UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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WHATSAPP INC. and FACEBOOK, INC.,
Petitioner,

v.

TRIPLAY, INC.,
Patent Owner.

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Case IPR2015-00740
Patent 8,332,475 B2

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Before BENJAMIN D. M. WOOD, BRIAN J. McNAMARA, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

WhatsApp Inc. and Facebook, Inc. (collectively "Petitioner") filed a Petition on February 14, 2015, requesting an *inter partes* review of claims 1, 6, 9, 12, 17, 18, 23, 28, 37, and 39–42 of U.S. Patent No. 8,332,475 B2 (Ex. 1001, "the '475 patent"). Paper 1 ("Pet."). Patent Owner, TriPlay Inc., filed a Preliminary Response to the Petition on May 26, 2015 (Paper 12, "Prelim. Resp.").

Based on these submissions, we instituted trial as to claims 1, 6, 9, 12, 17, 18, 23, 28, 37, and 39–42 of the '475 patent on the following grounds:

Reference(s)	Basis	Claim(s) Challenged
Coulombe[1]	§ 103	1, 12, 23, 37, 39, and 41
Coulombe, Druyan,[2] and Tittel[3]	§ 103	6, 9, 17, 18, 28, 40, and 42

Paper 13 ("Dec. on Inst."). In our Decision on Institution, we observed that after the filing of the Petition and the Preliminary Response, the United States Court of Appeals for the Federal Circuit issued an opinion in *Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2016) (en banc in relevant part), "which modified the law regarding when to treat a claim recitation as a means-plus-function element under 35 U.S.C. § 112, ¶ 6." Dec. on Inst. 8 n.4. Additionally, we instructed the parties that

> [a]t the initial conference call scheduled on the date indicated in the accompanying Scheduling Order, the parties should be

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[1] U.S. Patent App. Pub. No. 2003/0236892 A1, published. Dec. 25, 2003 (Ex. 1003, "Coulombe").
[2] US Patent No. 6,928,617 B2, issued Aug. 9, 2005 (Ex. 1004, "Druyan").
[3] Ed Tittel et al., *More HTML for Dummies* (2d ed. 1997) (Ex. 1005, "Tittel").

> prepared to discuss the impact of *Williamson* on this proceeding, including whether the terms "media block" and "access block" of claims 1 and 39, and "block" of claims 9 and 40 of the '475 patent should be interpreted as means-plus-function limitations pursuant to 35 U.S.C. 112, sixth paragraph. *See Williamson* at *6–7. The parties also should be prepared to discuss whether additional briefing on the matter is warranted, and, if so, an appropriate briefing schedule.

Id. After the initial conference call on September 24, 2015, our Order summarizing the call noted that

> [t]he Scheduling Order requested that the parties come to the initial conference prepared to discuss whether certain terms, such as "media block" and "access block" should be treated as means-plus-function limitations in view of *Williamson v. Citrix Online, LLC*, No. 2013-1130, 2015 WL 3687459 (Fed. Cir. June 16, 2015) (en banc in relevant part). Paper 14, 2–3. During the conference, the parties advised us that they had conferred and were prepared to stipulate that the claims do not recite means-plus-function limitations. **Noting that we may not agree with their conclusion, we asked the parties to address the constructions and the impact of *Williamson* in the Patent Owner Response and the Petitioner Reply**.

Paper 23, 5 (emphasis added). After institution, Patent Owner filed a Patent Owner's Response (Paper 33, "PO Resp."), and Petitioner filed a Reply (Paper 39, "Pet. Reply").

An oral hearing was conducted on May 19, 2016. A transcript of the oral hearing is included in the record. Paper 60 ("Tr.").

This decision is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 1, 6, 9, 12, 17, 18, 23, 28, 37, and 39–42. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that claims 1, 6, 9, 12, 17, 18, 23, 28, 37, and 39–42 of the '475 patent are unpatentable.

A. Related Proceedings

Petitioner indicates that the '475 patent is the subject of a pending United States District Court proceeding captioned *TriPlay, Inc. et al. v. WhatsApp Inc.*, Case No. 1:13-cv-1703-LPS (D. Del. Oct. 15, 2013). Pet. 1. Further, related patent U.S. Patent No. 8,874,677 B2 is the subject of Petitions in IPR2016-00717 and IPR2016-00718.

B. The '475 Patent

The '475 patent is directed generally to electronic messaging between communication devices. Ex. 1001, Abstract. More specifically, the '475 patent describes converting and or adapting formats/layouts of messages to be sent between an origination device and a destination device. *Id.* Referring to Figures 1 and 5, the '475 patent describes messaging system 16 as including access block 21 and media block 23. *Id.* at 12:62–65; 16:18–27. Access block 21 may include users' gateway 211 and third-party applications' gateway 214 that support communication with communication devices and third party applications via corresponding networks. *Id.* at 13:4–7; Fig. 2. For sending a message from an originating device to a destination device, the '475 patent describes media block 23 "configured to select the format and message layout fitting to the destination device and to convert the message accordingly before facilitating its delivery to the destination device." *Id.* at 16:24–27. Converting includes transcoding the message format and/or adapting the message layout. *Id.* at 16:28–30. Message manager 231 is configured to provide layout adaptation and/or repackaging. *Id.* at 34–37.

As an example of operation, Figure 6 is reproduced below.
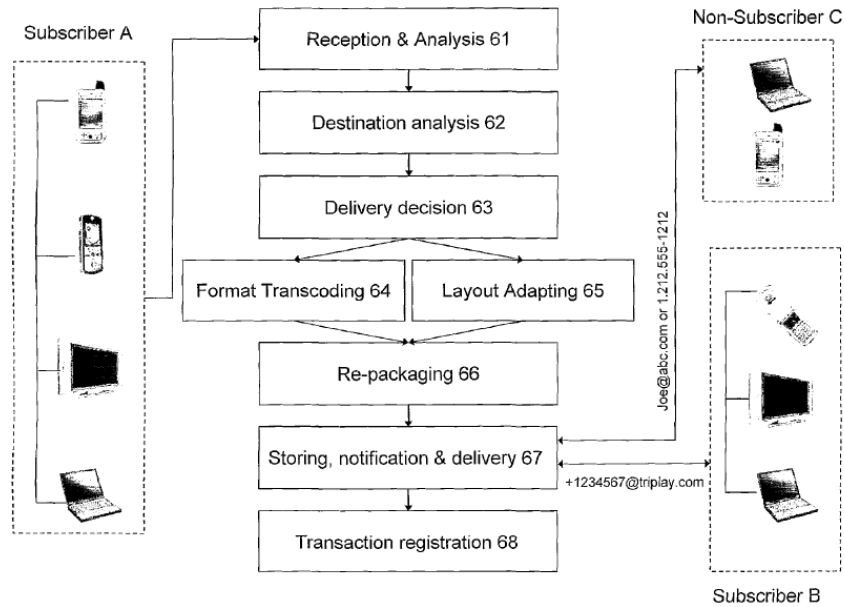
Figure 6

Figure 6 shows a generalized flow diagram of operating messaging system 16. *Id.* at 16:17–19. Messaging system 16 is connected with networks 13, 14 and/or 15 illustrated in Figure 1 in a manner that the message communication originated by the subscriber and/or designated to the subscriber shall pass through messaging system 16. *Id.* at 16:41–46. As shown in Figure 6, Subscriber A composes a message at one of the communication devices assigned and sends the message to Subscriber B and Non-subscriber C. *Id.* at 16:46–49. As the message is originated by the subscriber, it will be re-addressed to messaging system 16. *Id.* at 16:49–51. Messaging system 16 receives the message and analyzes 61 originating and destination addresses comprised in the message. *Id.* at 16:51–53.

If it is found that the destination device is assigned to a subscriber (e.g., per domain name assigned to the subscribers, IP address or other device attribute stored in the database, etc.), the system decides 62 on the destination device, and takes a delivery decision 63 accordingly. Ex. 1001, 16:53–58. The delivery decision comprises delivery instructions with regard

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