

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHATSAPP INC. and FACEBOOK, INC.

Petitioner

v.

TRIPLAY, INC.

Patent Owner

IPR2015-00740

Patent 8,332,475 B2

PATENT OWNER'S LIST OF PROPOSED MOTIONS

In anticipation of the initial conference call scheduled for September 18, 2015, TriPlay, Inc. (“Patent Owner”) hereby submits a list of proposed motions presently contemplated or for which it may seek future authorization.

1. Motion for Additional Discovery

In the event the parties cannot agree on additional discovery, Patent Owner seeks authorization to file a motion for narrowly tailored discovery with respect to the secondary considerations “long felt need” and “commercial success.”

As to long felt need, WhatsApp’s own patent application, Ser. No. 12/732,182, which was filed on March 25, 2010 and published on November 22, 2012 as US 2012/0294352, establishes at paragraphs 5 through 8 that there is more than a mere possibility and mere allegation that WhatsApp has documents regarding long felt need.

Further as to long felt need and commercial success, the required nexus is more than a possibility and mere allegation because the claims of the ‘475 patent cover the entire process by which WhatsApp, Inc. derives its revenues.

2. Motion to Exclude Petitioner’s Expert David Klausner

In Patent Owner’s Objections To Evidence Submitted In The Petition, Patent Owner objected to Petitioner’s Expert on the grounds that there is nothing in the record establishing that David Klausner is qualified to opine as to the knowledge of a person of ordinary skill in the art at the time of the ‘475 patent. Patent Owner

respectfully requests that the Board consider a motion to excluded David Klausner after Patent Owner has had the opportunity to take Mr. Klausner's deposition.

3. Contingent Motion to Amend

Patent Owner may move to amend one or more claims of the '475 patent. Any such amendments will be made to respond to one or more of the grounds of unpatentability involved in the trial, and will not enlarge the scope of the claims of the '475 patent (37 C.F.R. § 42.221(a)(2)(i)) or introduce new matter (37 C.F.R. § 42.221(a)(2)(i)).

Although Patent Owner does not presently contemplate filing additional motions, Patent Owner reserves the right to seek subsequent authorization for motions consistent with the relevant rules.

Respectfully submitted,

Dated: September 16, 2015

By /Barry J. Schindler/
Barry J. Schindler (Reg. No. 32,938)
Greenberg Traurig, LLP
200 Park Avenue
P.O. Box 677
Florham Park, NJ 07932
Telephone: 973-360-7900
Facsimile: 973-301-8410
SchindlerB@gtlaw.com
njdocket@gtlaw.com

 /Jeremy J. Monaldo/
Jeremy J. Monaldo (Reg. No. 58,680)

Fish & Richardson P.C.
1425 K Street, NW
11th Floor
Washington, DC 20005
Telephone: 202-783-5070
Facsimile: 202-783-2331
monaldo@fr.com

Counsel for Patent Owner TriPlay Inc.