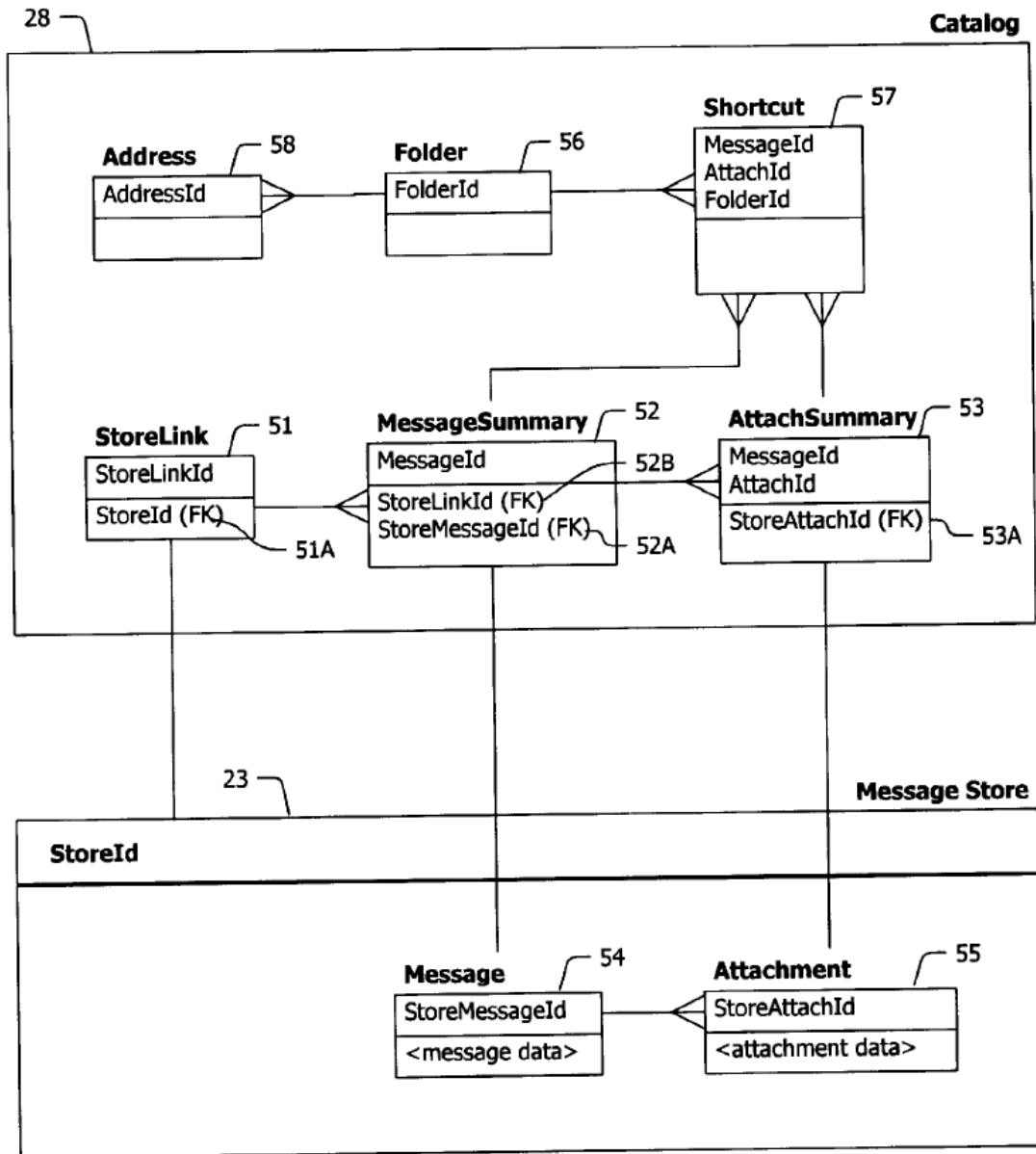


Figure 4A illustrates system 40A with client computer 18 implementing catalog server 29 and catalog database 28, and also including message client 27, message store 23, and message store server 24. *Id.* at 10:29–33. Each message store 23 comprises a memory, file, or database structure that provides temporary or permanent storage for the contained messages. *Id.* at 9:13–16. Clark describes the invention as providing catalog database 28 (and preferably catalog server 29) to organize the contents of one or more message stores 23. *Id.* at 9:54–57. Catalog database 28 and message store 23 may be separate from one another or may be integrated in a single integrated message store. *Id.* at 11:1–3. In the embodiment where they are separate from each other, illustrated in Figure 5A (reproduced below), catalog database 28 may be linked to a separate external message store 23. *Id.* at 11:3–7.



**FIG. 5A**

Figure 5A depicts the linking between catalog database 28 and external message store 23, where StoreLink table 51 contains rows, each with a StoreID pointing to a linked message store 23, and catalog database 28 includes MessageSummary table 52, which contains StoreMessageId 52A of messages in message store 23. *Id.* at 11:25–33. The Figure 5A embodiment

also shows that messages 22 are stored in Message table 54 in message store 23 and that attachments are stored in Attachment table 55 in message store 23. *Id.* at 35–37.

### *C. Analysis of Petitioner’s Contentions*

Petitioner points to Zydney as disclosing all the claim 1 limitations, except that it relies on Clark’s disclosure of a message store as disclosing the claimed message database and file manager system. Pet. 28–55. Claim 6 is similar in scope to claim 1 but, unlike claim 1, does not recite that the “instant voice message is represented by a database record including a unique identifier.”

#### 1. Claim 1

Petitioner maps the “instant voice messaging application” to the software agent running on a client computer of the sending user. Pet. 29. For the “client platform system” and “messaging system,” Petitioner relies on Zydney’s disclosure of the software agent function of recording a voice container and transport process. *Id.* at 30–34. For the “display [of] a list of one or more potential recipients,” Petitioner points to Zydney’s disclosure, in Figure 7, of the originator selecting “one or more recipients from a list maintained by the originator and presented visually by the agent.” *Id.* at 39 (emphases in Petition omitted).

Claim 1 recites, in part, “wherein the instant voice messaging application includes a *message database* storing the instant voice message, wherein the instant voice message is represented by a *database record* including a *unique identifier*.” Ex. 1001, 24:7–10 (emphases added). Petitioner points to Zydney as disclosing a message database because it

describes “saving, deleting or resending recorded containers from the recipient’s computer” and storing messages locally. Pet. 40–42. Petitioner argues that “Zydney does not use the term ‘message database’ to describe storage of instant voice messages on the client system, but the storage in Zydney meets the claim under its broadest reasonable construction.” *Id.* at 42 (emphasis in original omitted). We do not agree with these contentions. The claim recites the “message database” as being included in an “instant voice messaging application.” Thus, we look for Zydney’s disclosure of a database included in the software agent of a sender (the alleged “instant voice message application, *see id.* at 29). None of the “storing” disclosures identified by Petitioner disclose a database, much less one that is included in the software agent. Accordingly, we are not persuaded by Petitioner’s argument that Zydney alone would disclose the recited “message database.”

In the alternative, Petitioner argues that the limitation would have been obvious in view of Clark. *Id.* at 42. Petitioner argues that Clark’s message store 23 discloses a message database and that Clark’s StorageMessageId is the recited “unique identifier.” *Id.* at 43. Petitioner points out that the unique identifier represents the “underlying stored message and can be used to retrieve it,” relying on the following disclosure of Clark: “Using the StoreMessageId 52A and the related StoreId 51A, catalog server 29 can make requests to the message store server 24 to read messages from message store 23.” *Id.* at 49 (citing Ex. 1008, 11:38–40). Patent Owner challenges Petitioner’s assertions as failing to show “that a single database record in Clark includes both a unique identifier and an instant voice message,” because Clark discloses that the MessageSummary table and the Message table are in separate data stores. Prelim. Resp. 14.

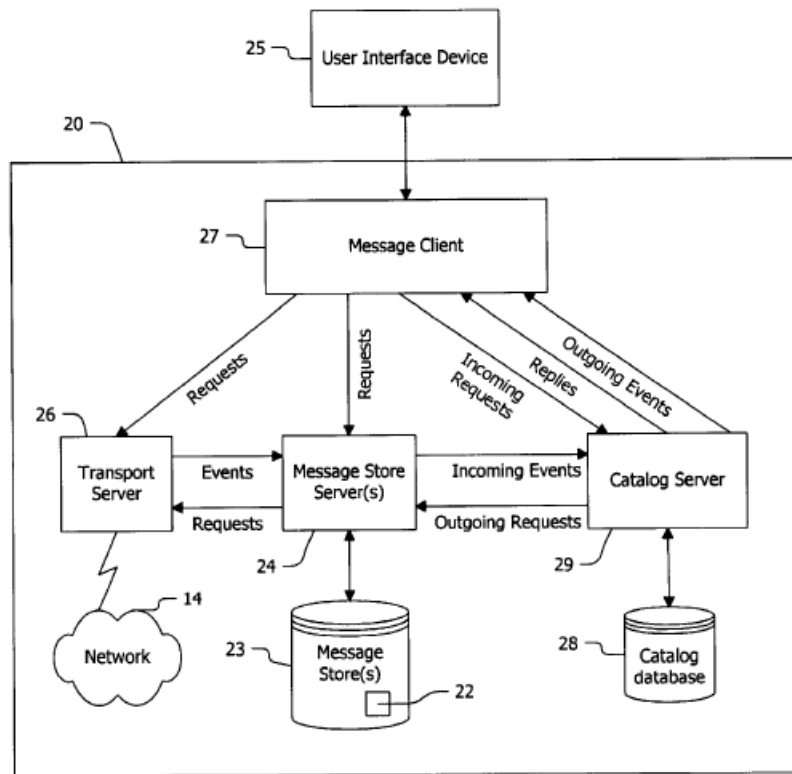
Patent Owner also argues that although the catalog database and message store may be combined, as shown in Figure 5B of Clark, none of the tables shown in Figure 5B of Clark includes the StoreMessageID, which Petitioner maps to the unique identifier. *Id.* at 14–15. Further, based on Clark’s disclosures that the message is stored in a message store while the StoreMessageID is stored at the catalog, Patent Owner argues that Clark teaches away from including the message data in the same database record as the unique identifier. *Id.* at 16–17.

Patent Owner’s arguments are not persuasive at this time to rebut Petitioner’s showing. Patent Owner’s arguments are premised on an interpretation of the claim language requiring that: (1) the instant voice message is stored in the recited database record; and (2) the message database includes the database record. Neither requirement is expressly recited in the claim language. And the record at this juncture is devoid of briefing of the parties’ claim construction positions for this phrase, such that we could determine, even preliminarily, that the scope of claim 1 includes these two alleged requirements. Accordingly, guided by the plain reading of the claim language, we do not agree with Patent Owner that Petitioner has failed to proffer institution-sufficient evidence that Clark discloses the recited “message database” and the “database record including a unique identifier.”

With regard to the motivation to combine, Patent Owner argues that Petitioner’s proposed combination would result in inoperability and teaching away from the claimed invention. *Id.* at 18–19. In particular, Patent Owner argues that because Zydney teaches deleting the sent instant voice message from the client’s temporary storage, any combination with Clark would

result in Clark deleting the messages from the client, thereby running counter to Clark's stated goal of cataloging electronic messages. *Id.* We are not persuaded by this argument on the present record. We understand the Petition to combine the teachings of Clark's message store for the purpose that Clark gives for such use: to catalog and retrieve messages saved in a message store. Ex. 1008, [57]. Although Zydney deletes the sent message from the temporary storage, Patent Owner does not show any disclosure in Zydney that would teach away from seeking and achieving the use and purpose of Clark's message store. The disclosure in Zydney of a "reserved temporary storage" does not teach away from using a different storage altogether (a message store) or from the purposes disclosed in Clark for storing and cataloging messages on a more persistent basis.

Claim 1 further requires that the instant voice message application includes a "file manager system performing at least one of storing, deleting and retrieving the instant voice message from the message database in response to a user request." Ex. 1001, 24:11–15. For this limitation, Petitioner relies on various disclosures of Zydney and Clark as disclosing the limitation. Pet. 50–55. More particularly, Petitioner argues that Clark discloses a "message database system for storing and organizing both sent and received messages, which can be instant voice messages." *Id.* at 52. Petitioner cites Clark: "Message client 27 will typically generate requests in response to user input such as requests to message store sever 24 to add, change or delete a message." *Id.* (citing Ex. 1008, 18:25–29). This citation pertains to the embodiment shown in Figure 2 of Clark, reproduced below.



**FIG. 2**

Figure 2 of Clark depicts system 20 comprising several software components which operate in a computer system. Ex. 1008, 9:7–10. Clark states that “[e]ach message store 23 comprises a memory, file or database structure that provides temporary or permanent storage for the contained messages 22.” *Id.* at 9:13–15. Further, “[a] message store server 24 manages the messages 22 in message store 23.” *Id.* at 9:15–16. Concerning the implementation of the database, Clark states it uses shortcuts and folders to handle the stored messages. *Id.* at 8:57–9:5 (cited substantially in the Petition at pages 52–53). Dr. Lavian opines that a person of ordinary skill in the art would have understood that when a user selects and views a message stored in the database, the system is retrieving the message from message store 23. *See* Pet. 53 (citing Ex. 1002 ¶ 227). Petitioner proffers various



reasons for combining the relevant teachings of Zydney and Clark.

Pet. 44–48, 54–55.

Patent Owner challenges Petitioner’s assertions regarding the “file manager system” because Petitioner relies on certain operations that Zydney performs at the receiving device, not the sending device. Prelim.

Resp. 21–22. And regarding Petitioner’s reliance on Zydney’s “sending” operations, Patent Owner contends those operations are described to take place in a temporary storage, not a database. *Id.* at 22–23. These arguments are not persuasive because we have focused our institution determination on the Petition’s arguments regarding Clark, not Zydney, for this limitation.

As for Petitioner’s reliance on Clark’s disclosures, Patent Owner argues that Clark describes requests being passed from component to component, but that none of those requests is a “user request,” and neither of the components between which the requests are passed is the “message store 23” that Petitioner alleges to be the claimed message database. *Id.* at 25. Patent Owner also argues that the claim requires multiple messages and disputes Petitioner’s obviousness showing in this regard. *Id.* at 25–26.<sup>1</sup> None of Patent Owner’s arguments are persuasive at this juncture. As stated above, we understand Petitioner’s argument to rely on teachings of Clark storing *sent and received* messages in the message store. Pet. 52. Further,

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<sup>1</sup> At this juncture, the argument presented in the Preliminary Response, at pages 25–26, concerning “plural” instant voice messages is underdeveloped and does not provide sufficient reasoning for the deficiencies that are alleged to preclude institution. *See* 35 U.S.C. § 313 (“a preliminary response . . . that sets forth reasons why no inter partes review should be instituted based upon the failure of the petition to meet any requirement under this chapter”). Accordingly, we do not discuss this argument further.

we note that claim 6 does not require any particular location for the “message database,” and, therefore, Clark’s message store need not be located strictly at the sending device as Patent Owner argues. Nevertheless, because Clark stores *sent* messages in the message store, we understand Petitioner to have mapped the claims to a *sending* device retrieving the stored messages. Finally, Petitioner has shown that Clark contemplates operations of adding and deleting a message at the request of a user. Pet. 52 (citing Ex. 1008, 18:25–29). Accordingly, Patent Owner’s arguments that Clark only shows component-to-component requests, and not “user requests,” is unpersuasive.

Finally, Patent Owner raises what appears to be a claim construction issue weaved into the arguments in its brief that contest the merits of Petitioner’s obviousness showing. Prelim. Resp. 19–20. Whether the “instant voice messaging application” and “client platform system” would encompass software alone or software and hardware is an issue of claim construction that is best resolved on a full record. However, even if we agreed with Patent Owner at this juncture that these limitations are only software, the outcome of our decision would not change, as Petitioner maps these limitations, at a minimum, to components of Zydney’s software agent.

Having reviewed the information presented by the parties at this juncture, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claim 1 is unpatentable over Zydney and Clark.

## 2. Claim 6

Petitioner relies on the arguments and evidence it makes for claim 1. Pet. 60–63. Claim 6 further recites a “compression/decompression system,”

for which Petitioner relies on Zydney's disclosure, in Figure 1A, of each software agent employing a "voice/compression software detector," and other disclosures that show compression and decompression of the voice message. *Id.* at 62–63. We note, as stated above, that claim 6 does not recite the limitation of a "unique identifier" and also does not require the "message database" to be included in the "instant voice message application." Patent Owner does not argue claim 6 separately from claim 1. For the same reasons as stated regarding claim 1, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claim 6 is unpatentable over Zydney and Clark.

### 3. Dependent Claims

The Petition sets forth contentions that the proffered combination of Zydney and Clark would have rendered obvious dependent claims 2–5 and 8. Pet. 55–63. With respect to claim 7, Petitioner relies on Appelman's disclosure of a Buddy List. *Id.* at 64–70. Patent Owner disputes Petitioner's evidence only for claims 7 and 8. Patent Owner's arguments are not persuasive at this juncture as discussed below.

With respect to claim 7, Patent Owner argues that claim 7 requires indication that some of the potential recipients of the instant voice messages are unavailable. Prelim. Resp. 26–27. Appelman, according to Patent Owner, only displays online buddies that are available, and offline buddies cannot be recipients of the instant voice messages. *Id.* Even if we accept Patent Owner's reading of Appelman, all of Patent Owner's arguments are premised on Patent Owner's interpretation of claim 7 as requiring the indication of the possibility that some of the intended recipients would be unavailable. Claim 7 recites, however, that the indicia indicates "whether

the potential recipient is currently available to receive an instant voice message.” From the plain reading of this claim, at this juncture, a showing that the Buddy List displays recipients available to receive a message reasonably meets the claim under the institution threshold. Arguments that the Buddy List does not (or would not) display offline recipients appear, at this juncture, to not be commensurate with the claim scope. Patent Owner will have an opportunity to develop further its claim construction position regarding claim 7 during trial.

Concerning claim 8, Patent Owner argues that Zydney does not meet the recited limitation by “merely displaying a list of potential recipients” because a user is not alerted immediately (or near immediately). *Id.* at 33–34. Claim 8 recites “wherein the instant voice message application generates an audible or visual effect indicating receipt of an instant voice message.” Ex. 1001, 24:57–59. Petitioner relies on Zydney disclosing “a visual effect because it indicates to the recipient that an instant voice message has been received.” Pet. 63. Zydney, Petitioner states, discloses “presenting the list of voice containers.” *Id.* (citing Ex. 1003 (Zydney), Fig. 9). Patent Owner’s arguments are premised on its interpretation of the claim language as requiring an immediate alert. Claim 8, however, is silent regarding the timing of the audible or visual effect. Accordingly, Patent Owner’s argument that a visual display of received messages is not a “visual effect,” because the display is not an immediate alert, is an argument not commensurate with the scope of claim 8. Patent Owner will have an opportunity to develop further its claim construction position regarding claim 8 during trial.

Having reviewed the information presented by the parties regarding the challenged dependent claims, we determine that Petitioner has demonstrated a reasonable likelihood that it will prevail in establishing that claims 1–8 are unpatentable under the grounds presented in the Petition.

### III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is instituted for claim 1–8 of the '433 patent under the grounds of obviousness listed below;

Challenged Claim(s)	Basis	Reference(s)
1–6, 8	§ 103(a)	Zydney and Clark
7	§ 103(a)	Zydney, Clark, and Appelman

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '433 patent is hereby instituted with trial commencing on the entry date of this decision, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of review; and

FURTHER ORDERED that the parties to this proceeding shall brief the applicability, if any, of 35 U.S.C. § 315(e)(1), with simultaneous briefing, of no more than 5 pages, due on DUE DATE 6 of IPR2017-00225, currently set for January 25, 2018.

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Patent 8,995,433 B2

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