

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WHATFIX INC.,
Petitioner,

v.

WALKME LTD.,
Patent Owner.

Case IPR2023-01379
Patent 11,258,732 B2

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY FOR
INTER PARTES REVIEW OF CLAIMS 1-6, 9-16, AND 18-21 OF U.S.
PATENT NO. 11,258,732 B2**

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TABLE OF CONTENTS

I.	INTRODUCTION	2
II.	CLAIM CONSTRUCTION.....	2
A.	“computer program”	2
B.	“a [the] displayed user interface of a [the] computer program”	5
C.	“defining an automation process”/ “defining a conversation”	7
D.	Steps ([a]/[b]/[d]) Order.....	9
E.	“At least one of” A and B.....	10
III.	THE PETITION FAILS TO MEET ITS BURDEN	11
A.	Ground 1: Symons/Williams Fails.....	11
1.	[Preamble] “Defining an Automation Process”	12
a.	Symons Does Not Teach “Defining an Automation Process”	12
b.	The Result of Symons/Williams Combination is Irrelevant and Unsupported	13
2.	Symons/Williams does not teach the claimed “automation process” configured to utilize a [c] “displayed user interface of a computer program”	14
a.	Two GUIs.....	14
b.	Symons does not necessarily disclose [c]	16
3.	Symons does not disclose [a] “defining a conversation” or necessarily using a “natural language interface”	16
4.	[b] Associating, [d] Publishing, and Order.....	17
5.	Petitioner Does Not Show Symons/Williams Teach the Dependent claims	17
a.	2/12/19	17
a.	3/13	17

b.	4/14	17
B.	Ground 3: Allen Fails.....	18
1.	Allen Does Not Inherently Disclose [a]/[b]/[d], Petitioner’s New Read Should Be Rejected.....	18
a.	[a] “Defining a conversation”	19
b.	Allen Does Not Teach [d] Publishing, if It Is Using “task-specific ontology” as the Reply Now Asserts ...	19
c.	[b] Associating.....	20
d.	[a]/[b]/[d] Order of Steps	21
e.	Allen Does Not Teach that the Conversation is Implemented Using a [a] “natural language interface” with Natural Language Processing	21
2.	PLOW is not “a computer program” and the Tasks Do Not Execute any Functionality of PLOW Using a “displayed user interface” of PLOW (elements 1[c]/11[c]/18[c])	24
a.	PLOW Is Not a Target System.....	24
b.	Allen Does Not Teach Using a “Displayed User Interface” During Execution	25
3.	Dependent claims	25
a.	2/12/19	25
b.	3/13	25
c.	4/14, 5/15 are not both met.....	26
d.	Claim 9.....	27
C.	Grounds 2/4: Ben-Itzhak/Symons/Williams (Ground 2), Ben- Itzhak/Allen (Ground 4) Fail.....	27
D.	Ground 5: Krishnan/Radhakrishnan Fails.....	27
1.	No “natural language interface” in Krishnan.....	27

2.	No [c]/[e] “parameterized automation process” using the “displayed user interface” to “execute a functionality” of the computer program in Radhakrishnan	28
3.	Krishnan’s Backend, Lack of Motivation to Combine	29
4.	Non-analogous art.....	29
5.	Dependent claims 9/10	29
IV.	THE BOARD SHOULD GIVE LITTLE/NO WEIGHT TO DR. BEIGI, NOT MR. ZATKOVICH	29
V.	CONCLUSION	31

TABLE OF AUTHORITIES

Page(s)

CASES

<i>CAE Screenplates, Inc. v. Heinrich Fiedler</i> , 224 F.3d 1308 (Fed. Cir. 2000)	7
<i>Tf3 Ltd. v. Tre Milano, LLC</i> , 894 F.3d 1366 (Fed. Cir. 2018)	2
<i>Thorner v. Sony Computer</i> , 669 F.3d 1362 (Fed. Cir. 2012) (POR; Reply)	3
<i>Virtek Vision Int’l ULC v. Assembly Guidance Sys., Inc.</i> , 97 F.4th 882 (Fed. Cir. 2024)	12, 14, 18

EXHIBIT LIST

<u>EXHIBIT NO.</u>	<u>DESCRIPTION</u>
Ex2001	Expert Declaration of Ivan Zatkovich in Support of Patent Owner’s Response with respect to Claims 1-6, 9-16, and 18-21 of U.S. Patent No. 11,258,732 (“ <u>Zatkovich Decl.</u> ”)
Ex2002	<i>Curriculum Vitae</i> of Ivan Zatkovich
Ex2003	Deposition Transcript of Homayoon Beigi, taken on June 25, 2024
Ex2004	Deposition Transcript of Homayoon Beigi, taken on June 26, 2024
Ex2005	Public Comments to S. Symons, “When Chatbots meet RPA bots,” https://medium.com/roborana/when-chatbots-meet-rpa-bots-c8b22579f49a , Medium (Oct. 19, 2017) (omitted by Petitioner in Ex1004)
Ex2006	Zatkovich’s Overview of Ex2009, “Simple chatbot” .html Code, and Ex2010, Video of “Simple chatbot” .html Code
Ex2007	Khoros Staff, “Different types of chatbots: Rule-based vs. NLP”, Expert insights, Aug. 29, 2019 (marked as Beigi Ex. 19)
Ex2008	IBM, “Whatis a chatbot?”, https://web.archive.org/web/20221227051852/https://www.ibm.com/topics/chatbots (archived copy of Dec. 27, 2022).
Ex2009	“Simple chatbot” .html Code, Prepared by Mr. Zatkovich for use in IPRs 2023-01368, 2023-01379, 2024-00065.
Ex2010	Video demonstration of the “Simple chatbot” .html Code (Ex2009)
Ex2011	U.S. Patent No. 10.819,664 [Ex1001 in IPR2023-01368]
Ex2012	[RESERVED]

<u>EXHIBIT NO.</u>	<u>DESCRIPTION</u>
Ex2013	U.S. Patent No. 11,558,317 [Ex1001 in IPR2024-00065]
Ex2014 ¹	Supplemental Declaration of Ivan Zatkovich Pursuant to 37 CFR § 42.64 (b)(2) In Response To Petitioner's Objection to Evidence and Providing Supplemental Evidence for Inter Partes Review of Claims 1-6, 9-16, and 18-21 of U.S. Patent No. 11,258,732
Ex2015 ¹	Comment of Neha Negi to S. Symons, “When Chatbots Meet RPA Bots”, Medium (Posted Sep. 10, 2018) (available at: https://medium.com/@nehanegi0230/hi-saw-the-video-but-wanted-to-know-how-does-the-chatbot-trigger-the-rpa-bot-2804de1ace4c)
Ex2016 ¹	Comment of Sachin Prakash to S. Symons, “When Chatbots Meet RPA Bots”, Medium (Posted June 9, 2018) (available at: https://medium.com/@sachinprakash.37/which-rpa-tool-and-chatbot-tool-are-you-used-and-give-description-to-do-this-automation-a4d4cc0e2193)
Ex2017 ¹	Comment of Esteban to S. Symons, “When Chatbots Meet RPA Bots”, Medium (Posted April 24, 2018) (available at: https://medium.com/@egalicia_coconutt/interesting-but-i-seems-that-rpa-is-a-simply-program-d3bbb7c333df)

¹ Ex2014, Ex2015, Ex2016, Ex2017 and Ex2018 were prepared and served in response to Objections by Petitioner to Ex2005 and Ex2007. Dr. Beigi relies upon Ex2014-Ex2017 in his Reply Declaration. (Ex1042, ¶72). Ex2015-2017 (as submitted in IPR2024-00065) were marked as Beigi Ex. 31, 32, and 33, respectively, at his deposition. (See Ex2020, at 113:12-116:25; 148:8-152:19).

<u>EXHIBIT NO.</u>	<u>DESCRIPTION</u>
Ex2018 ¹	June 19, 2021 archive of Khoros Staff, “Different types of chatbots: Rule-based vs. NLP”, Expert insights (Aug. 29, 2019) (accessible at: https://web.archive.org/web/20210619072226/ https://khoros.com/blog/different-kinds-of-chatbots)
Ex2019	Errata Sheet of Homayoon Beigi for Depositions taken on June 25 and 26, 2024 (Beigi Dep. Ex. 40)²
Ex2020	Deposition Transcript of Homayoon Beigi, taken on November 11, 2024
Ex2021	Deposition Transcript of Homayoon Beigi, taken on November 12, 2024

² Included for completeness of record. Counsel for Petitioner took the position that it was not obligated to provide an errata sheet, but Dr. Beigi provided a newly executed version at his November 12, 2024 deposition. (See Ex2021, 294:12-295:20).

I. INTRODUCTION

Patent Owner (“PO”) submits this Sur-Reply regarding claims 1-6/9-16/18-21 of Patent 11,258,732 (“the ’732 Patent”, Ex1001). Grounds 1-5 rely upon improper claim constructions, informal inherency arguments, and/or incomplete obviousness analysis. The Petition fails to meet its burden to render obvious any claims. All challenged claims should be confirmed.

II. CLAIM CONSTRUCTION

The Petition (and the ID, provisionally) offer no claim construction, asserting merely the “ordinary and customary meaning”. (Petition, 6; Reply, 1-5; (ID, 13). While Dr. Beigi acknowledged that “the claims come in light of the specifications” (Ex2020, 83:23-25; 36:2-13; *see also Tf3 Ltd. v. Tre Milano, LLC*, 894 F.3d 1366, 1372 (Fed. Cir. 2018), he failed to apply this principle properly in his declarations (Ex1003, Ex1042). Even where his Reply Declaration cites the specification, it is with incomplete and mischaracterized quotes. (*Compare* Ex1042, 12-13 *and* Ex2021, 398:5-438:19 *with* Reply, 1-3).

As Mr. Zatkovich demonstrated (Ex2001, ¶¶98-134), PO’s constructions best align with the specification and other intrinsic evidence.

A. “computer program”

The intrinsic evidence is clear: the specification expressly equates the term “computer program” to “target systems”: “target systems, generally referred to as

the computer program”. (Ex1001, 5:6-7). A Patentee acts as his own lexicographer where, as here, they “‘clearly set forth a definition of the disputed claim term’ other than its plain and ordinary meaning” *Thorner v. Sony Computer*, 669 F.3d 1362, 1365 (Fed. Cir. 2012) (POR, 23; Reply, 2).

Moreover, “[t]he target system may have a user interface, such as a Graphical User Interface (GUI), that the user may utilize in order to activate the functionalities of the target system.” (*Id.*, 5:10-13). Dr. Beigi admitted that “the graphical user interface of the target system is referring to the user interface in a computer program in the claim.” (Ex2020, 261:19-23). He tries to flip the specification’s express language that “[t]he target system [is] generally referred to as the computer program” (Ex1001, 5:6), by claiming a “target system” is merely an example of a “computer program”. (Ex2021, 310:19-311:4).

To support this contorted read, he asserts “there are other examples”. (Ex2021, 311:2). But, as Dr. Beigi reluctantly admitted, the term “computer program” is absent from the examples list in the Reply, 1 (*citing* Ex1001, 10:11-17, 5:37-51, 21:24-32; Ex1042, ¶¶12-13):

Ex1001	Actual Passage (omitted language in bold)	Dr. Beigi Admission (Ex2021)
10:11-17:	“[t]he agent may access other applications, including their UI elements.”	399:5-8

5:37-51:	“[e]nterprises may use many different software tools for different purposes”.	400:18-403:7
21:24-32:	“[t]he computer readable program instructions may also be loaded onto a computer...”	437:24-438:21

Petitioner also mischaracterizes the specification discussing “computer program product” (as if it did not use the term “product”) (Reply, 1) and Mr. Zatkovich’s actual testimony at Ex2011, 22:60-65 regarding it, which explains “compute program product” is a “more generic product, which unlike “computer program”, “describe[es] how you might package this particular invention” (Ex1036, 110:1-110:24). Dr. Beigi agreed that it “seems to be a packaging term” (Ex2021, 432:8-17).

Claim 18 demonstrates how different terms like “program instructions” in its preamble, or “computer readable program instructions” (Ex1001, 21:24-32), are used to “carry out aspects of the present invention” (Ex1001, 19:63-65; Ex2021, 409:16-410:12). The invention is the automation process interacting with the GUI of “target system”/“computer program”,¹ not the “target system”/“computer

¹ Dr. Beigi recognizes “the graphical user interface of the target system [in the ’664 Patent] is referring to the user interface of the computer program”. (Ex2020, 261:11-23).

program”, itself. (*See also* ID, 3 (an automation process that “may be executed in a manner that manipulates the [graphical user interface (GUI)] of [a] **target system**, in a similar manner to the manner in which the user operates”) (*citing* Ex1001, 5:62-6:1).²)

PO’s construction, “a target system which has functionality that is invoked through its displayed user interface” is clearly set forth in the specification and should be adopted.

B. “a [the] displayed user interface of a [the] computer program”

Undaunted by the law of antecedent basis or grammar,³ Petitioner mischaracterizes PO’s arguments by alleging that “nothing supports a ‘separate’/‘single’ computer program (POR, 35) with ‘its own’ UI (POR, 18) on a single computer device (POR, 35) as additional limitations.” (Reply, 3).

PO’s objection is that Petitioner seeks to read “the displayed user interface of the computer program” referred to in [c] upon a *different* computer interface of a *different* computer program than “a displayed user interface of a computer program” that provides antecedent basis. (POR, 51-52; Ex2001, ¶¶226-229)

² All emphasis added unless otherwise indicated.

³ Dr. Beigi offers his expertise in NLP, not patent law or grammar. (Ex2021, 388:23-390:13).

Petitioner's read violates the law of antecedent basis, which is clear. [c] reads as follows:

wherein the automation process is configured to utilize a displayed user interface of a computer program to simulate sequence of interactions with the displayed user interface of the computer program and execute a functionality of the computer program, wherein the automation process is a parameterized automation process depending on the one or more parameters;

(Markup added).

Here, “the displayed user interface of the computer program” which the automation process “simulate[s] sequence of interactions with” and “the computer program” which the automation process “execute[s] a functionality of” must be the same displayed user interface and the same computer program as “a displayed user interface of a computer program” which the automation process utilizes earlier in the claim. (*See, e.g.*, caselaw at POR, 51).

Petitioner's assertion that the claim can have more than one user interface and more than one computer program (Reply, 12, *citing* Ex1042, ¶61) is irrelevant. The question is whether “the displayed user interface of the computer program” and “the computer program” is necessarily referring to the same displayed user interface of the same computer program identified earlier in the claims as “a displayed user interface of a computer program”.

In virtually every other instance where the claim provided antecedent basis for “the” something, based on an earlier reference of “a” something, Dr. Beigi reluctantly admitted they had to be the same. (*See* Ex2021, 379:20-25/381:10-12/383:13-18 (automation process); 380:16-17 (conversation)). But when it comes to “displayed user interface” and “computer program”, Dr. Beigi attempts to distinguish “a” displayed user interface of “a” computer program from “the” displayed user interface of “the” computer program. (Ex2021, 388:10-12 (“it makes a distinction between “a” and “the.” Otherwise, it would have said “the” from the beginning”)). This contradiction with fundamental rules of grammar, antecedent basis and his own interpretation of other claim terms, strains Dr. Beigi’s credibility. It is also incorrect.

C. “defining an automation process”/ “defining a conversation”

Petitioner improperly divorces “defining” from the claim terms “**defining** an automation process” and “**defining** a conversation”. When placed in the right context, it is clear that PO’s construction should be adopted. (POR, 24-26; Ex2001, ¶¶101-107).

Construing “defining” as merely meaning “configuring” (Reply, 3), ignores the term “configured” already in the claims. The un rebutted presumption remains: “the use of these different terms in the claims connotes different meanings”. *CAE Screenplates, Inc. v. Heinrich Fiedler*, 224 F.3d 1308, 1317 (Fed. Cir. 2000).

Petitioner's reliance on 9:4-5 ("Chat Bot Front-End Module 130 may be configured to enable a User 190 to interact with a chat bot") and 9:27-29 ("Automation Execution Module 140 may be configured to execute, on the client-side, the automation process") to argue PO "improperly exclude embodiments in the '732 specification" (Reply, 3) is misplaced. Neither passage use the term "defining", much less discuss "defining an automation process" nor "defining a conversation".

Petitioner's reliance on 5:49-61 (Reply, 4) is again misplaced. Dr. Beigi admitted, 5:49-61 relates to part of a discussion of a technical problem sought to be addressed, which was identified as a "non-trivial task[]" (Ex2021, 336:15-25). Petitioner ignores the technical solution discussed in its continuation at 5:62-6:2. Dr. Beigi recognizes with respect to "[d]efining the automation process based on performing actions in the GUI" ([c]), 5:49-61's technical solution "enables the automation process to perform any functionality that the user can perform **without relying on dedicated APIs and without requiring any line of code, yes.**" (Ex2021, 342:22-343:14). Thus, the claimed solution is "defining" "without relying on dedicated APIs and without requiring any line of code". (*Id.*).

The ID is consistent with PO's construction:

The '732 patent discloses exemplary embodiments for **a non-programmer user to define** a flow of conversation for a chat bot. *See, e.g.*, Ex. 1001, Figs. 1-3. For example, **a user** "may **define** which questions the bot would ask, which remarks it will

make, [and] flow control operations that may be based on evaluated conditions.” *Id.* at 8:46–49. Further, “**the user may define** for a conversation flow which automation process is invoked,” or “that a conversation is associated with multiple automation processes, one of which may be selected based on the interaction with the user.” *Id.* at 8:49–55. The automation process may also be **defined by a user**. *Id.* at 11:27–28.

(ID, 3-4; *see* Ex2020, 270:24-272:3 (admitting the Board properly understood that the disclosure involving a user in the definition process: “With respect to the conversation flow, **a user may define** a conversation, yes”))).

Mr. Zatkovich confirms “defining” in the context of “defining an automation process” and “defining a conversation” means “the process of allowing non-programmers and novice users to create automation processes and conversations without relying on programming skills.” (Ex2001, ¶100).

D. Steps ([a]/[b]/[d]) Order

Petitioner asserts elements [a]/[b]/[d] may occur in *any* order. (Reply, 4). This is counter the claims’ grammar and the specification.

On one hand, “in order for Symons’ RPA to automatically generate an email signature, its automation process **must have been defined**”. (Reply, 6). On the other, the Reply asserts when “associating the conversation with the automation process”, that conversation need not have been defined. (Reply, 5, *citing* Ex1042, ¶28).

Paradoxically, Dr. Beigi's opinion is that "they [the automation process and the conversation] both need to exist" (Ex2021, 357:3-8). This is nonsense.

Fig. 3 confirms the order of operation. The claimed automation process is "a parameterized automation process depending on the one or more parameters". (Ex2001, ¶123). In [a] a conversation is defined which "is configured to obtain from the user one or more values to one or more parameters" "includes establishing the parameters to be obtained during a conversation (once implemented)" (*Id*). Dr. Beigi confirmed, "you have to define the conversation in a way that is aware of the parameters of the automation process". (Ex2021, 359:20-22). Then, [b] "'associating the conversation with the automation process' includes associating parameters of the automation process with the parameters of **the defined conversation**" (Ex2001, ¶123; Accord Ex2021, 368:16-22). By Petitioner's own logic, the conversation, and its one or more parameters, **must have been defined before** any association could be made between the automation process parameters and the defined conversation parameters. Similarly, Dr. Beigi confirmed that publication cannot happen until after the "defining" and "associating" are complete. (Ex2021, 369:6-9, 372:17-24). Order matters.

E. "At least one of" A and B

Relying upon rules of grammar, *Superguide* explains:

The phrase '**at least one of**' precedes a series of categories of criteria, and the patentee used the term '**and**' to separate the categories of

criteria, which connotes a conjunctive list. ... Applying [Strunk and Wright's] grammatical principle here, the phrase 'at least one of' modifies each member of the list, i.e., each category in the list.

358 F.3d 870, 886.

The claimed “conversation elements” are analogous to the “categories” “with many possible values” in *Superguide*, not the “modes of operation” in the “menu” in *Fujifilm*. While FIGs. 5A-5B, shows four buttons (Reply, 5-6), each of which could have one or more possible values (e.g., “question steps” 550b, 550c, 550d, 550e, 550f, 16:22-24). This does not change the claims’ scope.

III. THE PETITION FAILS TO MEET ITS BURDEN

A. Ground 1: Symons/Williams Fails

The “internals” of Symons “chatbot” are not disclosed. (POR, 4; Ex2003, 213:18-214:9). The Petition is merely **a hodgepodge of unsubstantiated, informal inherency arguments** for [a] “defining a conversation” “to be implemented by a natural language interface” (Ex1003, ¶¶78, 88), [b] “associating” (¶90), and [d] “publishing” (¶¶94-95), (see POR, 38-39), or **incomplete obviousness arguments** with Williams for [Preamble] “defining an automation process” (Ex1003, ¶¶80-89); and [a] (Petition, 15, 18; Ex1003, ¶¶80-82, 89). Both fail. (POR, 38-43, 43-46).

Petitioner fails to show that Symons inherently (necessarily) teaches [a]/[b]/[d]. (See *id.*, 40 (citing caselaw)).

Petitioner’s Symons/Williams combination fails with respect to “natural language interface” in [Preamble]/[a]/[d] (*id.*, 46-50), using the same “displayed user interface” of the same “computer program” in [c] (*id.*, 51-52), and performing the “defining”, “associating” and “publishing” steps in the claimed order (*id.*, 42).

The Symons/Williams ill-defined combination does not identify the differences between Symons/Williams and the claims (as required *Graham* and *KSR*), nor provide an explanation of how or why a POSITA would modify Symons to meet the claim. It merely identifies disparate passages from the cited art and an unsupported conclusion of obviousness.

The law is clear that “the mere fact that these possible arrangements existed in the prior art does not provide a reason that a skilled artisan would have” made a substitution. *Virtek Vision Int’l ULC v. Assembly Guidance Sys., Inc.*, 97 F.4th 882, 887 (Fed. Cir. 2024).

Grounds 1/2 also fail under PO’s various constructions, as discussed below.

1. [Preamble] “Defining an Automation Process”

a. Symons Does Not Teach “Defining an Automation Process”

Petitioner continues to argue Symons “must” have defined an automation process because it exists. (Petition, 6; Reply, 15). Symons discloses nothing about **how** the automation process in the Arinti chatbot was defined. (POR 38-39, Ex2001, ¶¶152, 188-201). Dr. Beigi, consistent with public comments on Medium with

respect to the Symons blog (Ex2005⁴), was unable to explain how the RPA was created besides saying it used “their RPA tool”. (Ex2020, 152:20-25). But without, Symons does not necessarily define the automation process without the use of APIs or, more importantly, without lines of code.

b. The Result of Symons/Williams Combination is Irrelevant and Unsupported

Petitioner asserts Symons/Williams combination “results in a chatbot-RPA bot system capable of handling a user request for automated generation of an email signature along with other requests ...” (Petition, 14; Reply, 6-7). But this result has nothing to do with any missing claim elements, including “defining an automation process”. (Reply, 6-7). Even if Symons’ RPA were modified to handle “multiple automation processes” (Reply, 7), that does not establish it was necessarily (or would be) generated without an API, or more importantly, any line of code. (*Cf.* Petition, 13-14; Reply, 6-7). Mr. Zatkovich’s exemplary code (Ex2006) demonstrates the contrary.

Petitioner’s assertion that WPML “encompasses the user defining the automation process using a UI” (Reply, 6), is unsupported. Rather, WPML is used

⁴ Dr. Beigi recognizes these comments appeared “accurate” and “reflect[ing] how three individuals responded to the Symons Medium post” (Ex2020, 148:19-23, 149:15-18, 150:15-22).

to update rules and policies outside of the RPA product “does not relate to defining an automation process”, which instead relates to policies that may be drafted by business process owners and subsequently used as part of an automation process. (Ex2001, ¶206).

Williams Figure 1 (Reply, 6) using the word “taught” does not disclose “defining an automation process”. (Ex2001, ¶¶156-163, 206).

Regardless, Grounds 1/2 listing “possible arrangements existed in the prior art” fails under *Virtek, supra*.

2. Symons/Williams does not teach the claimed “automation process” configured to utilize a [c] “displayed user interface of a computer program”

a. Two GUIs

Grounds 1/2 rely upon two different user interfaces of two different pieces of software (the UI of the Cronos email generator running in a browser, and a Windows modal window of the operating system):

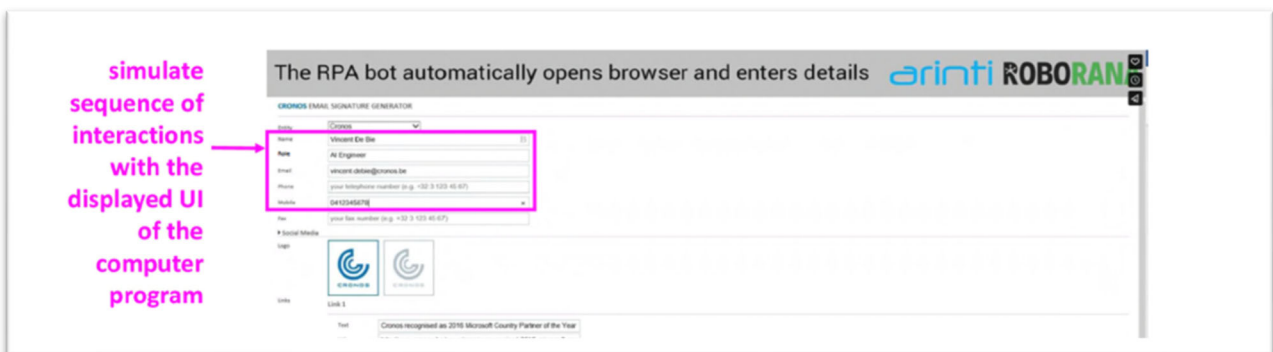


FIG. A (Petition, 19; Ex1003, ¶91)

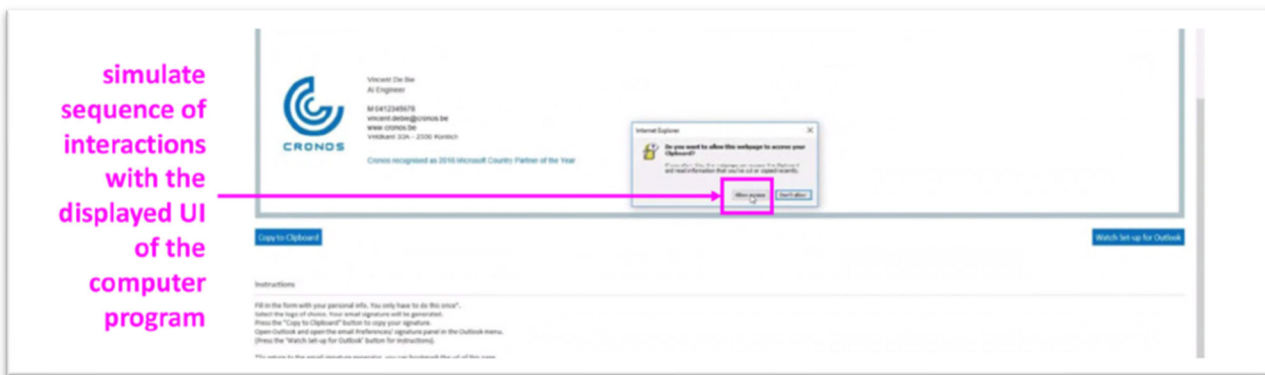


FIG. B (Petition, 20; Ex1003, ¶¶92)

(See also POR, 51-52; Ex2001, ¶¶228-229). [c] is not met.

PO’s read does not require that the automation process use “the displayed UI of **only** a single computer program”, *contra* Petitioner. (Reply, 12). Although other unclaimed steps in the automation process can be performed by any number of computer programs, the claimed steps, including the “sequence of interactions with the displayed user interface of the computer program”, must be performed using the **same** UI of the **same** computer program under the law of antecedent basis. (POR, 25).

Petitioner/Dr. Beigi reformulate their read, asserting the RPA software itself has its own GUI on which the automation process is run. (Reply, 12; Ex1042, ¶¶62-63). This is not in the Petition, has no support, and makes little sense. Even if the Symons RPA bot is a “desktop application”, according to the Petition, the RPA manipulates the displayed user interface (Pet., 18-20). It does not have its own GUI, and the Cronos email generator and Windows modal window are its GUI.

b. Symons does not necessarily disclose [c]

The Petition reads the ‘Allow Access’ button in FIG. B, above, as the automation process “executing a functionality of the computer program”. (Petition, 19-20; Ex1003, ¶91). But Dr. Beigi confirmed that the user, not Symons RPA, “most likely” clicks the “Allow Access” button: “it could be formed by the user and I believe that I think most likely by the user...” (Ex2020, 225:20-226:4). Thus, Grounds 1/2 does not meet [c].

3. Symons does not disclose [a] “defining a conversation” or necessarily using a “natural language interface”

Symons does not disclose **how** the conversation in the Arinti “chatbot” was generated or if it uses NLP. (POR, 38-39). Dr. Beigi does not know the “internals” of the Arinti “chatbot” or know **how** the user’s response is processed. Petitioner relies upon an informal inherency argument, ignoring the proper construction of “defining a conversation” (Pet., 38-39, 40-44; Ex1003, ¶88). The Reply offers no response other than the wrong construction.

Tellingly, Dr. Beigi confirmed that Mr. Zatkovich’s demo (Ex2006) did not meet claim 1 of Ex2011 (also reciting “natural language interface”), because it does not use NLP. (Ex2020, 83:25-84:12, 275:19-277:10; POR, 46-50; Ex2003, 63:15-64:17; Ex1003, ¶¶46-47; Petition, 5).

Petitioner’s attempts to explain away the lack of disclosure on the “internals” and Mr. Zatkovich’s demonstration (Reply, 13-15) are unavailing.

4. [b] Associating, [d] Publishing, and Order

To the extent the Board agrees that the order of the claim matters, Petitioner's offers no rebuttal to Symons failure to disclose how the conversation was generated. (Compare Reply, 13, with POR, 38-43; Ex2001, ¶214).

5. Petitioner Does Not Show Symons/Williams Teach the Dependent claims

a. 2/12/19

2/12/19 require that “defining comprises determining a conversation flow” which “defines an order between conversation elements”. Petitioner's continued reliance on an informal inherence argument that because Symons showed a conversation, does not mean that the order between conversation elements was inherently defined as required as 2/12/19 require. (Ex2001, ¶238). The other aspects are similarly absent from Symons.

a. 3/13

3/13 require “at least one of a message element and a condition element”. The Petition only pointed to Williams as teaching “conditional logic” in an RPA (Petition, 24-25). But that is not a “condition element”. (POR, 56). Faced with this fatal flaw, the Reply now seeks to assert a new aspect of Symons that is not part of the Petition, and thus not part of this proceeding. (Reply, 16)

b. 4/14

4/14 requires “the conversation elements comprise a second action element associated with a second automation process”. Symons only shows one automation

process. Without knowing the “internals” (Ex2003, 213:18-214:9), there is no “action element” disclosed.

Williams does not fill the gap, because Grounds 1/2 do not provide why or how Symons would be modified, or what would motivate a POSITA to make the single purpose conversation invoking a single automation process, want or need to do anything else. *Cf. Virtek, supra*.

B. Ground 3: Allen Fails

1. Allen Does Not Inherently Disclose [a]/[b]/[d], Petitioner’s New Read Should Be Rejected

The Petition (42-43) at most showed a conversation existed, citing Ex1014, 12:65-13:5. It never shows or explains “how” that conversation was generated, including how it was “defined”, or if it was “published” on the fly so that the next question would not be “defined” until after the previous question was published. (POR, 64-68). The Reply offers a new read, relying upon Allen’s defining “task-specific ontology” in the formulation of the automation process, as purportedly filling this gap. (Reply, 19-22).

This is not the basis for the Petition or the trial as instituted and should be disregarded. (Pet. 35-43; ID 17-23). *See* Trial Practice Guide 73 (2019). Regardless, these new arguments fail, as discussed below.

a. [a] **“Defining a conversation”**

Grounds 3/4 rely on the “conversation” at 12:64-13:5. (Petition, 39; Ex1003, ¶¶152-153). Allen does not disclose how this, or any other, conversation are generated, thus failing to teach “defining a conversation”. (POR 64-68).

Petitioner raises a new theory, pointing to training using “task-specific ontology”. (Reply, 20, *citing* Ex1014, 7:14-15). But 7:14-15 offers no teaching about how to define the conversation and merely states: “Natural language sentences obtained from the user are **thereby mapped to the task-specific ontology**”. The Reply’s extrapolation that this somehow means the “user provides the system with the conversation questions during training” is unsupported, and clearly does not match the Allen’s teachings. (Reply, 20).

b. **Allen Does Not Teach [d] Publishing, if It Is Using “task-specific ontology” as the Reply Now Asserts**

Petitioner’s reliance on “task-specific ontology” conveniently ignores that Allen’s use of “ontology” would result in information requests which are never “published” as part of a conversation but are instead “generated on the fly”. (POR 65, 68). As Mr. Zatkovich explained, “the most natural reading of Allen to a POSITA as of November 5, 2017 is that the conversation is developed **on the fly** using the properties of the task in the database”, and thus would never be published. (Ex2001, ¶361). This new read supports that conclusion, not rebuts it.

Similarly, Allen’s ontology does not show a conversation would have been first defined, then associated with an automation process, and then published. (*Id.*). As noted above, Dr. Beigi admits the publishing step must come after the conversation is defined and associated with the automation process. (Ex2021, 372:17-24). Accordingly, “on the fly”, ontologically-based conversation generation does not meet the claim.

Moreover, the Reply leaves completely unanswered PO’s response on element [d]. (*Compare* POR, 64-68 *with* Reply, 19-22). Thus, Petitioner’s Reply confirms that Allen fails to meet the claims, particularly since neither the Petition nor the Reply offered an obviousness analysis with respect to the “publication” element. (Pet., 42-43; Reply 19-22).

c. [b] Associating

Although Allen discloses obtaining information from a user, Allen does not teach “defining a conversation”, let alone associating a defined conversation with the automation process. (POR 64-66; Ex2001, ¶¶346-352). As Mr. Zatkovich explained, it would not be inherent, at least since Allen’s “automation can be performed without being associated with a conversation”. (Ex2001, ¶350).

Petitioner does not address this fundamental flaw in its reasoning, instead arguing that “price and delivery date information” would be part of a conversation and shows “associating”, since information is provided “back to the user”. (Reply,

21; Ex1014, 2-5). Providing information “back to the user” is not the claimed association, which allows the automation process to use “values [to one or more parameters associated with the automation process] provided by the user to the natural language interface” ([a]/[e]), not the other way around. (See Ex2001, ¶341).

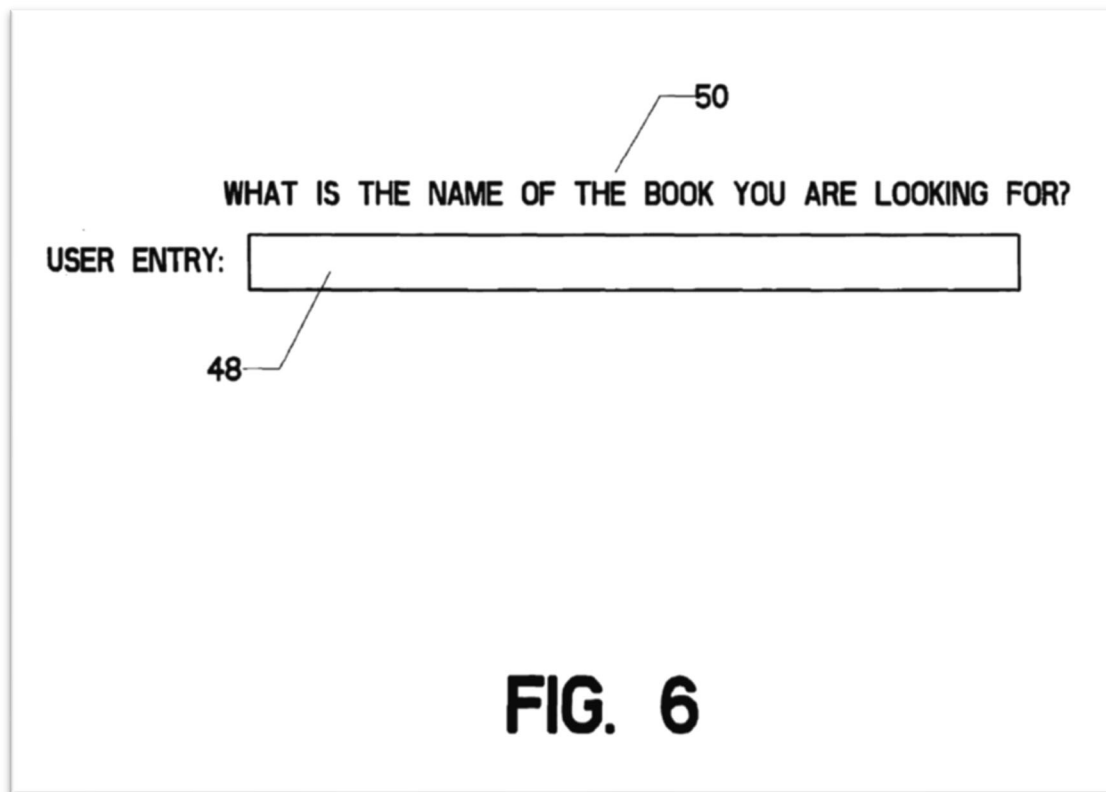
d. [a]/[b]/[d] Order of Steps

The Reply does not argue Allen discloses the claimed order. It does not. (POR, 65, 68; Ex2001, ¶361).

e. Allen Does Not Teach that the Conversation is Implemented Using a [a] “natural language interface” with Natural Language Processing

i. Allen teaches using a form, not a “natural language interface”

Allen teaches using a form, for example as displayed in Figure 6, to obtain information during execution of an automation process:



(Ex2014, FIG. 6; *see also* POR, 61-62, 64; Ex2001, ¶¶321-324, 339, 342).

Dr. Beigi explicitly acknowledged a form like Figure 6 collects information. (Ex2003, 257:15-24). He testified: “Q. So would a form where you fill in a name, address, telephone number, would that be human natural language? A. No”. (Ex2003, 60:24-61:3).⁵ Allen’s request for “name” of the book, is not a “natural language interface”. (POR 64; Ex2001, ¶¶321-324, *see also* ¶¶339-342).

⁵ The Reply provides no reasoning or explanation why Figure 6 is any different from “a form where you fill in name, address, telephone”. (Reply, 21; Ex1042, ¶¶116-119).

Petitioner’s concern that “name of the book” “is different from” “title” (Reply, 21) was answered by Dr. Beigi. He agreed “Figure 6 [is] an example of how the system asked [about information for the book buying task] using the word ‘name’ instead of title”. (Ex2003, 257:20)

Petitioner argues that “the Petition did not rely on Figure 6” because it relates to training”. (Reply at 21). But the same can be said of the “speech interface displayed 20” the Petition identifies as the “natural language interface”. As Mr. Zatkovich explained, the “speech interface display 20” is “used to teach the PLOW system how to perform a task”, not implement a conversation configured to invoke an automation process. (Ex2001, ¶¶305-318, 320-321, 336, 339-342). Even Dr. Beigi acknowledges these are “specific to training”. (Ex1042, ¶115).

Petitioner also provides a grab-bag of new citations to show Allen’s natural language interface is used outside training. These citations divergent from the Petition’s read (*compare* Petition, 38-40 *with* Reply, 20-21), and do not prove Petitioner’s point:

Ex1014, 18:38-49 (Claim 1): Does not show the “natural dialog-based interface” being used after training. Neither the Reply nor Dr. Beigi demonstrate otherwise. (Reply, 20; Ex1042, ¶112). Dr. Beigi expressly states this part of Allen

“shows that its GUI and natural dialog-based interface are limited to just training” (Ex1042, ¶112).⁶

Abstract: In full context, it should the GUI is used by the user, not the system, during performance: “A system **which allows a user to perform[s] complex, repetitive** tasks that the user usually would perform using the device’s graphical user interface (GUI).” (Ex1014, Abstract; **bold** omitted, underscored added by Petitioners).

1:50-52: “The present invention can be configured to apply to virtually any computational device employing a [GUI]...” offers no insight on using a “natural language interface”.

15:24-40: Irrelevant to a “natural language interface”. About FIG. 10, a GUI of the system showing formatted search results, not performing a “parameterized automation process.”

2. PLOW is not “a computer program” and the Tasks Do Not Execute any Functionality of PLOW Using a “displayed user interface” of PLOW (elements 1[c]/11[c]/18[c])

a. PLOW Is Not a Target System

Notwithstanding the Petition’s ambiguity, Dr. Beigi now clarifies that Grounds 3/4 assert Allen’s “PLOW” is the claimed “computer program”, not

⁶ He takes the opposite position in IPR2023-01368, Ex1042, ¶72.

“Widgico” which is the target system. (Ex2020, 237:2-8; Ex1042, ¶142). Under PO’s construction, since PLOW is not a target system, Grounds 3/4 fail.

b. Allen Does Not Teach Using a “Displayed User Interface” During Execution

Even if PLOW could be a “computer program”, the automation process of buying a book, does not necessarily use a “displayed” user interface of PLOW nor necessarily cause PLOW to simulate a sequence of interaction on its GUI to execute functionality of PLOW. (POR 63; Ex2001, ¶322). The book buying functionality is executed on the target system, Widgico, not PLOW.

“Allen discloses a ‘method for learning and executing executable tasks using language’” (Reply, 20) does not demonstrate otherwise. Petitioner’s conclusory argument should be rejected. *See* caselaw in POR 40-42.

3. Dependent claims

a. 2/12/19

2/12/19 require “defining a conversation” to include “determining a **conversation flow**” which “defines **an order** between conversation elements”. (POR, 69; Ex1003, ¶¶364-384). Petitioner continues to fail to show these extra elements. (Reply, 22).

b. 3/13

3/13 depends on 2/12, and so the “conversation elements” must include a “message element” and a “question element”. Petitioner’s read does not.

Petitioner mapped Allen’s request “authorization” to both the “message element”, required by 3/13, and the “question element” required by 2/12/19 (not the “condition element”, as Petitioner misattributes at Reply, 22. (*Compare* POR 70 with Petition at 44-45; *see also* Ex1003, ¶¶391-392).

Petitioner asserts it mapped “ask[ing] whether the user wishes to complete the transaction” to “condition element”. (Reply 22), But the Petition did not identify *any* condition elements (Pet., 44-45), nor rely on a search condition offered by Dr. Beigi, which is not a conversation “condition element”. (POR 70; Ex1003, ¶394). Regardless, this new read also fails by mapping the “authorization request” both onto the asserted “condition element” and the asserted “question element”.

c. 4/14, 5/15 are not both met

PO is not asserting a conversation cannot “be both associated with a second automation process” and also be “part of a plurality of conversations”. (Reply, 22-23). Rather, PO objected to using the same tasks in Allen (the “book buying task” and “hotel searching task”) to show both were invoked from the same conversation for 4/14 and different conversations of a “plurality of conversations” for 5/15. (POR 70-71; Ex2001, ¶¶398-414). Allen expressly disclose neither scenario. Petitioner asserts both are merely plausible, neither is “necessarily so”. Paradoxically, Beigi now confirms that “the conversation for the book buying task would be different

from the conversation for the hotel searching task”. (Ex1042, ¶140). This defeats at least claims 4/14.

d. Claim 9

PLOW as the asserted “computer program” is not a “target system”, and does not execute any functionality with its user interface. Adding a new task to PLOW would still not meet Claim 9.

C. Grounds 2/4: Ben-Itzhak/Symons/Williams (Ground 2), Ben-Itzhak/Allen (Ground 4) Fail

Ben-Itzak is not analogous art. (POR 72-74; Ex2001, ¶¶276-286).

6/16/21 requires “interaction with the link is configured to cause execution of the automation process.” Ben-Itzhak’s disclosure to “generate personal recommendations” does not teach this gap in the email signature generation process in Symons (Ground 2), nor to PLOW’s training system in Allen (Ground 4). (Ex2003, 314:23-315:8; POR, 74-75; Ex2001, ¶268, 274; Ex1034, [0018]).

D. Ground 5: Krishnan/Radhakrishnan Fails

1. No “natural language interface” in Krishnan

As Dr. Beigi confirms, *button* inputs (like for destination 130) are not a natural language interface (Ex2003, 199:11-200:25) (explaining that if “bots use buttons, then I would say it’s a form” and if “you click yes or no or you select something and then you say next ... that is just a form” as opposed to natural language.). Petitioner instead turns to a new ground that Krishnan’s 11:4-6 “teaches

receiving the input for destination 130 via typed words” (Reply, 25). However, this passage is not in the Provisional (Ex1017), and thus is not prior art. (*Cf.* Ex1003, ¶217).

2. No [c]/[e] “parameterized automation process” using the “displayed user interface” to “execute a functionality” of the computer program in Radhakrishnan

[c] require the “parameterized automation process” “utilize a displayed user interface a computer program” to “execute functionality of computer program”. Krishnan has no “automation process”; its execution of tasks uses “back-end” systems (Ex1016, 2:33-35). The Petition relies on Radhakrishnan, not Krishnan, for these elements. (Petition, 60-69). The Reply’s assertion, that Krishnan’s reference to “*or other information processing systems*” (Reply, 25) suggests using a GUI is unsupported by Krishnan.

Radhakrishnan does not fill this gap. The Reply’s assertion (26) that the RPA module interacts an application’s presentation layer **within a** virtual environment (Ex1018, 11:41-47) fails, since this is not executing a functionality on a displayed user interface of a computer program (i.e., the target system relied upon in Krishnan). Petitioner’s reply, that “‘virtual environment’ refers to whether the interactions are computer simulated, not whether they are displayed” (Reply, 26), is without basis and is contradicted by Radhakrishnan itself: “...virtual environment wherein the bot interprets the display of a screen electronically” (Ex1018, 5:58-59). Finally,

Radhakrishnan's automation processes are not "parameterized" nor configured to be "invoked". (Ex2001, ¶¶481-488).

3. Krishnan's Backend, Lack of Motivation to Combine

The Reply's assertion that "the automation process ... is tied to the displayed UI" has no support from the Petition. (Reply, 26-27). If the "combination does not replace Krishnan's database or access it with a displayed UI" (*id.*), this would only increase processing activities (by using both the GUI and backend database). (POR, 78-81; Ex2001, ¶¶489-492). It also does not use a GUI to, *e.g.*, book a flight, as required.

4. Non-analogous art

Rather than endorse Dr. Beigi (Ex2003, 273:20-276:25; 278:13-24), the Reply offers a new and different field for Radhakrishnan (Reply, 24), raising questions about Dr. Beigi's reliability, and the reference's appropriateness.

5. Dependent claims 9/10

Petitioner's analysis of 9/10 are incomprehensible, and fail to respond to POR, 82 and Ex2001, ¶¶494-503.

IV. THE BOARD SHOULD GIVE LITTLE/NO WEIGHT TO DR. BEIGI, NOT MR. ZATKOVICH

Petitioner asserts Mr. Zatkovich's opinion should be given little to no weight. (Reply, 30), To the contrary, Dr. Beigi's opinions deserve little or no weight.

Since Mr. Zatkovich relied upon the specification for his construction of “computer program” as a “target system”, not the claims ordinary and customary meaning, no “dictionary” definitions are relevant.

By contrast, Dr. Beigi’s construction was based on strained and unsupported citations to the specification and a failure to appreciate distinctions in usage of the terms “computer program”, from other different terms in the specification. Dr. Beigi’s analysis should not be credited.

Mr. Zatkovich was consistent in his testimony, unlike Dr. Beigi who changed several key points from his prior deposition, as discussed herein.

Dr. Beigi was evasive, would ramble with convoluted and irrelevant analysis, (*See, e.g.*, Ex2020, 176:10-179:20), hide his compensation (15:4-17:9), the amount of work he performed (15:4—17:9; 93:4-10, 95:2-19), the materials he relied upon (which were not identified in his declaration) (Ex2020, 106:10-22). His declaration had errors that if he had checked before signing he should have caught. (Ex2020, 142:21-145:9). His analysis of the ’317 Patent illustrates he did not “understand” the proper obviousness legal framework. (Ex2020, 179:21-180:9, 197:3-202:19).

V. CONCLUSION

Petitioner failed to establish Claim 1-6/9-16/18-21 are unpatentable.

Respectfully submitted,

Dated: November 19, 2024

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATION

Pursuant to 37 C.F.R. § 42.24(d), I hereby certify that this Sur-Reply complies with the type-volume limitation of 37 C.F.R. § 42.24(c)(4) because, based upon the word count of the word-processing system used to prepare this petition, the number of words in this Sur-Reply is 5,597. Pursuant to 37 C.F.R. §42.24(c), this word count does not include “table of contents; a table of authorities; a listing of facts that are admitted, denied, or cannot be admitted or denied; a certificate of service or word count; or an appendix of exhibits.”

By: /Charles R. Macedo/

Dated: November 19, 2024

Charles R. Macedo

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that on this 19th day of November 2024, a copy of the foregoing **PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY FOR *INTER PARTES* REVIEW OF CLAIMS 1-6, 9-16, AND 18-21 OF U.S. PATENT NO. 11,258,732 B2** was served via electronic mail on the following counsel of record for Petitioner in this proceeding:

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