NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

WHATSAPP, INC., FACEBOOK, INC.,
Appellants

v.

TRIPLAY, INC.,
Appellee

2017-2549, 2017-2551

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2016-00717, IPR2016-00718.

Decided: November 14, 2018

HEIDI LYN KEEFE, Cooley LLP, Palo Alto, CA, argued for appellants. Also represented by REUBEN HO-YEN CHEN, MARK R. WEINSTEIN.

MICHAEL ANTHONY NICODEMA, Greenberg Traurig LLP, Florham Park, NJ, argued for appellee. Also represented by BARRY SCHINDLER.

Before DYK, WALLACH, and TARANTO, *Circuit Judges*.

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DYK, *Circuit Judge*.

WhatsApp, Inc. and its parent, Facebook, Inc., ("petitioners") appeal the Patent Trial and Appeal Board's ("the Board") Final Decisions in IPR Nos. 2016-00717 and 2016-00718. The Board declined to find claims of U.S. Patent No. 8,874,677 ("the '677 patent"), owned by TriPlay, Inc. ("TriPlay"), unpatentable as obvious. We *vacate* and *remand*.

BACKGROUND

The '677 patent, entitled "Messaging System and Method," is directed to an electronic messaging system that addresses the problem of "cross-platform messaging," wherein messaging devices have "different communication and displaying capabilities and may use different communication protocols." '677 patent, Abstract; *id.* col. 11 ll. 53–56. The specification states that such messages may be "any kind of communication objects capable to be exchanged between communication devices," *id.* col. 10 ll. 43–46, and that the messaging system of the invention "is configured to support a variety of message formats, including, . . . video format (e.g. MPEG family, WMV family, 3GPP, etc.)," *id.* col. 12 ll. 16–19. The claims would, for example, cover an embodiment in which a PC user and cell phone user can send messages to one another containing pictures and video.

Independent claim 1 of the '677 patent is representative:

> 1. A method comprising:
>
> receiving, by a messaging system, an initial message sent by an originating communication device to a destination communication device, the initial message being characterized, at least, by message format, an initial message layout and data indicative of at least one receiver associated with the in-

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itial message, wherein the initial message includes a video;

obtaining, by the messaging system, data indicative of displaying capabilities of the destination communication device;

before delivery to the destination communication device associated with the at least one receiver, enabling, by the messaging system, conversion, in accordance with a criterion related to the displaying capabilities of the destination communication device, of the initial message into an adapted message, wherein the conversion comprises:

a) providing, by the messaging system, a clickable icon:

i) based on the video from the initial message and

ii) clickable into an adapted version of the video, wherein the adapted version of the video is adapted to the displaying capabilities of the destination communication device, and

b) determining, by the messaging system, an adapted message layout, comprising the clickable icon; and

facilitating, by the messaging system, delivery of the adapted message to the destination communication device.

’677 patent, col. 23 ll. 23–51.

On March 6, 2016, WhatsApp filed two petitions for inter partes review (“IPR”) of claims 1–21 of the ’677 patent. The PTAB instituted IPR based on the first petition as to claims 1, 2, 11, 13, 14, 16, 17, 20, and 21

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(IPR No. 2016-00717), and based on the second petition as to claims 6, 7, and 15 (IPR No. 2016-00718). In both institution decisions, the Board concluded that the claims were likely unpatentable as obvious over three pieces of prior art: U.S. Patent Application No. 2003/0236892 ("Coulombe"), U.S. Patent Application No. 2006/0176902 ("Bellordre"), and U.S. Patent No. 7,593,991 ("Friedman").

Coulombe, entitled "System for Adaptation of SIP Messages Based on Recipient's Terminal Capabilities and Preferences," is directed to solving the same problem as the '677 patent and does so generally in the same way as the '677 patent. J.A. 222. The Coulombe application teaches a messaging system relating to "interoperability between terminal devices using session initiation protocol (SIP) messages and, more particularly, to multimedia content adaptation." J.A. 225 ¶ [0001]. As with the '677 patent, Coulombe recognizes the importance of interoperability, given the "wide diversity of terminal characteristics: display size and resolution, available memory, formats supported, etc." J.A. 225 ¶ [0002]. Thus, the system described in Coulombe includes a "Capability Negotiation Manager" and a "Message Adaptation Engine," which respectively "resolv[e] terminal capability information" and "manipulat[e] or modif[y] . . . message content based on the terminal capabilities, user preferences, network conditions, or any characteristics of the user, his terminal or his environment." J.A. 228 ¶¶ [0059], [0063].

There is no dispute that Coulombe discloses a majority of the claim limitations, with the exception of two limitations: adaptation of video objects (a limitation petitioners find in Bellordre) and clickable icons (a limitation petitioners find in Friedman). Together, Coulombe, Bellordre, and Friedman disclose all the limitations of the '677 patent.

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Bellordre is directed to solving the same general problem as Coulombe and the ’677 patent but solves it in a different way. However, Bellordre, unlike Coulombe, discloses a method of processing “video objects.” J.A. 238 ¶¶ [0003]–[0004].

On August 28, 2017, the Board issued final decisions in both IPRs declining to find the claims obvious. The Board explained that while all elements of the claims were disclosed by the cited prior art references, the “[p]etitioner has not explained sufficiently its reasoning for the combination of Coulombe’s message adaptation system with Bellordre’s video adaptation and delivery processes.” J.A. 16. The Board’s decision addressed only the motivation to combine Coulombe with Bellordre; the Board did not address the motivation to combine Friedman with Coulombe and Bellordre.

As to the Coulombe and Bellordre combination, the petitioners’ theory was that one skilled in the art would have been motivated to combine the video objects of Bellordre with the method of Coulombe because video was “more powerful.” J.A. 50. The Board found the petitioners’ “ha[d] not provided the necessary reasoned analysis and evidentiary support for the assertion that the incorporation of a video object for adaptation and delivery by Coulombe’s system would have been ‘common sense.’” J.A. 17–18. The Board stated that the petitioners “ha[d] not explained with reasoning or supporting evidence why a person of ordinary skill in the art, or a layperson, would consider video to be ‘more powerful’ than text or still photos.” J.A. 18. Thus, the Board concluded that the petitioners and their expert’s “comparison of televisions to text and photos is too simplistic and general, and is not directed to the particular technology at issue.” J.A. 21. Although the claims challenged in the two IPRs were different, the reasons given by the Board for finding nonobvious the claims at issue were largely identical.

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