

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Oracle Corporation,
Petitioner

v.

Peter Pedersen,
Patent Owner

Case No. IPR2023-00867
Patent No. 6,965,920

Petition for *Inter Partes* Review

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LIST OF EXHIBITS

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1001	U.S. Patent No. 6,965,920 to Pedersen
1002	File History of U.S. Patent No. 6,965,920
1003	Declaration of Dr. David Martin
1004	Curriculum Vitae of Dr. David Martin
1005	U.S. Patent No. 7,058,586 to Law (“Law586”)
1006	U.S. Patent No. 6,690,773 to Law (“Law773”)
1007	U.S. Patent No. 7,072,845 to Law (“Law845”)
1008	Complaint (Dkt. No. 1) filed in <i>Pedersen v. Oracle Corporation</i> , No. 6:22-cv-00410 (W.D. Tex.), with Exhibits A-B thereto
1009	U.S. Patent No. 6,047,310 to Kamakura (“Kamakura”)
1010	U.S. Patent No. 6,711,682 to Capps (“Capps”)
1011	Greenspun, Philip, <i>Philip and Alex’s Guide to web Publishing</i> (1999)
1012	Raggett, Dave, et al., Raggett on HTML 4, Second Edition (1998) (“Raggett”)
1013	Hughes, Lawrence E, <i>Internet E-mail: protocols, standards, and implementation</i> (1998)
1014	U.S. Patent No. 5,765,033 to Miloslavsky
1015	U.S. Patent No. 6,182,118 to Finney
1016	U.S. Patent No. 6,463,462 to Smith (“Smith”)
1017	Alan R. Neibauer, <i>Running Microsoft Outlook 2000</i> (1999)
1018	U.S. Patent No. 5,805,810 to Maxwell
1019	U.S. Patent No. 6,498,835 to Skladman
1020	Webster’s New World Dictionary of Computer Terms, 6th Ed. (1997)
1021	Microsoft Computer Dictionary Fourth Edition (1999)
1022	U.S. Patent No. 6,282,565 to Shaw
1023	Gordon Padwick, <i>Using Microsoft Outlook 2000</i> (1999) (“Padwick”)
1024	Docket for District Court Case Filed Against Petitioner
1025	Article titled “District Court Trial Dates Tend to Slip After PTAB Discretionary Denials” (July 24, 2020)
1026	Article titled “How reliable are trial dates relied on by the PTAB in the Fintiv analysis?” (October 29, 2021)

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1027	Statistics from DocketNavigator showing active cases before Judge Albright of the U.S. District Court for the Western District of Texas (as of April 20, 2023)
1028	U.S. District Court’s – Federal Case Management Statistics – Comparison of Districts, dated December 31, 2022 (available at https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distprofile1231.2022.pdf)
1029	Kent Joshi, <i>Special Edition Using Microsoft Exchange Server 5.5</i> (1997) (“Joshi”)
1030	Microsoft Corporation, <i>Getting Started—Microsoft Exchange Server Version 5.5</i> (1997).
1031	Microsoft Exchange Server, Enterprise Edition, Version 5.5 (1997) (software distribution).
1032	D. Crocker, <i>Request for Comments 822: Standard for the Format of ARPA Internet Text Messages</i> (Aug. 1982) (“RFC 822”)
1033	N. Freed et al., <i>Request for Comments 2045 (“Multipurpose Internet Mail Extensions (MIME) Part One: Format of Internet Message Bodies”)</i> (November 1996) (“RFC 2045”)
1034	N. Freed et al., <i>Request for Comments 2046 (“Multipurpose Internet Mail Extensions (MIME) Part Two: Media Types”)</i> (November 1996) (“RFC 2046”)
1035	U.S. Patent No. 6,438,584 to Powers
1036	U.S. Patent No. 6,360,221 to Gough
1037	A. Bestavros, M. Crovella, J. Liu, and D. Martin, <i>Distributed Packet Rewriting and its Application to Scalable Server Architectures</i> , Proceedings of the 1998 International Conference on Network Protocols, October 1998

LISTING OF CLAIMS

Claim Element	Claim Language
1[pre]	“An electronic message management system comprising:”
1[a]	“an electronic computer system in operative communication with a global digital communications network, and an electronic message management database in operative communication with the computer system; the electronic computer system having”
1[b]	“a recipient profile application for receiving recipient profile data from recipients via the global network and storing the recipient data in the database, 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[c]	“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[d]	“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[e]	“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,
1[f]	“and a message management server operating system; and”
1[g]	“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.”
2	“The electronic message management system of claim 1, wherein the recipient profile application includes a global network interactive recipient profile input form, the recipient profile input form being accessible to a recipient computer via the global digital communications network.”
3	“The electronic message management system of claim 1, wherein the messenger profile application includes a global network interactive messenger profile input form, the messenger profile

Claim Element	Claim Language
	input form being accessible to a messenger computer via the global digital communications network.”
4	“The electronic message management system of claim 1, wherein the message input application includes an interactive global network message input form, the message input form being accessible to a messenger computer via the global communications network.”
5	“The electronic message management system of claim 1, wherein the recipient profile application further comprises a network interface and a recipient profile editor for receiving recipient profile data from a recipient computer via the global network interface and for manipulating the recipient profile database to store the recipient profile data.”
6	“The electronic message management system of claim 1, wherein the messenger profile application further comprises a global network interface and a messenger profile editor for receiving messenger profile data from a messenger computer via the global network interface and for manipulating the messenger profile database to store the messenger profile data.”
7	“The electronic message management system of claim 1, wherein the message input application further comprises a global network interface and a message data file editor for receiving a message file data from a messenger computer via the global network interface and for manipulating the message database to store the message data file.”
8[pre]	“A method of inputting data into the message management system of claim 1 from client computers via a global communications network, to centrally manage the distribution and delivery format of electronic messages from multiple messenger sources to multiple individual recipients, comprising the steps of:”
8[a]	“providing the client computers with access to the message management system via a global communications network, where the client computers are messenger and recipient computers;”
8[b]	“receiving a connectivity request from a client computer for access to the message management system to input data;”
8[c]	“connecting the client computer to the message management system via the global communication network;”

Claim Element	Claim Language
8[d]	“prompting the client computer for the data to be input by providing a data input form to the client computer; and”
8[e]	“accepting input data from the client computer and entering the input data into an electronic message management database of the message management system.”
9	“The method of claim 8, wherein the prompting step includes providing an input form to the client computer.”
10	“The method of claim 8, wherein the prompting step includes providing an input form to the client computer, the input form being at least one input form selected from the group consisting of a recipient profile form, a messenger profile form, and a message input form.”
11	“The method of claim 8, wherein the accepting step includes entering the input data into an electronic message management database comprising a recipient profile database, a messenger profile database, and a message database.”
14	“The electronic message management system of claim 1, wherein the individual message generator communicates with the database to identify messages and messenger parameters that are compatible with a recipient profile, and to configure the messages for delivery to the recipient.”
15	“The electronic message management system of claim 1, wherein the individual message generator generates and sends the individual message via a means selected from the group consisting of; electronic mail, voice telephone, facsimile transmission, and digital transmission.”
16	“The electronic message management system of claim 1, wherein the individual message generator generates the individual message and sends the individual message via a means selected from the group consisting of an electronic means and a hardcopy means.”
17	“The electronic message generator system of claim 16, wherein the individual message generator generates the individual message and sends the individual message via an electronic means selected from the group consisting of electronic mail, voice telephone, facsimile transmission, digital transmission, computer network, voice mail, SMS, telex, and wireless transmission.”

Claim Element	Claim Language
18	“The electronic message generator system of claim 16, wherein the individual message generator generates the individual message and sends the individual message via a hardcopy means selected from the group consisting of paper media, magnetic media, and optical media.”

Oracle Corporation (“Petitioner”) requests *inter partes* review of claims 1-11 and 14-18 of U.S. Patent No. 6,965,920 (EX1001, “the ’920 patent”), currently assigned—per Patent Office records—to Peter Pedersen (“Patent Owner”). There is a reasonable likelihood Petitioner will prevail on at least one challenged claim.

I. Introduction

The ’920 patent is directed to an electronic message management system for rule-based delivery of emails over the Internet from messengers (senders) to recipients using, for example, recipient-specified delivery parameters.

As explained below and in the declaration of Dr. Martin (EX1003), there is nothing novel or non-obvious about the electronic message management system as claimed. The ’920 patent discloses only conventional computer systems and components (including databases and applications) communicating over the Internet using conventional e-mail and web browsers and servers. The claimed rules and concepts were well known in the prior art. The challenged claims are obvious in view of the grounds presented herein.

II. Mandatory Notices (37 C.F.R. §42.8)

A. Real Parties in Interest (37 C.F.R. §42.8(b)(1))

Petitioner is the sole real party in interest.

B. Related Matters (37 C.F.R. §42.8(b)(2))

The '920 patent has been asserted by Patent Owner against Petitioner in *Pedersen v. Oracle Corporation*, Case No. 6:22-cv-00410-ADA, pending in the U.S. District Court for the Western District of Texas. Patent Owner has also asserted the '920 patent in the following cases: *Pedersen v. Google LLC*, Case No. 6-21-cv-01152 (W.D. Tex. 2021); *Pedersen v. Mailgun Technologies, Inc.*, Case No. 6-21-cv-01153 (W.D. Tex. 2021); *Pedersen v. Microsoft Corporation*, Case No. 6-21-cv-01154 (W.D. Tex. 2021); *Pedersen v. J2 Global, Inc.*, Case No. 6-21-cv-01155 (W.D. Tex. 2021); *Pedersen v. Yahoo! Inc.*, Case No. 6-21-cv-01308 (W.D. Tex. 2021); *Pedersen v. Zoho Corporation*, Case No. 6-22-cv-00408 (W.D. Tex. 2022); *Pedersen v. Salesforce.com Inc.*, Case No. 6-22-cv-00409 (W.D. Tex. 2022); *Pedersen v. Adobe Inc.*, Case No. 6-22-cv-00583 (W.D. Tex. 2022); *Pedersen v. Aurea Software, Inc.*, Case No. 6-22-cv-00584 (W.D. Tex. 2022); *Pedersen v. Intuit, Inc.*, Case No. 6-22-cv-00588 (W.D. Tex. 2022); *Pedersen v. Madwire, LLC*, Case No. 6-22-cv-00590 (W.D. Tex. 2022); *Pedersen v. SAP America, Inc.*, Case No. 6-22-cv-00591 (W.D. Tex. 2022); *Pedersen v. Upland Software, Inc.*, Case No. 6-22-cv-00594 (W.D. Tex. 2022); *Pedersen v. Ziff Davis, Inc.*, Case

No. 6-22-cv-00597 (W.D. Tex. 2022); *SAP America Inc. v. Pedersen*, Case No. 3-22-cv-01534 (N.D. Tex. 2022); *Pedersen v. Blackbaud, Inc.*, Case No. 6-22-cv-00921 (W.D. Tex. 2022); *Pedersen v. Constant Contact, Inc.*, Case No. 6-22-cv-00922 (W.D. Tex. 2022); *Pedersen v. Monday.com, Inc.*, Case No. 6-22-cv-00923 (W.D. Tex. 2022); *Pedersen v. Wix.com, Inc.*, Case No. 6-22-cv-00925 (W.D. Tex. 2022); *Pedersen v. Zendesk, Inc.*, Case No. 6-22-cv-00927 (W.D. Tex. 2022); and *Pedersen v. Zoho Corporation*, 1-23-cv-00071 (W.D. Tex. 2022).

A petition for *inter partes* review challenging the '920 patent, IPR No. 2023-00029, was filed on October 14, 2022, by Unified Patents, LLC and is currently pending.

C. Counsel and Service Information (37 C.F.R. §§42.8(b)(3)-(4))

Petitioner designates the following lead and back-up counsel:

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Petitioner authorizes service at the above-listed email addresses.

III. Requirements for *Inter Partes* Review (37 C.F.R. §42.104)

A. Grounds for Standing (37 C.F.R. §42.104(a))

Petitioner certifies that the '920 patent is available for IPR, and that Petitioner is not barred or estopped from requesting an IPR challenging the claims on the identified grounds.

B. Identification of Challenge (37 C.F.R. §42.104(b)(1)-(2)) and Relief Requested (37 C.F.R. §42.22(a)(1))

Petitioner requests the Board institute IPR because the challenged claims are obvious under pre-AIA 35 U.S.C. §103 on the following grounds:

Ground	Prior Art	Claims Challenged
1	U.S. Patent No. 7,058,586 (“Law586”) in view of <i>Special Edition Using Microsoft Exchange Server 5.5</i> (“Joshi”)	1-11, 14-18
2	U.S. Patent No. 6,463,462 (“Smith”) in view of <i>Using Microsoft Outlook 2000</i> (“Padwick”)	1-11, 14-17

IV. Relevant Information Concerning the Contested Patent

A. Overview of the '920 Patent

The '920 patent “relates generally to the field of [electronic] messaging,” EX1001, Cover Page, 1:11-25, and purports to solve the “spam” email problem and allow organizations to communicate with customers more efficiently and effectively, EX1001, 1:31-2:6.

The '920 patent admits that rule-based systems for managing email delivery were known, including U.S. Patent Nos. 5,765,033 (EX1014) and 6,182,118 (EX1015), but states that “it would be beneficial to have an electronic message management system where each individual recipient could access a rule set and maintain the parameters of his/her own profile, thus enabling each recipient to designate specific or classes of messengers from whom they are willing to receive a message, and to specify how the information or messages are to be delivered.” EX1001, 2:7-42.

Figure 1 shows the basic architecture, with “several [client] computer systems 20, 22, 40-43 coupled together through **network 11**, such as a LAN, WAN, or a global communications network, such as the World Wide Web or

Internet.” EX1001, 5:3-23.¹ The patent discloses that the “client computer system[s]... typically obtain access to the **Internet 11**” which “allow[s] a user of a client computer system[] to exchange information, receive and send e-mails, and view documents such as documents prepared in HTML format,” and that the client computers can be any known computer such as “a personal computer,” “a personal digital assistant” or “other such computer systems.” EX1001, 5:3-57, 7:13-41 (describing conventional computers). Per the patent, “[t]hese documents are provided by **web servers 14**” “which operate[] as a server computer system and [are] configured to operate with the protocols of the World Wide Web, and [are] coupled with the **Internet 11**.” EX1001, 5:21-31. “[A] **web server 14** [is] coupled to a **server computer system 15** which is itself coupled to **web content 16**, which is a form of a media database.” EX1001, 5:31-40. “It is to be appreciated that while two computer systems 14 and 15 are shown in FIG. 1, web server 14 and server computer system 15 can be one computer system having different software components, one providing web server 14 functionality and another providing server 15 functionality.” EX1001, 5:40-45. “[W]eb server 14 may be a conventional computer system.”

¹ Unless otherwise specified, all coloring and emphasis has been added.

EX1001, 6:15-16. “[M]essage management server 50” in one embodiment “is at least [partly] comprised of the server computer system 15 and database 16 of FIG. 1.” EX1001, 6:17-23.

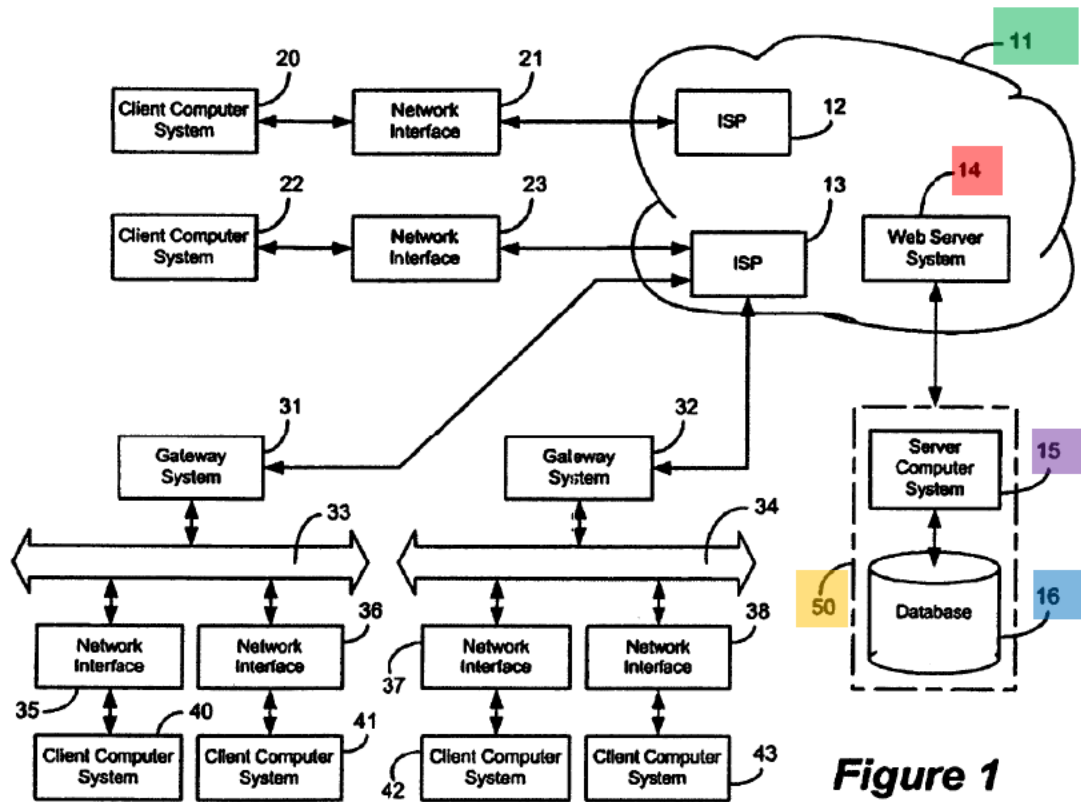


Figure 1

Figure 2 details message management server 50 “includ[ing]... profile database 56 for centrally storing profile and other information received from messengers and recipients, and from other users,” and “message database 57 for centrally storing messages received from messenger client computer systems.” EX1001, 6:22-32. Server 50 includes well-known and conventional “software profile applications” with “input forms” that include fields displayed on the conventional “web page” such that information can be

inputted (including recipient profile, messenger profile, and messages), as well as an individual message generator 54 to generate messages. EX1001, 6:33-67.

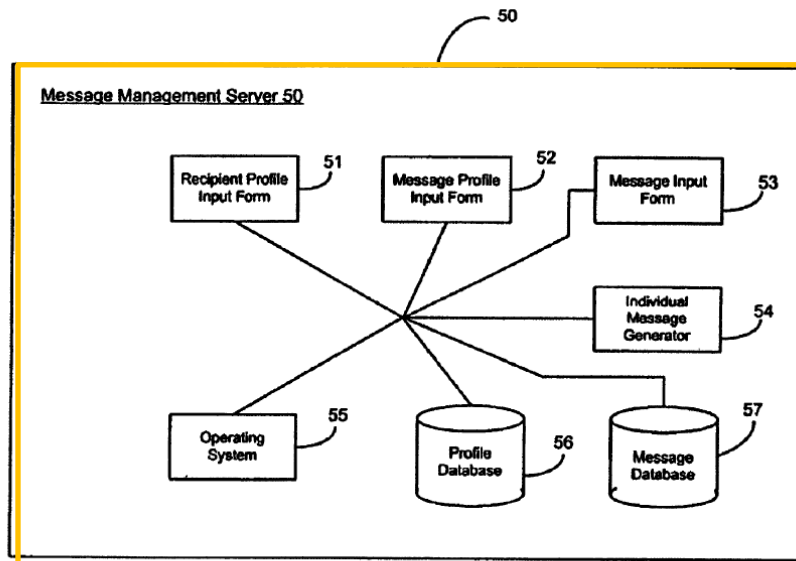
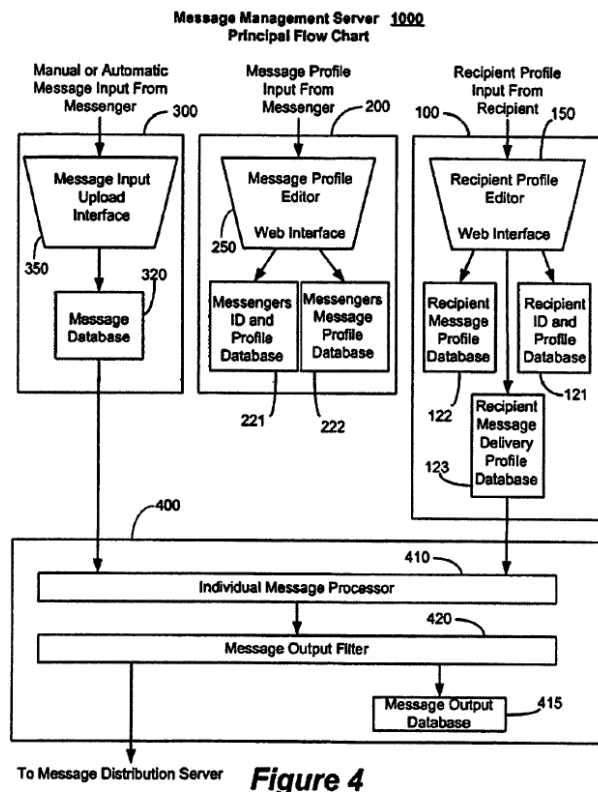


Fig. 2

Figure 4 discloses “the overall principle” of the management server, with “recipient profile system 100 for entering, managing and storing rules,” using a “web interface feature” such as a conventional “Web site (HTML document) accessed by the recipient via a web browser or similar application,” a similar “messengers profile system 200 [that] allows a messenger... to maintain his/her own basic identification information and messenger profile data from a messenger computer,” and “message input system 300” for “enter[ing] messages for the purpose of having them distributed to recipients

according to their individual specified recipient message profiles.” EX1001, 7:42-8:58.



To implement its rule-based delivery system, the patent relies upon conventional and well-known computers and components (such as databases, operating systems, and file management systems store in memory) communicating over the Internet using conventional email protocols and web browsers. EX1001, 5:2-6:16, 7:1-12, FIGs. 1-2; EX1003 ¶¶29-50.

B. Overview of the '920 Patent Prosecution History

In response to an examiner rejection of application claim 1 as being anticipated by U.S. Patent No. 6,047,310 (EX1009, “Kamakura”) and

application claims 2-23 as being obvious over Kamakura in view of U.S. Patent No. 6,711,682 (EX1010, “Capps”), the applicant incorporated the limitations of application dependent claims 2-4 into independent claim 1. EX1002, 95-96.

The applicant argued that neither reference “enables the receiver to designate ‘where, when and how’ specific types of messages from a sender/messenger are to be sorted for delivery to the receiver/recipient.” EX1002, 103. The applicant also argued that the combination did not teach “generat[ing] an individual message to be sent to the recipient *specified* by a messenger” and rather, “in a combination of Kamakura and Capps (even if successfully combined) the sender transmits its message to the apparatus; it is the apparatus that designates the receiver of the message.” EX1002, 104 (emphasis in original). In other words, the applicant’s basis for distinguishing the claims focused on the rules, and not the (generic) architecture, of the claimed invention.

The examiner allowed the then-pending claims without comment. EX1002, 120-23.

C. Person of Ordinary Skill in the Art

Several factors may be considered. M.P.E.P. §2141.03. Here, the level of skill is apparent from the cited art. *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995).

Petitioner submits that a person of ordinary skill in the art (“POSA”) would have had at least a B.S. in computer science or a related field, and would have had at least 2 years of experience working with web sites or other internet-based communications. EX1003 ¶¶24-26.¹

This description is approximate—a higher education or skill level might make up for less experience, and vice-versa. EX1003 ¶26.

D. Claim Construction (37 C.F.R. §42.104(b)(3))

This Petition construes terms consistent with the understanding a POSA would have had at the time of the invention in view of the ’920 patent’s intrinsic evidence and, where appropriate, extrinsic evidence. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005).

¹ Declaration of Dr. David Martin, an expert in computers and communication technology. EX1003 ¶¶8-16; EX1004.

As shown herein, the prior art teaches and renders obvious the challenged claims under any reasonable construction. Any implicit constructions derived from Petitioner’s analysis of the prior art are for the purposes of this IPR only, and may be based in-part on Patent Owner’s infringement allegations. For example, numerous limitations require various “databases,” and those databases are construed in accordance with the data they contain. EX1003 ¶¶41-47, 69-72. The “message type” is similarly construed to describe message characterizations. EX1003 ¶¶48-50.

V. The Specific Grounds of Unpatentability

As evidenced by the prior art and Dr. Martin’s declaration (EX1003), there was nothing new or novel about an email management system that relies on conventional computers and components to enable senders and receivers of email to specify certain delivery parameters. The prior art teaches the claimed configurations, and a POSA would have found obvious the claims.

A. Prior Art

1. Law586

Law586 was filed June 6, 2000 and issued June 6, 2006. EX1005, Cover Page. It is prior art under §102(e).

Law586 relates to “information delivery systems” where a recipient can “control various aspects of the messages techniques for ensuring that the senders have access to updated recipient preferences.” EX1005, Abstract,

1:19-20. In Law586, web server 110 “collects message preference data from recipients 180 and makes it available to the senders 155 so that the senders 155 may more efficiently and effectively communicate their messages to the recipients 180.” EX1005, 3:38-43.

This “message preference data” is in the form of a “recipient profile,” which is created by the recipient via a web browser and enables recipients to “receive messages if they want them, in the format they want, when they want and where they want.” EX1005, 2:31-43, 5:67-6:2, 6:56-7:8. The sender likewise creates a profile. EX1005, 2:31-43. Both profiles, along with an intended message, are sent to a centralized server. EX1005, 2:38-43, 5:45-52, FIG. 4. Senders use the recipient profiles both to learn how recipients desire to be communicated with, EX1005, 5:57-59, and to decide which recipients to send messages to, EX1005, 6:21-30. Law586 discloses senders using various message systems, including, for example, e-mail. EX1005, 3:61-4:7, 5:19-29, 6:37-42. Using the sender profiles, the web server 110 may also send e-mail to the senders, as in Figure 4. EX1005, FIG. 4, 5:19-27.

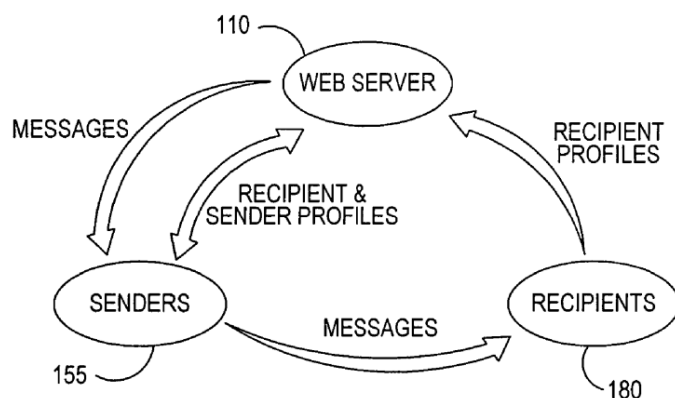


FIG. 4

Like the '920 patent, Law586 discloses that “web server 110” may be “any computer system” that includes, or is “operatively connected to,” a memory, such as a “database server.” EX1005, 3:33-4:19. The database server stores “a plurality of recipient preference profiles corresponding to the plurality of recipients,” where these profiles “define various parameters intended to control aspects of messages sent by the senders... that are intended for the recipient.” EX1005, 4:17-24, FIG. 2. Law586 also discloses a “plurality of sender profiles corresponding to the plurality of senders,” including an identifier and email address. EX1005, 5:19-55, FIG. 3.

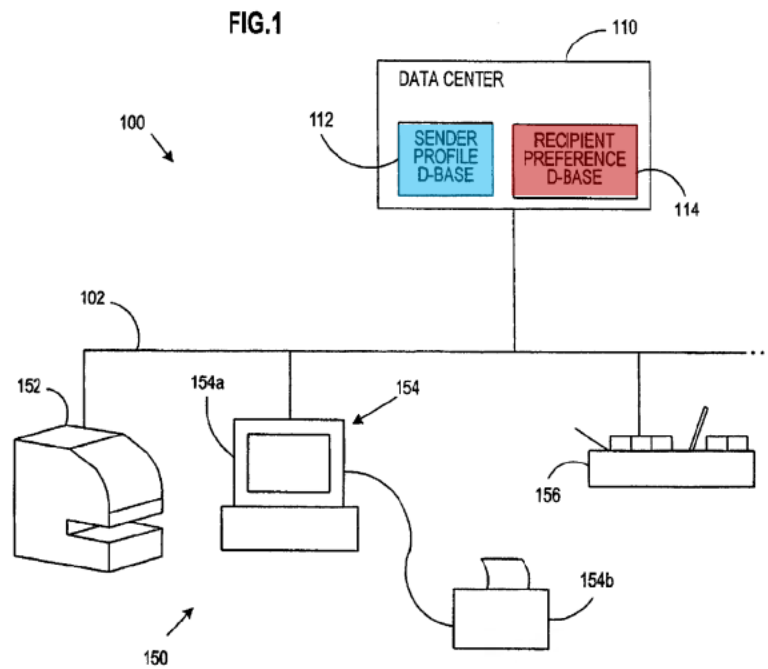
Law586 incorporates two concurrently-filed patents to the same inventor. EX1005, 1:7-15 (Law 586 incorporating App. Nos. 09/588,853 (issued as Law773) and 09/588,443 (issued as Law845)).

Law773 shares similar disclosure to Law586 but focuses on slightly different (but complementary) aspects of rule-based messaging systems. Where Law586 discloses web server 110, Law773 discloses data center 110, which is similar in nature and function to web server 110 of Law586; both disclose messenger and recipient computers in communication with each other and the data center/web server over the Internet. EX1005, 3:27-63, FIGs. 1, 4; EX1006, 3:17-63, FIGs. 1, 3. The memory of data center 110 is, like web server 110, used to store “recipient preference profiles” where these profiles describe “various parameters intended to control aspects of messages sent by the senders that are intended for the recipient.” EX1006, 4:28-30, 3:5-7.

Law773 discloses that the tasks and operations of the “data center” and the “messaging systems” may occur “at either location.” EX1006, 7:46-50. “[D]ata center 110 may operate as the message dispatcher. Thus, the messaging systems 150 generate the messages and upload them to the data center 110. Then, the data center reconciles the messages with the recipient preference profiles 190 and takes appropriate measures when dispatching or not dispatching the messages as discussed above.” EX1006, 7:47-56.

Law845 is also incorporated into Law586 and shares portions of the same specification as Law586 and Law773. EX1005, 1:7-15, 3:27-63, FIGs. 1, 4; EX1006, 3:17-63, FIGs. 1, 3; EX1007, 2:46-3:21, FIG. 1.

Law845, like Law586, discloses sender and recipient profiles; and, as in Figure 1 of Law845, Law586 further discloses that these profiles may be stored in separate “databases” (**sender profiles database 112** and **recipient profiles database 114**). EX1007, 3:46-47, 4:21-22, FIG. 1.



2. Joshi

Joshi was published in 1997, bearing an International Standard Book No. 0-7897-1503-1 and a Library of Congress Card No. 97-80666. EX1029, Copyright Page. It is prior art under §102(b).

Joshi describes key features of Microsoft Exchange 5.5. (“Exchange”), a “suite of server products that runs on top of the Windows NT operating system.” Exchange allows users to “manage email, calendars, contacts, tasks,

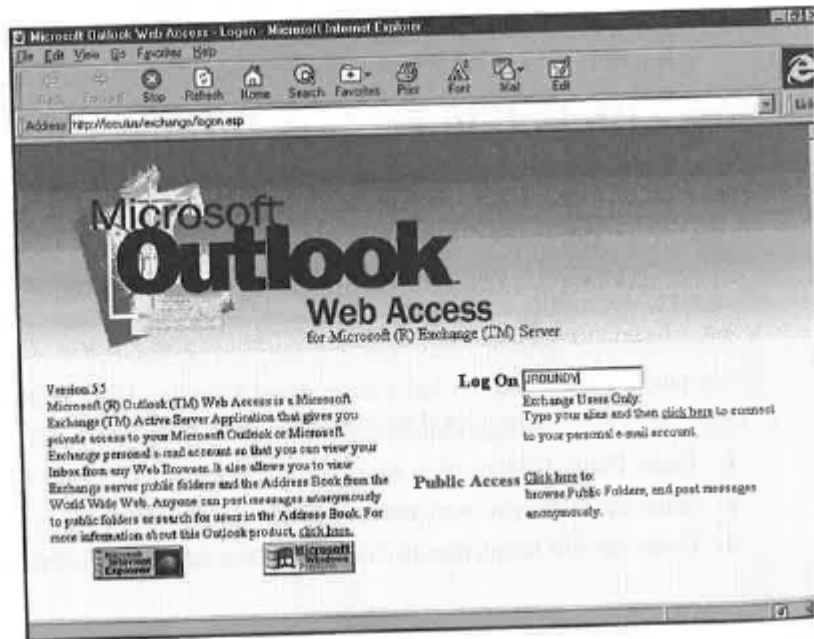
and to-do lists.” EX1029, 2. Exchange supports multiple internet protocols, including SMTP, POP3, and IMAP4 for email, and HTTP, HTML, and SSL for Web access. EX1029, 3.

Exchange also provides customization options. For example, Exchange allowed for the implementation of “server-based rules” through which users “configure[d] rules to execute on their Exchange home servers, such as forwarding messages to particular individuals, replying with an out of office note to all incoming messages, and routing messages to specific folders to manage messaging flow.” EX1029, 4.

Exchange discloses installation of “Internet Information Server (IIS) 3.0,” a related program that also resides on the Windows NT server. EX1029, 146. IIS functions as an Internet web server making it possible to host Active Server Pages applications, which provides dynamic content to web sites using HTML. EX1029, 813-15.

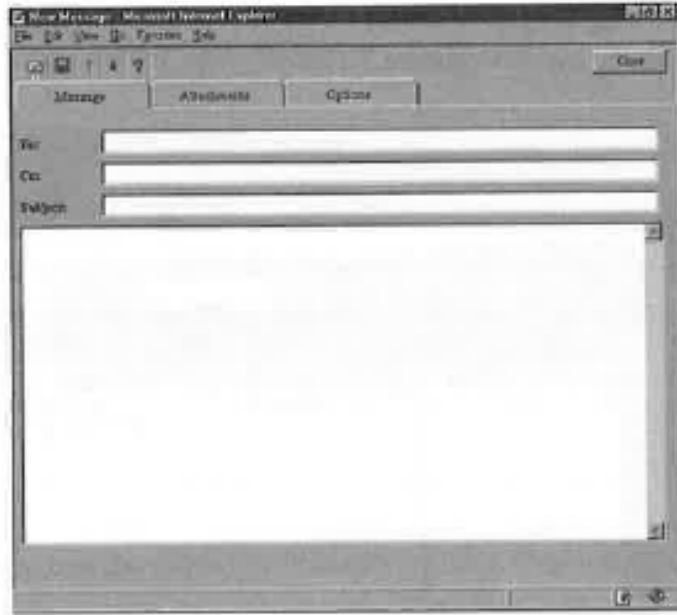
Joshi describes that one such application was “Outlook Web Access” (“OWA”). OWA enables users to access their mailbox on the Exchange Server, create and send messages, and read messages in their Inbox, all from a web browser. EX1029, 716, FIG. 31.9.

FIG. 31.9
User login to mailbox in
Web Outlook view.



OWA users create messages using “a New Message form.” EX1029, 717. The New Message form includes fields such as “To:” for “the main recipients of [the] message,” “Message:” for a user to type in the full text of the message, and “Attachments:” for files a user wants to send with a message. EX1029, 717, FIG. 31.11.

FIG. 31.11
New Message form.



Once a user “finished filling out the form,” the user sends or cancels the message. EX1029, 718.

Exchange discloses creating custom forms via an “Outlook Forms Designer,” enabling an administrator to “create custom forms that can replace paper forms.” EX1029, 22. Developers could “create a Visual Basic program to take the data off the form and store it in an Access, FoxPro, or SQL Server database for later retrieval and manipulation.” EX1029, 22. Using the “Information Store,” data from the forms “could continue to be stored.” EX1029, 22.

3. Smith

Smith was filed February 2, 1999 and issued October 8, 2002. EX1016, Cover Page. It is prior art under §102(e).

Smith discloses “an automated system for delivery of messages to multiple recipients,” in which a “recipient profile manager allows each recipient to select the messaging devices to be used for message delivery, as well as preferred messaging schedules, priorities, and message security.” EX1016, Abstract. Smith’s device is labeled a “universal notification system” or “UN” and includes a UN Client, a UN Server, and a UN database, depicted in Figure 1. EX1016, 2:63-67.

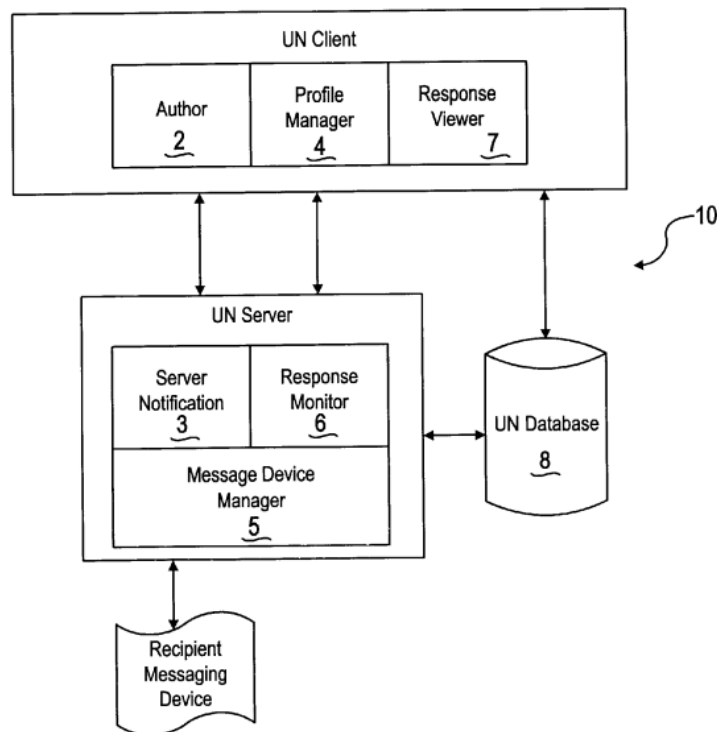


FIG. 1

As depicted, the UN Client, UN Server, and UN Database are “operatively linked to each other.” EX1016, 4:16-20. The UN Client “would

be accessed as a toolbar extension within the Microsoft Office 2000 environment,” EX1016, 8:8-9, and include “Message Author” and “Profile Manager” software, EX1016, 4:19-24. “Message Author” presents message senders with “a blank UN universal message form” in which the user “select[s] from a list of recipients” and enters a “message body and attachments.” EX1016, 5:15-30, FIG. 2. The UN Client further allows a sender to select a message priority and security level. EX1016, 5:25-28.

The “Profile Manager” “allows the recipient to choose which devices will be contacted by and at what times and security levels the devices shall be accessed.” EX1016, 8:65-9:1, FIG. 10. The profile management menu allows users to choose devices such as e-mail, voicemail, fax, pager, telephone or wireless communication devices, “select[ing] which devices are secure for sensitive or confidential information.” EX1016, 6:17-19. The user can also designate locations “such as work, home, vacation, travel office” or other user preferences. EX1016, 6:25-26. This information, referred to as a “profile,” is stored in the UN Database. EX1016, 6:29-30.

The UN Server includes the “Message Device Manager,” which “converts the message information received from the UN Client into the proper format for receipt and response by a recipient.” EX1016, 4:47-49. The Message Device Manager receives the recipient forms “with recipients,

priority, security, message body, attachments and response fields automatically processed from the UN Database 8.” EX1016, 5:40-45. The UN server further “enables web[-]based access to Outlook” using “[a] conventional internet Web Browser.” EX1016, 8:59-63.

Per Smith, database 8 preferably resides “on the same computer that supports the UN Server, although it could be located in a separate subsystem.” EX1016, 9:49-53.

4. Padwick

Padwick was published in 1999, bearing an International Standard Book No. 0-7897-1909-6 and a Library of Congress Card No. 98-87795. EX1023, Copyright Page. It is prior art under §102(b).

Padwick describes how to use Microsoft Outlook 2000 including its Rules Wizard. EX1023, 618-46. Per Padwick, “[a] rule is a set of conditions, actions, and exceptions that controls how Outlook processes and organizes messages.” EX1023, 618. “The conditions determine which types of messages a rule applies to, the actions are what the rule does; the exceptions determine when a rule does not apply to certain messages.” EX1023, 618.

The “Rules Wizard [can be used] to create many types of rules for incoming and outgoing messages,” such as “Check Messages When They Arrive,” “Move New Messages From Someone,” “Move Messages Based on

Content,” and “Assign Categories Based on Content.” EX1023, 634. There are “many combinations of rule types” that a user can create. EX1023, 635; *see also* 618 (discussing combining various rules).

Padwick discloses creating rules, such as “conditional rules” that execute under certain conditions, *e.g.*, subject matter, content, sender, or importance, as well as filtering for certain items such as junk mail. EX1023, 640-646. By example, Padwick discloses applying a rule to a message from a specific sender (Jane Rodgers) based on its importance (*e.g.*, “high”), content (*e.g.*, specific words in the subject, body, or header), and whether it is sent directly to the sender. EX1023, 628-34.

In Outlook 2000, the rules may be stored and run locally at a client or on a server. EX1023, 621-22.

B. Ground 1: Law586 in view of Joshi Renders Obvious Claims 1-11 and 14-18

Law586 in view of Joshi discloses and renders obvious claims 1-11 and 14-18. A POSA would have considered Law586, Law773, and Law845 as a single disclosure, including because Law586 expressly incorporates the disclosure of Law773 and Law845, and a POSA would have looked to these additional and complementary disclosures when considering the teachings of

Law586. EX1003 ¶¶138-155, 243, 263-64; *supra* Section V.A.1.² Moreover, all three references share the same inventor, were filed on the same day, rely upon a similar client-server architecture with one or more databases, and are all directed to the same field (rule-based messaging delivery systems). EX1003 ¶¶139-43. As explained in more detail above (Section V.A.1) and below (Section V.B), even if they are not considered a single reference, a POSA would have thought to incorporate the teachings of Law773 and Law845 into Law586, including to improve the overall functionality and features of Law586.

Also as discussed further herein, a POSA would have been motivated to incorporate, and had a reasonable expectation of success of incorporating, the teachings of Joshi into Law586. EX1003 ¶¶142-57. Law586 discloses that “web server 110 may operate as the message dispatcher.” EX1005, 8:15-18. A POSA would have looked to Joshi for additional details about the routine, standard and well-known implementation of creating, sending, receiving, and

² If Law773 and Law845 are not deemed to be incorporated by reference, the claims would have still been obvious over Law586 in view of Law773, Law845, and Joshi for the reasons set forth herein. *See also* Section V.A.1.

storing email using Outlook Exchange, consistent with the teachings in Law586 to use “conventional” web servers, email, and client-server communication sessions. EX1003 ¶¶145-46. A POSA would have found it advantageous, *e.g.*, to incorporate into Law586 Joshi’s teachings about message input forms, transmittal and storage because such specific input, transmittal and storage would provide a more user-friendly and mature system, widely accessible to those of skill in the art. EX1003 ¶¶146-57. Further analysis regarding the obviousness of combining Law586 and Joshi is provided below.

1. Claim 1

1[pre] “*An electronic message management system comprising:*”

Regardless of whether the preamble is limiting, as explained below and regarding limitations 1[a]-1[g], the combination of Law586 and Joshi discloses and renders obvious the claimed “electronic message management system.” EX1003 ¶¶160-63; *see also* limitations 1[a]-1[g].

Law586 discloses that its “invention relates to information delivery systems” (such as information delivery system 100 in Figure 1 including “web server 110” in operative communication over the Internet with recipient computers 180 and sender computers 155). *See* EX1005, 1:19-24, 2:25-30, 3:5-9, 3:27-61, FIG. 1; EX1003 ¶¶160-62. Law586 discloses that messages

may include “electronic mail” messages “and the like,” which are “well know[n].” EX1005, 4:3-11, 5:26-27; EX1003 ¶162.

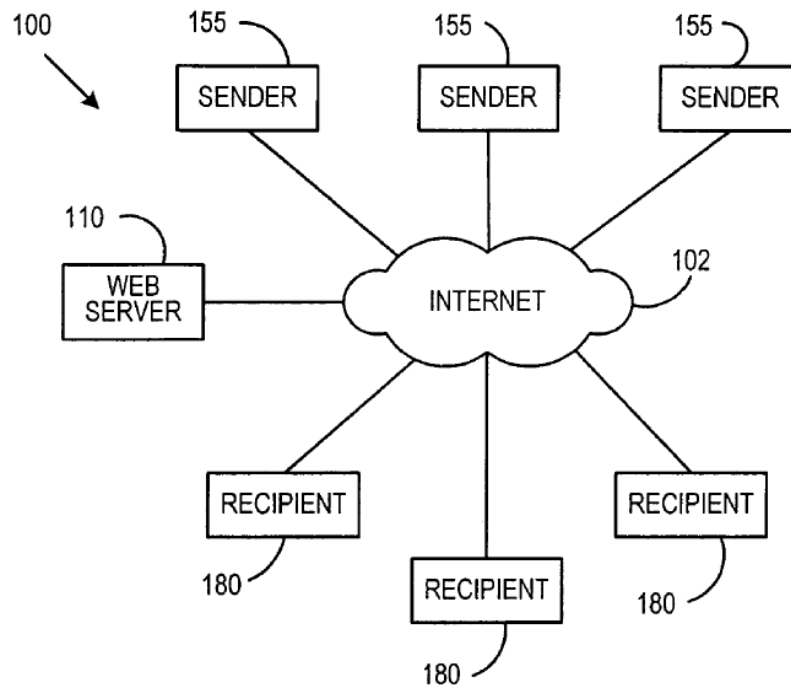


FIG. 1

1[a] “an electronic computer system in operative communication with a global digital communications network, and an electronic message management database in operative communication with the computer system; the electronic computer system having”

Law586 discloses, or it would have been obvious to include as part of Law586, limitation 1[a]. EX1003 ¶¶164-73.

Figure 1 discloses “**web server 110**” communicating over “**Internet 102**” with sender computers 155, which server may include “any computer

system (hardware, operating system, Web server application software, TCP/IP protocols and the Web site content or pages) that provides World Wide Web services on the Internet.” EX1005, 3:27-38, FIG. 1; EX1003 ¶¶165-69; EX1001, 5:3-6:16 (’920 patent disclosing same well-known architecture). A POSA would understand that **web server 110** and/or its “computer system” components, such as its hardware and software, correspond to the claimed “electronic computer system” that is in **operative communication with Internet 102** (claimed “global digital communications network”). EX1003 ¶¶166-69; EX1001, 5:9-20.

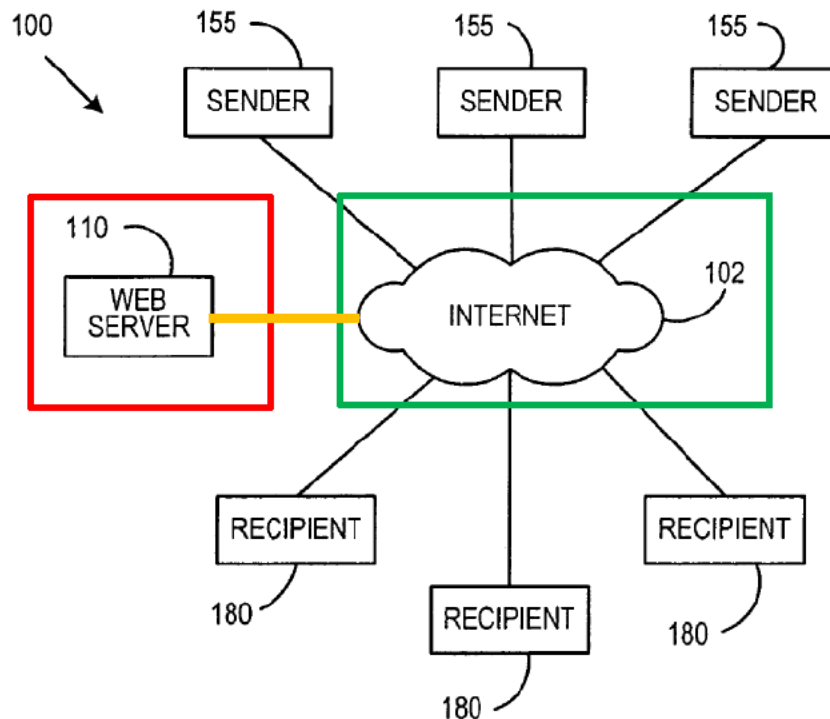


FIG. 1

Law586 discloses that “recipient preference profile 190 is preferably stored in any suitable memory device (**database server**, memory farm, hard disk, etc.) as part of or *operatively connected to the web server 110* and defines various parameters intended to control aspects of messages sent by the senders 155 that are intended for the recipient.” EX1005, 4:17-22, FIGs. 1-2; EX1003 ¶¶165-67. The messages in Law586 that are stored in, *e.g.*, “database server,” include “electronic mail.” EX1005, 3:61-4:7, 4:34-36, 5:19-29, 6:37-42; EX1003 ¶¶165, 170-72. A POSA would understand that Law586 discloses that **web server 110** is “*operatively connected to*” a “**database server**” (which a POSA would understand includes a **database** (database server not shown in Figure 1)) that stores “recipient preference profile 190” that “defines various parameters intended to convey aspects of [sent] messages” and therefore manages the sending and receiving of electronic messages via those parameters (the claimed “an electronic message management database in operative communication with the computer system”). EX1003 ¶¶164-73; EX1005, 4:17-22, 8:10-12; EX1006, 4:28-46; EX1007, 3:46-47, 4:21-22. When implementing Exchange (*i.e.*, Joshi’s teachings) such web server 110 would include OWA web server and Exchange server that stores and accesses many different types of data in databases. EX1003 ¶173; *see also* ¶¶41-50 (discussing databases); ¶¶67-74 (Exchange architecture); ¶¶107-113 (OWA).

Notably, the '920 patent does not provide detail regarding its “electronic message management database”—it only generically discloses various “databases” that store information and are in communication with the disclosed “computer systems.” EX1001, 6:17-31, FIG. 2. This is like Law586’s database for electronic message management discussed above and further confirms the obviousness and conventionality of relying upon databases in operative communication with computer systems to store various data. *See also* EX1003 ¶¶41-50, 69-72; EX1020, 130; EX1021, 123; EX1016, 9:49-53; EX1007, 3:46-47, 4:21-22.

1[b] “a recipient profile application for receiving recipient profile data from recipients via the global network and storing the recipient data in the database, 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,”

Law586 discloses, or it would have been obvious to include as part of Law586, limitation 1[b], EX1003 ¶¶174-208, addressed in two parts below.

First, Law586 discloses the claimed “a recipient profile application for receiving recipient profile data from recipients via the global network and storing the recipient data in the database.” EX1003 ¶¶175-84.

Law586 discloses that web server 110 receives profile information from recipient computer systems 180 (such as message preference data and other profile information) over Internet 102. EX1005, 3:27-47, 4:11-17, FIGs.

1, 2; EX1003 ¶175. Law586 discloses in Figure 2 “recipient preference profile 190” that includes recipient profile data (received from recipient computer systems 180) such as recipient identifier or ID data, message format, delivery instructions, interests, and primary and secondary addresses. EX1005, 3:10-14, 4:25-57; EX1003 ¶¶176-79.

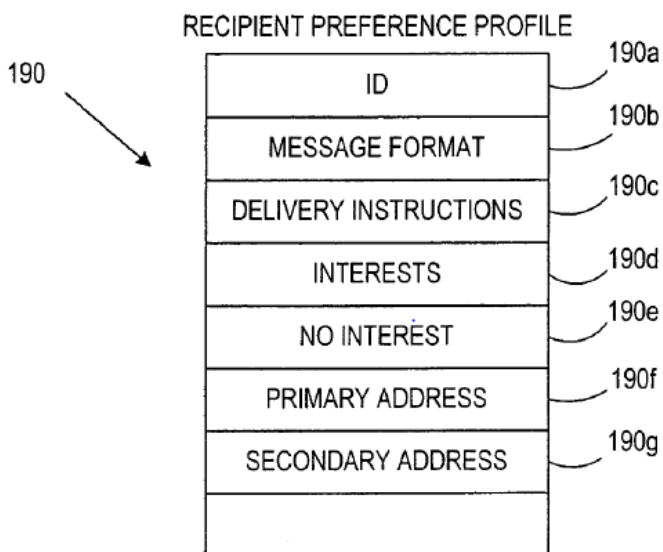


FIG. 2

Law586 discloses that “recipients 180 may establish their respective recipient preference profiles 190 with the web server 110 during a communication session *in any conventional manner*” and notes that “[a POSA] will recognize that the use of *appropriate menu and/or command driven web pages* that allow the recipient and sender to log on to and provide the sought[-]after information described above may be accomplished *in any conventional manner*.” EX1005, 5:46-55, 3:33-47 (discussing conventional

systems); EX1003 ¶¶175-76, 180-85; *see also* EX1006, 4:43-47 (Law773, incorporated into Law586, discloses conventionality of “an application software program executed by the data center 110 control system” to “access[] [using] any suitable technique” the “recipient preferences profiles 190”).

In the Law586/Joshi system, a POSA would understand that the code collects the data and makes it available is present at least on the web server 110 that includes both Exchange and OWA. EX1003 ¶180; *see also* ¶¶114-29; EX1005, 3:38-47; EX1011, 261-64, 288-91. If a recipient runs Outlook, Exchange code on web server 110 would obtain and receive the recipient data, *e.g.*, by presenting a Recipient Profile Exchange Form in the conventional manner. EX1003 ¶¶180, 152-53. A POSA would understand the code implementing this functionality (such as or part of the application software) corresponds to the recipient profile application. EX1003 ¶180. If a recipient uses a web browser to access OWA, the OWA code on web server 110 would also receive the recipient data before the Exchange code receives the recipient data, *e.g.*, by presenting a Recipient Profile Exchange Form in the conventional manner. EX1003 ¶¶180, 82, 96, 107-29. A POSA would understand that the code implementing this functionality—either the OWA code, the Exchange code, or both in combination—satisfies the “recipient profile application” limitation. EX1003 ¶180. This is also confirmed by

Law586's disclosure of conventional Web server application software, menus, application software programs, and the like. EX1003 ¶¶181-82; EX1005, 3:27-47, 4:13-24, FIGs. 1-2; EX1006, 4:43-47.

Law586's disclosure—including its “conventional” implementation of a web page application over the Internet—is consistent with the '920 patent, which generically describes a “recipient profile software application” to “include a recipient profile input form” that would be “displayed at a recipient's client computer... as a web page,” EX1001, 6:33-40; *see also* 5:13-20 (discussing Internet generally); EX1003 ¶183.

As noted, Law586 further discloses that the received “recipient preference profile 190” (including the recipient data) “is preferably stored in any suitable memory device” such as the “database” that is “operatively connected to” web server 110 (the claimed “storing the recipient data in the database”). EX1005, 4:12-24; EX1003 ¶¶178, 185. The construction of a web page and associated software to retrieve and store information was well-known, commonplace and understood to a POSA prior to the '920 patent, and a POSA, implementing the system disclosed in Law586, would have known to rely upon such conventional architecture as disclosed in both Law586 and admitted in the '920 patent. EX1003 ¶¶181-85, 63-81, 107-113.

Second, Law586 discloses, or it would have been obvious to include “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.” EX1003 ¶¶186-208.

Law586 discloses that “[r]ecipients 180 receive messages *if they want them, in the format they want, when they want and where they want*” and that “[b]y allowing recipients to control aspects of their incoming messages, their satisfaction is increased.” EX1005, 5:67-6:4; *see also* 4:25-62; EX1003 ¶187. Law586 further discloses that “recipient profile 190” (in Figure 2) enables a recipient to control various aspects of delivery including recipient-specific delivery parameters dictating the where, when and how specific messages and types from specific messengers (senders) are delivered to the recipient, including, *e.g.*, (i) “message format data 190b,” (ii) “delivery instruction data 190c,” (iii) “interest data 190d,” (iv) “no interest data 190e,” (v) “primary address data 190f,” and (vi) “secondary address data 190g.” EX1005, 4:25-5:10, 5:67-6:4; EX1003 ¶¶188-96. These are also applicable to the Law586/Joshi combinations, disclosing the “where,” “when,” and “how.” EX1003 ¶¶191-96.

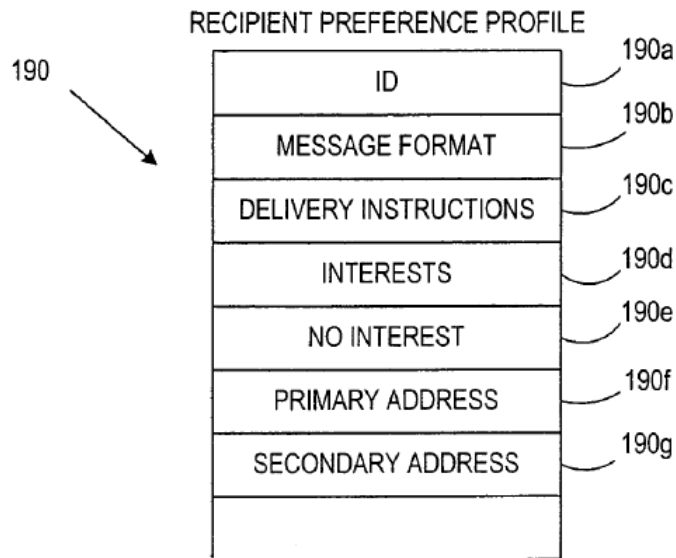


FIG. 2

For example, the “message format data” (190b) allows a recipient to choose “the recipient’s preferred mode of communication (physical mail, electronic mail, facsimile transmission, voice mail, etc.).” EX1005, 4:25-36; EX1003 ¶195. The “delivery instruction data” (190c) allows a recipient to choose “delivery preferences” including “hold messages” (which causes the delivery to be temporarily held when the recipient “is not available... to receive messages”) and “temporary reroute messages” “when the recipient 180 wishes to have messages sent to alternate address.” EX1005, 4:25-43; EX1003 ¶¶188, 190. The “interest data” (190d) and “no interest data” allows a recipient to choose which “particular types of senders” it wishes to receive messages from (or not). EX1005, 4:46-5:36, FIG. 3; EX1003 ¶¶189, 198-99.

Thus, a POSA would understand that the profile data, including the recipient-specific delivery parameters, disclosed in Law586 enables a recipient to choose where, when, and how specific message types from specific messengers are delivered (or not) to the recipient. EX1003 ¶¶190-96.

Further, it would have been obvious to a POSA to configure the delivery parameters “for specific types of messages from specific messengers.” This is a routine and beneficial extension of Law586, and would give recipients increased control over message delivery, consistent with the stated goals in Law586 and the well-known concepts of filtering emails, *e.g.*, to prevent unwanted “spam” or “junk” mail. EX1003 ¶¶197-208, 82-98. Indeed, this concept was well known in the prior art and advantageously used for rule-based filtering and message delivery of emails, such as in Law586. EX1003 ¶¶82-98, 130; EX1005, 4:58-5:11; EX1017, 51-63; EX1019, 7:28-32 (“[T]he user profiles can define specific actions to be taken by the servers 64, 66 in response to messages received from particular sources or regarding particular subjects.”); EX1011, 253-307 (case study for a single mailing list server with preferences for multiple senders); EX1023, 618-46 (disclosing Outlook 2000 rules applied to specific senders and message types such as importance, content, and direct addressee).

1[c] “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”

Law586 discloses, or it would have been obvious to include as part of Law586, limitation 1[c]. EX1003 ¶¶209-24.

Law586 discloses that web server 110 receives profile information from senders (*i.e.*, messengers) over Internet 102 in a similar manner as it does for the recipients, discussed above in limitation 1[b]:

Both recipients 180 and senders 155 provide data to the web server 110... *[T]he senders 155 may establish their respective sender profiles 195 with the web server 110 during a communication session in any conventional manner.*

EX1005, 5:45-55, FIG. 1; *see also* 3:27-4:11; EX1003 ¶211.

Law586 discloses in Figure 3 that “sender profile 195” received over the Internet includes a sender identifier or ID data, e-mail address, physical address, SIC number(s) and notification setting. EX1005, 5:19-55, FIG. 3; EX1003 ¶¶213-14. A POSA would understand that one or more of the sender identifier or ID data, e-mail address and SIC numbers received over the Internet correspond to the claimed “messenger identifying data,” as such information allows the sender to be identified. EX1003 ¶215.

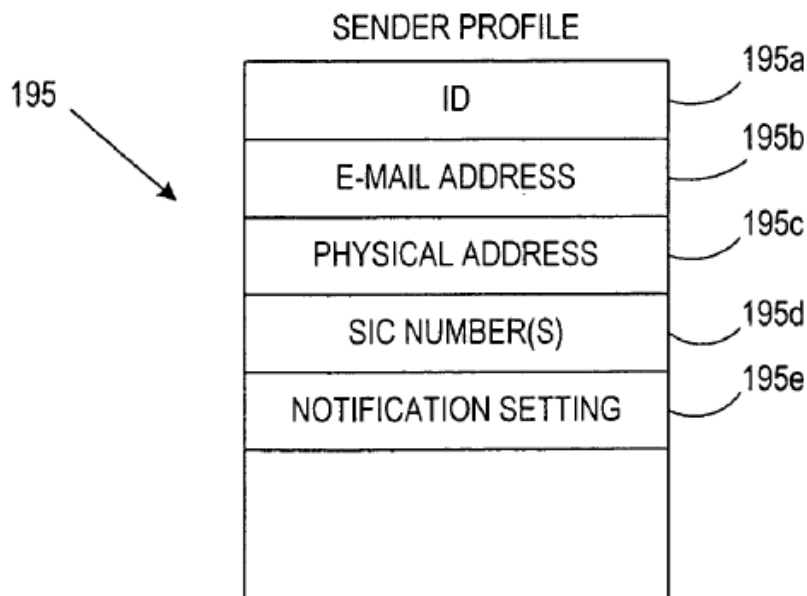


FIG. 3

Further, Law586 discloses that “[a POSA] will recognize that the use of *appropriate menu and/or command driven web pages* that allow the recipient and sender to log on to and provide the sought[-]after information described above may be accomplished *in any conventional manner*.” EX1005, 5:46-55; *see also* 3:33-38 (“In conventional fashion, the web server 110 may be any computer system” such as “*Web server application software*”); EX1003 ¶¶216-18; *see also* EX1006, 4:43-47; limitation 1[b] above.

For the reasons discussed above in limitation 1[b], a POSA would understand that the code on web server 110 (such as or part of the application software) used to receive and store information from a menu or web page for sender profile data in “any suitable memory” such as a database operatively

connected to web server 110, as implemented on Law586's web server 110, includes or constitutes an application for recipient profiles (the claimed "messenger profile application"). EX1003 ¶¶218-23; *see also* EX1001, 6:33-40, 5:13-20; EX1006, 4:43-47; limitation 1[b].

A POSA would further have understood that the received "sender profile 195" (including the messenger identifying data such as the sender ID or e-mail) would be stored in the same manner as the "recipient profile data," which is "in any suitable memory device" such as the "database" that is "operatively connected to" web server 110 (the claimed "storing the messenger data in the database, including messenger identifying data"). EX1005, 5:45-55, 4:17-23, FIG. 4; EX1003 ¶¶216-17, 222-23; *see also* EX1007, 3:46-47 ("The sender profile 200 may be stored in the data center 110 in a sender profiles database 112"), 4:21-22 ("The recipient profile 300 may be stored in the data center 110 in a recipient profiles database").

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

Law 586 in view of Joshi discloses, or it would have been obvious to include as part of Law586, limitation 1[d]. EX1003 ¶¶225-40.

Law586 discloses that a sender should use a well-known and conventional "messaging system" such as "electronic mail and the like" to

“assist [the sender] in the creation, addressing, output generation and/or delivery of messages.” EX1005, 3:58-4:11; EX1003 ¶227. Further, Law586 discloses that “web server 110 may operate as the message dispatcher” and “[t]hus, the senders 155 provide instructions to the web server 110 that control the messaging process.” EX1005, 8:15-18; EX1003 ¶¶227-28. In other words, although Figure 4 of Law586 discloses one embodiment where senders send messages directly to recipients, Law586 *also* discloses an alternative embodiment where those messages are routed through web server 110, which operates as a “message dispatcher” according to instructions received from senders. EX1003 ¶¶228-30. The same is true of Law773. EX1006, 7:47-56; EX1003 ¶¶228-30.

Law586 further discloses various applications on web server 110 designed to receive information (including inputs) from recipient computer systems 180 and sender computer systems 155 over Internet 102. *See* limitations 1[b] and 1[c] (explaining code used to implement functionality and web server applications and appropriate menu and command-driven web pages whereby data such as messages are input); *see also* EX1003 ¶¶230-40.

A POSA would understand that, when the web server acts as the message dispatcher, email messages would logically be transmitted from sender computer systems 150 (the claimed “messenger”) over Internet 102

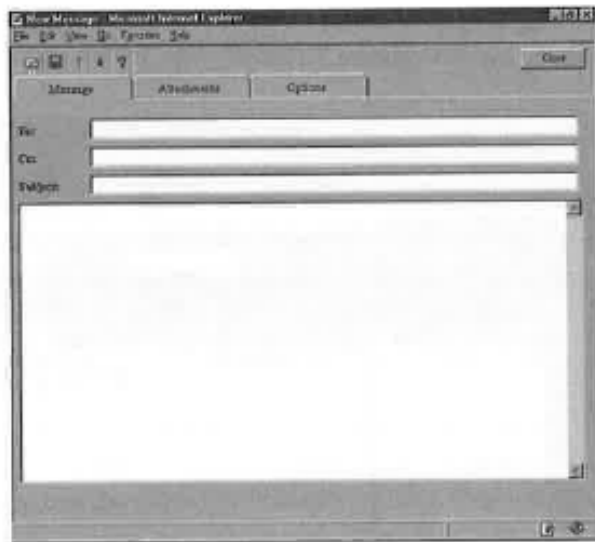
(the claimed “global network”) to web server 110, and further that such transmitted messages (alone or with standard email attachment files) constitute the claimed “message files” that are received by web server 110 over Internet 102. EX1003 ¶¶229-30.

As discussed above and further herein, a POSA would have been motivated to combine the teachings of Law 586 and Joshi, and would have had a reasonable expectation of success, including because Law586 describes utilizing “conventional” “Web server application software,” to implement its messaging system. EX1003 ¶¶145-46. Microsoft Exchange, as described by Joshi, was a conventional web server software and system. EX1003 ¶¶146-50; EX1029, 2, 24, 39, 88. Moreover, Joshi discloses that its system would commonly be used to set up third-party utilities or custom applications (such as in Law586). EX1029, 8, 39; EX1003 ¶148. Accordingly, in the combined system of Law586 and Joshi, a POSA would logically have thought to run Microsoft Exchange with Law586 to provide a robust system that enabled efficient message management, storage and distribution, controlled by the preferences of users (including senders and recipients). EX1003 ¶¶148-49.

Such a combined system would include OWA, a feature of the Microsoft Exchange system. EX1003 ¶¶63-74, 149, 235. Senders using OWA create messages using “a New Message form,” which includes fields for a

sender to select recipients, draft a message, and select attachments. EX1029, 717, FIG. 31.11; EX1003 ¶¶111, 234-35.

FIG. 31.11
New Message form.



Once a user is “finished filling out the form,” that user could send or cancel the message. EX1029, 718; EX1003 ¶235. Messages sent over the Internet are stored in a database (*e.g.*, in describing how a message is sent between servers, Joshi discloses that “client1 connects to the server and accesses the private Information Store (IS) where all mail messages are held. Client1 sends a new message to Server1”). EX1029, 39-40, 52-53; EX1003 ¶¶67-74, 230-31. Joshi further discloses that this “Information Store” is the “back-end database that contains all messages and data located on the Microsoft NT server that houses the Exchange server.” EX1029, 18, 67-69; EX1003 ¶¶69-74, 230-31.

Accordingly, a POSA would understand that the implementation of Exchange including OWA as used to receive and store information from a menu or web page for collecting message data from a messenger over the Internet to be stored in the database corresponds to the claimed “a message input application for receiving message files from a messenger via the global network and storing the message files in the database.” EX1003 ¶¶230-40.

1[e] “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”

Law586 in view of Joshi discloses, or it would have been obvious to include as part of Law586, limitation 1[e]. EX1003 ¶¶241-53.

As described above for limitation 1[d], Law586 discloses web server 110 operating as a “message dispatcher” according to various “instructions” provided by the messaging system and Joshi provides further detail about message generation, receipt and storage. Law773 further discloses that, when data center 110 is operating as the message dispatcher (as in Law586 and its web server 110), “the data center reconciles the messages with the recipient preference profiles 190 and takes appropriate measures when dispatching or not dispatching the messages as discussed above.” EX1006, 7:47-56, 6:33-63; EX1003 ¶¶243. Further, in the combined system of Law586 and Joshi, such

messages would first be uploaded to the data center from messenger computers over the Internet with a recipient specified in the “To:” field. EX1006, 7:47-56, 3:17-63, FIG. 1; EX1029, 717, FIG. 31.11; EX1003 ¶¶244-50.

Joshi further discloses that, for email routing, Exchange includes a “message transfer agent” or “MTA.” EX1029, 52; EX1003 ¶¶247, 67-74. The MTA “provides the engine for routing and transferring data to other servers” and that “[t]he routing process commences when an Exchange Server’s MTA receives a message.” EX1029, 53; EX1003 ¶248. The MTA then compares the recipient’s address to the local site, and if the sites do not match, “MTA will match the recipient’s address space to an available connector or gateway.” EX1029, 53; EX1003 ¶248. To do so, the MTA “communicates with all other Exchange components,” including the Information Store, which “submits messages for delivery,” and a Directory Service, which the MTA uses to “look[] up addresses and configuration information.” EX1029, 67-69; EX1003 ¶249.

As noted, in the combined system of Law586 (incorporating Law773) and Joshi, the MTA reconciles messages to recipients based on configuration information, and a POSA would therefore understand that, in the combined system, the code running on the Exchange server including the MTA would

correspond to the claimed “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,” specifically because:

- The code is “in communication with the database.” EX1003 ¶251; EX1029, 68 (“The [Information Store] contacts the MTA to... deliver new outgoing mail.”).
- The code is “operative to access and utilize data and files from the database,” including both message files and profile data. EX1003 ¶251; *see also* EX1029, 68 (“The [Information Store] contacts the MTA to...deliver new outgoing mail.”), 18 (“Information Store [is the] back-end database that contains all the messages and data located on the Microsoft Windows NT server that houses the Exchange server.”), 69 (“The MTA looks up addresses and configuration....”)
- The code then “generates an individual message.” EX1003 ¶251; EX1029, 67 (“In addition to being the transport vehicle for messaging information, [the MTA] also maps and routes addresses, and performs some message format conversion to other system’s standards.”)

- Said message, would, as discussed in connection with limitation 1[d] be “specified by the messenger via the global communications network.” For example, this could be specified using the “To:” field. EX1003 ¶251; EX1029, 717-18, FIG. 31.11.
- In the combined system, the code would, in addition to the configuration data disclosed by Joshi, also use “the delivery parameters.” EX1003 ¶251; EX1006, 7:47-56 (“[T]he data center reconciles the messages with the recipient preference profiles 190 and takes appropriate measures when dispatching or not dispatching the messages as discussed above.”)

Such prior art disclosure is consistent with the '920 patent, which describes that a messenger inputs a message or uploads a message file to the system for storage in a database and that “an individual message generator 54 obtains information from the database 57 and generates an individual messages [sic] for each recipient, based on the combination of recipient and messenger profile parameters and messages entered into the profile 56 and message 57 databases.” EX1001, 6:63-67, 8:30-48, 11:2-6, FIGs. 2, 4; EX1003 ¶252.

1[f] “a message management server operating system; and”

Law586 discloses, or it would have been obvious to include as part of Law586, limitation 1[f]. EX1003 ¶¶254-58.

Law586 discloses that web server 110 may include an “operating system” “[i]n conventional fashion.” EX1005, 3:33-37; EX1003 ¶255. Law586 further discloses that web server 110 “collects message preference data” and “may employ any suitable combination of computer hardware software (control system) to facilitate the storage, access and processing of the [described] information and various communications” such as managing messages from senders and recipient preferences. EX1005, 3:38-47; EX1003 ¶255; *see also* limitations 1[b]-1[c] above.

A POSA would understand that such an operating system, such as the Windows NT operating system of Joshi, that is part of web server 110 used for message management corresponds to the claimed “message management server operating system.” EX1003 ¶¶256-57. Notably, the ’920 provides does not identify any specific operating system or characteristics as a message management server operating system; it provides only a generic description of well-known, off-the-shelf operating systems. EX1001, 7:1-8; EX1003 ¶258.

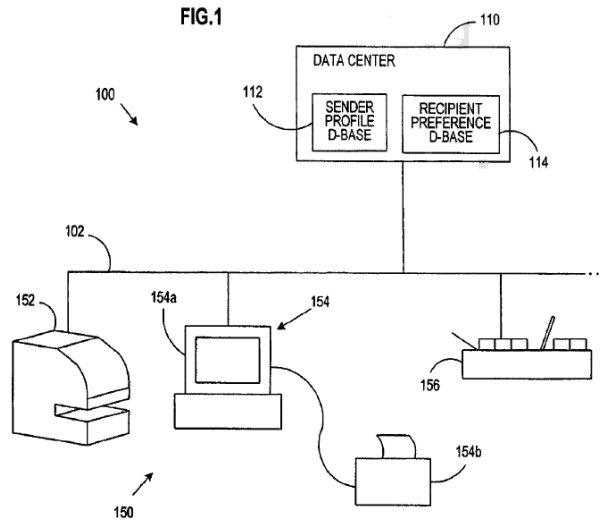
1[g] “the message management database including recipient and messenger profile databases for storing recipient and messenger profile data respectively, and a message database for storing message data files.”

Law 586 in view of Joshi discloses, or it would have been obvious to include as part of Law586, limitation 1[g]. EX1003 ¶¶259-68.

As discussed above, Law586 describes a “database server,” which a POSA would understand to include one or more databases in which the relevant information is stored (such as data about the sender, recipient and messages, as appropriate). EX1003 ¶¶262, 41-50, 69-72; EX1005, 4:17-24. Similarly, Law773 identifies a “recipient preference profiles database” and discloses that “recipient preference profile 190 is preferably stored in any suitable memory device” such as a “database server.” EX1006, 4:21-41; EX1003 ¶262.

Law586 and Law773 do not describe the specific layout or structure used to store the files in the disclosed conventional memory (*e.g.*, in the conventional-disclosed database server or database). However, Law845, incorporated into Law586, provides additional detail as to the storage of recipient and sender profiles organized and stored in respective “databases.” EX1007, FIG. 1; EX1003 ¶263. Law845 discloses that “sender profile 200 may be stored in the data center 110 in a sender profiles database 112” and that “[t]he recipient profile 300 may be stored in the data center 110 in a

recipient profiles database 114.” EX1007, 3:46-47, 4:21-22, FIG. 1 (below); EX1003 ¶¶263-64.



As discussed, Law845 is incorporated into Law586, shares the same relevant distributed architecture, and includes overlapping and compatible disclosure with Law586. For example, as described above, web server 110 of Law586 corresponds to the data center 110 of Law845 and Law773 and messaging system 150 in Law845 and Law773 corresponds to messaging system 155 in Law586.

A POSA would understand that this is because the recipient profiles and sender profiles are different data structures, and consequently would routinely be stored separately for easier and more efficient searching, sorting, recombining, and/or retrieving. EX1003 ¶¶265, 41-50, 69-72; EX1020, 130; EX1021, 123; EX1011, 345-52. Likewise, a POSA would understand that the

message files stored in the system would routinely be stored in a separate database as well—such as in Joshi—as was conventional in the art, such as in an email database, to allow for storage, retrieval and processing. EX1003 ¶¶266-68; EX1029, 6, 18, 316; *see also* EX1011, 345-52; EX1014, 3:15-27, FIG. 1 (separate tables/databases for messages and profiles); EX1022, 3:52-4:27, 6:49-7:63 FIG. 1 (disclosing conventional “email database” that may be an “Oracle7 database” for storing messages and a separate “category database” for storing rules).

2. Claim 2

“The electronic message management system of claim 1, wherein the recipient profile application includes a global network interactive recipient profile input form, the recipient profile input form being accessible to a recipient computer via the global digital communications network.”

Law586 in view of Joshi discloses or renders obvious claim 2 for the same reasons as claim 1. EX1003 ¶¶269-75.

As discussed in limitation 1[b], Law586 discloses the claimed “recipient profile application.” Law586 discloses that web server 110 receives profile information from recipient computers 180 over the Internet using “appropriate menu and/or command driven web pages that allow the recipient and sender to log on to and provide the sought[-]after information described

above may be accomplished in any conventional manner.” EX1005, 5:46-55, FIG. 1; EX1003 ¶¶271-72; limitation 1[b].

Such well-known Internet-based menus or command-driven web pages for inputting recipient profile data includes or constitutes a “global network interactive recipient profile input form” included in “the recipient profile application,” as conventional menus/web pages conventionally included a form with fields whereby a user interacts with the web pages by inputting the relevant information (for example, as expressly described in Joshi). EX1003 ¶¶273-75, 99-106; EX1029, 11, 22, 753-810; EX1016, 3:45-49, 8:15-16, FIG. 13 (“sample universal message form”); EX1035, FIG. 7 (email input form on the web browser Netscape); EX1036, FIG. 2 (email input form), 4:1-2; limitation 1[b].

This is consistent with the ’920 patent, which generically describes the “interactive recipient profile software application” as comprising “**a web page.**” EX1001, 6:33-40; *see also* 5:46-48; EX1003 ¶271; EX1010, 132.

3. Claim 3

“The electronic message management system of claim 1, wherein the messenger profile application includes a global network interactive messenger profile input form, the messenger profile input form being accessible to a messenger computer via the global digital communications network.”

Law586 in view of Joshi discloses or renders obvious claim 3 for the same reasons as claim 1. EX1003 ¶¶276-82.

As discussed in connection with limitation 1[c], Law586 discloses the claimed “messenger profile application.” Law586 discloses that “senders 155 may establish their respective sender profiles 195 with the web server 110 during a communication session in any conventional manner.” EX1005, 5:49-52; EX1003 ¶¶285-86. And, again, web server 110 receives profile information from senders 155 over the Internet using “appropriate menu and/or command driven web pages that allow the recipient and sender to log on to and provide the sought[-]after information described above may be accomplished in any conventional manner.” EX1005, 5:46-55; EX1003 ¶287. Moreover, Figure 1 of Law586 depicts that senders access the web server (and therefore its corresponding web pages) via the Internet.

Like the “global network interactive recipient profile input form” of claim 2, a POSA would understand that the menu/web page for sender profile data includes or constitutes a “global network interactive messenger profile

input form” included in “the messenger profile application.” EX1003 ¶¶288-90, 99-106; EX1029, 11, 22, 753-810; EX1016, 3:45-49, 8:15-16; EX1036, FIG. 2, 4:1-2; EX1035, FIG. 7; EX1001, 6:33-40, 5:46-48.

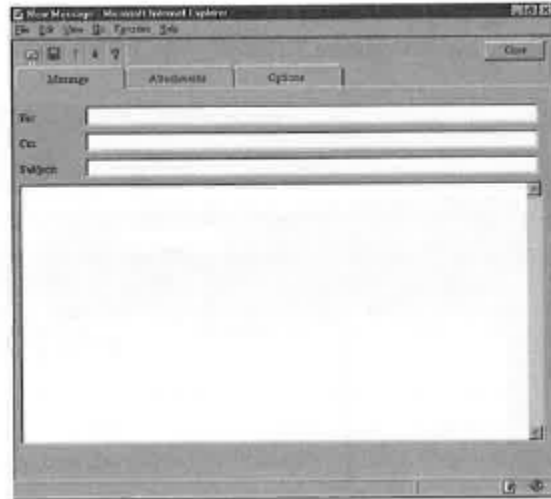
4. Claim 4

“The electronic message management system of claim 1, wherein the message input application includes an interactive global network message input form, the message input form being accessible to a messenger computer via the global communications network.”

Law586 in view of Joshi discloses or renders obvious claim 4 for the same reasons as claim 1. EX1003 ¶¶283-90.

A POSA would understand that Law773’s disclosure of “upload[ing a message] to the data center” and “communicat[ing]... with the data center” occurs over the Internet (the “global communications network”). EX1003 ¶¶285-86; *see also* EX1001, Abstract, 8:35-44, 10:10-25; limitation 1[d]. And a POSA would have been motivated to combine this teaching with OWA application of Joshi. EX1003 ¶¶288-89. A POSA would understand that the OWA application includes an interactive input form, specifically “a New Message form” accessible to a messenger computer. EX1003 ¶¶290, 99-106; EX1029, 717-18.

FIG. 31.11
New Message form.



5. Claims 5-7

“5. The electronic message management system of claim 1, wherein the recipient profile application further comprises a network interface and a recipient profile editor for receiving recipient profile data from a recipient computer via the global network interface and for manipulating the recipient profile database to store the recipient profile data.”

“6. The electronic message management system of claim 1, wherein the messenger profile application further comprises a global network interface and a messenger profile editor for receiving messenger profile data from a messenger computer via the global network interface and for manipulating the messenger profile database to store the messenger profile data.”

“7. The electronic message management system of claim 1, wherein the message input application further comprises a global network interface and a message data file editor for receiving a message file data from a messenger computer via the global network interface and for manipulating the message database to store the message data file.”

Law586 in view of Joshi discloses or renders obvious claims 5-7 for effectively the same reasons as claim 1. EX1003 ¶¶291-307.

As discussed above regarding claims 1-4, Law586 discloses the various applications that receive the relevant data over the Internet via interactive forms and store the data in the database. A POSA would understand that the software used to take information from multiple client computers via the Internet and store it in a database separate from those client computers comprises “a network interface.” EX1003 ¶¶292-296, 301, 306; EX1005, 3:31-34; EX1001, 6:4-7.

A POSA would also understand that, because these changes are implemented over a web site as part of applications, the web site and associated software used to make these changes comprise the claimed “editor[s]... for manipulating the [relevant] database to store the [relevant] data.” EX1003 ¶¶296-97, 302, 307.

6. Claim 8

8[pre] “A method of inputting data into the message management system of claim 1 from client computers via a global communications network, to centrally manage the distribution and delivery format of electronic messages from multiple messenger sources to multiple individual recipients, comprising the steps of:”

Regardless of whether the preamble is limiting, the combination of Law586 and Joshi discloses and renders obvious the claimed “method....” EX1003 ¶¶308-311.

As described above in claim 1 and further below, Law586, Law773 and Law 845 disclose or render obvious the limitations of claim 1 and include client computers (recipient and messenger computers), a global communication network (Internet), and that the system centrally manages the distribution and delivery format of electronic messages from multiple messenger sources to multiple individual recipients. *See also* limitations 8[a]-8[e] below; EX1003 ¶310.

8[a] “providing the client computers with access to the message management system via a global communications network, where the client computers are messenger and recipient computers;”

Law586 discloses limitation 8[a]. EX1003 ¶¶312-313.

As in Figure 1 (below) and discussed in claim 1, Law586 discloses providing **sender computers 155** and **recipient computers 180** with access to **web server 110** and its associated database over **Internet 102**, such that sender and recipient computers communicate with the web server. EX1005, Abstract, 3:27-4:24, 5:45-54, FIGs. 1, 4; EX1003 ¶313.

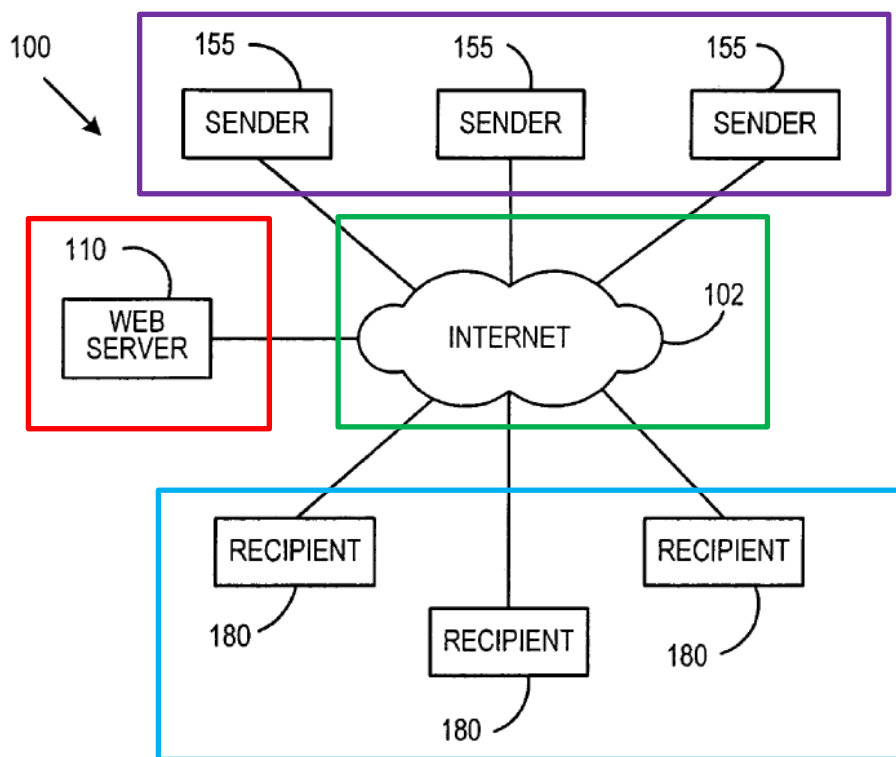


FIG. 1

8[b] *“receiving a connectivity request from a client computer for access to the message management system to input data;”*

8[c] *“connecting the client computer to the message management system via the global communication network;”*

Petitioner addresses limitations 8[b] and 8[c] together.

Law586 discloses or renders obvious limitations 8[b] and 8[c]. EX1003 ¶¶314-17. Law586 discloses that (i) recipient computers 180 and sender computers 155 “connect to the web server 110 using any conventional type of computer based communication system” over Internet 102, (ii) recipient and

sender computers “log on” to the system in order to access and then “provide the sought[-]after information,” and (iii) after logging-in, access to the system over the Internet. EX1005, 3:27-57, 6:45-55, FIG. 1; EX1003 ¶316. A POSA would understand this disclosure to correspond to “a connectivity request from a client computer for access to the message management system to input data” which connection occurs “via the global communication network” (Internet). EX1003 ¶317.

8[d] “*prompting the client computer for the data to be input by providing a data input form to the client computer; and*”

Law586 discloses or renders obvious limitation 8[d]. EX1003 ¶¶318-20. For example, as discussed in claims 2-4, a POSA would understand that the system of Law586 provides various “input forms” in the form of web pages to sender and recipient computers, which includes prompts (such as fields) to enter data as commonly used on conventional web pages. *See also* EX1003 ¶¶319-20; claims 2-4.

8[e] “*accepting input data from the client computer and entering the input data into an electronic message management database of the message management system.*”

Law586 discloses or renders obvious limitation 8[e]. EX1003 ¶¶321-22. For example, as discussed in limitations 1[a]-1[d], Law586, including Law773 and Law845, discloses that sender profiles, recipient profiles, and

messages (*i.e.*, “data”) from senders and recipients (*i.e.*, clients) are stored in the database of the message management system, and thus they must first be accepted and entered to be stored. *See also* EX1003 ¶¶322; limitations 1[a]-1[d].

7. Claims 9-10

“9. The method of claim 8, wherein the prompting step includes providing an input form to the client computer.”

“10. The method of claim 8, wherein the prompting step includes providing an input form to the client computer, the input form being at least one input form selected from the group consisting of a recipient profile form, a messenger profile form, and a message input form.”

The combination of Law586 and Joshi discloses and renders obvious claims 9-10 for the same reasons as claims 1 and 8. EX1003 ¶¶323-26. For example, as discussed in claims 2-4 and 8[d], a POSA would understand that the system of Law586 provides various “input forms” in the form of web pages including a “recipient profile form,” “messenger profile form,” and “message input form.” EX1003 ¶¶323-26; claims 2-4, 8[d].

8. Claim 11

“The method of claim 8, wherein the accepting step includes entering the input data into an electronic message management database comprising a recipient profile database, a messenger profile database, and a message database.”

Law586 discloses, or it would have been obvious to include, the limitation of claim 11; and the combination of Law586 and Joshi discloses and renders obvious claim 11 for the same reasons as claims 1 and 8. EX1003 ¶327.

9. Claim 14

“The electronic message management system of claim 1, wherein the individual message generator communicates with the database to identify messages and messenger parameters that are compatible with a recipient profile, and to configure the messages for delivery to the recipient.”

Law586 in view of Joshi discloses or renders obvious claim 14 for the same reasons as claim 1. EX1003 ¶¶328-330. For example, messages are identified by Exchange. EX1029, 67-69; EX1003 ¶¶329-30. And compatible parameters are identified when the MTA “match[es] the recipient’s address space to an available connector or gateway.” EX1029, 53; EX1003 ¶330. As a POSA would understand, the “address space” (*i.e.*, the recipient address specified by the messenger) would correspond to the claimed “messenger parameters” and the connector or gateway would be defined by the recipient profile. EX1003 ¶330.

10. Claims 15-18

Claims 15-18 require generation and sending of the individual messages via various methods. Law586 discloses such methods:

- “electronic mail,” “facsimile transmission,” and “voice mail” (claims 15, 17);
- “electronic mail” and “physical mail” (claim 16); and
- “physical mail” (claim 18).

EX1005, 3:64-4:10, 4:33-37; EX1003 ¶¶331-340.

And, the combination of Law586 and Joshi discloses and renders obvious these claims for the same reasons as claim 1. EX1003 ¶¶331-340.

C. Ground 2: Smith in view of Padwick Renders Obvious Claims 1-11 and 14-17

Smith in view of Padwick, discloses and renders obvious claims 1-11 and 14-17. As further explained below, a POSA would have been motivated to incorporate, and had a reasonable expectation of success in incorporating, the teachings of Padwick into Smith. EX1003 ¶¶341-350. Smith describes itself as a system built on top of Microsoft Outlook, and in particular, Outlook 2000. EX1016, 8:1-33, FIGs. 10, 14, 16; EX1003 ¶347. Smith also discloses the use of “custom” settings for recipient profiles. EX1016, FIGs. 10, 12, 14; EX1003 ¶348. A POSA would therefore have logically looked to and been motivated to look, when setting custom preferences, to references on

Microsoft Outlook, including those documenting features already included in Outlook 2000, as expressly disclosed in Smith. EX1003 ¶¶349. This includes the setting of specific rules for specific messengers and message types, incorporated into the system of Smith (e.g., Padwick and its “Rules Wizard” teachings for Outlook 2000). EX1003 ¶¶350, 386-87, 82-86, 88-93, 95.

1. Claim 1

1[pre] “An *electronic message management system comprising:*”

Smith discloses an “Automated System and Method for Delivery of Messages and Processing of Message Responses.” EX1016, 12:41-45; EX1003 ¶¶352. Smith’s system is capable of using “e-mail, voicemail, fax, pager and telephone communications devices.” EX1016, 2:30-31; EX1003 ¶352.

1[a] “*an electronic computer system...*”

Smith discloses, or it would have been obvious to include as part of Smith, limitation 1[a]. EX1003 ¶¶353-61.

Smith discloses a “UN Server” which includes an “Internet Information Server Module IIS 4.0,” which enables “Web based access to Outlook.” EX1016, 8:59-63, 4:15-31; EX1003 ¶¶355-56. The UN Server also includes or is connected to UN Database 8 (such as “a SQL server database”) for storing profile information, and a “Microsoft Exchange Server,” which serves

as “a messaging server controlling the flow of messages.” EX1016, 8:1-9, 8:34-39, 9:1-3, 9:48-52, FIG. 1 (below), FIG. 8 (database design), FIG. 9, FIG. 14; EX1003 ¶¶356-58. “UN Database 8 can be a conventional mass storage device combined with or linked to a processor and database engine for maintaining required recipient tables, system settings and response fields.” EX1016, 4:32-35; EX1003 ¶356. According to Smith, such a “system database” may store a variety of information, including “the recipient profiles, messages, and message response information.” EX1016, 13:13-20, 14:45-52, 15:16-16:5; EX1003 ¶356. “[T]he Database 8 will reside on the same computer that supports the UN Server although it could be located in a separate sub-system. The Database 8 is also the repository of information about the fields for a response and setup information.” EX1016 at 9:49-52, FIG. 9; *see also* 3:30-33; EX1003 ¶358.

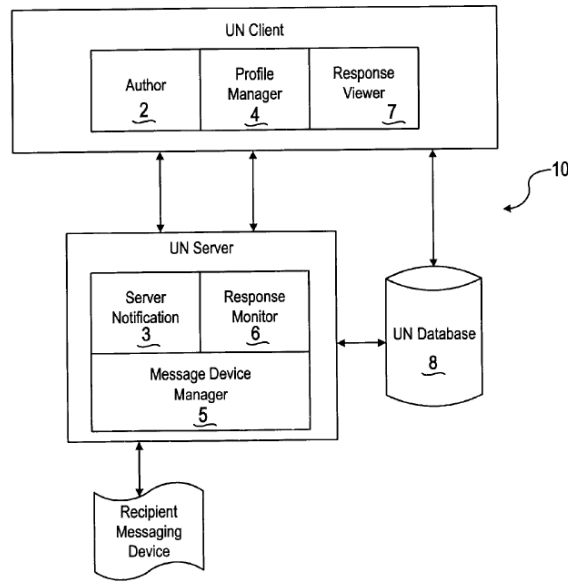


FIG. 1

A POSA would understand that the computer systems of this server, such as its hardware and software, correspond to the claimed “electronic computer system.” EX1003 ¶¶359-60. A POSA would have further understood that the connected databases (such as UN Database 8 and Exchange Server) used to store messages and profiles, constitutes or includes the claimed “electronic message management database in operative communication with the computer system.” EX1003 ¶360. This is consistent with the ’920 patent. EX1001, 6:20-23; EX1003 ¶361.

1[b] “a recipient profile application...”

Smith discloses, or it would have been obvious to include as part of Smith, limitation 1[b], EX1003 ¶¶362-88, addressed in two parts below.

First, Smith discloses the claimed “a recipient profile application for receiving recipient profile data from recipients via the global network and storing the recipient data in the database.” EX1003 ¶¶363-70.

Smith discloses a UN Client, which “would be accessed as a toolbar extension in the Microsoft Outlook 2000 environment.” EX1016, 8:6-10; EX1003 ¶365. Smith further discloses that Microsoft Outlook can be “web based” with a “conventional Internet Web Browser used to access this information.” EX1016, 8:59-63; EX1003 ¶365. The UN Client includes a “profile manager” module that “provides the recipient with tools to define their preferred method, time, priority and security of message delivery, and stores this information in a client profile.” EX1016, 4:40-44; 8:65-9:3 (“This module allows the recipient to choose which devices he/she will be contacted by and at what times and security levels these devices shall be accessed. The data for this profile will reside on the UN SQL Server database 8. The recipient profiles can be accessed and modified directly or from the Internet Web.”); 9:48-50; FIG. 14 (below); *see also* 6:2-40, FIG. 4; EX1003 ¶¶365-67.

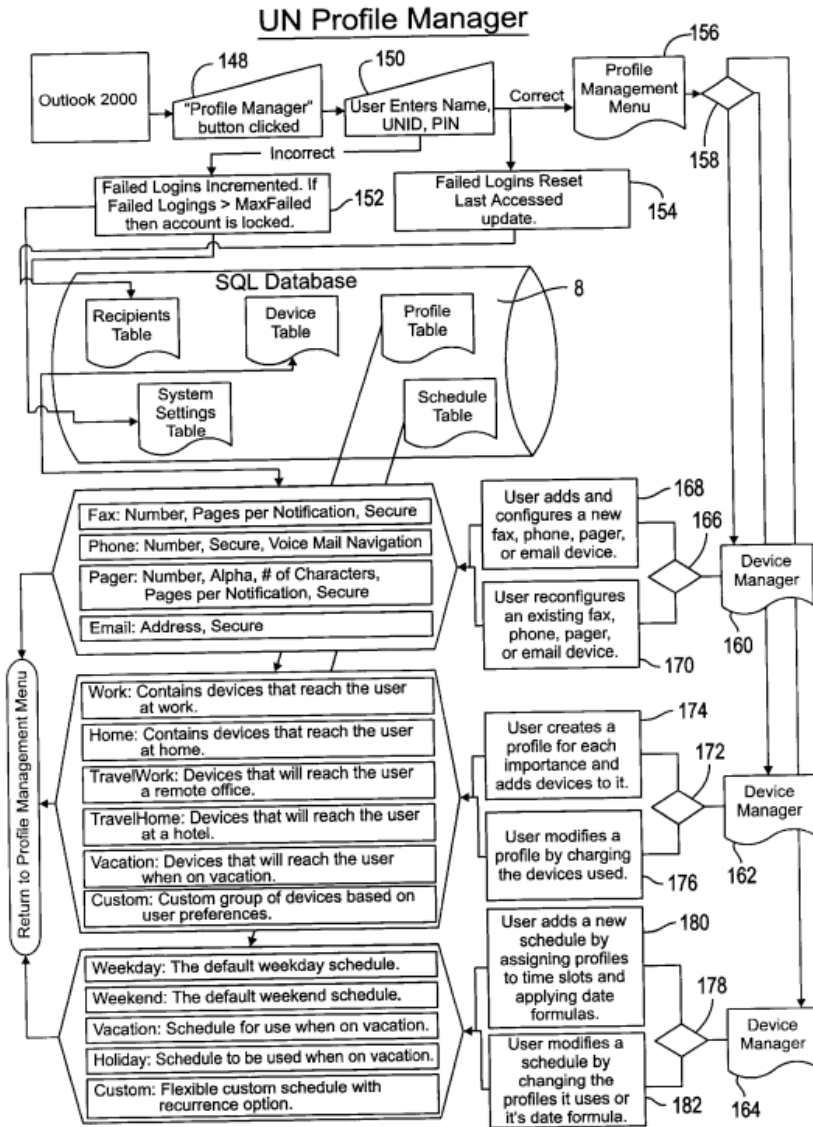


FIG. 14

A POSA would understand that the software and code used to receive the profile data “from the Web” and save it to the database constitutes the claimed “recipient profile application...” EX1003 ¶¶367-70.

Second, Smith in view of Padwick discloses the claimed “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.” EX1003 ¶¶371-401.

The profile manager of Smith, described above, allows a user to define their preferred method, time, priority, and security of message delivery. EX1016, 4:40-45, 9:4-24, FIG. 10; EX1003 ¶¶372-78. Once a message is sent by a sender, “Messaging Device Manager 5 converts the message information received from the UN Client into the proper format for receipt and response by a recipient.” EX1016, 4:47-49, 9:4-24; EX1003 ¶¶375. For example, the system may send messages via “e-mail, voicemail, fax, pager, telephone and wireless messaging devices.” EX1016, 4:53-54. Moreover, the recipient can select “whether a particular device is to be used for secure messages or not.” EX1016, 9:14-16; EX1003 ¶372.

The locations and times of messages can also be set, *e.g.*, “at certain times of the day or on certain days of the week” per recipient preference. EX1016, 9:20-22, 9:14-16; EX1003 ¶¶372-78.

Accordingly, a POSA would understand that Smith discloses that the profile data includes selection of specific times, locations, and devices involved with “specific types of messages” (*e.g.*, “normal importance” or “secure”). EX1003 ¶¶380-81, 372-74.

To the extent Smith does not expressly disclose configuring the delivery parameters for “specific types of messages from specific messengers,” this is disclosed by and rendered obvious in view of Padwick and the basic knowledge of Outlook 2000. EX1003 ¶¶380-88. Padwick discloses the creation of rules that apply to specific senders and message types, *e.g.*, example, a rule is applied to all messages from a sender or based on content and message type. EX1023, 618-46; EX1017, 51-63; EX1003 ¶¶384-88; Section V.A.4. The Outlook “Rules Wizard” in Outlook 2000 enables an email recipient to apply specific rules to a specified sender, such as “Jane Rodger,” along with message types such as high importance and delivery type. EX1023, 624-32; *see also* 634-35 (disclosing various rules); EX1017, 51-63 (discussing Rules Wizard functionality including management of specific senders and message types for importance); EX1003 ¶387; *see also* ¶¶82-98 (discussing Exchange rules).

In Outlook 2000, the rules may be stored and applied at the server or the client—just like in Smith. EX1023, 621-22; EX1003 ¶86.

Thus, a POSA would understand that the combination of Smith and Padwick disclose this limitation. EX1003 ¶388.

1[c] “a messenger profile application...”

Smith discloses, or it would have been obvious to include as part of Smith, limitation 1[c]. EX1003 ¶¶389-401.

Smith discloses that both senders and messengers use the same “UN Client” as recipients; however, the senders must be licensed. EX1016, 11:46-48 (“UN Client licenses can be purchased for additional users. Only senders must be licensed...”); EX1003 ¶392.

A POSA would accordingly understand that, to use the system, a sender would use a profile managed through the same Web-based system as the recipients described in connection with limitation 1[b], and that that this would require identification data stored in the database to log into the system. EX1003 ¶¶392-98; EX1016, 7:33-39 (“UN System identification 230 [contained in UN Database 8] provides information for user log in and access along with unique user identification and PIN 234.”), 11:53-67 (describing similar “Administration Console”), 12:5-9; EX1018, 9:26-30 (similarly requiring a sender database and ID data to keep track of sender payment). As shown in Figure 8, below, these message identifiers are stored in UN Database 8. EX1016, 7:33-39; FIG. 8; EX1003 ¶399.

Smith's UN Client, which would be accessed via a web-based version of Outlook provided by the UN Server, includes "Message Author," presents message senders with "a blank UN universal message form" in which the user "select[s] from a list of recipients" and enters a "message body and attachments." EX1016, 5:12-28, FIG. 2; EX1003 ¶¶402-05. Smith discloses that these messages are then sent to the UN server (*e.g.*, to the memory of the UN Server for storage) to be processed according to the recipient's preferences. EX1016, 10:61-65 ("Once the message is sent, the UN Server provides text-to-speech conversion and Voice mail navigation for phone and Voice mail recipients."), 5:53-55 ("Upon completion of the [UN Client Author process], messages are sent to the Messaging Device Manager 5."), 8:10-16, FIG. 9 (below); EX1003 ¶406.

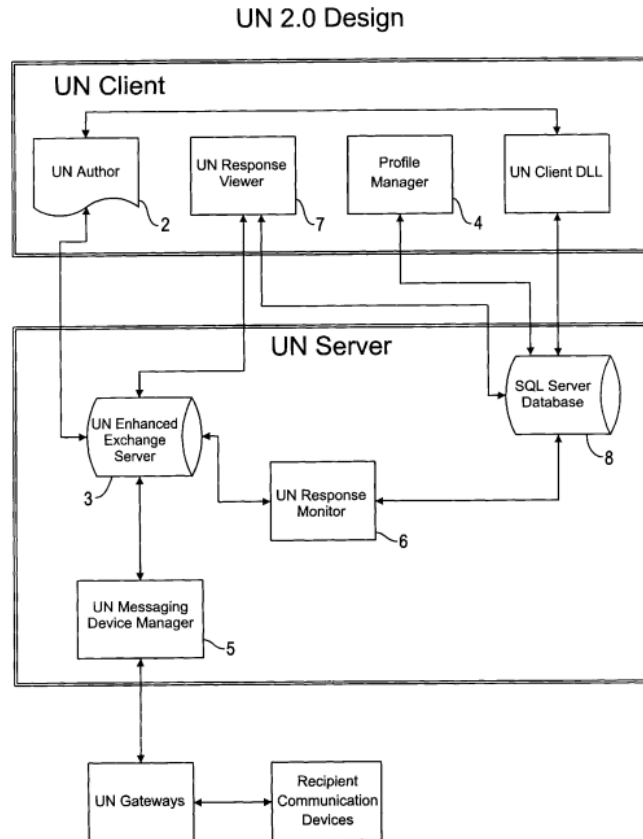


FIG. 9

Smith further discloses in Figure 13, below, “a graphic display of a sample universal message form used with the system of FIG. 9, further showing response fields added to the form by the message originator using the Message Author Module.” EX1016, 3:45-48, 8:10-32, 10:48-65, FIG. 13; EX1003 ¶406. In Figure 13, “the user is presented with a standard universal message form,” “he/she then selects the recipient from the global address list, adds fields if desired, fills out the message form, and sends the message.” EX1016, 10:53-57; EX1003 ¶407.

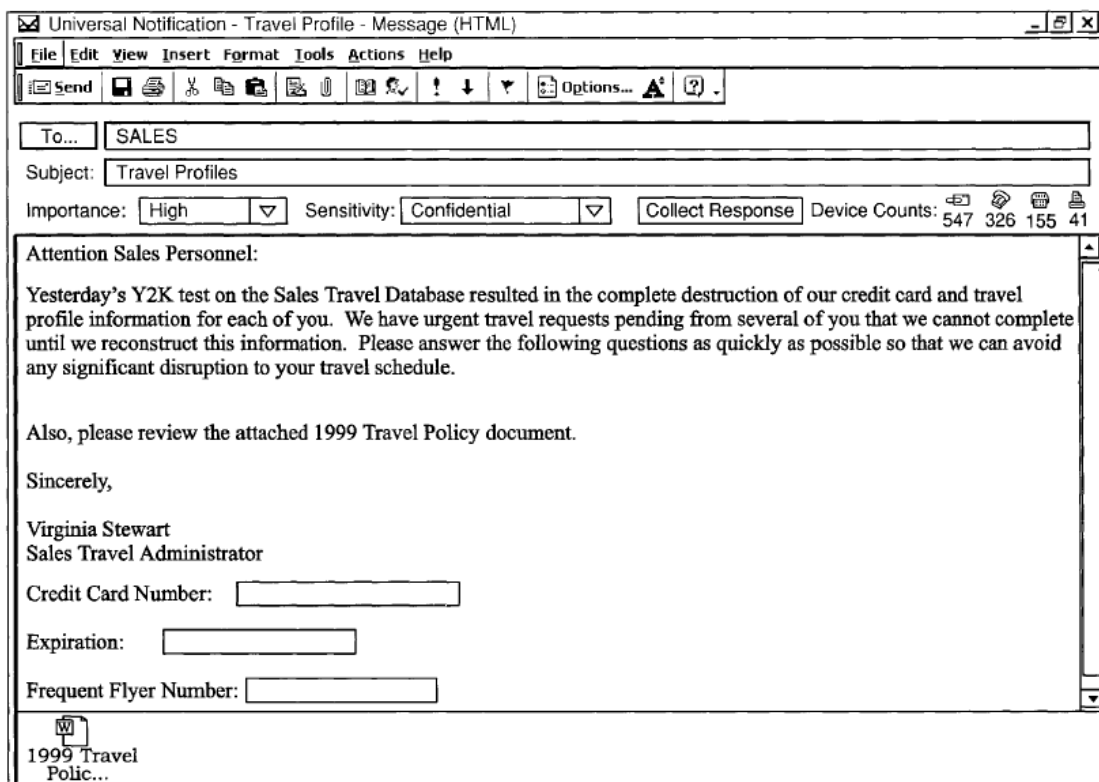


FIG. 13

A POSA would understand that Smith's web server application software and code used to receive information over the Internet (including message files input by a sender) includes or constitutes the claimed "a message input application for receiving message files from a messenger via the global network." EX1003 ¶412; *see also* limitations 1[a]-1[c].

A POSA would further have understood that the received message files would logically be stored in the database of Smith (such as the disclosed "system database" to store messages, recipient profiles and other information), which constitutes the claimed "electronic message management

database in operative communication with the computer system.” EX1003 ¶¶409-11; EX1016, 13:13-20, 14:45-52, 15:16-16:5; EX1023, 914.

1[e] “*an individual message generator...*”

Smith discloses that “Messaging Device Manager 5 converts the message information received from the UN Client into the proper format for receipt and response by a recipient.” EX1016, 4:46-49; EX1003 ¶¶415-16. The format used by Messaging Device Manager 5 “corresponds to the messaging device(s) selected by the recipients and stored in their respective client profiles,” which profiles “reside[] on the UN SQL Server Database 8” such that “[t]he recipient profiles can be accessed and modified either directly or from the Internet web.” EX1016, 4:50-52, 8:64-9:3; FIG. 14; EX1003 ¶416. To do this, Messaging Device Manager 5 accesses the recipient profiles and messages stored in the database, *e.g.*, it may access message files. EX1016, 8:46-50 (“Specially named folders residing on Exchange handle forwarding of non-email based messages. The Messaging Device Manager 5 monitors these folders and directs their messages to the appropriate gateway (FIG. 9).”); EX1003 ¶416.

A POSA would understand that, by accessing the message files along with data necessary to determine the proper format for receipt, the Device Manager includes or constitutes “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.... via the global communications network according to the delivery parameters.” EX1003 ¶¶415-19. Moreover, a POSA would understand that the recipient would have been “specified by the messenger” for sending the message to the recipient over the Internet. EX1003 ¶¶418-19; EX1016, 5:19-23.

1[f] “*a message management server operating system; and*”

Smith discloses that UN Server may include an “operating system” such as Windows 98 or 2000, EX1016, 8:1-4; EX1003 ¶421, just as in the ’920 patent, EX1001, 7:1-8.

1[g] “*the message management database including...*”

As discussed above, Smith discloses a UN Server, which a POSA would understand to include or be connected to one or more databases in which the relevant information is stored (such as messages and profiles). EX1003 ¶¶423-25; EX1016, FIG. 8, 9:48-53, 10:5-46, 12:17-22.

Database Design

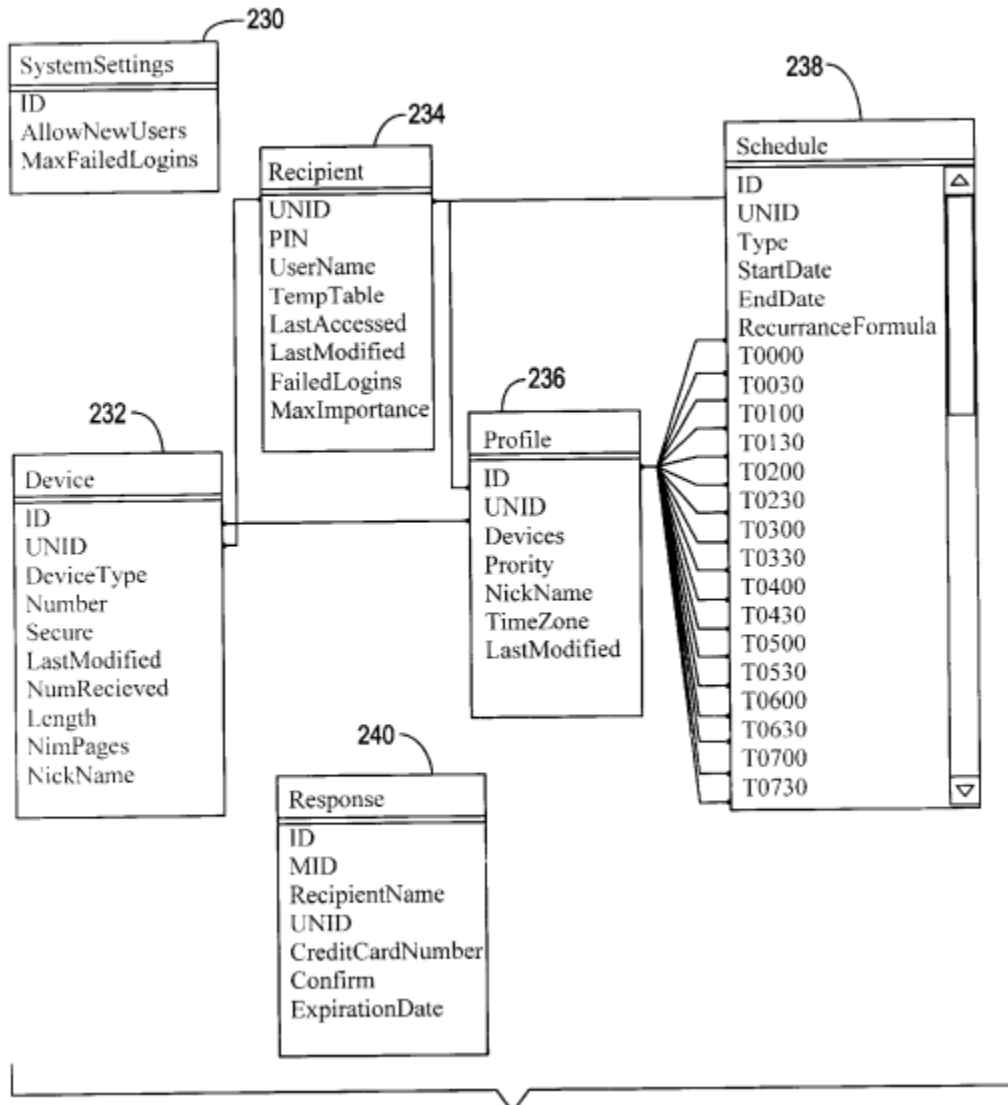


FIG. 8

Smith describes storing the recipient profile information in a specific database on the memory of the UN Server. EX1016, 9:1-2 (“The data for this profile will reside on the UN SQL server database 8.”). Smith also describes storing messages in a specific database in the memory of the UN Server.

EX1016, 8:46-50 (“Specially named folders residing on Exchange handle forwarding of non-email based messages. The Messaging Device Manager 5 monitors these folders and directs their messages to the appropriate gateway (FIG. 9).”); EX1003 ¶416.

Smith does not specifically describe the specific layout or structure used to store the sender profile (*e.g.*, the license and log in information for senders). EX1003 ¶427. However, a POSA would have inferred that this information is stored similar to the recipient profiles, as Smith describes them as managed by administrators in the same way. EX1003 ¶427; EX1016, 11:49-52 (“All global address list entries are initially notified of the UN Profile Manager opportunity from the administration Console, where both registered Client users and recipient profiles are managed.”). And Smith teaches that its system uses SQL server and Exchange server as the “database standards.” EX1016, 12:17-24; EX1003 ¶¶428-29.

2. Claim 2

Smith discloses or renders obvious the limitation of claim 2, and Smith and Padwick render obvious claim 2 for the same reasons as claim 1. EX1003 ¶¶431-34.

As discussed in limitation 1[b], Smith discloses the claimed “recipient profile application.” EX1003 ¶433; limitation 1[b]. Smith discloses a UN

Client, which “would be accessed as a toolbar extension in the Microsoft Outlook 2000 environment” which would be “web based” and accessed via a “conventional Internet Web Browser” and implements a user interface that the user fills out. EX1016, 4:4-12, 8:1-53, FIG. 20 (below), FIGs. 21-22; EX1003 ¶433.

The image shows a screenshot of a software window titled "Profile Manager". It has a standard Windows-style title bar with a close button (X). Below the title bar, there are two tabs: "Actions" and "Tabs", with "Tabs" being the active tab. Under the "Tabs" tab, there are three sub-tabs: "Devices", "Profiles", and "Schedules", with "Devices" being the active sub-tab. The main content area of the "Devices" sub-tab is divided into two sections. The top section is labeled "Phone" and contains a dropdown menu with a downward arrow. Below this, there are two text input fields: "Home Phone" and "Work Phone". The bottom section is labeled "Settings" and contains several fields: "Device Name" with the value "Work Phone", "Phone Number" with the value "(615)790-2882", "Pages per Message" with the value "0", "Characters" with the value "0", and "Device Secure" with a checked checkbox. There is a "Pager Settings" button in the bottom right corner of the "Settings" section. At the very bottom of the window, there are three buttons: "Ok", "Cancel", and "Apply".

FIG. 20

A POSA would understand that this entry corresponds to the claimed “form.” EX1003 ¶434.

3. Claim 3

Smith discloses or renders obvious the limitation of claim 3, and Smith and Padwick render obvious claim 3 for the same reasons as claim 1. EX1003 ¶¶435-38.

As discussed in connection with limitation 1[c], a POSA would understand that, to use the system, a sender would use a profile managed through the same Web-based system as the recipients described in connection with limitation 1[b]. EX1003 ¶437. A POSA would accordingly find that Smith discloses claim 3 for the same reasons as claim 2. EX1003 ¶¶436-38.

4. Claim 4

Smith discloses or renders obvious the limitation of claim 4, and Smith and Padwick render obvious claim 4 for the same reasons as claim 1. EX1003 ¶¶439-443.

Smith discloses that the messages are input via a “universal message form.” EX1016, 8:15-31, FIG. 13; *see also* 5:12-44; EX1003 ¶¶441-42. A POSA would understand that this constitutes the claimed “message input form.” EX1003 ¶443.

5. Claims 5-7

Smith and Padwick disclose and render obvious claims 5-7 for the same reasons as claim 1. EX1003 ¶¶444-460. A POSA would understand that the

profile applications receive the relevant information over the Internet and each comprise a “network interface.” EX1003 ¶¶444-460.

6. Claim 8

8[pre]

Smith and Padwick disclose and render obvious claim 8 for the same reasons as claim 1. EX1003 ¶¶461-64. Smith discloses or renders obvious the limitations of claim 1 and includes client computers (recipient and messenger computers), a global communication network (Internet), and that the system centrally manages the distribution and delivery format of electronic messages from multiple messenger sources to multiple individual recipients. *See also* limitations 8[a]-8[e] below; EX1003 ¶463.

8[a]

Smith discloses or renders obvious limitation 8[a]. EX1003 ¶465. Smith discloses providing client computers (including both messenger and sender computers as discussed in limitations 1[a]-1[c]) access to the UN Server via the Internet. EX1003 ¶465.

8[b]-8[c]

Smith discloses or renders obvious limitations 8[b] and 8[c]. EX1003 ¶¶466-69. Smith discloses that client computers for both messengers and recipients) “log on” to the system in order to access it. EX1016, 7:36-39, FIG. 14; EX1003 ¶468. A POSA would understand this disclosure corresponds to

“a connectivity request from a client computer for access to the message management system to input data” which connection occurs “via the global communication network” (Internet). EX1003 ¶469.

8[d]

Smith discloses or renders obvious limitation 8[d]. EX1003 ¶¶470-72. For example, as discussed in claims 2, 3, and 4, a POSA would understand that the system of Smith provides various “input forms” which include prompts (such as fields) to enter data. *See also* EX1003 ¶472; claims 2-4.

8[e]

Smith discloses or renders obvious limitation 8[e]. EX1003 ¶¶473-74. For example, as discussed in limitations 1[a]-1[d], Smith discloses that sender profiles, recipient profiles, and messages (“data”) from senders and recipients (clients) are stored in the database of the message management system, and thus they must first be accepted and entered to be stored. *See also* EX1003 ¶474; limitations 1[a]-1[d].

7. Claims 9-10

Smith and Padwick disclose and render obvious claims 9-10 for the same reasons as claims 1 and 8. EX1003 ¶¶475-477. As discussed in claims 2-4 and 8[d], a POSA would understand that the system of Smith provides various “input forms” to the client computer, including a “recipient profile

form,” “messenger profile form,” and “message input form.” EX1003 ¶¶476-77; claims 2-4, 8[d].

8. Claim 11

Smith discloses, or it would have been obvious to include, the limitation of claim 11, and Smith and Padwick disclose and render obvious claim 11 for the same reasons as claims 1 and 8. EX1003 ¶478.

9. Claim 14

Smith and Padwick disclose and render obvious claim 14 for the same reasons as claims 1 and 8. EX1003 ¶¶479-81. A POSA would understand that Exchange also “identif[ies] message and messenger parameters that are compatible with a recipient profile” after having obtained specific recipient addresses and having directed these addressed messages to the Exchange MTA for delivery. EX1029, 67-69; EX1003 ¶481. The compatible parameters (*i.e.*, “address space” or “messenger parameters”) are identified when the MTA “match[es] the recipient’s address space to an available connector or gateway.” EX1029, 53; EX1003 ¶481. The connector or gateway it is matched would be determined by addresses in the recipient profile. EX1003 ¶481.

10. Claims 15-17

Smith discloses or renders obvious the limitations of claims 15-17 (including generating and sending the message via “electronic mail,” “facsimile transmission,” “voice mail,” and/or “wireless transmission”).

EX1016, 4:52-57, 6:47-58; EX1003 ¶¶482-84. Smith and Padwick disclose and render obvious these claims for the same reasons as claim 1. EX1003 ¶¶482-84.

VI. Section 314 Denial is Unwarranted

1. The *Fintiv* Factors Favor Institution

Because no trial date has been set, there is no need to engage in the analysis under *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). See *Beckman Coulter, Inc. v. Sirigen II Ltd.*, IPR2022-01206, Paper 12, 16-17 (PTAB Jan. 6, 2023). Even if a trial date is set prior to the Board’s institution decision, consideration of the *Fintiv* factors and the Director’s June 21, 2022, Memorandum on the Interim Procedure (“Director Memo”) favors institution.

Factor 1 is neutral. The district court’s decision on any stay will come after institution and is “based on a variety of circumstances and facts beyond [the Board’s] control and to which the Board is not privy.” *Sand Revolution II, LLC v. Continental Intermodal Group – Trucking, LLC*, IPR2019-01393, Paper 24, 7 (PTAB Jun. 16, 2020) (informative).

Factor 2 favors institution. There is no schedule or trial date. EX1024. Even if one is set, the actual trial will not occur before the Board issues a final decision due to the over 550 hundred other patent cases pending before the

same judge, and the tendency for the court's trial dates to be pushed back. EX1025, 3; EX1026, 2; EX1027; *Micron Tech., Inc. v. Godo Kaisha IP Bridge 1*, IPR2020-01008, Paper 10, 13-14 (PTAB Dec. 7, 2020); Director Memo, 8. Moreover, the median time-to-trial for civil actions in the Western District of Texas is 29.5 months (and even later here, given there is no schedule). EX1028, 2; Director Memo, 8-9 & n.12

Factor 3 favors institution. The district court case is in its infancy. There is no schedule or trial date, no discovery has occurred, and the district court has invested no time on the merits.

Factor 4 favors institution. Petitioner expects its invalidity positions in district court will be vastly different from the grounds here (*e.g.*, product prior art). If a trial date is set before the Board's institution decision and the Board institutes here, Petitioner stipulates that it will not pursue invalidity on the same grounds in district court. *See Fintiv*, IPR2020-00019, Paper 11, 12-13; *Sand Revolution*, IPR2019-01393, Paper 24, 12.

Factor 5 is neutral. The parties are involved in the district-court case.

Factor 6 favors institution. Petitioner's Grounds are compelling. *Fintiv*, IPR2020-00019, Paper 11, 14-15; Director Memo, 4-5.

2. The General Plastic Factors Favor Institution

The General Plastic factors favor instituting Petitioner's first and only petition challenging the '920 patent. *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 15-19 (PTAB Sept. 6, 2017) (precedential at § II.B.4.i).

Factor 1 strongly favors institution because Petitioner is not a party to any prior IPR challenging the patent and is unrelated to the petitioner in the Unified IPR. *Samsung Elecs. Co., Ltd.*, IPR2022-00222, Paper 12, 10-11 (PTAB June 13, 2022); *Shenzhen Apaltek Co., Ltd. V. Asetek Danmark A/S*, IPR022-01318, Paper 7, 10 (PTAB Feb. 6, 2023).

Factors 2, 4, and 5 “have... little relevance” and favor institution because (i) Petitioner has never challenged the '920 patent, (ii) the parties are neither the same nor related, (iii) Petitioner filed its own Petition to protect its right such as if the Unified IPR is terminated before final decision but after Petitioner's one-year bar date, and (iv) the case against Petitioner remains in its infancy and thus so did Petitioner's investigation of invalidity until it turned to file the instant IPR before its one-year bar. *Apaltek*, IPR022-01318, Paper 7, 11; *Unified Patents, Inc. v. Certified Measurement, LLC*, IPR2018-00548, Paper 7, 7-8 (PTAB Sept. 5, 2018).

Factor 3 favors institution or at least is neutral because Petitioner did not use the Unified proceeding as a “roadmap” and the Petition “relies upon... different combination[s] of prior art references... and challenges a different set of claims,” *Samsung*, IPR2022-00222, Paper 12, 11; *Streck, Inc. v. Ravgen, Inc.*, IPR2021-01577, Paper 20, 22-24 (PTAB Apr. 22, 2022).

Factors 6 and 7 are “efficiency considerations.” *Valve Corp. v. Electronic Scripting Products, Inc.*, IPR2019-00063, Paper 13, 15 (PTAB Apr. 2, 2019) (precedential). The Petition promotes adjudicative efficiencies. It challenges additional claims and relies on significant prior art and testimony not previously before the PTAB or considered during original prosecution.

VII. Section 325 Denial is Unwarranted

The Board should not exercise its discretion under 35 U.S.C. §325(d) to deny institution because no reference used as the basis for a ground herein was applied to the challenged claims. *See Apple Inc. v. Omni MedSci, Inc.*, IPR2020-00175, Paper 11, 11 (PTAB June 17, 2020); *Zip Top, LLC v. Stasher, Inc.*, IPR2018-01216, Paper 14, 35 (PTAB Jan. 17, 2019); *Amazon.com, Inc. v. M2M Sols. LLC*, IPR2019-01205, Paper 14, 16 (PTAB Jan. 27, 2020).

Further, denial is unwarranted because: (i) Ground 1 relies exclusively upon references not disclosed during prosecution (and, thus, in combinations

not available then); (ii) although Smith was disclosed during prosecution, Ground 2 additionally relies on Padwick, which was not disclosed during prosecution and Smith was never applied by the examiner to reject any claim; (iii) no rejection based on any combination used herein was raised during prosecution; (iv) if the references in any ground had been actually considered, the claims would have been found obvious (*e.g.*, Padwick adds important disclosure about rules in Outlook 2000 and considered in connection with Smith, renders obvious the claims); and (v) all grounds rely upon the new testimony of Dr. Martin which explains how a POSA would understand the prior art's teachings and state of the art, and why a POSA would have found the combinations obvious. *See Caterpillar Inc. v. Wirtgen Am., Inc.*, IPR2022-01278, Paper 12, 43 (PTAB Feb. 7, 2023); *Tesla, Inc. v. Arsus, LLC*, IPR2022-01216, Paper 9, 7-8 (PTAB Dec. 23, 2022); *Amcol Int'l Corp. v. Oil-Dri Corp. of Am.*, IPR2022-01107, Paper 10, 12-14 (PTAB Dec. 5, 2022).

VIII. Conclusion

The Challenged Claims are unpatentable. Petitioner requests cancellation.

Respectfully submitted,

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LEHMAN & FELDBERG LLP

Dated: April 24, 2023

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CERTIFICATE OF COMPLIANCE

I hereby certify that this paper complies with the type-volume limitation of 37 C.F.R. §42.24 (as determined by the Microsoft Word word-processing system used to prepare this paper) because it contains 13,594 words, excluding the parts of the paper exempted by 37 C.F.R. §42.24(a).

REICHMAN, JORGENSEN,
LEHMAN & FELDBERG LLP

Dated: April 24, 2023

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing Petition for *Inter Partes* Review and the Exhibits listed on the List of Exhibits were served on Monday, April 24, 2023 pursuant to 37 C.F.R. §§42.6 and 42.105 via Federal Express, upon the following:

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