

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SNAP, INC.,
Petitioner

v.

BLACKBERRY LIMITED,
Patent Owner

Case No. IPR2019-00715
Patent No. 8,326,327

**PATENT OWNER'S SUR-REPLY TO
PETITIONER'S REPLY TO PRELIMINARY GUIDANCE
(PURSUANT TO 84 FED. REG. 9502)**

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I. CLAIM 21 IS NON-OBVIOUS UNDER 35 U.S.C. §103

A. Petitioner's Rationales For The Proposed New Obviousness Combinations Are Insufficient And Contrary To Substantial Evidence

1. Petitioner failed to articulate and support (with evidence) a specific rationale for applying *Eyal's* or *Jaffe's* video features to the base system of *Lemmela* or *Winkler*

The Preliminary Guidance (“PG”) properly explained that “Petitioner does not explain *why* a person of ordinary skill in the art would have been prompted to either perform a substitution or make the asserted combination,” and substantial evidence supports this assessment. PG, 10-12; EX2003, ¶¶143, 147; EX1022, 27:11-16; EX1024, 153:20-154:1. The Reply to the Preliminary Guidance (“PG-Reply”) overlooks this evidence—resorting to vague entreaties to *KSR*. PG-Reply, 2-6. Under *KSR*, it was Petitioner’s burden to provide persuasive evidence/articulated reasoning that a POSITA back in 2010, starting from *Lemmela* (or *Winkler*) and without hindsight, would have been prompted to make the specific changes proposed in Petitioner’s Opposition. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360-61 (Fed. Cir. 2011) (“selected and combined”). That burden certainly was not met.

The Opposition’s “reasons to combine” for all grounds lean on Petitioner’s false assumption that *Jaffe's* statements for “broad social and practical importance” of “viewing and interacting” were somehow tethered to video posts. Opp., 16, 18. They are not. The Preliminary Guidance correctly noted that these statements in *Jaffe* pertain to the popularization of “digital photography” at the time, not “video

posts.” PG, 11 (citing EX1013, 1:14-21). Contrary the PG-Reply (p. 7), the evidence shows *Jaffe*’s teaching in this regard is not equally applicable to images and video posts—and certainly not before August 2010. EX1022, 27:11-16; EX1024, 153:20-154:1. *Jaffe*’s system discussed later in the “Detailed Description” section can process several types of media objects including photographs and video (col. 3:63-4:4), but it does not follow from this that *Jaffe*’s specific statements in “Background” regarding “digital photographs” (col. 1:14-21) must be imputed to all other species of media objects. Petitioner had a burden to provide persuasive evidence of this allegation, but it failed to do so. Indeed, the Preliminary Guidance adroitly noted the evidence from Dr. McDaniel (PG, 10-11), which appears to be consistent with Dr. Bhattacharjee’s admission that the network infrastructure required to support large scale video posting was not available in August 2010 (EX1020, ¶¶94, 220). *Arctic Cat Inc. v. Bombardier Recreational Prods. Inc.*, 876 F.3d 1350, 1363 (Fed. Cir. 2017) (“Evidence suggesting reasons to combine cannot be viewed in a vacuum apart from evidence suggesting reasons not to combine.”).

The PG-Reply (pp. 7-9) improperly raised for the first time “specific reasons” that were fatally absent from its Opposition paper. Such prejudicially late theories should be disregarded. *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330-1331 (Fed. Cir. 2019). Moreover, they are unsupported. For instance, the Reply contends that a POSITA would have been prompted to further modify *Lemmela*’s

and *Winkler's* base systems in light of *Eyal* or *Jaffe* merely because some describe “similar problems in the prior art” and allegedly “provide methods for organizing the presentation of content.” Reply, 8. But the mere circumstance that references have these “alleged similarities” is not enough to “constitute an articulated reasoning with rational underpinning.” *William Wesley Carnes, Sr., Inc. v. Seaboard Int’l Inc.*, IPR2019-00133, Paper 10, 17-18 (PTAB May 8, 2019). Here, Petitioner overlooks critical differences among the references by characterizing their solutions at an absurdly high level of generality. Indeed, *Eyal's* solution for sharing geocoded video content is far different from *Winkler's* system for generating map elements that prompt user conversations or *Lemmela's* system for generating salient-word clouds. EX2003, ¶¶143, 147. *Jaffe's* goal for summarizing media collections is likewise markedly different from *Winkler's* or *Lemmela's* desired results. *Id.*

Finally, Petitioner's reliance on *Uber Techs., Inc. v. X One Inc.* is misplaced. Reply, 4. In *Uber*, the prior art highlighted a finite set of only two alternatives and a design need that would have prompted the substitution of one for the other. *Uber*, 2020WL 2123399 at *9-10. In contrast, the record here does not even define a specific problem, let alone a finite set of only two solutions. The addition of video posting was also not a mere “choice” (PG-Reply, 9) or “change/add for the *input*” of *Lemmela* and *Winkler* (PG-Reply, 5), especially where substantial evidence in the record confirms the proposed “video” modifications were inconsistent with device

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