

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 IPR2019-00706
Patent 9,349,120 B2

Before MICHAEL R. ZECHER, MIRIAM L. QUINN,
and AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION
Instituting *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Facebook, Inc., Instagram, LLC, and Whatsapp Inc. (collectively, “Petitioner”) filed a Petition requesting *inter partes* review of claims 1–3, 5, 7–11, 13–15, 17, 19–22, and 24 of U.S. Patent No. 9,349,120 B2 (Ex. 1001, “the ’120 patent”). Paper 2 (“Pet.”). BlackBerry Limited (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

Institution of an *inter partes* review is authorized when “the information presented in the petition . . . and any response . . . shows that 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).

Having considered the Petition, the Preliminary Response, and the evidence of record, we conclude there is a reasonable likelihood that Petitioner will prevail in establishing the unpatentability of claim 1 of the ’120 patent and, therefore, institute *inter partes* review.

A. *Related Matters*

The parties identify *BlackBerry Ltd. v. Facebook, Inc.*, No. 2:18-cv-01844-GW-KS (C.D. Cal.), as a related matter. *See* Pet. 2; Patent Owner Mandatory Notices (Paper 5) 2. The District Court entered a claim construction ruling in that case on April 11, 2019, a copy of which has been filed as Exhibit 1020. Petitioner also identifies *BlackBerry Ltd. v. Twitter, Inc.*, No. 2:19-cv-01444-GW-KS (CD Cal.), as a related matter. *See* Petitioner’s Updated Mandatory Notice (Paper 6) 2.

B. *The ’120 Patent*

The ’120 patent is directed to “[m]ethods, systems, and computer programming products . . . for silencing message threads.” Ex. 1001, [57].

The general scheme is illustrated in Figure 6 of the patent, which is reproduced in part below.

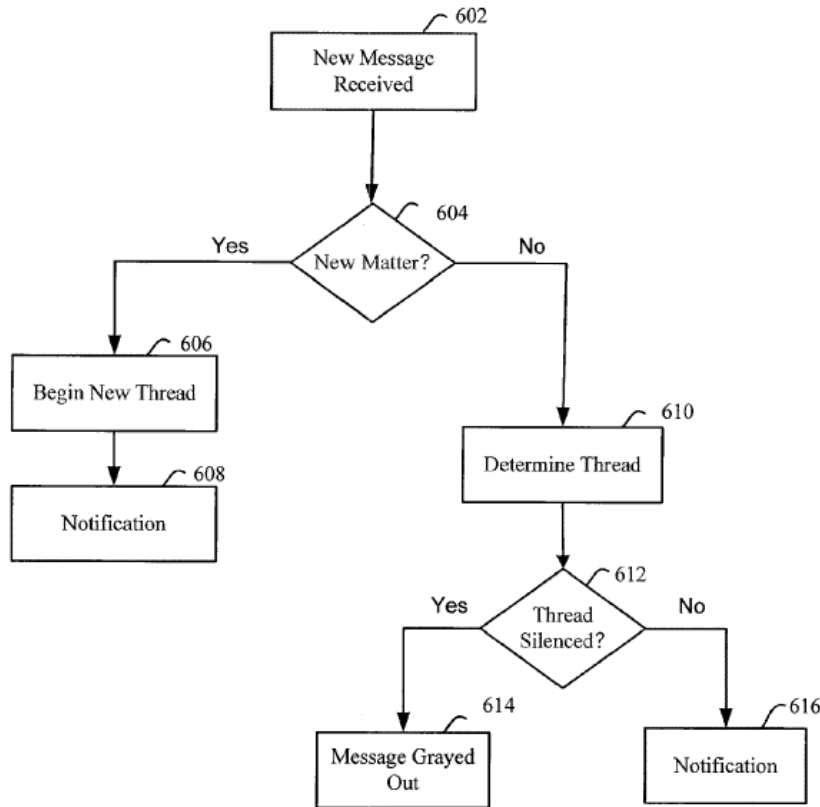


Figure 6 is a “schematic flow diagram of an example method for receiving a message.” Ex. 1001, 2:1–2.

The method “can begin at 602 where a message is received which is addressed or otherwise identified in such a way as to be associated with an inbox.” Ex. 1001, 14:5–7. “At 604, it may be determined whether or not the message relates to a new matter, such as a new topic of conversation or a new activity.” *Id.* at 14:19–21. “If the message does relate to a new matter, at 606, a new message thread is started” and, “[a]t 608, the user is notified of the message according to any currently-enabled notification settings.” *Id.* at 14:32–35.

“If the message does not relate to a new matter, at 610, a thread to which the message belongs may be determined” and, “[a]t 612, it [may be] determined whether or not the message thread to which the message belongs has been silenced by the user.” Ex. 1001, 14:36–37, 14:44–46. If the thread has been silenced, “no notification may be activated and at 614 the message may appear ‘greyed out’ or other diminished fashion when displayed with the inbox contents.” *Id.* at 14:49–52. If, on the other hand, the thread has not been silenced, “then at 616 the user may be notified of the incoming message according to any currently-enabled notification settings.” *Id.* at 14:52–55.

The ’120 patent explains that the “[n]otifications could include, for example, auditory user alerts such as ring tones, visual alerts such as flashing lights or pop-ups and physical alerts such as vibrations.” Ex. 1001, 1:30–32; *see also id.* at 9:6–8 (stating the same). The patent also explains that “[m]essage threads which have been silenced may be marked or flagged as silenced in memory 300 by, for example, setting a flag or other indicator in a data record associated with the message thread.” Ex. 1001, 9:35–38.

C. *The Challenged Claims*

Independent claim 1 is to a system for silencing notifications, independent claim 13 is to a corresponding method, and independent claim 24 is a corresponding *Beauregard* claim. Claim 1 is thus indicative of the subject matter addressed in this proceeding:

1. A communication system configured to silence notifications for incoming electronic messages, the system comprising a data processor, non-transitory media readable by the data processor and a communications subsystem:
the communication subsystem adapted for receiving the incoming

electronic messages; and

the non-transitory media readable by the data processor comprising coded program instructions adapted to cause the processor to:

receive a selected message thread for silencing;

in response to receiving the selected message thread, activate a flag stored in the non-transitory media in association with the selected message thread, wherein the flag indicates that the selected message thread has been silenced;

determine that a new incoming electronic message is associated with the selected message thread;

determine that the selected message thread has been flagged as silenced using the flag stored in the nontransitory media;

override a currently-enabled notification setting to prevent a receipt notification pertaining to new incoming electronic messages associated with the selected message thread from being activated; and

display the new incoming electronic message in an inbox together with any message thread not flagged as silenced, while silencing any further notifications pertaining to receipt of the new incoming electronic message, wherein the new incoming message thread flagged as silenced is displayed in the inbox in a different manner than any message thread not flagged as silenced.

Ex. 1001, 16:46–17:10.

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