

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

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.

Patent Owner’s proposed construction would not provide a basis to distinguish MacLaurin even if the Board were to adopt it. As the Petition fully explained, MacLaurin discloses at least two different categories of tag sources that render obvious the “**tag sources**” recited in the challenged claims – (1) “automatic” and “explicit” tags, and (2) “external tag sources” such as an attorney tag set obtained from the Internet and a medical profession tag set obtained from an on-line service. (Petition at 31-34.) Patent Owner focuses its arguments about “tag sources” on the automatic/explicit tags in MacLaurin, but nowhere disputes that the “external tag sources” in MacLaurin disclose discrete “tag sources,” even under its unduly narrow construction. Because Patent Owner has not provided a persuasive explanation as to how the challenged claims are non-obvious, the Board should find those claims unpatentable based on the instituted grounds.

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 noted, this construction would not distinguish MacLaurin even if adopted. Nevertheless, as explained at length below, the Board should reject this construction because it lacks support in the intrinsic record.

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 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 47 n.11; *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

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.

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, 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

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.)

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