

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, LLC,  
Petitioner,

v.

PETER HENRIK PEDERSEN,  
Patent Owner.

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IPR2023-00029  
Patent 6,965,920 B2

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Before LARRY J. HUME, STACEY G. WHITE, and MICHELLE N.  
WORMMEESTER, *Administrative Patent Judges*.

WHITE, *Administrative Patent Judge*.

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

## I. INTRODUCTION

Unified Patents, LLC (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1 and 14–17 of U.S. Patent No. 6,965,920 B2 (Ex. 1001, “the ’920 patent”). Paper 2 (“Pet.”). Trial was instituted on the asserted grounds of unpatentability. Paper 7 (“Inst. Dec.”), 47.

Peter Henrik Pedersen (“Patent Owner”) filed a Patent Owner Response (Paper 10, “PO Resp.”) to the Petition. Petitioner filed a Reply (Paper 12, “Reply”) to the Patent Owner Response. Patent Owner filed a Sur-reply (Paper 17, “Sur-reply”) to the Reply. An oral hearing was held on February 14, 2024, for which the transcript was entered into the record (Paper 28, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6(b)(4) and § 318(a). This Decision is a final written decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 1 and 14–17 of the ’920 patent. We determine Petitioner has shown by a preponderance of the evidence that claims 1 and 14–17 are unpatentable.

### A. Related Matters

As required by 37 C.F.R. § 42.8(b)(2), the parties identify various related matters. Pet. 1–3; Paper 4, 2–3; Paper 21, 2–3; Paper 25, 2.

### B. The ’920 Patent

The ’920 patent is titled “Profile Responsive Electronic Message Management System” and “relates to a system and method for the central filtering and distribution processing of messages from multiple messengers to selected individual recipients under filtering and distribution parameters in part established by each intended recipient.” Ex. 1001, code (54), 1:11–18. The ’920 patent addresses problems with existing Customer

Relation Management (“CRM”) systems pertaining to “the complexity, time consuming and resource demanding task in defining, operating and maintaining messages profiles on a one-to-one basis.” *Id.* at 1:40–62. For example, the ’920 patent explains that customers’ “message profiles must be entered and maintained in every single CRM system—in every single organization—for every single customer/client,” while “customers/clients will find it both time consuming and difficult to contact all his information suppliers to make them update his profile with e.g. a new e-mail address or phone number.” *Id.* The ’920 patent addresses problems with a system and method for the central specification and management of how messages are distributed to recipients, the system and method employing: (i) a recipient profile system for entering and storing rules about how to distribute specific types of messages and content from specific messengers to individual recipients; (ii) a messenger profile system where messengers can enter, store and maintain their identification information and the types of message services they will offer to recipients; (iii) a message input system where messengers manually or automatically can enter or upload message files for distribution to recipients with a valid recipient profile; and (iv) an individual message generator for combining the data from recipient profile and the message from the message input system into a plurality of individual messages for recipients as specified by the messenger. *Id.* at code (57). Figure 1 of the ’920 patent is reproduced below.

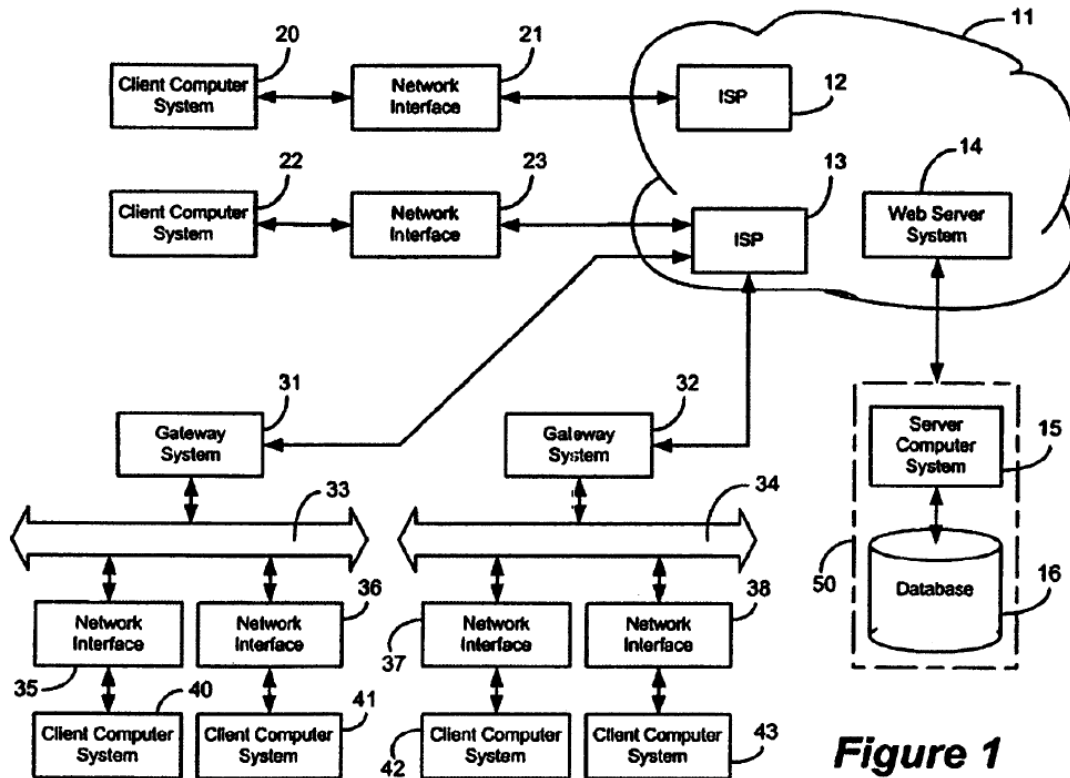


**Figure 1**

Figure 1, reproduced above, is a block diagram of an operating environment for practicing the '920 patent. *Id.* at 4:21–24. The operating environment illustrated in Figure 1 includes client computer systems 20, 22, and 40–43 coupled together through network 11, client computer system 20, 22, and 40–43 obtaining access to network 11 through Internet Service Providers (ISPs) 12–13. *Id.* at 5:3–23. Access to the network allows a user of a client computer system (20, 22, and 40–43) to exchange information, receive and send e-mails, and view documents. *Id.* at 5:23–45. Documents are provided by web servers 14, which are coupled to server computer system 15 which is, in turn, coupled to web content 16, which is a media database. *Id.* Server computer system 15 and database 16 form a message management server 50. *Id.* at 6:17–21.

Client computer systems 20, 22, and 40–43 can view HTML pages provided by web server 14. *Id.* at 5:45–57. Web server 14 also includes a message management server. *Id.*

Figure 2 of the '920 patent is reproduced below.

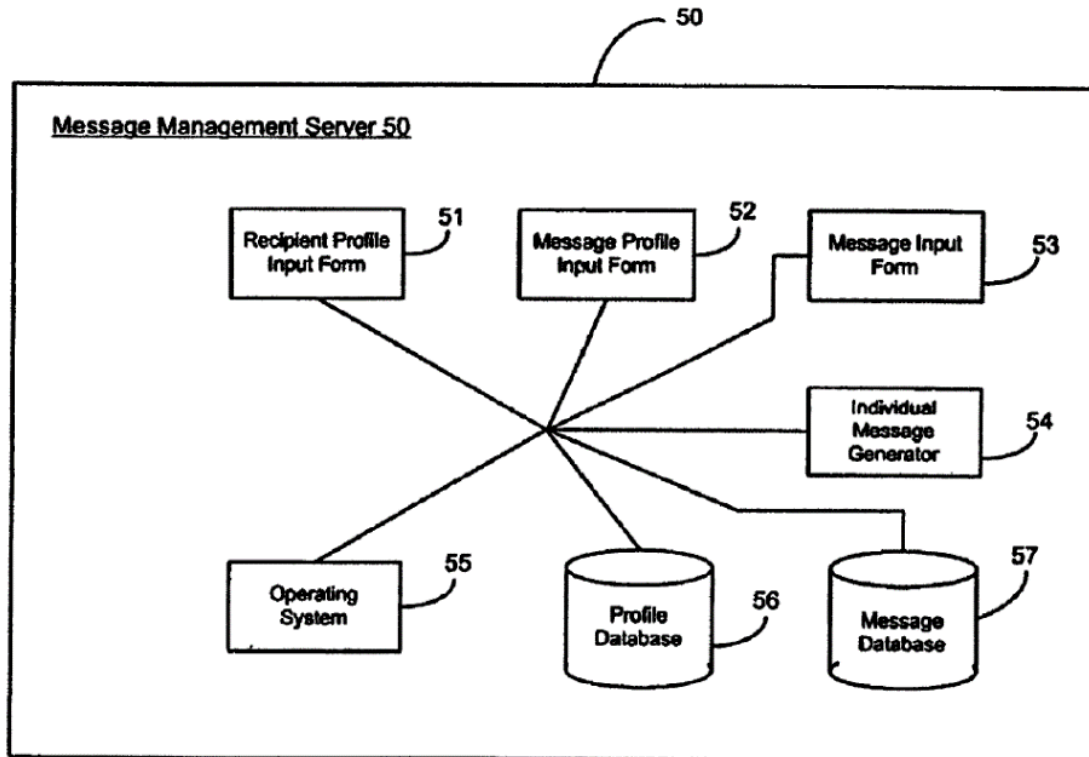


**Fig. 2**

Figure 2, reproduced above, is a block diagram of message management server 50 as illustrated in Figure 1. *Id.* at 6:17–20. Message management server 50 includes: (i) a recipient profile software application which includes recipient profile input form 51; (ii) a messenger profile software application, which includes messenger profile input form 52; (iii) a message input software application, which includes message input form 53; (iv) individual message generator 54; (v) operating system software 55 including a file management and disk operating system; (vi) profile database 56 for centrally storing profile and other information received from

messengers and recipients; and (vii) message database 57 for centrally storing messages received from messenger client computer systems 40–43. *Id.* at 6:22–7:4.

A computer system used to enter recipient profile data into message management server 50 is a recipient computer system (e.g., 20 and 22 in Fig. 1). *Id.* at 6:29–32. Recipient profile input form 51 includes discrete information fields, and may be displayed at a recipient's client computer (20, 22). *Id.* at 6:32–42. Information is processed into records stored in profile database 56. *Id.* Messenger profile input form 52 includes discrete information fields displayed at a messenger's client computer (40–43 in Fig. 1). *Id.* at 6:42–52. This information is processed into records stored in profile database 56. *Id.* Message input form 53 includes discrete information fields to be displayed at a messenger's client computer (40–43) in the form of a web page to receive information that is to be stored in message database 57. *Id.* at 6:53–62. Individual message generator 54 obtains information from database 57 and generates individual messages for each recipient, based on the combination of recipient and messenger profile parameters and messages entered into the profile 56 and message 57 databases. *Id.* at 6:63–67.

Figure 4 of the '920 patent is reproduced below.

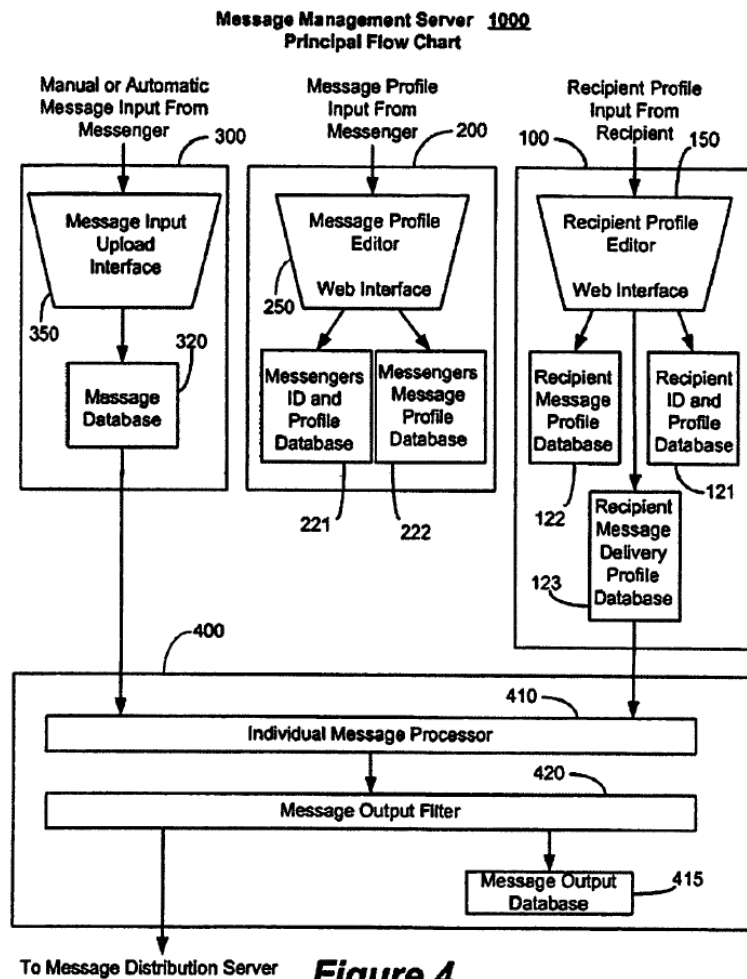


**Figure 4**

Figure 4, reproduced above, illustrates an overall flow of information through the message management server. *Id.* at 7:42–44. Message management server (1000 in Fig. 4) includes recipient profile system 100, messengers profile system 200, message input system 300, and individual message generator 400. *Id.* at 7:42–46, Fig. 4. Recipient profile system 100 is used for entering, managing, and storing rules about how message management system server 1000 is to communicate with each individual recipient. *Id.* at 7:46–8:5.

The recipient logs onto message management system server 1000 and enters basic identification data, which will be stored in the recipient ID and

profile database 121 (a subsystem of profile database 56 shown in Fig. 2). *Id.* In addition, the recipient enters message profile data, specifying one or more messengers, type of messages, and type of content the recipient wishes to receive from each messenger. *Id.* Data is stored in recipient message profile database 122 (a subsystem of profile database 56). *Id.* For each message profile entered, the recipient specifies one or more message delivery profiles with data about how messages are to be distributed, where to receive the specified message, and the type of message devices to transmit the messages. *Id.* The data is stored in message delivery profile database 123 (a subsystem of profile database 56). *Id.*

Messengers profile system 200 allows a messenger to access message management system server 1000 to enter and maintain identification information and messenger profile data. *Id.* at 8:6–29. The messenger utilizes messenger profile editor/web interface 250 to enter messenger profile data, specifying the types of messages and types of content the messenger is providing to recipients. *Id.* This profile is stored in messengers message profile database 222 (a subsystem of profile database 56). *Id.* A messenger also can specify a list of specific recipient IDs, each combined with a set of message types and content types that the identified entities must receive. *Id.* The message profiles entered by the messenger are stored in recipient message profile database 122 (a subsystem of the profile database 56). *Id.*

Message input system 300 is used by messengers to enter messages for the purpose of having them distributed to recipients according to their individual specified recipient message profiles. *Id.* at 8:30–44. A messenger logs onto message management system server 1000 via message

input (upload) editor/web interface 350. *Id.* Once connected, the messenger can manually or automatically enter the message data or upload messages files for distribution to recipients with an appropriate message profile. *Id.*

Message processor 410 of individual message generator 400 combines data from recipient message delivery profile database 123 with data from message database 320, and from this combination, message output filer 420 generates individual messages for each recipient as specified in the message database 57 and the recipient message delivery profile database 123. *Id.* at 8:45–58. Message generator 400 forwards the generated messages to a message distribution server, from where the messages are converted to the right device protocols and distributed to the devices and addresses as specified by the intended recipients. *Id.*

### *C. Illustrative Claim*

Challenged claim 1 is independent. Claims 14–17 depend from claim 1. Claim 1 is illustrative of the subject matter of the challenged claims.

1. [1.0] An electronic message management system comprising:
  - [1.1] an electronic computer system in operative communication with a global digital communications network, and [1.2] an electronic message management database in operative communication with the computer system; [1.3] the electronic computer system having
    - a recipient profile application for receiving recipient profile data from recipients via the global network and storing the recipient data in the database, [1.4] the profile data including delivery parameters specified by a recipient of where, when and how specific types of messages from specific messengers are delivered to the recipient,
    - [1.5] a messenger profile application for receiving messenger profile data from messengers via the global

network and storing the messenger data in the database, including messenger identifying data,

[1.6] a message input application for receiving message files from a messenger via the global network and storing the message files in the database, and

[1.7] an individual message generator in communication with the database and operative to access and utilize data and files from the database to generate an individual message to be sent to the recipient specified by the messenger via the global communications network according to the delivery parameters, and [1.8] a message management server operating system; and

[1.9] the message management database including recipient and messenger profile databases for storing recipient and messenger profile data respectively, and a message database for storing message data files.

Ex. 1001, 11:19–50 (bracketed designations added by Petitioner (*see* Pet. 36–82)).

#### *D. Asserted Grounds of Unpatentability*

Petitioner, supported by the declaration of Dr. Henry Houh (Ex. 1003), asserts the following grounds of unpatentability (Pet. 6)<sup>1</sup>:

| <b>Claim(s) Challenged</b> | <b>35 U.S.C. §</b> | <b>Reference(s)/Basis</b>            |
|----------------------------|--------------------|--------------------------------------|
| 1, 14–17                   | 103                | Funk <sup>2</sup> , Law <sup>3</sup> |
| 1, 14–17                   | 103                | Funk, Kamakura <sup>4</sup>          |

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<sup>1</sup> We apply the pre-AIA version of 35 U.S.C. § 103 because the claims at issue have an effective filing date prior to March 16, 2013, the effective date of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”). *See* Ex. 1001, code (22).

<sup>2</sup> Funk et al., U.S. Pat. No. 5,937,162, issued Aug. 10, 1999 (Ex. 1006, “Funk”)

<sup>3</sup> Law, U.S. Pat. No. 7,058,586 B1, issued June 6, 2006 (Ex. 1007, “Law”)

<sup>4</sup> Kamakura et al., U.S. Pat. No. 6,047,310, issued Apr. 4, 2000 (Ex. 1008, “Kamakura”)

## II. ANALYSIS<sup>5</sup>

### A. *Level of Ordinary Skill in the Art*

In order to determine whether an invention would have been obvious at the time the application was filed, we consider the level of ordinary skill in the pertinent art at critical time. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The resolution of this question is important because it allows us to “maintain[] objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). In assessing the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). Generally, it is easier to establish obviousness under a higher level of ordinary skill in the art. *Innovation Toys, LLC v. MGA Entm’t, Inc.*, 637 F.3d 1314, 1323 (Fed. Cir. 2011) (“A less sophisticated level of skill generally favors a determination of nonobviousness . . . while a higher level of skill favors the reverse.”).

Petitioner asserts that a person having ordinary skill in the art at and before the priority date of the ’920 patent

would have had a bachelor’s degree in electrical engineering, computer engineering, computer science, or a related subject, and one to two years of work experience in electronic content-delivery techniques or a related field. Less experience is necessary with additional education (e.g., a Master’s degree), and

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<sup>5</sup> Petitioner argues that discretionary denial is not warranted under 35 U.S.C. §§ 314(a) or 325(d). Pet. 97–99. Because Patent Owner does not argue for discretionary denial, we see no need to consider the issue further.

likewise, less education is necessary with additional work experience (e.g., 5–6 years).

Pet. 9–10 (citing Ex. 1003 ¶¶ 43–46). Patent Owner does not dispute the level of ordinary skill in the art. *See generally* PO Resp.

We are persuaded that Petitioner’s description is consistent with the prior art and patent specification before us. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). Thus, we adopt Petitioner’s description.

### *B. Claim Construction*

In an *inter partes* review proceeding, a patent claim shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b). 37 C.F.R. § 42.100(b). Our rule adopts the same claim construction standard used by Article III federal courts, which follow *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), and its progeny. Under this standard, the words of a claim are generally given their “ordinary and customary meaning,” which is the meaning the term would have to a person of ordinary skill at the time of the invention, in the context of the entire patent including the specification. *See Phillips*, 415 F.3d at 1312–13.

Petitioner submits that “for purposes of this proceeding, no claim term requires construction beyond its ordinary and customary meaning.” Pet. 11. Petitioner further argues that the challenged claims do not recite any terms that invoke 35 U.S.C. § 112, sixth paragraph. *See id.* (“These terms do not invoke § 112 ¶6 because they do not recite the term ‘means,’ and a POSITA would have understood that the claimed *electronic computer system* provides structure for executing the claim features.”). Petitioner states that “to the extent the Board determines that the ‘application’ and ‘generator’ terms of

the Challenged Claims, identified below, invoke §112 ¶6, Petitioner identifies their function and corresponding structure in compliance with 37 C.F.R. § 42.104(b)(3).” *Id.* at 11–21. We are not persuaded that any terms from the ’920 patent should be construed as means plus function terms.

Patent Owner submits that “the terms of the ’920 patent are clear on their face.” PO Resp. 16.

Based on the dispute before us, we see no need for express construction of any term. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019).

### *C. Overview of the Asserted Prior Art*

#### *1. Funk (Exhibit 1006)*

Funk is titled “Method and Apparatus for High Volume E-Mail Delivery” and “relates to electronic mail, and more particularly, to high volume electronic mail delivery systems and methods.” Ex. 1006, code (54), 1:13–15. Funk discloses a high-volume e-mail “newspaper” delivery system that contains, for each customer, a personal configuration file containing the information resources that the customer would like e-mailed to their desktop. *Id.* at code (57). The configuration file is highly customizable, allowing the end-user detailed control over the content, format, and timing of the delivered e-mails. *Id.*

Figure 1 of Funk is reproduced below.



Figure 1 of Funk, reproduced above, illustrates a block diagram of an information services system including service processing system 104. In Figure 1, one or more information sources 100 are connected to service processing system 104. *Id.* at 5:35–52. Information sources 100 include sources of information (such as the Associated Press, Reuters News, or The Wall Street Journal). *Id.* Service processing system 104 connects to Internet 106 or some other e-mail network, providing the information to end-user terminals 114. *Id.* at 5:53–67. Service processing system 104 receives information from information sources 100, translates that information into a database format, and stores the translated information in databases corresponding to services provided by service processing system 104. *Id.* Service processing system 104 then generates e-mail messages based on the contents of the databases, and feeds those e-mail messages through the Internet to end-user terminals 114. *Id.*

Figure 2 of Funk is reproduced below.

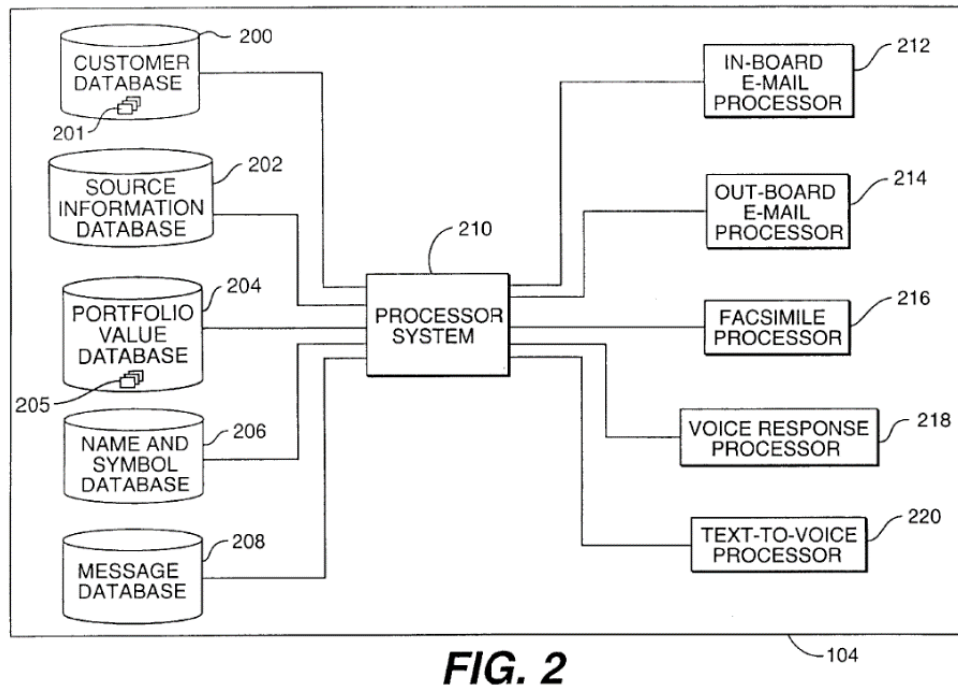


Figure 2 of Funk, reproduced above, is a block diagram of service processing system 104. *Id.* at 4:41–46. Service processing system 104 includes databases (including customer database 200, source information database 202, portfolio value database 204, name and symbol database 206, and message database 208), inbound e-mail processor 212, outbound e-mail processor 214, facsimile processor 216, voice response processor 218, and text-to-voice processor 220. *Id.* at 6:24–36. For each customer subscribing to the service, customer database 200 includes a customer record 201 listing fields relating to the service processor, the customer, and the service. *Id.* at 7:16–27. A customer may modify their services by modifying the pertinent customer record 201. *Id.* at 8:64–9:2. Message database 208 includes messages for customers. *Id.* at 8:25–29.

Each database 200–208 and each processor 212–220 is connected to processor system 210, which receives information from information

sources 100 and stores that information in one of databases 200–208. *Id.* at 6:39–52. At predetermined intervals, processing system 210 generates a temporary list or file of all information to be delivered via e-mails to end-users, then sends the file to outbound e-mail processor 214, facsimile processor 216, or text-to-voice processor 220, depending on the delivery path. *Id.* Processors 214, 216, and 220 translate the file into e-mail format or a message delivery format for Internet 106. *Id.* When an e-mail including appropriate key words is sent to inbound processor 212, processor system 210 adds that message to message database 208 for the customer. *Id.* at 8:39–46. The inbound message also includes a customer selector field to identify a customer or a class of customers. *Id.*

Processor system 210 looks to message database 208 for messages for customers, and writes these messages to a temporary file. *Id.* at 8:25–29. After completing the temporary file for a customer, processor system 210 determines whether there are more customer records in customer database 200. *Id.* at 8:47–63. If not, processor system 210 closes the temporary file and passes it to outbound e-mail processor 214, which translates the temporary file into individual e-mail messages for each subscriber, and sends the e-mail messages to an end-user terminal 114. *Id.*

Figure 3 of Funk is reproduced below.

|     |     |                                                                                 |                          |     |     |     |       |
|-----|-----|---------------------------------------------------------------------------------|--------------------------|-----|-----|-----|-------|
| 300 | 302 | TO: JOHN DOE<br>FROM:: CBELL@I-MAIL.COM<br>RE: CLOSING BELL@MONTH/DAY/YEAR      |                          |     |     |     |       |
|     |     | -----                                                                           |                          |     |     |     |       |
|     | 304 | CLOSING BELL FOR FEBRUARY 2, 1995<br>MERRILL LYNCH, DAVID SMITH, (703) 555-1212 |                          |     |     |     |       |
|     |     | -----                                                                           |                          |     |     |     |       |
|     | 306 | AMGN                                                                            | AMGEN.....               | .61 | 7/8 | -   | 1/8   |
|     |     | AMER                                                                            | AMERICA ONLINE.....      | .56 | 1/2 | +2  | 1/2   |
|     |     | BGEN                                                                            | BIOGEN.....              | .36 | 3/4 | +   | 3/8   |
|     |     | BBTK                                                                            | BROADBAND TECH.....      | .26 | 1/2 | -   | 9/16  |
|     |     | GNE                                                                             | GENENTECH.....           | .48 | 1/8 | ... |       |
|     |     | GIC                                                                             | GENERAL INSTRUMENT.....  | .28 | 7/8 | ... |       |
|     |     | CEL                                                                             | GROUPO IUSACELL.....     | .14 | 7/8 | -   | 1/8   |
|     |     | MOT                                                                             | MOTOROLA .....           | .60 | 5/8 | -   | 1/8   |
|     |     | CALL                                                                            | NEXTEL.....              | .10 |     | ... |       |
|     |     | ORCL                                                                            | ORACLE.....              | .42 | 7/8 | +   | 1/2   |
| 308 | 310 | PCTV                                                                            | PEOPLE'S CHOICE TV.....  | .21 | 1/8 | +   | 11/16 |
|     |     | SYBS                                                                            | SYBASE .....             | .44 |     | +   | 5/8   |
|     |     | TMX                                                                             | TELEFONOS DE MEXICO..... | .33 | 1/2 | -   | 3/4   |
|     |     | -----                                                                           |                          |     |     |     |       |
| 310 | 308 | TOTAL EQUITY VALUE                                                              |                          |     |     |     |       |
|     |     | \$75,328.11                                                                     |                          |     |     |     |       |
| 310 | 308 | TOTAL CASH BALANCE                                                              |                          |     |     |     |       |
|     |     | \$91,392.59                                                                     |                          |     |     |     |       |
|     |     | =====                                                                           |                          |     |     |     |       |
| 310 | 310 | JOHN, PLEASE CALL ME. -DAVE S.                                                  |                          |     |     |     |       |
|     |     |                                                                                 |                          |     |     |     |       |

**FIG. 3**

Figure 3, reproduced above, is a preferred embodiment of an e-mail message format generated by the service processing system. *Id.* at 4:47–50. Figure 3 depicts e-mail message 300 to be sent to end-user, John Doe. *Id.* at 6:57–58. E-mail 300 includes message fields 302–310, which contain information drawn from databases 200–208. *Id.* at 7:9–11. For example, first information field 302 identifies the user, the source of the email, the name of the e-mail service, and the date. *Id.* at 6:59–61. Additional message field 310 may include data from third parties. *Id.* at 7:4–8. Specifically, “processor system 210 looks to the message database 208 for any messages for the customer and . . . [t]hese messages are used to fill message field 310 of the e-mail message.” *Id.* at 8:26–29.

Figure 7 of Funk is reproduced below.

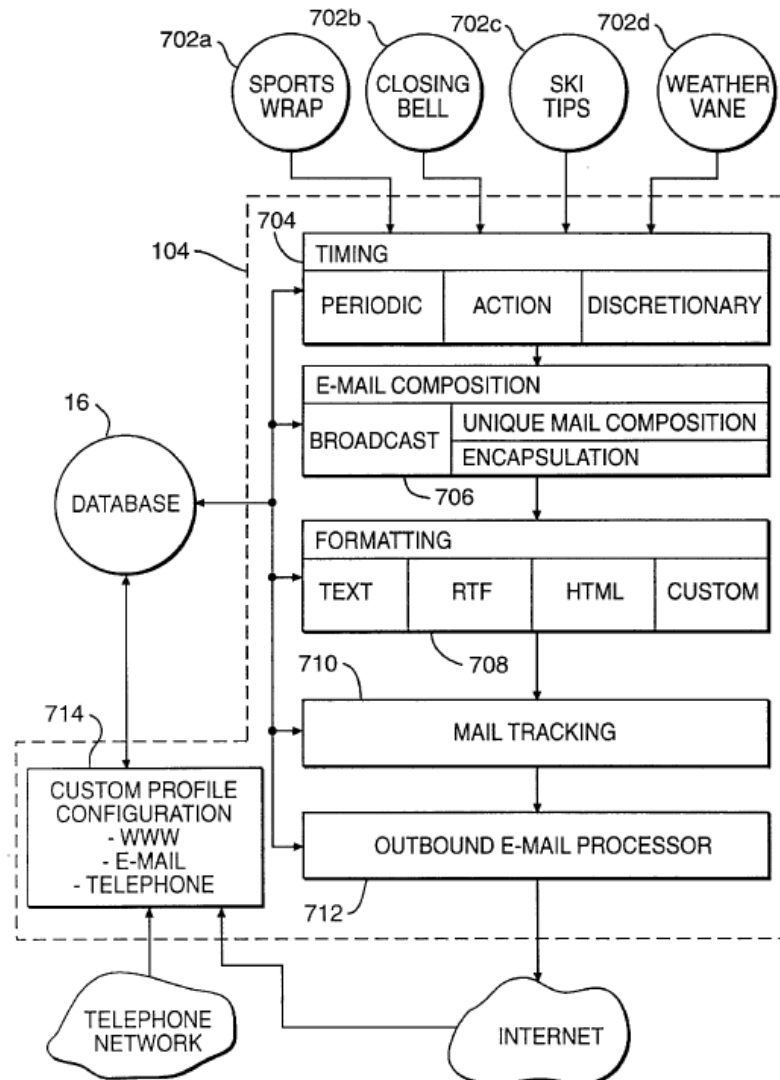


**FIG. 7**

Figure 7 of Funk, reproduced above, is a block diagram showing an alternative service processing system 104. *Id.* at 4:61–63, 9:28–30. A personal configuration file is created for each customer containing the information resources that the end-user would like e-mailed to their desktop. *Id.* at 4:30–42. The configuration file is highly customizable, allowing the customer detailed control over the content, format, and timing of the delivered e-mails. *Id.*

As shown in Figure 7, service processing system 104 has access to a plurality of source information databases 702a–d (similar to database 202). *Id.* at 4:49–67. Information is retrieved from databases 702 by timing processor 704 and forwarded to e-mail composition processor 706. *Id.* From there, it is processed by formatter 708, and then sent to e-mail tracker 710. *Id.* Finally, the information is transmitted to out-bound e-mail processor 712, where it is delivered. *Id.*

Database 16 stores, for each customer, a personal configuration file including fields describing the customer's desired electronic message configuration, and provides such information to timing processor 704, e-mail composition processor 706, and formatter 708. *Id.* at 9:62–10:5. Customer profile configuration processor 714 enables customers to individually modify their account configuration. *Id.* at 10:6–32. For example, the customer's account information may indicate that information from certain databases should be delivered periodically. *Id.* Alternatively, account information may indicate that information should be delivered based on an external action (e.g., when the customer sends a requesting e-mail to the system, or when a certain stock price drops below a preset threshold). *Id.*

In operation, timing processor 704 determines, based on each customer's account information, when to initiate preparation of an e-mail message for delivery. *Id.* at 10:17–52. Timing processor 704 works in conjunction with e-mail composition processor 706 to assemble the customer's electronic message. *Id.* Based on information from the timing processor 704 and customer account information from the database 16, e-mail composition processor 706 determines who shall receive the delivery, e.g., a unique individual broadcast, or a group of end-users; what pieces of

information are to be assembled for each individual end-user; and, when there are multiple pieces of information for delivery, whether the customer would like the information delivered as a series of e-mail messages, or as one encapsulated e-mail message. *Id.*

After the e-mail messages are prepared for content by timing processor 704 and e-mail composition processor 706, formatter 708 formats the e-mail messages into their final delivery form. *Id.* at 10:53–11:12. Formatter 708 formats the e-mails to a customer chosen format indicated in the customer configuration file. *Id.* Finally, the e-mail messages are sent to out-bound e-mail processing section 712, where they are transmitted to the customers. *Id.*

Figure 8 of Funk is reproduced below.

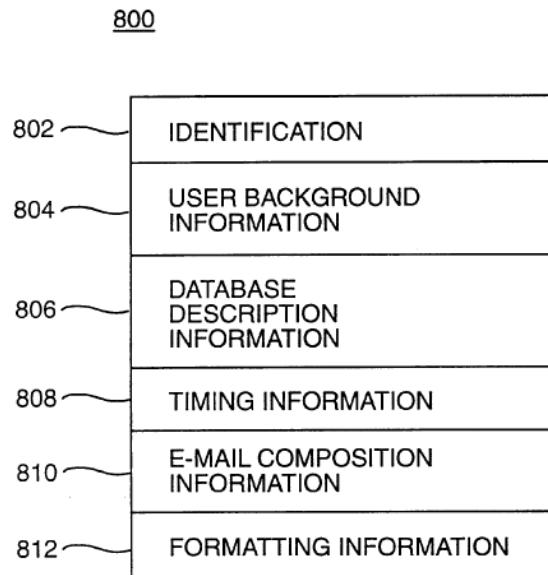


**FIG. 8**

Figure 8 of Funk, reproduced above, illustrates customer configuration file 800 for service processing system 104 illustrated in Figure 7. *Id.* at 11:13–18. The customer configuration file includes (i) section 802 with

customer identification information, (ii) optional field 804 containing background information about the customer such as, for example, age, annual income, and hobbies, (iii) field 806 containing information describing the information services the customer has subscribed to, and (iv) fields 808, 810, and 812 containing information relating to the timing information, the e-mail composition information, and the formatting information, respectively, used by timing section 704, e-mail composition section 706, and formatting section 708 of Fig. 7, respectively. *Id.* at 11:13–35. Customer configuration file 800 forms the basis for an individually customizable e-mail message configuration. *Id.* Customers may view or modify their configuration file through configuration processor 714. *Id.*

## 2. *Law (Ex. 1007)*

Law is titled “Information Delivery System for Providing Senders with a Recipient’s Messaging Preferences,” and “is directed to techniques allowing a recipient, receiving messages from a plurality of different senders desiring to communicate with the recipient, to control various aspects of the messages techniques for ensuring that the senders have access to updated recipient preferences.” Ex. 1007, code (54), 1:20–25. Law implements its techniques in “[a]n information delivery system that includes a web server in operative communication with a plurality of recipients and a plurality of senders.” *Id.* at code (57).

Figure 1 of Law is reproduced below.

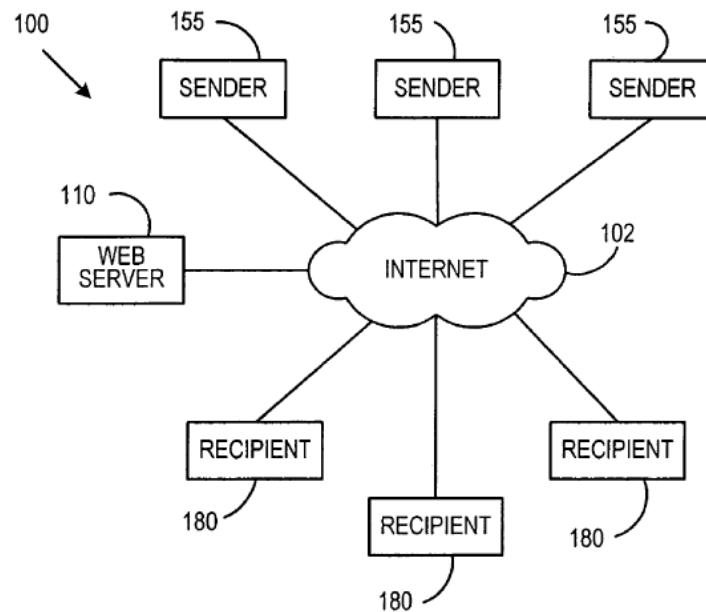


**FIG. 1**

Figure 1 of Law, reproduced above, illustrates information delivery system 100 including a web server, a plurality of plurality of recipients, and a plurality of senders, all in electronic communication with the web server. *Id.* at 3:5–8, 3:27–31. Web server 110, which may be any computer system that provides World Wide Web services on the Internet, collects message preference data from recipients 180, and makes it available to senders 155 so that senders 155 may more efficiently and effectively communicate their messages to recipients 180. *Id.* at 3:30–47. Recipients 180 may be geographically dispersed, and connect to web server 110 using a computer-based communication system. *Id.* at 3:47–57. Senders 155 may be geographically dispersed, and connect to web server 110 using a computer-based communication system. *Id.* at 3:58–4:11. Senders 155 employ messaging systems to assist in the creation, addressing, output generation, and/or delivery of messages. *Id.*

Recipient 180 may be an individual, a household, a business, or any other type of entity/organization that receives messages. *Id.* at 4:12–24. Web server 110 includes a plurality of recipient preference profiles 190 corresponding to recipients 180. *Id.* at code (57), Fig. 2.

Figure 2 of Law is reproduced below.

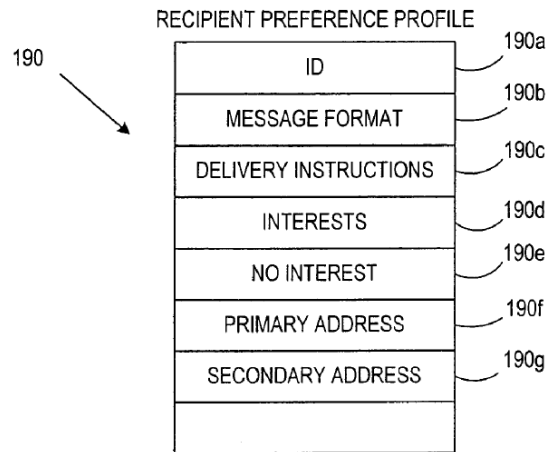


**FIG. 2**

Figure 2 of Law, reproduced above, illustrates a template for recipient preference profile 190. *Id.* at 3:9–13, 4:13–15. Recipients 180 may access their profiles to make corrections and changes to the information. *Id.* at 4:15–17. Recipient preference profile 190 defines various parameters intended to control aspects of messages sent by senders 155 that are intended for the recipient. *Id.* at 4:17–58. As shown in Figure 2, recipient preference profile 190 includes: a recipient identifier or ID data 190a; message format data 190b; delivery instruction data 190c; interest data 190d; no interest data 190e; primary address data 190f; and secondary address data 190g. *Id.*

Recipient ID data 190a may be a name or other suitably unique identifier. *Id.* at 4:25–5:10. Message format data 190b may indicate the recipient's preferred mode of communication, combination of modes of communication and/or priority for modes of communication in which to

receive messages. *Id.* Delivery instruction data 190c indicates if any optional delivery preferences are active. *Id.* Interest data 190d indicates if recipient 180 has any desire to hear from particular types of senders, and no interest data 190e indicates if recipient 180 has any desire to not hear from particular types of senders. *Id.* Interest data 190d and the no interest data 190e include indications of types of industry segments that the recipient may or may not, respectively, wish to hear from. *Id.* Primary address data 190f represents a default address (postal delivery, electronic mail, phone number) to which messages should be sent. *Id.*

Web server 110 includes a plurality of sender profiles 195 corresponding to senders 155. *Id.* at code (57), Fig. 3. Figure 3 of Law is reproduced below.

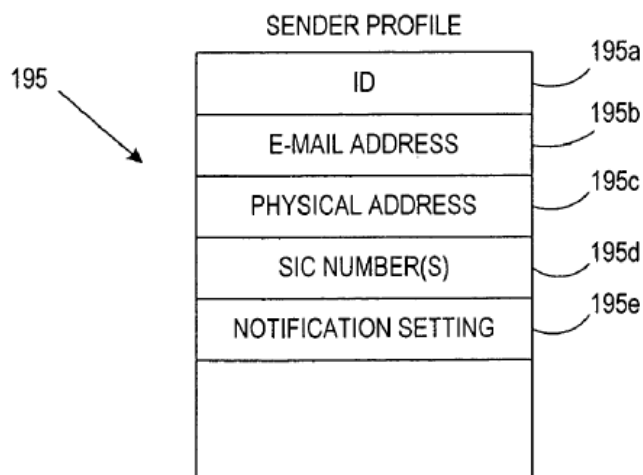


**FIG. 3**

Figure 3 of Law, reproduced above, illustrates a template for sender profile 195. *Id.* at 5:15–18. Senders 155 may access their profiles in order to make corrections and changes to any information. *Id.* at 5:11–36. Sender profile 195 is established by sender 155 and may include: a sender identifier or ID data 195a; an e-mail address 195b; a physical address 195c; a series of SIC

numbers (assigned by the Standard Industry Code (SIC) system to indicate well-known industry segments) 195d describing the sender; and notification setting data 195e. *Id.* Sender ID data 195a may be a name or any other suitably unique identifier. *Id.* E-mail address 195b provides an electronic point of contact for web server 110 to transmit messages to that are intended for sender 155. *Id.* Notification setting data 195e define how web server 110 is to communicate with sender 155. *Id.*

### 3. *Kamakura (Ex. 1008)*

Kamakura is titled “Information Disseminating Apparatus for Automatically Delivering Information to Suitable Distributees” and “relates to an information providing apparatus for automatically determining the distribution of information such as electronic mail, voice mail, video-on-demand data, facsimile data, and conventional mail, received by a receiver from a sender.” Ex. 1007, code (54), 1:8–13. As described in Kamakura, a receiver of advertisement information registers an advertisement reception requirement to a distribution host computer through a receiver terminal. *Id.* at code (57). A sender registers an advertisement transmission requirement to the distribution host computer through a sender terminal. *Id.* The host computer references receiver attributes and desired categories of the advertisement recorded in the advertisement reception requirement, and categories and desired attributes for the receivers recorded in the advertisement transmission requirement, and generates a distribution list that satisfies both the receiver and the sender. *Id.* An advertisement is then distributed to selected receivers corresponding to the distribution list. *Id.*

Figure 3 of Kamakura is reproduced below.

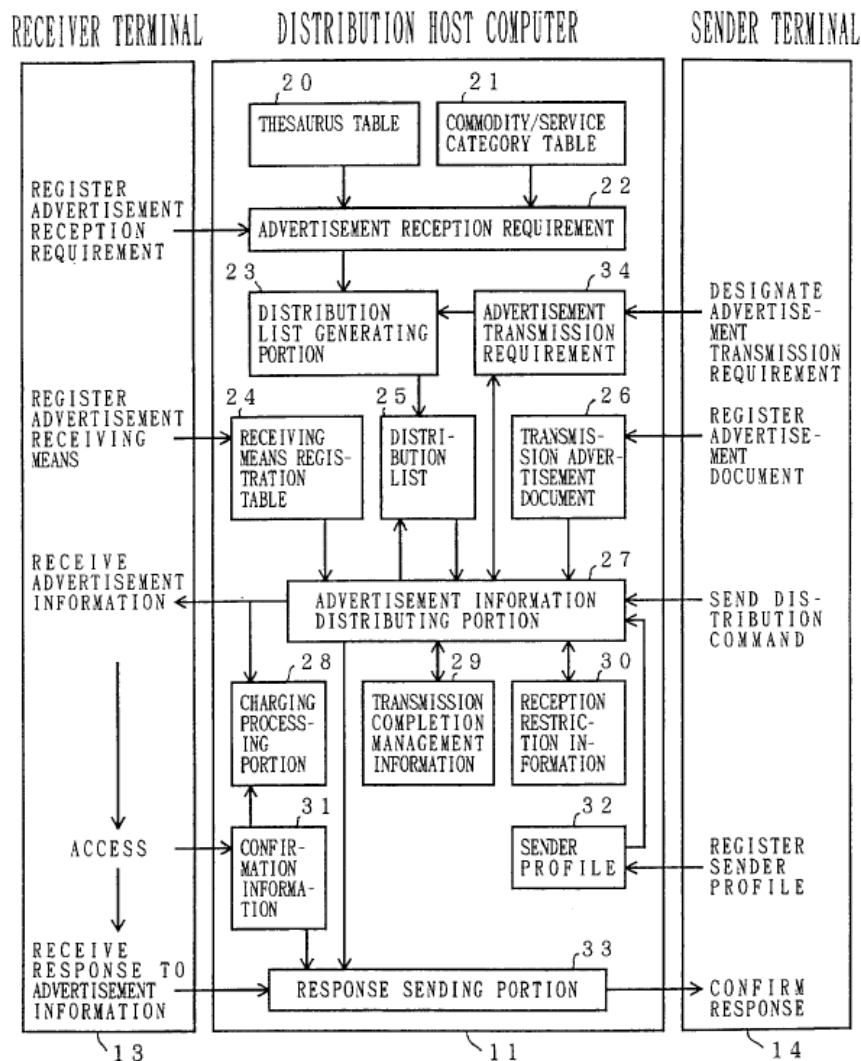


FIG. 3

Figure 3 of Kamakura, reproduced above, is a block diagram showing a structure of a distributing host computer. *Id.* at 3:49–50. Distribution host computer 11, receiver terminal 13, and sender terminal 14 are connected to communication network 12. *Id.* at 5:50–64. Sender terminal 14 is a computer terminal of a vendor of goods or services. *Id.* Receiver terminal 13 is a computer terminal of another user of the network. *Id.* A plurality of receiver terminals 13 and a plurality of sender terminals 14 are

connected to network 12. *Id.* Distribution host computer 11 designates senders and receivers who send and receive advertisement information corresponding to various information received from receiver terminals 13 and sender terminals 14. *Id.* Figure 3 illustrates the flow of information exchanged between distribution host computer 11, receiver terminal 13, and sender terminal 14. *Id.* at 5:65–6:13.

Distribution host computer 11 includes distribution list generating portion 23, advertisement information distributing portion 27, charging processing portion 28, and response sending portion 33. *Id.* Distribution host computer 11 also stores thesaurus table 20, commodity/service category table 21, advertisement reception requirement 22, advertisement transmission requirement 34, receiving means registration table 24, distribution list 25, transmission advertisement document 26, transmission completion management information 29, reception restriction information 30, confirmation information 31, and sender profile 32. *Id.*

Distribution list generating portion 23 and charging processing portion 28 are realized by the function of the CPU in distribution host computer 11. *Id.* at 6:14–36. Thesaurus table 20, commodity/service category table 21, advertisement reception requirement 22, advertisement transmission requirement 34, receiving means registration table 24, distribution list 25, transmission advertisement document 26, transmission completion management information 29, reception restriction information 30, confirmation information 31, and sender profile 32, are stored in a memory of distribution host computer 11. *Id.* The structure of advertisement information distributing portion 27 and response sending portion 33 depends on the communication mode. *Id.*

Figure 17 of Kamakura is reproduced below.

| ITEM                                             | CONTENT                               |
|--------------------------------------------------|---------------------------------------|
| COMPANY NAME (PERSON NAME)                       | COMPANY NAME OR PERSON NAME           |
| ADDRESS                                          | ADDRESS                               |
| TELEPHONE NUMBER                                 | TELEPHONE NUMBER                      |
| FAX NUMBER                                       | FAX NUMBER                            |
| COMPUTER NETWORK SUBSCRIBER ID                   | COMPUTER NETWORK SUBSCRIBER ID        |
| DIRECT MAIL DISTRIBUTION<br>SYSTEM SUBSCRIBER ID | AUTOMATICALLY DESIGNATED<br>BY SYSTEM |
| COMPANY SUMMARY                                  | DESCRIPTION OF COMPANY                |
| CONCERNED COMMODITY CATEGORY                     | CATEGORY CODES (ONE OR MORE)          |

## FIG. 17

Figure 17 of Kamakura, reproduced above, illustrates a schematic diagram of sender profile 32 shown in Figure 3. *Id.* at 13:64–66. The sender profile includes a number of fields such as company name or a sender name, phone number, fax number. *Id.* at 13:65–14:9. With sender profile 32, the contact information for the sender can be sent to receivers, such that receivers can easily contact the sender. *Id.*

### *D. Obviousness over Funk and Law*

Petitioner asserts that claims 1 and 14–17 are unpatentable under 35 U.S.C. § 103(a) as obvious over the teachings of Funk and Law, citing the Declaration of Dr. Houh for support. Pet. 21–86 (citing Ex. 1003); *see also* Ex. 1024 (Supplemental Declaration of Dr. Houh). Patent Owner opposes Petitioner’s challenge and is supported by the Declaration of Mr. Warner Scheyer. PO Resp. 24–46 (citing Ex. 2001).

*1. Independent Claim 1*

Petitioner's allegations and evidence regarding the unpatentability of claim 1 are persuasive and sufficiently articulate the rationale to support Petitioner's arguments. *See id.* at 21–81. We summarize those allegations and evidence as follows: Petitioner relies on Funk's teachings for the majority of the limitations of claim 1. *See id.* at 36–82. Petitioner asserts that Funk's service processing system 104 teaches the recited electronic message management system. *Id.* at 36–37. Petitioner directs us to two embodiments in Funk that each detail the service processing system. *Id.* at 26–33. In Figure 2, "Service processing System 104 includes an inbound e-mail processor 212, outbound e-mail processor 214, facsimile processor 216, voice response processor 218, and text-to-voice processor 220." Ex. 1006, 6:33–36. Figure 2 also includes a number of databases that along with processors 212–220 are connected to processor system 210. *Id.* at 6:39–40. Processor system 210 receives information and periodically generates a file or list of information to be delivered in an email. *Id.* at 6:40–46. Figure 7 also illustrates service processing system 104. *Id.* at 9:28–29. As depicted in Figure 7, information is retrieved from databases by timing processor 704 and forwarded to e-mail composition processor 706, then it is processed by formatter 708 and then sent to e-mail tracker 710. *Id.* at 9:56–59. According to Petitioner, Figure 7 "expands on the customer profiles, and provides explicit measures for customers to create and maintain profiles via the World-Wide-Web using a customer profile configuration processor 714 that 'allow[s] the customer detailed control over the content, format, and timing of the delivered e-mails.'" Pet. 28–29 (alteration in original) (citing Ex. 1006, 9:30–36, 10:6–17).

Petitioner combines these disclosures into a so-called “‘Funk combined system,’ [in which] Funk’s service processing system 104 in Figure 2 would include processors 704–706, 714, and formatter 708 of Funk’s Figure 7 embodiment, connected to processor system 210. Processors 704–706, 714, formatter 708 would have been implemented as a part of, or connected with, processor system 210, just as processors 212–220 are connected to processor 210 in Figure 2.” Pet. 26–27 (citations omitted).

Petitioner argues that a person of ordinary skill in the art “would have been motivated to combine Funk’s Figures 2 and 7 embodiments to implement the processors 704–706 and formatter 708 to assemble e-mails based on the customer profiles created by each customer.” *Id.* at 29 (citing Ex. 1006, 10:18–67, Ex. 1003 ¶ 82). Petitioner also contends that one of ordinary skill in the art would have combined Figure 2’s databases into a single database (“Funk combined database”) as shown in Figure 7, because the single database configuration would have been simpler, more efficient, and faster. *Id.* at 32. Dr. Houh supports this assertion by opining that the combined database would be an improvement “because rather than having to find and interface with multiple separate databases 200-208, only a single database storing the same information as these multiple databases would have been accessed.” Ex. 1003 ¶ 86.

Finally, Petitioner asserts that the ordinarily skilled artisan “would have been motivated to combine details of both embodiments to retain Funk’s message input and delivery system (the Figure 2 embodiment) while advantageously integrating Funk’s customer profile control (the Figure 7 embodiment).” Pet. 31. We are persuaded by Petitioner’s arguments that such modification would have been within the skill of the ordinarily skilled

artisan, and would have been a predictable combination of known methods. *See id.* at 33.

Petitioner relies on the Funk combined system to teach the recited computer system in communication with a global digital network. *Id.* at 37–38 (discussing limitation 1.1). Petitioner argues that the Funk combined system “connects ‘to the Internet 106 or some other e-mail network,’ allowing access to the ‘world-wide web’ that operates over the Internet.” *Id.* at 41 (citing Ex. 1006, 5:53–58, 1:66–2:1, 10:6–17, Figs. 1, 2, 7; Ex. 1003 ¶ 97). Petitioner also relies on Funk to teach the recited electronic message management database in communication with the computer system. *Id.* at 45–48 (discussing limitation 1.2). Specifically, Petitioner directs us to the Funk combined system’s database(s) that communicate with processor system 210. *Id.* at 47–48. As to the “recipient profile application,” here again Petitioner relies on Funk and more specifically on Funk’s disclosure of customer profile configuration processor 714. *Id.* at 48–52 (discussing limitation 1.3).

As to limitation 1.4, Petitioner contends Funk teaches “the profile data including delivery parameters specified by a recipient of where, when and how specific types of messages from specific messengers are delivered to the recipient.” Pet. 52–60. Petitioner directs us to Funk’s customer configuration file 800, which is used to individually customize email message configuration. *Id.* at 52. Petitioner argues that customer configuration file 800 is modified through the use of profile configuration processor 714. *Id.* As described in Funk, customer configuration file 800 includes fields that specify *delivery parameters* as to *where* communications to a customer should be delivered, such as “e-mail address,” “customer

address,” and “customer phone.” *Id.* at 53. Petitioner argues that customer configuration file 800 includes field 808, which specifies “information relating to the timing information,” where timing information indicates, for example, “when the electronic mailing is to be assembled and delivered.” *Id.* at 55 (citing Ex. 1006, 4:17–18, 10:20–22).

Petitioner further directs us to fields 810 and 812 of customer configuration file 800. According to Petitioner, “[f]ields 810 and 812 specify *delivery parameters* as to how communications to a customer should be delivered because they indicate how these communications should be composed, formatted, and sent.” *Id.* at 58 (citing Ex. 1006, 10:33–67, 11:23–28, 18:3–4, 18:16–29, Fig. 8). As to claim 1’s requirement that the system provide these delivery parameters “for specific types of messengers,” Petitioner argues that Funk allows users to “specify preferences for how types of messages from certain sources [are] received.” *Id.* at 59 (citing Ex. 1006, 10:22–25, 9:31–36, 10:34–46, Ex. 1003 ¶ 121). For example, Funk discloses that “‘the customer’s account information may indicate that information from certain databases should be delivered periodically (e.g., send a weather report every six hours).’” *Id.* at 59 (emphases omitted) (citing Ex. 1006, 10:22–25). According to Petitioner this shows that “Funk describes a *message type* of a ‘weather report’ from a service that provides weather updates (*specific messenger* that is a weather service).” *Id.* at 59–60.

Patent Owner contends that Funk does not teach limitation 1.4. PO Resp. 27–34. In particular, Patent Owner argues (i) Funk does not teach or suggest the limitation pertaining to “specific types of messages from specific messengers.” *Id.* at 28. Patent Owner asserts that the ’920 patent screens

messages based on both content (specific type of messages) and sender (specific messenger). *Id.* at 29. According to Patent Owner, Funk’s configuration file 800 can be said to teach screening based on “‘specific types of messages,’ but does not teach [screening] ‘from specific messengers.’” *Id.* at 28. Patent Owner contends that Funk’s disclosures are insufficient because Funk’s information sources “merely ‘include any source information such as the Associated Press, Reuters News, or the Wall Street Journal.’ The sources 100 are not ‘senders’ and do not send messages to the subscribers.” PO Resp. 48 (quoting Ex. 1006, 5:47–49), Ex. 2001 ¶ 100. In other words, Patent Owner contends the information sources do not disclose the recited messengers because “[t]hey’re not the ones sending the information. They’re not the ones determining where this information should go.” Tr. 21:13–14. Further, Patent Owner argues that Petitioner relies on testimony from Dr. Houh to fill in the gaps of Funk’s teachings and that testimony is both factually incorrect and based on impermissible hindsight from Dr. Houh. *Id.* at 31–32.

Petitioner responds by asserting that Funk discloses third party senders and Funk describes its information sources as senders. Reply 3. We find Petitioner’s arguments to be persuasive. In discussing Figure 7, Funk states

timing processor 704 determines, based on each customer's account information, when to initiate preparation of an e-mail message for delivery. The timing section provides flexible, highly configurable customer control over when and what should be delivered to the customer. For example, the customer’s account information may indicate that information ***from certain databases*** should be delivered periodically (e.g., send a weather report every six hours).

Ex. 1006, 10:18–25 (emphasis added). Dr. Houh opines that this shows that Funk allows a user to “specify preferences for how types of messages from certain sources [are] received.” Ex. 1003 ¶ 121 (citing Ex. 1006, 10:22–25, 9:31–36, 10:34–46). Funk allows users to indicate when and what information “from certain databases” should be delivered to the user. This screening is happening in processor 704, which is part of the Funk combined system on which Petitioner relies. *See* Pet. 25–26; *see also* Ex. 1006, 9:31–33 (“a personal configuration file is created ***containing the information resources that the end-user would like e-mailed*** to his desktop” (emphasis added)).

Petitioner further argues, “Funk’s third parties, the information sources are senders because they provide information (messages) to a central server and those messages are then communicated to recipients.” *Id.* at 5 (citing Pet. 21; Ex. 1006, 5:53–67, Fig. 1, Ex. 1024 ¶ 9). Petitioner argues that this is in accord with the description of messengers in the ’920 patent. *Id.* at 6. “For example, both Funk and the ’920 patent describe indirect communication from sender to recipient via a central system, as shown in Fig. 4 of the ’920 patent.” *Id.*

Petitioner asserts that Funk’s inbound e-mail processor 212 “operates to allow ***parties*** to connect to Funk’s system to leave messages for customers.” Pet. 66 (citing Ex. 1006, 8:30–36, 9:4–6, Fig. 2) (emphasis added); *see also* Pet. 67 n.10 (“Funk discusses information sources 100, customers, and other third parties.”). Petitioner points out that, in Funk, “messages ‘can come from ***several sources***, including ***third parties***.”” Reply 4 (quoting Ex. 1006, 7:6–8). Dr. Houh supports Petitioner by opining that “[t]he ‘parties’ of Funk are senders because they transmit messages to a

system that in turn transmits the messages to recipients including information received from the parties.” Ex. 1024 ¶ 7 (citing Ex. 1006, 8:30–63). As an example of one such third-party sender, Petitioner directs us to Funk’s Figure 3, which includes message field 310. Reply 4. In Figure 3, message field 310 is depicted as containing the following message: “JOHN, PLEASE CALL ME. -DAVE S.” Ex. 1006, Fig. 3.

We find that the example message shown in Figure 3 directly contradicts Patent Owner’s argument that the prior art lacks a disclosure of “identification of specific recipients by specific messengers.” Sur-reply 1–2. Figure 3 indicates that a sender (Dave S.) has specifically identified the recipient of his message (John). Ex. 1006, Fig. 3. Patent Owner also is incorrect in its assertion that the prior art lacks “parameters set by recipients identifying specific messengers.” Sur-reply 2. As Petitioner points out, Funk allows its customers to specify that a particular customer wants to hear from a particular information source at a particular interval. *See* Ex. 1006, 10:18–25 (allowing the user to request a weather report from the weather information source on a periodic basis). We also are unpersuaded by Patent Owner’s argument that the prior art “lacks a plurality of messengers” (Sur-reply 2) as evidenced by Funk’s disclosure of third-party senders and multiple information sources. We also are unpersuaded by Patent Owner’s argument that Dr. Houh’s testimony is incorrect and based on hindsight. According to Patent Owner, Dr. Houh is incorrect in asserting that a system that directs “specific types of messages from specific messengers” was well-known. PO Resp. 31. We find Dr. Houh’s testimony to be well supported by the cited art references. As discussed above, we find there is ample evidence in Funk to support Petitioner and Dr. Houh’s assertions that this

claim limitation was known in the art at the critical date. As such, Patent Owner's arguments and evidence do not overcome Petitioner's showing as to this claim limitation.

As to limitation 1.5, Petitioner contends the combination of Funk and Law teaches this claim limitation. Pet. 60–65. As to the recited messenger profile application, Petitioner relies on Law's disclosure of web server 110. *Id.* at 60. Web server 110 collects message preference data from recipients and makes that information available to senders. *Id.* (citing Ex. 1007, 3:38–43). In addition, web server 110 stores sender profiles that include sender information such as sender ID and sender email address. *Id.* (citing Ex. 1007, 5:19–37). Petitioner argues that one of ordinary skill in the art would have been motivated to enhance the Funk combined system with Law's sender profiles, because the application of this known technique from Law would have improved Funk's system by using Law's sender profiles to help keep track of, organize, and identify senders in Funk. *Id.* at 63 (citing Ex. 1003 ¶ 130). "In the Funk-Law combination, Funk's system would maintain profiles for senders in the Funk combination database, and provide a way for senders to update their profile information, in the same way that Funk already allows customers to have user profiles that the users may update in Funk's system." *Id.* at 64 (citing Ex. 1003 ¶ 130).

Patent Owner argues Petitioner failed to meet its burden with respect to limitation 1.5 because a person of ordinary skill in the art would not have modified Funk in view of Law. PO Resp. 24–25, 34–36. Specifically, Patent Owner argues (i) "Funk is a single sender system to many subscribers/recipients using a single 'service processing system'" while (ii) "Law . . . includes a software system for saving data including sender

identification information from ‘senders’ over the Internet that is used to establish and update multiple sender ‘profiles,’” and (iii) “[t]here is no need in Funk for multiple sender profiles since it uses a single sender, and there is no motivation in Funk or Law to combine Law’s multiple sender profiles application with Funk’s system that only uses a single sender.” *Id.* at 35. That is, “[a person of ordinary skill in the art] would have no motivation to modify Funk with Law’s multiple sender profiles with Funk where such profiles are not necessary nor would even function if combined into the Funk system.” *Id.* at 36.

We are not persuaded by Patent Owner’s arguments. Funk describes “[a] high volume e-mail ‘newspaper’ delivery system.” Ex. 1006, code (57). Funk’s newspaper is created by “manipulat[ing] publicly available information (AP wire service, Reuters, Business Wire, etc.)” and matching that information to a user profile. *Id.* at 1:49–50. These various inputs (information sources 100) all feed into service processing system 104. *Id.* at 5:43–44, Fig. 1. In addition, as we discussed above, Funk also discloses third parties that may send information to the customers. *See* Reply 9. Law’s “information delivery system includes a web server in operative communication with a plurality of recipients and a plurality of senders.” Ex. 1007, code (57). Thus, Law’s web server and Funk’s service processing system both connect multiple information sources to the email system. Law sets out to “improv[e] the collection and dissemination of recipient preferences for messages . . . by collecting recipient preference data and making it available to a plurality of senders for their use in preparing messages intended for a selected recipient.” *Id.* at 2:26–30.

According to Petitioner, “[i]n the Funk-Law combination, Funk’s system would maintain profiles for senders in the Funk combination database, and provide a way for senders to update their profile information, in the same way that Funk already allows customers to have user profiles.” Reply 9–10 (citing Pet. 64, Ex. 1003 ¶ 130, Ex. 1006, 11:29–33). Dr. Houh opines on behalf of Petitioner that one of ordinary skill in the art would have been motivated to “enhance Funk such that the Funk combined processors . . . (1) include[] a software application used to receive sender information including sender identification information from senders via the Internet to establish and update sender profiles, and (2) store[] such sender information in the Funk combination database.” Ex. 1003 ¶ 129. According to Dr. Houh, this would have required the application of a known technique, Funk’s sending messages from parties to customers, by incorporating Law’s sender profiles to help keep track of, organize, and identify senders in Funk. *Id.* ¶ 130. “Funk contemplates a ‘high volume e-mail ‘newspaper’ delivery system’ that parties can use to send emails to customers, but does not provide explicit disclosure on how various parties sending messages would maintain profiles with Funk’s system.” Ex. 1003 ¶ 130. Dr. Houh further opines that “in the combination of Funk and Law, Funk’s system would maintain profiles for sending parties in the Funk combination database, and provide a way for senders to update their profile information, in the same way that Funk already allows customers to have user profiles that the users may update in Funk’s system.” *Id.*

As such, we are persuaded that this modification would have been obvious in light of Law’s teachings. Patent Owner contends that “[t]here is no need in Funk for multiple sender profiles since it uses a single sender, and

there is no motivation in Funk or Law to combine Law’s multiple sender profiles application with Funk’s system that only uses a single sender.” PO Resp. 36. We must, however, be mindful of the Supreme Court’s statement that “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). Petitioner’s asserted modification would allow the existing information sources in Funk to target the impact of their information in a manner similar to the screening provided to users of Funk’s system. Petitioner provides a sufficient rationale to support its assertions that one of ordinary skill in the art would have been motivated to add this functionality to Funk’s system. We are persuaded that Petitioner is correct in asserting that the asserted modification would only require the application of a known method to achieve a predictable result. Pet. 63–65.

As for limitation 1.6, Petitioner directs us to Funk to teach the recited message input application. *Id.* at 65. Specifically, Petitioner directs us to Funk’s inbound e-mail processor 212 and processor system 210, which Petitioner alleges implement a software application that receives message files from senders and stores the files in Funk’s database. *Id.* (citing Ex. 1003 ¶ 133).

As to limitation 1.7, Petitioner directs us to the Funk combined processors including timing processor 704, e-mail composition processor 706, and formatter 708, which are alleged to be software programs that teach the recited individual message generator. *Id.* at 70. Petitioner asserts that Funk teaches the recited “*individual message* because Funk generates ‘individual e-mail messages’ for each individual subscriber (e.g., to that customer’s e-mail address with that customer’s preferences).” *Id.* at 73

(citing Ex. 1006, 8:58–61, 10:56–58, Ex. 1003 ¶ 143); *see also* Ex. 1006, Fig. 3 (example e-mail message). As to the recited “*generat[ing] an individual message to be sent . . . according to the delivery parameters,*” Petitioner contends that Funk’s processors 704–708 collectively generate a message for a recipient, assemble the message, and format the message based Funk’s databases (e.g., customer preferences). *Id.* (citing Ex. 1006, 10:18–58, 5:64–67 (“Service processing system 104 then generates e-mail messages **based on the contents of the databases** [(e.g., the customer preferences)] and feeds those e-mail messages through the Internet 106 to end user terminals 114.” (emphasis added))); Ex. 1003 ¶ 144).

Patent Owner argues Petitioner failed to meet its burden with respect to limitation 1.7 because: (i) although Funk does disclose “the desired recipients of each messenger,” Funk does not disclose the limitation “individual message to be sent to the recipient specified by the messenger according to the delivery parameters” of limitation 1.7, because, as set forth in the limitation 1.4, Funk does not disclose “specific messengers of each recipient,” Funk need not determine sending individual message to the recipient through pairing up “the desired recipients of each messenger” and “specific messengers of each recipient” either; (ii) Law does not remedy the deficiency or Funk. PO Resp. 37–42.

As discussed above, we are not persuaded by Patent Owner’s arguments in regards to limitation 1.4. Petitioner has shown sufficiently that Funk discloses multiple senders through its discussion of third-party sources and information sources. For example, Figure 3 shows an email message from a specific messenger that is sent to a specific recipient and Funk discloses multiple information sources 100 that send information to central

service processing system 104. Pet. 21, Ex. 1006, Figs. 1, 3. As to limitation 1.7 specifically, one of the processors relied upon by Petitioner for this limitation is timing processor 704. Pet. 72. This processor retrieves information from Funk’s database for use in generating an email. *Id.* “[C]omposition processor 706 uses information from the timing processor 704 and the database to determine who receives the message, what is in the message, and how many messages to send.” *Id.* As noted above, we are persuaded that Funk’s processors determine whether information from certain databases should be delivered periodically is sufficient to teach “specific types of messages from specific messengers.” We are similarly persuaded that the cited art teaches or at least suggests the sending of individual messages “to the recipient specified by the messenger.” Ex. 1006, 10:18–25.

We note that the combined Funk-Law system relied upon by Petitioner “would maintain profiles for sending parties in the Funk combination database, and provide a way for senders to update their profile information, in the same way that Funk already allows customers to have user profiles [they] may update.” Ex. 1003 ¶ 130. Patent Owner asserts that this is insufficient because “[t]o the extent that Law discloses information of ‘the desired recipients of each messenger,’ the information is stored in the sender’s computer, not in the server.” PO Resp. 42. Patent Owner notes that Law teaches that “[b]oth recipients 180 and senders 155 provide data to the web server 110. Generally, the recipients 180 may establish their respective recipient preference profiles 190 with the web server 110 . . . [and s]imilarly, the senders 155 may establish their respective sender profiles 195 with the web server 110.” Ex. 1007, 5:45–51 (*cited in* PO Resp. 40). Patent

Owner argues that while server 110 stores send profiles it does not include the information of “the desired recipients of each messenger.” PO Resp. 41–42. That information would instead be stored on the sender’s computer. *Id.* at 42. Patent Owner also contends that “pairing up ‘the desired recipients of each messenger’ and ‘specific messengers of each recipient’ of the message, and then generating an individual message to be sent to the recipient specified by the messenger is performed by the server in the ’920 Patent, while performed by the sender in Law.” *Id.* (citing Ex. 2001 ¶ 93).

Patent Owner is taking an improperly narrow view of Petitioner’s challenges, not based on arguments relating to the combination of Funk and Law as a whole. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”). Petitioner asserts that its proposed combination would modify the Funk combined processors, which exist on the processing system, and not the end user terminals. *See* Pet. 63; *see also* Ex. 1006, Fig. 1 (depicting the service processing system as connecting to the end user terminals via the internet). Thus, in reading the disclosures of these references together, we are persuaded that one of ordinary skill in the art would have been motivated to modify Funk’s system to include sender profiles that could be used to screen messages in a manner consistent with the screening that is already provided by Funk’s system for recipient profiles. Therefore, we are persuaded by Petitioner’s arguments and determine that Patent Owner’s assertions have not overcome Petitioner’s arguments and evidence.

As to limitation 1.8, Petitioner relies on Funk to teach the recited message management server operating system. Pet. 74–76. Specifically, Petitioner asserts that a person of ordinary skill in the art “would have understood the Funk combined processors would similarly implement [] a generic and well-known operating system, e.g., Microsoft Windows, forming a message management server operating system because the Funk combined processors are implemented by a computer that manages the communication of messages.” *Id.* at 74–75 (citing Ex. 1003 ¶ 147) (emphasis omitted).

Petitioner argues the combination of Funk and Law teaches limitation 1.9. Pet. 76–82. Petitioner relies on Funk’s configuration profile (recipient profile) and Law’s sender profile (messenger profile) and related databases. *Id.* at 76–81. Specifically, Petitioner argues that the Funk combination database teaches the recited message management database. *Id.* at 76. Petitioner relies on Funk’s message database 208 to teach the recited message database for storing message data files. *Id.* at 81–82. According to Petitioner, “[t]he Funk combination database ‘stores, for each customer, a personal configuration file including fields describing each customer’s desired electronic message configuration,’ which includes the customer account information provided by customers.” *Id.* at 78. Funk’s customer database 200 is relied upon to teach the recited recipient profile database. *Id.* at 77 (citing Ex. 1006, Fig. 2; Ex. 1003 ¶ 154). Funk’s source information database 202, as modified by Law, is relied upon to teach the recited messenger profile database. *Id.* at 79 (citing Ex. 1006, Fig. 2, Ex. 1007, 3:31–43, 5:19–37, Ex. 1003 ¶ 156).

Patent Owner argues Petitioner has failed to meet its burden with respect to limitation 1.9 because “a [person of ordinary skill in the art] would never have been motivated to modify Funk with Law without the knowledge of the ’920 Patent.” PO Resp. 43–46. In particular, Patent Owner argues there “would be no motivation for a [person of ordinary skill in the art] to modify Funk with Law, which includes a software system for saving data including sender identification information from ‘senders’ over the Internet that is used to establish and update multiple sender ‘profiles,’” because (i) Funk discloses a single sender, and (ii) “[t]here is no need in Funk for multiple sender profiles since it uses a single sender, and there is no motivation in Funk or Law to combine Law’s multiple sender profiles application with Funk’s system that only uses a single sender.” *Id.* at 44. Patent Owner further argues that “[e]ven if [Funk and Law were] combined, the senders in Law control the messaging to the receivers and would not store message data files needed in the claim limitation 1.9 since the data is recipient’s data of the types of messages from specific messengers.” *Id.* at 44–45.

These arguments are substantially similar to the arguments addressed above in regards to limitation 1.5 and we find these arguments to be unavailing for the reasons articulated above as to limitation 1.5.

Accordingly, upon consideration of Petitioner’s contentions and supporting evidence, and Patent Owner’s arguments and supporting evidence, we are persuaded by Petitioner’s showing and find that Petitioner has demonstrated by a preponderance of the evidence that the limitations recited in independent claim 1 would have been obvious over Funk and Law. *See* Pet. 36–82.

## *2. Dependent Claims 14–17*

Petitioner accounts for the limitations recited in claims 14–17. Pet. 82–86. Petitioner provides detailed explanations as to how the prior art combination teaches or suggests these remaining limitations and claims, citing Dr. Houh’s testimony for support. *Id.* (citing Ex. 1003). Patent Owner does not provide any arguments regarding claims 14–17 outside of the arguments advanced against claim 1. PO Resp. 46.

Having reviewed Petitioner’s arguments and supporting evidence, we find that Petitioner has demonstrated by a preponderance of the evidence that claims 14–17 are unpatentable over the combined teachings of Funk and Law.

### *E. Obviousness over Funk and Kamakura*

Petitioner asserts that claims 1 and 14–17 are unpatentable under 35 U.S.C. § 103 as obvious over Funk and Kamakura, citing the Declaration of Dr. Houh for support. Pet. 86–96 (citing Ex. 1003); *see also* Ex. 1024 (Supplemental Declaration of Dr. Houh). Patent Owner opposes Petitioner’s challenge and is supported by the Declaration of Mr. Scheyer. PO Resp. 46–52 (citing Ex. 2001).

#### *1. Independent Claim 1*

With the exception of limitations 1.5 and 1.9, Petitioner relies on the same arguments and evidence as discussed above in regards to claim 1 as obvious over Funk and Law. *Id.* at 86. We focus our discussion here on the points of distinction between the Funk and Law and Funk and Kamakura grounds.

Petitioner contends the combination of Funk and Kamakura teaches limitation 1.5. Pet. 88–94. Petitioner relies on Kamakura’s teachings

regarding the recited messenger profile application. *See id.* Specifically, Petitioner directs us to Kamakura’s sender terminals that register their sender profile with a distribution host computer. *Id.* at 89. According to Petitioner, Kamakura’s sender profile includes data such as the name of the sender, and the sender’s address, telephone number, and fax number. *Id.* (citing Ex. 1008, Fig. 17; Ex. 1003 ¶ 179). Petitioner argues

[a person of ordinary skill in the art] would have been motivated to modify Funk to incorporate Kamakura’s sender profiles because it would have been the use of a known technique (Kamakura’s sender profiles for those sending messages) to improve similar devices (Funk’s similar system for sending messages from parties to customers) in the same way (by incorporating Kamakura’s sender profiles to help keep track of, organize, and identify senders in Funk).

*Id.* at 91 (citing Ex. 1003 ¶ 181). Further, Petitioner asserts that, in “the Funk-Kamakura combination, Funk’s system would maintain profiles for sending parties and provide a way for them to update their information, in the same way that Funk already allows customers to have user profiles that the users may update in Funk’s system.” *Id.* at 92 (citing Ex. 1003 ¶ 181). Petitioner argues that one of ordinary skill in the art would have been able to combine these systems “because Funk and Kamakura are similar software systems for managing mass messages, and Funk already contemplates a parallel disclosure (customer profiles) akin to the disclosure in Kamakura (sender profiles).” *Id.* at 92 (citing Ex. 1003 ¶ 181).

As to limitation 1.9, Petitioner relies on Funk’s source information database 202, modified by Kamakura to teach the recited “messenger profile database for storing . . . messenger profile data.” *Id.* at 94 (citing Ex. 1006, Fig. 2; Ex. 1003 ¶ 188). Petitioner asserts that Funk’s source information database 202 contains information provided by information source 100 that

includes “any source of information,” e.g., news. *Id.* at 95 (citing Ex. 1006, 7:43–51, 5:47–49; Ex. 1003 ¶ 189). According to Petitioner, a person of ordinary skill in the art would have modified Funk to include Kamakura’s sender profile 32 in order to associate parties with the information they send and to maintain party profiles in source information database 202. *Id.* (citing Ex. 1003 ¶ 189).

Patent Owner reiterates its arguments regarding the disclosures of Funk that were addressed above in regards to the Funk and Law ground. *See* PO. Resp. 46. We find these arguments to be unavailing for the same reasons discussed above.

As to limitations 1.5 and 1.9<sup>6</sup>, Patent Owner argues that Petitioner’s allegations fail because one of ordinary skill in the art would not have been motivated to modify Funk with Kamakura. *Id.* at 47–49, 51–52. Patent Owner asserts that Funk is a single-to-many customer service management system, and there are no contemplated “sending parties” in Funk; and no person of ordinary skill would modify Funk with profiles for sending parties from Kamakura, as there are no sending parties in Funk, nor are any contemplated. *Id.* at 47–49. Similarly, for limitation 1.9, Patent Owner argues “there would be no reason or motivation to include a messenger profile database in Funk, since Funk has only one sender and does not contemplate multiple senders.” *Id.* at 52.

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<sup>6</sup> Patent Owner also argues that Kamakura does not teach limitations 1.4 and 1.7 (PO Resp. 46–51), but Petitioner only relies on Funk for these limitations. *See* Pet. 52, 70, 86. We are persuaded by the sufficiency of Petitioner’s arguments as to limitations 1.4 and 1.7 for the same reasons articulated above in regards to the Funk and Law ground.

We are not persuaded by Patent Owner's arguments and we are persuaded that Petitioner has shown sufficiently that the disputed limitations are taught by the combined Funk-Kamakura system.

Petitioner argues "Kamakura provides further teachings on how an information delivery system would maintain profiles for both recipients and senders." Reply 13 (citing Pet. 92, Ex. 1008, 7:14–17, Fig. 17; Ex. 1003 ¶ 181). Kamakura discusses the rise of mass marketing direct email systems. Ex. 1008, 1:15–21. It describes a problem in the art in which senders "almost unconditionally send[] advertisements to all subscribers," noting that many users may receive advertisements that they are not interested in; as such, the success rate for these campaigns is very low. *Id.* at 1:28–35. Kamakura describes a system with a plurality of sender and receiver terminals connected to a communication network. *Id.* at 5:52–55. Senders register their profiles with the system and then distribute advertisements. Pet. 89 (citing Ex. 1008, 7:14–17, Fig. 17, Ex. 1003 ¶ 179).

Funk's system aggregates input from information sources 100 and uses that information to create an email message to a user. Pet. 90. Patent Owner argues that Petitioner fails to provide any reason to explain why Funk would benefit from the proposed combination. Sur-reply 5. Petitioner, however, argues that one of ordinary skill in the art would have modified Funk to include Kamakura's sender profiles because this modification would have allowed Funk's system "to associate information sources with the information they provide and store in source information database 202." Pet. 91 (citing Ex. 1003 ¶ 180); Reply 13. Dr. Houh supports Petitioner's position and opines that "in the Funk-Kamakura combination, Funk's system would maintain profiles for sending parties and provide a way for them to

update their information, in the same way that Funk already allows customers to have user profiles that the users may update in Funk's system." Ex. 1003 ¶ 181.

Patent Owner further argues that this proposed combination would be contrary to Funk's stated objective of "allow[ing] a user to passively receive unique, customized personal information via e-mail and/or facsimile machine." Sur-reply 5 (quoting Ex. 1006, 3:25–28). We are not persuaded that the inclusion of sender profiles would alter the user's experience in a manner that should be characterized as "active." The addition of sender profiles does not require additional interventions by the user so it is unclear what would cause the user to no longer be able to passively receive customized information. Patent Owner also argues that the inclusion of sender profiles would cause a "random inundation of the customers inbox." *Id.* We also find this argument to be unpersuasive. We find allowing the sender to have specificity as to who its intended audience would be is the opposite of a random inundation. We are persuaded that Petitioner has provided a sufficient rationale to support its proffered modification. Patent Owner's arguments to the contrary do not outweigh the showing made by Petitioner.

Petitioner has provided sufficient evidence and argument to persuade us that claim 1 would have been obvious over the teachings of Funk and Kamakura. Accordingly, we determine Petitioner has demonstrated by a preponderance of the evidence that independent claim 1 is unpatentable over the combination of Funk and Kamakura.

## 2. *Dependent Claims 14–17*

Petitioner accounts for the limitations recited in claims 14–17 by relying on the showing provided with respect to Ground 1 regarding the teachings of Funk. *See* Pet. 86. Patent Owner does not provide any arguments regarding claims 14–17 outside of the arguments advanced against claim 1. PO Resp. 52.

Having reviewed Petitioner’s arguments and supporting evidence, we find that Petitioner has demonstrated by a preponderance of the evidence that claims 14–17 are unpatentable over the combined teachings of Funk and Kamakura.

## III. CONCLUSION<sup>7</sup>

Based on the evidence presented with the Petition, the evidence introduced during the trial, and the parties’ respective arguments, Petitioner

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<sup>7</sup> Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. §§ 42.8(a)(3), (b)(2).

has shown by a preponderance of the evidence that each of claims 1 and 14–17 of the '920 patent are unpatentable.

In summary:

| <b>Claim(s)</b>            | <b>35 U.S.C. §</b> | <b>References/<br/>Basis</b> | <b>Claims Shown<br/>Unpatentable</b> | <b>Claims Not Shown<br/>Unpatentable</b> |
|----------------------------|--------------------|------------------------------|--------------------------------------|------------------------------------------|
| 1, 14–17                   | 103                | Funk, Law                    | 1, 14–17                             |                                          |
| 1, 14–17                   | 103                | Funk,<br>Kamakura            | 1, 14–17                             |                                          |
| <b>Overall<br/>Outcome</b> |                    |                              | 1, 14–17                             |                                          |

#### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner has established by a preponderance of the evidence that claims 1 and 14–17 of the '920 patent are unpatentable; and

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

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