

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHATSAPP INC.,
Petitioner,

v.

TRIPLAY, INC.,
Patent Owner.

Case IPR2016-00717 (Patent 8,874,677 B2)
Case IPR2016-00718 (Patent 8,874,677 B2)

Before JOSIAH C. COCKS, BRIAN J. MCNAMARA, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

ORDER
Granting Parties' Joint Request for Oral Argument
37 C.F.R. §§ 42.5, 42.70

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A final written decision was entered in IPR2016-00717 on August 28, 2017, in which we determined that Petitioner had not proven, by a preponderance of the evidence, that claims 1, 2, 11, 13, 14, 16, 17, 20, and 21 of U.S. Patent No. 8,874,677 B2 (Ex. 1001, “the ’677 patent”) were unpatentable. IPR2016-00717, Paper 42. On the same day, a final written decision was entered in IPR2016-00718, in which we determined that Petitioner also had not proven, by a preponderance of the evidence, that claims 6, 7, and 15 of the ’677 patent were unpatentable. IPR2016-00718, Paper 44.

The final written decisions in both proceedings were appealed by Petitioner to the United States Court of Appeals for the Federal Circuit. *See* IPR2017-00717, Paper 43. On November 14, 2018, the Federal Circuit vacated our determination in both proceedings and remanded for further consideration the motivation to combine the clickable icons of Friedman with Coulombe and Bellordre. *WhatsApp, Inc. v. TriPlay, Inc.*, No. 2017-2549, 2018 WL 5962733 (Fed. Cir. Nov. 14, 2018).

On January 23, 2019, a telephone conference call was held between respective counsel for the parties, and Judges Cocks and Ippolito.¹ The purpose of the call was to discuss whether the parties had any request, such as additional briefing, in view of the remand by the Federal Circuit. On the call, the parties both agreed that additional briefing is not necessary for either case. The parties did, however, jointly request a post-remand oral hearing to address the remaining remanded issues, namely the evidence and arguments the parties have submitted previously regarding the combination

¹ Judge McNamara was unavailable for the call.

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of Friedman with Coulombe and Bellordre. Petitioner and Patent Owner each requested thirty (30) minutes for their respective presentations at a supplemental oral hearing.

Having considered the narrow issues remaining in these proceedings, we GRANT the parties' joint request for a supplemental consolidated oral hearing to address the parties' arguments and supporting evidence regarding the combination of Friedman with Coulombe and Bellordre.

The consolidated hearing will commence at 1:00 pm Eastern Standard Time on March 5, 2019, at the USPTO Headquarters in Alexandria, Virginia. Each party will have thirty (30) minutes of total argument time to present arguments. Petitioner bears the ultimate burden of proof that the claims at issue in this review are unpatentable. Therefore, at oral hearing Petitioner will proceed first to present its case on Petitioner's challenges to patentability. Thereafter, Patent Owner may argue its opposition to Petitioner's arguments. Petitioner may reserve time for rebuttal arguments.

The Board expects lead counsel for each party to be present in person at the oral hearing. However, lead or backup counsel may present the party's argument. If either party anticipates that its lead counsel will not be attending the oral argument, the parties should initiate a joint telephone conference with the Board no later than two business days prior to the oral hearing to discuss the matter.

Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least five business days before the hearing and filed no later than the time of the hearing. The Board requests that such exhibits be filed at the Board at least five business days before the hearing to facilitate the panel's preparation. The parties are directed to *St. Jude Medical, Cardiology*

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Division, Inc. v. The Board of Regents of the University of Michigan, IPR2013-00041, Paper 65 (PTAB Jan. 27, 2014), for guidance regarding the appropriate content of demonstrative exhibits. As a reminder, demonstrative exhibits used at the final hearing are aids to oral argument and not evidence.

Additionally, either party may request a prehearing conference with the panel to occur no later than three business days prior the oral hearing. The purpose of a pre-hearing conference is to afford the parties the opportunity to preview (but not argue) issues to be discussed at the oral hearing, and to seek the Board's guidance as to particular issues that the panel would like the parties to address at oral argument.

The parties are further advised that the hearing will be open to the public for in-person attendance, which will be accommodated on a first-come, first served basis. There is a strong public policy interest in making all information presented in these proceedings public, as the review determines the patentability of claims in an issued patent and thus affects the rights of the public. This policy is reflected in part, for example, in 35 U.S.C. § 316(a)(1) and 35 U.S. C. § 326(a)(1) which provide that the file of any *inter partes* review or post grant review be made available to the public, except that any petition or document filed with the intent that it be sealed shall, if accompanied by a motion to seal, be treated as sealed pending the outcome of the ruling on the motion.

At least one member of the panel hearing the case will attend the hearing remotely, by video and audio link. The parties are reminded that, during the hearing, the presenter must identify clearly and specifically each demonstrative exhibit references (e.g., by slide or screen number) to ensure the clarity and accuracy of the reporter's transcript, and to ensure that the

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remote judge(s) can follow the argument even if the video connection is disrupted. The parties are requested to speak directly into the microphone, including during initial introduction of counsel.

Hearing rooms are equipped with projectors for PowerPoint presentations. A party should advise the Board as soon as possible before an oral argument of any special needs. Examples of such needs include additional space for a wheelchair, an easel for posters, or an overhead projector (“Elmo”). Parties should not make assumptions about the equipment the Board may have on hand. Such requests should be directed in the first instance to a Board Trial Division paralegal at (571) 272-9797.

The Board will provide a court reporter for the hearing, and the reporter’s transcript will constitute the official record of the hearing.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that oral argument for these proceedings shall take place beginning at 1:00 pm Eastern Standard Time on March 5, 2019, at the USPTO Headquarters in Alexandria, VA.

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