

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
U.S. Patent No. 8,209,634

PETITIONERS' REPLY

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Petitioner respectfully submits the following Reply in support of its Petition for *Inter Partes* Review:

I. PETITIONER PROVIDED COMPELLING MOTIVATIONS TO COMBINE FOR EACH GROUND AND PRIOR ART REFERENCE

In an attempt to make the instituted obviousness grounds seem more complex than they are, or improperly suggest that the instituted grounds require a physical combination,¹ Patent Owner structured its response around a list of five purported technical “modifications” it claims must be applied to the computer system of Ordering to meet the claim limitations of the challenged claims. (Response at 14-15.) For each of these purported “modifications,” Patent Owner primarily argues that the Petition did not articulate a sufficient motivation to combine. Patent Owner does not appear to seriously contest that the prior art cited in the instituted grounds, as a whole, discloses all limitations of the challenged claims.

¹ See, e.g., *Allied Erecting & Dismantling Co., Inc. v. Genesis Attachments, LLC*, 825 F.3d 1373, 1381 (Fed. Cir. 2016) (“‘The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference,’ but rather whether ‘a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention.’”) (citations omitted).

A closer look at Patent Owner’s list of “modifications” confirms that the instituted obviousness combinations, even under the stilted and complex way in which Patent Owner frames them, are straightforward, well-reasoned, and not based on hindsight analysis. The Petition supported each of these so-called modifications with multiple motivations to combine. Patent Owner does not dispute any of Petitioner’s evidence that a skilled artisan would have had a reasonable expectation of success in combining the prior art references in the manner described.

Patent Owner makes no challenge whatsoever to its first modification (nor could it) – adapting the Ording computer to incorporate wireless communication capabilities. (Response at 14, ¶1.) The second purported modification – combining Ording with the email program of Abiko – is fully supported by the record and the multiple motivations to combine set forth in the Petition. The same is true for the third purported modification – adapting the numeric character in Ording to report the number of distinct senders as opposed to the number of new messages – as also explained in the Petition. And as for the fourth and fifth modifications, they merely relate to the ability to identify new messages (and separate them from all received messages), a feature of prior art messaging systems so basic that Patent Owner cannot credibly claim provides any point of novelty or distinction over the prior art. Nevertheless, even as to this trivial feature, the Petition provided an exhaustive analysis of the motivations to combine with respect to Abiko and Crumlish.

A. The IPR Petition provided a compelling motivation to combine the teachings of Ording and Abiko.

Patent Owner's first attack focuses on its second so-called modification, *i.e.* combining the user interface of Ording with the email capabilities of Abiko. (Response at 17-24.) But Patent Owner's arguments ignore the actual motivations set forth in the Petition.²

The Petition explained that a person of ordinary skill in the art would have been motivated to combine Ording with Abiko because Abiko provided wireless communications capabilities not disclosed in Ording. (Ex. 1102, ¶¶67, 71-73.) This motivation is not only relevant to Patent Owner's first so-called modification (which Patent Owner does not dispute), but also the second. The Petition explained that wireless capabilities "provide a key convenience in that the user need not be tethered

² Patent Owner claims that Petitioner's entire motivation to combine analysis was contained on pages 33-34 of the Petition (and the corresponding paragraphs of its expert declaration). (Response at 17-18.) But those pages were devoted to simply laying out and explaining the combination itself, *i.e.* adapting the userbar **600** of Ording to include an icon for the Abiko email program. (Petition at 33-34; Ex. 1102, ¶80.) Patent Owner ignored other disclosures in the Petition (under sections conspicuously entitled "Rationale and Motivation to Combine") that provide the motivations to combine the teachings of Ording and Abiko, as explained in the text.

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