

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,

Petitioner,

v.

PETER HENRIK PEDERSEN,

Patent Owner.

IPR2023-00867
U.S. Patent No. 6,965,920

PATENT OWNER PETER HENRIK PEDERSEN'S PRELIMINARY
RESPONSE TO PETITION FOR INTER PARTES REVIEW OF U.S. PATENT
NO. 6,965,920

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	OVERVIEW OF THE '920 PATENT (EX1001).....	1
A.	Summary.....	1
B.	The '920 Patent File History	13
C.	Person of Ordinary Skill in the Art	14
D.	Claim Construction.....	14
III.	THE SPECIFIC GROUNDS OF UNPATENTABILITY	15
IV.	THE ASSERTED PRIOR ART	16
A.	Law.....	16
B.	Joshi	17
C.	Smith	18
D.	Padwick.....	20
V.	PETITIONER HAS NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE PETITION	21
A.	Requirements for Showing Obviousness Under 35 U.S.C. § 103.....	21
B.	Petitioner Fails to Establish Ground I: Law586 in view of Joshi Would Render Claims 1-11 and 14-18 Obvious.....	23
C.	Ground 2: Smith in View of Padwick Fails to Render Obvious Claims 1-11 and 14-17	33
V.	CONCLUSION.....	39

TABLE OF AUTHORITIES

Cases

<i>Broadcom Corp. v. Emulex Corp.</i> , 732 F.3d 1325, 1335 (Fed. Cir. 2013)	22
<i>Chef America, Inc. v. Lamb-Weston, Inc.</i> , 358 F.3d 1371 (Fed. Cir. 2004)	15
<i>Graham v. John Deere Co.</i> , 383 U.S. 1, 17–18 (1966)	21
<i>Innogenetics, N.V. v. Abbott Labs.</i> , 512 F.3d 1363, 1373 (Fed. Cir. 2008)	23
<i>Pers. Web Techs., LLC v. Apple, Inc.</i> , 848 F.3d 987, 994 (Fed. Cir. 2017)	22
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	15
<i>In re Zletz</i> , 893 F.2d 319 (Fed. Cir. 1989)	15

Statutes

37 C.F.R. § 42.107	1
37 C.F.R. §42.100(b)	14

Patent Owner's Exhibits

Exhibit No.	Description
EX2001	Declaration of Warner Scheyer
EX2002	Curriculum Vitae of Warner Scheyer

I. INTRODUCTION

On April 24, 2023, Oracle Corporation (“Oracle” or “Petitioner”) submitted a Petition for *Inter Partes Review* (“Petition”) of U.S. Patent No. 6,965,920 (EX1001, “the ’920 Patent”), challenging Claims 1-11 and 14-18 (“Challenged Claims”). Pursuant to 37 C.F.R. § 42.107, Patent Owner Peter Henrik Pedersen (“Pedersen” or “Patent Owner”) files this Patent Owner Preliminary Response to the Petition, setting forth reasons the Board should deny institution.

Petitioner fails to establish a reasonable likelihood that the Challenged Claims are unpatentable. Patent Owner will specifically address each of Petitioners arguments in the following sections.

II. OVERVIEW OF THE ’920 PATENT (EX1001)

A. Summary

The ’920 Patent relates to the “central filtering and distribution processing of messages from multiple messengers to selected individual recipients” using parameters “established by each intended recipient.” EX1001, Abstract.

The ’920 Patent is directed to electronic computers and digital processing systems for filtered and targeted electronic message distribution. EX1001 at 1:11-13. However, as discussed by the ’920 Patent, the filtered and targeted electronic message distribution methods used by CRM systems and networks known at the time of the invention were too complex, costly, and in general not effective. *Id.* at

1:31-67. Rather, the '920 Patent provides an effective and improved technical solution for central filtering and distribution processing of messages in a CRM networked system from multiple messengers to selected recipients under filtering and distribution parameters in part established by each intended recipient. *Id.* at 1:13-18. This technological improvement was not known at the time of the invention.

The specific technical problem solved by the '920 Patent is related to the inaccessibility of efficient electronic message management for customer relation management of organizations, which results in widespread use of inefficient mass communication means through an organization's information technology and customer service departments. *Id.* at 1:58-60. Prior to the invention, for organizations to keep customers and clients updated with the kind of information and messages that will assure goodwill and loyal behavior was a complex task requiring costly resources, focus, and complex information technology solutions. *Id.* at 1:31-35. Organizations used rule-based CRM IT systems, which were designed to handle message profiles based on rules for how each individual customer or client will receive information and messages from the organization. *Id.* at 1:35-39. Since customer information can be critical for many organizations, CRM systems are most often for security reasons maintained by the customer service department inside an organization. Defining and changing message profiles requires an interaction between each individual customer and the customer service department, to prevent

unauthorized access to the CRM system by individuals. *Id.* at 1:40-47. These message profiles must be entered and maintained in every single CRM system in every organization for each and every customer and client. The customers and clients will find it both time consuming and difficult to contact all of his or her information suppliers to make them update the customer's profile with, for example, a new e-mail address or phone number. *Id.* at 1:47-53.

Because of the complexity, time consuming and resource-demanding task of defining, operating, and maintaining messages profiles on a one-to-one basis in prior CRM systems, only a few organizations are able to keep customers and clients informed with respect to how, when, and where the individual customer prefers to receive his or her message information. *Id.* at 1:53-55. The inaccessibility of efficient message management systems and methods results in widespread use of inefficient mass communication systems, such as systems that send out spam Email. *Id.* at 1:58-61. Further, the distribution to a potential customer of relevant information, but at the wrong time or in the wrong place, may disappoint or frustrate a receiver who missed or was not able to use the information. These considerations may even dissuade companies from distributing any information at all, because it is too complex, costly, and time consuming. The result is that customers are motivated to exploit alternative companies, lowering customer loyalty, and lowering overall business effectiveness dramatically. *Id.* at 1:64-2:6.

Attempts have failed to address the core problems of the inefficiency and complexity of the one-to-one CRM messaging systems. For example, in U.S. Pat. No. 5,765,033 to Miloslavsky, the patent describes a rule based electronic mail system for receiving messages, extracting information from the message, and then forwarding the extracted information to a particular recipient based on the content of a set of rules. However, the recipient of the information and the sender of the message do not have direct access to the rule set and the ability to redefine the sets of parameters. EX1001 at 2:8-16. In U.S. Pat. No. 6,182,118 to Finney, et al., a rule-based system is disclosed for managing electronic messages where a recipient can access the rule set and define in advance certain parameters controlling whether a message received by the system is forward to the recipient. However, the Finney system does not provide the sender of the message with the ability to define any parameters of the rules controlling the forwarding of its messages to a designated recipient or group. EX1001 at 2:16-25.

The invention disclosed in the '920 Patent provides a specific technical solution to these technical problems that is not found in prior systems or methods. The invention is beneficial to have an electronic message management system where each individual recipient can access a rule set and maintain the parameters of his or her own message profile, thus enabling each recipient to designate specific or classes of messengers from whom they are willing to receive a message, was well as specify

how the information or messages are to be delivered. *Id.* at 2:26-33. Additionally, the invention of the '920 Patent provides for messengers (those organizations creating and sending messages) to be able to submit not only message content, but also individual and group recipient profiles or identifications to the central message management system rule set, to enable message distribution and delivery to recipients according to individual recipient profiles. *Id.* at 2:33-38. Further, the electronic messaging system of the invention allows individual recipients to centrally define a plurality of recipient profiles specifying how messages from messengers generally or from certain messengers specifically must be distributed to the recipient. *Id.* at 2:38-42.

An example of an architecture for the '920 Patent includes messenger client computers and recipient client computers that have access to the Internet. A web server is coupled to a specialized message management server of the invention. The client computers can access the message management server through the Internet and web server using web browsing software. *Id.* at 5:21-51.

FIG. 2 of the '920 Patent (reproduced below) shows the components of an embodiment of the message management Server 50. The message management server 50 includes a profile database 56 for centrally storing profile and other information received from messengers and recipients. *Id.* at 6: 22-25.

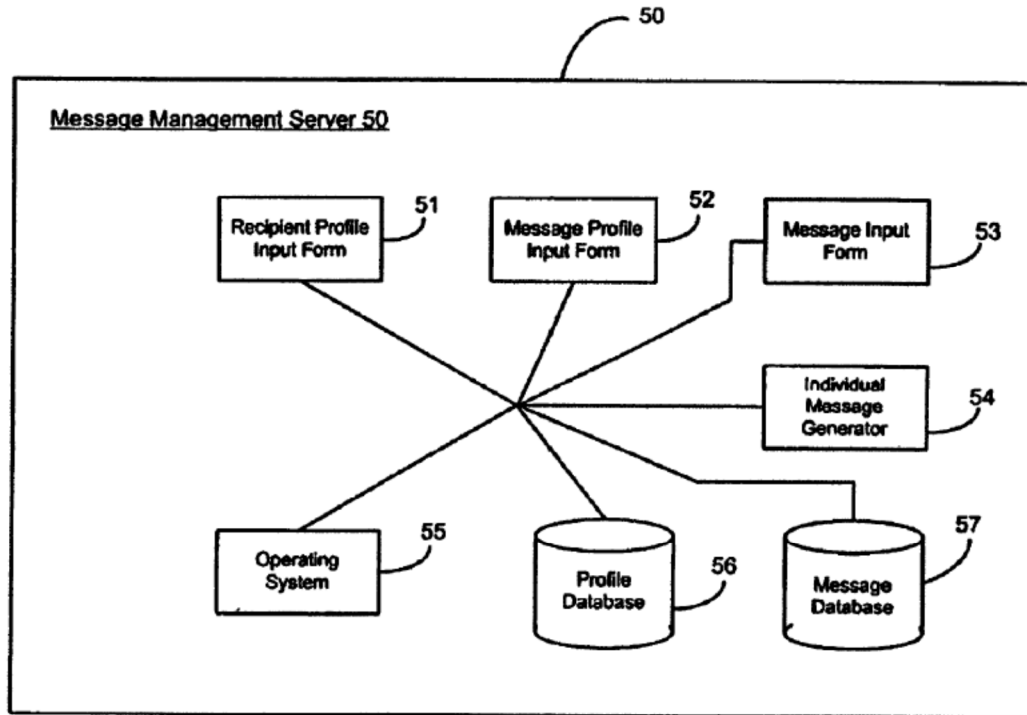


Fig. 2

Figure 2 – '920 Patent

The message management server 50 comprises a recipient profile software application which includes a recipient profile input form 51. EX1001, 6: 33-35. A recipient will log on to the message management system server 1000 and enter his/her basic identification data. The identification data will be stored in the recipient ID and profile database 121, a subsystem of the profile database 56 of FIG. 2. In addition, the recipient will enter one or more sets of message profile data, specifying one or more messengers, type of messages and type of content the recipient wishes to receive from each messenger. This data will be stored in the recipient message

profile database 122, a subsystem of the profile database 56 in FIG. 2. *Id.* at 7: 56-65.

The message server 50 also comprises a messenger profile software application, which includes a messenger profile input form 52. EX1001, 6: 43-45. A messenger utilizes the messenger profile editor/web interface 250 to enter one or more sets of messenger profile data, specifying the types of messages and types of content the messenger is providing to recipients in general. This profile is stored in the messengers message profile database 222, a subsystem of the profile database 56 of FIG. 2. Also, a messenger can specify a list of specific recipient ID's, each combined with a set of message types and content types that the identified must receive. *Id.* at 8: 18-26. The message management server also includes a recipient profile software application that includes the recipient input form. The recipient profile input form includes discrete information fields that are displayed at a recipient's client computer, which can receive information from the recipient through the computer. These records are stored in the profile database.

The individual message generator 54 obtains information from the database 57 and generates an individual messages for each recipient, based on the combination of recipient and messenger profile parameters and messages entered into the profile 56 and message 57 databases. EX1001, 6: 63-67. Recipients are users that are the targeted receivers of messages generated and sent by messengers via the

message generator. *Id.* at 7:15-18. Figure 4 of the '920 Patent illustrates an overall principle of the message management server:

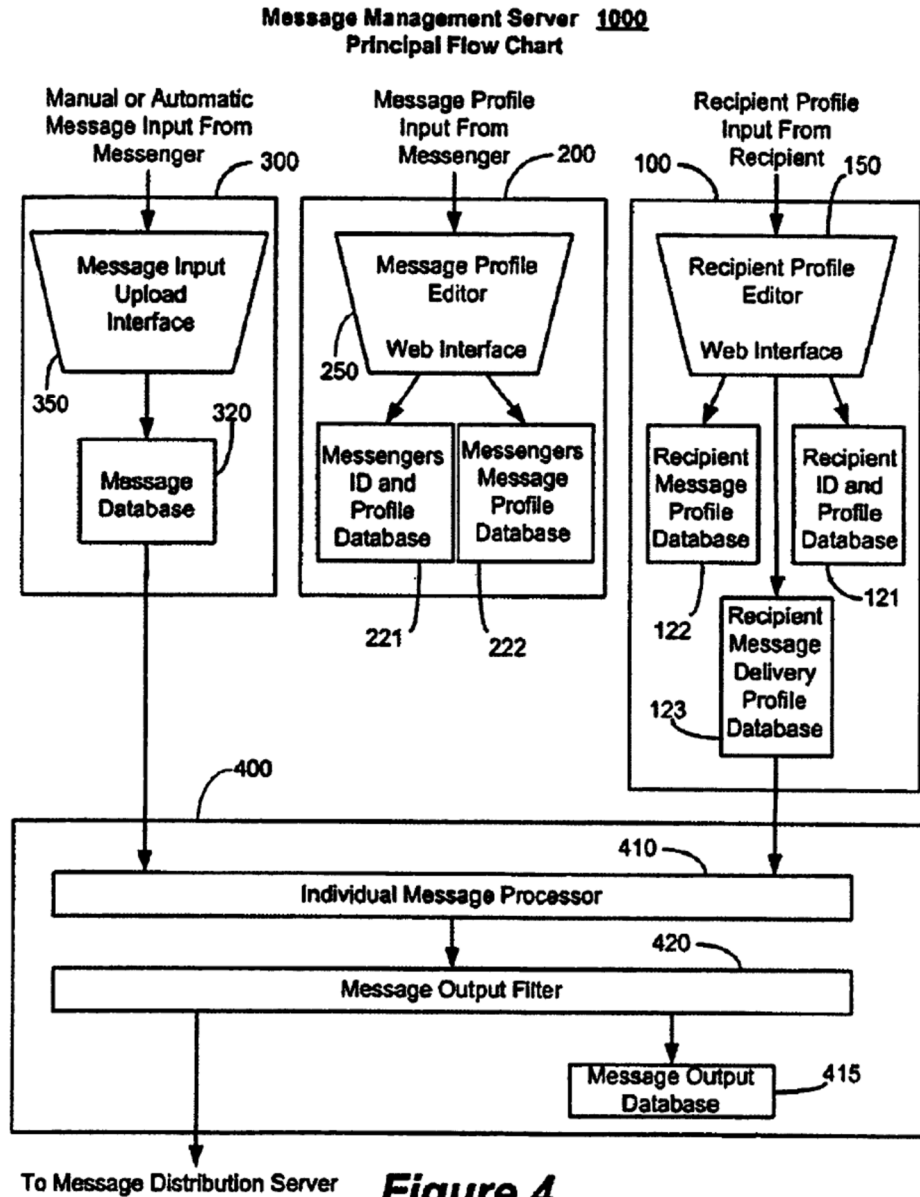


Figure 4

Figure 4 – '920 Patent

A recipient profile system of the message management server is for entering, managing, and storing rules about how the server communicates with each individual recipient. A recipient can log onto the server and enter his/her basic information data and one or more sets of message profile data specifying one or more messengers, types of messages and type of content the recipient wishes to receive from each messenger. For each message profile entered, the recipient will specify one or more message delivery profiles with data about how the messages must be distributed, where to receive the specified message, and the type of message devices to transmit the messages. *Id.* at 7:47-8:5.

The messenger profile system of the server enables a messenger to access the message management system server to enter and maintain his/her own basic identification information and messenger profile data. *Id.* at 8:6-10. A messenger can enter one or more sets of messenger profile data, specifying the types and messages and types of content the messenger is providing to recipients in general, which is stored in the message profile database. The messenger can also specify a list of specific recipient ID's, each combined with a set of message types and content types that the identified recipients must receive. *Id.* at 8: 18-27. Using the message input system, a messenger can enter messages for the purpose of having them distributed to recipients according to their individual specified recipient message profiles. *Id.* from 8:30-33. The messenger can manually or automatically enter the

message data or upload messages files for distribution to recipients with an appropriate message profile. *Id.* at 8:39-43.

A message processor of the individual message generator combines the data from the recipient message delivery profile database with appropriate data from the message database. From the combination, the message output filer will generate individual messages for each recipient as specified in the message database and recipient message delivery profile database. The generated messages are stored in the message output database until they are further distributed. *Id.* at 8:45-53.

The recipient profile system is used to create and maintain recipient message profiles for a multiple set of messengers. *Id.* at 8:60-61. Based on the existence of recipient identity profile data, the server will perform a lookup in the messenger ID and message profile database and retrieve all messengers with a basic profile matching the recipient's basic profile parameters. Examples of such parameters include country, city, gender, etc. A list of available messengers is presented to the recipient, and the recipient selects a messenger. The recipient specifies the message types and content types to be received from the selected messenger and then specifies one or more preferred delivery profiles such as the message device, the delivery address, the delivery schedule, sequence of appearance, etc. for each message and content type from the messenger. These steps are repeated until the recipient has

specified all necessary delivery profiles and parameters for the chosen message and content type. *Id.* at 9:5-21.

A recipient editor application then creates a recipient message profile for the recipient logged onto the system and stores the profile data in the recipient message profile database. The system also creates a recipient delivery profile for the recipient and stores this data in the recipient message delivery profile database. *Id.* at 9:28-35.

A messenger uses the messenger profile input system to create and maintain message profiles for the available message types and content type the messenger wishes to offer, and to create and maintain a messenger's recipient message profile for recipients targeted to receive specific message types and content types. *Id.* at 9:37-43. A messenger can elect to create or update a messengers message profile using the messenger editor, from which the messenger can specify multiple sets of message types and content types to be offered to recipients. The editor creates a messengers message profile and saves it in the message profile database. *Id.* at 9:55-63. If the messenger elects to create or update a messengers recipient message profile, the messenger can specify a list of recipient IDs together with multiple sets of message types and content types that each specified recipient is to receive. The messengers editor creates a recipient message profile for the specified recipient and messenger logged on to the server and stores this in the recipient message profile database. *Id.* at 9:63-10:5.

A messenger can use the message input system of the system to manually or automatically input and/or upload messages into the message management server. *Id.* at 10:11-17. The messenger accesses the message input editor's input form that allows the messenger to choose whether to enter a message manually or by uploading a message file. *Id.* at 10: 23-35. If uploading a message file is selected, the messenger attaches the file to the input form and submits the file to the message management server. The message input editor validates the file for correct format, valid message type, content type, recipient IDs, message content, etc., according to messengers message profile stored in the database. *Id.* at 10:26-37.

If manual entry of the message is elected, the input form prompts the messenger to enter specifications of message type and content type. The editor then looks for a match between the messenger, message type, content type, and the recipient message profile in the recipient message profile database. If matches are found, a list of matching recipient ID's is presented to the messenger. *Id.* at 10: 38-45. The editor allows the messenger to enter the actual message content through the input form. After entering, the editor submits the message and confirmed recipient ID list to the individual message generator and to the message database. The editor then confirms to the messenger that the message has been submitted for message generation. *Id.* at 10:48-57.

Next, the individual message generator can be used to finalize the process. The individual message processor receives a message notification from the message input system, and the processor looks up the message in the message database as well as the recipient message profiles and delivery profiles in the recipient profile database. *Id.* at 10:59-67. The individual message processor then matches the recipient, and type and content criteria for the message. Next, a message output filer of the individual message generator combines the message with the delivery profile data for all recipients matching the profile and creates a total output file. In the final step, an output filer application submits the message output file to an external message distribution server as well as to the message output database. *Id.* at 11: 1-9.

B. The '920 Patent File History

The application that issued as the '920 Patent was filed on July 12, 2001. The priority date of the '920 Patent is July 12, 2000.

References cited by the applicant and considered by the Examiner include U.S. Patent No. 6,047,310 (Kamakura) and U.S. Patent No. 6,711,682 (Capps). During prosecution, the Examiner rejected claim 1 as allegedly being anticipated by Kamakura and rejected claims 2-23 as allegedly being obvious over Kamakura and Capps. EX1002, 119-128. The applicant amended claim 1 and argued that neither reference “provide[s] [an] electronic message management system having the features of a message ‘sorting filter’ system” that “enable[s] 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.” The applicant further argued that the combination did not teach the “individual message generator...to generate an individual message to be sent...to a recipient specified by a messenger” EX1002, 111-112. On July 07, 2005, a Notice of Allowance was mailed allowing claims 1-18. EX1002, 82.

C. Person of Ordinary Skill in the Art

Patent Owner submits that a person of ordinary skill would have had at least a B.S. in computer science, and would have at least 2 years of experience, or have a B.S. in a scientific or engineering field with relevant work experience.

D. Claim Construction

According to 37 C.F.R. §42.100(b), in an *inter partes* review, claim terms are construed using the same standard used in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.

The ordinary and customary meaning of a term may be evidenced by a variety of sources, including the words of the claims themselves, the specification, drawings, and prior art. However, the best source for determining the meaning of a claim term is the specification – the greatest clarity is obtained when the

specification serves as a glossary for the claim terms. *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). The words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13USPQ2d 1320, 1322 (Fed. Cir. 1989); *Chef America, Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1372, 69 USPQ2d 1857 (Fed. Cir.2004).

In accordance with these principles, Patent Owner submits that the terms of the '920 Patent are clear on their face, Patent Owner reserves all rights to raise claim construction arguments in district court and in this proceeding.

III. THE SPECIFIC GROUNDS OF UNPATENTABILITY

The Petition alleges that the '920 Patent is directed an email management system relying on conventional computers and components to enable senders and receivers of email to specify certain delivery parameters. However, this is not true. Email management systems at the time of Patent Owner's invention were locally installed systems designed to handle one messenger or one organization and many recipients. This is evidenced by Petitioner's extensive use of the legacy Microsoft Outlook email program, which is used for one organization and multiple senders that is installed on the organization's server. Outlook's data model is the opposite of the '920 Patent's system. The '920 Patent teaches multiple senders and receivers on the same cloud-based system, where all senders and all recipients can access profile data

on each specific sender and recipient and also define delivery parameters on each of them. EX2001 at ¶ 75.

IV. THE ASSERTED PRIOR ART

A. Law

Law is titled “Information delivery system for providing senders with a recipient's messaging preferences” and discloses a web server in operative communication with a plurality of recipients and a plurality of senders.

Law is directed to a web server – where recipients can add a preference profile with their ID, email and interests and where senders can add their profile with ID, email and SIC numbers. The Abstract of Law states: “An information delivery system includes a web server with a plurality of recipients and a plurality of senders. The web server includes recipient preference profiles and sender profiles. Recipient preference profiles includes respective information directed to the recipient’s preferences for receiving messages. The web server provides the plurality of senders with access to the plurality of recipient preference profiles. The invention is directed to techniques allowing a recipient, receiving messages from a plurality of different senders desiring to communicate with the recipient, to control various aspects of the messages techniques for ensuring that the senders have access to updated recipient preferences. EX2001 at ¶¶ 63-65.

Law586 does not, however describe that recipients have any access to specific sender profiles data or that recipients can define rules for any specific senders. Only the rules connected to generic interests or SIC codes can be specified in recipient profile data. The data model in Law586 is not designed to give a recipient access to profile data of any specific senders. Law586's data model is opposite of the '920 Patent's data model, which is where all senders and all recipients can access profile data on each specific sender and recipient and also define delivery parameters on each of them. EX2001 at ¶¶ 66-71.

B. Joshi

The original Windows NT using a Microsoft Exchange server management software is a conventional, one-to-many, local installed email management system to be used by one Messenger (a single organization with a limited number of users being both senders and receivers) - as opposed the '920 Patent's data model where a centralized system can be used and operated by an unlimited number of independent messengers. EX2001 at ¶¶ 80-81.

Microsoft Exchange is not a centralized system for many different messengers. It is an email management system designed to be installed within a single organization and on a limited number of physical sites, to be used only by users within that same organization. Different business units or groups may operate within the same license or server, but ultimately it is under the control of one

organization with its own security and mail protocols. Exchange is peer-to-peer, where users send and receive emails from each other. No Exchange groups are designated “messengers” or “senders” and no groups are designated “receivers.” Microsoft Exchange was never designed for, and cannot handle, different Messengers/Senders organizations - nor does Microsoft Exchange have a Messenger profile database to handle several different messengers. EX2001 at ¶ 80.

C. Smith

Smith describes a conventional one-to-many local installed system to be used by one Messenger as opposed to a centralized many-to-many system that can be used and operated by several messengers as does the '920 Patent. Smith does not describe a Messenger profile database to handle several different messengers. EX2001 at ¶ 82.

Smith allows recipients to specify a preferred format, messaging device, schedule, etc. using recipient profiles that are maintained by each recipient. However, these rules will only apply to the messages originated from the one specific messenger operating the system. The Abstract of Smith reads:

An automated system for delivery of messages to multiple recipients, and for processing of responses to the messages, includes a message client, message server, and system database. A message is created using a universal message form. The message content can be translated into multiple formats and sent to one or more different recipients using one or more different types of messaging devices, including pagers, telephones, fax machines, and e-mail readers. 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 at Abstract.

Smith makes it clear that its system is to be used by “a sender,” not multiple senders/messengers (EX2001 at ¶ 84):

One object of the present invention is to create messages using a universal format that is independent of the type of messaging devices used for delivering the messages, with attachments and response requirements, to multiple e-mail, voicemail, fax, pager and telephone communications devices. The communications can be initiated by a sender, or automatically created as a digital message based on escalating trigger events. EX1016 at 2:19-46.

Smith uses Microsoft Outlook 2000 for its client software, which as explained above, is a single messenger system and could not operate with '920 Patent's multiple messenger system:

UN Client and UN Server modules are initially installed using the Microsoft Windows Installer Service. . . The UN Server resides on a LAN in conjunction with the Server Notification Module 3 (Exchange 5.5, for example) and UN Database 8 (Microsoft SQL 6.5, for example). UN Client software may be downloaded to licensed users who also have a copy of Outlook 2000. The 3-tier architecture of this embodiment of the system is fully scalable from small office to enterprise environments. The UN Client is integrated with Outlook 2000 for full compatibility with Office 2000 users. EX1016 at 12:5-25.

Smith is intended and being pictured to be implemented into a Microsoft Exchange and Microsoft 2000 environments. Microsoft Exchange and Microsoft Office 2000 environments are one-to-many local installed systems to be used by one Messenger/one organization. EX2001 at ¶ 85.

D. Padwick

Microsoft Outlook 2000 is a conventional one-to-many local installed e-mail management system to be used by one Messenger (one organization with several but a limited number of users being both senders and receivers) – opposed to a centralized system that can be used and operated by unlimited number of independent messengers as in the '920 Patent. As such, Padwick is not a centralized system for many different messengers but instead an E-mail management system designed to be installed within a single organization and on a limited number of physical sites, to be used only by users within the organization. Padwick cannot handle several different Messengers/senders organizations. It does not have a Messenger profile database to handle several different messengers. EX2001 at ¶ 86.

Padwick is cited here, describing how a user using Microsoft Outlook 2000 for receiving and sending e-mails, as a system to allow to specify different kind of rules for incoming and outgoing messages – for any specific subject matter, content, sender, or importance. These rules are stored on the local client or server having the Microsoft Outlook 2000 installed. EX2001 at ¶ 86-87.

However, these rules will only apply to the messages routed via the one specific organization or “user within this organization” assigned to the Microsoft Outlook 2000 installation where these rules are specified and stored. In other words, if a recipient is receiving an incoming message on any other device not a part of the

Microsoft Outlook 2000 installation, the rules are not checked for or applied. The Microsoft Outlook 2000 installation of servers and clients is a closed environment, limited to users within the organization covered by the installation. That system is opposed to the '920 Patent, which is a centralized installation and capable of, for example, covering all worldwide messengers/organizations and recipients. EX2001 at ¶¶ 86-87.

V. PETITIONER HAS NOT DEMONSTRATED A REASONABLE LIKELIHOOD OF SUCCESS FOR THE GROUNDS ADVANCED IN THE PETITION

A. Requirements for Showing Obviousness Under 35 U.S.C. § 103

The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). The Board has held that a failure to identify the differences between the claimed subject matter and the prior art is fatal to an obviousness challenge. See, *Apple, Inc. v. Contentguard Holdings, Inc.*, IPR2015-00355, Decision Denying Institution of *Inter Partes* Review, Paper 9 at 9-10 (P.T.A.B. June 26, 2015) (denying institution for failure to identify the differences between the claimed subject matter and the prior art).

In arriving at an obviousness determination, the Board must sufficiently explain and support the conclusions that the prior art references disclose all the elements recited in the Challenged Claims and a relevant skilled artisan not only could have made but would have been motivated to combine all the prior-art references in the way the patent claims. *Pers. Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017). That is, even if all the claim elements are found across a number of references, an obviousness determination must consider whether a person of ordinary skill in the art would have been motivated to combine those references. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1368 (Fed. Cir. 2016); *Los Angeles Biomedical Res. Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly Co.*, 849 F.3d 1049, 1067 (Fed. Cir. 2017) (vacating and remanding an obviousness determination, in part, because the Board did not make factual findings as to whether there was an apparent reason to combine all three prior art references to achieve the claimed invention and whether a POSITA would have had a reasonable expectation of success from such a combination). This combination determination, as supported by an articulated motivation to combine, requires a plausible rationale as to why those prior art references would have worked together. *Broadcom Corp. v. Emulex Corp.*, 732 F.3d 1325, 1335 (Fed. Cir. 2013). Absent some articulated rationale, a “common sense” finding is no different than the conclusory statement “would have been obvious.” *In re Van Os*, 844 F.3d 1359, 1361

(Fed. Cir. 2017). Of additional importance, “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references.”

Innogenetics, N.V. v. Abbott Labs., 512 F.3d 1363, 1373 (Fed. Cir. 2008).

B. Petitioner Fails to Establish Ground I: Law586 in view of Joshi Would Render Claims 1-11 and 14-18 Obvious

Microsoft Exchange was a very common platform when Law586 was filed with millions of users around the world, around the year 2000. The platform was launched in 1996 and Joshi published his book in 1997. “Microsoft Exchange,” stated Joshi, “was a conventional web server software and system.” EX1029 at 51. A POSA would not have combined a conventional web server based email system of Microsoft Exchange that can only handle one sender or organization with a web based system of plurality of senders and a plurality of recipients. EX2001 at ¶ 89; EX1005 at 2:31-49. Law586 has its own specialized profiles for recipients of email and would not look to a conventional system for additional help. EX1005 at 7:9-64.

The concepts of filtering emails, e.g., to prevent unwanted “spam” or “junk” mail and use for rule-based filtering and message delivery of emails to define specific actions to be taken in response to messages received from particular sources or regarding particular subjects, was well known prior art. The combination of Law and Joshi remains in the context of locally installed systems operated by a single organization with several but still a limited number of users (messengers and recipients). Microsoft Exchange, Outlook 2000 EX1017, Smith EX1016, Skladman

EX1019 – are all systems that would need to be installed and implemented in each single organization and operated on each physical site. As opposed to the '920 patent which is a centralized system (today known as a cloud solution) where only one physical installation could in theory cover all worldwide messengers and all recipients. EX2001 at ¶ 88.

1. Claim 1

Independent claim 1 has been divided into elements for consideration by the Board as follows:

[1 prel] 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; 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, and

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

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

EX1001 at Claim 1.

a. Element 1[b]

The '920 Patent's data model was developed envisioning that any messenger and recipient computer in the world could now connect to one centralized system where the recipient can control specific messages from specific messengers. Law586 cannot do this and does not suggest that this is a feature of Law586's system. The '920 Patent's data model was developed envisioning that any messenger and recipient computer in the world could now connect to one centralized system where the recipient can control specific messages from specific messengers.

Law586 cannot do this and does not suggest that this is a feature of Law586's system. EX2001 at ¶ 93. Thus, Law fails to teach or suggest 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

The Petition focuses on recipient profile 190 in Figure 2. But this profile is different from that which is claimed in 1[b]. Profile 190 lists message format, delivery instruction data, interest data, and no interest data. EX1005 at 4:25-5:10. These list the “where, when and how” of 1[b] but does not teach the “specific types of messages from specific messengers” of 1[b]. In the Law586/Joshi combination the recipient has no access to any messenger-specific data. Only the interests of the recipients are logged in their profiles, which is not what is claimed in 1[b] and not what the Law586/Joshi combination teaches. The “no interest data” in Law586 allows recipients to choose which *types* of senders it wishes to receive messages from, (EX1005 at 4:46-5:36), but there is no access for a recipient to choose a particular sender to receive from, and which particular message from a particular sender the recipient wishes to receive. This is an important distinction that is not an obvious extension of the combination. EX2001 at ¶ 94.

The Internet and web interfaces the both the Recipient profile and Messenger profile in the '920 Patent enable each specific messenger and recipient to enter,

manage and edit his own individual set of rules of what to send or receive from each individual messenger or recipient. This is a more detailed, more complex system than the one disclosed in the combination. EX2001 at ¶ 95.

As an example of the differences, these data 190d and 190e may be captured in any conventional manner. One system available for use is the standard Industry Code (SIC) system that assigns SIC numbers for a variety of well-known industry segments. As examples, automobile rental companies would be assigned a SIC number in the range of 2100 to 2199, while automobile dealerships would be assigned a SIC number in the range of 2400–2499 and service stations would be assigned a SIC number in the range of 4000 to 4099. Still other SIC numbers exist for financial institutions, health care providers, legal service providers, professional associations, utility service providers, governmental agencies and a variety of other industry segments. EX1005, 4:25-5:5. The Law586 system could flood a recipient who picked an SIC code with all emails from all automobile rental companies, when a recipient was only interested in emails from a two companies with discounts on long-term rentals. The combination does not solve the problems with floods of emails from unwanted messengers that is addressed by the '920 Patent. EX2001 at ¶ 96.

Law586 is designed to handle unlimited number of senders and recipients as is the '920 Patent. However, to configure the delivery parameters in Law586 to

include “specific types of messages from specific messengers” would require a completely different and more complex data model, that could link each recipient to each messenger despite of the facts that there are unlimited numbers of each. Law586 did not think of this, Joshi did not think of this, and the combination does not teach this. One skilled in the art would not think it was obvious because clearly the technology was not contemplated at the time by anyone else except for Pedersen. EX2001 at ¶ 97.

The concepts of filtering emails, *e.g.*, to prevent unwanted “spam” or “junk” mail began the use for rule-based filtering and message delivery of emails. To define specific actions to be taken in response to messages received from particular sources or regarding particular subjects, was well known prior art. But this concept was only in the context of local installed systems operated by a single organization with several but still a limited number of users (messengers and recipients) like Microsoft Exchange, Outlook 2000 EX1017, Smith EX1016, Skladman EX1019 – all systems that would need to be installed and implemented in each single organization and operated on each physical site where needed. This is opposed to ’920 Patent being a centralized system (today known as a cloud solution) where only one physical installation could in theory cover all worldwide messengers and all recipients, and the recipients could define exactly what messages they wanted to receive from exactly the messengers they wanted to receive them from. The combination, or any

of the art cited by the Petition, does not teach this, and it was not obvious at the time. Otherwise, considering the ubiquitous use of email, Pedersen would not be the only one to incorporate these technical concepts into his invention. EX2001 at ¶ 88.

While Law586 teaches a web server with a plurality of recipients and a plurality of senders, the recipients in Law586/Joshi cannot choose to receive specific messages from specific messengers, as required by 1[b]. EX2001 at ¶ 98.

b. Element 1[d]

The Petition describes that Law586 understood by a POSA discloses the web server acting as the mail dispatcher, where email messages would logically be transmitted from sender computer systems over the Internet. Petition at 52. Law586 describes using conventional Web server application software, and it is alleged that Microsoft Exchange described by Joshi is that conventional web server software. Petition at 53. However, neither of these references, alone or in combination, teach that there is a message database where un-sent messages from a messenger/sender are stored for later use by the messenger/sender to send to recipients as required by 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

In Joshi, the Microsoft Exchange stores messages sent *from* a sender, and these are stored in the recipients inbox, as in a normal email application. But there

is no provision in the combination of storing pre-sent messages for the messenger in the messenger's database of files. This is not even alleged by the Petition. The Petition focuses on routing messages through a "message dispatcher" of Law586, but not the storage of message files for the *messenger* in the *messenger's* database. EX2001 at ¶ 99.

Thus, the combination fails to teach or suggest 1[d].

2. Claim 8

a. Element 8[d]

If, as the Petition alleges above, Law586 uses a "conventional" email system, and Microsoft Exchange of Joshi is that convention system, then there is no "input form" in the combination for the client computer to input data to. A user simply enters a message and hits "send" without using a form to input the message into. The Petition does not cite anywhere in Law586 or Joshi stating that an input form is used, because there is no such form used or needed in a conventional email system. As a POSA knows, a "web page" could be anything, and is not defined by the combination as an "input form" specifically in the meaning of the claim. EX2001 at ¶ 101. The Petition conjectures that an input form may be used, but without any evidentiary basis other than an expert's speculation and hindsight reading the element of 8[d]. Petition at 71.

The combination fails to render obvious element 8[d] that requires “prompting the client computer for the data to be input by providing a data input form to the client computer.”

3. Claims 9 and 10

Claim 9 requires the limitations of claim 8 with “the prompting step includes providing an input form” and claim 10 requires the limitations of claim 8 with “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.”

As stated above for element 8[d], Law586 uses a “conventional” email system, and Microsoft Exchange of Joshi is that convention system where there is no “input” form” or “message input form” in the combination for the client computer to input data to. The Petition does not cite anywhere in Law586 or Joshi stating that a message input form is used, because there is no such form used or needed in a conventional email system. As a POSA knows, a “web page” could be anything, and is not defined by the combination as an “input form” specifically in the meaning of the claims. EX2001 at ¶ 101. The Petition conjectures that an input form may be used, but without any evidentiary basis other than an expert’s speculation and hindsight reading the elements of 8[d], 9 and 10.

The combination fails to render obvious claims 9 and 10 that require input forms.

4. Claim 11

Claim 11 requires the limitations of claim 8 where “the accepting step includes entering the input data into an electronic message management database comprising . . . a message database.”

As stated above, in Joshi, the Microsoft Exchange stores messages sent *from* a sender, and these are stored in the recipients inbox, as in a normal email application. But there is no provision in the combination of storing pre-sent messages for the messenger in the messenger’s database of files. This is not even alleged by the Petition. The Petition focuses on routing messages through a “message dispatcher” of Law586, but not the storage of message files for the *messenger* in the *messenger’s* database. EX2001 at ¶ 102.

The combination fails to render obvious claim 11.

5. Claim 14

The combination only matches address space to an available connector or gateway but does not and is not capable to “communicate[] with the database to identify messages and messenger parameters that are compatible with a recipient profile” as required by claim 14. This element requires that the individual message generator identify messages and messenger parameters that are compatible with a recipient. This process is not performed by the MTA and not suggested by the combination. These limitations have nothing to do with how “messages are

identified by Exchange. . . and compatible parameters are identified when the MTA matches the recipients address space to an available connector or gateway.” The identification by Exchange is not identifying the recipients’ profiles and messenger parameters to perform a compatibility analysis. EX2001 at ¶ 103.

The combination fails to render obvious claim 14.

C. Ground 2: Smith in View of Padwick Fails to Render Obvious Claims 1-11 and 14-17

Smith is describing a conventional one-to-many, locally installed system, which is to be used by one Messenger. This is opposed to ’920 Patent which describes a centralized many-to-many system that can be used and operated by several messengers. It does not describe a Messenger profile database to handle several different messengers. Smith is intended and defined as being implemented into Microsoft Exchange and Microsoft 2000 environments. The Microsoft Exchange and Microsoft 2000 environments are one-to-many locally installed systems to be used by one Messenger/one organization. EX2001 at ¶ 104.

Padwick describes how to use Microsoft Outlook 2000 including its Rules Wizard. Microsoft Outlook 2000 is a conventional one-to-many locally installed e-mail management system to be used by one Messenger (one organization with several but a limited number of users being both senders and receivers). This is opposed to ’920 which is a centralized system that can be used and operated by an

unlimited number of independent messengers. Padwick does not describe a centralized system for many different messengers but an E-mail management system designed to be installed within a single organization and on a limited number of physical sites, to be used only by users within the organization. It cannot handle several different Messengers/senders organizations. It does not have a Messenger profile database to handle several different messengers. EX2001 at ¶ 86.

Padwick describes how a user using Microsoft Outlook 2000 for receiving and sending e-mails, is allowed to specify different kind of rules for incoming and outgoing messages – for any specific subject matter, content, sender, or importance. These rules are stored on the local client or server having Microsoft Outlook 2000 installed. However, these rules will only apply to the messages routed via the one specific organization “user within this organization” assigned to the Microsoft Outlook 2000 installation where these rules are specified and stored. In other words, if a recipient is receiving an incoming message on any other device not a part of the Microsoft Outlook 2000 installation, the rules are not checked for or applied. A Microsoft Outlook 2000 installation - servers and clients is a closed environment, limited to users within the organization covered by the installation. Opposed to '920 which is a centralized installation in theory covering all worldwide messengers and recipients. EX2001 at ¶ 87.

1. Claim 1

a. 1[b] The Combination Fails to Teach or Suggest “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

The Smith/Padwick combination does not include, teach, or suggest a recipient profile application that provides the recipient the ability to save data for “where, when and how specific types of messages from specific messengers are delivered to the recipient.” First, the Petition is incorrect that the combination includes “messengers” and “recipients” as defined in the claims. The messengers send messages to the recipients in the claim, and the two are not interchangeable as alleged in the Petition. The claim specifically allows messengers to message recipients, but not vice-versa. Thus, the combination does not teach “recipients” according to the claims, either. EX2001 at ¶ 105.

Smith and Padwick are convention one-to-many email systems that do not feature an organization or user as one of the “messengers” and one of the “recipients” according to the claims. The combination simply has users that send emails back and forth to each other under the organization of a single entity such as a company or organization. EX2001 at ¶ 106.

Second, the receiver profile of Smith only describes the different media or methods of delivery, such as “e-mail, voicemail, fax, pager, telephone and wireless messaging devices.” EX1016, 4:53-54. The Petition alleges Padwick should define

a recipient as a messenger according to the claim. There is no feature in Smith or Padwick for saving data for how specific types of messages from **specific messengers** are delivered to the recipient. In the claim, a recipient in the claim cannot be a messenger, and a messenger cannot be a recipient. Thus, the Petition is fundamentally incorrect that the combination makes element 1[b] obvious to a POSA. EX2001 at ¶ 107.

b. 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”

As stated above in 1[b], the claim has two distinct users, a messenger and a recipient, and these entities or users are not interchangeable. There is no support in the '920 Patent for the Petition's assumptions for interchangeability of a messenger and a recipient. Thus, the combination fails to teach or suggest a “messenger profile application” since there are no “messengers” in the combination as alleged. A POSA understands the messenger and recipient distinctions. EX2001 at ¶ 108. Thus, the combination fails to render obvious element 1[c].

c. 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

As stated above in 1[b] and 1[c], the claim has two distinct users, a messenger and a recipient, and these entities or users are not interchangeable. There is no support in the '920 Patent for the Petition's assumptions for interchangeability of a

messenger and a recipient. Thus, the combination fails to teach or suggest a “message input application for receiving message files from a messenger” since there are no “messengers” in the combination as alleged. The combination simply sends Microsoft Outlook emails back and forth to and from each other. There is no disclosure for a separate “messenger,” according to the claim, only for selecting a list of recipients from an address book. EX1016, 5:12-28, FIG. 2. A POSA understands the messenger and recipient distinctions. Thus, the combination fails to render obvious element 1[d]. EX2001 at ¶ 109.

d. Dependent claims 2-7

Dependent claim 2-7 are nonobvious for depending from a nonobvious independent claim 1. However, specifically regarding claim 3 for a “messenger profile application” and claim 4 for a “message input form being accessible to a messenger computer,” claim 6 for a “messenger profile,” and claim 7 for a “message data file editor for receiving a message file data from a messenger,” the combination fails to teach or suggest a “messenger” according to the claims. As stated above, there is no support in the ’920 Patent that a “messenger” and “recipient” are interchangeable as alleged in the Petition. There are no “messengers” according to the claims disclosed in the combination. Thus, a POSA would know that the combination cannot render obvious these claim features. EX2001 at ¶ 110.

2. Claim 8

a. 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;”

The combination fails to teach or suggest “where the client computers are messenger and recipient computers” according to 8[a]. There are no separate entities as “messengers” disclosed in the combination. They are all simply users sending emails back and forth from one another. The Petition is incorrect that the combination includes “messengers” as defined in the claims. The messengers send messages to the recipients in the claim, and the two are not interchangeable as alleged in the Petition. The claim specifically allows messengers to message recipients, but not vice-versa. Smith and Padwick are convention one-to-many email systems that do not feature an organization or user as one of the “messengers” according to the claims. The combination simply has user that send emails back and forth to each other under the organization of a single entity such as a company or organization. EX2001 at ¶ 111.

Thus, the combination fails to render obvious claim 8.

2. Dependent Claims 9-11, and 14-17

The dependent claims 9-11 and 14-17 are nonobvious for depending from a nonobvious independent claim.

However, specifically regarding claim 11 for a “messenger profile database” and claim 14 for a “messenger parameters that are compatible with a recipient

profile,” the combination fails to teach or suggest a “messenger” according to the claims and a “recipient according to the claims. As stated above, there is no support in the '920 Patent that a “messenger” and “recipient” are interchangeable as alleged in the Petition. There are no “messengers” according to the claims disclosed in the combination and no “recipients” that receive messages from “messengers.” Thus, a POSA would know that the combination cannot render obvious these claim features. EX2001 at ¶ 113.

V. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Board deny institution of the Petition in its entirety.

Ramey, LLP
5020 Montrose Blvd., Suite 800
Houston, Texas 77006
(832) 454-1456 (Telephone)
(832) 900-4941 (facsimile)

Respectfully submitted,
/Jacob B. Henry/
Jacob B. Henry
Reg. No.: 61,093
Attorney for Patent Owner

CERTIFICATION OF WORD NUMBER

I certify that the foregoing document contains no more than 10,842 words as calculated using the word count function of Microsoft Word, not including material excluded under 37 C.F.R. 42.24(a)(1).

Date: August 23, 2023

/Jacob B. Henry/
Jacob B. Henry

CERTIFICATE OF SERVICE

I certify that the foregoing document is being served via email on all counsel of record on this, the 23rd day of August 2023.

/s/ Jacob B. Henry
Jacob B. Henry