

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC. and INSTAGRAM, LLC
Petitioner

v.

VOXER IP LLC,
Patent Owner

Case No. IPR2021-00113
U.S. Patent No. 10,511,557 B2

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST

No.	Description
2001	2013 Winners – Silicon Valley Business App Awards, available at: http://www.svbaawards.com/2013-winners.html (accessed February 11, 2021)
2002	<i>Voxer, Inc. et al. v. Facebook, Inc. et al.</i> , No. 1-20-cv-00655-ADA, Dkt. 74 (Claim Construction Order) (W.D. Tex. October 29, 2020)
2003	<i>Voxer, Inc. et al. v. Facebook, Inc. et al.</i> , No. 1-20-cv-00655-ADA, Dkt. 84 (Joint Motion to Amend Schedule) (W.D. Tex. October February 8, 2021)
2004	INTENTIONALLY OMITTED
2005	Email From G. Snyder to P Malhotra et al. (regarding claim election)
2006	INTENTIONALLY OMITTED
2007	<i>Information About the COVID-19 Vaccine</i> , CDC Webpage, available at: https://www.cdc.gov/coronavirus/2019-ncov/vaccines/different-vaccines/Pfizer-BioNTech.html (accessed February 11, 2021)
2008	<i>Texas First State to Administer 1 Million COVID-19 Vaccines</i> , Texas.gov, available at: https://gov.texas.gov/news/post/texas-first-state-to-administer-1-million-covid-19-vaccines (accessed February 11, 2021)
2009	<i>Voxer, Inc. et al. v. Facebook, Inc. et al.</i> , No. 1-20-cv-00655-ADA, Dkt. 60 (Defendants’ Opening Claim Construction Brief) (W.D. Tex. August 3, 2020)
2010	<i>Voxer, Inc. et al. v. Facebook, Inc. et al.</i> , No. 1-20-cv-00655-ADA, Dkt. 61 (Plaintiff’s Opening Claim Construction Brief) (W.D. Tex. August 3, 2020)
2011	Defendants’ Final Invalidity Contentions Claim Charts served in <i>Voxer, Inc. et al. v. Facebook, Inc. et al.</i> , No. 1-20-cv-00655-ADA (W.D. Tex.)
2012	UDP Datagram Protocol, Internet Engineering Task Force (August 28, 1980), available at: https://tools.ietf.org/html/rfc768 (accessed February 11, 2021)

I. INTRODUCTION

The Petition should be denied institution for two reasons. First, the Board should use its discretion to deny institution under § 314(a). In particular, the challenged patent is currently the subject of litigation in the Western District of Texas, a case that has been ongoing for ***over a year***. In that time, the parties have exchanged multiple document productions as well as source code productions, and Petitioner has served both preliminary and final invalidity contentions. In addition, the district court has already issued a claim construction order after full briefing by the parties and a hearing. The trial date in the Texas case is currently set for January 18, 2022—***four months*** before the Board’s Final Written Decision would issue if institution were granted.

Moreover, there is ***complete*** overlap between the issues presented in the Petition and the district court case. Petitioner’s invalidity contentions claim charts rely on precisely the same art asserted the Petition. Petitioner has not agreed to forego relying on the Petition’s cited prior art and arguments in the litigation if institution is granted.

Thus, not only has there been significant investment of time and resources in the district court litigation, it is months behind the district court case ***and*** the obviousness issues presented in it are identical to the issues the

district court will decide months earlier. Petitioner has effectively chosen the forum in which they will present their invalidity defense by waiting over **nine months** to file the Petition and relying on the same grounds presented in the litigation. Petitioner's attempt to pursue its invalidity case in two separate forums should be rejected, since trying the same invalidity case in both the district court and an IPR will duplicate efforts and waste judicial and party resources. Accordingly, institution should be denied under § 314(a).

Second, Petitioner's prior art fails to render obvious multiple elements of independent claim 45. In particular, claim 45 requires "the transmission of (a) and (b) occurring so that the recipient device can simultaneously render at least a first portion of the first video message and at least a second portion of the second video message." Petitioner argues that Clisham's end-user device may view two **distinct** video conversation sessions with separate senders on **distinct** operating system windows, thus purportedly disclosing this limitation. However, Petitioner's focus on Clisham's end-user device ignores that claim 45 recites a dual requirement for **both** transmission of data enabling simultaneous rendering **and** simultaneous rendering of the two video messages. Petitioners entirely fail to address this dual requirement, and Clisham does not teach either a) transmission that enables simultaneous rendering, or b) the simultaneous rendering itself. Rather, Clisham teaches

that only **one** video message from **one** sender may be rendered per session. The '557 patent criticizes this precise mono-transmission and rendering approach.

Petitioner next argues that Clisham renders obvious claim 45's requirement that transmission occur without an "end-to-end connection." In fact, Clisham expressly teaches that a **session**, *i.e.*, an end-to-end connection, **must** be established before transmission. Likewise, Petitioner's argument that UDP transmission in Clisham occurs without an end-to-end connection is merely a rehash of its failed construction of "end-to-end connection," already rejected by the district court. Indeed, in addition to Clisham's several express teachings that end-to-end connections are required, it is self-evident that Clisham's UDP transmissions require an end-to-end connection based on the inclusion of both sender and recipient addresses in UDP packets – the presence of both addresses in the packets confirms that an end-to-end connection exists before transmission.

The Petition's grounds thus also fail on the merits, and the petition should be denied.

II. PATENT OWNER

Voxer is a leading communications innovator. It developed and provides the Voxer app for iOS and Android, as well as the Voxer SDK. Tom

Katis is Voxer's co-founder, served as CEO until 2015, and is a named inventor on the '557 patent. He served as a United States Army Special Forces Communications Sergeant in a combat deployment to Afghanistan after September 11, 2001. Mr. Katis experienced the shortcomings of existing communications systems while coordinating medevac, tactical reinforcements, and close air support in combat operations. Among other deficiencies, he observed that these systems could operate only in real-time or after complete message composition, and were ill-suited for time-sensitive communications with multiple groups in a disruptive environment.

Mr. Katis and his team began developing communications solutions in 2006 to remedy these shortcomings. The new technologies enabled transmission of voice and video communications with the immediacy of live communication and the reliability and convenience of messaging. The technologies allowed transmission and reception under poor and varying network conditions and regardless of recipient availability.

Voxer launched the Voxer Walkie Talkie app in 2011. It became an immediate success and was named Best Overall App in the First Annual Silicon Valley Business App Awards in 2013. Ex. 2001.

III. GROUNDS ASSERTED IN THE PETITION

The Petition asserts three invalidity grounds based on pre-AIA 35 U.S.C. §103(a) against independent claim 45 and dependent claims 46, 51, 54, 57, and 58 from within the same claim family (the “challenged claims”):

- Ground 1 alleges that claims 45, 46, 51, 54, 57 and 58 are obvious over U.S. Patent Application Publication Number US 2004/0119814 A1 to Clisham et al. (“Clisham”) (Petition at 16-51);
- Ground 2 alleges that claim 54 is obvious over Clisham and U.S. Patent No. 7,818,444 B2 to Brueck et al. (“Brueck”) (Petition at 51-61);
- Ground 3 alleges that claim 58 is obvious over Clisham and U.S. Patent Application Publication Number US 2006/0047750 A1 to Schmitt et al. (“Schmidt”) (Petition at 61-67);

IV. CHALLENGED CLAIMS OF THE ’557 PATENT

Petitioner challenges claims 45, 46, 51, 54, 57, and 58 of the ’557 patent. Claim 45 is the only challenged independent claim. Claim 45 reads:

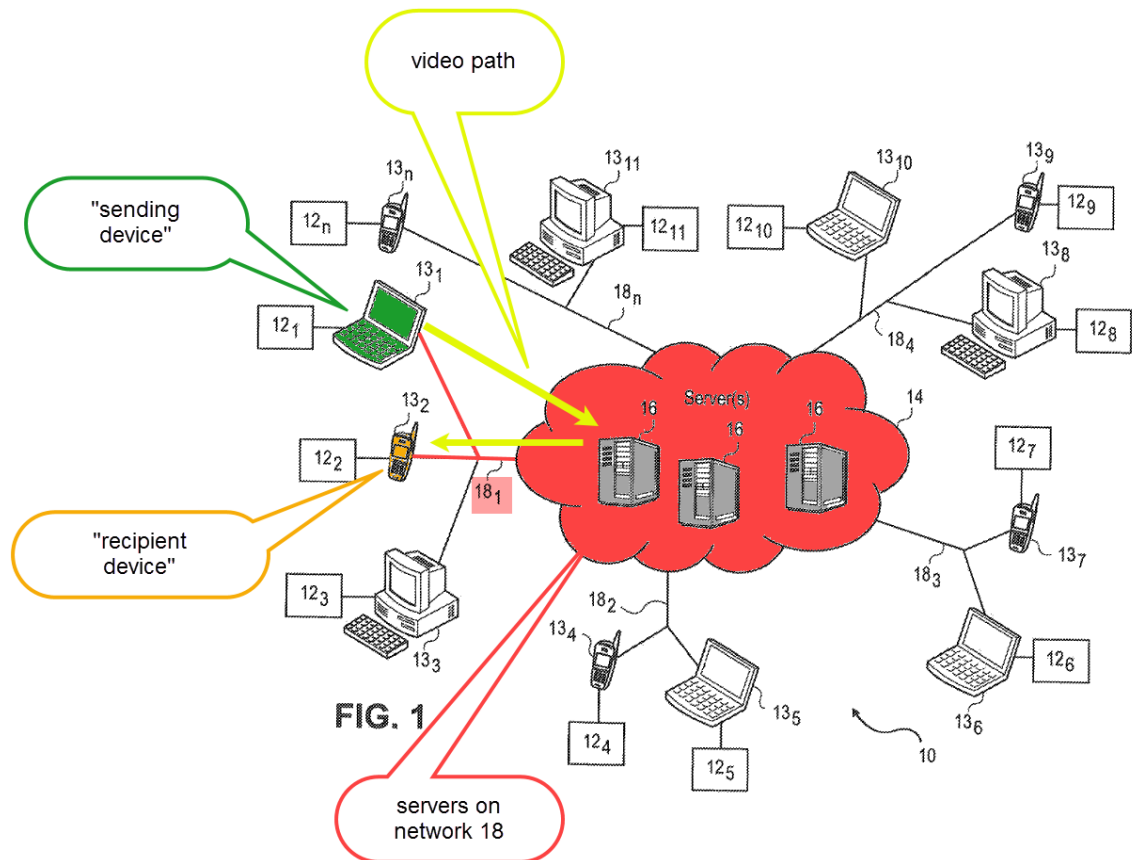
Claim	Limitation
45 preamble	“A method for operating a video message service infrastructure on a network, the method comprising:
45[a]	receiving, at the video message service infrastructure, a first video message transmitted by a first sending device, the first video message containing first video media, the first video media being transmitted as the first video media is created;
45[b]	“receiving, at the video message service infrastructure, a second video message transmitted

	by a second sending device, the second video message containing second video media, the second video media being transmitted as the second video media is created;
45[c]	transmitting from the video message service infrastructure over the network: (a) the first video media of the first video message to a recipient device; and
45[d]	“(b) transmitting the second video media of the second video message to the recipient device;
45[e]	the transmission of (a) and (b) occurring so that the recipient device can simultaneously render at least a first portion of the first video message and at least a second portion of the second video message, the simultaneous rendering occurring:
45[f]	(c) as the first video media of the first video message and the second video media of the second video message are each being created and transmitted over the network by the first and the second sending devices respectively; and
45[g]	(d) without having to first establish an end-to-end connection over the network between either of: (i) the first sending device and the recipient device before the first sending device begins to transmit the first video media of the first video message; and (ii) the second sending device and the recipient device before the second sending device begins to transmit the second video media of the second video message.

V. OVERVIEW OF THE '557 PATENT

The '557 patent is entitled “Telecommunication and multimedia management method and apparatus” and issued on December 17, 2019. The challenged claims of the '557 patent describe simultaneously creating and transmitting video messages to a recipient. Ex. 1001 at 15:15-33, Claim 1.

For example, as shown in annotated Figure 1, below, “sending device” 13₁ (green) generates a video message (yellow) and transmits the message as it is being created:



Ex. 1001 at Fig. 1; *see also id.* at 27:20-33, 27:33-36. Thereafter, the '557 patented system transmits the video message (yellow) to a recipient device 12₂ (orange). *Id.* at 27:33-45.

The '557 patent further teaches that a coordinated transmission of multiple conversations allows for simultaneous rendering at the recipient device. One example of such coordination at transmission is segmenting and indexing messages:

Conversations are defined by a threaded sequence or organization of Messages. The Messages are segmented from a stream of media, with each Message given a sequence identifier and indexed by the time the Media was created. Depending on the variation of the MCMS application, Messages can be rendered in accordance with one or more render options.

Ex. 1001 at 37-47.

Annotated Figure 13D of the '557 patent illustrates an example of the claimed transmission protocol coordinating the transmission of three conversations—A, B, and C—so that the message service infrastructure simultaneously renders video messages from a plurality of senders in real time at the end-user device:

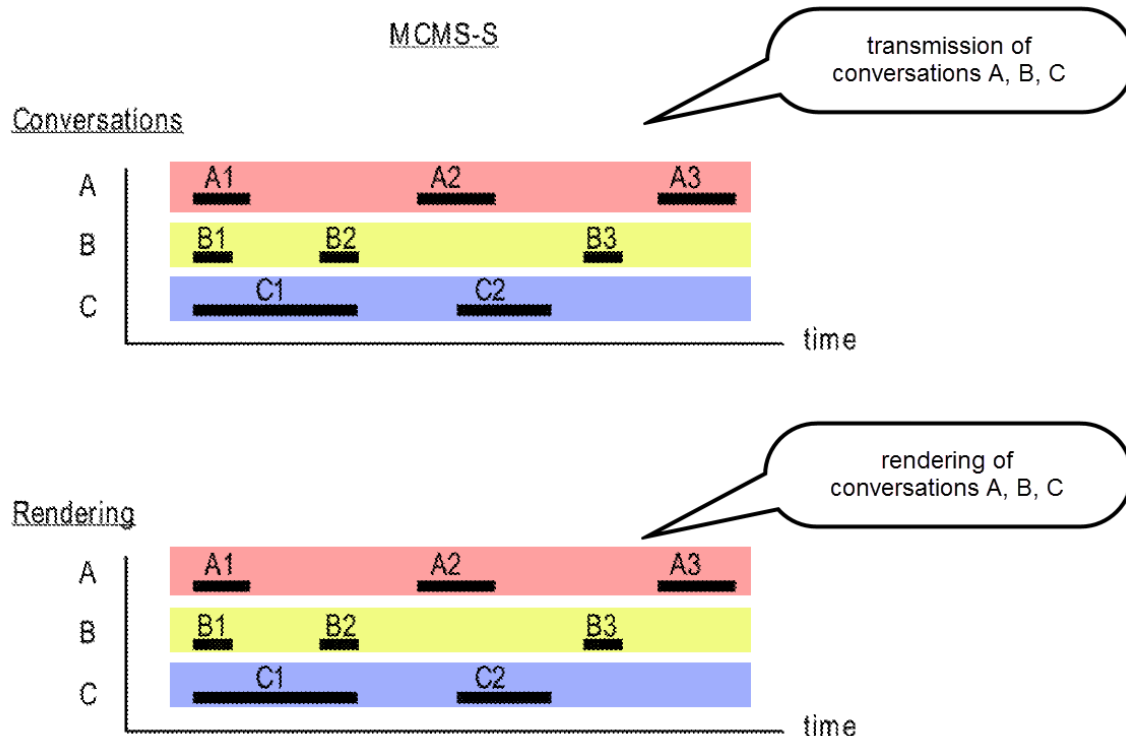


FIG. 13D

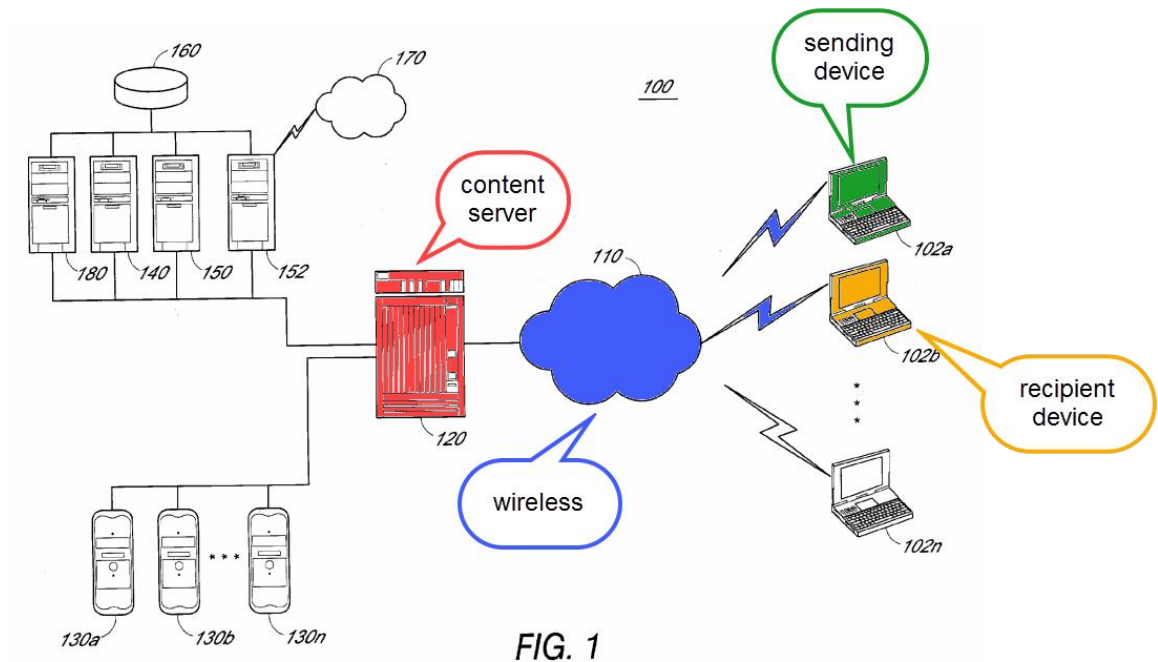
Ex. 1001 at Fig. 13D.

VI. OVERVIEW OF CLISHAM

Clisham teaches¹ a “Video Conferencing System And Method.” Ex. 1103 at Title. Clisham discusses remote video conferencing over wireless communication links. *Id.* at Abstract. Clisham explains that “[a] particular

¹ Petitioner relies on additional secondary references to attack the validity of the challenged dependent claims, but relies on Clisham alone to challenge claim 45. Accordingly, Patent Owner only addresses Clisham here.

client device, for example 102a, can initiate a video conference session with a single destination client device, for example 102b.” Ex. 1103 at ¶ 31. This is shown, for example, in Figure 1:



Id. at Fig. 1. Clisham explains that each session is limited to a **single** conversation between a **single** sender and recipient device. Ex. 1103 at ¶¶ 65-66 (describing that each session may only transmit one video conversation). Clisham’s includes a billing feature that bills end-users on a per-session basis. Ex. 1103 at ¶¶ 65, 219.

Clisham’s discussion of multicast expressly teaches that the recipient devices **must** first establish an end-to-end connection with the recipient devices before transmission by “independently enabling a session with each remote device”:

The first client device 202a can video conference with a single remote device or with multiple remote devices. The ***first client device 202a can engage in a video conference with multiple remote devices concurrently by independently enabling a session with each remote device.*** Thus, the first client device 202a can operate many independent video conference sessions. . . the client device can transmit signals to a video Server that, in turn, multicasts the signals to the multiple remote devices engaged in the video conference.

Ex. 1103 at ¶ 64.

VII. LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art (“POSITA”) relevant to the ’557 patent at the time of the invention would have at least (1) a Bachelor’s degree in electrical or computer engineering or a related course of study with at least two years of work experience in industry in the areas of computer networking, multimedia processing, or a related area of work or (2) a Master’s degree in electrical or computer engineering or a related course of study, with at least one year of experience in industry in the areas of computer networking, multimedia processing, or a related area of work. More education can substitute for practical experience and vice versa.

Patent Owner’s description of the level of ordinary skill in the art is essentially the same as that of the Petitioner, except that Petitioner’s

description requires two to three years of work with distributed multimedia systems. *See* Petition at 4. The positions set forth in this preliminary response would be the same under either parties’ proposal.

VIII. CO-PENDING LITIGATION

The ’557 patent has been at issue in district court litigation in the Western District of Texas for over one year. *Voxer, Inc. and Voxer IP LLC v. Facebook, Inc. and Instagram LLC*, Case No. 6:20-cv-00011 (W.D. Tex.) (the “Texas case”). Trial is set for January 18, 2022.

IX. CLAIM CONSTRUCTION

The ’557 patent has already gone through a full *Markman* process in the district court. The parties disputed the construction of a single term of the ’557 patent, “end-to-end connection.” The interpretation of that term is also relevant to the issues raised in the present Petition. Petitioners sought the construction “connection between network endpoints in which connection state necessary to maintain the connection exists at the endpoints.” Ex. 2009 at 19. Petitioner urged the District Court that an “end-to-end connection” must mean that “each endpoint has knowledge of the other endpoint with which it communicates as well as knowledge of the state of the communication.” *Id.* at 21. Petitioner argued in the district court that UDP transmission does not store the connection state at the sending and recipient

devices, and therefore UDP is an example of a transmission protocol that transmits without an end-to-end connection. *Id.* at 23 (“As UDP is connectionless, no ‘end-to-end connection’ need be established with UDP before a sender may transmit information.”). However, the District Court rejected Petitioner’s construction, and gave “end-to-end connection” its plain and ordinary meaning. Ex. 2004; Ex. 2010.

As to all other claim terms, Patent Owner has applied their plain and ordinary meaning in this Preliminary Response. If *inter partes* review is instituted, Patent Owner reserves the right to raise additional claim construction arguments as appropriate.

X. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY THE PETITION UNDER § 314(A)

The precedential *Fintiv* decision identifies several factors that balance considerations of system efficiency, fairness, and patent quality when a Patent Owner raises an argument for discretionary denial due to the advanced state of a parallel proceeding. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB March 20, 2020). These factors include:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;

3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Id.; see also *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (considering an earlier trial date as a factor in favor of discretionary denial). The Board examines these factors, which relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution. *Fintiv*, IPR2020-00019, Paper 11 at 6, 9. In evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review. *Id.*

The current state of the Texas case, as well as the tremendous investment in that case, favors denial of the Petition. Indeed, Petitioner waited over nine months after the complaint was filed to file their Petition. The validity of the challenged claims will be addressed in the Texas jury trial on January 18, 2022, ***four months*** before the Board issues its final written

decision here. Ex. 2003. Further, Petitioner's claim charts rely on the same prior art cited in the Petition's grounds. Ex. 2011 at 1-233 (Brueck), 234-399 (Schmitt), 400-777 (Clisham). Accordingly, the district court will determine the validity of the challenged patent, based on the *same* grounds presented in this petition, months before a final written decision in this IPR.

The parties have also spent considerable time and resources in the litigation. Petitioner has already served both preliminary and final invalidity contentions. The district court has issued a claim construction order after full briefing by the parties and a hearing. Likewise, fact discovery, expert discovery, dispositive motions, and the trial itself addressing the validity of the '557 patent will also have been completed in advance of the Board's final written decision. Therefore, instituting here, on the same invalidity arguments asserted against the same patent in the parallel district court litigation is contrary to the AIA's goal of providing for an effective and efficient means to resolve questions of validity. *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16-17 (PTAB Sept. 6, 2017)

1. Factor 1: There is No Evidence the Court Would Grant a Stay in View of Institution

Factor 1 favors discretionary denial. Petitioner does not argue that institution would result in a stay of the Texas case. Nor has Petitioner requested a stay. Even if Petitioner did seek a stay, at this late stage of the

litigation, it would not likely be granted, given the significant time and resources expended on the litigation to date. Thus, in the absence of a motion to stay, this factor weighs in favor of denial or is, at worst, neutral. *See Fintiv*, IPR2020-00019, Paper 15, at 12 (“A judge determines whether to grant a stay based on the facts of each specific case as presented in the briefs by the parties. We decline to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here.”); *Supercell Oy v. Gree*, IPR2020-00215, Paper 10 at 9 (PTAB June 10, 2020) (Board finds factor neutral where the record “is silent as to whether the district court has granted a stay, or has commented on the possibility of a stay in this case.”).

2. Factor 2: The Advanced Stage of the District Court Trial Weighs In Favor of Denial

Factor 2 weighs in favor of discretionary denial. Precedent requires the Board to consider the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision” in the parallel proceeding. The trial date in the Texas case is currently set for January 18, 2022—**four months** before the Board’s Final Written Decision would issue if institution were granted. This fact alone weighs heavily in favor of denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15, at 13, 17 (PTAB May 13, 2020) (Trial precedes Board decision by **2 months**); *U.S. Venture, Inc. v.*

Sunoco Partners Marketing & Terminals L.P., IPR2020-00728, Paper 10 at 8-9 (PTAB Oct. 1, 2020) (finding that factor 2 favored denial where the trial date was not set but the Board estimated trial “some **three or four months** before we issue our final decision”).

Further, the litigation is in advanced stages. Indeed, as already discussed, Petitioner waited **nine months**² after the complaint was filed before filing this petition. The complaint was filed more than a year ago on January 7, 2020. Since then, the parties have exchanged multiple document productions and source code productions. Petitioner served preliminary invalidity contentions on July 1, 2020, more than **seven months** ago. Ex. 1029. Likewise, Petitioner served final invalidity contentions on January 14, 2021, more than **three months** before the institution decision deadline in this proceeding. The district court issued its claim construction order months ago as well, on October 29, 2020, after full briefing by the parties and a hearing. Ex. 2002. Thus, the litigation is significantly ahead of this IPR.

² The initial scheduling order issued on May 12, 2020. Thus, Petitioner was aware at least as of that date that the trial was quickly approaching. Ex. 1029.

3. Factor 3: The Investments of the Parties and the Court Favor Denial

Factor 3 weighs strongly in favor of discretionary denial. “[The] more work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Fintiv*, IPR2020-00019, Paper 11 at 10.

As already discussed, the parties and the district court will have already invested a substantial amount of time and effort in the parallel proceeding—including completing fact discovery, expert discovery, and preparing for and holding a jury trial—by the time the Board issues a final written decision in May 2022. Ex. 2003.

Likewise, as discussed with respect to Factor 2, the parties and the Court have already heavily invested in the district court case. The parties have exchanged multiple document productions and source code productions. Petitioner has served both its preliminary and final invalidity contentions. The parties have fully briefed and argued claim construction issues, and the Court has issued a *Markman* order.

Further, the invalidity case in the litigation is identical to the Petition. Thus, instituting the petition will be duplicative of the efforts already expended in district court, wasting time and resources.

4. Factor 4: The Issues and Arguments Raised in the Petition are The Same as Those in District Court

Petitioner challenges the same claims of the '557 patent based on the same grounds as those at issue in the litigation. Ex. 2005. As discussed above, Petitioner's invalidity claim charts rely on the same art presented in the Petition. Additionally, Petitioner has not stipulated to withdraw any reference or combination of references cited in the Petition from the parallel district court litigation. This strongly favors discretionary denial because the same invalidity issues would continue to be litigated here and in the district court, and distinguishes this case from others where the withdrawal of invalidity arguments in district court was found to favor institution. *Cf. Sand Revolution II, LLC v. Continental Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 11-12 (June 16, 2020); *Apple Inc. v. Maxell, Ltd.*, IPR2020-00204, Paper 11 at 15-17 (June 19, 2020). Accordingly, there is complete overlap of issues and arguments between the two proceedings.

5. Factor 5: Petitioner and the defendant in the district court litigation are the same parties

Petitioner and Defendants are the same parties. Accordingly, this factor weighs in favor of denial, especially in light of the other factors.

6. Factor 6: The COVID-19 Virus Does Not Weigh in Favor of Denial

No other compelling circumstances support institution. The specific factors addressed above each weigh strongly in favor of denial of institution under §314(a) and in line with *NHK Spring*, as discussed above. As such, any balancing of these factors demonstrates that efficiency and integrity of the AIA are best served by denying review. *Fintiv*, IPR2020-00019, Paper 11 at 6. And no other circumstances that impact the Board’s exercise of discretion under §314(a) demonstrate otherwise. Indeed, the merits of the grounds asserted in the instant Petition are far from strong, for the reasons discussed further in this preliminary response. Nevertheless, even where “the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present.” *Fintiv*, IPR2020-00019, Paper 11, at 15; *E-One, Inc. v. Oshkosh Corp.*, IPR2019-00162, Paper 16 at 8, 13, 20 (denying institution based on earlier district court trial date, weakness on the merits, and the district court’s substantial investment of resources considering the invalidity of the challenged patent).

In particular, the district court case is unlikely to be delayed due to the COVID-19 pandemic. Indeed, even before any COVID-19 vaccines were approved, the Court did not delay the trial. The FDA has since approved multiple COVID-19 vaccines with effectiveness rates around 95%. *See, e.g.*,

Ex. 2007. Texas has already administered over one million vaccines, more than any other state. *See* Ex. 2008. The district court case is currently set for trial in January 18, 2022. Ex. 2003. Thus, the trial will take place many months after the general population will have been vaccinated against the virus. Petitioner has cited no evidence that the trial will be delayed in these circumstances, let alone evidence that the trial will be delayed more than four months necessary to take it beyond the final written decision period. Petitioner has also cited no evidence supporting their conclusory assertion that the COVID-19 virus will delay trials on the 2022 docket.

For all of these reasons, the facts of this case—like those in *NHK Spring* (and its progeny)—support the conclusion that “[i]nstitution of an inter partes review under these circumstances would not be consistent with ‘an objective of the AIA ... to provide an effective and efficient **alternative** to district court litigation.’” *NHK Spring*, Case IPR2018-00752, Paper 8 at 20 (emphasis added) (quoting *Gen. Plastic*, Case IPR2016-01357, Paper 19 at 16–17); *Fintiv*, IPR2020-00019, Paper 11, at 6. The Board should deny institution under §314(a).

XI. GROUNDS 1-4: CLISHAM FAILS TO RENDER OBVIOUS CLAIM 45 OF THE ’557 PATENT

Petitioner relies on Clisham alone to challenge claim 45, the only independent claim challenged in the Petition. However, Clisham fails to

render obvious claim 45. First, Clisham fails to teach coordinating the transmission of multiple messages to allow for simultaneous rendering as recited in claim 45. In fact, Clisham teaches the ***opposite***—disclosing that each transmission may contain only ***one*** conversation. Likewise, Clisham fails to teach transmitting a message without establishing an end-to-end connection as required by claim 45. Instead, Clisham expressly discloses that an end-to-end connection, referred to as a “session,” must first be established before message transmission.

A. **Clisham fails to disclose “the transmission of [a first and second video message] occurring so that the recipient device can simultaneously render” portions of the messages**

Claim 45 recites that its video message service infrastructure transmits video messages from a first and a second sending device, “the transmission...occurring so that the recipient device can simultaneously render” at least a portion of each video message. Ex. 1001 at claim 45. Thus, claim 45 is directed at a specific method of transmission that allows for simultaneous rendering of multiple video messages transmitted by different senders. Petitioner argues that Clisham’s teaching of displaying multiple video sessions at the recipient device discloses this limitation. However, Clisham does not teach transmission for simultaneous rendering, rather, it

teaches the same one-session-per-channel technique expressly criticized by the '557 patent.

In particular, the '557 patent criticizes prior art systems in which “***only one message can be sent at a time per channel.***” Ex. 1001 at 3:1-3. To overcome this problem, the '557 patent teaches configuring the video message service infrastructure's transmission protocol to allow for simultaneous rendering of multiple video messages from different senders at the recipient device. Annotated Figure 13D of the '557 patent illustrates an example of the claimed transmission protocol coordinating the transmission of three conversations—A, B, and C—so that the message service infrastructure simultaneously renders video messages from a plurality of senders in real time at the end-user device:

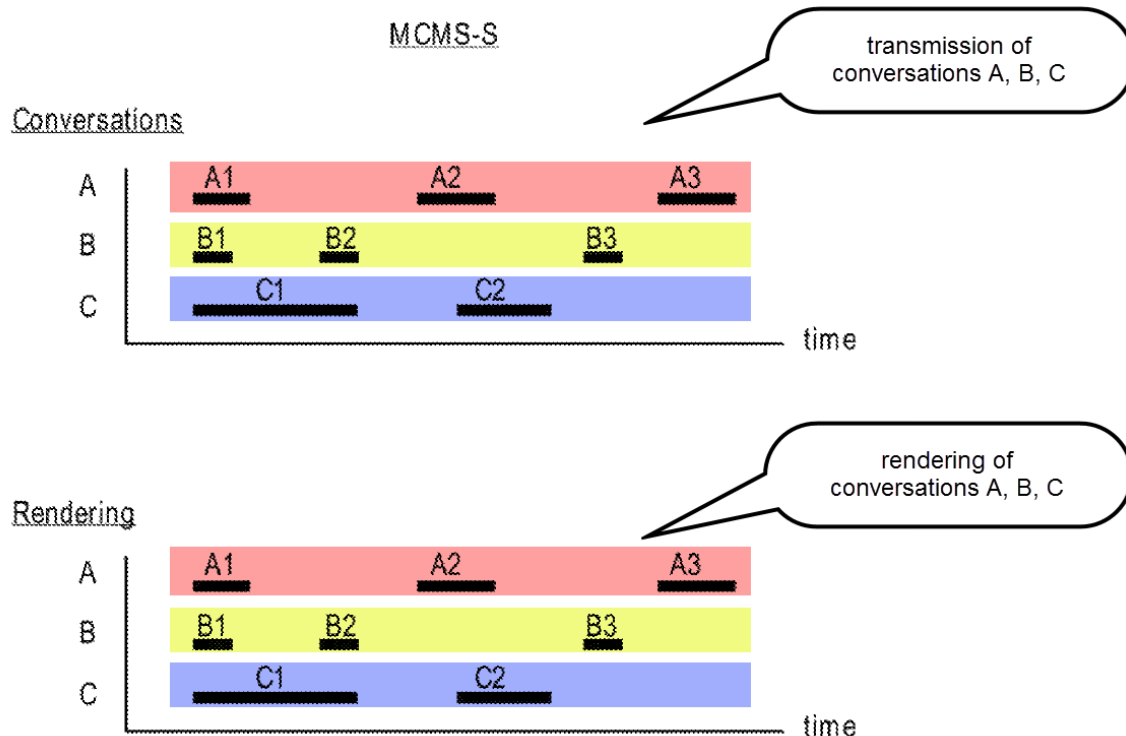


FIG. 13D

Ex. 1001 at Fig. 13D. The '557 patent further describes how to coordinate the transmission of multiple messages, for example, by segmenting and indexing messages *before* transmission:

Conversations are defined by a threaded sequence or organization of Messages. The Messages are segmented from a stream of media, with *each Message given a sequence identifier and indexed by the time the Media was created*. Depending on the variation of the MCMS application, Messages can be rendered in accordance with one or more render options.

Ex. 1001 at 37-47. Thus, consistent with the specification, claim 45’s “transmission” limitation requires that the claimed video message service infrastructure’s transmission protocol permits simultaneous rendering by an end-user, for example, by segmenting and indexing messages.³

The ’557 patent further explains that simultaneous rendering involves selecting these “multiple conversations” which can be simultaneously rendered through, *e.g.*, indexing techniques. Ex. 1001 at 8:66-9:4. The ’557 patent explains:

In the MCMS-S or simultaneous mode. . ***the indexed media payload streams associated with the set of Conversations are simultaneously rendered*** on the Device 13, regardless if they overlap or not.

Ex. 1001 at 43:60-65.

However, Petitioner ignores these disclosures and argue that Clisham’s one-message-per-channel setup—the very configuration criticized by the ’557 patent—discloses this limitation. To support their assertion Petitioner argues,

³ Of course, there are other ways that the transmission could be customized to enable simultaneous rendering—but none are disclosed by Clisham or raised by Petitioner.

without supporting citations to the '557 patent, that claim 45 is disclosed by Clisham because its end-user device may view separate videos from a plurality of senders by opening multiple **distinct** conversation “sessions,” and keeping each separate session window open on the screen. Petition at 27 (“[I]n the case of multiple independent video conference sessions, Clisham explains that the video media for each active session ‘can be displayed by the client device as multiple windows, with one window displaying the received video for each active session.’”).

However, as discussed above, this is the very system architecture criticized by the '557 patent. Indeed, Clisham does not disclose the coordinated transmission that enables simultaneous recited by claim 45. Instead, Clisham specifically limits its transmission to a **single** conversation from a **single** sender, without any attempt to combine, interleave, or otherwise coordinate that single conversation from a single sender with any other conversation from any other sender:

A first client device 202a can engage in an active video conference session with a second client device, for example 202b. The first client device 202a can then initiate a video conference session with a third client device, for example 202c. However, the second client device 202b and the third client device 202c are not in communication. ***If the second client device 202b desires to video conference with the third client***

device 202c, an independent video conference needs to be set up between those devices. . . . Multiple video conference sessions can be displayed by the client device as multiple windows, with one window displaying the received video for each active session.

Ex. 1103 at ¶¶ 65-66.

Thus, Clisham's one-session-per-channel setup stands in direct contrast to the '557 patent's claimed technique of simultaneously rendering video messages from a plurality of senders. Accordingly, Clisham fails to disclose this limitation.

B. Clisham fails to render obvious “transmission. . . without having to first establish and end-to-end connection over the network between [the sending and recipient devices]”

Claim 45 further requires that the video message service infrastructure transmits a first and second video message “without having to first establish and end-to-end connection” between the sending and recipient devices. Ex. 1001 at claim 45.

Petitioners first argues that a POSITA would understand that Clisham transmits video to recipients without establishing an end-to-end connection based on its teaching of multicast transmission. Petition at 30. In fact, Clisham teaches precisely the opposite: Clisham's transmission device

always establishes an end-to-end connection with the recipient device before transmission by “independently enabling a session with each remote device”:

The first client device 202a can video conference with a single remote device or with multiple remote devices. The ***first client device 202a can engage in a video conference with multiple remote devices concurrently by independently enabling a session with each remote device***. Thus, the first client device 202a can operate many independent video conference sessions. . . the client device can transmit signals to a video Server that, in turn, multicasts the signals to the multiple remote devices engaged in the video conference.

Ex. 1103 at ¶ 64. The “sessions” discussed in Clisham are explicitly end-to-end connections between the sending and receiving devices. *E.g., id.* at ¶¶ 10 (“a video conference session between the source device and the destination device”), 31 (“The system 100 enables each of the client devices 102a-102n to initiate, or accept, video conference sessions with one or more of the other client devices 102a-102n.”).

These “sessions” must be established with special signaling mechanisms before any video data can be transmitted. *E.g., id.* at ¶¶ 101 (“Additionally, the first client device 202a includes a session control module 242 that communicates with servers, such as the billing server 212, and other client devices, such as 202b-202d, to set up, manage, and terminate video

conference sessions.”), 102 (“The session control module 242 can accept the user inputs to initiate a video conference session with a remote device.”). For example, the session must be established before the camera and microphone even start capturing any data. *Id.* (“For example, the session control module 242 can control the camera 220 and microphone 230 to begin capturing video and audio after the start of a video conference session.”). Thus, Clisham’s sending device first establishes a session—*i.e.*, an end-to-end connection—before transmitting video messages.

Moreover, contrary to Petitioner’s assertion, there is nothing inherent in the use of multicast transmissions versus unicast transmission that prohibits an end-to-end connection. Clisham’s server receives multicast packets that are explicitly ***addressed to the recipients*** (*i.e.*, using IP multicast addresses rather than any higher-level identifiers), not to the intermediate server. *Id.* at ¶ 43 (“The video server can receive the video stream, audio stream, and ***addresses of the destination client devices*** and multicast the video stream and audio stream to the destination client devices.”). In this situation, Clisham’s server simply acts as a typical networking appliance such as a switch or a router, forwarding packets to their initially-addressed destination. Accordingly, Clisham’s disclosure of multicast does not show the claimed transmission without an end-to-end connection.

Petitioner next argues that Clisham’s disclosure of a “connectionless” UDP transport-layer protocol confirms that no end-to-end connection need be established in Clisham before transmission. Petition at 30-31. This argument, again, ignores Clisham’s express disclosure of end-to-end “sessions” established before transmission. Ex. 1103 at ¶ 64. Moreover, Petitioner improperly re-litigates its unsuccessful claim construction position from District Court, where they sought the construction “connection between network endpoints in which connection state necessary to maintain the connection exists at the endpoints.” Ex. 2009 at 19. Petitioner urged the District Court that an “end-to-end connection” must mean that “each endpoint has knowledge of the other endpoint with which it communicates as well as knowledge of the state of the communication.” *Id.* at 21. Petitioner argued in the district court that UDP transmission does not store the connection state at the sending and recipient devices, and therefore UDP is an example of a transmission protocol that transmits without an end-to-end connection. *Id.* at 23 (“As UDP is connectionless, no ‘end-to-end connection’ need be established with UDP before a sender may transmit information.”).

But the District Court rejected Petitioner’s construction and gave “end-to-end connection” its plain and ordinary meaning. Ex. 2004. As Patent Owner explained in the district court, and the Court agreed, according to its

plain and ordinary meaning an end-to-end connection does **not** require that the sending and receiving devices store a connection state as Petitioners suggest. As Patent Owner argued to the district court in support of its construction, an “end-to-end connection” is instead one in which the sending and receiving devices directly communicate with each other. *See, e.g.* Ex. 2010 at 7 (citing Ex. 2007) (“An end-to-end connection refers to a connection between two systems across a switched network. For example, the Internet is made up of a mesh of routers. Packets follow a hop-by-hop path from one router to the next to reach their destination.”). Clisham’s UDP transmission establishes an end-to-end connection, which it calls a “session,” before transmission. Ex. 1103 at ¶ 64.

Moreover, it is clear UDP establishes an end-to-end connection with the recipient device. This is confirmed, for example, by the fact that UDP packets at the sending device **include the destination address**. *See, e.g.*, Ex. 2012 (explaining that UDP packets include both the source and destination address: “The pseudo header conceptually prefixed to the UDP header **contains the source address, the destination address**, the protocol, and the UDP length. This information gives protection against misrouted datagrams.”). Petitioner’s argument that UDP cannot support an end-to-end connection fails to hold water.

Accordingly, Clisham fails to render obvious claim 45.

XII. CONCLUSION

A trial before the Board will not serve as an “efficient alternative” to the Texas district court litigation, but will simply be a duplicative proceeding that wastes the Board’s resources and creates a risk of the Board and the district court reaching inconsistent determinations on the same arguments. Further, the Petition’s Grounds fail on the merits. Accordingly, discretionary denial is appropriate.

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Respectfully submitted,

By: /s/ James M. Glass
James M. Glass (Lead Counsel)
Reg. No. Reg. No. 46,729
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Avenue, 22nd Floor
New York, NY 10010
P: 212-849-7142 / F: 212-849-7100
jimglass@quinnemanuel.com
*Lead Attorney for Patent Owner –
Voxer IP, LLC*

CERTIFICATE OF COMPLIANCE

I hereby certify that this paper complies with the type-volume limitation of 37 C.F.R. § 42.24 because it contains 6,359 words, excluding the parts of the paper exempted by 37 C.F.R. § 42.24(b).

/s/ James M. Glass
James M. Glass
Reg. No. 46,729

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certify that PATENT OWNER'S PRELIMINARY RESPONSE, and all exhibits and other documents filed together with the preliminary response, were served on February 12, 2021 by e-mailing copies to:

FBVoxerIPRKVP@keker.com

Date: February 12, 2021

Respectfully submitted,

/s/ D'Andrea Green
D'Andrea Green