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Paper No. 23
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHATSAPP INC. and FACEBOOK, INC.,
Petitioner,

v.

TRIPLAY, INC.,
Patent Owner.

Case IPR2015-00740
Patent 8,332,475 B2

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

McNAMARA, *Administrative Patent Judge*.

INITIAL CONFERENCE SUMMARY
Conduct of the Proceeding
37 C.F.R. § 42.5

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An initial conference in this proceeding, which concerns U.S. Patent 8,332,475 B2 (the ’475 Patent), was conducted on September 18, 2015. WhatsApp Inc. and Facebook, Inc. (collectively, “Petitioner”) was represented by Reubin Chen and lead counsel, Heidi Keefe. Triplay, Inc. (“Patent Owner”) was represented by lead counsel, Barry Schindler, back-up counsel Jeremy Mondalo, and Lennie Berch. The following subjects were discussed during the conference:

Applicable Rules

The parties are reminded that the Rules of Practice for Trials Before the Patent Trial and Appeal Board, as amended on May 19, 2015, are now in effect.

Related Matters

The parties stated that the ’475 Patent is not currently the subject of any re-examination proceeding. The parties also reported that the corresponding district court litigation has not been stayed at this time.

Scheduling Order

Both parties confirmed that they seek no changes to the current Scheduling Order. The parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1–5, as provided in the Scheduling Order, by filing an appropriate notice with the Board. The parties may not stipulate to any other changes to the Scheduling Order.

Protective Order

The parties have not discussed a protective order at this time. No protective order has been entered in this proceeding. The parties are reminded of the requirement for a protective order when filing a motion to seal. 37 C.F.R. § 42.54. If the parties have agreed to a proposed protective order, including the default Standing Protective Order, 77 Fed. Reg. 48756, App. B (Aug 14, 2012), they should file a signed copy of the proposed protective order with the motion to seal.

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If the parties propose a protective order other than or departing from the default Standing Protective Order, Office Trial Practice Guide, *id.*, they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default Standing Protective Order in Appendix B to the Board's Office Patent Trial Practice Guide. *See id.* at 48769.

We also remind the parties of the expectation that confidential information relied upon or identified in a final written decision will be made public. *Id.* at 48760. Confidential information that is subject to a protective order ordinarily becomes public 45 days after denial of a petition to institute or 45 after final judgment in a trial. *Id.* A party seeking to maintain the confidentiality of the information may file a motion to expunge the information from the record prior to the information becoming public. 37 C.F.R. § 42.56.

Initial Disclosures and Discovery

The parties have not stipulated to any initial disclosures at this time. The parties are reminded of the discovery provisions of 37 C.F.R. § 42.51–52 and Office Trial Practice Guide. *See,* 77 Fed. Reg. at 48761–2. The parties are reminded of amendments to 37 C.F.R. § 42. 64(b)(1) concerning the filing of objections and the service of supplemental evidence in response.

Discovery requests are not to be filed with the Board without prior authorization. If the parties are unable to resolve discovery issues between them, the parties may request a conference with the Board.

A motion to exclude, which does not require Board authorization, must be filed to preserve any objection. *See,* 37 C.F.R. § 37.64(c), Office Trial Practice Guide, 77 Fed. Reg. at 48767.

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The parties are reminded of the provisions for taking testimony found at 37 C.F.R. § 42.53 and the Office Trial Practice Manual at 77 Fed. Reg. at 48772, App. D.

Motions

Prior to the initial conference, the parties each filed a list of anticipated motions. Petitioner requested authorization for a motion to file supplemental information in response to objections under FRE 702 that Patent Owner filed concerning the qualifications of Petitioner's declarant. During the conference we discussed that a motion to file supplemental information under 37 C.F.R. § 123(a), which must be filed within one month of the date trial is instituted and be relevant to a claim for which trial is instituted, would not be responsive to an evidentiary objection. Instead Petitioner should respond to Patent Owner's evidentiary objection by serving supplemental evidence within ten business days of the objection in accordance with 37 C.F.R. 64(b)(2). Petitioner noted that it would serve its supplemental evidence on September 21, 2015. It is not necessary for Petitioner to file the supplemental evidence, although Petitioner may later file it as part of response to a motion to exclude. Patent Owner noted that it would defer filing a motion to exclude the testimony to which it objected, pending its review of the supplemental evidence. Authorization to file a motion to exclude is not required. The last date to file a motion to exclude is specified in the Scheduling Order.

Before the conference, Patent Owner had advised us that it planned to seek authorization to file a motion for additional discovery. However, after a meet and confer, the parties agreed that such a motion is not necessary at this time.

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A

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party seeking to file a motion should request a conference to obtain authorization to file the motion. No motions are authorized in this proceeding at this time.

Although Board authorization is not required for the Patent Owner to file one motion to amend the patent by cancelling or substituting claims, we remind Patent Owner of the requirement to request a conference with the Board before filing a motion to amend. 37 C.F.R. § 42.121(a). The conference should take place at least two weeks before filing the motion to amend. Parties should take note of the guidance provided in *Master Image3D, Inc. v. RealD, Inc.*, Case IPR2015-00040 (PTAB July 15, 2015)(Paper 42) and cases cited therein concerning the subject matter to be included in a motion to amend.

Other Issues

The 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.

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