

Reply Declaration of Sandeep Chatterjee, Ph.D.

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

IPR2019-00528
U.S. Patent No. 8,279,173 B2

REPLY DECLARATION OF SANDEEP CHATTERJEE, PH.D.

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I, Sandeep Chatterjee, Ph.D., declare as follows:

1. I have been asked to review and respond to certain points raised in the “Patent Owner’s Response” filed with respect to the IPR petition for U.S. Patent No. 8,279,173 in IPR2019-00528. I understand that Patent Owner submitted a declaration from Dr. Rajeev Surati (**Ex. 2001**) (“Surati Declaration”) in support of its Patent Owner’s Response. I have therefore been asked to review and respond to statements in the Surati Declaration as well.

I. RESPONSE TO DR. SURATI’S OPINIONS RE WHETHER “TAG SOURCES” HAVE TO BE “SEPARATELY SEARCHABLE”

2. Dr. Surati devotes a significant discussion to the term “**tag source**” and argues that the term should be construed as “**separately searchable collections of tags.**” (Surati Decl., ¶¶72-97.) I have carefully reviewed Dr. Surati’s arguments, and for the reasons below, I respectfully disagree.

3. Dr. Surati appears to rely exclusively on the figures and textual description in the ’173 patent specification to support his “separately searchable” limitation on “tag sources,” but in my opinion, those statements do little more than restate the claim language and cannot be fairly read, by a person of ordinary skill in the art, as imposing a “separately searchable” requirement. Dr. Surati does not cite anything from the ’173 patent prosecution history for his construction, or identify anything in the claim language itself that would impose such a requirement.

4. Turning first to the *claims*, a person of ordinary skill in the art would

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have found nothing suggesting that a tag source must be “separately searchable.” Independent claim 1, for example, merely recites “*displaying a tag list including tags from one or more tag sources matching a search string,*” and a substantially similar limitation appears in the other challenged independent claims. This language merely recites an end result – the display of a tag list with particular content, *i.e.* tags from one or more tag sources matching a search string. The claim does not address how the tag list was constructed or the mechanics of how information was located or retrieved from the one or more “tag sources.” The recitation of “tags from one or more tag sources *matching a search string*” may suggest that search occurred at some time before the display, but this claim language does not specify how any such search was conducted or suggest that tag sources must be separately searchable.

5. Turning next to *specification*, I am informed by counsel for Petitioner that, under the patent laws governing construction of claim terms, it is generally improper to import limitations or details from the specification into the claims. I am further informed that this rule applies even if a patent specification describes only a single embodiment. I am further informed that this rule stems from the differences in the purposes of the claims and the patent specification; the former defines the scope of the invention and the latter teaches and enables persons of ordinary skill in the art to make and use the invention. I am further informed that an embodiment from the specification *can* impose a claim limitation where statements in the

specification provide a clear and unmistakable disavowal or disclaimer. I am further informed that a disclaimer or disavowal will not be found when the statements in the specification are ambiguous or susceptible to multiple reasonable interpretations.

6. Although I have articulated the principle that it is generally improper to “import” a limitation from the specification into the claims, Dr. Surati’s position cannot even be fairly characterized as attempting to do that. A person of ordinary skill in the art reading the ’173 specification would find nothing in the specification, for any embodiment, requiring that “tag sources” be “separately searchable.” Dr. Surati does not identify any clear disclosure of separately searchable tag sources. Dr. Surati has at best *inferred* a “separately searchable” characteristic based on a high-level description of the exemplary “tag sources” in the specification, and then imported that inferred characteristic into the claims. As I will explain below, the specification does not support such an approach.

7. The specification describes the searching of tag sources in the following passage, which describes the search in a high-level fashion without details about the actual search or how matching information in the underlying tag sources is accessed, identified, or retrieved:

Now referring to FIG. 4A, shown in screen **400A** is an illustrative tag selection user interface **404** for displaying a tag search facility as may be presented by photo tag selection module **148B**. As shown in FIG. 4A, the user is initially presented with a tag entry field **406** indicating

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