

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 IPR2019-00925
Patent 8,209,634

SECOND DECLARATION OF RAJEEV SURATI, PH.D.

TABLE OF CONTENTS

I.	INTRODUCTION AND SCOPE OF WORK	1
II.	SUMMARY OF OPINIONS	1
III.	BASIS FOR OPINIONS	1
IV.	FIELD OF ART	5
V.	PERSON OF ORDINARY SKILL IN THE ART	5
VI.	THE '634 PATENT	6
A.	Overview of the '634 patent	6
B.	Prosecution History of the '634 patent	10
VII.	INTERPRETATIONS OF THE '634 PATENT CLAIMS AT ISSUE	13
A.	“wireless communication device” (All challenged claims)	14
B.	“messaging correspondent” (All challenged claims)	15
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)	16
VIII.	ANALYSIS REGARDING THE CLAIMS OF THE '634 PATENT IN LIGHT OF THE PRIOR ART	17
A.	References cited in Grounds 1-4	17
1.	Overview of Ording (EX1103)	18
2.	Overview of Abiko (1109)	20
3.	Overview of Crumlish (EX1110)	23
4.	Overview of Dvorak (EX1111)	25
5.	Overview of McPherson (EX1112)	26
B.	The Petition Fails to Show a Motivation for Each of the Proposed Layers of Modifications to Ording’s Computer (All Grounds 1-4)	27
1.	The Petition does not demonstrate a reason why a POSITA would have been motivated to modify Ording’s computer to include Abiko’s e-mail program (Elements 1[a] and 1[b])	28

2. The Petition does not demonstrate that, at the time of the invention, a POSITA would have been motivated to modify Ording’s icon in the manner proposed (Element 1[c])	31
C. The Petition’s Proposed Modifications to Abiko’s E-mail Program are Unsupported and Contrary to Abiko’s and Crumlish’s Teachings (All Grounds 1-4)	39
1. The Petition’s further modifications to Abiko’s e-mail program based on Crumlish’s description of “Pegasus mail” suffer from multiple errors (Element 1[c]).....	40
2. The Petition’s fourth and fifth proposed modifications ignore Abiko’s stated purpose for creating and displaying Abiko’s “sender selection” menus (Element 1[c]).....	48
D. The Petition Does Not Identify Any Publication That Describes the Step of Visually Modifying a “Displayed Icon” to Achieve the Specific “Count” Recited in the Claims (All Grounds 1-4).....	54
E. The Petition fails to show that claims 6, 12, and 18 were obvious in view of Ording, Abiko, Crumlish, Dvorak, and McPherson (Grounds 2 and 4).....	58
IX. LEGAL STANDARDS.....	61
A. Claim Interpretation	61
B. Obviousness	62
X. CONCLUSION	66

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

I. INTRODUCTION AND SCOPE OF WORK

1. On July 17, 2019, I provided an initial Declaration in the IPR2019-0925 proceeding. *See* EX2001. I provide this Second Declaration in response to the October 16, 2019 Board Decision instituting IPR. In this Second Declaration, I provide additional analysis regarding whether the references cited in Grounds 1-4 of the Petition render obvious the inventions claimed by the '634 patent.

2. 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.

3. 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

4. Based on my experience and expertise, which is discussed in my initial Declaration (EX2001, ¶¶7-20), and my review of the references identified by Petitioners 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. BASIS FOR OPINIONS

5. My opinions and analysis set forth in this Declaration are based on my education, training, and experience as summarized above and detailed in my C.V., as well as my review of the '634 patent, its prosecution history, and the references identified by Petitioners in this IPR proceeding. I have also reviewed the declaration from Dr. Sandeep Chatterjee (EX1102), which Petitioners submitted in support of its Petition in this IPR proceeding. I have also reviewed the Petition and each of the accompanying documents that are cited in the Petition, including those specifically mentioned in Grounds 1-4 of the Petition (noted below). I have also reviewed my initial Declaration signed July 17, 2019 (EX2001) and the October 16, 2019 Board Decision instituting IPR in this case ("Institution Decision"). Further, I have also reviewed the deposition testimony of Dr. Sandeep Chatterjee (EX2017).

6. The Petition refers to the following materials in Grounds 1-4 of the Petition, which I specifically reviewed and address below as part of my analysis for this Declaration:

- Declaration of Sandeep Chatterjee, Ph.D. (EX1102)
- U.S. Patent No. 7,434,177 B1 to Bas Ording et al. ("Ording", EX1103)
- Excerpts from Microsoft Computer Dictionary (5th ed. 2002) (EX1108)

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.