

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

BLACKBERRY LIMITED,
Patent Owner.

Case IPR2019-00516
Patent 8,279,173 B2

Before MIRIAM L. QUINN, JACQUELINE T. HARLOW, and
AARON W. MOORE, *Administrative Patent Judges*.

HARLOW, *Administrative Patent Judge*.

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

I. INTRODUCTION

Facebook, Inc., Instagram, LLC, and WhatsApp Inc. (collectively, “Petitioner”), filed a Petition (Paper 2, “Pet.”), requesting *inter partes* review of claims 1, 2, 4, 6–8, 10, 12–14, 16, and 18 of U.S. Patent No. 8,279,173 B2 (Ex. 1001, “the ’173 patent”). Blackberry Limited (“Patent Owner”) timely filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons stated below, we determine that there is a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim. We hereby institute *inter partes* review of the challenged claims on all the grounds of unpatentability asserted in the Petition.

A. Related Matters

The ’173 patent is the subject of a district court proceeding in the Central District of California, captioned *BlackBerry Ltd. v. Facebook, Inc.*, Case No. 2:18-cv-01844-GW-KS (C.D. Cal.). Pet. 2; Paper 4, 2. In addition, Petitioner filed a second petition seeking *inter partes* review of the ’173 patent in IPR2019-00528 (“the ’528 IPR”). ’528 IPR, Paper 6, 1. Our decision instituting *inter partes* review in the ’528 IPR issued concurrently with this Decision.

B. The '173 Patent

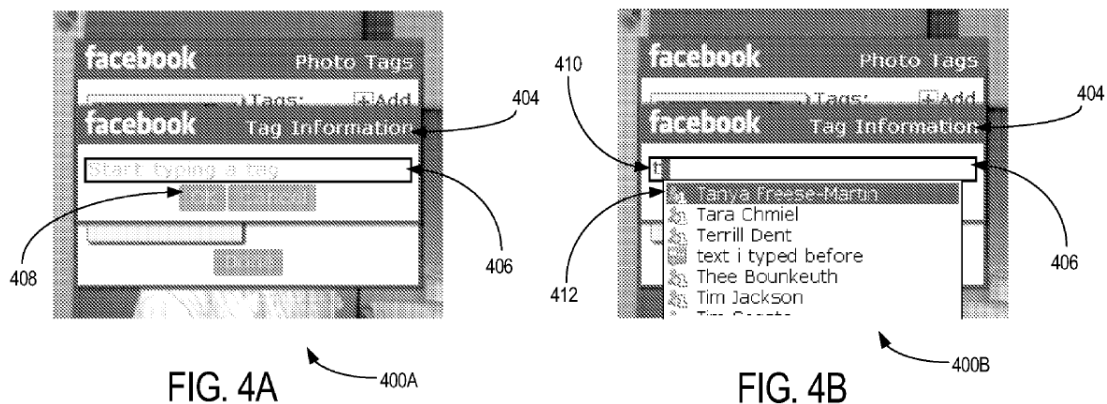
The '173 patent relates to a “user interface for selecting a photo tag” to associate with a digital photograph, for example, in a social networking or photo sharing application. Ex. 1001, 1:15–23. The patent recognizes the existence of prior art methods for tagging digital photographs, but explains that an improved user interface is needed because “[s]electing a ‘tag’ to associate with an identified point in a photograph can be a complicated task if there are many potential tags to choose from,” and “common techniques used on desktops and laptops with full sized screens do not work as well” on smaller wireless mobile devices. *Id.* at 1:23–32. To this end, the '173 patent discloses a

user interface [that] embodies a method of selecting a photo tag for a tagged photo, comprising: providing a tag entry field for entering a photo tag; in dependence upon a string entered by a user, displaying in a matching tag list any tags from one or more selected tag sources matching the entered string. The method may further comprise displaying a tag type for each tag appearing in the matching tag list. The method may further comprise allowing user selection of a tag in the matching tag list to complete the tag entry field.

Id. at Abstract.

Figures 4A and 4B of the '173 patent, reproduced below, depict an exemplary user interface in accordance with the claimed invention.

Ex. 1001, 1:43–44.



Referring to Figure 4A, the '173 patent explains that the tag selection user interface presents the user “with a tag entry field 406 indicating that he should start typing a tag.” *Id.* at 5:32–37.

[A]s the user begins to type, photo tag selection module 148B may be configured to search one or more selected “tag sources” for tags that match the currently entered text. As shown by way of illustration in screen 400B of FIG. 4B, these tag sources could include, for example, a list of friends from an online service like Facebook™, a list of contacts from the user’s address book 142, a list of the user’s browser bookmarks (in Internet browser 138), a cache of recent free-form text entries, etc.

Id. at 5:39–47. The '173 patent further explains that

photo tag selection module 148B may be configured to display any matching tags . . . from one of the tag sources to the tag being typed by the user in the tag entry field 406 in a matching tag list 412. Each tag may have an icon or some other visual identifier associated with it that clearly indicates its type, and allows the user to quickly distinguish between different types of tags.

Id. at 5:49–55. According to the patent, similar to “tag sources,” “tag types could include a free-form alphanumeric string, Facebook™ friends, address book entries (in address book 142), browser bookmarks (in Internet browser module 138), etc.” *Id.* at 4:46–50.

C. Challenged Claims

Petitioner challenges claims 1, 2, 4, 6–8, 10, 12–14, 16, and 18 of the '173 patent. Claims 1, 7, and 13 are independent. Claim 1 is representative, and is reproduced below:

1. A method of selecting a photo tag for a tagged photo, comprising:

displaying a tag list including tags from one or more tag sources matching a search string;

displaying a tag type indicator for each tag appearing in the tag list, said tag type being indicative of a tag source associated with the tag.

Ex. 1001, 9:14–21. Independent claims 7 and 13 respectively recite a “system” and “computer readable medium” for performing the method of claim 1. *Id.* at 9:34–41, 10:13–21.

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability (Pet. 4–5):

Ground	Claims	Basis	References
1	1, 2, 4, 6–8, 10, 12–14, 16, 18	§ 103	Zuckerberg ¹
2	1, 2, 4, 6–8, 12–14, 18	§ 103	Zuckerberg, Rothmuller, ² and MacLaurin ³

¹ Zuckerberg, US 7,945,653 B2, issued May 17, 2011 (Ex. 1003).

² Rothmuller, US 7,415,662 B2, issued Aug. 19, 2008 (Ex. 1004).

³ MacLaurin, US 7,831,913 B2, issued Nov. 9, 2010 (Ex. 1006).

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