

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.

IPR2019-00516
IPR2019-00528¹
Patent 8,279,173 B2

Before SALLY C. MEDLEY, MIRIAM L. QUINN, and
AARON W. MOORE, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

¹ This Preliminary Guidance addresses each of these related cases. The parties, however, are not authorized to use this heading for any subsequent filings.

I. INTRODUCTION

On August 5, 2019, we instituted *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 (“the ’173 patent”). Paper 7 (“Dec.”).² After institution, Blackberry Limited (“Patent Owner”) filed a Contingent Motion to Amend. Paper 15 (“Motion” or “Mot.”). Specifically, should we find in a final written decision that the challenged claims are unpatentable, Patent Owner proposes amendment of the ’173 patent to include proposed substitute claims 21–32, each of which corresponds to a respective one of challenged claims 1, 2, 4, 6–8, 10, 12–14, 16, and 18. *Id.* at 1, Appendix A (appendix with marked-up version of substitute claims 21–32) (“App. A”). Patent Owner also requests that we provide Preliminary Guidance on the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. *Id.* at 1–2.³ Facebook, Inc., Instagram, LLC, and WhatsApp Inc. (“Petitioner”) filed an Opposition to the Motion. Paper 23 (“Opposition “ or “Opp.”). We have considered Patent Owner’s Motion and Petitioner’s Opposition and the associated arguments and evidence.

In this Preliminary Guidance, we provide information indicating the panel’s preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory

² The Motion and Opposition filed in each of the above-identified proceedings are substantively the same. All citations are to the Papers in IPR2019-00516 unless otherwise noted.

³ *See also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”).

IPR2019-00516 (Patent 8,279,173 B2)

IPR2019-00528 (Patent 8,279,173 B2)

requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* 35 U.S.C. § 316(d); 37 C.F.R. § 42.121; *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential).⁴ In the Final Written Decision, we will determine whether the substitute claims are unpatentable by a preponderance of the evidence based on the entirety of the record, including any opposition made by the petitioner. *Lectrosonics*, Paper 15, at 4.

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. In this paper, we do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties' other substantive papers on the underlying merits of Petitioner's challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including, if applicable, any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision. *See id.* at 9, 500.

⁴ *See also* Notice, 84 Fed. Reg. at 9,497 (“The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the parties about the [motion to amend].”).

IPR2019-00516 (Patent 8,279,173 B2)

IPR2019-00528 (Patent 8,279,173 B2)

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding and based on the current record, Patent Owner appears to have shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121(a) associated with filing a motion to amend for substitute claims 21–32.

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))

Yes. Patent Owner proposes one substitute claim for each of the twelve (12) challenged claims and argues that the number of substitute claims is reasonable. *See* Mot. 1–2, App. A. Petitioner does not contest Patent Owner’s arguments on this point. *See generally* Opp.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

Yes. Patent Owner presents the claim amendments in an attempt to add features to further distinguish the substitute claims as patentable over the references asserted in the instituted grounds. In particular, because Patent Owner addresses expressly Grounds 1–7 in IPR2019-00516 and Grounds 1–6 in IPR 2019-00528, including the Zuckerberg, Rothmuller, and MacLaurin references in particular, which underlie our Institution Decision, the Motion responds to the grounds of unpatentability involved in the trial. *See* Mot. 13–15 (citing Ex. 1003, Fig. 5; Ex. 1004, 3:36–39; Ex. 2012, 126:21–25, 127:10–18; Ex. 1006, 1:60–64, 8:8–11, Fig. 8). Petitioner does not contest Patent Owner’s arguments on this point. *See generally* Opp.

IPR2019-00516 (Patent 8,279,173 B2)

IPR2019-00528 (Patent 8,279,173 B2)

3. Scope of Amended Claims

**Does the amendment seek to enlarge the scope of the claims?
(35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))**

No. Proposed substitute claims 21–32 include narrowing limitations as compared to each corresponding original claim. *See* Mot. 2, App. A. Petitioner does not contest Patent Owner’s arguments on this point. *See generally* Opp.

4. New Matter

Do the amendments seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

No. On the current record, Patent Owner appears to have set forth adequate written description support for the amendments of proposed substitute claims 21–32. *See* Mot. 5–13 (citing Ex. 2009 ¶¶ 3, 8, 11, 12, 14, 16–41, 49, 50, 52, 53, 56, 59, 62, 64, 65, 68, 70, 71, 74, 76, Figs. 1, 3A–E, 4A–F, 5, 6).⁵

Although Petitioner alludes to the lack of textual description in the ’173 patent of the vertical list limitation, Petitioner does not argue that any particular limitations lack adequate written description support. *See* Opp. 5.

B. Patentability⁶

For the reasons discussed below, at this stage of the proceeding and based on the current record, it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 21–32 are unpatentable.

⁵ Exhibit 2009 refers to U.S. Appl. No. 13/252,807 (now the ’173 patent), which is a continuation of U.S. Appl. No. 11/746,285 (filed May 9, 2007). *See* Mot. 5 n.1.

⁶ We express no view on the patentability of original claims 1, 2, 4, 6–8, 10, 12–14, 16, and 18 in this Preliminary Guidance. Instead, we focus on limitations added to proposed substitute claims 21–32 in Patent Owner’s Motion to Amend.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.