

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

---

Case IPR2019-00924  
Patent 8,209,634

---

**DECLARATION OF RAJEEV SURATI, PH.D.**

## TABLE OF CONTENTS

|              |   |    |
|--------------|---|----|
| <b>I.</b>    | <b>INTRODUCTION AND SCOPE OF WORK</b> .....   | 1  |
| <b>II.</b>   | <b>SUMMARY OF OPINIONS</b> .....  | 2  |
| <b>III.</b>  | <b>BACKGROUND AND QUALIFICATIONS</b> .....  | 2  |
| <b>IV.</b>   | <b>BASIS FOR OPINIONS</b> .....   | 6  |
| <b>V.</b>    | <b>FIELD OF ART</b> .....   | 9  |
| <b>VI.</b>   | <b>PERSON OF ORDINARY SKILL IN THE ART</b> .....  | 9  |
| <b>VII.</b>  | <b>THE '634 PATENT</b> .....  | 10 |
|              | A. Overview of the '634 patent .....  | 10 |
|              | B. Prosecution History of the '634 patent .....   | 14 |
| <b>VIII.</b> | <b>INTERPRETATIONS OF THE '634 PATENT CLAIMS AT ISSUE</b> ..  | 18 |
|              | A. “wireless communication device” (All challenged claims) .....  | 18 |
|              | B. “messaging correspondent” (All challenged claims) .....  | 19 |
|              | C. “a numeric character representing a count of the plurality of different message correspondents for which one or more of the electronic messages have been received and remain unread” (All challenged claims)..... | 20 |
| <b>IX.</b>   | <b>ANALYSIS REGARDING THE CLAIMS OF THE '634 PATENT IN LIGHT OF THE PRIOR ART</b> .....   | 20 |
|              | A. Ording, Canfield, and Schwartz (Ground 1).....   | 21 |
|              | B. The Petition failed to show that the Ording/Canfield/Schwartz discloses the claimed “numeric character representing a count of the plurality of different messaging correspondents.”.....                          | 31 |
|              | C. The Petition fails to show a POSITA would have been motivated to modify Ording in view of Canfield and Schwartz to arrive at the claimed invention. (All Grounds) .....  | 32 |
|              | D. The Petition fails to acknowledge additional problems posed by its modification of Canfield to prohibit all sessions except one-on-one sessions. ...   | 37 |

- E. The Petition fails to show that the proposed modification based on Canfield alone would have been obvious.....38
- F. The Petition’s alternative theory that proposed modifications to Ording/Canfield/Schwartz would have been “obvious to try” is unsupported by any sufficient evidence .....38
- X. LEGAL STANDARDS .....39**
  - A. Claim Interpretation .....40
  - B. Obviousness.....41
- XI. CONCLUSION .....44**

I, Rajeev Surati, Ph.D., of Cambridge, Massachusetts, declare that:

**I. INTRODUCTION AND SCOPE OF WORK**

1. I have been retained by Patent Owner Blackberry Limited in the above-captioned *Inter Partes* Review (IPR) as an independent expert in the relevant field.

2. I have been asked to provide my independent analysis regarding the references identified by petitioners Facebook, Inc., Instagram, LLC, and WhatsApp Inc. (“Petitioner”) in this IPR related to U.S. Patent 8,209,634 (“the ’634 patent”), which is assigned to Patent Owner. I have been asked to consider what one of ordinary skill in the art before the priority date of the ’634 patent would have understood from the ’634 patent, including scientific and technical knowledge related to the ’634 patent. I have also been asked to consider whether the references relied on by Petitioner disclose or render obvious the inventions claimed by the ’634 patent.

3. I understand that this proceeding is currently in a preliminary stage, and no IPR has yet been instituted. I have been asked to present my independent analysis with respect to certain issues relevant to the question of whether IPR should be instituted. I understand that I may be asked to present my complete analysis at a later date (if IPR is instituted), but the complete analysis is not

necessary at this time. Accordingly, my independent analysis for relevant issues is set forth below.

4. My analysis is directed by my education, training, and experience as a person of ordinary skill in the art as of the priority date of the '634 patent, which for purposes of my analysis here is assumed to be the effective filing date of the '634 patent—December 1, 2003.

5. I am being compensated for my work in connection with this IPR proceeding at my standard hourly rate. My compensation is not in any way contingent on the substance of my opinions or the outcome of these proceedings.

## **II. SUMMARY OF OPINIONS**

6. Based on my experience and expertise, discussed below, and my review of the references identified by Petitioner in this IPR for the '634 patent, it is my opinion that the cited references do not render obvious at least claims 1, 4-7, 10-13, and 16-18 of the '634 patent.

## **III. BACKGROUND AND QUALIFICATIONS**

7. I have more than twenty (20) years of experience in electrical engineering, computer science, and electronic messaging. The following paragraphs summarize some of my experience that is relevant to the technologies described within the '634 patent. For further details, please refer to my *curriculum vitae* which is attached as Appendix A.

# 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.