UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FACEBOOK, INC., INSTAGRAM, LLC, AND WHATSAPP INC.
Petitioner

v.

BLACKBERRY LIMITED
Patent Owner

Case IPR2019-00924
Patent 8,209,634

PATENT OWNER BLACKBERRY LIMITED'S PRELIMINARY SUR-REPLY

EXHIBITS

EX2001	Declaration of Rajeev Surati, 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	Defendant's Notice and Motion to Stay Pending *Inter Partes* Review, *BlackBerry Limited v. Facebook, Inc. et al.*, Case Nos. 2:18-cv-01844-GW & 2:18-cv-02693-GW (C.D. Cal. April 16, 2019)
EX2004	Minutes of Status Conference, Initial Thoughts re Joint Report, *BlackBerry Limited v. Facebook, Inc. et al.*, Case Nos. 2:18-cv-01844-GW & 2:18-cv-02693-GW (C.D. Cal. April 22, 2019)
EX2005	Notice Withdrawing Pre-Institution Motion to Stay In View of Court's Guidance, *BlackBerry Limited v. Facebook, Inc. et al.*, Case Nos. 2:18-cv-01844-GW & 2:18-cv-02693-GW (C.D. Cal. April 26, 2019)
EX2006	Minutes of Order In Chambers, Trial Schedule, *BlackBerry Limited v. Facebook, Inc. et al.*, Case Nos. 2:18-cv-01844-GW & 2:18-cv-02693-GW (C.D. Cal. May 15, 2019)
EX2007	BlackBerry Limited's Final Election of Asserted Claims, *BlackBerry Limited v. Facebook, Inc. et al.*, Case Nos. 2:18-cv-01844-GW & 2:18-cv-02693-GW (C.D. Cal. May 31, 2019)
EX2008	Defendant's Final Election of Asserted Prior Art, *BlackBerry Limited v. Facebook, Inc. et al.*, Case Nos. 2:18-cv-01844-GW & 2:18-cv-02693-GW (C.D. Cal. June 14, 2019)
EX2009	RESERVED
EX2010	RESERVED

EX2011	Order Modifying Scheduling Order *BlackBerry Limited v. Facebook, Inc. et al.*, Case Nos. 2:18-cv-01844-GW & 2:18-cv-02693-GW (C.D. Cal. July 12, 2019)
EX2012	Order Denying Renewed Motion for Stay, *The California Institute of Technology v. Broadcom Ltd. et al.*, Case No. 2:16-cv-03714-GW (C.D. Cal. October 5, 2017)

§ 325(d): Nothing in Facebook's Reply disputes the critical facts on page 28 of the POPR demonstrating the meaningful overlap between the Examiner's "Canfield Considered" grounds (which were withdrawn) and the Petition's "Canfield" grounds. Facebook's Reply merely repeats the same §325(d) arguments previously raised in the Petition. The Reply again attempts to rely on one purported difference between "Canfield" and "Considered Canfield," but this line of argument overlooks that both Canfield and Considered Canfield are directed to numbers of instant messaging "sessions" and both include scenarios in which a single correspondent would "start and stop" a number of sessions. As a result, both Canfield and Considered Canfield suffer from the same shortcoming identified during original prosecution that led the Examiner to withdraw such grounds for rejection. *See* POPR, 28; EX1013, 814; 678 ("a single correspondent can initiate an unlimited number of new IM sessions"). Nothing in the Reply identified new teachings of Canfield that address this pertinent reasoning in the prosecution history, and the fact that Canfield and Considered Canfield may describe different numbers of "sessions" is immaterial to this shared deficiency. The Petition relies on Canfield's number of sessions—just like the Examiner relied on Considered Canfield's number of sessions—and Petitioner has failed in its burden to demonstrate why Canfield is not cumulative. *See* POPR, 28.

§ 314(a): Likewise, the Reply never disputes the critical facts explained on

pages 21-22 of the POPR nor the consistencies with the *E-One* case. By waiting nearly a year to file its Petition, Facebook has acted against the interests of efficiency. Congress intended the PTAB to implement IPR proceedings to "ultimately reduce litigation costs" and "create[] an inexpensive substitute for district court litigation"—not for insuring a defendant's second chance at invalidity positions after the costly litigation ends. *See* 157 Cong. Rec. S5319 (Sept. 6, 2011) (Sen. Kyl). The PTAB is not Facebook's insurance policy.

The Reply alleged that Facebook "intends" to renew its request for a stay, but noticeably absent is the proposed date for this alleged motion. Reply, 3. The Reply also ignored that the institution decisions for all IPRs at issue in the concurrent litigation are not likely to be received until November 2019 (e.g., refer to IPR2019-00923)—only five months before the trial date. Facebook never cites to a single C.D. Cal. decision granting a stay based upon an IPR instituted only five months before the trial date. Facebook's "intention" to seek a stay is nothing more than an invitation for the Board to speculate about a change to the district court trial date. *See Amazon.com, Inc. v. Customplay, LLC*, IPR2018-001498, Paper 13, 10 (PTAB March 14, 2019) ("We decline to speculate about whether the district court is likely to postpone the current trial date…"). Critically, Facebook never addressed the fact that Judge Wu warned Facebook that the court may "deny the stay even if an IPR has been granted ... if a party has dallied in filing the IPR request." POPR, 21 (citing

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