

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHATFIX INC.,
Petitioner,

v.

WALKME LTD.,
Patent Owner.

IPR2023-01443
Patent 10,819,664 B2

Before CHARLES J. BOUDREAU, KARA L. SZPONDOWSKI,
and MICHAEL T. CYGAN, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Whatfix Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 10 and 24 of U.S. Patent 10,819,664 B2, issued on October 27, 2020 (Ex. 1001, “the ’664 patent”). In addition, Petitioner filed a Ranking and Explanation of Material Differences Between Petitions (“Ranking”), ranking the Petition in this proceeding second.¹ Paper 3, 2. WalkMe Ltd. (“Patent Owner”) did not file a Preliminary Response or response to Petitioner’s Ranking.

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). For the reasons provided below, we exercise our discretion under 35 U.S.C. § 314 to deny institution of an *inter partes* review for this second Petition.

II. BACKGROUND

A. *Real Parties-in-Interest*

Petitioner identifies Whatfix Inc. and Whatfix Private Limited as the real parties-in-interest. Pet. 43. Patent Owner identifies itself as the real party in interest. Paper 6, 1 (Mandatory Notices of Patent Owner).

B. *Related Matters*

Petitioner and Patent Owner identify *WalkMe Ltd., v. Whatfix Inc.*, Case No. 1:23-cv-00227-MN (D. Del) as a related matter. Pet. 43; Paper 6, 2. The parties also identify that the ’664 patent is the subject of IPR2023-01368, and that related U.S. Patent 11,258,732 is the subject of IPR2023-01379. *Id.*

¹ Petitioner challenges claims 1–9, 12–16, 18–23, 25, 26, 28–31, and 33 of the ’664 patent in IPR2023-01368.

C. The '664 Patent (Ex. 1001)

The '664 patent is titled “Chat-Based Application Interface for Automation” and generally relates to “user-interfaces for automation processes that utilize chat bots.” Ex. 1001, code (54), 1:16–17. The '664 patent discloses a “technical solution . . . to use a natural language interface to receive input from the user, and based thereon, select an automation process to be executed,” where “[t]he automation process may be executed in a manner that manipulates the [graphical user interface (GUI)] of the target system, in a similar manner to the manner in which the user operates.” *Id.* at 8:65–9:4.

The '664 patent discloses exemplary embodiments for a non-programmer user to define a flow of conversation for a chat bot. *See, e.g.*, Ex. 1001, Figs. 1–3. For example, a user “may define which questions the bot would ask, which remarks it will make, [and] flow control operations that may be based on evaluated conditions.” *Id.* at 11:48–50. Further, “the user may define for a conversation flow which automation process is invoked,” or “that a conversation is associated with multiple automation processes, one of which may be selected based on the interaction with the user.” *Id.* at 11:52–57. The automation process may also be defined by a user. *Id.* at 14:29–30.

Figure 2A, reproduced below, shows a flowchart in accordance with an exemplary embodiment:

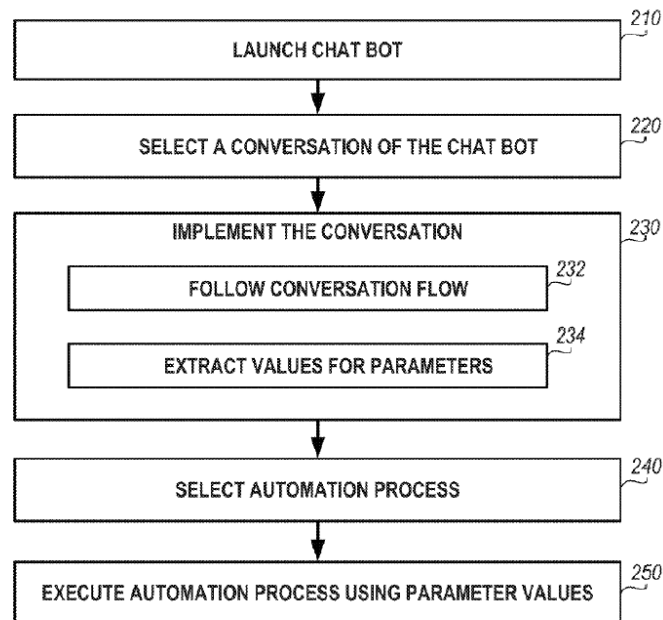


FIG. 2A

Figure 2A, above, shows step 210 (Launch Chat Bot), step 220 (Select a Conversation of the Chat Bot), Step 230 (Implement the Conversation) which further includes Step 232 (Follow Conversation Flow) and Step 234 (Extract Values for Parameters), Step 240 (Select Automation Process), and Step 250 (Execute Automation Process Using Parameter Values). After the chat bot is launched (step 210), the user may interact with the chat bot using natural language processing techniques and the appropriate conversation may be selected (step 220). Ex. 1001, 13:33–43. The user may, for example, “converse with the chat bot using natural language, such as using written text in a messenger-like [user interface (UI)], [or] using oral conversation such as by providing oral instructions that may be translated to text using speech-to-text methods.” *Id.* at 12:6–11. At step 230, the conversation may be implemented, and the chat bot may execute the conversation flow by following the flow defined for that conversation. *Id.* at

13:44–46. At step 240, an automation process may be selected based on the flow of the conversation. *Id.* at 14:4–6. “The automation may be a flow that comprises steps in a predefined order.” *Id.* at 14:32–33. At step 250, the automation process may be executed. *Id.* at 14:13. In some embodiments, the user may be provided with a link during the chat bot session, and the automation process may be executed after the user clicks on the link. *See, e.g., id.* at 16:24–31, Fig. 2B.

The ’664 patent also discloses various schematic illustrations of a user interface by which a user can edit and define a bot (Figures 4A and 4B), edit and define a conversation (Figures 5A and 5B), edit and define an action step (Figure 5C), edit and define a question step (Figure 5D), edit and define a condition step (Figure 5E), and edit and define an automation process (Figure 6). Ex. 1001, 17:31–22:28. One example described in the foregoing figures is to “Add New Employee.” *Id.*

Figure 7A, reproduced below, shows a schematic illustration of a user interface of the user with a chat bot.

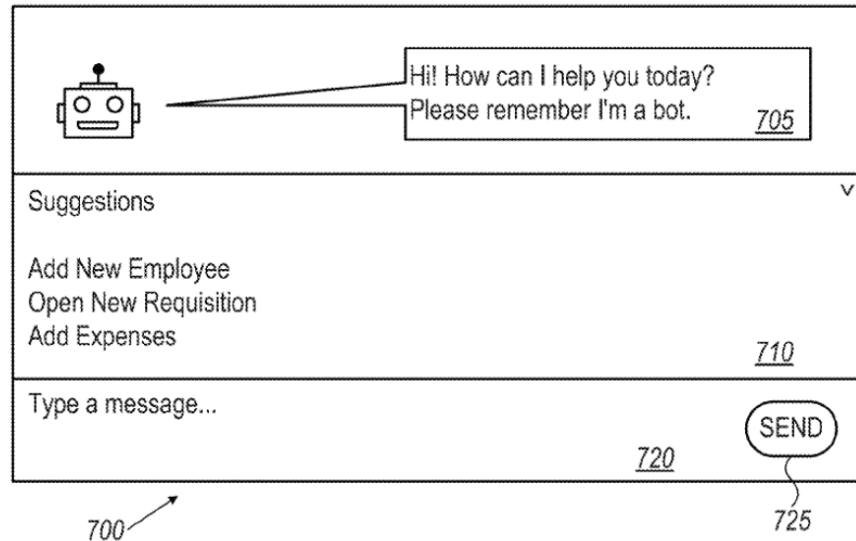


Fig. 7A

Figure 7A, above, shows a user interface of a user conversing with a chat bot after the chat bot has been launched. Ex. 1001, 22:32–34. The chat bot has provided a greeting “Hi! How can I help you today? Please remember I’m a bot.” (message 705), which may be based on the definition of the chat bot. *Id.* at 22:35–38. The chat bot has indicated suggested conversations 710 of “Add New Employee,” “Open New Requisition,” and “Add Expenses.” *Id.* at 22:47–50; *see id.* at 17:64–67. The user may converse with the chat bot by entering a message in text field 720, or speech to text may be used to analyze speech of the user and generate a text string. *Id.* at 22:39–46.

Figure 7B, reproduced below, further shows a schematic illustration of a user interface of the user with a chat bot.

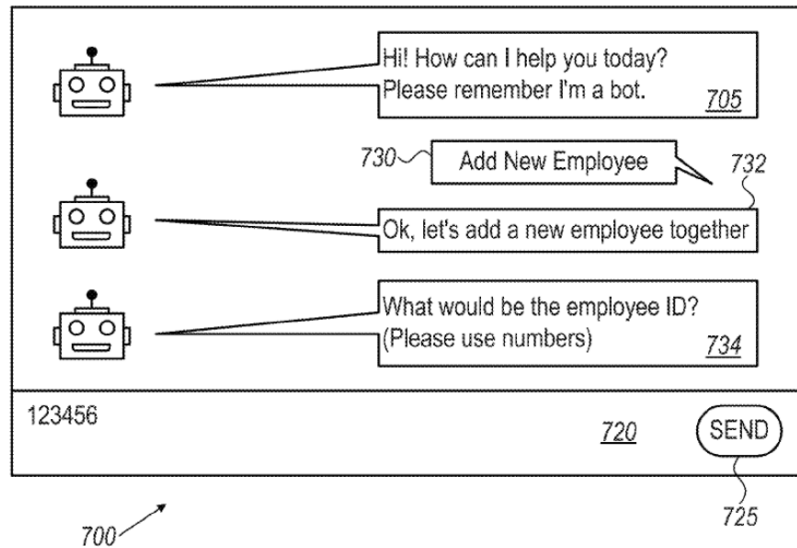


Fig. 7B

In Figure 7B, above, the user has indicated in message 730 that they would like to “Add New Employee.” The chat bot has started to implement the conversation flow of this selected conversation, and responds “Ok, let’s add a new employee together” (message 732) and “What would be the employee ID? (Please use numbers)” (message 734). Ex. 1001, 22:52–58. The user has replied in text field 720 with “123456.” *Id.* at 22:58–59.

D. Illustrative Claims

Challenged claims 10 and 24 depend from independent claims 1 and 19, respectively. Independent claim 1 and dependent claim 10 are reproduced below, with brackets noting Petitioner’s identifiers:

1. A method comprising:

[a] using a natural language interface, receiving input from a user as part of a natural language conversation between the natural language interface and the user, [b] wherein the natural language conversation comprises a first natural

language input from the user, a natural language feedback on the first natural language input from the natural language interface, and a second natural language input from the user in response to the natural language feedback:

[c] determining, based on the first and second natural language inputs from the user, an automation process configured to perform an automation of a sequence of interactions with a displayed user interface of a computer program and to simulate user interactions with the displayed user interface of the computer program,

[d] wherein the user interface of the computer program is configured to be displayed on a screen,

[e] wherein each interaction of the sequence of interactions comprises an action selected from a group consisting of inputting data to the displayed user interface and executing a functionality of the displayed user interface; and

[f] executing the automation process, wherein said executing comprises utilizing the displayed user interface of the computer program to perform the sequence of interactions.

10. The method of claim 1 further comprises: generating a link, wherein the link is configured to cause said executing upon clicking thereon, wherein the natural language interface provides the link to the user.

Ex. 1001, 25:14–39, 26:27–30. Independent claim 19 is similar to independent claim 1, and dependent claim 24 is similar to dependent claim 10. *Id.* at 27:5–32 (claim 19 reciting a “non-transitory computer readable medium retaining program instructions . . .”), 27:55–59 (claim 24 reciting “[t]he non-transitory computer readable medium of claim 19...”).

E. Prior Art and Asserted Challenges to Patentability

Petitioner asserts that claims 10 and 24 are unpatentable on the following challenges (Pet. 7):

Claims Challenged	35 U.S.C. § ²	Basis/References
10, 24	103	Symons, ³ Williams, ⁴ Ben-Itzhak ⁵
10, 24	103	Allen, ⁶ Ben-Itzhak

In support of its proposed challenges, Petitioner relies on the Declaration of Dr. Homayoon Beigi. *See* Ex. 1003.

² Because the '664 patent issued from a patent application that was filed after March 16, 2013, patentability is governed by the version of 35 U.S.C. § 103 of the Leahy-Smith America Invents Act ("AIA"), Pub L. No. 112–29, 125 Stat. 284 (2011).

³ Senne Symons, *When Chatbots meet RPA bots*, available at <https://medium.com/roborana/when-chatbots-meet-rpa-bots-c8b22579f49a> (October 19, 2017) (Ex. 1004, article) (Exs. 1005, 1006, video). Petitioner contends that Symons is prior art to the '664 patent at least under 35 U.S.C. § 102(a)(1) as a printed publication or as being otherwise available to the public. Pet. 9.

⁴ Douglas D. Williams and Ira L. Allen, *Using artificial intelligence to optimize the value of robotic process automation*, (IBM 2017) ("Williams") (Ex. 1011). Petitioner contends that Williams is prior art to the '664 patent at least under 35 U.S.C. § 102(a)(1) as a printed publication or as being otherwise available to the public. Pet. 12–13.

⁵ Ben-Itzhak, US 2017/0250930 A1, published Aug. 31, 2017 (Ex. 1034). Petitioner contends that Ben-Itzhak is prior art to the '664 patent under at least 35 U.S.C. 102(a)(1). Pet. 24.

⁶ Allen et al., US 7,983,997 B2, issued July 19, 2011 ("Allen") (Ex. 1014). Petitioner contends that Allen is prior art to the '664 patent at least under 35 U.S.C. § 102(a)(1). Pet. 27.

III. DISCRETIONARY DENIAL

Petitioner filed the present petition approximately three weeks after Petitioner filed a first petition in IPR2023-01368 also directed to the '664 patent.⁷ The petition in IPR2023-01368 (“-01368 petition”) asserts the following challenges:

Claims Challenged	35 U.S.C. §	Basis/References
1–8, 12, 13, 16, 19–23, 26, 29, 31	103	Symons, Williams
1–8, 12–16, 18–23, 25, 26, 28–31, 33	103	Allen
9	103	Allen, Dayanandan ⁸
1–8, 12–14, 16, 18–23, 26, 28, 29, 31, 33	103	Krishnan, ⁹ Radhakrishnan ¹⁰

IPR2023-01368, Paper 2, 7.

⁷ Given the timing and circumstances, we consider the present Petition to be a parallel petition challenging the '664 patent, as it was filed “at or about the same time” as the petition in IPR2023-01368. *See* Consolidated Trial Practice Guide (“CTPG”), 59 (Nov. 2019), available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>. Because the petitions filed in IPR2023-01368 and in this proceeding are parallel petitions, not serial petitions, Petitioner’s arguments applying *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (Sept. 6, 2017) (precedential) are inapplicable. *See* Pet. 39–43; *General Plastic*, Paper 19 at 10 (“Applying these factors to the *follow-on* petitions, we conclude that the circumstances do not warrant institution of *inter partes* reviews.” (emphasis added)).

⁸ Dayanandan, US 10,838,699 B2, filed Nov. 2, 2017, published July 19, 2018 (“Dayanandan”) (IPR2023-01368, Ex. 1015).

⁹ Krishnan et al., US 10,839,798 B2, filed Jan. 30, 2018 (“Krishnan”) (IPR2023-01368, Ex. 1016).

¹⁰ Radhakrishnan et al., US 10,503,627 B2, filed Oct. 30, 2017, published May 2, 2019 (“Radhakrishnan”) (IPR2023-01368, Ex. 1018).

Petitioner ranks the -01368 petition first, and the present Petition second. Ranking 2. In the Ranking, Petitioner states that “[d]ue to the need to establish the authenticity and printed publication status of the Symons Article, the Symons Video, and Williams, Petitioner was not able to fit all grounds against all challenged claims into a single petition, but rather needs two petitions to demonstrate unpatentability of the challenged claims.” *Id.* Petitioner also states that a large number of claims are being challenged, so Petitioner needs two petitions. *Id.* at 3. Petitioner further explains that the patentability challenges to claims 10 and 24 in the present Petition rely on the Ben-Itzhak reference, which is not asserted in the -01368 petition. *Id.* Petitioner also states that “[e]ach Petition provides a strong showing of unpatentability, without being redundant or duplicative.” *Id.* at 4.

The Consolidated Trial Practice Guide provides that “multiple petitions by a petitioner are not necessary in the vast majority of cases,” but acknowledges that “there may be circumstances in which more than one petition is necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.” CTPG 59. The CTPG characterizes such circumstances as “rare.” *Id.*

We are concurrently instituting *inter partes* review based on the -01368 petition. *See* IPR2023-01368, Paper 12. However, we are not persuaded by Petitioner’s arguments that filing this second Petition was necessary under the circumstances presented here. That is, looking at both petitions, we fail to see why one petition would not have been sufficient to address all of the claims challenged across the two petitions. As stated

above, challenged claims 10 and 24 depend from independent claims 1 and 19, which are challenged in the -01368 petition. Although Petitioner is challenging a total of twenty-nine claims across the two petitions, only two relatively short dependent claims are challenged in the present Petition. And *nineteen* of the claims challenged in the -01368 petition — claims 1–8, 12, 13, 16, 19–23, 26, 29, and 31 — are *each* challenged as unpatentable on *three separate alternative grounds*, i.e., those based on the Symons/Williams; Allen; and Krishnan/Radhakrishnan combinations.

Contrary to Petitioner’s assertion (Ranking 4), there is a large amount of overlap between the two petitions. Specifically, Petitioner provides all of the same contentions for independent claims 1 and 19 for the common asserted challenges (i.e., the challenges asserting Symons/Williams and Allen). *Compare* Pet. 7–9 (arguing Symons is a printed publication), 9–11 (setting forth summary of Symons), 11–13 (arguing Williams is a printed publication), 13–14 (setting forth summary of Williams), 14–23 (claim 1 contentions for Symons/Williams), 23–24 (claim 19 contentions for Symons/Williams), 27–28 (summary of Allen), 28–34 (claim 1 contentions for Allen), 34–35 (claim 19 contentions for Allen), *with* IPR2023-01368, Paper 2, 8–10 (arguing Symons is a printed publication), 10–11 (setting forth summary of Symons), 11–13 (arguing Williams is a printed publication), 13–14 (setting forth summary of Williams), 14–22 (claim 1 contentions for Symons/Williams), 33–34 (claim 19 contentions for Symon/Williams), 35–36 (summary of Allen), 36–42 (claim 1 contentions for Allen), 55–56 (claim 19 contentions for Allen). As indicated, both petitions include

approximately six pages of argument regarding the printed publication status of Symons and Williams.

The new material in this Petition, compared to that in the -01368 petition, mainly provides a description of the Ben-Itzhak reference and analysis of claims 10 and 24 (relying on Ben-Itzhak to teach those limitations). Pet. 24 (setting forth summary of Ben-Itzhak), 25–27 (claim 10 and 24 contentions for Symons/Williams/Ben-Itzhak), 35–37 (claim 10 and 24 contentions for Allen/Ben-Itzhak). Yet this new material only comprises approximately six pages. It, therefore, appears that Petitioner has filed a second petition to allow for these additional six pages of argument against two relatively short dependent claims.

Petitioner does not persuasively explain in its Ranking why these arguments could not have been provided in a single petition. It is difficult to reconcile Petitioner’s arguments that two petitions were necessary when Petitioner has asserted *three* alternative challenges against *nineteen* of the challenged claims in the -01368 petition. And Petitioner provides no explanation as to why three alternative challenges were necessary for all of these nineteen claims. On this record, Petitioner’s identification of a potential dispute over authentication and printed publication status (i.e., Symons/Williams) (*see* Ranking 2) does not demonstrate a genuine need for both petitions, and Petitioner does not persuade us that this is one of the “rare” instances where more than one petition is needed (*see* CTPG 59), particularly in light of the three alternative challenges asserted against the majority of the claims in the -01368 petition, and the relatively brief amount

of argument devoted to the printed publication status of Symons and Williams cited as justification for needing two petitions.

For the foregoing reasons, Petitioner has not sufficiently justified the need for two petitions against the '664 patent. In light of the totality of the circumstances, including that we are concurrently instituting review in IPR2023-01368 for all claims challenged in that proceeding, we exercise our discretion to decline institution in this proceeding. 35 U.S.C. § 314(a).

IV. CONCLUSION

Pursuant to 35 U.S.C. § 314(a), we exercise our discretion to decline to institute this proceeding.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied*, and no trial is instituted.

IPR2023-01443
Patent 10,819,664 B2

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