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UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

BLACKBERRY LIMITED,

Plaintiff,

v.

FACEBOOK, INC., WHATSAPP INC.,  
and INSTAGRAM LLC,

Defendants.

SNAP INC.,

Defendant.

Case Nos. 2:18-cv-01844;  
2:18-cv-02693 GW(KSx)

**FACEBOOK DEFENDANTS’  
OPPOSITION TO BLACKBERRY’S  
MOTION FOR PARTIAL SUMMARY  
JUDGMENT OF INFRINGEMENT  
(U.S. PATENT NOS. 8,677,250,  
8,279,173, AND 9,349,120)**

Hearing Date: September 5, 2019  
Time: 8:30 A.M.  
Ctrm: 9D

Assigned to the Hon. George H. Wu

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**Cases**

*DeMartini Sports, Inc. v. Worth, Inc.*,  
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*L & W, Inc. v. Shertech, Inc.*,  
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*Medtronic, Inc. v. Mirowski Family Ventures, LLC*,  
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*Nazomi Commc'ns, Inc. v. Arm Holdings, PLC*,  
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*Soremekun v. Thrifty Payless, Inc.*,  
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*TypeRight Keyboard Corp. v. Microsoft Corp.*,  
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*Uniloc USA, Inc. v. Microsoft Corp.*,  
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**Other Authorities**

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1 **I. INTRODUCTION**

2 In its rush to have something heard at the same time as the pending motions for  
3 summary judgment under 35 U.S.C. § 101, BlackBerry filed an error laden and  
4 deficient motion for partial summary judgment seeking to establish that several  
5 accused products infringe claims across multiple patents. Tellingly, the “Statement  
6 of Uncontroverted Facts” accompanying the motion relies almost entirely on bald  
7 statements that BlackBerry’s experts analyzed the systems and provided opinions.<sup>1</sup>  
8 When those opinions are closely analyzed, they demonstrate BlackBerry’s inability to  
9 show that any accused product infringes any asserted claim.

10 The ’250 patent requires enabling a “game application” to utilize a “contact list”  
11 for an instant messaging application, but BlackBerry and its expert point only to a  
12 “Chats list” that does not contain a list of the user’s contacts and cannot be accessed  
13 by any supposed game application. The deposition of BlackBerry’s expert also  
14 uncovered a profound lack of knowledge, as he repeatedly changed positions multiple  
15 times in an attempt to salvage BlackBerry’s theory, raising credibility issues that  
16 provide a separate basis for rejecting BlackBerry’s motion. With respect to the  
17 ’173 patent, which requires the display of a “tag type indicator” for every tag in a tag  
18 list, BlackBerry’s expert admitted that he was relying on a blank area of the screen –  
19 on which **nothing** is displayed – as the supposedly displayed indicator. For the  
20 ’120 patent, which requires the ability to silence all new message notifications within  
21 a thread, BlackBerry’s expert acknowledged that the accused products continue to  
22 show visual cues that inform the user of the receipt of new messages, even for silenced  
23 threads. These and the other flaws with BlackBerry’s analysis, as discussed below,  
24 actually show non-infringement of the asserted patents. But at a minimum, they raise  
25 genuine issues of material fact that preclude summary judgment.

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<sup>1</sup> E.g., SUF Nos. 29-36.  
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1 **II. LEGAL STANDARD**

2 BlackBerry’s motion only attempts to establish *literal* infringement,  
3 not infringement under the doctrine of equivalents.<sup>2</sup> The standard for proving literal  
4 infringement is well-settled, and exacting. Literal infringement exists only “when  
5 every limitation recited in the claim appears in the accused device, i.e. when ‘the  
6 properly construed claim reads on the accused device exactly.’” *DeMartini Sports,*  
7 *Inc. v. Worth, Inc.*, 239 F.3d 1314, 1331 (Fed. Cir. 2001) (citation omitted).  
8 The absence of even a single limitation precludes a finding of literal infringement.  
9 *See, e.g. Kahn v. Gen. Motors Corp.*, 135 F.3d 1472, 1477-78 (Fed. Cir. 1998).  
10 Whether an accused product infringes a claim presents a question of fact. *See Uniloc*  
11 *USA, Inc. v. Microsoft Corp.*, 632 F.3d 1292, 1301-02 (Fed. Cir. 2011).

12 BlackBerry bears the burden of proving infringement. *See, e.g., Medtronic, Inc.*  
13 *v. Mirowski Family Ventures, LLC*, 571 U.S. 191, 198-199 (2014). In the context of  
14 summary judgment, “[w]here the moving party will have the burden of proof on an  
15 issue at trial,” as here, “the movant must affirmatively demonstrate that no reasonable  
16 trier of fact could find other than for the moving party.” *Soremekun v. Thrifty Payless,*  
17 *Inc.*, 509 F.3d 978, 984 (9th Cir. 2007); *see also, e.g., L & W, Inc. v. Shertech, Inc.*,  
18 471 F.3d 1311, 1318 (Fed. Cir. 2006). As established below, BlackBerry has not  
19 carried its burden with respect to any of the asserted claims or any of the accused  
20 products addressed in its motion.

21 **III. ARGUMENT**

22 **A. BlackBerry Has Not Shown Infringement of the ’250 Patent**

23 It is somewhat puzzling that BlackBerry’s motion chose to lead with the  
24 ’250 patent considering the profound deficiencies in BlackBerry’s theory.  
25 The problems with BlackBerry’s infringement theory run the gamut of summary

26 \_\_\_\_\_  
27 <sup>2</sup> BlackBerry’s two technical experts (on which BlackBerry’s motion entirely relies)  
28 only evaluated literal infringement for purposes of the present motion. (Schonfeld  
Dep., 22:21-23:4, Keefe Ex. 1; Rosenberg Dep., 132:2-9, Keefe Ex. 2.)

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1 judgment defects, from BlackBerry and its expert misunderstanding how the accused  
2 products operate, to serious credibility issues with BlackBerry’s expert that cannot be  
3 resolved on summary judgment. At a minimum, genuine issues of material fact  
4 remain as to whether Facebook infringes any claim of the ’250 patent.

5 The problem with BlackBerry’s infringement arguments begin at limitation  
6 [9.a], which recites “*enabling a game application on the electronic device to utilize a*  
7 *contact list for an instant messaging application for playing games with contacts in*  
8 *the contact list by identifying game play in the contact list.*” BlackBerry’s arguments  
9 about this limitation provide a clear example of either misunderstanding or  
10 misrepresenting how the accused products work. In order to fully understand why  
11 BlackBerry’s motion must fail, it is helpful to unpack and explain its theory.

12 Under BlackBerry’s theory, the “**game application**” corresponds to an Instant  
13 Game that can be invoked from Facebook Messenger or the Facebook website.  
14 (Schonfeld Dep., 29:4-13, 29:23-30:9; Mot. at 6-7.) The only specific game that  
15 BlackBerry and its expert identify or discuss is “Words with Friends,” created by non-  
16 party Zynga, Inc. (Schonfeld Dep., 29:23-30:9; Chen Decl., ¶5.)<sup>3</sup> Blackberry then  
17 alleges that the claimed “**contact list for an instant messaging application,**”  
18 corresponds to the “Chats” list shown on the Facebook website and through the  
19 Messenger app. (Schonfeld Dep., 33:21-34:1 (citing Schonfeld Decl., pp. 16 & 27);  
20 *see also* Mot. at 7:4-6.) With those understandings in mind, we now turn to the  
21 specific requirements in limitation [9.a].

22 As noted, limitation [9.a] requires that the alleged “*game application*” (like  
23 Words with Friends) be enabled “*to utilize a contact list for an instant messaging*  
24 *application.*” BlackBerry simply assumes without explanation that the Chats list  
25 qualifies as a “**contact list**” for purposes of claim 9. But a reasonable jury could

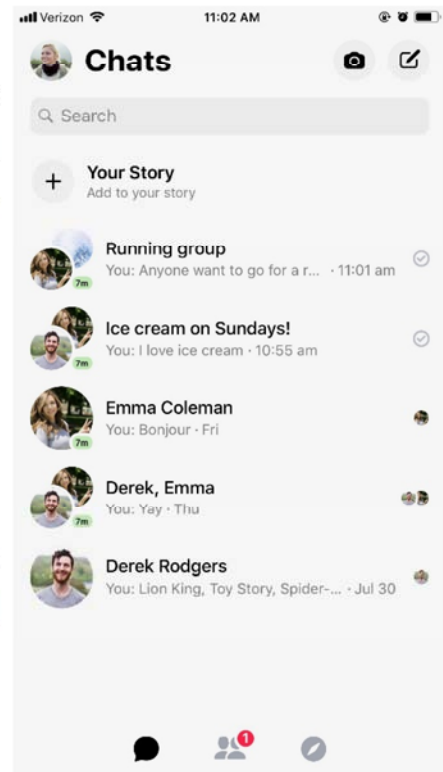
26 \_\_\_\_\_  
27 <sup>3</sup> For each witness from whom Facebook submits a declaration herewith, BlackBerry  
28 has already received document discovery and taken their depositions under Fed. R.  
Civ. Pro. 30(b)(1) and 30(b)(6).

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1 conclude that the Chats list is not a contact list. As explained in the accompanying  
2 declaration of Facebook engineer Kun Chen, who was deposed by BlackBerry prior  
3 to the filing of its motion, [REDACTED]

4 [REDACTED]  
5 [REDACTED] (Chen Decl., ¶¶4, 9.)

6 This difference is illustrated by the exemplary Chats list shown at the right,  
7 which shows five exemplary chats. (*Id.*, ¶9.)  
8 The first two chats correspond to group chats that  
9 have user-selected titles (*e.g.*, “Running group” and  
10 “Ice cream on Sundays!”), and do not identify any  
11 participating users or “contacts.” The remaining  
12 three chats include two one-on-one conversations  
13 (one between the user and Emma Coleman and the  
14 other between the user and Derek Rodgers), and one  
15 group conversation (including both Emma and  
16 Derek). Although the Chats list can include the  
17 names of individuals, as shown, the list is oriented  
18 around conversations, not individual contacts. (*Id.*)  
19 Thus, the names of other users may be missing from,  
20 or included multiple times in, the Chats list (as  
21 shown), and contacts who are not in those chats will not be listed at all. (*Id.*)



22 BlackBerry’s infringement theory apparently assumes that any list that may  
23 show names of individuals qualifies as a “contact list,” regardless of how the list is  
24 organized or presented, and regardless of its purpose. BlackBerry never asked for a  
25 construction of “contact list,” the Court did not construe it, and the term is not defined  
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1 in the '250 patent.<sup>4</sup> The term “contact list” therefore takes on its ordinary and  
2 everyday meaning, and at a minimum, a question of fact exists as to whether the  
3 “Chats” list qualifies under that ordinary meaning. *See Uniloc*, 632 F.3d at 1301-02  
4 (application of the claim to the accused device was a question of fact). A reasonable  
5 jury could conclude that a list of “Chats” is not the same as a list of contacts, and  
6 therefore does not qualify as a contact list.

7 This is not the only flaw with BlackBerry’s infringement theory – diving down  
8 to a more technical level reveals profound deficiencies. As noted, limitation [9.a]  
9 expressly requires that the alleged “game application” be enabled “to utilize a contact  
10 list for an instant messaging application.” But as shown below, an Instant Game such  
11 as Words with Friends (the alleged “game application”) [REDACTED]

12 [REDACTED] (Chen Decl., ¶10.)

13 [REDACTED]  
14 [REDACTED]  
15 [REDACTED]  
16 [REDACTED]  
17 [REDACTED] But BlackBerry  
18 and its expert were mistaken. [REDACTED]  
19 [REDACTED]

21 \_\_\_\_\_  
22 <sup>4</sup> The specification does not provide meaningful guidance on this issue. Figure 3  
23 shows an exemplary “Mike’s Contact List” that includes a section for conversations  
24 (304), but unlike the accused Chats list, the contact list in the specification also  
25 contains a specific section (308) that provides an actual listing of contacts.  
26 (’250, Figs. 3-4.)

27 <sup>5</sup> The term “API” stands for Application Programming Interface (API), which is an  
28 interface that allows software programs to gain access to certain functionality. (Chen  
Decl., ¶6; Schonfeld Dep., 38:6-24.) Here, Facebook provides an API for its Instant  
Games platform that provides a series of functions that allow game developers to adapt  
their games to interact with the features of Facebook Messenger. (Chen Decl., ¶6.)



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1 [REDACTED]  
2 [REDACTED]  
3 [REDACTED]  
4 [REDACTED]  
5 In other words, [REDACTED]  
6 [REDACTED]  
7 [REDACTED]

8 It was clear from the deposition of BlackBerry’s expert that, when he wrote his  
9 declaration, he did not understand the limitations of [REDACTED]  
10 [REDACTED] He had never tested it, and could not confirm [REDACTED]  
11 [REDACTED] – on which he expressly  
12 relied – was accurate. (Schonfeld Dep., at 35:25-36:6, 46:7-47:7.) When asked  
13 whether [REDACTED]  
14 [REDACTED]  
15 [REDACTED]  
16 [REDACTED]

17 [REDACTED] A reasonable jury could decide, based on the lack of knowledge and  
18 equivocations of BlackBerry’s expert, to not credit him or BlackBerry’s theory of  
19 infringement that he attempted to support. *See TypeRight Keyboard Corp. v.*  
20 *Microsoft Corp.*, 374 F.3d 1151, 1158-59 (Fed. Cir. 2004) (“[S]ummary judgment is  
21 not appropriate where the opposing party offers specific facts that call into question  
22 the credibility of the movant’s witnesses.”).

23 The problems do not end there. Limitation [9.a] also recites “*enabling a game*  
24 *application on the electronic device to utilize a contact list for an instant messaging*  
25 *application ... by identifying game play in the contact list.*” BlackBerry’s analysis  
26 of the latter portion of limitation [9.a] (“by identifying game play in the contact list”)  
27 does not mention [REDACTED]. BlackBerry appears to treat  
28 “utiliz[ing] a contact list for an instant messaging application,” and “identifying game

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1 play in the contact list,” as two separate and independent requirements that can be  
2 shown by disparate and unrelated functionalities. (Schonfeld Decl., ¶¶40-41, 53-54.)  
3 But the claim links the two by reciting the ability to “utilize a contact list ...  
4 *by* identifying game play in the contact list.” BlackBerry has articulated no theory  
5 that accounts for these interrelated requirements.

6 BlackBerry’s expert had no idea whether [REDACTED]  
7 [REDACTED]  
8 [REDACTED] – had any role in the display of the Chats list (the alleged “contact list”),  
9 let alone identifying game play in the alleged contact list. (Schonfeld Dep., 50:21-  
10 51:3.) [REDACTED]

11 [REDACTED] An Instant Game, such as Words with  
12 Friends, [REDACTED] BlackBerry  
13 thus cannot show that Facebook “enabl[es] a game application ... to utilize a contact  
14 list ... *by identifying game play in the contact list.*”

15 There are even more problems. BlackBerry’s expert admitted that the  
16 [REDACTED] would be invoked, if at all, by the Instant  
17 Game (the alleged “game application”). (Schonfeld Dep., 37:7-13, 48:18-49:4.) But  
18 BlackBerry’s expert admitted that he had no idea “if the Words with Friends game  
19 ever [REDACTED].” (*Id.*, 37:16-20.) Nor could he  
20 answer this question with respect to any other game available through Facebook  
21 Instant Games. (*Id.*, 37:21-38:4.)<sup>6</sup> BlackBerry’s expert further admitted that he had  
22 never looked at the source code for Words with Friends (or any other Instant Game).  
23 (*Id.*, at 31:5-32:1.) He, in fact, claimed he did not need it. (*Id.*, at 32:6-33:4.) In any  
24 case, BlackBerry has zero evidence of any game application that used

25 \_\_\_\_\_  
26 <sup>6</sup> An Instant Game does not need to use [REDACTED] in order to  
27 function. (Schonfeld Dep., 39:10-22; Chen Decl., ¶8.) The mere existence of an  
28 operational Instant Game, therefore, does not provide evidence that the game ever uses  
[REDACTED].

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1 [REDACTED] performed the function of  
2 “utiliz[ing] a contact list” by “identifying game play in the contact list,” as the claim  
3 requires. This failure of proof provides a further basis to deny BlackBerry’s motion  
4 for summary judgment.

5 BlackBerry’s theory of infringement also fails with respect to limitation [9.b]  
6 because BlackBerry has not articulated what its theory (if any) actually is – and its  
7 expert’s attempts to do so at his deposition called his credibility into question.  
8 Limitation [9.b] recites, in relevant part, the step of “preparing game messages *to be*  
9 *sent to the particular* contact by including game progress data in an instant messaging  
10 message and *an identifier to associate the data with the game application.*” A clear  
11 requirement of this claim language is that the “identifier” must be included in a “game  
12 message” *that is sent to the particular contact* (e.g., the other game player).  
13 BlackBerry’s expert agreed. (Schonfeld Dep., 60:2-17.)

14 The only example of the claimed “identifier” in BlackBerry’s motion is  
15 “a banner including the name of the game being played.” (Mot. at 7-8.)  
16 But BlackBerry’s expert admitted that he did not know whether that information is  
17 actually sent *to the particular contact*, as the claim expressly requires. (Schonfeld  
18 Dep., 70:24-71:5 [REDACTED]  
19 [REDACTED]  
20 [REDACTED]  
21 [REDACTED].)

22 The deposition of BlackBerry’s expert played out like a game of cat-and-mouse,  
23 in which BlackBerry’s expert repeatedly demurred as to what, if anything, was the  
24 “identifier to associate the data with the game application” in the accused product –  
25 repeatedly testifying that such an identifier existed but never identifying what it was.  
26 (Schonfeld Dep., 57:2-58:21, 61:20-63:18, 70:17-72:15.) The section of his  
27 declaration addressing limitation [9.b] identified two different IDs used with Instant  
28 Games – [REDACTED] – but the declaration does not state whether



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1 In the end, the repeated equivocations, flat out lack of knowledge, and changed  
2 opinions of BlackBerry's expert call into question his preparation, knowledge, and  
3 ultimately his credibility as a witness. *See TypeRight Keyboard Corp.*, 374 F.3d at  
4 1158-59 (“[S]ummary judgment is not appropriate where the opposing party offers  
5 specific facts that call into question the credibility of the movants witnesses.”).  
6 A reasonable jury could conclude that the testimony of BlackBerry's expert – the sole  
7 evidence offered in support of the present motion – should not be credited.

**B. BlackBerry Has Not Shown Infringement of the '173 Patent**

8 BlackBerry has also failed to show infringement of the '173 patent by the  
9 accused Facebook website and Instagram application. Again, BlackBerry has failed  
10 to carry its burden with respect to multiple limitations of the asserted claims.  
11

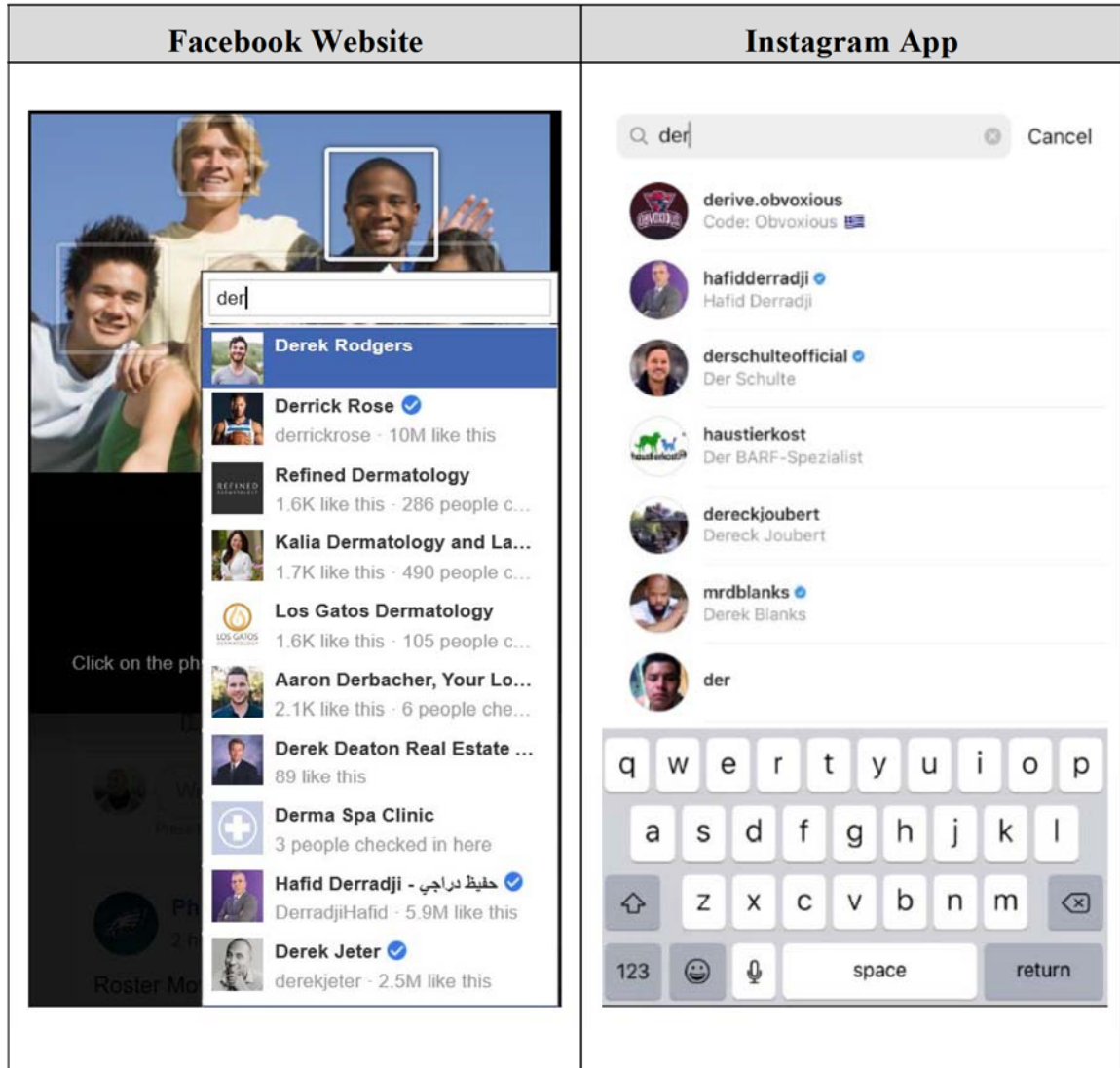
12 Claim 13, from which the sole asserted claim depends, recites a “computer  
13 readable medium” (transitory or non-transitory) that, when loaded into a device,  
14 performs the following functions: “displaying a tag list including tags from one or  
15 more tag sources matching a search string” [13.a], and “displaying a tag type indicator  
16 for each tag appearing in the tag list, said tag type being indicative of a tag source  
17 associated with the tag” [13.b]. As with the '250 patent discussed above, to fully  
18 understand the flaws with BlackBerry's infringement theory, Facebook will unpack  
19 and analyze that theory in more detail than was provided in BlackBerry's motion.

20 A key limitation is the display of a “*tag type indicator for each tag appearing*  
21 *in the list*,” as recited in claim [13.b]. The Facebook website and Instagram provide  
22 photo tagging features that present the user with a list of tag suggestions, allowing the  
23 user to specify a particular tag for a photo. (Wang Decl., ¶9; Douglas Decl., ¶3.)  
24 The two screen captures below show examples of how the Facebook website and  
25 Instagram can present tag suggestions to the user:

26 \_\_\_\_\_  
27 and evidence not included with BlackBerry's motion. BlackBerry never amended its  
28 motion or expert declaration to discuss the [REDACTED], or to withdraw BlackBerry's  
prior reliance on the other (discredited) identifiers discussed earlier at the deposition.

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(Douglas Decl., ¶3; Wang Decl., ¶9.) BlackBerry contends that the tag suggestion lists shown above correspond to the claimed “tag list” of claim 13.


As noted, a key limitation recites the display of “a tag type indicator for each tag appearing in the tag list” [13.b], which on its face requires a tag type indicator for every tag in the list. But the tag suggestion lists shown above (and every example provided by BlackBerry’s expert) show tag suggestions unaccompanied by any kind of visual indicator. For example, the screen capture on the left above shows “Derek

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1 Rogers” with nothing more than his name and a small profile icon (neither of which  
2 BlackBerry contends is a “tag type indicator”). The screen capture on the right shows  
3 substantially the same for Dereck Joubert (among others). All of the example screen  
4 captures provided by BlackBerry show similar examples of tag suggestion lists  
5 containing items displayed without any kind of accompanying indicator. (Mot. at 14;  
6 Schonfeld Decl., ¶¶35, 36, 84, 88, 105, 129.)

7 How can BlackBerry claim that Facebook and Instagram display “*a tag type*  
8 *indicator for each tag appearing in the tag list*” [13.b], when the accused products  
9 indisputably display tag suggestions without any such indicator? Or stated more  
10 simply, how can the *absence* of an indicator qualify as an “indicator”?

11 BlackBerry responded to this question by inventing a new term – “blank  
12 indicator” – which it claims is displayed alongside certain tag suggestions. (Schonfeld  
13 Decl., ¶86 [REDACTED])

14 [REDACTED] (underlining  
15 added.) BlackBerry’s motion even goes as far as to show screen captures of  
16 Instagram and Facebook in which BlackBerry placed  red boxes over empty areas of the screen to show the  
17 locations of these supposed “blank indicators” (see example from BlackBerry’s  
18 motion shown at the right). (See Mot. at 14.)

19 There is no such thing as a “blank indicator.” (Wang Decl., ¶13; Douglas Decl.,  
20 ¶9.) What BlackBerry calls a “blank indicator” is actually the *absence* of any indicator  
21 at all. (*Id.*; Schonfeld Dep., 116:19-22 [REDACTED])

22 [REDACTED] (citing  
23 Schonfeld Decl., ¶50); *see also id.*, 115:5-10.) BlackBerry’s reliance on its newly  
24 concocted “blank indicator” does not even remotely meet its burden of showing that  
25 claim [13.b] is satisfied; to the contrary, it establishes non-infringement.

26 BlackBerry’s attempts to rationalize its “blank indicator” argument are easily  
27 rejected. BlackBerry argues that the absence of any displayed indicator for Facebook  
28

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1 friends and unverified Instagram profiles somehow qualifies as a “tag type indicator”  
2 because, according to BlackBerry, the lack of an indicator distinguishes those tag  
3 suggestions from other suggestions where some kind of indicator is in fact displayed.  
4 (Mot. at 18; Schonfeld Decl., ¶¶86, 87, 107.) But arguing that the *absence* of an  
5 indicator somehow qualifies as an “indicator” cannot be reconciled with the plain  
6 claim language which expressly recites “*displaying a tag type indicator for each tag.*”  
7 “Displaying” requires an affirmative act of displaying the claimed “indicator.” In the  
8 case of tag suggestions for Facebook friends and Instagram unverified profiles,  
9 no such indicator is displayed. (Wang Decl., ¶13; Douglas Decl., ¶9 n.2.) In other  
10 words, the step of “*displaying a tag type indicator*” does not occur for those tag  
11 suggestions.

12 BlackBerry has not established, for purposes of summary judgment or  
13 otherwise, that Facebook and Instagram display “a tag type indicator for each tag  
14 appearing in the list.” BlackBerry never asked for a construction of “tag type  
15 indicator” (and the Court did not construe it), so the term must be given its ordinary  
16 meaning. At a minimum, a question of fact exists as to whether each of the supposed  
17 indicators relied upon by BlackBerry qualifies as a “tag type indicator” under its  
18 ordinary meaning. *See Uniloc*, 632 F.3d at 1301-02.

19 That same limitation of claim 13 provides further problems with BlackBerry’s  
20 infringement theory. It recites “displaying a tag type indicator for each tag appearing  
21 in the tag list, *said tag type being indicative of a tag source associated with the tag*”  
22 [13.b], and BlackBerry’s analysis of the claimed “tag sources” fails. The supposed  
23 “tag type indicators” identified by BlackBerry, at best, correspond to *categories* of tag  
24 suggestions – not their *sources*. (Douglas Decl., ¶¶4-8; Wang Decl., ¶¶10-11.)  
25 For Facebook, all tag suggestions – regardless of their category – come primarily from

26 [REDACTED]  
27 [REDACTED]  
28 [REDACTED]



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1 [REDACTED] Facebook, though, can also obtain tag suggestions  
2 from a [REDACTED] But Facebook  
3 does not display anything with a tag suggestion to indicate whether the suggestion  
4 [REDACTED]  
5 BlackBerry therefore cannot show the display of a tag type indicator “**indicative of a**  
6 **tag source**,” as claimed. What BlackBerry calls the “tag type indicators,” as  
7 mentioned, have no relationship to the source of the tags.

8 Instagram operates in a similar fashion. All tag suggestions – for verified and  
9 unverified profiles – [REDACTED]

10 [REDACTED]  
11 [REDACTED] BlackBerry’s expert did not know whether tag suggestions from “verified” and  
12 “unverified” tags came from [REDACTED]

13 [REDACTED]  
14 [REDACTED] But like Facebook, Instagram [REDACTED]  
15 [REDACTED]  
16 [REDACTED]

17 Finally, BlackBerry concedes that the claimed tag type indicator must “clearly  
18 indicate [the tag’s] type, and allow[] the user to quickly distinguish between different  
19 types of tags.” (Mot. at 18 (alterations in original) (quoting ’173, 5:54-55).) Even  
20 putting aside the so-called “blank indicator,” the other indicators identified by  
21 BlackBerry do not provide this capability. (Douglas Decl., ¶¶9-10; Wang Decl., ¶¶12-  
22 13.) With both Facebook and Instagram, BlackBerry points to additional information  
23 displayed with a tag suggestion (such as the number of “Likes” or a checkmark to  
24 indicate whether a profile belongs to a celebrity or public figure). (Schonfeld Decl.,  
25 ¶¶79, 101.) But this additional information does not indicate a *type* of tag, but rather,  
26 provides contextual information about the popularity, prominence, or closeness of the  
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1 tag suggestion. (Douglas Decl., ¶¶9-10; Wang Decl., ¶13.)<sup>8</sup> For example, BlackBerry  
2 claims that the “tag type indicator” for a Facebook page is simply an identification of  
3 the number of users who liked it. (Schonfeld Decl., ¶79.) But the number of “likes”  
4 simply provides information about the popularity of a tag suggestion as compared to  
5 other suggestions in the list. (Douglas Decl., ¶10.)

6 At a minimum, a genuine issue of material fact exists as to whether each of the  
7 supposed “tag type indicators” identified by BlackBerry actually indicates a type of  
8 tag. For all of these reasons, therefore, summary judgment of infringement must be  
9 denied with respect to the ’173 patent.

10 **C. BlackBerry Has Not Shown Infringement of the ’120 Patent**

11 BlackBerry’s infringement claims under the ’120 patent focus on a feature that  
12 allows messaging users to “mute” or disable the presentation of certain types of new  
13 message notifications. Although BlackBerry accuses a broad array of products  
14 offered by Facebook, WhatsApp, and Instagram, its infringement allegations – and  
15 the reasons they fail – are substantially similar for each accused product.

16 **1. BlackBerry Has Not Shown that the Accused Muting Features**  
17 **Satisfy All Limitations of the Asserted Claims**

18 **a. The Accused Products Continue to Provide Notifications**  
19 **Even for “Muted” Conversations and Chats**

20 Claims 1 and 13 (the two independent claims in BlackBerry’s motion) both  
21 recite the ability to activate a “flag” indicating that a particular message thread has  
22 been “silenced.” When a new incoming electronic message is received, both claims

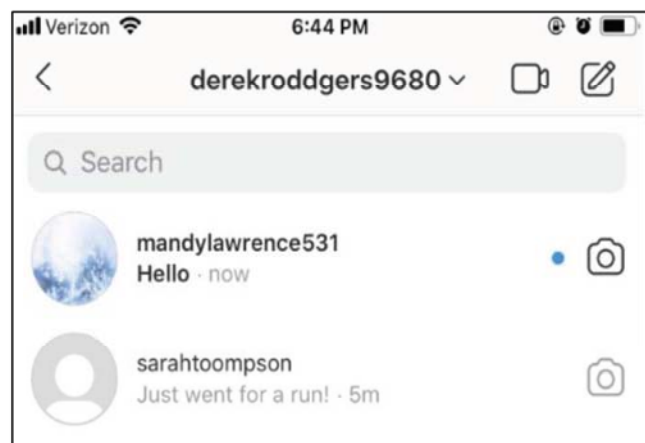
23 <sup>8</sup> The ’173 patent distinguishes the claimed tag type indicator from *context data* about  
24 a tag. Dependent claim 19 separately calls out display of context data. (’173, claim  
25 19 (“The computer readable medium of claim 13, further comprising code for  
26 displaying context data with the photo tag.”).) But under BlackBerry’s theory, the  
27 context data under dependent claim 19 would collapse into the “tag type indicator” of  
28 claim 13, which would render claim 19 meaningless. *Nazomi Commc’ns, Inc. v. Arm*  
*Holdings, PLC*, 403 F.3d 1364, 1370 (Fed. Cir. 2005) (“The concept of claim  
differentiation ‘normally means that limitations stated in dependent claims are not to  
be read into the independent claim from which they depend.’”) (citation omitted).

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1 recite the ability to “display[] the new incoming electronic message in an inbox  
2 together with any message thread not flagged as silenced, **while silencing any further**  
3 **notifications pertaining to receipt of the new incoming electronic message**” [1.g],  
4 [13.g]. The claim thus requires all notifications pertaining to the new incoming  
5 electronic message be silenced or prevented. BlackBerry has failed to show that any  
6 of the accused products satisfy this requirement.

7 It is true that, when a particular chat or conversation (which BlackBerry calls  
8 the claimed “thread”) is muted in the accused Facebook, WhatsApp, and Instagram  
9 messaging products, some notifications pertaining to new incoming messages in that  
10 chat or conversation are prevented. But the accused muting feature does not prevent  
11 “any further notifications pertaining to receipt of the new incoming electronic  
12 message,” because the accused products continue to provide other types of  
13 notifications upon receipt of new messages in muted chats or conversations.

14 For example, the screen  
15 capture shown at the right shows a  
16 list of conversations (the alleged  
17 “inbox”) in Instagram. (Wang  
18 Decl., ¶¶5-8.) The first listed  
19 conversation (mandylawrence531)  
20 shows the name and message text  
21 shown in **boldface** type, with a blue  
22 dot ● on the right of that entry in






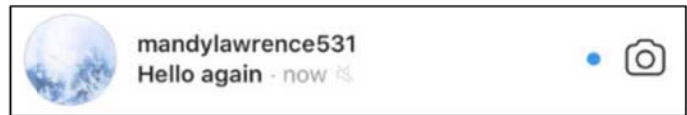
23 the list. These visual cues – the boldface type and the blue dot – notify the user a new  
24 incoming message has been received in the “mandylawrence531” conversation. (*Id.*)  
25 They do not appear next to the second conversation shown in the list (sarahtompson)  
26 because no new message was received in that conversation.



27 The accused Facebook and WhatsApp features function in a substantially  
28 similar way with respect to displaying chats or conversations in which a new incoming

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1 message has been received. Just like Instagram, the accused Facebook and WhatsApp  
2 products provide a substantially similar visual cue to the user (such as a blue or green  
3 dot, bolded or different colored text, moving to the top, etc.) to notify the user that a  
4 new incoming message has been received for a particular chat. (Nachman Decl., ¶¶4-  
5 5, 7-8 (WhatsApp); Biczó Decl., ¶¶4-6, 9-10 (Facebook).) With respect to all of the  
6 accused products, the purpose of these visual cues is to draw the attention of the user  
7 to the fact that a new message has been received in a particular chat or conversation.  
8 (Wang Decl., ¶¶6, 8; Nachman Decl., ¶8; Biczó Decl., ¶¶6, 10, 13, 16.)

9 Critically, it is undisputed that *the accused products continue to present these*  
10 *new message notifications even with respect to chats or conversations that have been*  
11 *“muted” by the user.* (Wang Decl., ¶¶7-8; Nachman Decl., ¶¶7-8; Biczó Decl., ¶¶8-  
12 11, 15-16.) When a new message is received in a muted conversation (*e.g.*, denoted  
13 by icons such as “” or “”), the accused products still show new message  
14 notifications. For example, as shown below, Instagram shows a blue dot and bolded  
15 text next to a new message in a  
16 thread that has been muted. (Wang  
17 Decl., ¶8.) The accused Facebook  
18 and WhatsApp features similarly show new message notifications. (*E.g.*, Nachman  
19 Decl., ¶¶7-8; Biczó Decl., ¶¶8-11, 15-16.) BlackBerry’s expert agreed that 



20   
21   
22 His declaration, in fact, identifies numerous screen captures showing, even after  
23 muting a particular conversation, the accused products continuing to display these  
24 visual notifications when new incoming messages are received. (*E.g.*, Rosenberg  
25 Decl., ¶¶151, 232, 259, 297, 328, *passim*.)

26 This is fatal to BlackBerry’s theory of infringement. As explained, both  
27 independent claims require, while displaying the new electronic message in an inbox,  
28 “silencing *any further notifications* pertaining to receipt of the new incoming

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1 electronic message” [1.g], [13.g]. It is undisputed that, while displaying the  
2 conversation or chat list (the accused “inbox”), the accused products continue to  
3 present new message notifications even for chats or conversations in the list that have  
4 been muted by the user. Accordingly, at a minimum, there are genuine issues of  
5 material fact as to whether the accused products satisfy at least claim limitations [1.g]  
6 and [13.g], requiring that BlackBerry’s motion be denied. The evidence presented  
7 above, in fact, affirmatively establishes non-infringement.<sup>9</sup>

8 BlackBerry argues that these visual cues do not avoid infringement because,  
9 according to BlackBerry, they do not qualify as “notifications” under the Court’s  
10 order. But the Court’s construction directly covers those visual cues.

11 During claim construction, BlackBerry argued that “notification” should be  
12 given its plain and ordinary meaning, or in the alternative, construed as “user alert.”  
13 (Dkt. No. 157 at 29.) The Court did not adopt BlackBerry’s proposal, and instead  
14 construed the term as “*some form of visual, auditory, or physical cue to draw attention*  
15 *to an incoming message that would not otherwise have been noticed, at the time of the*  
16 *incoming message.*” (Dkt. No. 157 at 31.) BlackBerry has no explanation as to why  
17 the visual changes discussed above do not fall within this definition.

18 The display of colored dots, the bolding or coloring of text, etc., clearly provide  
19 some form of visual cue, and as explained, their purpose is to draw the user’s attention  
20 to the new incoming message that might otherwise have gone unnoticed. (Wang  
21 Decl., ¶¶6, 8; Nachman Decl., ¶8; Biczko Decl., ¶¶6, 10, 13, 16.) BlackBerry’s expert  
22 admitted, in fact, that these visual cues are [REDACTED]

23 [REDACTED] It is also undisputed  
24

25 \_\_\_\_\_  
26 <sup>9</sup> BlackBerry’s claims against the iOS version of Instagram fail for a separate and  
27 independent reason. In that version, when a user is viewing the conversation list (the  
28 alleged “inbox”), Instagram provides a haptic vibration upon arrival of a new  
incoming message, even if the conversation to which the message belongs has been  
muted. (Wang Decl., ¶8.)

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1 that these visual cues are displayed in the chat or conversation list [REDACTED]  
2 [REDACTED] pursuant to the Court's construction. (Wang Decl., ¶6; Nachman  
3 Decl., ¶5; Biczko Decl., ¶6; Rosenberg Dep., 161:23-162:2 [REDACTED]  
4 [REDACTED]  
5 [REDACTED] Accordingly, the  
6 visual cues provided by the accused products discussed above satisfy each aspect of  
7 the Court's construction. Because the accused products continue to present  
8 "notifications" even for chats or conversations that have been muted, BlackBerry  
9 cannot show infringement of any claim of the '120 patent.

10 BlackBerry's argument that these visual cues do not qualify as "notifications"  
11 relies not on the Court's actual construction, but the discussion on page 31 of the claim  
12 construction order about whether certain hypothetical visual changes in a user  
13 interface would qualify as notifications. The specific examples cited by the Court  
14 included "a change to a numeric character on a phone application icon, without any  
15 other cue to draw attention to it," "a change in the listed number of unread messages  
16 in an email inbox, without any other cue to draw attention to it," and "a changing  
17 numeric icon or a changing number of unread messages in an email inbox." (Dkt. 157  
18 at 31 & 31, n.13.) The Court commented that a construction of "notification" that  
19 would include those types of visual changes could be too broad. (*Id.*)

20 But the visual cues provided by the accused Facebook, Instagram, and  
21 WhatsApp products do not resemble any of the hypotheticals described in the Court's  
22 order. A common thread running through each of the hypotheticals in the Court's  
23 order is the use of generic user interface elements that would not draw the user's  
24 attention *to the new message (or its associated thread)*. But in this case, the accused  
25 products present specific visual cues that show up directly in the conversation or chats  
26 list, and apply *specifically* to the conversation or chat in which the new incoming  
27 message was received. (Rosenberg Dep., 165:17-20 [REDACTED]  
28 [REDACTED]

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1 [REDACTED] These visual cues are not  
2 analogous to generic application icons or numeric values of unread messages which,  
3 unlike the accused products, do not draw the user’s attention in any kind of thread-  
4 specific or message-specific way. They are visual cues drawing attention to the  
5 incoming message as described in the Court’s construction.

6 **b. The Accused Facebook and WhatsApp Products Do Not**  
7 **Store a Flag Indicating That a Chat Is Muted**

8 A second non-infringement argument applicable to Facebook and WhatsApp  
9 also precludes summary judgment. Claim 1 recites the ability to “*activate a flag*  
10 *stored in the non-transitory media in association with the selected message thread,*  
11 *wherein the flag indicates that the selected message thread has been silenced.*”  
12 (’120, claim 1; *see id.*, claim 13 (“activating one or more flags ... wherein the one or  
13 more flags indicate that the associated one or more selected message threads have  
14 been silenced”).) The claims require use of the “flag” to determine whether a message  
15 thread associated with a new message is silenced. (*Id.*)

16 The accused Facebook and WhatsApp products do not store such a “flag.”  
17 When a user mutes a chat, [REDACTED]

18 [REDACTED]  
19 [REDACTED] For example, if a user muted a particular chat in WhatsApp for one week,  
20 the program would [REDACTED]

21 [REDACTED] The accused  
22 products can ascertain, at any given point in time, if a chat is muted by [REDACTED]  
23 [REDACTED]  
24 [REDACTED]  
25 [REDACTED]  
26 [REDACTED]

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[REDACTED]  
[REDACTED] “best before” date stamps one might find on food items at the grocery store. These stamps do not themselves indicate that the food item is still safe to eat or should be thrown away; it simply states a date whose significance depends entirely on when one looks at it.



BlackBerry’s expert stated that the plain and ordinary meaning of “flag” was [REDACTED]. One [REDACTED] would never argue that the “BEST BEFORE 12/15/2017” stamp on a can of food was a flag, because that date tells you nothing about the status or condition of the contents of the can. The same date could signal to a customer in 2016 that the food is fresh, or to a customer in 2020, that the food should probably be thrown away. [REDACTED]

[REDACTED]  
[REDACTED]

This is consistent with the asserted claims, which do not contemplate the use of a single purported “flag” to indicate both a silenced and non-silenced state for a thread. To the contrary, claim 13 recites the step of “*activating* one or more flags ... [that] indicate that the associated one or more message threads have been silenced,” and claim 19 further recites the ability to “allow the message thread to be unflagged by *deactivating* the flag.” At a minimum, a question of fact exists as to whether [REDACTED] [REDACTED] qualify as “flags” under the ordinary meaning of that term. *See Uniloc*, 632 F.3d at 1301-02.

**IV. CONCLUSION**

For the foregoing reasons, BlackBerry’s motion should be denied.



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Dated: August 8, 2019

RESPECTFULLY SUBMITTED,

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