UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

BLACKBERRY LIMITED
Patent Owner

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

PETITIONERS' SUR-REPLY TO PATENT OWNER'S CONDITIONAL MOTION TO AMEND UNDER 37 C.F.R. § 42.121[1]

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

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I. INTRODUCTION

The Board's comprehensive Preliminary Guidance[2] correctly found that Patent Owner's proposed substitute claims would be unpatentable. Patent Owner's Reply[3,4] offers no new analysis or evidence to challenge any aspect of the Board's guidance. Patent Owner offers no expert testimony with its Reply, thus leaving Dr. Chatterjee's testimony unrebutted.

In fact, Patent Owner offers no argument to refute Petitioners' arguments and the Board's preliminary findings as to two of the three features introduced by the proposed substituted claims: (1) display of a photograph and user selection of a subject or object in the photograph, and (2) associating at least one of the tags in the tag list with the selected subject or object. Petitioners explained how those features were readily disclosed in Zuckerberg, and further explained the rationale and motivation to combine those features with the other prior art of record. (Pet. Resp. at 2-4, 16-19 (Grounds 6-7 of IPR2019-00516), 19-22 (Grounds 3-6 in IPR2019-

[2] Paper 25, IPR2019-00516; Paper 26, IPR2019-00528.

[3] Other than references to the case numbers, Patent Owner's replies in IPR2019-00516 and IPR2019-00528 are identical.

[4] Patent Owner did not propose any revised substitute claims following issuance of the Board's guidance.

00528).) Patent Owner makes no attempt to defend these features.

Patent Owner instead focuses its Reply on the most inconsequential of the new features in the proposed substituted claims – the display of a "vertical" tag list showing at least three tags from two tags sources in a particular arrangement. But even with respect to this limitation, Patent Owner merely repeats the arguments from its Patent Owner Response regarding the *existing* claim limitations. Petitioners have explained at length how the prior art discloses and renders obvious both the existing and proposed substitute claims. Patent Owner's motion to amend should be denied.

II. PATENT OWNER'S REPLY MERELY REPEATS ARGUMENTS RELATED TO ORIGINAL CLAIM LIMITATIONS

Patent Owner does not dispute that the prior art discloses a "vertical" tag list and that such a list would have been obvious. (Pet. Resp., *e.g.*, at 5-12 (Rothmuller and Plotkin), 15 (Zuckerberg).) Patent Owner's Reply instead repeats its argument about the prior art allegedly failing to disclose distinct "tag sources," recycling the argument it made for the *original* claims. (PO Reply at 7 ("The proposed substitute claims thus further highlight the novelty and non-obviousness of the '173 patent's 'tag type indicator…indicative of a tag source.'") (emphasis added).) These arguments make little sense in the context of Patent Owner's *contingent* motion to amend because those arguments would only be considered if the existing claims are found unpatentable. But if the existing claims were found unpatentable, the Board would have necessarily rejected Patent Owner's distinct "tag source" argument.

That argument has no greater applicability with respect to the proposed substitute claims than it does with the original challenged claims.

Patent Owner also makes the irrelevant argument that Zuckerberg alone does not disclose interspersing of tags from different tag sources.[5] Petitioners did not rely on Zuckerberg alone for that feature, but rather, explained that the feature would have been obvious in view of Rothmuller and Plotkin. (Pet. Resp. at 15 ("…doing so would have provided the benefit of a more flexibly-organized tag list, where tags could be displayed in any order, without the constraints of a separate list for each type.").) Patent Owner's attack on Zuckerberg individually is of no moment. *See Bradium Techs. LLC v. Iancu*, 923 F.3d 1032, 1050 (Fed. Cir. 2019) ("A finding of obviousness...cannot be overcome 'by attacking references individually where the rejection is based upon the teachings of a combination of references.'").

With respect Rothmuller and Plotkin, Patent Owner merely repeats its argument that neither discloses multiple tag sources (PO Reply at 7), the same argument that Petitioner already addressed in connection with the original claims.

[5] Patent Owner also spends two pages irrelevantly arguing that Zuckerberg's "horizontal" line is not a tag type indicator. (PO Reply at 4-5.) As explained in Petitioners' Reply, Petitioners no longer contend that Zuckerberg's horizontal line qualifies as a tag type indicator. (Pet. Reply (IPR2019-00516) at 11 n.3.)

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