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 RESPONSE TO PATENT OWNER'S
CONDITIONAL MOTION TO AMEND UNDER 37 C.F.R. § 42.121[1]**

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[1] An identical response is filed in IPR2019-00528.

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I. INTRODUCTION

Patent Owner filed identical contingent motions to amend in IPR2019-00516 and IPR2019-00528, urging the Board to allow substitute claims 21-32 in the event the challenged claims are found unpatentable based on the instituted grounds. But the new features recited in substitute claims 21-32 do not provide any meaningful distinction over the prior art, and are obvious for the same reasons as the original challenged claims. The new limitations added by substitute claims 21-32 are so insubstantial, in fact, that they are disclosed and rendered obvious by the prior art already of record in these IPRs. Patent Owner's motion should be denied.

II. ARGUMENT

Substitute claims 21-32 would replace claims 1, 2, 4, 6-7, 10, 12-14, 16, and 18, the challenged claims. These substitute claims introduce new limitations only with respect to independent claims 21, 25, and 29, which would replace original independent claims 1, 7, and 13, respectively. The remaining substitute dependent claims are unchanged from their corresponding original claims other than modifying the claim dependency. (Motion at 2.)

Generally speaking, the new limitations would add three additional features into the independent claims: (1) display of a photograph and user selection of a subject or object in the photograph; (2) display of a "vertical" tag list showing at least three tags from two tag sources in a particular arrangement; and (3) associating

at least one of the tags in the list with the selected subject or object. But as explained below, each of these features is disclosed by the prior art.

>   **A.   Zuckerberg discloses "displaying a photograph comprising at least one subject or object; receiving a user selection of a location in the photograph corresponding to the at least one subject or object" and "associating at least one of the tags in the tag list with the at least one subject or object."**

These claim limitations, which correspond to features (1) and (3) in the brief summary above, are readily disclosed by Zuckerberg as shown in Figure 5:
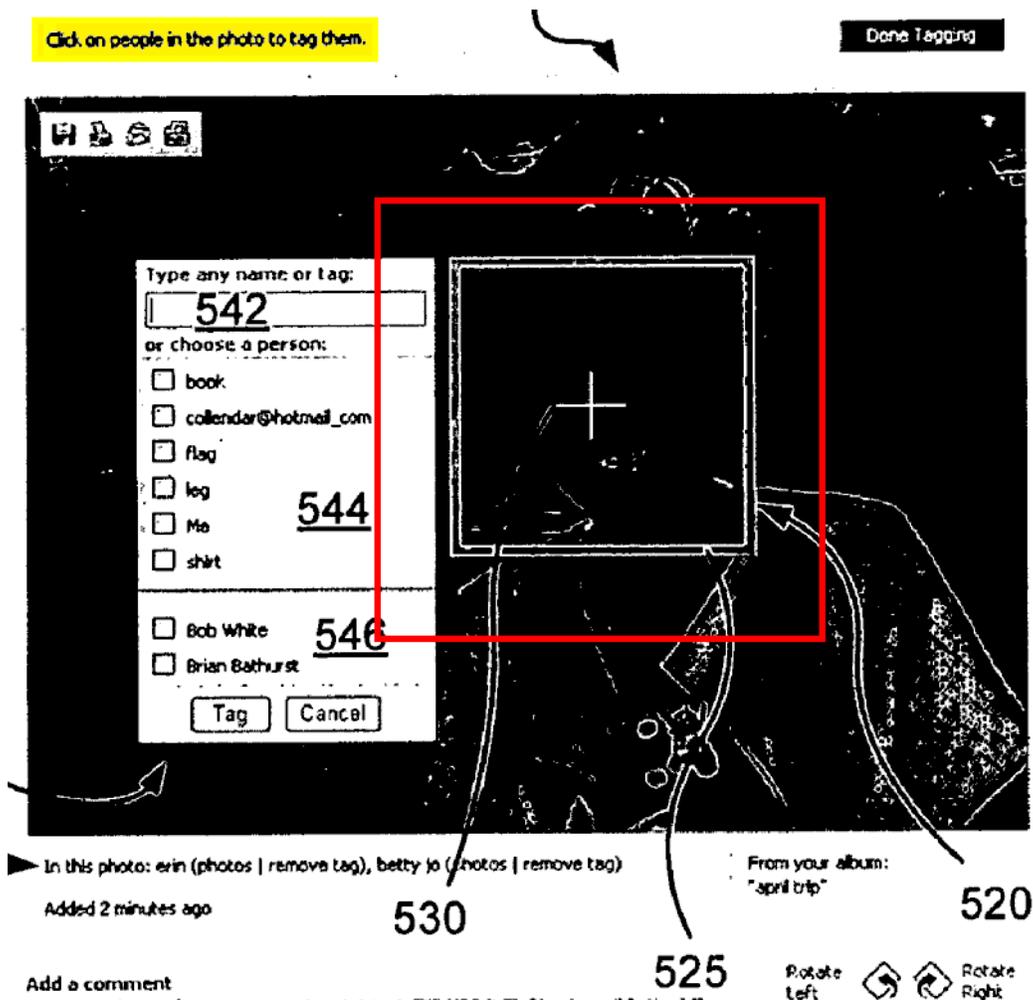
(Zuckerberg, Fig. 5 (partial figure; annotations added); Ex. 1027, ¶¶6-8.) As shown

highlighted in yellow in Figure 5 above, the system instructs the user to "[c]lick on

people in the photo to tag them." (Zuckerberg, Fig. 5.) As shown in the red box,

the user has selected a region **520** corresponding to an individual's face. (*Id.*)[2]

Zuckerberg discloses "**displaying a photograph comprising at least one**

subject or object," as shown by the display of digital image **362** in Figure 5 above.

The photograph has "**at least one subject or object**," in this case a human being.

Zuckerberg also discloses "**receiving a user selection of a location in the**

photograph corresponding to the at least one subject or object." As disclosed in

Figure 5 above and further discussed in Zuckerberg's textual description, "[t]he

region selection component **410** is configured to receive input from a user **101**," and

"select a region (e.g., a selected region **520**) within a digital image **362** according to

the input." (Zuckerberg, 8:15-22.) The "**location in the photograph**" in

Zuckerberg thus corresponds to a point in the digital image **362** selected by the user

(such as the cross-hatch shown in Figure 5), which can correspond to a subject or

object in the photo. Zuckerberg explains that in some embodiments, "the user **101**

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[2] Zuckerberg is Exhibit 1003 in IPR2019-00516 but was not included in IPR2019-00528. Accordingly, Zuckerberg will be added as previously-unused **Exhibit 1003** in IPR2019-00528 upon the filing of this response.

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