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

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)

§ 314(a): The Reply never disputes the critical facts explained on pages 21-23 of the POPR nor the consistencies with the *E-One* case. Facebook waited nearly a year to file its IPR Petition, did so using apparent "different" grounds that Facebook admittedly does not deem worthy of submitting to the jury, and now demands the Board proceed with a trial that will be grossly inefficient. Reply, 1 ("grounds are different from those"). 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 backup grounds to be resolved only after the costly litigation ends. 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, 2. 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, 22 (citing EX2004, 2). That Facebook "dallied" is hardly in question. POPR, 21-22. Indeed, by the time of any institution decision here, fact discovery will have been completed, and the parties will be exchanging expert reports. *See* EX2011, 1-2. The same district court previously denied a renewed motion to stay in view of instituted IPRs based on similar facts, finding that "significant litigation activity" had already occurred. *See* EX2012, 2-3.

Facebook attempts to downplay its delay by suggesting that the twelve originally asserted claims were somehow too numerous to challenge before being narrowed further. Reply, 1. But an IPR challenge against twelve claims is not burdensome, and it is telling that the Petition ultimately challenged the twelve claims because Facebook alleged they were "substantially similar." *See* Pet., 9. Facebook's credibility here is lacking. Moreover, Facebook's arguments about "differing" claim sets and the *3Shape* case are misplaced. Reply, 1. Facebook's reliance on the *3Shape* decision conveniently ignores that the panel gave weight to "the lack of preclusive effect of any ITC determination of invalidity," which is certainly not applicable here. *3Shape A/S v. Align Tech.*, IPR2019-00160, Paper 9, 39 (PTAB June 11, 2019). Also, any claim asserted in the district court is part of the claim set

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