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Paper 49
Entered: July 16, 2019

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

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

IPPOLITO, *Administrative Patent Judge*.

DECISION ON REMAND
35 U.S.C. § 318(a) and 35 U.S.C. § 144

I. INTRODUCTION

A. Background

WhatsApp Inc. ("Petitioner") filed a Petition requesting *inter partes* review of claims 1–5, 11–14, and 16–21 of U.S. Patent No. 8,874,677 B2 (Ex. 1001, "the '677 patent"). Paper 1 ("Pet."). TriPlay, Inc. ("Patent Owner") filed a Preliminary Response. Paper 12 ("Prelim. Resp.").

Based on these submissions, we instituted an *inter partes* review of claims 1, 2, 11, 13, 14, 16, 17, 20, and 21 of the '677 patent based on Petitioner's asserted challenge that these claims are unpatentable under 35 U.S.C. § 103 as obvious over Coulombe,[1] Bellordre,[2] and Friedman[3]. Paper 15 ("Dec.").

After institution, Patent Owner filed its Patent Owner Response on December 16, 2016 (Paper 21, "PO Resp.") and Petitioner filed a Reply (Paper 26, "Reply"). An oral hearing was held on June 12, 2017. A transcript of that hearing is available at Paper 41 ("2017 Tr.").

In due course, we issued a final written decision determining that Petitioner had not shown by a preponderance of the evidence that claims 1, 2, 11, 13, 14, 16, 17, 20, and 21 of the '677 patent are unpatentable. Paper 42, 25 ("Final Written Decision" or "FWD").

Petitioner appealed our final written decision to the United States Court of Appeals for the Federal Circuit. The court issued its decision vacating our written decision and remanding this case to the Board on

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[1] US 2003/0236892 A1 (Dec. 25, 2003) (Ex. 1003).

[2] US 2006/0176902 A1 (Aug. 10, 2006) (Ex. 1004).

[3] US 7,593,991 B2 (Sept. 22, 2009) (Ex. 1005).

November 14, 2018. *WhatsApp, Inc. v. TriPlay, Inc.*, 752 F. App'x 1011 (Fed. Cir. 2018) (nonprecedential) ("Remand Decision").

Following remand, a conference call was held between the parties and the panel. *See* Paper 44. On the call, the parties both indicated that post-remand briefing was not necessary in this proceeding. *Id.* The parties did, however, jointly request a supplemental oral hearing to address the remaining remanded issues, namely the evidence and arguments the parties have submitted previously regarding the combination of prior art references asserted in the Petition. *Id.* at 2. We granted the parties' joint request. *Id.* at 2–3. On March 5, 2019, a supplemental oral hearing was held with Petitioner and Patent Owner. A transcript of that hearing is available at Paper 47 ("2019 Tr.").

For the reasons that follow, we determine Petitioner has demonstrated, by a preponderance of the evidence, that claims 1, 2, 11, 13, 14, 16, 17, 20, and 21 of the '677 patent are unpatentable.[4]

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[4] In the Petition, Petitioner initially also presented challenges to the patentability of claims 3–5, 12, 18, and 19 of the '677 patent. We, however, were not persuaded that Petitioner was likely to prevail in those challenges, and we did not institute trial as to those claims. *See* Paper 15. Petitioner did not request rehearing. On April 24, 2018, the Supreme Court issued *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018), which held that we may not institute trial on fewer than all claims. The Federal Circuit, however, has determined that "a party's request for *SAS* relief can be waived." *Mylan Pharm. Inc. v. Research Corp. Techs, Inc.*, 914 F.3d 1366, 1376 (Fed. Cir. 2019). In this case, neither party has raised any issue pertaining to claims 3–5, 12, 18, and 19 as a part of the trial in this proceeding, before the Federal Circuit, or now on Remand. Indeed, when queried, the parties expressly stated that no further briefing on any issue was necessary (Paper 44, 2), and no mention or discussion of claims 3–5, 12, 18, and 19 was made at the supplemental oral argument on March 5, 2019. In

B. Related Proceedings

The '677 patent is also involved in IPR2016-00718.[5] The parties indicate that the '677 patent is the subject of pending litigation captioned *TriPlay, Inc. v. WhatsApp Inc.*, Case No. 1:13-cv-1703-LPS (D. Del.). Pet. 1; Paper 5, 2. Additionally, the parent to the '677 patent, U.S. Patent No. 8,332,475, was involved in IPR2015-00740. Pet. 1.

C. The '677 Patent

The '677 patent issued October 28, 2014 from an application filed November 16, 2012, and claims priority to a provisional application filed August 22, 2005. Ex. 1001, cover page. The '677 patent is directed to "cross-platform messaging" and describes a messaging system that converts the formats and layouts of messages sent between communication devices that may have different communication and display capabilities. *Id.*, Abstract, 11:53–56. Figure 1, reproduced below, illustrates a network architecture in which the messaging system may be used.

light of the circumstances present here, we determine that the parties have waived any *SAS* issue pertaining to claims 3–5, 12, 18, and 19. Accordingly, we do not address claims 3–5, 12, 18, and 19 as a part of this Decision on Remand.

[5] A post-remand Final Written Decision in IPR2016-00718 has been issued concurrently with the present Decision.

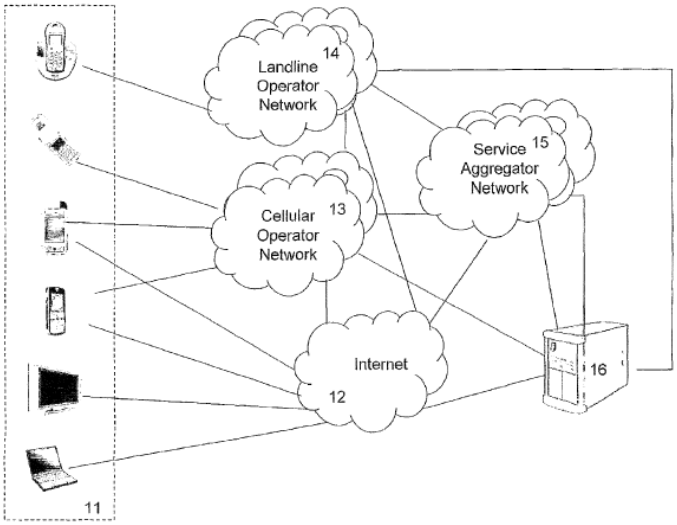

Figure 1

Figure 1 depicts various communication devices 11 (e.g., cell phone, PC) connected to at least one of Internet 12, Cellular Operator Network 13, etc. *Id*. at 11:30–40. Messages from an originating device to a destination device pass through messaging system 16, where at least one of the devices is assigned to a user registered in the system. *Id*. at 12:12–13. Messaging System 16 supports a variety of message formats such as text, video, and image. *Id*. at 12:16–21.

Figure 6, reproduced below, depicts an example of the messaging system's operation.

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