

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SNAP INC.,  
Petitioner,

v.

BLACKBERRY LIMITED,  
Patent Owner.

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IPR2019-00715  
Patent 8,326,327 B2

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Before MICHAEL R. ZECHER, MIRIAM L. QUINN, and  
AARON W. MOORE, *Administrative Patent Judges*.

QUINN, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE  
PATENT OWNER'S MOTION TO AMEND

## I. INTRODUCTION

On September 4, 2019, we instituted *inter partes* review of claims 1–3, 8–11, 13–15, and 20 of U.S. Patent No. 8,326,327 B2 (Ex. 1001, “the ’327 patent”). Paper 9 (“Institution Decision”). After institution, Patent Owner filed a Non-Contingent Motion to Amend. Paper 13 (“Motion” or “Mot.”). Patent Owner’s Motion proposes replacing claim 2 with substitute claim 21. Mot. 1, App. A. Patent Owner also requests that we provide a Preliminary Guidance on the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 1; *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”). Petitioner filed an Opposition to the Motion. Paper 24 (“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 our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory 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) (2018); 37 C.F.R. § 42.121 (2019); *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential); *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].”). In the final written decision, we will

determine whether the substitute claim is 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 proposed substitute claim 21, and specifically, on the amendments proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims 1–3, 8–11, 13–15, and 20. *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.

## 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 proposed substitute claim 21.

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 to replace one challenged claim with one substitute claim. Mot. 1. 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 proposed substitute claim 21 as patentable over the references asserted in the instituted grounds. In particular, because Patent Owner expressly addresses the Winkler, Altman, Lemmela, Crowley, and Waldman references, which underlie our Institution Decision, the Motion responds to the grounds of unpatentability involved in the trial. Mot. 6, 7, 9–13. Petitioner does not contest Patent Owner's arguments on this point. *See generally* Opp.

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 claim 21 includes narrowing limitations as compared to original claim 2. *See* Mot. 1, App. A. Petitioner does not contest Patent Owner's arguments on this point. *See generally* Opp.

4. New Matter

**Does the amendment 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 claim 21. *See* Mot. 1–5 (citing Ex. 2007 ¶¶ 20, 22, 23, 26–30, 32, 33, 35, 36, 41, 48, 61, Figs. 1–4, 9, 10).<sup>1</sup>

Petitioner contends written description support is lacking for the limitation “provide a pop-up display of said posted video” in proposed substitute claim 21. Opp. 2–6. Specifically, Petitioner acknowledges that “[i]n connection with a ‘pop-up window’ displayed next to an action spot, the ’676 application provides examples of ‘additional information relating to the documenting activity’ that can be provided in this pop-up window.” *Id.* at 4 (citing Ex. 2007 ¶ 48). But, Petitioner argues, “[n]one of these examples describes displaying video posting activity, as recited in substitute claim 21.” *Id.* (citing Ex. 1020 ¶¶ 86, 87).<sup>2</sup> Rather, Petitioner argues, “Patent Owner’s expert conceded that where the specification identified posting of videos, it was ‘not the context’ of pop-up displays, but in context of a server ‘monitoring phones that [are] capturing videos.’” *Id.* at 5 (citing Ex. 1024, 184:3–187:4).<sup>3</sup> “[D]isclosure of a broad genus of pop-up displays of posts with ‘additional information’ cannot,” Petitioner asserts, “provide written description support for a narrow species of pop-up displays of the claimed video posts, where that species is not expressly disclosed.” *Id.* at 6 (emphases omitted).

The test for satisfying the written description requirement, under 35 U.S.C. §112, first paragraph,<sup>4</sup> “is whether the disclosure of the application relied

<sup>1</sup> Exhibit 2007 refers to U.S. Patent Appl. No. 12/870,676 (“the ’676 application”), which was filed August 27, 2010 and issued as the ’327 patent on December 4, 2012.

<sup>2</sup> Exhibit 1020 refers to the Rebuttal Declaration of Dr. Samrat Bhattacharjee.

<sup>3</sup> Exhibit 1024 refers to the Deposition Transcript of Dr. Patrick D. McDaniel for the deposition conducted March 6, 2020 in this proceeding.

<sup>4</sup> The ’676 application that issued as the ’327 patent was filed before the effective date of Section 4(c) of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284, 287–88 (2011) (effective Sept. 16, 2012). Therefore, in evaluating the relevant amendments we refer to the pre-AIA version of § 112.

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