

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,¹
Petitioner,

v.

UNILOC LUXEMBOURG S.A.,
Patent Owner.

Case IPR2017-02067
Patent 8,995,433 B2

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

QUINN, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. §§ 42.108, 42.122; 35 U.S.C. §§ 315(d), 325(d)

¹ Petitioner filed Updated Mandatory Notices alerting the Board that Google Inc. filed a Certificate of Conversion with the Delaware Secretary of State, whereby Google Inc. converted from a corporation to a limited liability company and changed its name to Google LLC. Paper 5.

Petitioner filed a Petition requesting *inter partes* review of claims 1–27 of U.S. Patent No. 8,995,433 B2 (Ex. 1001, “the ’433 patent”). Paper 2 (“Pet.”). Uniloc Luxembourg S.A. (“Patent Owner”) 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.

We have authority under 35 U.S.C. § 314. Upon considering the information presented in the Petition, the Preliminary Response, and Reply, and for reasons discussed below, we deny the Petition and do not institute *inter partes* review of claims 1–27 of the ’433 patent.

I. BACKGROUND

A. *Real Parties In Interest and Related Matters*

Petitioner asserts that following entities are real parties in interest: Motorola Mobility, LLC, Huawei Device Co., Ltd., Huawei Device USA, Inc., Huawei Investment & Holding Co., Ltd., Huawei Technologies Co., Ltd., and Huawei Device (Dongguan) Co., Ltd. Pet. 1.

Petitioner indicates that the ’433 patent has been asserted against Motorola Mobility LLC in the Eastern District of Texas. *Id.* at 1–2 (identifying Case No. 2:16-cv-992). Petitioner also indicates that a complaint was filed against the Huawei entities (Case No. 2:16-cv-994). *Id.* at 2. Finally, Petitioner asserts that Patent Owner filed, in the Eastern District of Texas, several complaints against Petitioner (Case Nos. 2:17-cv-465, 2:17-cv-466, 2:17-cv-467, 2:17-cv-231, 2:17-cv-224, 2:17-cv-214). *Id.*

The '433 patent is the subject matter of several *inter partes* reviews: IPR2017-00225 (instituted May 25, 2017), IPR2017-01427 (instituted December 4, 2017), and IPR2017-01428 (instituted December 4, 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.

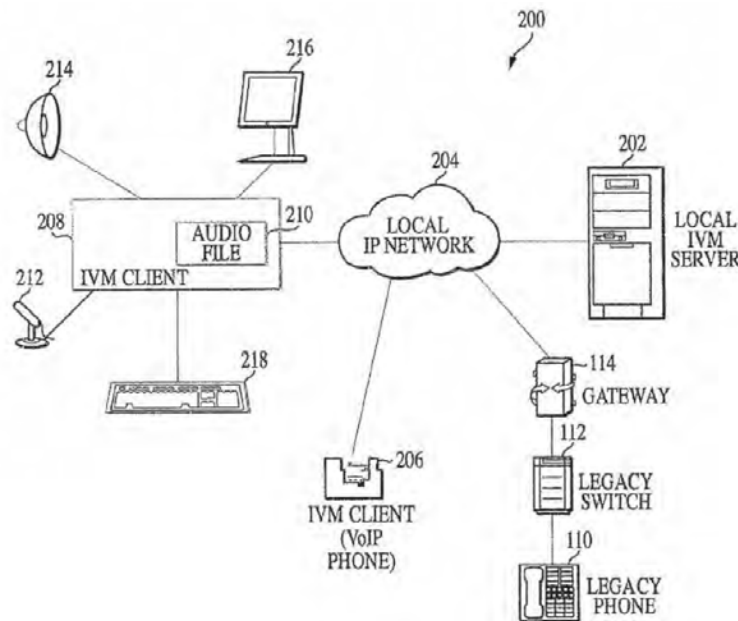


FIG. 2

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 7:49–53. 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. Illustrative Claim

Of the challenged claims, claim 1, 6, and 9 are independent. Claim 1 is illustrative, and is reproduced below.

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) *Zydney*: PCT App. Pub. No. WO 01/11824 A2, published February 15, 2001, filed in the record as Exhibit 1005 (with line numbers added by Petitioner);
- b) *Stern*: PCT App. Pub. No. WO 98/47252, published October 22, 1998, filed in the record as Exhibit 1006;
- c) *Enete*: US 2003/0208543 A1, published November 6, 2003, filed in the record as Exhibit 1010;
- d) *Trapani*: PCT App. Pub. No. WO 02/087135 A2, published October 31, 2002, filed in the record as Exhibit 1007;
- e) *Demsky*: US 2003/0182323 A1, publication date September 25, 2003, filed in the record as Exhibit 1008; and
- f) *Katseff*: US 6,301,258 B1, issued October 9, 2001, filed in the record as Exhibit 1009.

Petitioner asserts two grounds of unpatentability (Pet. 6–7):

Challenged Claim(s)	Basis	Reference(s)
9, 12–14, 17, 25	§ 102	<i>Zydney</i>
1–6, 11, 16	§ 103(a)	<i>Zydney</i> and <i>Stern</i>
7, 8	§ 103(a)	<i>Zydney</i> , <i>Stern</i> , and <i>Enete</i>
10	§ 103(a)	<i>Zydney</i> and <i>Trapani</i>

Challenged Claim(s)	Basis	Reference(s)
15	§ 103(a)	Zydney and Demsky
18–24	§ 103(a)	Zydney and Katseff
26–27	§ 103(a)	Zydney and Enete

Petitioner also relies on a Declaration of Paul S. Min, Ph.D., filed as Exhibit 1003.

II. DISCRETIONARY AUTHORITY: 35 U.S.C §§ 315(d) and 325(d)

Section 325(d) states that “[i]n determining whether to institute . . . the Director may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office.” In this proceeding, Patent Owner argues that the same or substantially the same prior art has been presented to the Office previously because Zydney has been asserted in multiple *inter partes* reviews. Prelim. Resp. 3. Specifically, Zydney has been asserted by a different petitioner in IPR2017-01427 and IPR2017-01428, which we instituted in December 4, 2017, and which also address the ’433 patent (“the previous IPRs”).

Petitioner responds that we should not exercise our discretion because although Zydney has been presented previously, the Petition presents different combinations with Zydney, such as by including the references Stern, Enete, Trapani, Demsky, and Katseff. Reply 2. Petitioner also proffers that Google has not filed any previous petition challenging the ’433 patent, thus precluding the characterization of this proceeding as a

follow-on petition. *Id.* at 1. Finally, Petitioner argues that dependent claims 13, 18–24, and 27 have never been challenged on a ground based on Zydney, and that where, as here, the Petitioner is different from any petitioner of previously filed petitions based on Zydney, the facts weigh heavily against a discretionary denial. *Id.* at 2–3. We are not persuaded by Petitioner’s arguments.

There is no question that Zydney has been previously presented to the Office in the previous IPRs challenging the ’433 patent. The question is whether, based on this fact, we should exercise our discretion and deny the Petition. Applicability of § 325(d) is not limited to situations where the *same petitioner* has filed a follow-on petition. The statute allows for the exercise of discretion upon consideration only of whether the same or substantially the same prior art or arguments were presented previously to the Office. Further, the statutory authority to deny the petition based on the same previously presented prior art is not tied to the format of how that prior art is presented or whether every aspect of the asserted grounds is identical in both petitions. Therefore, we have statutory authority to deny this Petition because Zydney was previously presented to the Office in the previous IPRs, notwithstanding that Petitioner is not a party to the previous IPRs and the asserted grounds here are not exactly the same as the previous IPRs.

We further note that under the current circumstances, where the patent-at-issue is involved in ongoing trials,² we also have discretionary

² Trials in IPR2017-00225, IPR2017-01427, and IPR2017-01428 are pending as of the issuance of this Decision.

authority, under 37 C.F.R. § 42.122, to issue “any appropriate order regarding the additional matter[, i.e., this proceeding,] including providing for the stay, transfer, consolidation, or termination or any such matter.” See 35 U.S.C. § 315(d). We recognize that in exercising our discretion we determine the proper course of conduct in a proceeding (37 C.F.R. § 42.5) in a manner consistent with securing the just, speedy, and inexpensive resolution of the proceeding (37 C.F.R. § 42.1(b)).

Here, our exercise of discretion to deny institution under §§ 315(d) and 325(d) is warranted for several reasons. To start with, the previous IPRs and the present Petition rely on Zydney as the primary reference against which the majority of the claim limitations are mapped. Petitioner has proffered no reasoning regarding how it has relied on Zydney in any way that *differs materially* from the previous IPRs. And Petitioner’s reliance on different secondary references does not remedy this shortcoming. Moreover, Petitioner, here, does not explain whether the secondary references in this case are used in a different manner or add anything materially different to the secondary references used in the previous IPRs.

Further, Zydney is being considered on the merits in pending IPRs. In fact, two trials regarding the ’433 patent are ongoing, with Zydney as the hallmark, i.e., a distinctive feature, of those trials. See IPR2017-01427 and IPR2017-01428. Under these circumstances, we look to Petitioner to provide some reason that convinces us to institute yet another trial that features Zydney as prominently as the previously presented IPRs. Again, if there was a manner in which Petitioner here distinguishably relied on Zydney, Petitioner did not proffer that fact explicitly.

Moreover, the time of filing of this Petition leads us to conclude that Petitioner gained the benefit of Patent Owner's preliminary responses in the previous IPRs. Patent Owner filed those responses on September 9, 2017. Three days later Petitioner filed the instant petition. Petitioner, as the party with the knowledge of this fact, failed to allege that it did not gain the benefit of the preliminary responses in previous IPRs. We look to Petitioner to explain its delay in its filing. Petitioner provides no reason here.

Finally, although not a dispositive fact, we note that in the previous IPRs, Patent Owner requested authorization to file a motion to amend challenged claims of the '433 patent. This fact raises concerns regarding the complexity and potential for inconsistency inherent in allowing this proceeding to occur in tandem with ongoing trials that arise in large part from the considerable role Zydney plays each proceeding. Further, we are concerned not only with ensuring consistency across multiple trials focused on Zydney, but also with administrative efficiency because significant resources of the Board would be consumed reconciling arguments, issues, and evidence across multiple, independent trials,³ especially in light of the forthcoming motion to amend in the previous IPRs. *Cf. Heckler v. Chaney*, 470 U.S. 821, 831 (1985) (indicating an agency, when deciding whether to take action in a particular matter, must determine whether its resources are best spent on one matter or another).

With regard to the non-overlap of claims between the previous IPRs and those challenged in this Petition, we recognize the interests of Petitioner in challenging claims that are not challenged in the previous IPRs (i.e.,

³ See *MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373 (Fed. Cir. 2018).

claims 13, 18–24, and 27). The interest of Petitioner in this regard weigh heavily against our exercise of discretion. But we can exercise our discretion in a manner that balances the interests of Petitioner in challenging different claims here with the concern for duplication of Board resources and repeated challenges against the same claims of the same patents over Zydney, either alone or in combination with other references.

Therefore, based on the foregoing and to secure the just, speedy, and inexpensive resolution of the dispute, we exercise our discretion under §§ 315(d) and 325(d), and deny institution of all challenged claims that overlap with the previous IPRs, namely, claims 1–12, 14–17, 25, and 26. We do not exercise our discretion to deny institution with respect to the claims that have not been challenged in the previous IPRs: claims 13, 18–24, and 27.

III. DISCUSSION OF CONSIDERED GROUNDS

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). We presume a claim term carries its plain meaning, which is the meaning customarily used by those of skill in the relevant art at the time of the invention. *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016). 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).

For purposes of determining whether to institute review, we need not construe expressly any term.

B. Overview of 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. 1005, [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

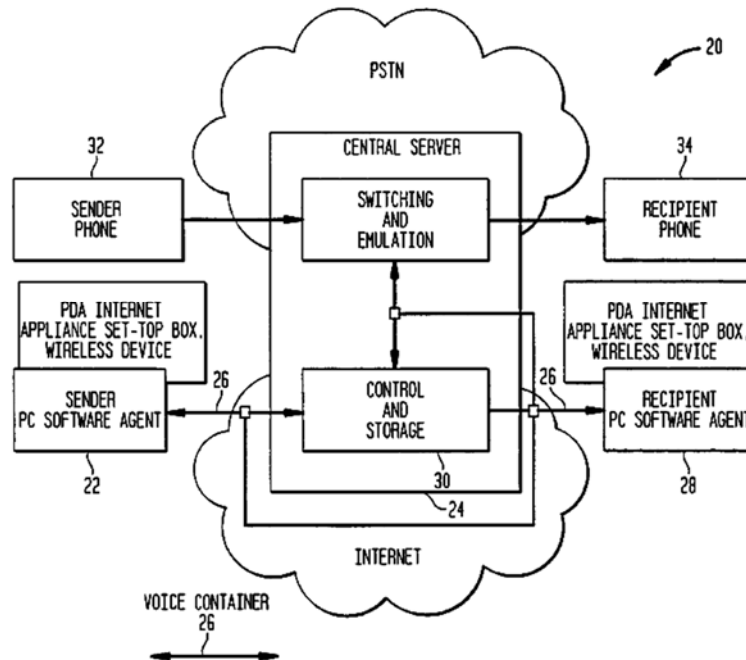


Figure 1, above, illustrates a high level functional block diagram of Zydney's system for voice exchange and voice distribution. *Id.* at 10:19–20. Referring to Figure 1, system 20 allows software agent 22, with a user interface, in conjunction with central server 24 to send messages using voice containers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

C. Analysis of Petitioner’s Contentions

Petitioner challenges claims 13, 18–24, and 27 relying primarily on Zydney. Pet. 7. For example, Petitioner asserts that Zydney anticipates claim 13 because, in addition to Zydney disclosing the limitations of independent claim 9, Zydney discloses a software agent that “offers the originator alternative ways to communicate with the recipient,” and one of those alternatives is the intercom mode. Pet. 16–18. Petitioner also relies on Zydney, in combination with Katseff, as teaching the elements of claims 18–24. Pet. 53–65. Petitioner relies on Katseff for its disclosure of data buffers. *See, e.g., id.* at 61 (citing Ex. 1008, 3:5–43, 3:64–4:19, Fig. 1; Ex. 1003 ¶¶ 136, 146–47). Finally, with regard to claim 27, Petitioner relies on Zydney’s teachings, but argues that the combination of Zydney and Enete would render obvious claim 27 because of its dependence from claim 26. Pet. 69. We analyze each of these challenges below.

1. Claim 13

We determine that Petitioner has not demonstrated a reasonable likelihood of prevailing with regard to its contention that claim 13 is anticipated by Zydney. In particular, we find that Petitioner has failed to show that Zydney’s software agent “displays a selectable control for generating an instant voice message using an intercom mode.” This is an anticipation challenge, which requires that the art disclose each and every limitation of the claim, in the same arrangement as claimed. *Net MoneyIn*,

Inc. v. VeriSign, Inc., 545 F.3d 1359, 1371 (Fed. Cir. 2008). The Board cannot fill in the gaps and consider what an ordinary artisan might supplement or envisage. *Net MoneyIn*, 545 F.3d at 1372; *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor*, 851 F.3d 1270, 1274–75 (Fed. Cir. 2017) (The Board is not permitted to “fill in missing limitations simply because a skilled artisan would immediately envision them.”).

The Petition sets forth that Zydney teaches a “selectable control” because the software agent permits a number of distinct modes of communication and that the originator selects a delivery mode, i.e., intercom mode. Pet. 17–18. But with regard to the *display* of the “selectable control,” Petitioner states that “Zydney plainly teaches that its software agent’s user interface displays a selectable control for generating an instant voice message using an intercom mode based on the connectivity status (e.g., status of the recipient) of an intended recipient.” Pet. 18 (citing Ex. 1003 ¶ 58). In support, the Min Declaration mentions “display” in reference to selecting the recipients, stating, “Once the originator has selected the recipients from the display, Zydney’s system allows the originator to select a delivery option depending on which ‘core state’ the intended recipient is in—online or offline.” *Id.* This is insufficient support for demonstrating that Zydney discloses the display limitation of claim 13.

Claim 13 recites that the “instant voice messaging application displays a selectable control for generating an instant voice message using an intercom mode.” Neither the Petition nor the Min Declaration addresses the display of the “selectable control for generating an instant voice message.” At best, the Min Declaration adduces to the display of a list of recipients and their selection. But there is no explanation as to the display *of the*

“*selectable control*” in Zydney or citation of evidence that Zydney displays any selection such that it can generate a voice message in intercom mode. Without evidence that Zydney discloses the recited “display,” we are unpersuaded by Petitioner’s arguments that Zydney anticipates the claim. Therefore, Petitioner’s contention of unpatentability regarding claim 13 does not meet the reasonable likelihood institution threshold.

2. Claims 18–24

We determine that Petitioner has not demonstrated a reasonable likelihood of prevailing with regard to its contention that claims 18–24 are unpatentable over Zydney and Katseff. Pet. 53–65. Claim 18 requires that the “client platform system transmits each successive buffered portion to the instant voice messaging server for delivery to the one or more intended recipients.” Petitioner has not shown that Zydney in combination with Katseff teaches or suggests this limitation. Petitioner relies on Zydney’s disclosure of the “real time ‘intercom mode’” (Pet. 53) and alleges that Zydney’s software agent “also transmits voice containers to the central server for delivery” (*id.* at 54). Although we agree with Petitioner that Zydney uses an intercom mode to transmit voice messages in real time by transmitting “successive” portions, none of Petitioner’s citations to Zydney show that any of those “successive” portions are transmitted to the central server for delivery to a recipient.

Petitioner’s reliance on page 16, lines 7–10 of Zydney are misplaced. We do not agree with Petitioner that the cited portion of Zydney refers to the transmission of intercom mode voice messages to the central server. Page 15 of Zydney explains that the intercom mode occurs (a) when the recipient is online; and (b) as a peer-to-peer communication. Ex. 1005, 15:8–14. On

that same page, Zydneý explains that voice containers are delivered to the central server when the recipient is offline. *Id.* at 15:15–21. Petitioner has not explained how Zydneý’s voice container discloses the successive portions, nor has Petitioner shown any embodiment in which Zydneý’s intercom mode communications transmit buffered *portions to the central server*. Accordingly, Petitioner has failed to demonstrate a reasonable likelihood of prevailing in its contention that Zydneý in view of Katseff teaches or suggests the subject matter of claim 18, and, thus, any of its dependents therefrom (claims 19–24).

3. Claim 27

Claim 27 depends from claim 26, which depends from claim 25, which depends from claim 17. Claims 17 and 25 recite as follows:

17. The system according to claim 9 further comprising an instant voice messaging server receiving the instant voice message and an indication of one or more intended recipients of the instant voice message.

25. The system of claim 17 wherein the instant voice messaging server determines availability of the one or more intended recipients for receipt of the instant voice message.

Ex. 1001, 25:25–28, 26:18–21. Petitioner challenges claims 17 and 25 as anticipated by Zydneý. Pet. 20–22. In particular, Petitioner cites to the portions of Zydneý that describe the “pack and send mode,” 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 21 (citing, for example, Ex. 1005, 11:1–23). The portion Petitioner cites also states that Zydneý provides the “ability to store messages 30 both locally and centrally at the server whenever the recipient is not available for a prescribed period of

time.” Ex. 1005 11:4–6. Thus, Petitioner contends that Zydney anticipates the “instant voice messaging server” features recited in claim 17 because in the “pack and send mode” Zydney delivers a voice container to the central server, which stores the voice container for a prescribed period of time.

For claim 25, Petitioner points out that Zydney maintains the status of the recipients, whether they are “online or offline, but also offers related status information, for example whether the recipient does not want to be disturbed.” Pet. 22 (citing Ex. 1005, 14:22–15:1). Based on Zydney’s disclosures of the central server maintaining status of software agents in this manner, Petitioner concludes that Zydney’s central server determines the availability of a recipient for receipt of a voice container, just as required by claim 25. *Id.* (citing Ex. 1003 ¶ 62).

We are not persuaded that Petitioner’s anticipation challenge to claim 25 is adequate. Claim 25 requires that the server determine availability of “the one or more intended recipients for receipt of the instant voice message.” That is, the server’s availability determination is for the intended recipients recited in claim 17. In Zydney, the determination of availability, and thus why the voice containers are sent to the central server, is made by the software agent, not the central server. Zydney notably states that: “Based on the 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.” Ex. 1005, 16:7–10 (emphasis added). Thus, the central server tracks or detects the status of *all* software agents (*id.* at 14:8–9, 40:4–5), and it conveys that information to the software agents (*id.* at 14:20–22). The central server, however, receives a

voice container *after* the software agent has made the determination that *the intended recipient* of that voice container is not available. *See, e.g.*, Ex. 1005, 13:13–15 (central server: “maintain and provide the status of all software agents; store the voice container *if the recipients are not available*”) (emphasis added); 15:3–4 (“Considering just the two core states[, online or offline,] the software agent offers the originator alternative ways to communicate with the recipient.”); 15:19–21 (“For these [offline] cases, the voice containers are delivered to the central server to manage the ultimate delivery to the recipient.”). None of the citations in the Petition or the Min Declaration (Ex. 1003 ¶ 62) persuade us Zydney teaches otherwise.

Accordingly, based on the information on the record before us and the arguments and evidence presented in the Petition, we do not agree with Petitioner that Zydney anticipates claim 25. Additionally, Petitioner does not rely on Enete as teaching or suggesting the “determin[ing] availability of the one or more intended recipients for receipt of the instant voice message” limitation of claim 25 that we conclude Zydney lacks. Consequently, we determine that Petitioner has not demonstrated a reasonable likelihood that it will prevail in its contention that claim 27, which depends indirectly from claim 25, is unpatentable over Zydney and Enete.

IV. ADDITIONAL PATENT OWNER ARGUMENTS

Patent Owner has advanced a variety of additional arguments concerning an alleged failure on the part of Petitioner to name all real parties-in-interest, and the constitutionality of *inter partes* review proceedings. Prelim. Resp. 9–15, 26. We have considered those arguments, but in view of our determination not to institute trial on the basis of

35 U.S.C. §§ 315(d) and 325(d) and Petitioner's substantive grounds, we do not address those arguments further herein.

V. CONCLUSION

We exercise our discretion under 35 U.S.C. §§ 315(d) and 325(d) and do not institute *inter partes* review of claims 1–12, 14–17, 25, and 26 on that basis. We also determined that Petitioner has failed to demonstrate a reasonable likelihood of prevailing in its contentions that claims 13, 18–24, and 27 are unpatentable as asserted.

VI. ORDER

In consideration of the foregoing, it is hereby:
ORDERED that the Petition is *denied*.

IPR2017-02067
Patent 8,995,433 B2

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