

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNIFIED PATENTS, LLC,

Petitioner,

v.

PETER HENRIK PEDERSEN,

Patent Owner.

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

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DECLARATION OF WARNER B. SCHEYER  
IN SUPPORT OF PATENT OWNER'S RESPONSE TO PETITION FOR INTER  
PARTES REVIEW OF U.S. PATENT NO. 6,965,920

I, Warner B. Scheyer, do hereby declare as follows:

## **I. INTRODUCTION**

1. I have been retained as an independent expert witness on behalf of Peter Henrick Pedersen for the above-captioned Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 6,965,920 (“the ’920 Patent”). I am being compensated at my usual and customary rate for the time I spent in connection with this IPR. My compensation is not affected by the outcome of this IPR.

2. I have been asked to provide my opinions regarding whether claims 1-11 and 14-17 (each a “Challenged Claim” and collectively the “Challenged Claims”) of the ’920 Patent are unpatentable as they would have been obvious to a person having ordinary skill in the art (“POSITA”) as of the earliest claimed priority date. It is my opinion that all of the Challenged Claims would not have been obvious to a POSITA after reviewing the prior art discussed below.

3. In preparation for this Declaration, I have reviewed:

- a. EX1001, the ’920 Patent;
- b. EX1002, the file history of the ’920 Patent;
- c. EX1003 Martin declaration;
- d. EX1004 Martin curriculum vitae;

- e. Petition for *Inter Parte* Review of U.S. Patent 6,965,920 Challenging Claims 11 and 14-17;
- f. EX1005, U.S. Patent 7,058,586 to Law (“Law586”)
- g. EX1006 U.S. Patent 6,690,773 to Law (“Law773”)
- h. EX1007 U.S. Patent 7,072,845 to Law (“Law845”)
- i. EX1016 U.S. Patent 6,463,462 to Smith (“Smith”)
- j. EX1023 (“Padwick”)
- k. EX1029 (“Joshi”)
- l. Any document further cited herein.

4. The '920 Patent issued on November 15, 2005 from Patent Appl. 09/904,270 (“the '270 application”), filed on July 12, 2001.

5. In forming the opinions expressed in this Declaration, I relied upon my education and experience in the relevant field of art, and have considered the viewpoint of a POSITA, as of July 12, 2001. I have also considered:

6. I understand that claims in an IPR are given their ordinary and customary meaning as understood by one of ordinary skill in the art. I further understand that this is the same claim construction standard as one would use in a District Court proceeding.

## II. BACKGROUND AND QUALIFICATIONS

7. My qualifications are set forth in my curriculum vitae, a copy of which is included as Exhibit [Warner Scheyer CV.pdf]. As described in my curriculum vitae:

8. I received a bachelor's degree in mechanical engineering from the University of Washington in 1989 with a concentration in software engineering and interactive computer graphics programming. I also attended the graduate Ethnomusicology program.

9. I am a software and creative professional with over 30 years of software industry experience, including roles as CTO, director, individual contributor, manager, account representative and expert witness. Expertise in technologies and programming languages in a variety of professional environments. I consider myself a talented leader that can collaborate in ways that motivate and bring out the best in team members. My experience includes producing quality software products within budget and on schedule. I have strong analytical capabilities with excellent written and verbal communication skills.

10. My prior roles include CTO, director, technical sales, account management, creative management, expert witness, business analyst, solution design, team leader, and musician.

11. I am a board member of the Samaya Foundation of New York City, NY, which is an educational and cultural organization. I am also a board member of The Berghaus of Seattle, WA, which is a cooperative ski club. Further, I am a board member of the Pioneer Park Protective Association of Langley, WA, which is a non-profit corporation.

12. In 2021 I was a practicing musician in Seattle, WA and an acting CTO in a startup company for online K-12 music education. Our mission was to empower and collaborate with music educators to create a free, world-class music education that meets the needs of all K-12 students.

13. In my professional experience, I roles have changed from individual contributor to end-to-end solution, including writing specifications, identifying deliverables, and estimating costs, scheduling project timelines, providing creative and technical design, implementing development, overseeing QA and installation, hosting client meetings, building teams and managing subcontractors.

14. The technologies I have worked with include ASP.NET, C#, Unity, WPF, MVC, MVVM, AJAX, JavaScript, Node.js, Vue.js, SQL, C, C++, MFC, Java, Azure, LINQ, Entity Framework, JavaScript, Microsoft SQL Server, Reporting Services for clients such as Microsoft, Gates Foundation, Richard Lewis Media

Group, Weatherhead Studios, CREO Industrial Arts, Red Card Studios, Global Technica, PBJs, CCT Group, Samaya Foundation.

15. My expert witness consulting experience includes consulting for software, database, and system analysis for high profile litigations including patent, trademark, copyright infringement and trade secret misappropriation cases for plaintiffs and defendants. My experience includes UI, code and database comparisons, and analysis, claim construction and expert report writing.

16. From 2019-2020 I was employed as an AV Systems Engineer by CREO Industrial Arts in Woodinville, WA. In this role, I was responsible for overseeing the media, audio, and visual production process, supporting, and advising sales teams as well as research and recommending and implementing new technologies. Additionally, I designed and built software and electromechanical systems.

17. From 2001-2010 I was the Director of Development for Knowledge Anywhere in Bellevue, WA. Under my leadership, the development/production team more than doubled in size and includes additional full-time resources, an extensive network of contractors, as well as satellite offices in Minneapolis, Mexico, and Uruguay. My role and responsibilities included day-to-day development responsibilities include managing a team of full-time and contract software developers, IT, graphics resources, and QA professionals. Other responsibilities

include acting as senior developer, mentor, sales consultant, project manager, account manager, and solution architect.

18. This position required a broad knowledge of various technologies to develop custom eLearning software, LMS (learning management systems), related support services, and SCORM-compliant courses to deliver content and a rich user experience. Technologies included: MSSQL 2000, 2005 and 2008, ASP, ASP.NET, C#, JavaScript, XML, XHTML, Expression Studio, Silverlight, Adobe Creative Suite CS3 & CS4, Photoshop, Flash, ActionScript 2.0 & 3.0, Flex, Web Services, SCORM, MSCOM, Windows Mobile, Mobile Podcasting. Selected clients included Siemens Healthcare Diagnostics, Cobalt Group, F5 Networks, Hewlett Packard, Microsoft, Palm, T-Mobile, EJ Gallo, Starbucks Corporation, and Chateau Ste. Michelle Wine Estates.

19. From 1999 to 2000 I was the Senior Developer for software development at KNOWware, LLC in Seattle, WA. My role and responsibilities included Development lead for Intranet and desktop, database, business applications and tools using technologies including C++, Java, Visual Basic, HTML, and JavaScript.

20. From 1994 to 1997 was Product Developer for software products and tools at Wall Data, Inc., in Seattle, WA. My role and responsibilities included

participating as a member of the RUMBA and SALSA development teams to design and implement a lightweight Micro MFC and application generation using technologies including Windows CE, C++, MFC and the Windows API. I was part of the lead development team for multimedia interactive SALSA Learning Studio and received the Excellence Award at the STC 22nd Annual Competition.

21. The following is a list of selected project summaries that I have been the lead developer for or involved with:

- Richard Lewis Media Group. – Moonshot, Sailing and WWI Museums, System Architect and Technologist, designed and implemented custom client server, messaging, CMS and multimedia systems for museum exhibits. .NET and Unity.
- WEATHERHEAD Experience Design Group Inc. – Pacific Fleet Submarine Museum, System Architecture and Development Director, CMS driven museum exhibits. Honolulu, HI.
- CREO Industrial Arts – US Olympic Museum, Development oversight for exhibits, liaison for multinational software production team. Colorado Springs, CO.

- Chicago History Museum – Amplified Chicago Blues (<https://www.chicagohistory.org/blues>) SQL, ASP.NET, C#, WPF. Database, data access tier, administration application and interactive exhibits. Learn to play the blues guitar and create your own album cover.
- CREO Industrial Arts – Powering Future Learning Lab interactives, Tablet and Arduino development for kiosks and a voting booth. C programming in conjunction with NeoSegments and NeoPixels. America's Car Museum, Tacoma, WA.
- Museum of History & Industry – Restaurant Time Machine (<http://www.mohai.org/>) Touch screen exhibit interactive. SQL, ASP.NET, C#, WPF. Database, data access tier, administration application.
- BiNW – Catalyst Loft (<http://catalystactivation.com/the-loft/>), located in One Convention Place, used to showcase their expertise in creating spaces that improve efficiency and increase teamwork, or enhance the ability to recruit and retain talented staff. Provided Audio / Visual Hardware and Software Architecture and Development.

- WEATHERHEAD Experience Design Group Inc. – Seattle Children’s Research Discovery Portal (<http://www.seattlechildrens.org/research/discovery-portal/>), SQL, ASP.NET, C#, WPF. Database, data access tier, administration application and interactive exhibits.
- WEATHERHEAD Experience Design Group Inc. - Chicago History Museum (<http://www.chicagohistory.org/>) SQL, ASP.NET, C#, WPF. Database, data access tier, administration application and interactive exhibit,
- WEATHERHEAD Experience Design Group Inc. - Museum of History & Industry (<http://www.mohai.org/>) SQL, AS
- P.NET, C#, WPF. Database, data access tier, administration application and interactive exhibits.
- Microsoft, Bing in the Classroom. ASP.NET, C#, SQL, Azure (<https://www.bing.com/classroom/summerstorychallenge>) I worked to create an online web application that acted as the program hub for teacher resources as well as student submissions for the Summer Story Challenge contest.

- Microsoft - Employee Company Store. ASP.NET, C#, WPF, Administrative tool to manage store content displayed on their single and multi-monitor display systems. Entryway sculpture which allowed users to interact with the display via a mounted camera.
- Gates Foundation - ASP.NET, C#, WPF, MVVM, SQL, Facebook and Twitter Platform.
- Seattle Center - Space Needle 50th (<http://spaceneedle50.com/>), ASP.NET, CSS, CMS. Developed CMS system, and UI development.
- Microsoft Bill Gates Yearbook - Silverlight, MSSQL, LINQ, JavaScript.

22. I have been retained as an expert in intellectual property and software related cases for the past seven years. The following is a list of litigation support experience I have been retained for:

- 2023 – *Multimedia Technologies International v. LG, Multimedia Technologies International v. Vizio, Multimedia Technologies International v. Samsung* – Stroock & Stroock & Lavan LLP , representing Multimedia Technologies, Patent case involving Smart TV user interfaces.

- 2022 – *MULTIFOLD INTERNATIONAL v. SAMSUNG ELECTRONICS CO., LTD* – Stroock & Stroock & Lavan LLP, representing Multifold Patent infringement case. Performed a review of the Samsung Android code base to support UI and functionality trade secret infringement.
- 2022 – *HIGHLANDS GLEN, LLC v. SAVIBANK* – Demco Law Firm, P.S., representing Highlands Glen. Performed an analysis of Microsoft Office meta data and did research on the procedure used to track the history of an Excel document. Provided an expert report.
- 2021 – *UNITED STATES OF AMERICA v. Davis Lu – Friedman & Nemecek, L.L.C.* representing Davis Lu. Testifying expert for Criminal case that includes an analysis of evidence including system and version control logs and Java code to determine the cause of a customer facing system outage.
- 2019 – *Saracen v. Sylvain Ross* – Norton Rose Fulbright representing Saracen LLC. Misappropriation of Trade Secrets case. Assisted in compilation of Saracen trade secret definition. Analysis of UI, code base and database to determine similarities between a competing product utilized by traders at Saracen for speculative trading of power

prices. Required a clear understanding of how complex electric power transmission and flow functions and how it is monitored.

- 2018 – *Barbaro v. Niantic* – DUNLAP CODDING PC representing Barbaro. Patent infringement case. Helped with drafting claim construction, review of the Niantic code base to support UI and functionality trade secret infringement. Compilation of the evidence and analysis and production of the expert report.
- 2018 – *Prostar v. Dominos* – Ogloze Fortney LLP representing Prostar Wireless Group, LLC. Misappropriation of Trade Secrets. Assisted with the definition of Prostar’s trade secrets. Analysis of Prostar and the defendants code bases to determine similarities supporting misappropriation. Analysis of code base and compilation of expert report.
- 2018 – *Omnitracs v. Blue Dot* – Norton Rose Fulbright US LLP. Representing Omnitrac. Misappropriation of Trade Secrets. Software architecture copying. Analysis of code base and compilation of expert report.
- 2018 – *Title Source v. House Canary* – Greenberg Traurig, LLP representing Title Source. Software development failure. Analysis of

entire code base over the project lifecycle to determine when features were delivered and quality of product. Assisted with compiling of an expert report.

- 2017 – *Colliers v. Rotter* – Davis Wright Tremaine LLP representing Colliers. Misappropriation of trade secrets. Analysis of Excel macros and reporting of results.
- 2016 – *Macklin v. Liquid Dynamics* – Hinkle Law Firm representing Macklin. Trade secret regarding interface design issues for automotive repair software. Architecture and code analysis and comparisons.

### **III. MY UNDERSTANDING OF PATENT LAW**

23. Since I am not an attorney, I have been informed about certain aspects of the law that are relevant to my opinions in this declaration. I have been an expert in prior patent litigations, and therefore have knowledge of patent law I have retained from working on those cases.

24. I understand that prior art to the '920 Patent includes patents and printed publications in the relevant art that predate the priority date of the '920 Patent. For purposes of this Declaration, I have applied the date of July 12, 2001, the filing date of the earliest application that the '920 Patent claims priority to, as the priority date.

25. I understand that a claim is invalid if it would have been “anticipated” by or “obvious” in view of the prior art. My understanding of the two legal standards is set forth below.

26. I understand that other challenges to the validity of a patent, including patent ineligibility, enablement, written description, and definiteness, cannot be raised in *inter partes* review proceedings before the Board to challenge the validity of the '920 Patent. Accordingly, I did not consider those other challenges.

27. I understand that Petitioner has the burden of proving unpatentability by a preponderance of evidence, which means that the claims are more likely than not unpatentable.

**A. Anticipation under 35 U.S.C. § 102**

28. I understand that the following standards govern the determination of whether a patent claim is “anticipated” by the prior art.

29. I understand that, for a patent claim to be “anticipated” by the prior art, each and every requirement of the claim must be found, expressly or inherently, in a single prior art reference as recited in the claim. I understand that claim limitations that are not expressly described in a prior art reference may still be there if they are “inherent” to the thing or process being described in the prior art. For example, an

indication in a prior art reference that a particular process complies with a published standard would indicate that the process must inherently perform certain steps or use certain data structures that are necessary to comply with the published standard.

30. I understand that it is acceptable to consider evidence other than the information in a particular prior art document to determine if a feature is necessarily present in or inherently described by that reference.

## **B. Obviousness**

31. I understand that the following standards govern the determination of whether a patent claim is “obvious” in view of the prior art.

32. I understand that obviousness of a claim requires that the claim would have been obvious from the perspective of a POSITA at the time the alleged invention was made. I understand that a claim could have been obvious from a single prior art reference or from a combination of two or more prior art references.

33. I understand that an obviousness analysis requires an understanding of the scope and content of the prior art, any differences between the alleged invention and the prior art, and the level of ordinary skill in evaluating the pertinent art.

34. Also, I understand that obviousness does not require physical combination/bodily incorporation, but rather consideration of what the combined

teachings would have suggested to persons of ordinary skill in the art at the time of the invention. I understand that the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.

35. I further understand that a claim would have been obvious if it unites old elements with no change to their respective functions, or alters prior art by mere substitution of one element for another known in the field and that combination yields predictable results. While it may be helpful to identify a reason for this combination, I understand that there is no rigid requirement of finding an express teaching, suggestion, or motivation to combine within the references. When a product is available, design incentives and other market forces can prompt variations of it, either in the same field or different one. If a POSITA can implement a predictable variation, obviousness likely bars its patentability. For the same reason, if a technique has been used to improve one device and a POSITA would recognize that it would improve similar devices in the same way, using the technique would have been obvious. I understand that a claim would have been obvious if common sense directs one to combine multiple prior art references or add missing features to reproduce the invention recited in the claims.

36. I further understand that certain factors may support or rebut the obviousness of a claim. I understand that such secondary considerations include, among other things, commercial success of the patented invention, skepticism of those having ordinary skill in the art at the time of the alleged invention, unexpected results of the alleged invention, any long-felt but unsolved need in the art that was satisfied by the alleged invention, the failure of others to make the alleged invention, praise of the alleged invention by those having ordinary skill in the art, and copying of the alleged invention by others in the field. I understand that there must be a nexus—a connection—between any such secondary considerations and the alleged invention. I also understand that contemporaneous and independent invention by others is a secondary consideration tending to show obviousness.

37. I understand that in considering obviousness, it is important not to determine obviousness using the benefit of hindsight derived from the patent being considered.

38. The analysis in my declaration for this *inter parte* review is in accordance with the above-stated legal principles.

#### **IV. THE '920 PATENT**

39. The '920 Patent is entitled "Profile Responsive Electronic Message Management System." The Abstract states that the patent relates to "A system and method for **the central specification and management** of how **messages are distributed to recipients** with the steps of: a recipient profile system for entering and storing rules about **how to distribute specific types of messages** and content **from specific messengers to individual recipients**, a messenger profile system where messengers can enter, store and maintain his identification information and the types of message services he/she will offer to recipients, **a message input system where messengers** manually or automatically can enter messages or upload message files for distribution to recipients with a valid recipient profile, an individual message generator combining the data from recipient profile and the message from the message input system into a plurality of individual messages for recipients as specified by the messenger. (Emphasis added.)

40. The field of the invention is "...a system and method for the central filtering and distribution processing **of messages from multiple messengers** to selected **individual recipients** under filtering and distribution parameters in part established by each intended Recipient." (Emphasis added.)

41. The summary of the invention states that "The present invention is an electronic message management system and method for **the central specification**

**and management of how messages electronic messages received from a plurality of messengers or sources are distributed to individual recipients.” “The recipient profile application receives and stores a plurality of messenger specific profiles, each profile indicating delivery parameters for where, when and how specific types of messages from each messenger are to be delivered to the recipient.” “In practice, the present the message management system is accessible from a client computer via a global communications network, to centrally manage the distribution and delivery format of messages from multiple messenger sources to multiple individual recipients.” “Input forms practicable in the present message management system include: a recipient profile form, a messenger profile form, and a message input form.” (Emphasis added.)**

42. These aspects are reflected in claim 1 of the '920 Patent, which reads as follows: An electronic message management system comprising: 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 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

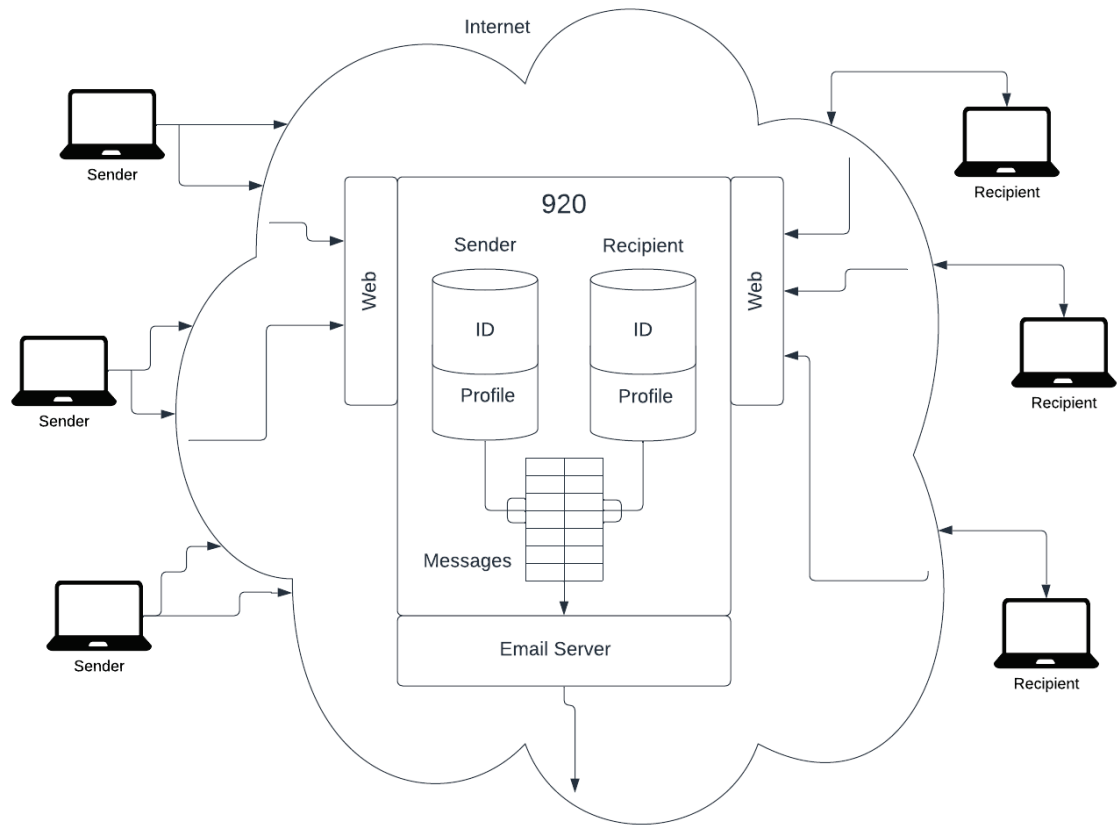
specific types of messages from specific messengers are delivered to the recipient, a messenger profile application for receiving messenger profile data from messengers via the global network and storing the messenger data in the database, including messenger identifying data, a message input application for receiving message files from a messenger via the global network and storing the message files in the database, and 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 a message management server operating system; and 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.

43. Claim 14 states: “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.”

44. The '920 Patent's invention relates to electronic computers and digital processing systems for filtered and targeted electronic message distribution. EX1001

at 1:11-13. 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. *EX1001* at 1:31-67. 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 multiple recipients under filtering and distribution parameters in part established by each intended recipient. *EX1001* at 1:13-18. This technological improvement was not known at the time of the invention.

45. The following diagram shows the many-to-many relationship between Senders and Recipients with the '920 invention.



46. The problem solved by the '920 Patent is related to the inaccessibility of efficient electronic message management for customer relation management of organizations, which resulted in widespread use of inefficient mass communication means through an organization's information technology and customer service departments. *EX1001* at 1:58-60. 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. *EX1001* 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. *EX1001* 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. *EX1001* 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. *EX1001* at 1:47-53.

47. 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. *EX1001* 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. EX1001 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. EX1001 at 1:64-2:6.

48. 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.

49. 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. EX1001 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. EX1001 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. EX1001. at 2:38-42.

50. 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. EX1001 at 5:21-51.

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. EX1001 at 6: 22-25.

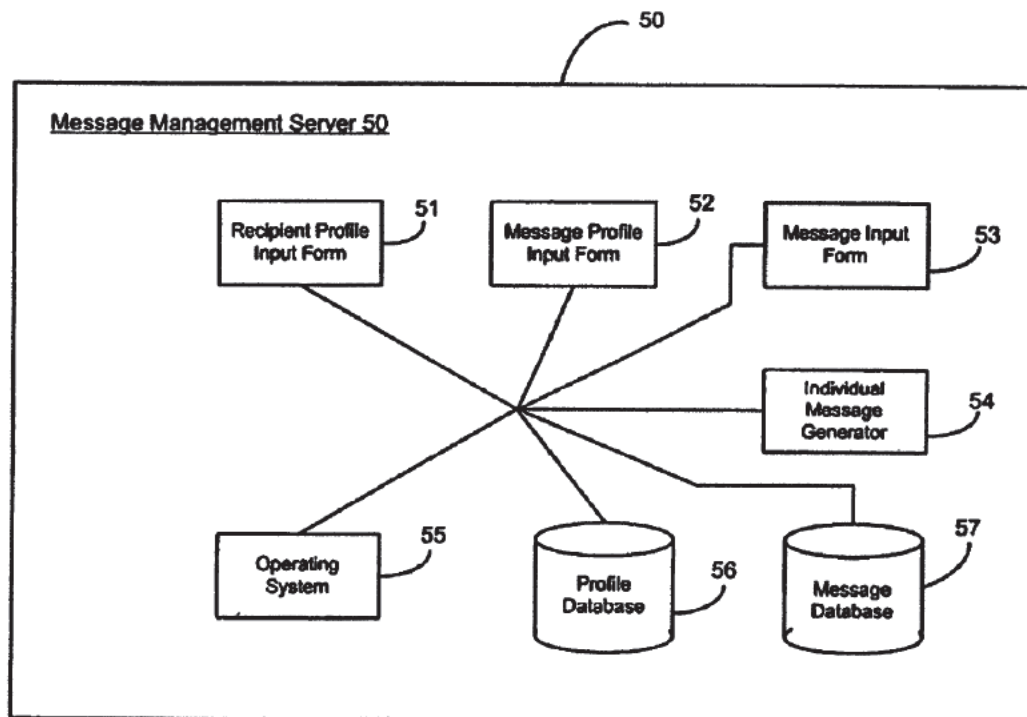


**Fig. 2**

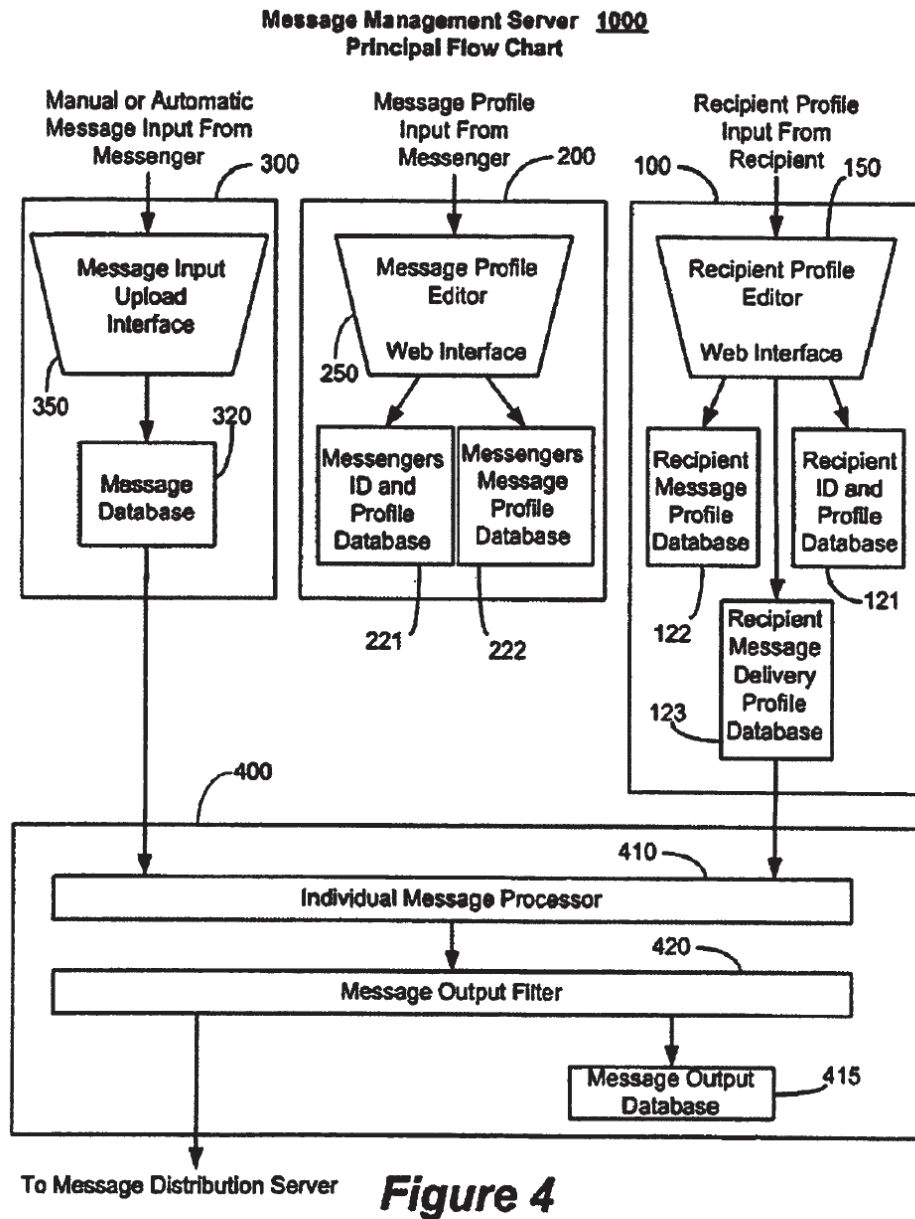
52. The message management server 50 comprises a recipient profile software application which includes a recipient profile input form 51. EX1001, 6: 33-35. A recipient will log on to the message management system server 1000 and enter his/her basic identification data. The identification data will be 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. These data will be stored in the

recipient message profile database 122, a subsystem of the profile database 56 in FIG. 2. EX1001 at 7: 56-65.

53. The message server 50 also comprises a messenger profile software application, which includes a messenger profile input form 52. EX1001, 6: 43-45. 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 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. EX1001 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.

54. 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:



55. 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. EX1001 at 7:47-8:5.

56. 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. EX1001 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. EX1001 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. EX1001 at 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. EX1001 at 8:39-43.

57. 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. EX1001 at 8:45-53.

58. The recipient profile system is used to create and maintain recipient message profiles for a multiple set of messengers. EX1001 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. EX1001 at 9:5-21.

59. 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. EX1001 at 9:28-35.

60. 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. EX1001 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. EX1001 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. EX1001 at 9:63-10:5.

61. 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. EX1001 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. EX1001 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. EX1001 at 10:26-37.

62. 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). References cited by the applicant and considered by the Examiner included 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 at 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 at 111-112. On July 07, 2005, a Notice of Allowance was mailed allowing claims 1-18. EX1002 at 82.

## **V. DETAILED ANALYSIS**

63. Law586 is 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.

64. The Abstract of Law586 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.

65. The Summary of Law586 states: “A web server in operative communication with a plurality of recipients and a plurality of senders, of the web server includes a plurality of recipient preference profiles corresponding to the plurality of recipients. a plurality of sender profiles corresponding to the plurality of senders. Law586 is disclosing a library with preference data from several recipients – and making this information available to several senders.”

66. An aspect of the '920 Patent is the data model being able to handle recipient message profiles on a one-to-one basis – between an unlimited number of recipients and unlimited numbers of messengers – specifying an unlimited number of rules for “specific types of messages from each specific messengers.” This data model did not exist and is not described before the filing date of the '920 Patent.

67. The data model was developed envisioning that any messenger and recipient computer in the world could now connect to one centralized system. By building a many-to-many database relation between all recipients and all messengers

– each relation also includes an unlimited number of one-to-one relations for each pair of specific recipient and specific messenger. The entities in each of these multiple one-to-one relations would store various values describing rules for how “specific types of messages from the specific messenger” should be handled.

68. The Internet and web interfaces would in addition enable each specific messenger and recipient to enter, manage and edit his own individual set of rules. This is described in '920 Patent as the Recipient profile and Messenger profile.

69. This multidimensional many to many relational database structure in the '920 Patent would not make sense or serve any purpose (and therefore unlikely to have been developed or described by a POSITA) before the idea of having one single computer database system to serve all worldwide messengers and recipients.

70. While Law586 teaches a web server with a plurality of recipients and a plurality of senders, the recipients in Law586 cannot choose to receive specific messages from specific messengers.

71. The '920 patent admits that rule-based systems for managing email delivery were known, and 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.

72. 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. Note the sections emphasized above describe how the ’920 Patent represents one centralized system that handles many messengers/senders and many recipients. In addition, ’920 enables all senders and all recipients the ability to access profile data on each specific sender and recipient.

73. In section [Overview of the ’920 Patent Prosecution History] the Petition says:

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. In the combination of Kamakura and Capps, the messenger does not know any specific recipient – as the architecture in the combination will not give messenger access to any information on any recipients. The recipient remains anonymous to the messenger, as it is the apparatus that designates the receiver of the message.

74. In section V. The Specific Grounds of Unpatentability the Petition states:

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.

I do not agree with Dr. Martin's statement.

75. Conventional Email management systems of the time where locally installed systems designed to handle one messenger or one organization and many recipients. These systems like MS Outlook, Exchange, Office 2000, Lotus Notes would enable users (senders and receivers of email) to specify certain rules including delivery parameters. But from these Conventional Email management systems there would not be access to any information on messengers/recipients not located within the one organization running this Email management systems. Any information on external messengers/recipients had to be generated/maintained within the organization. In other words no access to external messenger or recipient profiles existed. In addition the rules specified would be locally installed

on the system and was only applied when users were operating from the local installation.

76. Centralized email systems like Hotmail and AOL were introduced during this time as alternative to the Conventional locally installed Email management systems. All though all users of Hotmail etc. was running virtually on “one single centralized computer system” would still not have access to any information on other Hotmail users. Not even other Hotmail email addresses. Each user would still have to create his own contact list. In other words no Messenger/recipient profiles existed.

77. In addition, these systems would also not enable users (senders and receivers) of email to specify any contents or messenger specific rules with delivery parameters. Forwarding of emails could typically be specified only to cover all or none of all the incoming emails.

78. Law586 does not describe that Recipients have any access to specific sender profile data or the ability to define rules for any specific senders. Only rules connected to generic interests / SIC codes can be specified in the recipient profile. The data model in Law586 is simple and is not designed to give recipient access to profile data of any specific senders. This is opposed to 920 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.

79. Joshi. Note the following excerpt from the Petition: 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 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...Exchange discloses installation of "Internet Information Server (IIS) 3.0," a related program that also resides on the Windows NT server.

80. Joshi describes that one such application was "Outlook Web Access" ("OWA"). OWA enables users to access their mailbox on the Exchange Server.... The Windows NT and Microsoft Exchange Systems of the time are conventional one-to-many locally installed e-mail management systems to be used by one Messenger (one organization with a limited number of users being both senders and receivers ). This is opposed to the '920 Patent which is a centralized system that can be used and operated by an unlimited number of independent messengers.

81. This is opposed to the '920 Patent which is a centralized system that can be used and operated by an unlimited number of independent messengers. Joshi,

which describes key features of Microsoft Exchange 5.5 and runs on top of the Windows NT operating system is not a centralized system for many different messengers. Alternatively, Joshi describes 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. Microsoft Exchange 5.5 cannot handle several different Messengers/senders organizations – nor does it have a Messenger profile database to handle several different messengers.

82. Smith is describing a conventional one-to-many, locally installed system, which is to be used by one Messenger. This is opposed to the '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.

83. As in the '920 Patent, Smith does allow recipients to specify preferred format, messaging device and schedule by using recipient profiles that are maintained by each recipient. However, these recipient rules will only apply to the messages that have originated from the one specific messengers operating the system.

84. 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. Smith makes it clear that its system is to be used by “a sender,” not multiple senders/messengers.

85. 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.

86. 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 the '920 Patent 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.

87. 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.

88. 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 Law586 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. Opposed to 920 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.

89. Microsoft Exchange was a conventional system when Law586 was filed and not obvious to use as messaging system in combination with Law586 to obtain the key function in 920 of giving recipients ability to specify delivery parameters to include “specific types of messages from specific messengers”. This was not possible by simply combining the two systems. To do so, it would require a completely different and more complex data model, that was not implemented in Microsoft Exchange or Law586 as described.

90. With regards to the statement: “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.” Nowhere in Law is it described how to “to centrally manage

the distribution and delivery format of electronic messages from multiple messenger sources to multiple individual recipients.”

91. With regards to the statement: “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.”

92. System of Claim 1 ... identify messages and messenger parameters that are compatible with a recipient profile ... this has nothing to do with how “messages are identified by Exchange. ... And compatible parameters are identified when the MTA “match[es] the recipient’s address space to an available connector or gateway.” .. and it is not obvious to see this to “correspond to the claimed messenger parameters” and the connector or gateway would be defined by the recipient profile.

93. For 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 hint that this is a feature of Law586’s system.

94. The recipient profile 190 in Figure 2 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 extension of the combination.

95. 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.

96. The 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.

97. 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. A POSA would not think it was obvious because the technology was not contemplated at the time.

98. 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 claim 1[b].

99. Law586 describes using conventional Web server application software, and it is alleged that Microsoft Exchange described by Joshi is that conventional web server software. However, neither of these references state 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 claim 1[d]. 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.

100. If 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 would understand, a “web page” could be anything, and is not defined by the combination as an “input form” specifically in the meaning of the claim.

101. 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.

102. 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.

103. 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.

104. Smith is describing a conventional one-to-many, locally installed system, which is to be used by one Messenger. This is opposed to 920 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.

105. The Smith/Padwick combination does not include 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.” 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.

106. 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.

107. 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 says that 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.

108. Claim 1[b] 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 of Smith and Padwick does not include a "messenger profile application" since there are no "messengers" in the combination as alleged. A POSA understands the messenger and recipient distinctions.

109. Claim 1[d] 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.

110. 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,” all require a “messenger” according to the claims. As stated above, there is no support in the ’920 Patent that a “messenger” and “recipient” are interchangeable in the patent. There are no “messengers” according to the claims that are disclosed in the Smith Padwick combination. A POSA would know that the combination cannot render obvious these claim features.

111. Regarding 8[a], there are no separate entities as “messengers” disclosed in the Smith 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 ’920 Patent. The messengers send messages to the recipients in the claim, and the two are not interchangeable. 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.

112. For claim 11 for a “messenger profile database” and for claim 14 for a “messenger parameters that are compatible with a recipient profile,” the combination does not have any “messenger” according to the ’920 Patent and a “recipient according to the Patent. As stated above, there is no support in the ’920 Patent that a “messenger” and “recipient” are interchangeable. There are no “messengers” 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.

Respectfully submitted

WARNER SCHEYER

DocuSigned by:  
*Warner Scheyer*  
DA7BBC04071A420...

Dated: August 23, 2023