

Meta, Instagram And WhatsApp Beat Swipe-Reply Patents Suit

By **Bonnie Eslinger**

Law360 (October 19, 2023, 9:02 PM EDT) -- A Delaware federal judge on Thursday tossed with prejudice a patent infringement suit claiming Meta and its WhatsApp and Instagram units stole the technology for a feature that lets users reply to an individual within group chats, after Meta invalidated most of the suit's claims before the Patent Trial and Appeal Board.

U.S. District Judge Richard G. Andrews noted in his decision that he had previously stayed the case after the PTAB granted Meta's request for inter partes review of the two patents at issue in the case, brought by online messaging platform Wrinkl Inc.

Meta prevailed in the inter partes review proceedings, as the PTAB invalidated 50 of the 54 claims asserted in Wrinkl's suit in November, the judge noted.

Before the judge were cross-motions to dismiss claims related to two Wrinkl patents, U.S. Patent Nos. 9,860,198 and 10,728,192.

"The parties now agree that this case should be dismissed. They disagree, however, on whether the case should be dismissed with prejudice or without prejudice," the judge said.

Wrinkl asked the court to dismiss all claims in the two patents, without prejudice, leaving an opportunity to file an amended suit. In the alternative, the plaintiff asked the court to dismiss the surviving claims of the two patents without prejudice — and all other claims with prejudice.

Meta urged the court to toss all the claims with prejudice.

In his decision, Judge Andrews noted that Wrinkl conceded that it does not have any information to suggest the Meta defendants infringe the four surviving claims. Nonetheless, Wrinkl told the court it wished to retain the right to assert the claims "should it uncover evidence of infringement in the future."

Meta argued that the proposal from Wrinkl was an "unconventional approach," since it asked to dismiss some patent claims with prejudice and others without prejudice in the same action. They also told the court that they had been limited to 14,000 words in their inter partes review petitions and argued that omitting the four surviving claims "does not render them materially different" from the invalidated ones.

On Thursday, the judge agreed to the voluntary dismissal of the case proposed by both sides, but found

Wrinkl's argument for dismissing the four remaining claims without prejudice was "unpersuasive." Dismissal with prejudice is warranted for all claims in the two patents, the judge said.

"I note that the dismissal with prejudice does not prevent plaintiff from asserting the four surviving claims against anyone other than defendants in this case," the judge said.

In his decision, the judge also ordered each party to bear its own attorney fees and costs.

Wrinkl is a group messaging platform that includes a feature enabling users to reply to individual messages within the moving stream of a group chat, according to the company's 2022 complaint. Meta, which owns Facebook, Instagram and WhatsApp, stole that technology for the messaging features on the apps, Wrinkl Inc. alleged.

The suit was originally filed against Facebook Inc, which subsequently changed its name to Meta Platforms Inc., although the social media platform is still called Facebook.

Wrinkl claimed in its litigation that the tech giant had been aware of its patented inventions since at least October 2018, when Marc Cohen, the inventor of the feature, emailed Facebook Vice President Julien Codorniou to discuss a potential collaboration between the two companies.

Codorniou acknowledged receipt of the email, the suit claimed, and a few days later Cohen provided more detailed information describing the "one step reply capability for group messaging."

But rather than collaborate with Wrinkl, the suit said, Codorniou never responded and Facebook and the other companies decided to create infringing features for their own messaging platforms.

In March 2019, Facebook introduced a Messenger "swipe-to-reply" feature that enabled users to write a reply to a specific message in a chat window, which quoted and had a link to the original message, by swiping on the original message, according to the suit. WhatsApp introduced a similar swipe-to-reply feature in 2017, while Instagram debuted the feature in 2020, Wrinkl said.

Representatives for the parties did not immediately respond to requests for comment Thursday.

The patents-in-suit are U.S. Patent Nos. 9,860,198 and 10,728,192.

Wrinkl is represented by Kelly Allenspach Del Dotto, Nitika Gupta Fiorella, Chet D. Campbell, Steven R. Katz, Adam J. Kessel, Lawrence K. Kolodney, Kayleigh E. McGlynn and Frank E. Scherckenbach of Fish & Richardson PC.

Meta Platforms Inc., WhatsApp LLC and Instagram LLC are represented by Tara D. Elliott, Gabriel K. Bell and Richard G. Frenkel of Latham & Watkins LLP, and Karen Jacobs and Jennifer Ying of Morris Nichols Arsht & Tunnell LLP.

The case is Wrinkl Inc. v. Meta Platforms Inc. et al., case number 1:20-cv-01345, in the U.S. District Court for the District of Delaware.

--Additional reporting by Lauren Berg. Editing by Scott Russell.

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