

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GOOGLE LLC,  
Petitioner

v.

BLACKBERRY LTD.,  
Patent Owner.

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Case IPR2017-01619  
Patent 8,489,868 B2

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Before SALLY C. MEDLEY, ROBERT J. WEINSCHENK,  
and AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

### A. Background

Google LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) for *inter partes* review of claims 1, 13, 76–95, 98, 100, 104, 108, 112, 113, 137–139, and 142–144 of U.S. Patent No. 8,489,868 B2 (Ex. 1001, “the ’868 patent”). The Petition asserted that these claims are unpatentable on the following grounds (*see* Pet. 2–3):

References	Basis	Challenged Claim(s)
Garst <sup>1</sup> and Gong <sup>2</sup>	§ 103(a) <sup>3</sup>	1, 13, 76, 78, 81, 84, 85, 87, 88, 90–93, 95, 98, 100, 104, 108, 112, 113, 137–39, and 142–44
Garst, Gong, and Davis <sup>4</sup>	§ 103(a)	77, 79, 80, and 82
Garst, Gong, and Chang <sup>5</sup>	§ 103(a)	83
Garst, Gong, and Sibert <sup>6</sup>	§ 103(a)	86
Garst, Gong, and Wong-Insley <sup>7</sup>	§ 103(a)	89
Garst, Gong, and Haddock <sup>8</sup>	§ 103(a)	94

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<sup>1</sup> U.S. Patent No. 6,188,995 B1, Feb. 13, 2001 (Ex. 1012).

<sup>2</sup> Li Gong, *Inside Java™ 2 Platform Security* (1999) (Ex. 1016).

<sup>3</sup> Because the effective filing date of the ’868 patent is earlier than March 16, 2013, the pre-AIA version of § 103 controls.

<sup>4</sup> U.S. Patent No. 5,844,986, Dec. 1, 1998 (Ex. 1013).

<sup>5</sup> U.S. Patent No. 5,724,425, Mar. 3, 1998 (Ex. 1014).

<sup>6</sup> U.S. Patent No. 7,243,236 B1, July 10, 2007 (Ex. 1015).

<sup>7</sup> U.S. Patent No. 6,131,166, Oct. 10, 2000 (Ex. 1017).

<sup>8</sup> U.S. Patent No. 5,657,378, Aug. 12, 1997 (Ex. 1018).

We instituted an *inter partes* review on all grounds raised in the Petition. *See* Paper 9 (“Inst. Dec.”) at 21.

The briefing in this proceeding now includes the Petition, a Patent Owner Response (Paper 16, “PO Resp.”), a Petitioner Reply (Paper 19, “Reply”), and a Patent Owner Sur-Reply (Paper 26, “Sur-Reply”). On September 17, 2018, we held an oral hearing, together with IPR2017-01620, a transcript of which is included in the record as Paper 30 (“Tr.”). Petitioner relies on a declaration by Dr. Patrick D. McDaniel (Ex. 1002, “McDaniel Decl.”); Patent Owner relies on a declaration of Dr. George T. Ligler (Ex. 2002, “Ligler Decl.”). Both experts were deposed, and the deposition transcripts were made of record. *See* Ex. 2004 (“McDaniel Tr.”); Ex. 1046 (“Ligler Tr.”). Patent Owner filed evidentiary objections (Papers 11 and 21), but no motion to exclude.

We have jurisdiction under 35 U.S.C. § 6. Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail, Petitioner must prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d).

This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. On this record, we determine, for the reasons detailed below, that Petitioner has shown by a preponderance of the evidence that claims 1, 13, 76, 78, 81, 83–85, 87–95, 98, 100, 104, 108, 113, 137–39, and 142–44 of the ’868 patent are unpatentable, but has not shown that claims 77, 79, 80, 82, 86, and 112 are unpatentable.

B. Related Proceedings

The '868 patent was at issue in *BlackBerry Ltd. v. BLU Products, Inc.*, No. 1-16-cv-23535 (S.D. Fla.). Pet. 1. According to PACER, the case was dismissed on August 15, 2017.

Petitioner concurrently filed another petition, IPR2017-01620, for *inter partes* review of the '868 patent based on different prior art. Pet. 1. The 1620 petition does not challenge claims 87, 108, 138, 143, and 144.

Patent Owner is presently prosecuting a continuation of the '868 patent, U.S. Serial No. 13/413,173.

C. The '868 Patent

The '868 patent describes “a code signing system and method” said to be “particularly well suited for Java™ applications for mobile communication devices, such as Personal Digital Assistants, cellular telephones, and wireless two-way communication devices.” Ex. 1001, 1:20–24.

The patent explains that “[i]n a typical software code signing scheme, a digital signature is attached to a software application that identifies the software developer” and “[o]nce the software is downloaded by a user, the user typically must use his or her judgment to determine whether or not the software application is reliable, based solely on his or her knowledge of the software developer’s reputation.” *Id.* at 1:30–36. The patent identifies two drawbacks to this prior art scheme. First, it “does not ensure that a software application written by a third party for a mobile device will properly interact with the device’s native applications and other resources.” *Id.* at 1:37–43. Second, “[b]ecause typical code signing protocols are not secure and rely solely on the judgment of the user, there is a serious risk that destructive . . .

software applications may be downloaded and installed onto a mobile device.” *Id.*

The solution described in the '868 patent is “[a] code signing system [that] operates in conjunction with a software application having a digital signature.” *Id.* at 1:54–56. An application programming interface (“API”) is “configured to link the software application with [an] application platform” and “[a] virtual machine verifies the authenticity of the digital signature in order to control access to the API by the software application.” *Id.* at 1:58–61.

The main embodiment of the '868 patent is described with reference to Figure 1:

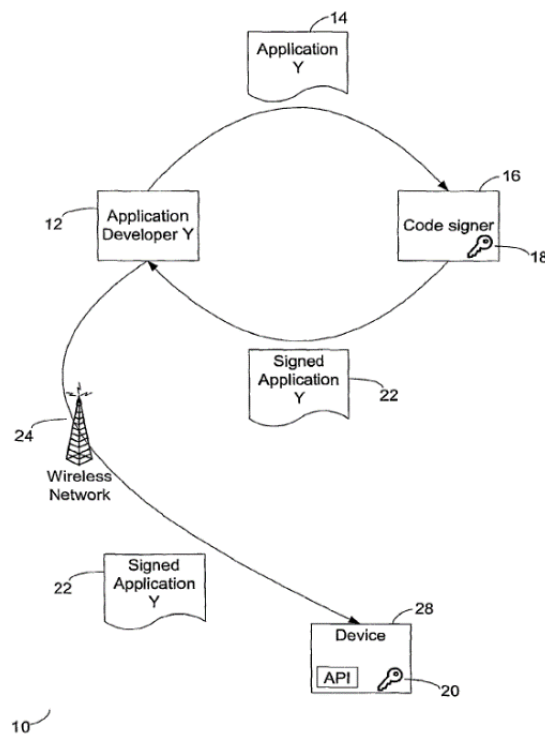


Figure 1

*Figure 1 represents “a code signing protocol according to one embodiment of the invention.” Ex. 1001, 2:54–55.*

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