

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.

IPR2019-00942
Patent 8,677,250 B2

Before MIRIAM L. QUINN, GARTH D. BAER, and AARON W. MOORE,
Administrative Patent Judges.

BAER, *Administrative Patent Judge.*

JUDGEMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

Facebook, Inc., Instagram, LLC, and WhatsApp Inc., (“Petitioner”) filed a Petition (Paper 2, “Pet.”), requesting an *inter partes* review of claims 1, 4–6, 8, 9, and 12–14 of U.S. Patent No. 8,677,250 B2 (Ex. 1001, “the ’250 patent”). Patent Owner BlackBerry Limited filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Pursuant to our authorization, Petitioner additionally filed a Reply (Paper 7) and Patent Owner filed a Sur-Reply (Paper 10). Upon consideration of the Petition, Preliminary Response, Reply and Sur-Reply, we instituted *inter partes* review of all challenged claims on all grounds raised. Paper 11 (“Dec. Inst.”).

Patent Owner filed a Response to the Petition (Paper 22, “PO Resp.”) and Petitioner filed a Reply (Paper 30, “Pet. Reply”). Patent Owner filed a Sur-Reply (Paper 34, “PO Sur-Reply”). An oral hearing was held on September 8, 2020, and the hearing transcript is included in the record. *See* Paper 40 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(b). This is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons set forth below, we find Petitioner has not shown by a preponderance of evidence that claims 1, 4–6, 8, 9, and 12–14 of the ’250 patent are unpatentable.

A. RELATED PROCEEDINGS

The parties identify the following related matters:

BlackBerry Ltd. v. Facebook, Inc., Case No. 2:18-cv-01844-GW-KS (C.D. Cal.); *Facebook, Inc. v. BlackBerry Ltd.*, Case No. IPR2019-00516; *Facebook, Inc. v. BlackBerry Ltd.*, Case No. IPR2019-00528; *Facebook, Inc. v. BlackBerry Ltd.*, Case No. IPR2019-00706; *Facebook, Inc. v. BlackBerry*

Ltd., Case No. IPR2019-00787; *Facebook, Inc. v. BlackBerry Ltd.*, Case No. IPR2019-00899; *Facebook, Inc. v. BlackBerry Ltd.*, Case No. IPR2019-00923; *Facebook, Inc. v. BlackBerry Ltd.*, Case No. IPR2019-00924; *Facebook, Inc. v. BlackBerry Ltd.*, Case No. IPR2019-00925; *Facebook, Inc. v. BlackBerry Ltd.*, Case No. IPR2019-00940; *Facebook, Inc. v. BlackBerry Ltd.*, Case No. IPR2019-00941. Pet. 1; Paper 4, 2–3.

B. THE '250 PATENT

The '250 patent is directed to integrating a game application with an instant messaging (IM) application. Ex. 1001, 1:15–19, 2:36–39. Specifically, the '250 patent discloses a technique “for using a contact list entry of an IM contact list interface to designate an IM game in progress to facilitate switching between an IM conversation and an IM game.” *Id.* at 2:36–39. Figure 7B is reproduced below.

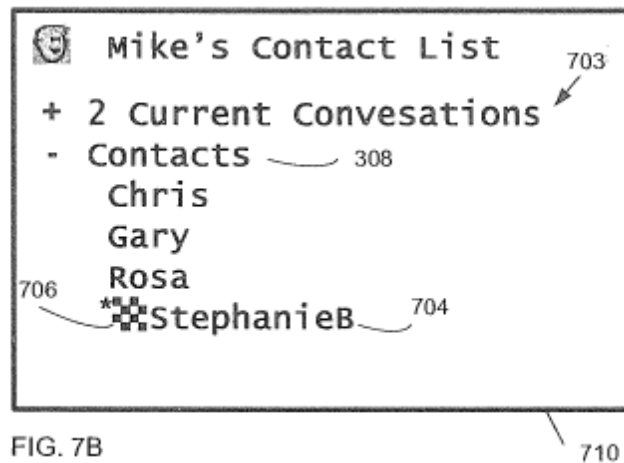


Figure 7B “illustrates a view 710 of contact list 703 depicting contacts 308 in an embodiment where a single individual contact element (e.g. 704) may represent a contact element for both IM conversation and IM game purposes.” *Id.* at 10:60–64. Selecting a contact element invokes a menu that

allows the user to open either a conversation or game screen. *Id.* at 11:11–21.

Figure 5B is reproduced below.

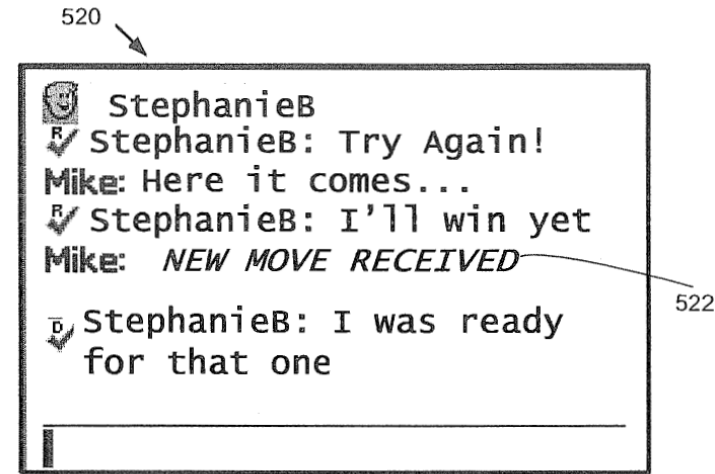


FIG. 5B

Figure 5B is an example of an IM view of a current conversation interface.

Id. at 10:8–9.

As a new move is received from the contact in the associated game in progress, a notification of the new move 522 is presented in the conversation screen (e.g. portion 504) in a manner similar to how a new message is presented. The user may then select and open or switch (not shown) to the game in progress from the conversation interface 520.

Id. at 10:10–15.

C. ILLUSTRATIVE CLAIM

Petitioner challenges claims 1, 4–6, 8, 9, and 12–14. Challenged claims 1 and 9 are independent. Claim 1 is illustrative and is reproduced below:

1. A method of enabling a game to be played on an electronic device, the method comprising:

enabling a game application on the electronic device to utilize a contact list for an instant messaging application for playing

games with contacts in the contact list by identifying game play in the contact list;

during a game in progress with a particular contact in the contact list, preparing game messages to be sent to the particular contact by including game progress data in an instant messaging message and an identifier to associate the data with the game application;

communicating at least one game message during the game in progress with the particular contact using an instant messaging system used by the instant messaging application;

displaying at least one instant message in an instant messaging conversation user interface associated with the particular contact indicative of game progress, the instant messaging conversation user interface enabling additional instant messages to be sent to the particular contact in addition to instant messages indicating game play; and

displaying a game in progress user interface associated with the game play, after detecting a selection in the instant messaging conversation user interface to switch to the game in progress.

Id. at 13:18–43.

D. PRIOR ART AND ASSERTED GROUNDS

Petitioner asserts the following grounds of unpatentability. Pet. 1–2.

Claims Challenged	35 U.S.C. § ¹	References/Basis
1, 4–6, 8, 9, 12–14	§ 103	Galli, ² Crane, ³ Miyaji ⁴

II. ANALYSIS

A. LEVEL OF SKILL IN THE ART

Petitioner asserts that a skilled artisan “would have possessed at least a bachelor’s degree in software engineering, computer science, electrical engineering, [or] computer engineering with at least two years of experience in the design and implementation of messaging systems and user interfaces, including user interfaces for messaging systems (or equivalent degree or experience).” Pet. 4. Patent Owner does not contest this or offer its own formulation for a skilled artisan. We agree with and adopt Petitioner’s proposal because it is consistent with the ’250 patent, as well as the problems and solutions in the prior art of record. *See Daiichi Sankyo Co., Ltd. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007).

B. CLAIM CONSTRUCTION

Neither party proposes any claim terms for construction. Pet. 8; PO Resp. 4. We agree with the parties that no express claim construction is

¹ The Leahy-Smith America Invents Act (“AIA”) amended 35 U.S.C. § 103. *See* Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011). As the application that issued as the ’049 patent was filed before the effective date of the relevant amendments, the pre-AIA version of § 103 applies.

² U.S. Pat. App. Pub. No. 2005/0086309 A1 (pub. Apr. 21, 2005) (Ex. 1003, “Galli”).

³ PCT Pub. No. WO01/31476 A1 (pub. May 3, 2001) (Ex. 1004, “Crane”).

⁴ U.S. Pat. App. Pub. No. 2006/0116205 A1 (pub. June 1, 2006) (Ex. 1005, “Miyaji”).

necessary to determine whether Petitioner has shown sufficiently that any of the challenged claims are unpatentable. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (explaining that it is only necessary to “construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

C. ASSERTED PRIOR ART

1. *Galli (Ex. 1003)*

Galli discloses “a framework that allows a number of software application agents, called IMLets, to be stacked on top of an instant messenger application.” Ex. 1003 ¶ 20. Galli’s framework “enables the user to seamless[ly] bring a local application into the instant messaging session.” *Id.* ¶ 19. Galli’s Figure 5A is reproduced below.

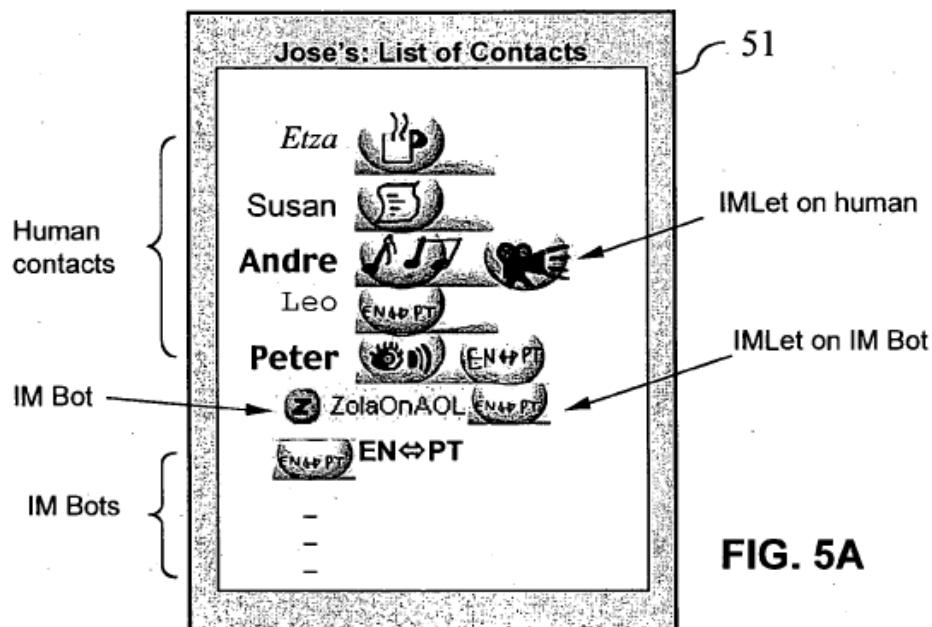


Figure 5A illustrates an exemplary contacts list, along with IMLets associated with particular contacts. *Id.* ¶ 60. The icons to the right of the contacts correspond to the IMLets. *Id.*

2. Crane (Ex. 1004)

Crane discloses “a method and system for providing a turn-based game and, more particularly, a turn-based game to be played by communicat[ing] over a network.” Ex. 1004, 1:5–6. According to Crane, “after each player has played a move, they are allowed to communicate their moves directly to one another.” *Id.* at 7:6–8. Game moves are transmitted as game packets between players over a network. *Id.* at 7:21–23.

3. Miyaji (Ex. 1005)

Miyaji describes “an operating program of a multiple match-up type network game, which is performed through communication networks.” Ex. 1005 ¶ 2. Miyaji’s Figure 4 is reproduced below.

FIG. 4

	(1) UNREGISTERED
MOVE	(2) 00:28/9MOVES
MOVE	(3) 00:22/7MOVES
YET	(4) 00:15/5 MOVES
	(5) DURING REGISTRATION FOR MATCH
LOSE	(6) TERMINAL STAGE/90MOVES
	(7) DURING REGISTRATION FOR MATCH
WIN	(8) TERMINAL STAGE/90MOVES

Figure 4 illustrates a match list. *Id.* ¶ 59. In Figure 4, “YET” identifies a game in which it is the user’s turn to move, and “MOVE” identifies a game in which it is the opponent’s turn to move. *Id.* at ¶¶ 66–67.

D. OBVIOUSNESS ANALYSIS

Petitioner asserts that claims 1, 4–6, 8, 9, and 12–14 would have been obvious over Galli, Crane, and Miyaji. Pet. 3. Based on Petitioner’s

analysis and as explained below, we find Petitioner has not made the requisite showing that claims 1, 4–6, 8, 9, and 12–14 would have been obvious over Galli, Crane, and Miyaji.

1. Petitioner's Proffered Combination

Petitioner relies on Galli for disclosing allowing a third party application to use an IM system to communicate, and on Crane for disclosing playing a turn-based game over a network. *See* Pet. 8–10. Specifically, Petitioner explains, Galli discloses the claimed integration of third-party applications with an IM system by “stacking one or more ‘software agents,’ which Galli also refers to as ‘IMLets,’ on top of the IM application that creates the IM session between two end users.” *Id.* at 10 (citing Ex. 1003 ¶¶ 20, 21, 36, 50, Abstr.). Petitioner further explains that

Galli discloses the key feature of the challenged claims – allowing a third party application to use an IM system to communicate. Although Galli does not in any way limit the types of programs that can have an IMLet, it does not provide a specific example of a third party game application. Petitioner has therefore cited Galli in combination with Crane and Miyaji, which disclose systems for playing turn-based games (such as chess and checkers) over a computer network.

Id. at 9–10.

Petitioner next explains, with support from its declarant, Dr. Chatterjee, and the prior art, that a skilled artisan would have been motivated to integrate Crane’s turn-based game application as an IMLet in Galli’s system because “the user experience in IM systems is enriched by the ability to bring additional, non-IM applications into an instant messaging session.” *Id.* at 26 (citing Ex. 1002 ¶ 61; Ex. 1003 ¶ 17). “The combination would,” Petitioner notes, “have predictably resulted in the inclusion, on Galli’s contact list, of an icon or other visual cue for the game application in

Crane,” and “[t]he icon or other visual cue would enable the user to activate the game application.” *Id.* at 22. Petitioner explains further that adding non-IM applications like games improves conventional IM systems “because a user of an IM system would no longer be constrained to ‘text messages’ or other forms of traditional IM content.” *Id.* at 26. In addition, according to Petitioner, “as Galli expressly suggests, the contact list is a natural and advantageous place to display the availability of shared applications because ‘spatial association’ can be used to clearly inform the user of the contact list as to which applications can be used with which contacts.” *Id.* at 27 (citing Ex. 1002 ¶ 62).

Petitioner relies on Miyaji for teaching “a ‘match list’ that identifies game play and games in progress.” *Id.* at 22 (citing Ex. 1005 ¶¶ 6, 10, 19, 20, 66). Petitioner explains that incorporating Miyaji’s match list functionality into Galli’s IM contact list would have been obvious to “provide useful information about the current state of an ongoing game,” particularly given that “turn-based game play may take place over hours or days.” *Id.* at 28 (citing Ex. 1002 ¶ 64 Ex. 1005, Fig. 14). Petitioner provides the following mock-up:



Id. at 24. According to Petitioner, the above mock-up shows an example of how the contact list in Galli could be adapted with an icon for the game application in Crane, along with Miyaji's match list functionality.

2. "identifying game play in the contact list"

Independent claims 1 and 9 require "identifying game play in the contact list." Petitioner asserts that the combined teachings of Galli and Miyaji suggest identifying game play in the contact list because "Galli discloses a **contact list for an instant messaging application**," while Miyaji discloses a "'match list' that identifies game play and games in progress." Pet. 18, 22. Petitioner explains that "a person of ordinary skill in the art would have understood that displaying the additional 'match list' information in the contact list could provide useful information about the current state of an ongoing game," particularly given that "turn-based game play may take place over hours or days." *Id.* at 28. Petitioner goes on to

explain that a skilled artisan “would also have recognized the analogous nature of the IMLet icon in Galli and the match list entries in Miyaji as both provide a selectable means to activate application functionality — functionality that is associated with communication with another user.” *Id.* at 28–29. In addition, according to Petitioner’s expert, “a person of ordinary skill would have been further motivated to provide a visual cue for games already in progress (to the extent there are any between the user of the contact list and her contacts) in addition to identifying the game application itself. This is beneficial because not only would the user be informed of the availability of particular ongoing games to be played, the user is also provided with an easy way to initiate the game application directly to the particular state of an ongoing game.” Ex. 1003 ¶ 64. Finally, Petitioner asserts that a person skilled in the art would have been motivated to “spatially associate[]” Miyaji’s game play identification “with their respective contacts,” in light of Galli’s teaching that it is desirable to spatially associate IMLet icons with contacts in a contact list. *Id.* at 29; *see* Ex. 1003 ¶ 41 (explaining that “[t]o maximize the users’ IM experience . . . the user can conveniently associate one or more IMLets with a certain contact in his friend-list or buddy list”).

Patent Owner argues Petitioner’s obviousness challenge is deficient because it does not provide an adequate motivation to combine Galli’s and Miyaji’s teachings. PO Resp. 19–25. For the reasons outlined below, we agree with Patent Owner that Petitioner’s rationale is deficient.

Although Galli and Miyaji separately disclose a contact list and identifying game play, the challenged claims require more than just those two separate features. Instead, the claims require a specific spatial

relationship between the contact list and identifying game play—i.e., identifying game play *in* a contact list. Neither Galli nor Miyaji has that feature, and Petitioner does not adequately explain why one skilled in the art would have combined the references’ separate identifying-game-play and contact-list teachings to arrive at identifying game play *in* a contact list, as claimed. Three of Petitioner’s proffered reasons for combining Galli’s contact list and Miyaji’s game play identification—providing useful information about the current state of an ongoing game, proving a selectable means to activate application functionality, and providing a visual cue for games in progress—explain why a skilled artisan would want Miyaji’s game play information in general, but do not adequately explain why it would have been obvious to include game play information specifically in a contact list. Petitioner’s other reason for combining Galli and Miyaji—spatially associating game play identification with a user’s contacts—might justify displaying game play information along with individual users, but again does not adequately explain why a skilled artisan would have found it obvious to include game play information *in a contact list*, as the challenged claims require. Moreover, we conclude that Galli’s teaching of “spatially associating” the IMLet icon with the name of a contact (*see* Ex. 1003 ¶ 41) is insufficient to teach or suggest adding an entirely different type of information—updating game play—to Galli’s contact list. Given this deficiency, we find that Petitioner has not produced the required “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Claims 4–6, 8, and 12–14 depend ultimately from either claim 1 or claim 9. Petitioner’s analysis for these claims does not remedy the

deficiencies explained above for claims 1 and 9. Therefore, Petitioner has not met its burden to show that claims 4–6, 8, and 12–14 would have been obvious over the asserted prior art.

III. CONCLUSION

We have reviewed the Petition, Patent Owner Response, Petitioner Reply, and Patent Owner Sur-Reply. We have considered all of the evidence and arguments presented by Petitioner and Patent Owner, and have weighed and assessed the entirety of the evidence as a whole.

For the reasons above, we determine, on this record, that Petitioner has not demonstrated by a preponderance of evidence that claims 1, 4–6, 8, 9, and 12–14 of the '250 patent are unpatentable over Galli, Crane, and Miyaji.

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
11, 12	103	Galli, Crane, Miyaji		1, 4–6, 8, 9, 12–14

IV. ORDER

It is hereby:

ORDERED that Petitioner has not shown that claims 1, 4–6, 8, 9, and 12–14 of the '250 patent are unpatentable under 35 U.S.C. § 103(a) as obvious over Galli, Crane, and Miyaji; and

FURTHER ORDERED that this Decision is final, and a party to this proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2019-00942
Patent 8,677,250 B2

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