

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.

IPR2019-00899
Patent 8,301,713 B2

Before MIRIAM L. QUINN, ROBERT L. KINDER,
and AARON W. MOORE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

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I. INTRODUCTION

A. Background

Facebook, Inc., Instagram, LLC, and Whatsapp Inc. (collectively, “Petitioner”) filed a Petition for *inter partes* review of claims 1–12 of U.S. Patent No. 8,301,713 B2 (Ex. 1001, “the ’713 patent”). Paper 2 (“Pet.”). Blackberry Limited (“Patent Owner”) filed a Preliminary Response. Paper 10 (“Prelim. Resp.”).

On October 8, 2019, we instituted an *inter partes* review of claims 1–12. Paper 15 (“Decision”), 32. Patent Owner then disclaimed claims 1–3, 5–7, and 9–11 (*see* Ex. 2013) and filed a Patent Owner Response (Paper 23, “PO Resp.”),¹ Petitioner filed a Reply (Paper 27, “Pet. Reply”), and Patent Owner filed a Sur-Reply (Paper 30, “PO Sur-Reply”). An oral hearing was held on July 9, 2020, by video only, and a transcript of the hearing is included in the record. Paper 36 (“Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

¹ As a result of the statutory disclaimer, claims 1–3, 5–7, and 9–11 are no longer regarded as claims challenged in the Petition. *See Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998) (“This court has interpreted the term ‘considered as part of the original patent’ in section 253 to mean that the patent is treated as though the disclaimed claims never existed.” (citing *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996))); *see also Sanofi-Aventis U.S., LLC v. Dr. Reddy’s Labs., Inc.*, 933 F.3d 1367, 1372–75 (Fed. Cir. 2019) (explaining that disclaimer during infringement litigation “mooted any controversy” over the disclaimed claims, ending the Article III case or controversy requirement for district court jurisdiction).

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