

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WhatsApp, Inc. and Facebook, Inc.
Petitioners

v.

TriPlay, Inc.
Patent Owner

Inter Partes Review No. IPR2016-00717
U.S. Patent No. 8,874,677

PETITIONERS' NOTICE OF APPEAL

Pursuant to 37 C.F.R. § 90.2(a) and 35 U.S.C. § 142, Petitioners WhatsApp, Inc. and Facebook, Inc. ("Petitioners") hereby appeal to the United States Court of Appeals for the Federal Circuit from the Patent Trial and Appeal Board's ("Board's") Final Written Decision entered August 28, 2017 (Paper 42), and from all underlying and related findings, orders, decisions, rulings and opinions. A copy of the Board's Final Written Decision is attached hereto.

For the limited purpose of providing the Director with the information requested in 37 C.F.R. § 90.2(a)(3)(ii), Petitioners further indicate that the issues on appeal may include, but are not limited to: the Board's determination that claims 1, 2, 11, 13, 14, 16, 17, 20, and 21 have not been shown to be unpatentable under 35 U.S.C. § 103, the findings, rulings and conclusions supporting or relating to those determinations, and any other issues decided adversely to Petitioners in any orders, decisions, ruling, or opinions.

Simultaneous with this submission, three (3) copies of this Notice of Appeal are being filed with the Clerk of the United States Court of Appeals for the Federal Circuit, together with the requisite fee in the amount of \$500. In addition, a copy of this Notice of Appeal is being filed with the Patent Trial and Appeal Board and served upon counsel of record for TriPlay, Inc.

A Notice of Appeal is also being filed concurrently in the related *inter partes* review proceeding IPR2016-00718.

Petitioners' Notice of Appeal
IPR2016-00717

Dated: September 14, 2017

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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*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

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 Friedman³. Paper 15 (“Dec. on Inst.”).

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”).

We have jurisdiction under 35 U.S.C. § 6. This Decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of the challenged claims. For the reasons that follow, we determine Petitioner has 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.

B. *Related Proceedings*

The parties state that the ’677 patent is the subject of pending litigation captioned *TriPlay, Inc. v. WhatsApp Inc.*, Case No. 1:13-cv-1703-

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).

LPS (D. Del.). Pet. 1; Paper 5, 2. Petitioner further states that the parent to the '677 patent, U.S. Patent No. 8,332,475, is the subject of IPR2015-00740. Pet. 1. The '677 patent is also involved in IPR2016-00718.⁴

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.

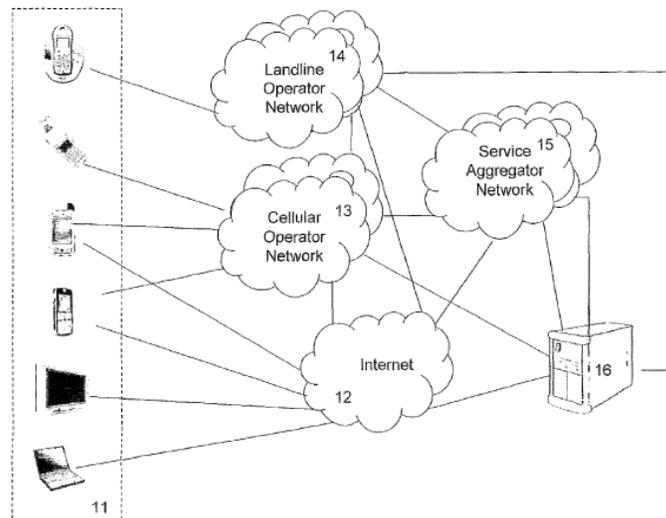


Figure 1

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.

⁴ A Final Written Decision in IPR2016-00718 has been issued concurrently with the present Decision.

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.

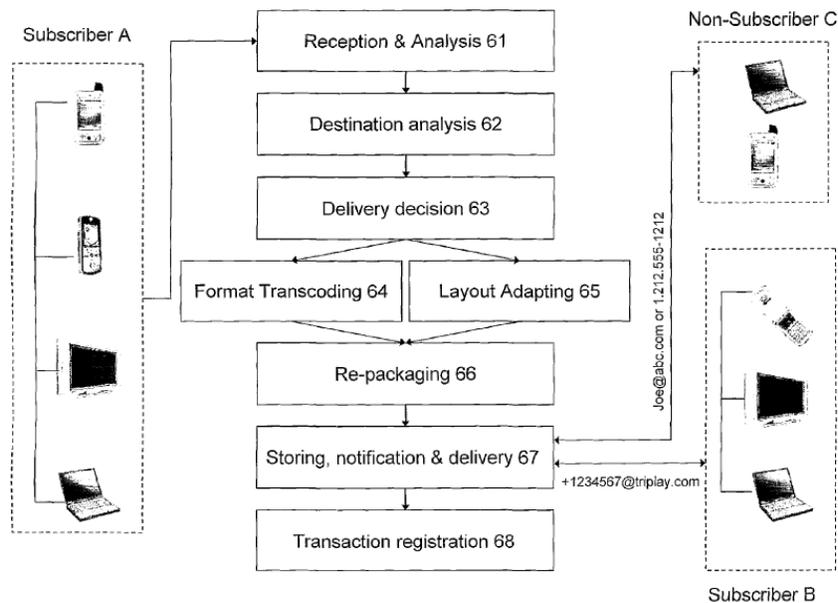


Figure 6

As shown in Figure 6, Subscriber A composes a message at one of the communication devices assigned and sends the message to Subscriber B and Non-subscriber C. *Id.* at 16:40–42. Messaging system 16 receives the message and analyzes 61 originating and destination addresses comprised in the message. *Id.* at 16:44–46. If the destination device is assigned to a subscriber, the system analyzes the destination device 62 and makes a delivery decision 63 accordingly. *Id.* at 16:45–49. The delivery decision comprises deciding, e.g., the content, format, and/or layout of the message to be delivered. *Id.* at 16:45–57. In accordance with the delivery decision, the

system provides transcoding of the message format 64 and/or adapting message layout 65 and appropriate repackaging 66 if necessary (for example, if limitations of the communication media or destination device require deleting or replacing some of the media items in the message). *Id.* at 16:64–17:3. The converted message and/or notification thereof are delivered 67 to the destination device, and the transaction is registered 68 in the system. *Id.* at 17:4–6. The described process may be provided in a similar manner for several destination devices. *Id.* at 17:6–9.

The '677 patent further describes facilitating composing messages using “pre-defined templates.” *Id.* at 19:40–42. The '677 patent describes different template “types,” each having different “Content Structures.” *Id.* at 19:50–66 (Table 1). “Each type of template and/or each template is provided with [a] unique identifier [that can be] recognized by the message system and/or client and stored in the message metadata.” *Id.* at 19:45–48. The template layout may depend on the capabilities of the destination device. *Id.* at 20:50–52. For example, Table 2 of the '677 patent describes a “General” template type with different layouts for PC, Web, and cell-phone display. For audio/video media, the cell phone layout contains a clickable icon into the video. *Id.*, Table 2. “Among advantages of certain aspects of the present invention is reduction in need of content analysis and ability to provide layout-related delivery instructions based on pre-defined rules and parameters (e.g., in a form of a look-up table).” *Id.* at 20:63–67.

D. The Challenged Claims

Of the challenged claims, claims 1, 11, and 13 are independent. Claim 1 is illustrative, and is reproduced below:

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 initial 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.

II. ANALYSIS

A. *Claim Construction*

In an *inter partes* review, a claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard in *inter partes* review). Consistent with the broadest reasonable construction, claim terms are presumed to have their

ordinary and customary meaning as understood by a person of ordinary skill in the art in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

We determine that no claim terms require express construction on this record and for purposes of this Decision. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

B. Ground Under 35 U.S.C. § 103

1. Principles of Law

A claim is unpatentable under § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); 35 U.S.C. § 103. The ultimate determination of obviousness under § 103 is a question of law based on underlying factual findings. *In re Baxter Int'l, Inc.*, 678 F.3d 1357, 1362 (Fed. Cir. 2012) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966)). These underlying factual considerations consist of: (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) “secondary considerations” of non-obviousness such as “commercial success, long-felt but unsolved needs, failure of others, etc.” *KSR*, 550 U.S. at 406 (quoting *Graham*, 383 U.S. at 17–18).

We analyze the asserted grounds based on obviousness with the principles identified above in mind.

2. *Level of Skill in the Art*

Petitioner's declarant, Mr. David Klausner, testifies that a person of ordinary skill in the art at the time of the invention would have had at least a bachelor's degree in electrical engineering or computer science (or equivalent degree or experience) with at least two years of experience in the design and implementation of systems for sending and receiving messages over a communications network, such as the Internet. Ex. 1002 ¶ 16.

Mr. Klausner adds that this "experience would include an understanding of (a) network communications protocols used to exchange messages over a network (such as the Hypertext Transport Protocol (HTTP), Simple Mail Transfer Protocol (SMTP) or Session Initiated Protocol (SIP)), and (b) formats that can be used to encode the messages exchanged over the network." *Id.*

Patent Owner's declarant, Dr. Rajeev Surati, testifies a person of ordinary skill in the art at the time of the invention is a person with a bachelor's degree in either electrical engineering or computer science, at least two years of experience designing and implementing messaging systems between user devices, and at least one year of experience working with format encoding and layout of images or video. Ex. 2002 ¶ 32.

We do not perceive any meaningful difference between the parties' definitions of the technical field of the required experience. For example, both experts testify that the level of ordinary skill entails a bachelor's degree in electrical engineering or computer science, and at least two years of experience in designing and implementing messaging systems. Ex. 1002 ¶ 16; Ex. 2002 ¶ 32. Based on the complete record, including our review of the '677 patent and the types of problems and solutions described in the '677

patent and cited prior art, we agree with both parties' assessments of the level of ordinary skill in the art and our analysis would be the same using either definition. As noted, we have also considered the cited references as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the level of ordinary skill in the art may be evidenced by the cited references themselves).

3. *Claims 1, 2, 11, 13, 14, 16, 17, 20, and 21—Obviousness over Coulombe, Bellordre, and Friedman*

We instituted trial on the ground that the subject matter of claims 1, 2, 11, 13, 14, 16, 17, 20, and 21 would have been obvious over Coulombe, Bellordre, and Friedman. Dec. on Inst. 7–17, 21; *see* Pet. 11–38. Having now considered the evidence in the complete record established during trial, we are persuaded that, based on this record, Petitioner has not demonstrated by a preponderance of the evidence that the claims would have been obvious over those references in combination.

a. *Coulombe*

Coulombe, titled “System for Adaptation of SIP Messages Based on Recipient’s Terminal Capabilities and Preferences,” published December 25, 2003 from an application filed May 31, 2002. Ex. 1003, cover page. Coulombe describes a system for adaptation of session initiation protocol (SIP) messages based on the recipient’s terminal capabilities and preferences. *Id.*, Abstract. Coulombe discloses that the described invention “tries to overcome the problem of interoperability between terminals and to improve the end user experience by providing a framework for making SIP messages conform to the recipient’s terminal capability and characteristics.”

Id. ¶ 7. For example, Coulombe describes message size reduction and format adaptation for delivery to the destination terminal. *Id.*

Figure 1 is reproduced below.

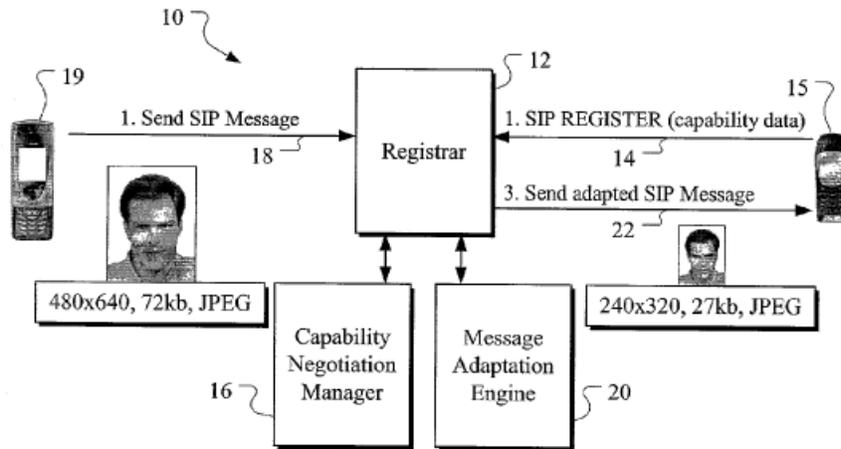


FIG. 1

Figure 1 shows a message flow for SIP message adaptation using system 10. System 10 includes SIP proxy/registrar 12, Capability Negotiation Manager 16, and Message Adaptation Engine 20. *Id.* ¶ 54. Coulombe discloses that when new message 18 arrives at proxy/registrar 12 from another entity, such as sending terminal 19, proxy 12 obtains the terminal capabilities or user preferences of intended recipient's terminal 15 already stored in the registrar, adapts the message (using Message Adaptation Engine 20), and sends adapted message 22 to recipient's terminal 15. *Id.* ¶ 58. Capability Negotiation Manager 16 is responsible for resolving terminal capability information. *Id.* ¶ 59. Message Adaptation Engine 20 is responsible for adapting the message for recipient terminal 15 by performing format conversion, presentation adaptation, media characteristics adaptation, message size reduction, and encapsulation adaptation, as needed. *Id.* ¶¶ 63, 85–91. Coulombe further teaches that “adaptation is any manipulation or

modification of the message content based on the terminal capabilities, user preferences, network conditions, or any characteristics of the user, his terminal or his environment.” *Id.* ¶ 63.

b. Bellordre

Bellordre relates to “a method of processing a multimedia message and a corresponding processing system.” Ex. 1004 ¶ 1. Multimedia messages may contain text, picture, audio, and/or video objects. *Id.* ¶ 4. Bellordre’s message-processing system receives a multimedia message from a receiver, extracts any audio or video object from the message, “adapt[s] the format, sound and size of the audio and video objects to the technical features of the destination terminal,” and stores the adapted message. *Id.* ¶¶ 17–19, 57, 47, 69. Adapting a video object may entail “modifying its size (number of pixels) to adapt it to the size of the screen of the [receiving terminal], or reducing its size (number of bytes) to take account of the object reception characteristics.” *Id.* ¶ 62. The system then sends to the intended recipient a “substitute message.” Figures 3 and 4, reproduced below, compare the initial message and substitute message:

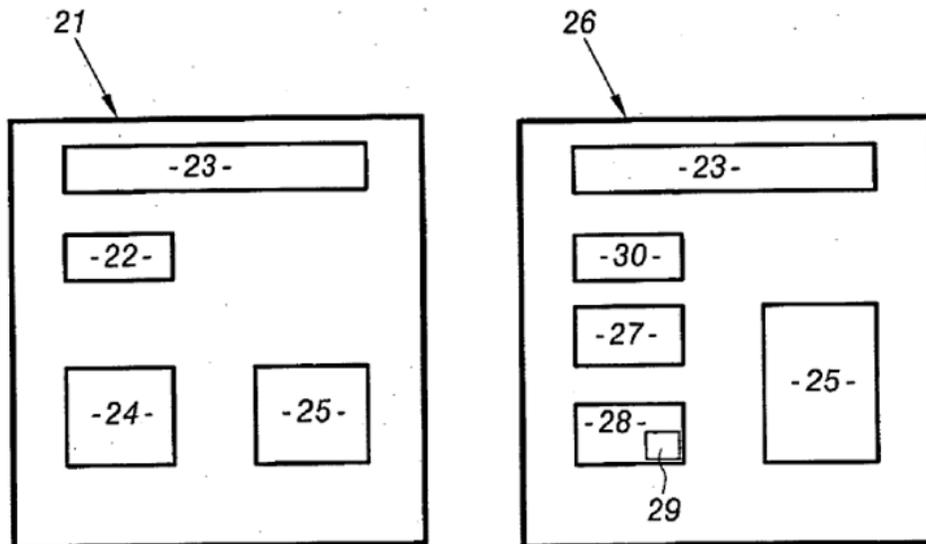


Fig. 3

Fig. 4

Figure 3 depicts multimedia message 21 comprising, e.g., identification element 23 identifying the terminal receiving the message, audio or video object 24, and text object 25. *Id.* ¶ 46. Substitute message 26, depicted in Figure 4 retains identification element 23 and text object 25, and further contains sequence 27 and “SDP definition file 28 replacing the audio or video object 24.” *Id.* ¶ 47. Sequence 27 is an object comprising one or more representative extracts from the audio or video object, such as one or more pictures from a video (animated GIF) or a musical excerpt. *Id.* ¶48. SDP definition file 28 contains URL hyperlink address 29 of the storage location of the object. *Id.* ¶ 49.

c. Friedman

Friedman discloses a system for processing attachments in electronic messages. Ex. 1005, 1:7–9, 2:40–42. Friedman defines “attachment” as any object—e.g., text file, image file, or video file—that is “transported inside, outside, and/or along with, an electronic message.” *Id.* at 8:1–9. Friedman’s attachment processing system: (1) automatically detaches and saves the contents of the object; (2) generates a “thumbnail graphic” for a portion of the object; and (3) displays the thumbnail graphic in a display area of a graphical user interface. *Id.* at 8:30–34, 59–60, 9:5–7, Figs. 5A, 5B. Figure 4, reproduced below, illustrates one embodiment of the system’s graphical user interface:



FIG. 4

Figure 4 depicts graphical user interface 500 having display area 510 showing multiple thumbnail graphics representing email attachments. *Id.* at 7:8–12, Fig. 4. In particular, thumbnail graphic 525, labeled “riddik.mov,” represents a video. *Id.* at 7:19–21, Fig. 4. To open the video, the user may double-click on the thumbnail graphic. *Id.* at 9:21–25.

d. Independent Claims 1, 11, and 13

We follow the parties’ lead and treat claim 1 as representative of claims 11 and 13, which are the other independent claims challenged in this ground. Pet. 32, 34–35.

For claim 1, Petitioner relies on Coulombe to teach a messaging system that: (1) receives the initial message from an originating communication device characterized, at least, by message format, an initial layout, and data indicative of at least one receiver associated with the initial message; (2) obtains data indicative of the destination communication device; (3) enables conversion of the initial message into an adapted message based on the destination device’s display capabilities; (4)

determines an adapted message layout; and (5) facilitates delivery of the adapted message to the destination communication device. Pet. 14–16, 18–21.

Petitioner argues that Coulombe “does not appear to expressly disclose that the message received . . . includes a video.” Pet. 16. In particular, claim 1 recites that “the initial message” sent from an originating communication device “includes a *video*.” Petitioner relies on Bellordre for this limitation, noting that Bellordre teaches a message that contains “at least one audio or video multimedia object.” *Id.* at 17. Petitioner further asserts that Bellordre teaches adapting the video to the display capabilities of the destination device. According to Petitioner, “Bellordre teaches that ‘[p]rocessing a video object entails the format[ing] of its sequence, modifying its size (number of pixels) to adapt to the size of the screen of the terminal 10, or reducing its size (number of bytes) to take account of the object reception characteristics, for example.’” Pet. 23–24 (quoting Ex. 1004 ¶ 62) (emphasis and bracketing added by Petitioner).

Petitioner argues that it would have been obvious to a person of ordinary skill to combine Coulombe and Bellordre such that Coulombe’s initial message includes a video. In support of this combination, Petitioner relies on the testimony of its declarant, Mr. Klausner, who asserts that

It would have been obvious to a person of ordinary skill in the art to combine Coulombe with Bellordre, predictably resulting in the messaging system of Coulombe in which the initial message also includes a video. *The motivation to add video capability is self-evident—people have long understood that video information (such as television and motion pictures) can provide a more powerful message than text or still photos. One of ordinary skill in the art would also have found no technological obstacle to, and no teaching away from, adding videos to the*

messaging system of Coulombe. In addition, Bellordre and Coulombe are analogous references in the same field of adapting messages according to the technical capabilities, and specifically, displaying capabilities, of mobile terminals.

Ex. 1002 ¶ 64 (emphasis added).

Additionally, claim 1 requires the “conversion” to provide a “clickable icon” that is “based on the video from the initial message and 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.” For this limitation, Petitioner relies on Friedman, and specifically its teaching of “thumbnail graphic 525.” *Id.* at 21 (citing Ex. 1005, 7:19). Petitioner asserts that Friedman’s thumbnail graphic 525 is based on a video attachment (“riddick.mov”) to an electronic message, and double-clicking on the thumbnail graphic opens the video. Pet. 22–23 (citing Ex. 1005, *passim*). Petitioner contends that “[o]ne of ordinary skill in the art would therefore have appreciated that generating a clickable thumbnail graphic would allow for straightforward access to a video attached to a message transported by the Coulombe messaging system.” *Id.* at 25 (citing Ex. 1002 ¶ 74). Petitioner notes that “Friedman does not appear to expressly disclose that the thumbnail graphic is clickable ‘into an adapted version of the video,’” but that “one of ordinary skill in the art would have been motivated to apply the teachings of Friedman to ‘uniquely associate[]’ the generated thumbnail graphic with the adapted video of Bellordre” so that Friedman’s thumbnail graphic is clickable into Bellordre’s adapted video. *Id.* at 23–24 (citing Ex. 1002 ¶ 72).

In its Response, Patent Owner presents several arguments, among which is that Petitioner’s reasoning for the combination of Coulombe and

Bellordre is unsupported and conclusory. In particular, Patent Owner asserts that the reasoning for the combination of the Coulombe and Bellordre provided in the Petition and by Petitioner's declarant, Mr. Klausner, "are not well founded and fail to establish a case of obviousness" and that these purported motivations (presented in paragraph 64 of Mr. Klausner's declaration) are "nothing more than general factually-unsupported platitudes that are repeated nearly verbatim in both the Petition and Mr. Klausner's declaration." PO Resp. 3, 32.

Based on the complete record before us, we determine that Petitioner has not explained sufficiently its reasoning for the combination of Coulombe's message adaptation system with Bellordre's video adaptation and delivery processes. Specifically, Petitioner's reasoning is incomplete. To start, Petitioner asserts that Coulombe does not expressly disclose a message that includes a video, but relies on Bellordre for its teaching of a message with a video object. Pet. 16–17. In doing so, Petitioner asserts that "[t]he motivation to add video capability is *self-evident*—people have long understood that video information (such as television and motion pictures) can provide a *more powerful message* than text or still photos." Pet. 17 (citing Ex. 1002 ¶ 64) (emphases added). In its Reply, Petitioner adds that the limitation in question is unusually simple and the technology particularly straightforward and that the "benefits of using videos instead of still photos was 'self-evident.'" Reply 16 (citing Ex. 1002 ¶ 64; Ex. 1028 ¶¶ 33–36). Petitioner adds that Patent Owner's position ignores the fact that in any obviousness analysis, the amount of explanation and expert testimony required depends on the complexity of the combination.

Mr. Klausner’s testimony mirrors Petitioner’s reasoning in the Petition, and states that the motivation to add video capability is “self-evident” and “people have long understood that video information (such as television and motion pictures) can provide a more powerful message than text or still photos.” Ex. 1002 ¶ 64. In his rebuttal declaration, Mr. Klausner adds that:

[t]he motivation to add video capability, as taught by Bellordre, *is so self-evident that even laypersons would have appreciated the value of being able to communicate using video in a messaging system.* To require more explanation of why video capability is beneficial to a messaging system is to ignore common sense. And because the motivation to add video capability to a messaging system would have been apparent to laypersons, it cannot be said to be the product of hindsight.

Ex. 1028 ¶ 34.

With regard to common sense, we note that in *KSR*, the Supreme Court criticized a rigid approach to determining obviousness based on the disclosures of individual prior art references that were already on the record, with little recourse to the knowledge, creativity, and common sense that an ordinarily skilled artisan would have brought to bear when considering combinations or modifications. *KSR*, at 415–22. However, in relying upon common sense, our reviewing court has cautioned “that references to ‘common sense’—whether to supply a motivation to combine or a missing limitation—*cannot be used as a wholesale substitute for reasoned analysis and evidentiary support.*” *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362 (2016) (emphasis added).

Based on the complete record before us, we determine that Petitioner has 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." Neither the Petition nor Mr. Klausner declaration testimony explains how the asserted combination of Bellordre and Coulombe would be "self-evident," either to a person of ordinary skill in the art or, alternatively, to a "lay person" as Mr. Klausner asserts. Further, Petitioner has 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. Rather, Petitioner (and Mr. Klausner) concludes this to be true without providing any explanation as to why video is "more powerful," or at a minimum, what "more powerful" means in the context of the field of technology and art at issue.

Additionally, even assuming Petitioner's general proposition to be true—that it is "self-evident" television is more powerful than text or photos, it bears mentioning that Petitioner has not explained how this sentiment demonstrates the "common sense" or "common knowledge" that a skilled artisan would have considered because Petitioner's assertions are too general and fail to take into consideration the specific references, field of technology, and art at issue, which are directed to the design and implementation of systems for sending and receiving messages over a communications network, such as the Internet. In this context, Petitioner provides no reasoning beyond the bare statement that the asserted combination is "self-evident." Moreover, Petitioner presumes that which is "self-evident" need not be explained. However, this is not the standard by which obviousness is shown. Indeed, "assumptions about common sense cannot *substitute* for evidence thereof." *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006).

Mr. Klausner's testimony does not help in this regard. The statements in Mr. Klausner's declaration (Ex. 1002) mirror those provided in the Petition, and do not point to any evidence in the record to support his conclusion that the asserted combination of Bellordre and Coulombe would be "self-evident." Ex. 1002 ¶ 64. Turning to his rebuttal declaration, Mr. Klausner states that:

[t]he motivation to add video capability, as taught by Bellordre, is so self-evident that even laypersons would have appreciated the value of being able to communicate using video in a messaging system. To require more explanation of why video capability is beneficial to a messaging system is to ignore common sense. And because the motivation to add video capability to a messaging system would have been apparent to laypersons, it cannot be said to be the product of hindsight.

Ex. 1028 ¶ 34.

While Mr. Klausner makes broad statements that it would be "self-evident" to a skilled artisan or layperson to add Bellordre's video messaging to Coulombe's message adaptation system, we, nonetheless, observe that Mr. Klausner's conclusion does not rest upon any reasoning or explanation in his declaration to support this position. Thus, we weigh Mr. Klausner's testimony accordingly. *See In re Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) ("[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations."); *see also* 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.").

Moreover, we disagree with Mr. Klausner's testimony that requiring additional explanation would "ignore common sense." Although "common sense of those skilled in the art demonstrates why some combinations would

have been obvious where others would not,” *Leapfrog Enters., Inc. v. Fisher–Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007), the determination is made not after observing what the inventor actually did, but in light of the state of the art before the invention was made, *see Outside the Box Innovations, LLC v. Travel Caddy, Inc.*, 695 F.3d 1285, 1298 (Fed. Cir. 2012). Here, on this record, Mr. Klausner does not address why it would have been “self-evident,” or, more importantly, common sense for a skilled artisan to modify Coulombe’s message adaptation system with Bellordre’s video content. Further, Mr. Klausner’s appeal to the “layperson” is also unavailing as Mr. Klausner does not direct us to any support in the record that a layperson would have this understanding of messaging systems. *See Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360–61 (Fed.Cir.2011) (providing that the inquiry under § 103 is not whether the claimed invention is “sufficiently simple to appear obvious to judges after the discovery is finally made”). We recognize that the Board has subject matter expertise, but the Board cannot accept general conclusions about what is “self-evident” or “common sense” as a replacement for documentary evidence for core factual findings in a determination of patentability. *See K/S Himpp v. Hear-Wear Techs., LLC*, 751 F.3d 1362, 1366 (Fed. Cir. 2014); *In re Zurko*, 258 F.3d 1379, 1385–86 (Fed. Cir. 2001).

Additionally, we observe that Petitioner asserts Coulombe discourages the use of SIP proxies to transcode video content. In particular, Petitioner argues the “sole reference to video content in Coulombe appears in Paragraph 69, which mentions use of existing SIP proxies to transcode video content, but actively discourages their use” because the SIP streaming video transcoding does not adapt videos for display characteristics and SIP

streaming video is “fundamentally different from Coulombe’s messaging system.” Reply 7–15. Thus, according to Petitioner’s own reading of Coulombe, the notion of adding streaming video to Coulombe’s system is not necessarily “self-evident” without considering, as Petitioner does with paragraph 69, the design of the Coulombe system and the consequences of modifying the Coulombe’s system. *See* Reply 1 (Petitioner asserting “the existing SIP streaming video techniques alluded to in Coulombe would not have been applicable to Coulombe’s messaging application.”). As such, this further indicates that Petitioner’s and Mr. Klausner’s comparison of televisions to text and photos is too simplistic and general, and is not directed to the particular technology at issue.

Next, Petitioner contends that, like the claims at issue in *Perfect Web Technologies, Inc. v. InfoUSA, Inc.*, 587 F.3d 1324 (Fed. Cir. 2009), “the limitation in question [is] unusually simple and the technology particularly straightforward,” and the benefits of using videos instead of still photos was “self-evident.” Reply 15–16.

In *Perfect Web*, our reviewing court reiterated the principle that although “common sense can be a source of reasons to combine or modify prior art references to achieve the patented invention,” this analysis must be explained with sufficient reasoning. *Perfect Web*, 587 F.3d at 1328. In reviewing the district court’s determination, the Federal Circuit noted that the claims at issue were directed to methods of managing bulk e-mail distribution to groups of targeted customers that involved three steps (A)–(C) and a fourth step (D) for repeating steps (A)–(C) if desired. *Id.* at 1326, 1330. The Federal Circuit further agreed with the district court’s obviousness determination that based on the prior art disclosure of steps

(A)–(C), it would have been common sense to repeat steps (A)–(C) (i.e., step (D)) if desired. The Federal Circuit found that “the predicate evidence on which the district court based its ‘common sense’ reasoning appears in the record [t]he district court also adequately explained its invocation of common sense.” *Id.* at 1330. More specifically, the Federal Circuit noted with approval the district court’s analysis of the claim language in Step D, which “simply recites repetition of a known process until success is achieved,” and the district court’s explanation that “[i]f 100 e-mail deliveries were ordered, and the first transmission delivered only 95, common sense dictates that one should try again. One could do little else.” *Id.* at 1330.

In contrast, here, Petitioner has not provided the required reasoned analysis and evidentiary support for its statement that adding video to Coulombe’s message adaptation system would have been “self-evident” or “powerful.” While we agree that expert testimony is not required for all cases, nevertheless, even if not relying on expert testimony, Petitioner must provide some credible analysis and evidence to support its reasoning for the asserted combination of Coulombe and Bellordre. *Arendi S.A.R.L.*, 832 F.3d at 1362; *see In re Nuvasive*, 842 F.3d 1376, 1383 (Fed. Cir. 2016) (holding conclusory statements insufficient if not supported by a reasoned explanation) (citing *In re Lee*, 277 F.3d 1338, 1342 (Fed. Cir. 2002) (“The factual inquiry whether to combine references must be thorough and searching.”)). We do not find that Petitioner’s bare assertions of self-evidence are sufficient to provide the required analysis and support. Further, it is not Patent Owner’s burden to argue, as Petitioner proposes, that “relevant computer and communication field is an unpredictable art.” Reply 16. Rather, the burden to demonstrate the unpatentability of the challenged

claims by a preponderance of the evidence rests and remains with the Petitioner. *See* 35 U.S.C. § 316(e). “In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)).

Petitioner additionally argues that:

One of ordinary skill in the art would also have found no technological obstacle to, and no teaching away from, adding videos to the messaging system of Coulombe. (*Id.*) Further, Bellordre and Coulombe are analogous references in the same field of adapting messages according to the technical capabilities, and specifically, displaying capabilities, of mobile terminals. (*Id.*)

Pet. 17 (citing Ex. 1002 ¶ 64). Although not presented in the Petition, the Petitioner further argues in its Reply that it would have been “technologically straightforward” to combine Coulombe and Bellordre to attach a video to a message using longstanding and well-known MIME (Multipurpose Internet Mail Extensions) message encoding techniques. Petitioner adds that the SIMPLE (also known as Session Initiation Protocol for Instant Messaging and Presence Leveraging Extensions) standard confirms that it would have been technologically trivial for a message sent using SIP (such as a message in Coulombe) to include a video. *See* Reply 2–6.

We first observe that Petitioner does not rely on the MIME or SIMPLE standards for its obviousness challenge in the Petition. As a general matter, a reply is not an opportunity to supplement reasoning or

evidence that is absent from the Petition. Nevertheless, even considering Petitioner's arguments in its Reply, we are not persuaded these arguments are sufficient to demonstrate by a preponderance of the evidence that the challenged claims are unpatentable. Based on the complete record here, Petitioner's arguments that the references are analogous and the asserted combination is technically trivial, essentially "say no more than that a skilled artisan, once presented with the two references, would have understood that they *could* be combined. And that is not enough: it does not imply a motivation to pick out those two references and combine them to arrive at the claimed invention." *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993–94 (Fed. Cir. 2017). While the references need not explicitly provide a reason for the asserted substitution, Petitioner must, nevertheless, explain why a person of ordinary skill in the art *would* have made the combination. *See Belden Inc. v. Berk–Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (“[O]bviousness concerns whether a skilled artisan not only could have made but would have been motivated to make the combinations or modifications of prior art to arrive at the claimed invention.”).

We have reviewed the complete record, including the parties' arguments and supporting evidence, and have determined that Petitioner has not demonstrated by a preponderance of the evidence that claim 1 would have been obvious over Coulombe, Bellordre, and Friedman. For the same reasons above, we determine that Petitioner has also not demonstrated by a preponderance of the evidence that independent claims 11 and 13 are unpatentable. For these claims, Petitioner relies on the same arguments discussed above for claim 1. Pet. 32–38. Additionally, claims 2, 14, 16, 17, 20, and 21 ultimately depend from one of claims 1, 11, and 13. For the same

reasons discussed above, Petitioner has also not demonstrated by a preponderance of the evidence that claims 2, 14, 16, 17, 20, and 21 would have been obvious over the asserted combination of Coulombe, Bellordre, and Friedman.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1, 2, 11, 13, 14, 16, 17, 20, and 21 of the '677 patent have not been shown by a preponderance of the evidence to be unpatentable; and

FURTHER ORDERED that this is a Final Written Decision under 35 U.S.C. § 318(a), and that parties to the proceeding seeking judicial review of the decision under 35 U.S.C. § 319 must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2016-00717
Patent 8,874,677 B2

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CERTIFICATE OF FILING

Pursuant to 37 C.F.R. §§ 90.2(a)(1) and 104.2(b), the undersigned hereby certifies that on September 14, 2017, the original of the foregoing Notice of Appeal was filed with the Director of the United States Patent and Trademark Office **by hand-delivery**, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of General Counsel
10B20, Madison Building East
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In addition, pursuant to 37 C.F.R. § 90.2(a)(1) and 37 C.F.R. § 42.6(b), the undersigned certifies that on September 14, 2017, a copy of the foregoing Notice of Appeal was filed **electronically** with the Board through the Board's Patent Review Processing System.

In addition, pursuant to 37 C.F.R. § 90.2(a)(2) and Federal Circuit Rule 15(a)(1), the undersigned certifies that on September 14, 2017, the requisite fee for the appeal and three (3) true and correct copies of the foregoing Notice of Appeal were filed with the Clerk of Court of the United States Court of Appeals for the Federal Circuit **by hand-delivery**, at the following address:

Daniel E. O'Toole
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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4) and 37 C.F.R. § 90.2(a)(3)(ii), the undersigned certifies that on September 14, 2017, a true and correct copy of the foregoing the Notice of Appeal was served **via email** on the patent owner by serving the correspondence email addresses of record below:

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