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Paper 7
Entered: August 30, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner,

v.

BLACKBERRY LTD.,
Patent Owner.

Case IPR2017-00911
Patent 8,745,149 B2

Before SALLY C. MEDLEY, ROBERT J. WEINSCHENK, and RICHARD H. MARSCHALL, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Google Inc. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 1–17 of U.S. Patent No. 8,745,149 B2 (Ex. 1001, "the '149 patent"). BlackBerry Limited ("Patent Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp.") to the Petition. An *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a).

For the reasons set forth below, Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of claims 1–17 of the '149 patent. Accordingly, we institute an *inter partes* review as to claims 1–17 of the '149 patent on the grounds specified below.

A. *Related Proceedings*

The parties indicate that the '149 patent is the subject of the following district court case: *BlackBerry Ltd. v. BLU Products, Inc.*, No. 1:16-cv-23535 (S.D. Fla.). Pet. 1; Paper 4, 1. The parties also indicate that Petitioner filed another petition requesting an *inter partes* review of the '149 patent in IPR2017-00912. Pet. 1; Paper 4, 1.

B. *The '149 Patent*

The '149 patent relates to "a handheld electronic device and a method for providing information representative of the times of certain communications in a messaging environment." Ex. 1001, 1:20–24. According to the '149 patent, handheld electronic devices are capable of numerous types of communication, including instant messaging. *Id.* at 1:39–44. The '149 patent explains that, when an instant messaging conversation continues quickly, there generally is no need to display time information for

an instant message. *Id.* at 1:58–64. In other circumstances, though, "it may be desirable for information regarding certain timing aspects . . . to be available to a user," but "the limited space available on a display of a handheld electronic device has made a solution difficult." *Id.* at 1:65–2:2.

To address this alleged problem, the '149 patent describes an electronic device that displays time information for an instant message only after the expiration of a predetermined period of time during which no messages are exchanged. *Id.* at 5:31–38. In another embodiment, the electronic device displays time information only when it is requested manually by a user. *Id.* at 6:14–23, 7:11–19. The '149 patent also describes a smart time stamp. *Id.* at 7:37–50. For example, the smart time stamp displays first time information (e.g., 2:44 pm) for an instant message. *Id.* If the conversation is not resumed until the following day, the smart time stamp automatically changes the first time information to second time information (e.g., 2:44 pm yesterday) to reflect the change in day. *Id.*

C. *Illustrative Claim*

Claims 1, 9, and 17 are independent. Claim 1 is reproduced below.

> 1. A method of displaying an instant messaging conversation on a display of an electronic device, the method comprising:
>
> displaying a conversation of instant messages;
>
> displaying a first time information for an instant message in the conversation in response to a first input; and
>
> automatically changing the first time information for the instant message to a second time information as time progresses and displaying the second time information instead of the first time information.

Ex. 1001, 8:48–57.

D. *Evidence of Record*

Petitioner submits the following references and declaration (Pet. 2–3):

Reference or Declaration	**Exhibit No.**
Declaration of Dr. Dan R. Olsen, Jr. ("Olsen Declaration")	Ex. 1002
Milton et al., U.S. Patent No. 5,631,949 (filed May 22, 1995, issued May 20, 1997) ("Milton")	Ex. 1006
Toshio, Japanese Patent Application Publication No. H03-89639 (filed Aug. 31, 1989, published Apr. 15, 1991) ("Toshio")	Ex. 1007
MacPhail, U.S. Patent No. 6,661,434 B1 (filed Apr. 13, 2000, issued Dec. 9, 2003) ("MacPhail")	Ex. 1009
Appelman et al., PCT Publication No. WO 01/24036 A2 (filed Sept. 21, 2000, published Apr. 5, 2001) ("Appelman")	Ex. 1012

E. *Asserted Grounds of Unpatentability*

Petitioner asserts that the challenged claims are unpatentable on the following grounds (Pet. 2–3):

Claims	**Basis**	**References**
1–5, 9–13, and 17	35 U.S.C. § 103(a)	Appelman and Toshio
1, 5–7, 9, 13–15, and 17	35 U.S.C. § 103(a)	Appelman and Milton
8 and 16	35 U.S.C. § 103(a)	Appelman, Toshio, and MacPhail
8 and 16	35 U.S.C. § 103(a)	Appelman, Milton, and MacPhail

II. ANALYSIS

A. *Claim Construction*

The claims of an unexpired patent are interpreted using the broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–45 (2016).

1. *First Input*

Petitioner argues that the term "first input" should be construed to mean "any event detected by the electronic device." Pet. 13. Patent Owner argues that the term "first input" does not require express construction at this stage of the proceeding. Prelim. Resp. 10. On this record and for purposes of this decision, we determine that the term "first input" does not require express construction at this stage of the proceeding to resolve the parties' disputes regarding the asserted grounds of unpatentability. *See infra* Section II.B; *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) ("[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.").

2. *Automatically*

Patent Owner argues that the term "automatically" should be construed to mean "not manually initiated." Prelim. Resp. 12. Patent Owner also argues that both the "changing" limitation and the subsequent "displaying" limitation of the challenged claims are performed automatically. *Id.* at 16. Patent Owner argues that its proposed construction is supported by the claim language, specification, prosecution history, and extrinsic evidence. *Id.* at 12–17. Petitioner does not propose an express construction for the term "automatically" at this stage of the proceeding. *See* Pet. 12–14.

The specification supports Patent Owner's position that the term "automatically" means "not manually initiated," and that the term "automatically" modifies both the "changing" limitation and the subsequent "displaying" limitation of the challenged claims. Specifically, the '149 patent states that, if a time stamp for a message is desired, "the user may

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