

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 NON-CONTINGENT MOTION TO AMEND

TABLE OF CONTENTS

I.	STATEMENT OF RELIEF REQUESTED	1
II.	PROCEDURAL REQUIREMENTS OF 37 C.F.R. §42.121	1
A.	Reasonable Number of Claims—37 C.F.R. §42.121(a)(3).....	1
B.	Non-Broadening Amendments—37 C.F.R. §42.121(a)(2)(ii).....	1
C.	Fully Supported Amendments—37 C.F.R. §42.121(a)(2)(ii).....	1
1.	Element [21b]—Touch Sensitive Display	2
2.	Element [21c]—Displaying an Interactive Map.....	2
3.	Elements [21e] & [21g]—Action Spot and Activity Level.....	4
4.	Element [21f]—Action Spot and Current Location Signifying.....	5
5.	Element [21i]—Providing a Pop-Display.....	5
D.	Responsive Amendments—37 C.F.R. §42.121(a)(2)(i)	6
III.	PATENTABILITY OF THE SUBSTITUTE CLAIM.....	7
A.	The Amended Subject Matter of Substitute Claim 21	7
B.	Claim Construction	9
1.	“determine” at least one “action spot”	9
C.	Non-Obviousness	9
1.	The New Features of Elements [21e], [21g], & [21i].....	9
a)	Winkler (EX1004).....	10
b)	Altman (EX1006).....	11
c)	Lemmela (EX1005).....	12
d)	Crowley (EX1008).....	12
e)	Waldman (EX1011)	13
2.	The Original Elements of Claim 2 (Remaining in Claim 21)	13
a)	Deficiencies of the Lemmela Combinations as to the Original “Action Spot” Features of Element [21e].....	13
b)	Deficiencies of the Lemmela Combinations As To the Original “Activity Level” Features of Element [21g]	15

- c) Deficiencies of the Lemmela Combinations As To the Original “Coloring” Feature Element [21h]16
- d) Deficiencies of the Winkler Combination As To the Original “Action Spot” Feature of Element [21e]17
- D. Substitute Claim 21 Represents Patent Eligible Subject Matter19
 - 1. Revised Guidance Step 1—Statutory Class.....19
 - 2. Revised Guidance Step 2A—Abstract Idea.....20
- IV. DUTY OF CANDOR—37 C.F.R. 42.1121

EXHIBIT LIST

- EX2001 Declaration of Patrick McDaniel, Ph.D.
- EX2002 Corrected Final Ruling on Claim Construction/*Markman* Hearing, *Blackberry Limited v. Snap Inc.*, Case Nos. CV 18-1844-GW & 18-2693-GW (C.D. Cal. April 5, 2019) (“*Markman* Order”)
- EX2003 Second Declaration of Patrick McDaniel, Ph.D.
- EX2004 Transcript of Deposition of Dr. Samrat Bhattacharjee (November 18, 2019)
- EX2005 Final Ruling On Defendant Snap Inc.’s Motion For Summary Judgment Of Invalidity Under Section 101 Of U.S. Patent Nos. 8,825,084 And 8,326,327, *Blackberry Limited v. Snap Inc.*, Case Nos. CV 18-1844-GW & 18-2693-GW (C.D. Cal. October 1, 2019)
- EX2006 Disclosure Pursuant To 37 C.F.R. §42.11
- EX2007 US Appl. No. 12/870,676 (as filed)
- EX2008 Garmin: Updating Maps on Your Garmin Device (May 2010), *available at* https://www8.garmin.com/documents/instructions/Garmin_Map_Update_Guide.pdf (retrieved November 24, 2019)
- EX2009 CNET Article: How To Update Your GPS Maps TomTom Edition (July 14, 2010), *available at* <https://www.cnet.com/pictures/how-to-update-your-gps-maps-tomtom-edition-photos> (retrieved November 24, 2019) (slideshow pictures reproduced in a single PDF)

I. STATEMENT OF RELIEF REQUESTED

BlackBerry respectfully requests that the Board consider this Motion on a non-contingent basis and grant entry of corresponding substitute claim 21 in replacement of original claim 2. BlackBerry also respectfully requests preliminary guidance concerning this Motion, in accordance with the New Pilot Program Concerning Motion to Amend Practice. *See* Fed. Reg. 9,497 (Mar. 15, 2019).

II. PROCEDURAL REQUIREMENTS OF 37 C.F.R. §42.121

A. Reasonable Number of Claims—37 C.F.R. §42.121(a)(3)

Substitute claim 21 corresponds to original claim 2. *See* Appendix A. This one-to-one relationship fits within “[t]he presumption [] that only one substitute claim would be needed to replace each challenged claim.” 37 C.F.R. §42.121.

B. Non-Broadening Amendments—37 C.F.R. §42.121(a)(2)(ii)

Substitute claim 21 includes amendments that: (i) rewrite original claim 2 into independent form, incorporating all features of original claims 1-2; and (ii) add new feature combinations to the original claim language. Appendix A; EX2003, ¶¶117-119 (claim language comparison). With no original elements removed and several new elements added, claim 21 is solely narrowing and *a priori* non-broadening.

C. Fully Supported Amendments—37 C.F.R. §42.121(a)(2)(ii)

Substitute claim 21 is fully supported by the disclosure of U.S. Appl. No. 12/870,676 (the ’676 Application; EX2007), as demonstrated below. *See generally* EX2003, ¶¶125-139.

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