

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

**PATENT OWNER'S CONDITIONAL MOTION TO AMEND
UNDER 37 C.F.R. § 42.121**

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RULES

37 C.F.R. § 42.121(a)(2)(i) 13

37 C.F.R. § 42.121(a)(3) 2

37 C.F.R. 41.121(a)(2)(ii) 2

37 C.F.R. §§ 42.6(E), 42.105(A) 4

LIST OF EXHIBITS

Exhibit #	Description
2001	Declaration of Rajeev Surati, Ph.D.
2002	Excerpts from the American Heritage College Dictionary, 4th ed. (2002)
2003	Excerpts from Webster's New World College Dictionary, 4th ed. (2008)
2004	Excerpts from Merriam-Webster's Collegiate Dictionary, 11th ed. (2003)
2005	Exhibit 9 from the Deposition of Sandeep Chatterjee, Ph.D.
2006	Petitioners' Opposition to BlackBerry's Motion for Partial Summary Judgment of Infringement in the District Court Litigation
2007	Intentionally Omitted
2008	Prosecution History of U.S. Patent No. 9,495,335
2009	U.S. Patent Application No. 13/252,807
2010	U.S. Patent Application No. 11/746,285
2011	Redline comparison of '807 and '285 Applications
2012	Transcript of November 7, 2019 Deposition of Sandeep Chatterjee, Ph.D.

I. INTRODUCTION

Pursuant to 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, Patent Owner BlackBerry Ltd. (“BlackBerry”) submits this conditional motion (“Motion”) to substitute proposed claims 21-32 shown in Appendix A (“the Substitute Claims”) for original claims 1, 2, 4, 6-8, 10, 12-14, 16, and 18 (“the Challenged Claims”) of U.S. Patent No. 8,279,173 (“’173 Patent”) should any of the Challenged Claims be found unpatentable. The Board authorized the filing of this Motion in its Scheduling Order entered August 5, 2019. *See* Paper 8. BlackBerry also e-mailed the Board, apologizing for the late notice and respectfully requesting that the conference requirement be waived.

The proposed Substitute Claims satisfy the requisite showing for a motion to amend, as they (1) do not impermissibly “enlarge the scope of the claims;” (2) present a “reasonable number of substitute claims;” (3) do not “introduce new subject matter;” and (4) “respond to a ground of unpatentability involved in the trial.” *See* 35 U.S.C. § 316(d); 37 C.F.R. § 42.121. BlackBerry has thus met its burden of production. *Aqua Products, Inc. v. Matal*, 872 F.3d 1290 (Fed. Cir. 2017) (en banc). Accordingly, should the Board find any original Challenged Claim unpatentable in this proceeding, BlackBerry requests that the Board grant this Motion to Amend with respect to each corresponding substitute claim presented herein. BlackBerry also requests that the Board provide preliminary

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