

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

BLACKBERRY LTD.,
Patent Owner.

Case IPR2017-00912
Patent 8,745,149 B2

Before SALLY C. MEDLEY, ROBERT J. WEINSCHENK, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

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

I. INTRODUCTION

Google LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–17 (“the challenged claims”) of U.S. Patent No. 8,745,149 B2 (Ex. 1001, “the ’149 patent”). BlackBerry Limited (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition. On August 30, 2017, we instituted an *inter partes* review of the challenged claims of the ’149 patent on the following grounds:

Claims	Statutory Basis	Applied Reference(s)
1, 5, 7, 9, 13, 15, and 17	35 U.S.C. § 103(a) ¹	Graham et al., U.S. Patent No. 7,167,703 B2 (filed Sept. 25, 2002, issued Jan. 23, 2007) (Ex. 1005, “Graham”)
1, 5–7, 9, 13–15, and 17	35 U.S.C. § 103(a)	Graham and Milton et al., U.S. Patent No. 5,631,949 (filed May 22, 1995, issued May 20, 1997) (Ex. 1006, “Milton”)
1–5, 9–13, and 17	35 U.S.C. § 103(a)	Graham and Toshio, Japanese Patent Application Publication No. H03-89639 (filed Aug. 31, 1989, published Apr. 15, 1991) (Ex. 1007, “Toshio”)
8 and 16	35 U.S.C. § 103(a)	Graham and MacPhail, U.S. Patent No. 6,661,434 B1 (filed Apr. 13, 2000, issued Dec. 9, 2003) (Ex. 1009, “MacPhail”)
8 and 16	35 U.S.C. § 103(a)	Graham, Milton, and MacPhail
8 and 16	35 U.S.C. § 103(a)	Graham, Toshio, and MacPhail

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, which was enacted on September 16, 2011, made amendments to 35 U.S.C. §§ 102, 103. AIA § 3(b), (c). Those amendments became effective on March 16, 2013. *Id.* at § 3(n). Because the challenged claims of the ’149 patent have an effective filing date before March 16, 2013, any citations herein to 35 U.S.C. §§ 102, 103 are to their pre-AIA versions.

Claims	Statutory Basis	Applied Reference(s)
1, 5, 7, 9, 13, 15, and 17	35 U.S.C. § 103(a)	Graham and Deshpande et al., U.S. Patent Application Publication No. 2003/0039340 A1 (filed Aug. 24, 2001, published Feb. 27, 2003) (Ex. 1008, “Deshpande”)
1, 5–7, 9, 13–15, and 17	35 U.S.C. § 103(a)	Graham, Deshpande, and Milton
1–5, 9–13, and 17	35 U.S.C. § 103(a)	Graham, Deshpande, and Toshio
8 and 16	35 U.S.C. § 103(a)	Graham, Deshpande, and MacPhail
8 and 16	35 U.S.C. § 103(a)	Graham, Deshpande, Milton, and MacPhail
8 and 16	35 U.S.C. § 103(a)	Graham, Deshpande, Toshio, and MacPhail

Paper 7 (“Dec. on Inst.”), 22–23.

After institution, Patent Owner filed a Response (Paper 17, “PO Resp.”) to the Petition, Petitioner filed a Reply (Paper 20, “Pet. Reply”) to the Response, and Patent Owner filed a Sur-reply (Paper 27, “PO Sur-reply”) to the Reply.² Petitioner submitted a Declaration of Dr. Dan R. Olsen Jr. (Ex. 1002) with the Petition, and Patent Owner submitted a transcript of the deposition of Dr. Olsen (Ex. 2006) with the Response. Patent Owner submitted a Declaration of Dr. George T. Ligler (Ex. 2007) with the Response, and Petitioner submitted a transcript of the deposition of Dr. Ligler (Ex. 1018) with the Reply. An oral hearing was held on May 30, 2018, and a transcript of the hearing is included in the record. Paper 30 (“Tr.”).³

² We authorized Patent Owner to file a Sur-reply to the Reply. Paper 22, 3.

³ The oral hearing included a related proceeding, IPR2017-00911. Paper 26.

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a). For the reasons set forth below, Petitioner has shown by a preponderance of the evidence that claims 1–17 of the ’149 patent are unpatentable.

A. *Related Proceedings*

The parties indicate that the ’149 patent is the subject of the following district court case: *BlackBerry Ltd. v. BLU Products, Inc.*, No. 1:16-cv-23535 (S.D. Fla.). Pet. 1; Paper 4, 1. The parties also indicate that Petitioner filed another petition requesting an *inter partes* review of the ’149 patent in IPR2017-00911. Pet. 1; Paper 4, 1.

B. *The ’149 Patent*

The ’149 patent relates to “a handheld electronic device and a method for providing information representative of the times of certain communications in a messaging environment.” Ex. 1001, 1:20–24. The ’149 patent explains that when a messaging conversation continues quickly, there generally is no need to display time information. *Id.* at 1:58–64. In other circumstances, though, “it may be desirable for information regarding certain timing aspects . . . to be available to a user,” but “the limited space available on a display of a handheld electronic device has made a solution difficult.” *Id.* at 1:65–2:2. To address this alleged problem, the ’149 patent describes an electronic device that displays time information for a message only after the expiration of a predetermined period during which no additional messages are exchanged or only when a user manually requests time information. *Id.* at 5:31–38, 6:14–23, 7:11–19.

The ’149 patent also explains that it is desirable to provide a user with additional time information “depending upon the prevailing circumstances” so that the user may have “an expedited understanding of the timing aspects

of the message.” *Id.* at 7:37–40, 8:26–33. To address this alleged problem, the ’149 patent describes a smart time stamp and an active time stamp. *Id.* at 7:37–50, 7:59–8:5. A smart time stamp displays first time information, such as “2:44 pm,” for a message in a conversation. *Id.* at 7:37–50. If the conversation is not resumed until the following day, the smart time stamp automatically changes the first time information to second time information, such as “2:44 pm yesterday,” to reflect the change in day. *Id.* An active time stamp displays first time information, such as “one minute ago,” for a message in a conversation, and then changes the first time information to second time information, such as “two minutes ago,” as time progresses. *Id.* at 7:59–8:5.

C. *Illustrative Claim*

Claims 1, 9, and 17 are independent. Claim 1 is reproduced below.

1. A method of displaying an instant messaging conversation on a display of an electronic device, the method comprising:

- displaying a conversation of instant messages;
- displaying a first time information for an instant message in the conversation in response to a first input; and
- automatically changing the first time information for the instant message to a second time information as time progresses and displaying the second time information instead of the first time information.

Ex. 1001, 8:48–57.

II. ANALYSIS

A. *Level of Ordinary Skill in the Art*

Petitioner argues that a person of ordinary skill in the art would have had “at least a B.S. degree in computer science, electrical engineering, or

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