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 IPR2019-00925
Patent 8,209,634

PETITIONER'S PRELIMINARY REPLY[1]

[1] This Reply was authorized by the Board's order dated August 20, 2019 (Paper 11).

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Petitioner respectfully requests that the Board decline to exercise its discretion to deny institution under § 314(a) and under the Trial Practice Guide (July 2019).

§ 314(a): Prior to the filing of this Petition and IPR2019-00924, filed on the same day, no other petitions had been filed by Petitioner or anyone else. The timing of the Petition was also appropriate; it enabled Petitioner to address recent claim construction issues raised by Patent Owner, and the court's April 1, 2019 tentative *Markman* order. (Petition at 9-13.) As a result, the Petition was more thorough than would have been possible even a couple months earlier.

The state of the district court proceeding does not support discretionary denial under § 314 or *NHK Spring v. Intri-Plex Techs.*, Case IPR2018-0072 (PTAB Sept. 12, 2018). Because the Petition here challenges claims 1, 4-7, 10-13 and 16-18, while only claim 4 remains in the district court case (Ex. 2007 at 3), the district court case will not resolve the invalidity challenges presented here. "[D]iffering claim sets is a factor that weighs against exercise of … discretion under § 314(a) to deny institution based on [parallel litigation]." *3Shape A/S v. Align Tech.*, Case IPR2019-00160, Paper 9 at 39 (PTAB June 11, 2019).

Second, the Board in *NHK* found it significant that the IPR petition relied on the same prior art and arguments as the district court. *NHK Spring*, at 19-20. But here, the prior art references cited in the IPR grounds are different from those relied on in the district court litigation. (Ex. 1125 at 4.)

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Third, the *NHK* petitioner did not disclose any intention to seek a stay of the litigation. Here, Petitioner intends to renew its request for a stay based on the results of the institution decisions. Thus, the trial date in the district court proceeding is far from set in stone. But even if the trial date does not change, given the circumstances here, denial of institution would be unwarranted. *See RTI Surgical, Inc. v. LifeNet Health*, Case IPR2019-00571, Paper 20 at 2-3, 8 (PTAB Aug. 12, 2019) (instituting IPR of patent after district court litigation and Federal Circuit affirmance given absence of showing that Patent Office or courts had considered cited prior art).

Parallel Petition Considerations: The Petitioner filed the present Petition and the one in IPR2019-00924 prior to the July 2019 Trial Practice Guide. The Petition here nevertheless explained why two petitions were filed, and why the two were neither cumulative nor redundant of one another. (Petition, at 5-6.) Although Patent Owner now only asserts claim 4, this narrowing did not take place until well after the filing of the IPR petitions, thus requiring that Petitioner address more claims. Petitioner explained that condensing the grounds from both petitions "into a single IPR petition within the word limits, while possible, would have resulted in a reduction in the thoroughness of analysis." (Petition, at 5.)

Nevertheless, if the Board is only inclined to institute one IPR petition, Petitioner requests that it consider the present petition before IPR2019-00924, in order to conserve resources of the Board. Patent Owner in IPR2019-00924 has

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argued that a prior reference cited there implicates § 325(d). Petitioner is mindful that addressing those arguments (even though Petitioner does not agree with them) will consume resources of the Board. Because Patent Owner makes no § 325(d) arguments here, an institution decision would present fewer issues.

But Petitioner believes substantive differences justify consideration and institution here and in IPR2019-00924. The two petitions differ with respect to the key claimed feature – a numeric character representing a count of different messaging correspondents. (Petition at 5-6.) This feature was the sole ground for allowing the claims. (*Id.* at 13 (citing Ex. 1113 at 0826).) The Petition in IPR2019-00924 relies on Canfield, which discloses a number of IM sessions (old and new) with new messages, a number that can represent a number of correspondents. Patent Owner primarily argues that a count of IM sessions in Canfield is different from a count of messaging correspondents. But here, primary reference Abiko discloses a count of senders, so the IM session issue is not presented here. (Petition, at 35-37.) Accordingly, the primary attack raised by Patent Owner here is whether a motivation of combine exists (which it does). But on the other side, the Canfield reference in IPR2019-00924 presents fewer motivation to combine issues because there are fewer references. In either case, the references in the two petitions address this critical limitation using different techniques. Consideration and institution of both IPR petitions is therefore respectfully requested.

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Dated: August 23, 2019

Respectfully submitted,

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