UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FACEBOOK, INC., INSTAGRAM, LLC, and WHATSAPP INC.,
Petitioners

v.

BLACKBERRY LIMITED
Patent Owner

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Case IPR2019-00516
U.S. Patent No. 8,279,173 B2

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PETITIONER REPLY

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I.   INTRODUCTION

Patent Owner relies almost entirely on a narrow construction of "tag sources" that lacks support in the intrinsic record and violates well-established principles of claim construction.   The prior art discloses separate "tag sources," as properly construed, and renders the claims obvious under § 103.

II.   CLAIM CONSTRUCTION OF "TAG SOURCES"

Patent Owner argues that "tag sources" should be construed as a "separately searchable collections of tags."   Petitioner agrees that a "**tag source**" refers to a "**collection of tags**," but the construction should stop there.[1]   As explained at length below, there is no support in the intrinsic record for the additional requirement that a collection of tags be "separately searchable."

One immediate problem with Patent Owner's proposal is its ambiguity – it is not clear how to determine whether an accused system or prior art reference meets the "separately searchable" requirement.   Patent Owner's arguments might be read

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[1]   Although the Petition did not provide an express construction of "tag source," it described the term as referring to a source of predefined tags.   (Petition at 9.) Petitioner does not perceive a material difference between that formulation and simply a "collection of tags," which comes closer to the language of Patent Owner's proposal and therefore helps to narrow and crystalizes the dispute.

to suggest that "separately searchable" requires that tag sources be *physically* stored separately from each other in computer memory. But Patent Owner has definitively walked away from that position. Its Patent Owner Response agrees with Petitioner's expert that "a 'tag source' may encompass a collection of tags held together 'from a logical perspective.'" (Response at 48 n.10; *id.* ("BlackBerry does not dispute that perspective, and submits that this potential 'logical' grouping is captured by BlackBerry's proposed construction of 'separately searchable collections of tags.").)[2] Patent Owner's expert similarly acknowledged that the claimed "tag sources" need not be stored in any particular physical location. (Ex. 1021, 165:23-166:2.) This is also consistent with Patent Owner's position in the underlying litigation in which it told the district court that "[t]here is no basis for requiring that different 'sources' require different storage structures." (Ex. 1022 at 019.)

So if a "separately searchable collection of tags" need not be physically separated from other collections, what does Patent Owner's construction actually require? To the best Petitioner can tell, a "separately searchable" tag source is one that is capable of being searched without having to search another tag source,

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[2] As Patent Owner's expert explained, a "logical collection" of data "can be thought of together," but is "not necessarily physically together," for example, "the data might be all over the place." (Ex. 1021, 71:12-73:10.)

although the proposed construction is unclear as to how this characteristic is to be achieved, or how its presence or absence in the prior art can be determined. (Ex. 1023, ¶8 n.1.) In any event, there is no basis in the intrinsic record for any "separately searchable" restriction.

A. The Intrinsic Record Does Not Support Importing "Separately Searchable" Into the Construction of "Tag Sources"

Patent Owner relies exclusively on the '173 patent specification for its construction. But the Federal Circuit has long held that "[t]he claims, not specification embodiments, define the scope of patent protection. The patentee is entitled to the full scope of his claims, and we will not limit him to his preferred embodiment or import a limitation from the specification into the claims." *Kara Tech., Inc. v. Stamps.com, Inc.*, 582 F.3d 1341, 1348 (Fed. Cir. 2009) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc)); *see also Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014) ("While we read claims in view of the specification, of which they are a part, we do not read limitations from the embodiments in the specification into the claims.").

Patent Owner does not identify any basis for departing from these well-established principles. Patent Owner does not, for example, argue that the applicants acted as their own lexicographer by providing an express definition of "tag sources" in the specification. Patent Owner does not identify any clear and unmistakable disclaimer or disavowal in the specification relating to "tag sources." And Patent

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