Trials@uspto.gov
571-272-7822

Paper 38
Entered: June 28, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP INC.,
Petitioner,

v.

VAPORSTREAM, INC.,
Patent Owner.

Case IPR2018-00404
Patent 8,935,351 B2

Before JUSTIN T. ARBES, STACEY G. WHITE, and JENNIFER MEYER CHAGNON, *Administrative Patent Judges*.

ARBES, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a)

I. BACKGROUND

Petitioner Snap Inc. filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 1, 5, 6, 9, 11, and 12 of U.S. Patent No. 8,935,351 B2 (Ex. 1001, "the '351 patent") pursuant to 35 U.S.C. § 311(a). On July 10, 2018, we instituted an *inter partes* review of all challenges raised in the Petition. Paper 11 ("Dec. on Inst."). Patent Owner Vaporstream, Inc. subsequently filed a Patent Owner Response (Paper 22, "PO Resp."), Petitioner filed a Reply (Paper 26, "Reply"), and Patent Owner filed a Sur-Reply (Paper 29, "Sur-Reply"). An oral hearing was held on March 27, 2019, and a transcript of the hearing is included in the record (Paper 36, "Tr.").

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 5, 6, 9, 11, and 12 are unpatentable.

A. Related Proceedings

The parties indicate that the '351 patent is the subject of the following district court proceeding involving Petitioner and Patent Owner: *Vaporstream, Inc. v. Snap Inc.*, Case No. 2:17-cv-00220-MLH-KS (C.D. Cal.). *See* Pet. 1; Paper 4, 1. Petitioner filed nine additional petitions for *inter partes* review of various related patents owned by Patent Owner in Cases IPR2018-00200, IPR2018-00312, IPR2018-00369, IPR2018-00397, IPR2018-00408, IPR2018-00416, IPR2018-00439, IPR2018-00455, and IPR2018-00458. *See* Pet. 1–2; Paper 4, 1–3. *Inter partes* review was instituted in each of these proceedings.

B. The '351 Patent

The '351 patent discloses "[a]n electronic messaging system and method with reduced traceability." Ex. 1001, Abstract. The '351 patent notes that "[t]ypically, an electronic message between two people is not private." *Id.* at col. 1, ll. 53–54. For example, messages may be intercepted by third parties; logged and archived; or copied, cut, pasted, or printed. *Id.* at col. 1, ll. 54–59. "This may give a message a 'shelf-life' that is often uncontrollable by the sender or even the recipient." *Id.* at col. 1, ll. 59–60. As such, according to the '351 patent, there was "a demand for a system and method for reducing the traceability of electronic messages." *Id.* at col. 2, ll. 6–8. Figure 3 of the '351 patent is reproduced below.

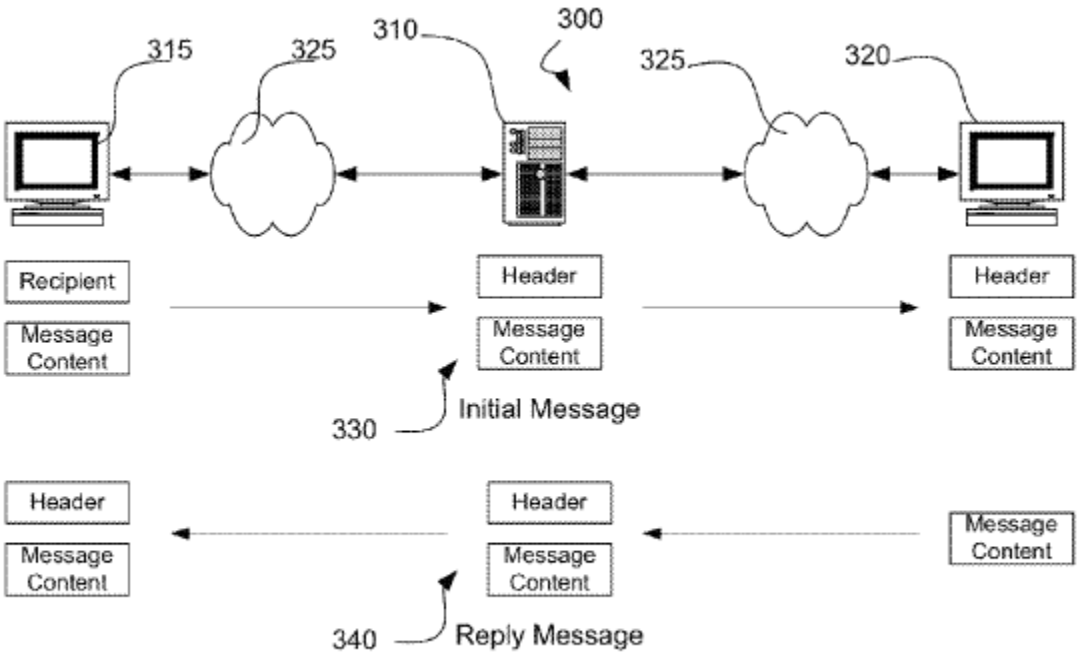

FIG. 3

Figure 3 above depicts system 300 for communicating electronic message 330 from user computer 315 to user computer 320 over network 325 using server 310. *Id.* at col. 10, ll. 51–56. "An electronic message may be any

electronic file, data, and/or other information transmitted between one or more user computers." *Id.* at col. 7, ll. 39–41. The electronic message may include text, image, video, audio, or other types of data. *Id.* at col. 7, ll. 41–49.

Figure 5 of the '351 patent is reproduced below.

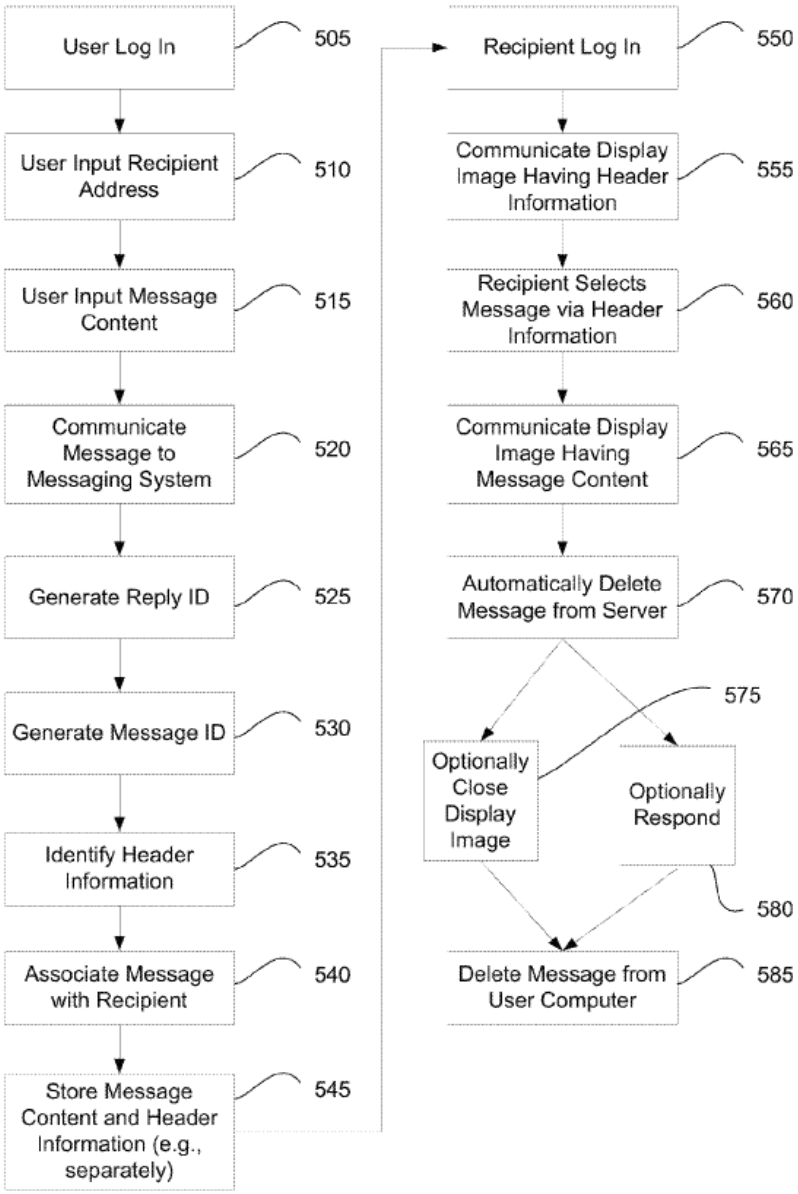

FIG. 5

Figure 5 depicts the process by which the electronic message is sent from the first user computer and received by the second user computer. *Id.* at col. 10, l. 66–col. 11, l. 1. At steps 510–520, the user inputs a recipient address (e.g., a unique identifier, such as an email address) and message content, using separate screens provided by the server computer, and the message is communicated from the user computer to the server. *Id.* at col. 11, l. 26–col. 12, l. 15, Figs. 8, 9. The server then performs various actions to process the message at steps 525–545. *Id.* at col. 12, l. 16–col. 14, l. 17. For example, the server identifies header information (e.g., information that "identifies the sending user, recipient user, location of the electronic message, [or] timing of [the] electronic message") separate from the content of the message itself and generates a message ID associated with the header information and message content. *Id.* at col. 12, ll. 26–38, col. 13, ll. 19–21 ("A message ID [is] used to maintain a correspondence between the separated components of electronic message 330."). The '351 patent describes an example in which the message ID is included both in an Extensible Markup Language (XML) file storing the header information and in an XML file storing the message content. *Id.* at col. 13, l. 27–col. 14, l. 17.

To retrieve the message, the recipient first logs in to the system at step 550. *Id.* at col. 14, ll. 18–20. At step 555, the server communicates to the recipient user computer a display image showing header information for multiple messages. *Id.* at col. 14, ll. 24–40, Fig. 10. For example, the display image may show a display name and date/time for each message, but not show the content itself for any of the messages. *Id.* In one embodiment, the header information may include "a sequence number (ex: 1, 2, 3, etc.) assigned to each electronic message," where each sequence number is

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.