

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC.,
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
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*.

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

I. INTRODUCTION

Samsung Electronics America, Inc. (Petitioner or “Samsung”) filed a Petition requesting *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”). Paper 1 (“Pet.”). Uniloc Luxembourg S.A. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“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 1–5, 7–12, 14–17, 25, and 26 of the ’433 patent.

A. *Related Matters*

The parties indicate that the ’433 patent is involved in a multitude of 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 (*id.*), and is the subject of Case IPR2017-00225 (filed by Apple Inc.), which we instituted on May 25, 2017.

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.

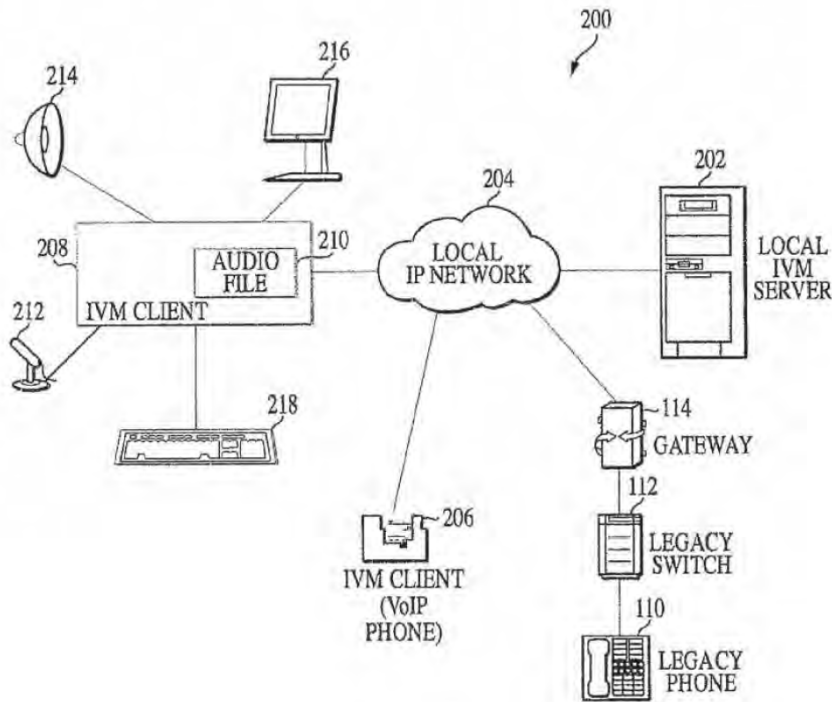


FIG. 2

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 7:53–56. 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 8:25–33. “[O]nly 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 (i.e., is unavailable), 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 202 (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. The content of each buffer is, as it fills, automatically transmitted to the IVM server for transmission to the one or more IVM recipients. *Id.* Buffering is repeated until the entire instant voice message has been transmitted to the IVM server. *Id.* at 11:46–59.

C. Illustrative Claim

Of the challenged claims, claim 1, 6, and 9 are independent and claim 1 is illustrative of the subject matter.

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.

Ex. 1001, 23:65–24:14.

D. Asserted Prior Art and Grounds of Unpatentability

This proceeding relies on the following prior art references:

- a) *Griffin*: U.S. Patent No. 8,150,922 B2, issued April 3, 2012, filed in the record as Exhibit 1005;
- b) *Zydney*: PCT App. Pub. No. WO 01/11824 A2, published February 15, 2001, filed in the record as Exhibit 1006;
- c) *Clark*: U.S. Patent No. US 6,725,228 B1, issued April 20, 2004, filed in the record as Exhibit 1007;
- d) *Väänänen*: PCT App. Pub. No. WO 02/17650 A1, published February, 28, 2002, filed in the record as Exhibit 1008;

e) *Lee*: U.S. Patent Application Pub. No. US 2002/0101848 A1,
published on August, 1, 2002, filed in the record as Exhibit 1014;
and

f) *Vuori*: U.S. Patent Application Pub. No. US 2002/0146097 A1,
published on October 10, 2002, filed in the record as Exhibit 1015.

Petitioner asserts seven grounds of unpatentability as follows (Pet.
6–7):

| Challenged Claim(s) | Basis | References |
|--------------------------------|--------------|-------------------------------|
| 1–3, 8 | § 103(a) | Griffin and Clark |
| 4 and 7 | § 103(a) | Griffin, Clark, and Zydney |
| 5 | § 103(a) | Griffin, Clark, and Väänänen |
| 9, 11, 14–17, 25, and 26 | § 103(a) | Griffin and Zydney |
| 12 | § 103(a) | Griffin, Zydney, and Väänänen |
| 10 | § 103(a) | Griffin, Zydney, and Lee |
| 26 | § 103(a) | Griffin, Zydney and Vuori |

Petitioner also relies on a Declaration of Dr. Zygmunt J. Haas.
Ex. 1002 (“Haas Declaration”).

II. DISCUSSION

E. *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 an *inter partes* review proceeding). 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 asserts that “the Board need not construe the challenged claims to resolve the underlying controversy.” Pet. 9–10. Patent Owner does not challenge this assertion. We agree that for purposes of determining whether to institute review, we need not construe expressly any term at this time.

F. *Overview of Asserted Prior Art*

We discuss more fully certain disclosures in the asserted references in our analysis below.

1. Griffin

Griffin, titled “Voice and Text Group Chat Display Management Techniques for Wireless Mobile Terminals,” relates to a technique of managing the display of “real-time speech and text conversations (e.g., chat threads) on limited display areas.” Ex. 1005, [54], 1:9–11. Griffin discloses a wireless mobile terminal as shown in Figure 1, reproduced below.

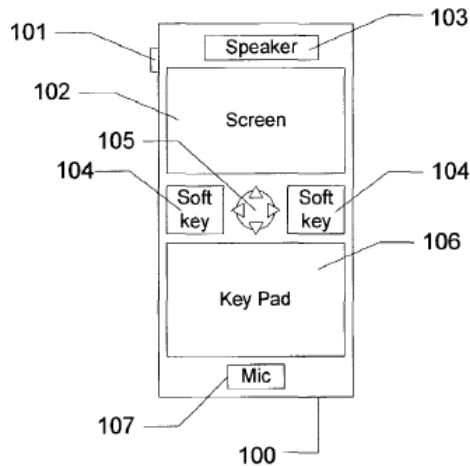


FIG. 1

Figure 1, above, depicts mobile terminal 100 comprising speaker 103 (which renders signals, such as received speech, audible), display 102 (for rendering text and graphical elements visible), navigation rocker 105 (which allows a user to navigate a list or menu displayed on the screen), microphone 107 (for capturing the user’s speech), and push-to-talk button 101 (which allows the user to initiate recording and transmission of audio). *Id.* at 3:14–30. Griffin also describes, in connection with Figure 2, reproduced below, the overall system architecture of a wireless communication system where the mobile terminals communicate with a chat server complex. *Id.* at 3:49–51.

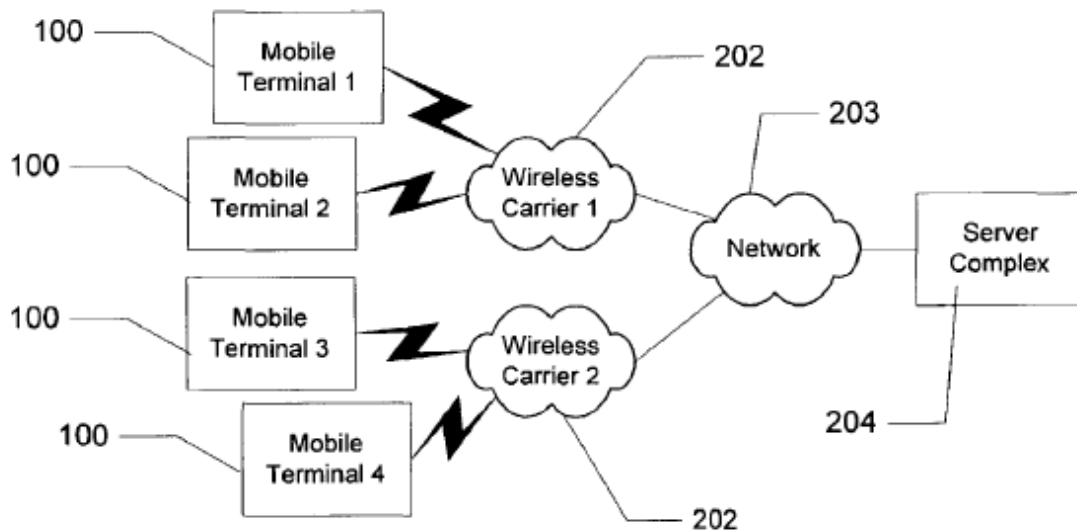


FIG. 2

Figure 2, above, illustrates wireless carrier infrastructures 202, which support wireless communications with mobile terminals 100, such that the mobile terminals wirelessly transmit data to a corresponding infrastructure 202 for sending the data packets to communication network 203, which forwards the packets to chat server complex 204. *Id.* at 3:49–61.

Communication network 203 is described as a “packet-based network, [which] may comprise a public network such as the Internet or World Wide Web, a private network such as a corporate intranet, or some combination of public and private network elements.” *Id.* at 3:61–65.

Griffin’s chat server complex 204 receives encoded data comprising text, speech, and/or graphical messages (or some combination thereof), when a plurality of users chat together (i.e, send chat messages from one terminal 100 to another). *Id.* at 4:11–15, 4:62–65. An outbound chat message, for example, is decomposed to locate the list of recipients, and the recipient’s current status is determined. *Id.* at 5:9–15. Griffin describes

presence status 702 as “an indicator of whether the recipient is ready to receive the particular type of message, speech and/or text messages only, etc.).” *Id.* “When presence status 702 changes, the presence manager 302 [of server complex 204] sends a buddy list update message 600 to all the subscribers listed in the subscriber identifier field 706 of the corresponding presence record 700.” *Id.* at 5:27–30.

Griffin provides a buddy list display illustrated in Figure 9, reproduced below. *Id.* at 8:15–16.

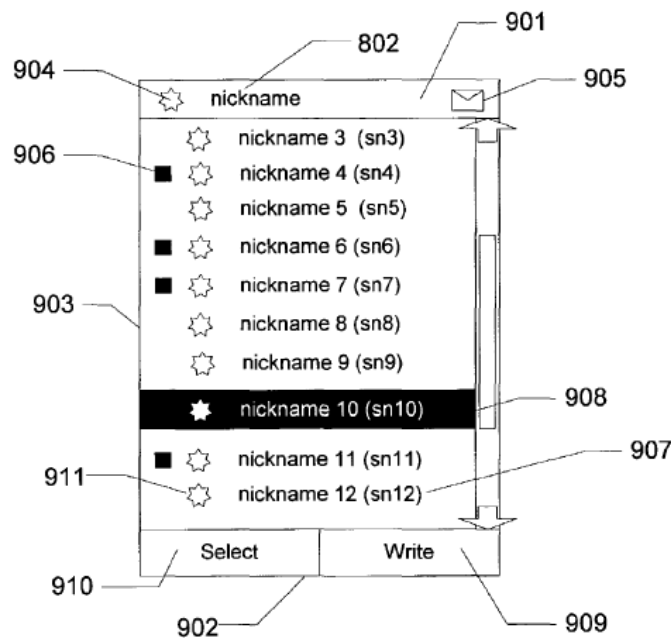


Figure 9, above, depicts title bar 901, where inbound chat message indicator 905 is an icon accompanied by an audible sound when the icon is first displayed, indicating to the user that there is at least one unheard or unread inbound chat message that has arrived at terminal 100. *Id.* at 8:17–18, 8:28–32. Left softkey 910, labeled “Select,” permits selection of a particular buddy for chatting, which selection is indicated with selection indicator 906.

Id. at 8:45–52, 8:60–9:1–5. “If the user pushes-to-talk, the display switches to the chat history, and the user is able to record and transmit a speech message and consequently start a new thread with the selected buddies.” *Id.* at 9:27–31.

2. 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. 1006, [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

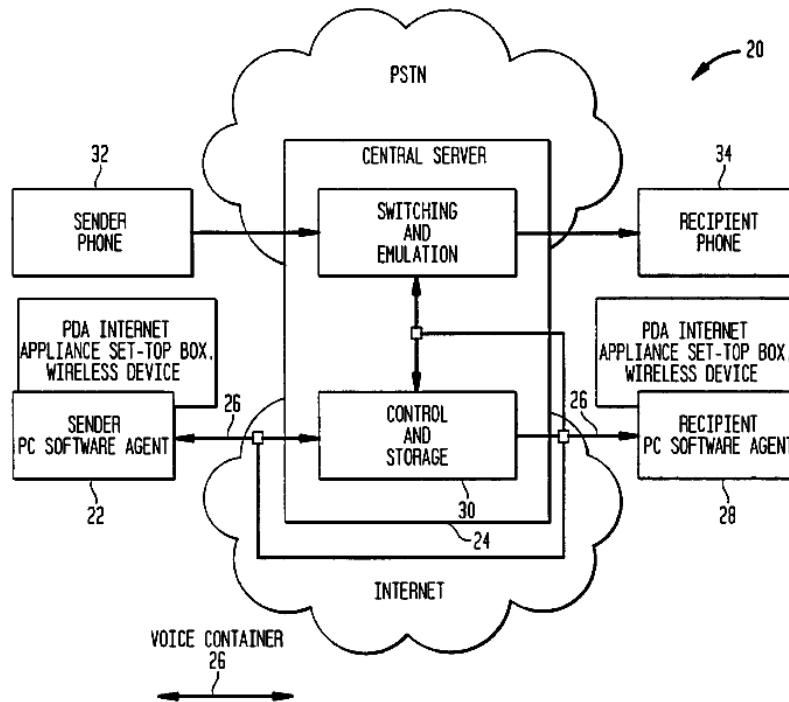


Figure 1, above, illustrates a high level functional block diagram of Zydney's system for voice exchange and voice distribution. *Id.* at 10:19–20. Referring to Figure 1, system 20 allows software agent 22, with a user interface, in conjunction with central server 24 to send messages using voice containers 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.

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.

3. Clark

Clark, titled “System for Managing and Organizing Stored Electronic Messages,” is directed to systems for managing and organizing electronic messages. Ex. 1007, [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.

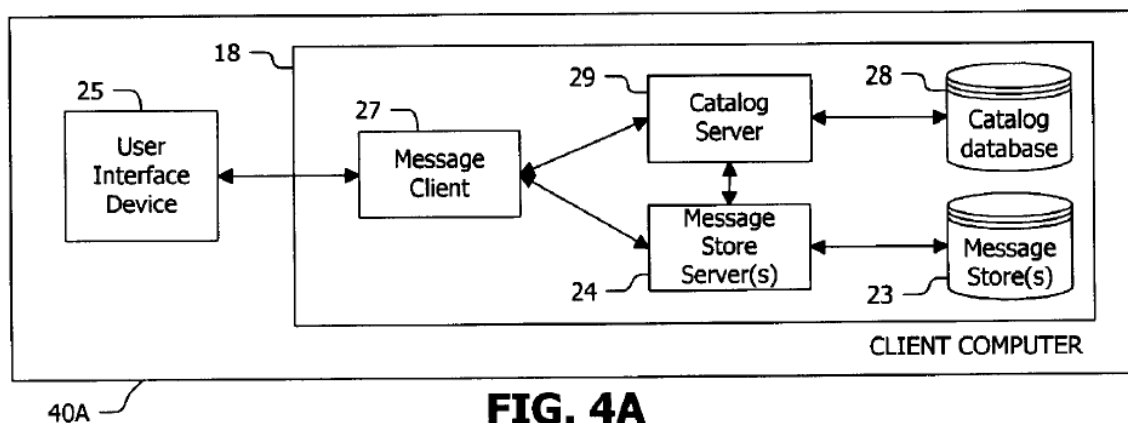


Figure 4A illustrates system 40A with client computer 18 implementing catalog server 29 and catalog database 28, and also including message

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 9:13–15. 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 9:54–56. “[C]atalog 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.

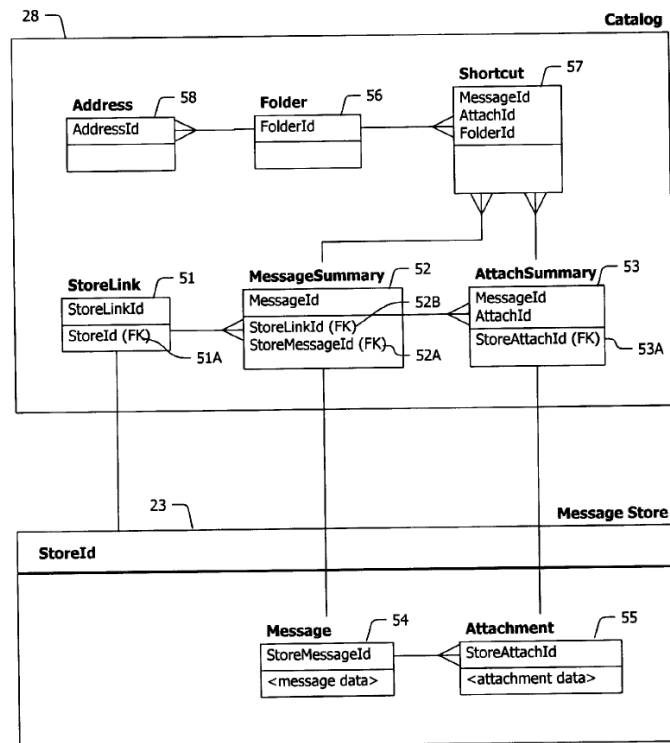


FIG. 5A

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.

G. Petitioner's Contentions

Claims 1 and 9 are independent claims, and Petitioner asserts slightly different grounds for the two claims. For claim 1, Petitioner asserts obviousness over Griffin and Clark, and for claim 9, Petitioner asserts obviousness over Griffin and Zydney. In both of these grounds, Petitioner points to Griffin as disclosing all the independent claim limitations, except that it relies on the following aspects of Clark and Zydney:

- a) Clark's disclosure of a client including a message store, catalog database(s), where a message record is identified by a "StoreMessageId;"
- b) Clark's disclosure of a user interface that "permits a user to select a folder and to view and manipulate messages;" and
- c) Zydney's disclosure of attachments to the voice container, including MIME standard attachment.

Pet. 22–23, 28, 49.¹ For certain dependent claims, Petitioner relies on other disclosures of Zydney and Clark, or other asserted references. For example, for claim 4, which depends from claim 1, Petitioner relies on Zydney’s disclosure of an MP3 format. *Id.* at 35 (citing Ex. 1006, 39:16, 21:15–18). For claims 7, 25, and 26, Petitioner points to Zydney’s disclosure of the central server tracking and maintaining the status of all software agents, where the status indicates “whether the recipient is online or offline,” or whether the recipient does not want to be disturbed. *Id.* at 41, 58–59. Zydney is further relied on for the disclosure of storing messages both locally and centrally at the server when the recipient is not available. *Id.* at 64–66.

Väänänen is relied upon for its disclosure of encryption prior to sending a file to the recipient and decrypting the file prior to opening the message, in connection with dependent claims 5 and 12. *Id.* at 45, 68. And finally, Lee is relied upon for its disclosure of connecting wirelessly to the Internet via a conventional cellular phone telecommunication network and its disclosure of a WiFi network. *Id.* at 71–72.

Petitioner proffers a second ground of unpatentability with respect to claim 26. Pet. 76–78. This ground is based on Vuori’s disclosure of a short voice messaging service center (“SVMSC”) that sends short voice messages immediately to the available intended recipients and that “continue[s] attempting to send to those not then available until they become available or

¹ The attachment aspects of Zydney also feature prominently in connection with claim 14, for which Petitioner argues that “attaching a file to a speech message creates an association between the message and the file, which discloses the claimed ‘link’.” Pet. 53.

until a time out occurs.” *Id.* (citing Ex. 1015 ¶ 34). We now evaluate the information in the Petition in light of Patent Owner’s argument and evidence. We note that Patent Owner supports its arguments against institution with a Declaration of William C. Easttom II. Ex. 2001 (“Easttom Declaration”).

H. Determination of Reasonable Likelihood

We have reviewed the Petition and the evidence cited in support thereof and are persuaded that, at this juncture, Petitioner has established a reasonable likelihood of prevailing in its contention that claims 1–5, 7–12, 14–17, 25, and 26 of the ’433 patent are unpatentable as obvious over the asserted references identified in Petitioner’s grounds (*see supra* Section I.D.). Specifically, Patent Owner has not persuaded us that the following arguments are supported by facts sufficient to overcome the evidence presented in the Petition:

- a) Griffin does not disclose “instant voice message” (Prelim. Resp. 24–30);
- b) Griffin’s communication does not occur over a “packet-switched network” (*id.* at 36–39);
- c) Griffin would not have been combined with Zydney (*id.* at 30–36);
- d) Neither Griffin nor Zydney discloses attaching a file to an “audio file” (*id.* at 40–49);
- e) Clark does not disclose a database record that includes both an instant voice message and a unique identifier, and there is no motivation to combine Griffin and Clark (*id.* at 50–55); and

- f) The combination of Griffin and Clark does not disclose the recited “file manager system storing, retrieving, and deleting the instant voice message” (*id.* at 55–58).

With regard to the “instant voice message” argument, Patent Owner focuses on whether Griffin’s disclosures are for “text messages” and whether speech chat messages are in “real-time.” *Id.* at 25–29. On this record none of these arguments overcome the express disclosure in Griffin of “managing the display of a plurality of *real-time speech* and text conversations (e.g., chat threads) on limited display areas.” Ex. 1005, 1:9–11 (emphasis added). Further, Griffin describes both inbound and outbound messages as either text or speech. *Id.* at 6:39–41, 11:48–50. Additionally, although Griffin describes “queuing” an inbound speech message, Griffin explains that the message is nevertheless received at the terminal, and the queuing is only for automatic playback. *Id.* at 11:50–67. In other words, with the evidence available, we do not agree with Patent Owner’s characterization of Griffin as indicating that a terminal is configured to “receive a message at some point in the future.” *See* Prelim. Resp. 27–28 (arguing that “available” status does not result in the terminal receiving the message because of “queuing”). Consequently, we are not persuaded by Patent Owner’s arguments that Griffin’s speech chats do not disclose instant voice messages.

Further, with regard to the second argument, we have reviewed Patent Owner’s contention that Griffin’s “push-to-talk” feature results in Griffin’s speech chats occurring over a circuit-switched network, rather than over a packet-switched network as claimed. *See id.* at 30. This argument is not supported sufficiently by the present record, because as explained in the

summary of Griffin above, Figure 2 describes that all encoded speech messages are delivered through communication network 203, which may be the Internet. Ex. 1005, 3:49–65. Moreover, whether Griffin teaches the recited “packet-switched network” is an issue of fact where Patent Owner has proffered only testimonial evidence challenging Petitioner’s contention that Griffin discloses the limitation. The conflicting testimonial evidence has created a genuine issue of material fact that we do not resolve at this juncture, but instead is viewed “in the light most favorable to the petitioner solely for purposes of deciding whether to institute an *inter partes* review.” 37 C.F.R. § 42.108(c). Consequently, Patent Owner’s arguments and evidence are not persuasive at this time.

Now we address Patent Owner’s challenge to the asserted combinability of Griffin and Zydney. The premise of Patent Owner’s arguments is that the availability status in Griffin is different from the availability status in Zydney. Prelim. Resp. 32. According to Patent Owner, Zydney is a peer-to-peer system that needs to know availability in the sense that the receiving software agent can receive messages instantaneously. *Id.* at 31. In contrast, Patent Owner characterizes Griffin as delivering the message only if the user has the “chat history display” visible on the user interface, and even then only the most recently received speech message is available. *Id.* at 30–31, 33–34. This discrepancy, Patent Owner reasons, would render Zydney inoperable for its intended purpose, would not motivate a person of ordinary skill in the art to combine the teachings, would result in substantial, unexplained modifications of Griffin, and would result in Zydney’s messages being lost. *Id.* at 30–34. As stated above, however, we do not agree that the record at this time supports Patent Owner’s

characterization of Griffin’s queuing disclosure as meaning that the message is not received at the terminal—the queuing only affects whether the most recently received speech message is played automatically upon receipt. The portions of Griffin Patent Owner cites do not support sufficiently the arguments that the terminal does not receive the speech message in real-time or that only the last received speech message is available. Therefore, Patent Owner’s arguments that rest on the characterization of Griffin’s queuing as incompatible with Zydney are not persuasive at this time.²

With regard to the argument concerning file attachment, claim 9 recites “wherein the instant voice message application attaches one or more files to the instant voice message.” For this limitation of “attach[ing] one or more files to the instant voice message,” Petitioner relies on Zydney’s disclosures of “attachment to the voice container,” such as the following: “Another important application of the present invention system and method for voice exchange and voice distribution is attaching other media to the voice containers.” *Id.* at 49 (citing Ex. 1103, 19:1–7). Patent Owner’s challenge to Petitioner’s showing rests on two premises: (1) that Zydney does not attach files to the instant voice message because Zydney’s voice container is not analogous to the recited “instant voice message”; and (2) that Zydney teaches away from attaching one or more files *to the voice*

² We also find unpersuasive the argument that Griffin and Zydney are not combinable for “text-only” buddy situation. Prelim. Resp. 34–36. None of Petitioner’s contentions rely on “text-only” buddy features. And Griffin is silent as to how that feature operates, in the event of a speech chat directed to a text-only buddy, even without considering Zydney. Accordingly, the scenario that Patent Owner presents is speculative and is supported only with conclusory declaration testimony that is entitled to little or no weight.

message itself. Prelim. Resp. 40–48. We are not persuaded by any of Patent Owner’s arguments on the record developed at this stage of the proceeding. Both of these arguments are premised on an implied construction of “instant voice message” as encompassing *only* the voice message and excluding all else. Indeed, Patent Owner’s declarant makes a distinction between Zydney’s voice container and the “instant voice message” that appears to be rooted in characterizing the “instant voice message” as audio data only. *Id.* at 42–43 (citing Ex. 2001 ¶¶ 41–50, 54).

This is an argument of claim construction that is underdeveloped at this juncture and has been presented only in connection with arguments distinguishing Zydney. On the present record, we do not have sufficient evidence or argument from either party to render even a preliminary construction for the term “instant voice message.” The parties will have an opportunity during trial to present fully claim construction briefing for the term “instant voice message.”

Turning to Clark, Petitioner argues that Clark’s message store 23 discloses a message database and that Clark’s StorageMessageId is the recited “unique identifier.” Pet. 22–23. Clark states: “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.” Ex. 1007, 11:38–40 (cited in Pet. 23). 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. 52. Patent Owner also argues that Petitioner speculates as to whether catalog database 28 and the message

store 23 could be combined, as shown in Figure 5B of Clark. *Id.* at 53. 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 53–55.

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 find that Petitioner has proffered sufficient evidence, at this juncture, that Clark discloses the recited “message database” and the “database record including a unique identifier.”

Finally, we address the arguments concerning the “file manager system performing at least one of storing, deleting and retrieving the instant voice messages,” as recited in claim 1. For this limitation, Petitioner relies on Griffin alone as disclosing, for example, “retrieving” because a displayed message can be selected for playback. Pet. 27 (citing, e.g., Ex. 1005, 12:38–42). As an alternative, Petitioner also relies on various disclosures of Clark as disclosing adding, changing, or deleting a message. Pet. 27–29. For instance, 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.* at 28 (citing Ex. 1007, 18:25–29).

Patent Owner argues that the claim language requires the sending device to include the message database. Prelim. Resp. 55–56. Accordingly, Patent Owner reasons that Griffin’s sender does not store a copy of the message sent, and, therefore, Griffin does not disclose “storing” as recited in the claim. *Id.* at 57. This argument, however, does not address that Petitioner reasonably relies on Griffin for the “retrieving” function of the file manager system, at the sending device. 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 58.

Patent Owner’s arguments are not persuasive at this juncture. It is not clear, on this record, that Claim 6 requires any particular location for the “message database,” and, therefore, neither Griffin’s retrieved messages nor Clark’s message store needs to be located strictly at the sending device as Patent Owner argues. Nevertheless, because Clark stores *sent* messages in the message store, Petitioner’s allegations reasonably apply to a *sending* device retrieving the stored messages. *See e.g.*, Ex. 1007, 17:12–17 (stating that displayed information for sent messages includes the send date/time). Finally, Petitioner has shown that Clark contemplates deleting a message at the request of a user. Pet. 28 (citing Ex. 1007, 18:25–29). Accordingly, Patent Owner’s arguments that Clark only shows component-to-component requests, and not “user requests,” is unpersuasive.

Patent Owner does not argue the challenged dependent claims separately from independent claims 1 and 9, and based on our review of Petitioner's arguments and evidence directed to the additional limitations of those dependent claims (2–5, 7, 8, 10–12, 14–17, 25, and 26), we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contention that claims 1–5, 7–12, 14–17, 25, and 26 of the '433 patent are unpatentable as obvious over the asserted grounds.

In light of the above, and having reviewed the information presented by the parties at this juncture, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing in its contentions that the challenged claims are unpatentable as obvious as identified in Section 1.D. and II.C. above.

I. Additional Considered Arguments

Patent Owner has advanced a variety of additional arguments concerning the repeated challenges of unpatentability asserted by other parties. For instance, Patent Owner argues that the Petition is redundant to other prior petitions. Prelim. Resp. 4–14. Patent Owner also argues that Zydney is duplicative of prior art cited during prosecution and that we should find the instant petition redundant in light of the multiple cases filed against Patent Owner's patents and that we should exercise our discretion and deny the petition under 35 U.S.C. § 314(a) and § 325(d). *Id.* at 14–20. And finally, Patent Owner alleges unconstitutionality of post-grant proceedings in view of *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 137 S. Ct. 2239 (2017). *Id.* at 54–55.

We have considered Patent Owner's arguments (except for the *Oil States* issue)³ and have found they are underdeveloped and unpersuasive, and thus, unworthy of further substantive discussion. We acknowledge that, including the instant case, we have been presented thus far with multiple challenges to the '433 patent. Although we understand the purposes of §§ 314(a) and 325(d), vis-à-vis repeated challenges, we also recognize the purpose of the availability of *inter partes* review to parties accused of infringement. And while Zydney has been the basis of grounds presented in a previous Petition by a different Petitioner, Zydney is not the focus of the grounds here; Griffin is. Patent Owner's complaint about the multiple *inter partes* review petitions filed against the '433 patent is not persuasive when the volume appears to be a direct result of its own litigation activity. The discretion to deny petitions is for the panel to wield under certain conditions, but not in every situation where a Patent Owner complains of repeated challenges against its patents.

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 1–5, 7–12, 14–17, 25, and 26 of the '433 patent under the grounds of obviousness listed below; and

³ Patent Owner's arguments relate to the constitutionality of *inter partes* review generally. At this time, no court has found *inter partes* review unconstitutional. The matter is before the U.S. Supreme Court, and Patent Owner's arguments as to denial of this Petition on this basis are premature.

| Challenged Claim(s) | Basis | References |
|-----------------------------|--------------|-------------------------------|
| 1–3, 8 | § 103(a) | Griffin and Clark |
| 4 and 7 | § 103(a) | Griffin, Clark, and Zydney |
| 5 | § 103(a) | Griffin, Clark, and Väänänen |
| 9, 11, 14–17, 25, and 26 | § 103(a) | Griffin and Zydney |
| 12 | § 103(a) | Griffin, Zydney, and Väänänen |
| 10 | § 103(a) | Griffin, Zydney, and Lee |
| 26 | § 103(a) | Griffin, Zydney and Vuori |

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.

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