

Patent No. 10,819,664
Petition For *Inter Partes* Review

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Whatfix Inc.
Petitioner,

v.

WalkMe Ltd.
Patent Owner.

Patent No. 10,819,664

Inter Partes Review No. IPR2023-01443

**PETITION FOR *INTER PARTES* REVIEW
UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.100 *et seq.***

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Petitioner Whatfix, Inc. petitions for *inter partes* review of claims 10 and 24 (“challenged claims”) of U.S. Patent No. 10,819,664 (“the ’664 patent” (EX1001)) in accordance with 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 *et seq.*

I. INTRODUCTION

The ’664 patent claims are directed to a method and system that involves a natural language conversation with the user, and then automatically executes a process that simulates interactions with a displayed user interface (UI). For example, the ’664’s system includes a chatbot that collects information from the user for buying stocks, and automatically fills out the online stock purchase form using the collected information. (EX1001, 8:17-23.)

Collecting information using a chatbot and performing an automation process using the collected information was well known before the ’664 patent’s 2017 filing date. Discussed in more detail below, Symons discloses a chatbot that collects the user’s name, job role, email address, etc., and automatically creates an email signature using the collected information. Allen likewise discloses teaching (by a non-programmer user) and executing a bot that collects book information from the user and then automatically buying a book online using the collected information. Similarly, Krishnan discloses a chatbot, and Radhakrishnan discloses a robotic process automation (RPA) bot that performs an automation process without using an application programming interface (API). Like the ’664 patent,

the automation processes in Symons, Allen, and Radhakrishnan simulate interactions with a displayed user interface (UI).

Petitioner submits that the challenged claims are unpatentable for the reasons set forth in this Petition, as supported by Dr. Homayoon Beigi (EX1003).

II. BACKGROUND OF NATURAL LANGUAGE PROCESSING AND PROCESS AUTOMATION

Natural language processing (NLP) refers to the interaction between a computer and a human using human “natural” language, where human users are able to converse with the chatbots using every day, natural language (instead of using programming code). (EX1003, ¶17.) For example, some businesses have replaced customer service agents with chatbots. (EX1026, 2; EX1027; EX1003, ¶17.)

Process automation refers to automation of certain tasks. (EX1003, ¶18.) For example, transactional, repetitive tasks may be automated using RPA bots. (*Id.*, ¶¶18-19.) RPA bots are being used to process insurance claims, conduct credit checks, etc. (EX1026, 2; EX1003, ¶19.)

Both NLP and process automation offer lower operational costs, high volume processing, and faster turnaround time. (EX1003, ¶20.) In 2017, a chatbot could have an intelligent conversation with a human, but may only have been able to provide, *e.g.*, answers from a search engine, while an RPA bot may have been

able to automatically perform more complex tasks that require, *e.g.*, analysis or executing actions. (*Id.*) Combining the two not only exploited the benefits that both had to offer, but also expanded the capabilities that each may not have had alone. (*Id.*)

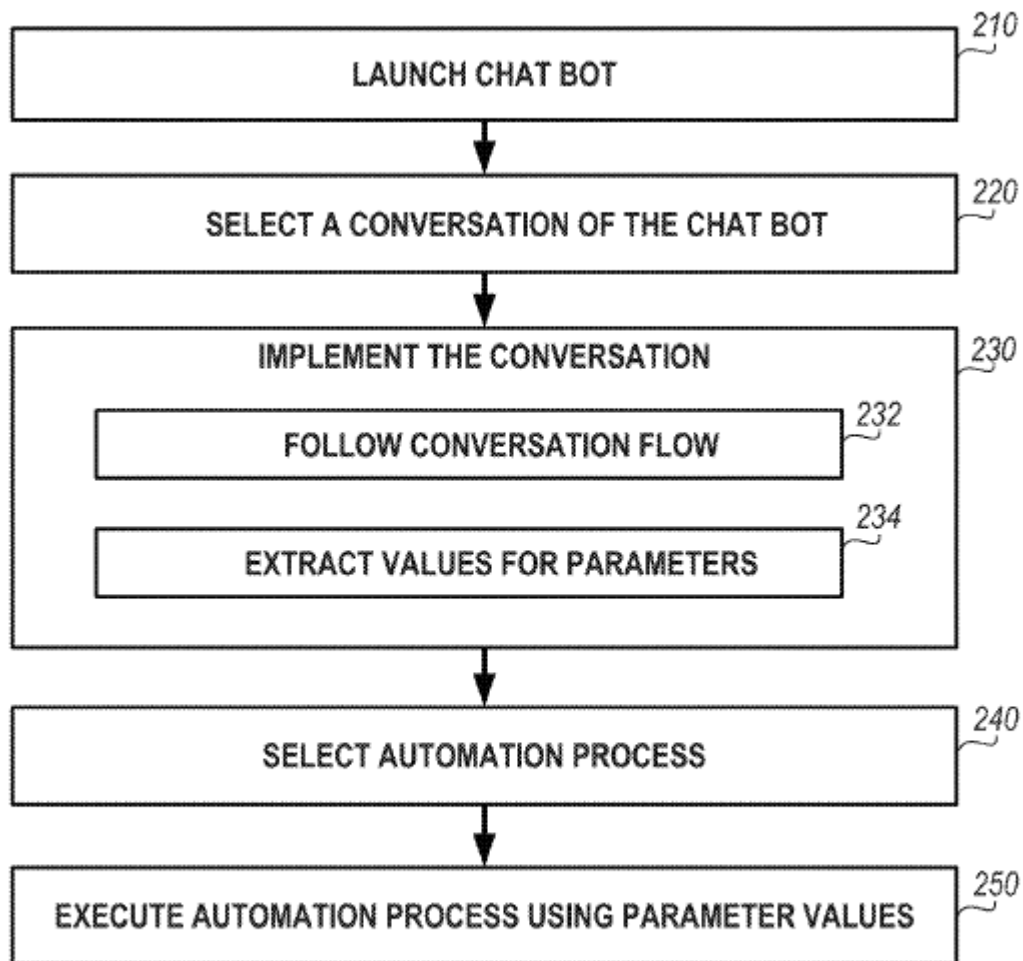
The idea of combining NLP and process automation and the associated benefits were known by at least November 5, 2017 (earliest priority date for the '664 patent). (EX1030, 6-7; EX1031, 4; EX1003, ¶21.) “[T]his harmonious alliance [of a chatbot-RPA bot combination] is revolutionizing business operations, enhancing customer experiences, and driving efficiency gains.” (EX1026, 1.) “[E]ndless possibilities [] arise when chatbots and RPA come together.” (EX1026, 1-2.)

III. SUMMARY OF THE '664 PATENT

The '664 patent discloses “[a] method, apparatus and product for chat-based application interface for automation.” (EX1001, Abstract.) The chatbot is an allegedly user-friendly way to converse with a user for, *e.g.*, collecting information. (*Id.*, 7:62-64, 9:44-47; EX1003, ¶23.) An automation process is executed, based on the conversation, including simulating a sequence of user interactions with a UI (*e.g.*, filling out an online form using the collected information) that is displayed. (*Id.*, 9:44-47, 10:8-10; 14:12-17.)

Fig. 2A (below) shows the chatbot is launched (step 210), and a

conversation between the chatbot and user is selected and implemented (steps 220, 230). (*Id.*, 13:24-58; EX1003, ¶24.) Values are extracted (collected) from the conversation (step 234), and an automation process is selected and executed (steps 240, 250) using the collected values. (EX1001, 13:58-14:17.)

**FIG. 2A**

A. Effective Filing Date

The '664 patent was filed on March 19, 2019, issued on October 27, 2020, and claims priority to a provisional application filed on November 5, 2017. For purposes of this Petition only, Petitioner relies on November 5, 2017 as the earliest effective filing date. (EX1003, ¶22.)

B. Prosecution History

During prosecution, the Examiner identified Corbett (EX1019), Chang (EX1020), White (EX1021), Owen (EX1022), and Gallopyn (EX1023) as the closest art to the substance of the independent claims. (EX1002, 208, 242, 243, 245, 283 285; EX1003, ¶¶27-35.)

Applicant amended the claims to recite: a natural language conversation (elements 1[a], 1[b] (below)); determining an automation process that simulates user interactions with a displayed UI using inputs from the natural language conversation (element 1[c]-1[e] (below)); and executing the automation process (element 1[f] (below)). (EX1002, 242, 243, 245, 304; EX1003, ¶¶27-35.)

Without stating the reasons for the allowance, the Examiner issued a Notice of Allowance. (EX1002, 367; EX1003, ¶36.)

C. Level of Ordinary Skill in the Art

A person of ordinary skill in the art (“POSITA”) in the field of the '664 patent would have a bachelor’s degree in engineering or computer science and two

years of experience working on NLP and automation processes. Alternatively, a POSITA would have five to six years of experience working on NLP and automation processes. (EX1003, ¶¶47-49.)

IV. CLAIM CONSTRUCTION

For purposes of this Petition only, Petitioner does not believe any terms require a formal construction. Each of the terms carries its “ordinary and customary meaning” (“the meaning that the term would have to a person of ordinary skill in the art in question” at the time of the invention). *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (citation omitted); (EX1003, ¶¶50-51).

V. PRECISE REASONS FOR RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.104(b), Petitioner requests cancellation of the challenged claims based on the following references (EX1003, ¶¶25-26, 52-57):

Prior Art Reference	Abbreviation (Exhibit No.)
S. Symons, “When Chatbots meet RPA bots,” Medium, (2017)	“Symons Article” (EX1004)
English Translation of Screenshots of S. Symons, “RPA meets chatbot: Automatically generate e-mail signature,” Vimeo, (2017)	“Symons Video” (EX1006)
D. Williams et al., “Using artificial intelligence to optimize the value of robotic process automation,” IBM White paper, (2017)	“Williams” (EX1011)

Prior Art Reference	Abbreviation (Exhibit No.)
U.S. Pub. No. 2017/0250930	“Ben-Itzhak” (EX1034)
U.S. Patent No. 7,983,997	“Allen” (EX1014)

The statutory grounds for the challenge of each claim are set forth below.

All of the statutory citations are AIA.

Ground	35 U.S.C. §	Claims	Prior Art Reference(s)
1	103	10, 24	Symons (Article and Video), Williams, Ben-Itzhak
2	103	10, 24	Allen, Ben-Itzhak

Below, Petitioner discusses why the challenged claims are unpatentable under the statutory grounds raised, including how and where the prior art satisfies each element of each challenged claim, as required by 37 C.F.R. § 42.104(b)(4). Petitioner’s showing establishes a reasonable likelihood that it will prevail on each ground of unpatentability to each challenged claim.

A. Ground 1 – Symons, Williams, and Ben-Itzhak Render Obvious Claims 10 and 24

1. Summary of Symons

The Symons Article and the Symons Video (collectively “Symons”) were publicly available on Medium and Vimeo by at least October 19, 2017. (EX1008.) The Medium page indicates that the Symons Article was posted on October 19, 2017. (EX1004.) The text of the Symons Article accords with the contents of the

Symons Video. (EX1004; EX1006; EX1008; EX1003, ¶¶58-60.)

The Symons Article indicates that it was posted by Senne Symons, an employee of RoboRana, who verified the authenticity of the Symons Article and the Symons Video. (EX1008.) Mr. Symons also verified that the Symons Article and the Symons Video were made publicly available by at least October 19, 2017. (*Id.*) Mr. Symons was one of the names appearing in the Symons Video. (EX1006, 18.)

The Baetens Article includes a link to the Symons Article and Symons Video. (EX1009.) The Baetens Article was publicly available on Medium by at least October 20, 2017. (*Id.*) The Medium page indicates that the Baetens Article was posted on October 20, 2017. (*Id.*) The text of the Baetens Article accords with the contents of the Symons Article and the Symons Video. (EX1009; EX1006; EX1010; EX1003, ¶61.)

The Baetens Article indicates that it was posted by Wouter Baetens, a previous employee of Arinti, who verified the authenticity of the Baetens Article and Symons Video and public availability by at least October 20, 2017. (EX1010.) Mr. Symons and Mr. Baetens verified that they worked together on development of the chatbot-RPA bot system discussed in the Symons Article, Symons Video, and Baetens Article. (EX1008; EX1010.)

Medium and Vimeo are mainstream Internet-based platforms that companies

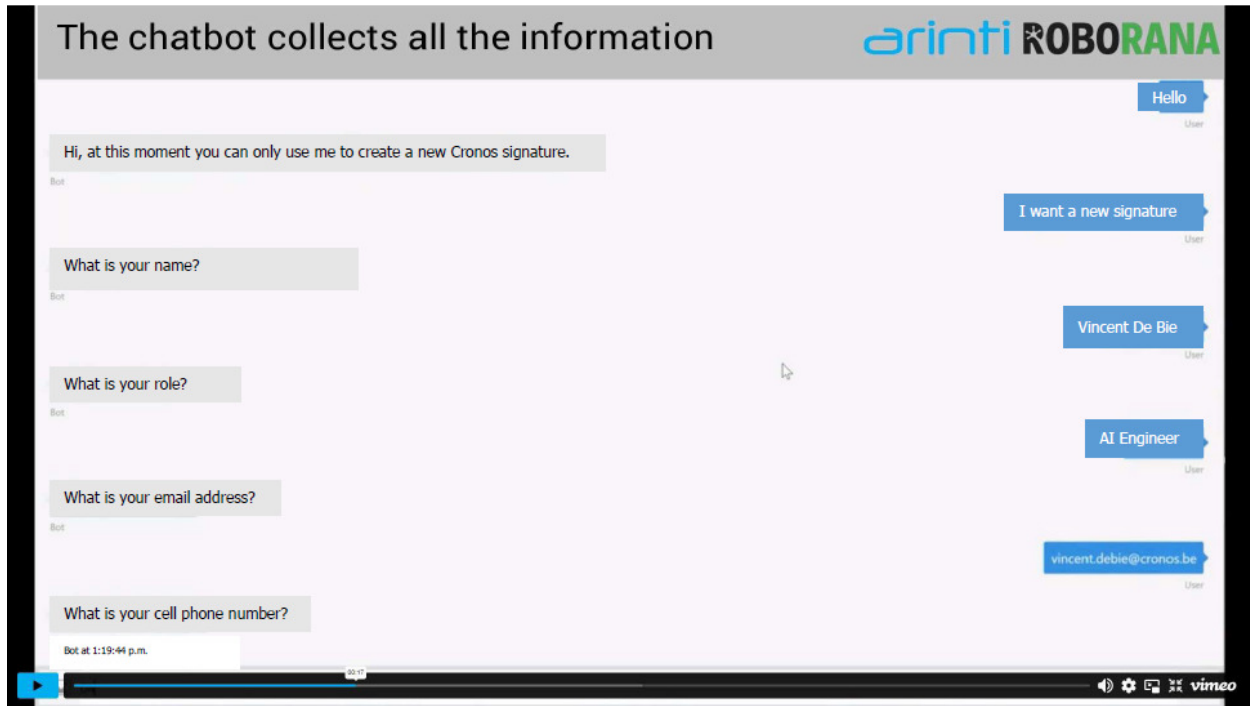
like RoboRana and Arinti use to disseminate information about products to interested members of the public, including POSITAs. (EX1003, ¶¶58, 61.) These platforms were well-known, public (*e.g.*, no access restrictions), searchable, and intended to reach a wide audience. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 18 (PTAB Dec. 20, 2019) (precedential); (EX1003, ¶58). Given that Medium and Vimeo are known in the industry for spreading ideas and discussing technologies of interest, a POSITA would have readily located information that RoboRana and Arinti posted on these platforms with reasonable diligence. (EX1003, ¶58.) Moreover, videos can constitute printed publications in IPR proceedings under § 311. *London Luxury LLC v. E&E Co., Ltd.*, PGR20201-00083, Paper 10 at *18-19 (PTAB Nov. 15, 2021).

Based on this evidence taken as a whole, the Symons was publicly available by at least October 20, 2017, and is prior art to the '664 patent at least under § 102(a)(1) as a printed publication or as being otherwise available to the public. The Examiner never found, and Applicant never cited, Symons during prosecution.

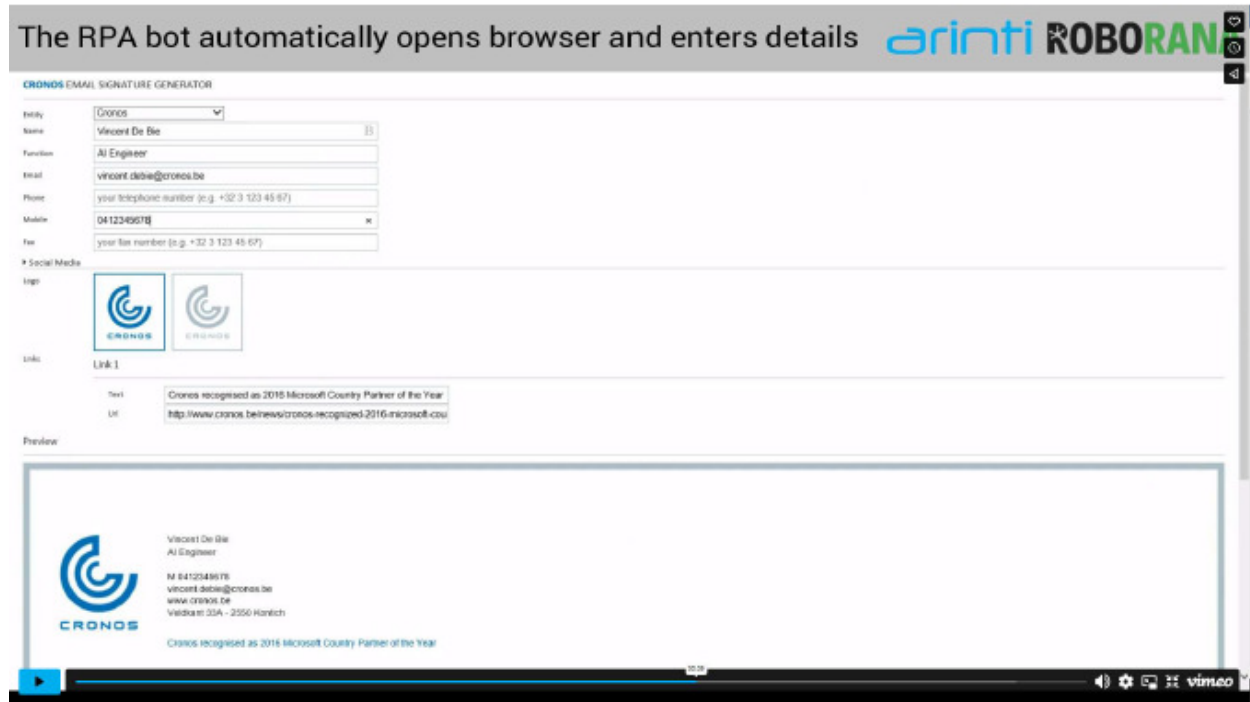
Symons discloses a computer system and computer program that “automate the process of creating an email signature.” (EX1004, 2; EX1003, ¶62.) “First, the chatbot collects all the information in a friendly, interactive manner. This information gets passed on to the RPA robot, which will then automatically generate the signature, save it, and email it back to the requester.” (EX1004, 2.)

The “RPA bot can mimic the users’ actions and thus enables organizations to automate repetitive tasks.” (*Id.*)

The chatbot asks questions to collect the user’s name, job role, email address, and phone number. (EX1006, 2-6; EX1003, ¶62.)



The chatbot then triggers the RPA bot, which automatically inputs the collected information in input fields to generate the email signature, and clicks on UI buttons to email the signature to the user. (EX1006, 10-17; EX1003, ¶¶63-64.)



2. Summary of Williams

Williams is a white paper that was publicly available on IBM's website by at least September 2017. (EX1012.) The September 2017 date time stamps on the first and last pages of the document means that it was freely available to the public no later than that date. One of the authors is Ira Allen, an employee of IBM during that time, who verified the authenticity of Williams its public availability on IBM's website by at least September 16, 2017. (EX1012.)

White papers are often made available on a company's website to disseminate information to interested members of the public, including POSITAs. (EX1003, ¶¶65.) IBM's website was well-known, public (*e.g.*, no access restrictions), searchable, and intended to reach a wide audience. *Hulu, LLC v.*

Sound View Innovations, LLC, IPR2018-01039, Paper 29 at 18 (PTAB Dec. 20, 2019) (precedential); (EX1003, ¶¶65). IBM is a known trailblazer in the field and publishes white papers to disseminate, promote, or highlight information to POSITAs about its products. A POSITA would have readily located Williams on IBM's website with reasonable diligence. (EX1003, ¶¶65-66.)

Williams was also publicly available on IT World Canada's website by at least September 16, 2017. (EX1012.) The IT World Canada post indicates that Williams was posted on September 16, 2017. (EX1013.) Ira Allen verified the authenticity of the post and verified that it was publicly available by at least September 16, 2017. (EX1012.)

IT World Canada is an online website that was known, public (*e.g.*, no access restrictions), searchable, and intended to reach a wide audience. *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 18 (PTAB Dec. 20, 2019) (precedential); (EX1003, ¶¶67-68). Companies like IBM use IT World Canada to disseminate information to interested members of the public, including POSITAs. (*Id.*) Accordingly, a POSITA would have readily located Williams on this website with reasonable diligence. (*Id.*)

Based on this evidence taken as a whole, Williams was publicly available by at least September 16, 2017, and is prior art to the '664 patent at least under § 102(a)(1) as a printed publication or as being otherwise available to the public.

(EX1011.) The Examiner never found, and Applicant never cited, Williams during prosecution.

Williams discloses a system and method that combines artificial intelligence and RPA. (EX1011, 1; EX1003, ¶69.) RPA offers a significant reduction in operational costs, but can have deployment challenges, so Williams proposes using cognitive computing to address these challenges. (EX1011, 2; EX1003, ¶69.)

Williams' intelligent automation system comprises chatbots that engage in natural language dialog with a user to determine the user's intent and collects information from the user. (EX1011, 3; EX1003, ¶70.) The chatbot then triggers an RPA bot, passes the collected information to the RPA bot, and the RPA bot completes the request. (EX1011, 3; EX1003, ¶71.)

Fig. 1 (below) shows Williams' intelligent automation continuum. A robot is taught to drive applications like a human does through a GUI. (EX1011, Fig. 1; EX1003, ¶72.) The robot conducts complex calculations, performs actions, and triggers downstream activities and/or interacts with humans using, *e.g.*, NLP. (EX1011, Fig. 1; EX1003, ¶72.)

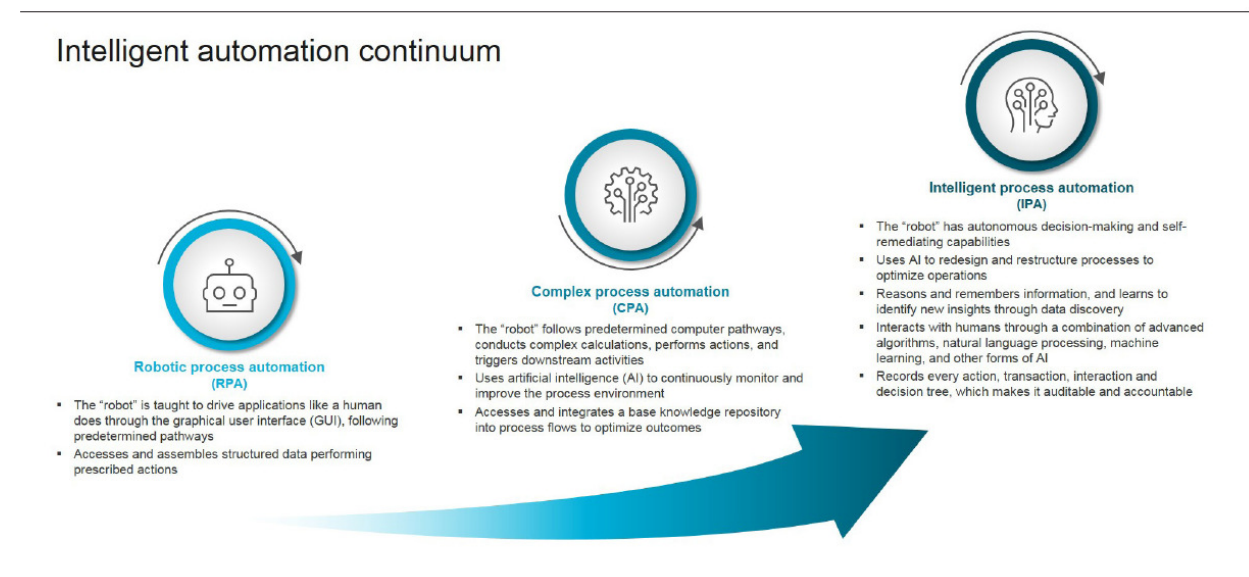


Figure 1. This diagram shows IBM's intelligent automation continuum.

3. Symons and Williams Render Obvious Independent Claims 1 and 19

a. Claim 1

(i) Preamble: "A method comprising:"

To the extent the preamble is limiting (which Petitioner does not concede), Symons discloses the preamble.

Symons discloses a method that "automate[s] the process of creating an email signature." (EX1004, 2; EX1003, ¶73.)

(ii) 1[a]: "using a natural language interface, receiving input from a user as part of a natural language conversation between the natural language interface and the user,"

Symons discloses using chatbots as "a more intuitive, natural way to interact with [] customers." (EX1004, 2.) "First, the chatbot collects all the information in

a *friendly, interactive manner*.” (EX1004, 2 (emphasis added).) The chatbot uses a natural language interface (below), where “[t]he chatbot collects all the information.” (EX1006, 5; EX1003, ¶¶74-76.)



The chatbot receives input from a user: asking the user for a name (“What is your name?”), job role (“What is your role?”), email address (“What is your email address?”), etc. (screen above), and the user responds. (EX1006, 5; EX1003, ¶¶77-78.) The chatbot’s questions and the user’s responses are displayed on a GUI, and resembles language spoken by a human, and are part of a natural language conversation between the natural language interface and the user. (EX1003, ¶78.)

- (iii) **1[b]: “wherein the natural language conversation comprises a first natural language input from the user, a natural language feedback on the first natural language input from the natural language interface, and a second natural language input from the user in response to the natural language feedback:”**

The natural language conversation between Symons’ chatbot and the user comprises a first natural language input from the user (annotated below), *e.g.*, the user inputs “I want a new signature” in response to the chatbot’s welcome message. (EX1006, 5; EX1003, ¶¶79-83.) The user also inputs “Vincent De Bie” when the chatbot asks a first question: “What is your name?” (EX1006, 5; EX1003, ¶¶79-83.) Since the user responded to the chatbot’s question message and answered the first question, the chatbot continues the conversation with a second question (“What is your job role?”). (EX1006, 5; EX1003, ¶¶79-83.) This continuation of the conversation is a natural language feedback (*e.g.*, that the chatbot received a suitable answer to the question) on the first natural language input from the natural language interface. (EX1003, ¶82.)



In response to the second question (natural language feedback), the user responds (“Engineer”) (above), which is a second natural language input from the user. (EX1006, 5; EX1003, ¶¶83.)

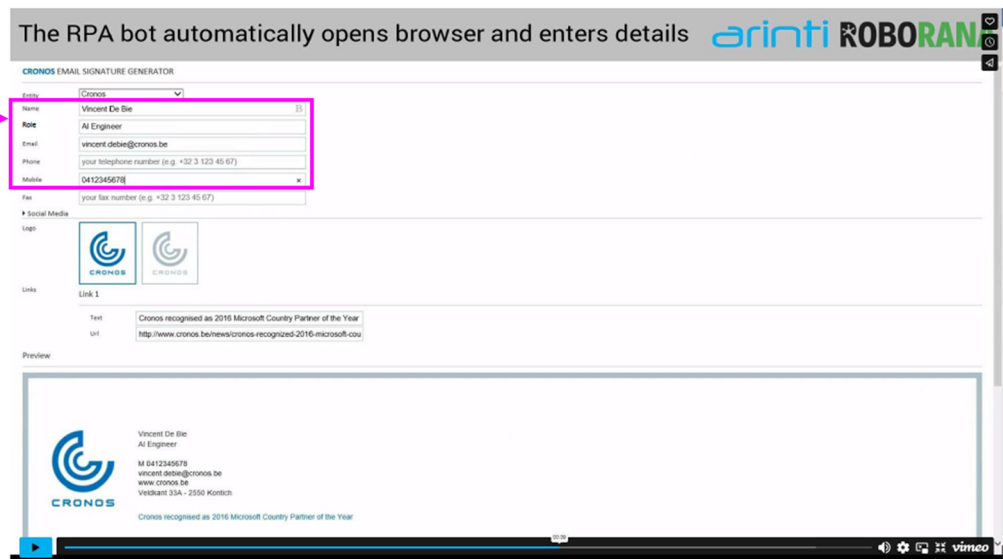
- (iv) **1[c]: “determining, based on the first and second natural language inputs from the user, an automation process configured to perform an automation of a sequence of interactions with a displayed user interface of a computer program and to simulate user interactions with the displayed user interface of the computer program,”**

In Symons, the first and second natural language inputs from the user comprise the welcome-message response, name “Vincent De Bie,” and job role “Engineer.” (See element 1[b]; EX1003, ¶¶84.) Based on the welcome-message response, name, and job role (first and second natural language inputs from the user), Symons *determines* an automation process that “*automate[s] the process* of creating an email signature.” (EX1004, 2 (emphasis added); EX1003, ¶¶85.)

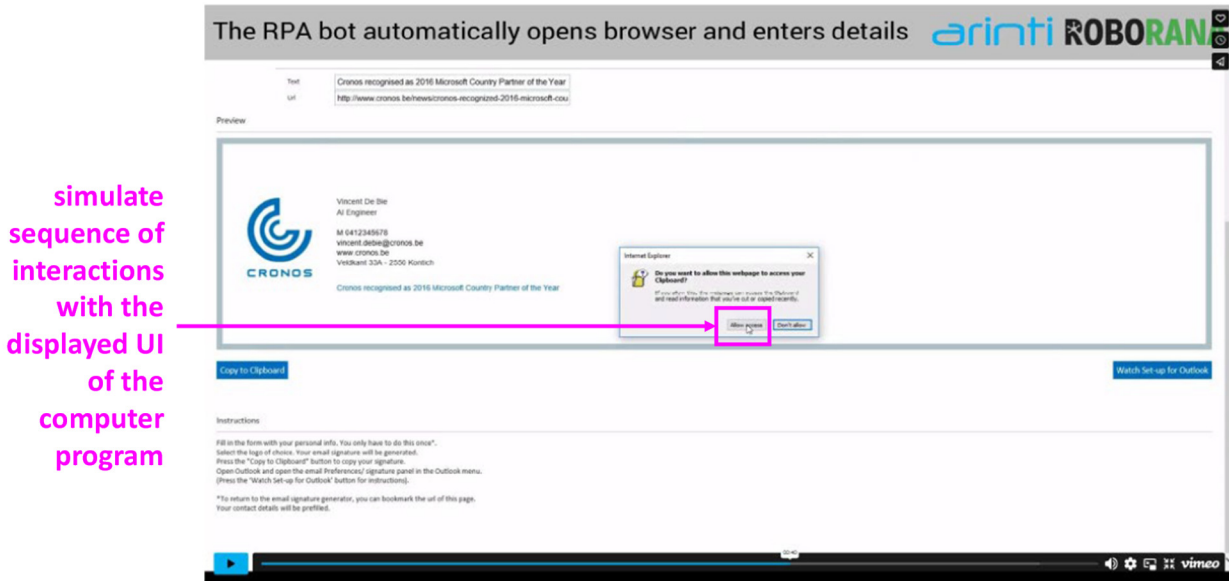
It would have been obvious for Symons to determine an automation process that waits for the user to respond, or an automation process that receives collected information from the chatbot. (EX1004, 2; EX1003, ¶¶86-87.) “The chatbot triggers the RPA bot.” (EX1006, 10.)

Symons’ RPA bot performs an automation of a sequence of interactions with a displayed UI of a computer program (annotated below), “mimic[ing] the users actions.” (EX004, 2; EX1003, ¶88.) “The RPA bot automatically opens browser and enters details,” entering “Vincent De Bie” and “Engineer” in the name and job role input fields (annotated below). (EX1006, 10-11; EX1003, ¶88.)

simulate
sequence of
interactions
with the
displayed UI
of the
computer
program



The RPA bot also simulates user interactions via GUI button clicks (annotated below). (EX1006, 13; EX1003, ¶89.)



To the extent that Symons does not determine an automation process, it would have been obvious in view of Williams. (EX1003, ¶¶90.) Williams discloses a method comprising “chatbots [that] engage[s] in natural language dialog with the caller and *discern, through a series of interactions, the nature of the call and then capture information required to further handle the request.* The chatbot will then trigger a robot, passing the required information to the robot to complete the request.” (EX1011, 3 (emphasis added).)

A POSITA would have been motivated to have a chatbot that discerns the user’s intent (the nature of the call) so that the RPA can handle multiple requests, improving the costs, time, and capabilities. (EX1003, ¶¶90-91.) RPA robots are designed to execute multiple different types of automation processes, so combining Symons and Williams, both which disclose chatbots-RPA bot systems, is a natural extension of exploiting the full capabilities of RPA. (*Id.*, ¶¶92-94.) The

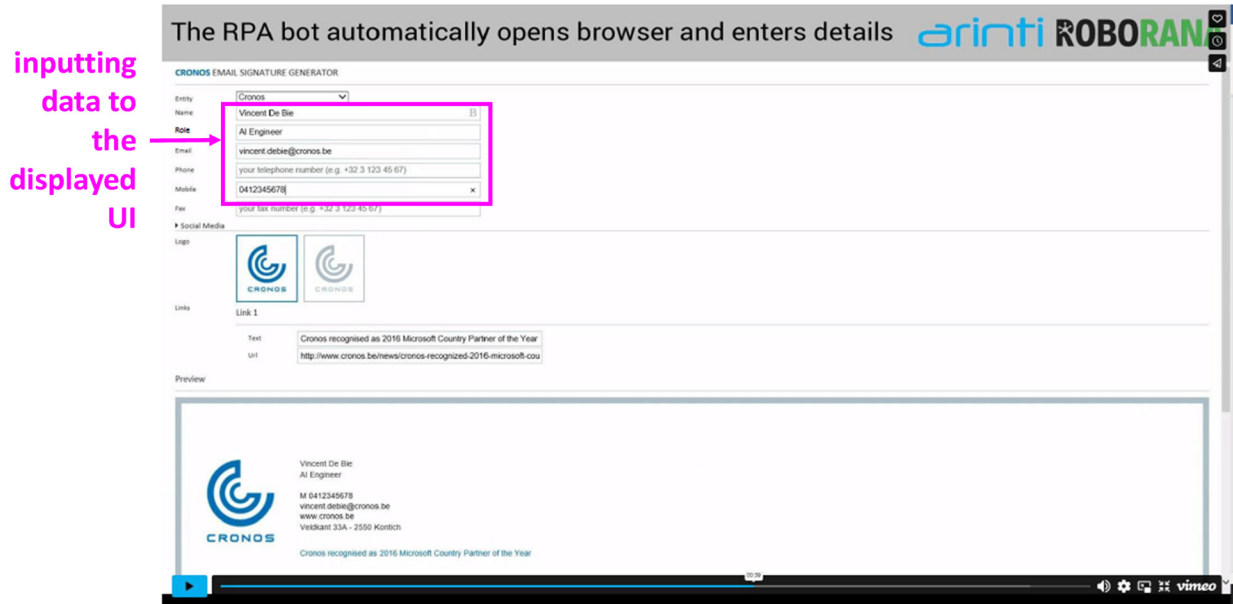
Symons-Williams combination results in a chatbot-RPA bot system capable of handling a user request for automated email signature generation along with other requests, such as automated generation of an electronic letterhead or an electronic invoice. (*Id.*, ¶93.) The ability to handle multiple requests would expand the capabilities and flexibilities of the chatbot-RPA bot without requiring much effort and with a reasonable expectation of success. (*Id.*, ¶94.)

- (v) **1[d]: “wherein the user interface of the computer program is configured to be displayed on a screen,”**

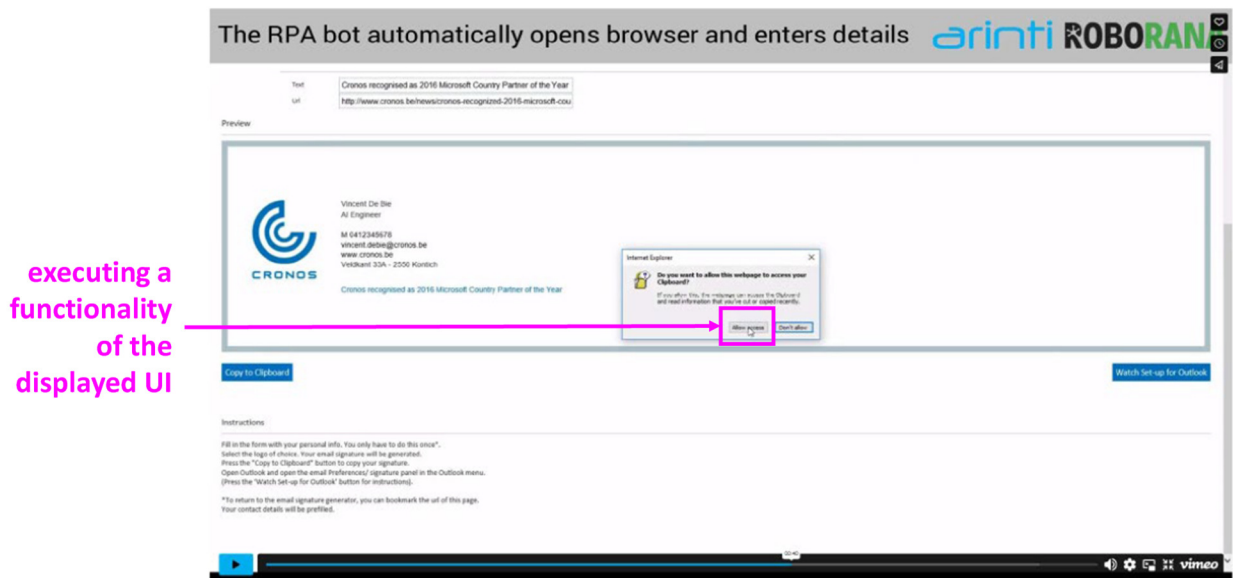
Symons’ UI of the computer program is displayed on a screen, here, a computer screen. (*See* element 1[c]; EX1003, ¶95.)

- (vi) **1[e]: “wherein each interaction of the sequence of interactions comprises an action selected from a group consisting of inputting data to the displayed user interface and executing a functionality of the displayed user interface; and”**

Symons’ “RPA bot automatically opens browser and enters details.” (EX1006, 11.) Each interaction of the RPA bot comprises inputting data to the displayed UI (annotated below): inputting “Vincent De Bie,” “AI Engineer,” “vincent.debie@cronos.be,” and “0412345678” in the name, job role, email, and phone input fields. (EX1006, 12; EX1003, ¶96.)



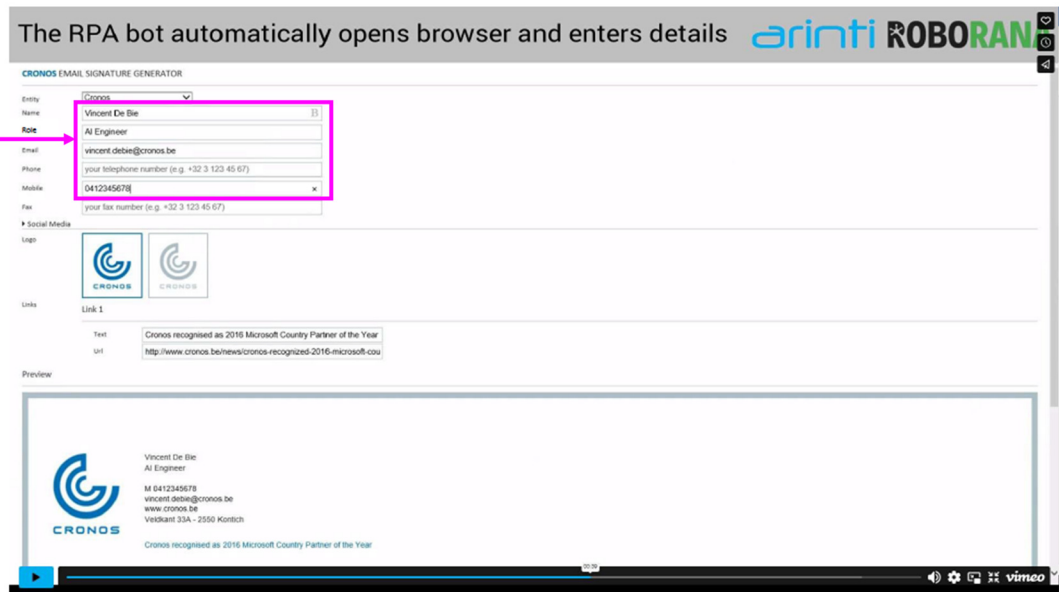
The sequence of interactions also includes executing a functionality of the displayed UI (annotated below): copying the email signature onto the clipboard by simulating GUI button clicks. (EX1006, 13; EX1003, ¶97.)

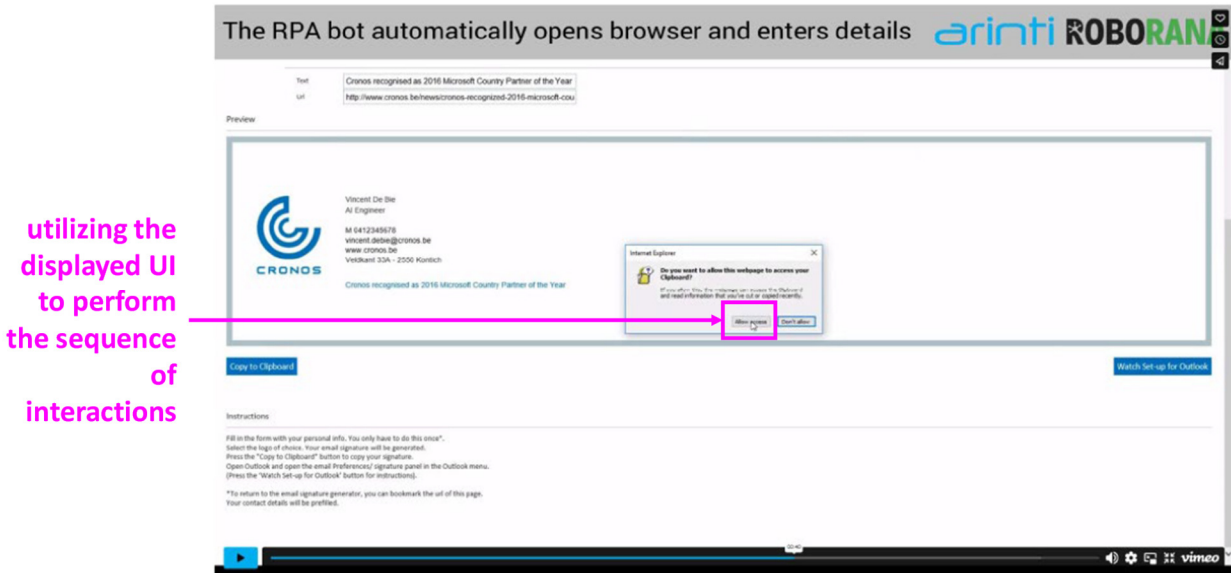


- (vii) 1[f]: “executing the automation process, wherein said executing comprises utilizing the displayed user interface of the computer program to perform the sequence of interactions.”

Symons’ “chatbot triggers the RPA bot,” which executes an “automate[d] [] process of creating an email signature.” (EX1006, 10, 12; EX1003, ¶¶98.) The executing comprises inputting data in data fields and clicking on GUI buttons, utilizing the displayed UI of the computer program to perform the sequence of interactions (annotated below). (EX1003, ¶¶98.)

utilizing the
displayed
UI to
perform
the
sequence
of
interactions





b. Claim 19

- (i) **Preamble: “A non-transitory computer readable medium retaining program instructions, which program instructions when read by a processor, cause the processor to perform:”**

To the extent the preamble is limiting (which Petitioner does not concede), Symons discloses the preamble.

Symons’ chatbot-RPA system is a computer program that executes an automated email signature process on a personal computer. (See claim 1; EX1003, ¶¶99.) A personal computer comprises a non-transitory computer readable medium retaining program instructions, which when read by a processor, cause the processor to perform steps. (EX1003, ¶¶99.)

(ii) Elements 19[a]-19[f]

Elements 19[a]-19[f] mirror elements 1[a]-1[f], which Symons discloses

alone, or in combination with Williams. (EX1003, ¶¶ 100-105.)

4. Summary of Ben-Itzhak

Ben-Itzhak published on August 31, 2017, qualifying as prior art to the '664 patent at least under § 102(a)(1). (EX1015.) The Examiner never found and Applicant never cited, Ben-Itzhak during prosecution.

Ben-Itzhak discloses an “interactive communication-based personalized content recommendation provisioning method and system” comprising a conversation agent that presents the user with personalized content recommendation. (EX1015, Abstract; EX1003, ¶106.) For example, the conversation agent provides the user with a Uniform Resource Locator (URL) link. (*Id.*) The user accesses and consumes the recommended content by interacting with the URL link. (*Id.*)

5. **Claim 10: “The method of claim 1 further comprises: generating a link, wherein the link is configured to cause said executing upon clicking thereon, wherein the natural language interface provides the link to the user.”**

Ben-Itzhak discloses an “interactive communication-based personalized content recommendation provisioning method and system.” (EX1034, Abstract.) “[T]he user may engage in a conversation . . . with the conversation agent,” which “present[s] [the user] with the personalized content recommendation.” (*Id.*, [0016], [0018], [0019]; EX1003, ¶107.)

The conversation agent provides “a Uniform Resource Locator (URL) link . . . to the user as a message or response to the one or more user messages in the active conversation. In this example, the user may interact with the provided URL link associated with the personalized content recommendation to access and consume the recommended content.” (EX1034, [0018]; EX1003, ¶¶108-109.)

It would have been obvious to combine Symons-Williams and Ben-Itzhak. Williams and Symons both disclose different platforms interfacing with each other. (EX1011, 2; EX1006, 11, 15, 21; EX1003, ¶110.) As explained, “RPA is the application of technology that allows computer software or a ‘robot’ to capture and interpret existing applications for processing a transaction, manipulating data, triggering responses and *communicating with other digital systems*.” (EX1011, 2 (emphasis added).) “[T]hese platforms are equally able to work through system’s

graphical interfaces including web browsers and Citrix terminal sessions.” (*Id.*)

A POSITA would be motivated to interface with a different platform without using an API—by generating and providing a link—because doing so leads to shorter times for deployment, lower upfront costs, and lower operational costs.

(*Id.*; EX1003, ¶¶110-111.) Williams explains that “RPA enlists software robots to perform complex, nested routines that cut across multiple applications and interact with these systems without the need to build complex and rigid system-to-system interfaces. Although robots can be configured to interface directly with applications through pre-existing application programming interfaces (APIs), these platforms are equally able to work through systems’ graphical interfaces, including web browsers and Citrix terminal sessions.” (EX1011, 2.) Williams recommends not relying on a dedicated API of the computer program because it is “an attractive way to drive operational cost reduction.” (EX1003, ¶111.) Without relying on a dedicated API, “robotic automation can be deployed in a relatively short period of time measured in days and weeks, instead of more heavy, traditional IT programming efforts that can take months and require a much larger upfront investment.” (EX1011, 2; EX1003, ¶111.)

- 6. Symons discloses the need to interface with a different platform. (EX1006, 11, 15, 21; EX1003, ¶110.) Symons’ chatbot-RPA system involves interfacing among multiple platforms, an email signature platform, Microsoft Word, and Microsoft Outlook. (*Id.*) Williams specifically identifies the motivation for interfacing with a different platform without utilizing an API. (EX1003, ¶111.) Ben-Itzhak provides a technique for interfacing with a different platform without utilizing an API. (EX1003, ¶111.) With Symons and Williams in hand, a POSITA would have looked to other prior art for a solution to interface with a different platform without utilizing an API, and would have found Ben-Itzhak. (*Id.*) Claim 24: “The non-transitory computer readable medium of claim 19, wherein the program instructions further cause the processor to generate a link, wherein the link is configured to cause said executing upon clicking thereon, wherein the natural language interface provides the link to the user.”**

Claim 24 mirrors claim 10, which Symons, Williams, and Ben-Itzhak render obvious. (EX1003, ¶112.)

B. Ground 2 – Allen and Ben-Itzhak Render Obvious Claims 10 and 24

1. Summary of Allen

Allen published on July 19, 2011, qualifying as prior art to the ’664 patent at least under § 102(a)(1). (EX1014.) The Examiner never found, and Applicant never cited, Allen during prosecution.

Allen discloses a system that allows a user to teach it how to perform complex, repetitive tasks that a user would perform using a GUI. (EX1014,

Abstract; EX1003, ¶¶113.) The user teaches the system the task steps by inputting natural language (displayed in speech interface display 20) and demonstrating actions with the browser display 12 and movable cursor of the GUI 10 (Fig. 1 (annotated below)). (EX1014, Abstract; EX1003, ¶¶114-115.) After the task has been taught, the user instructs the system to perform the task, and the system automatically executes it. (*Id.*)

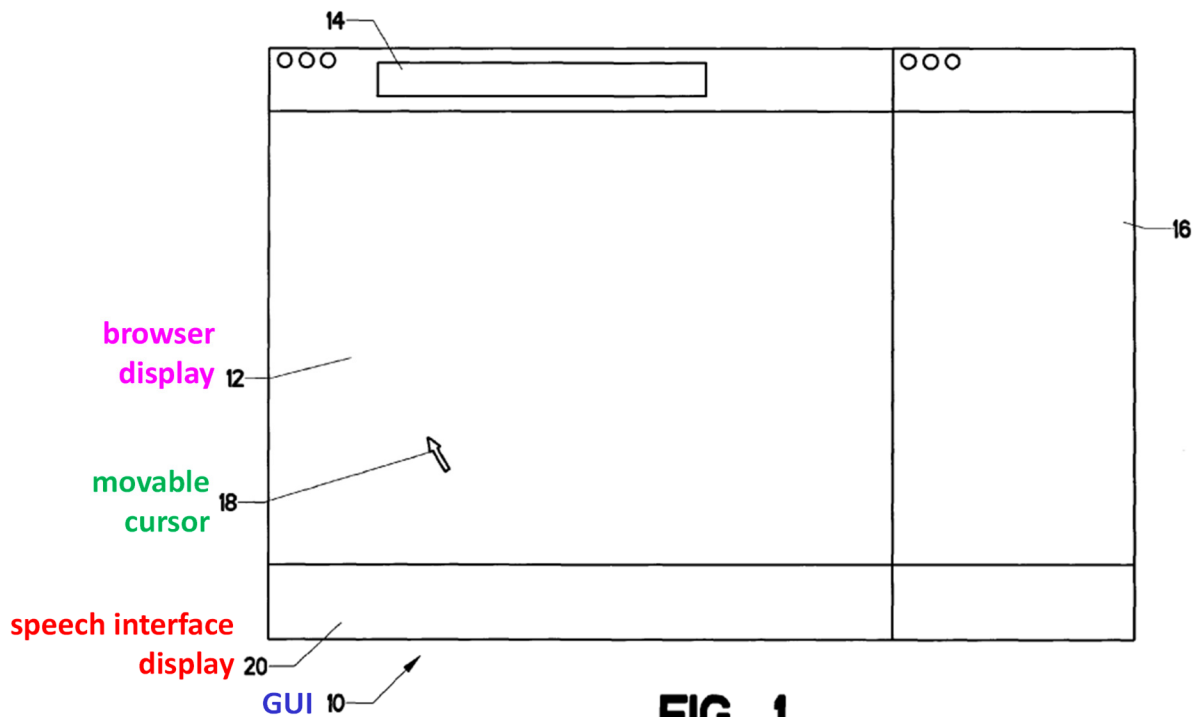


FIG. 1

2. Allen Renders Obvious Independent Claims 1 and 19

a. Claim 1

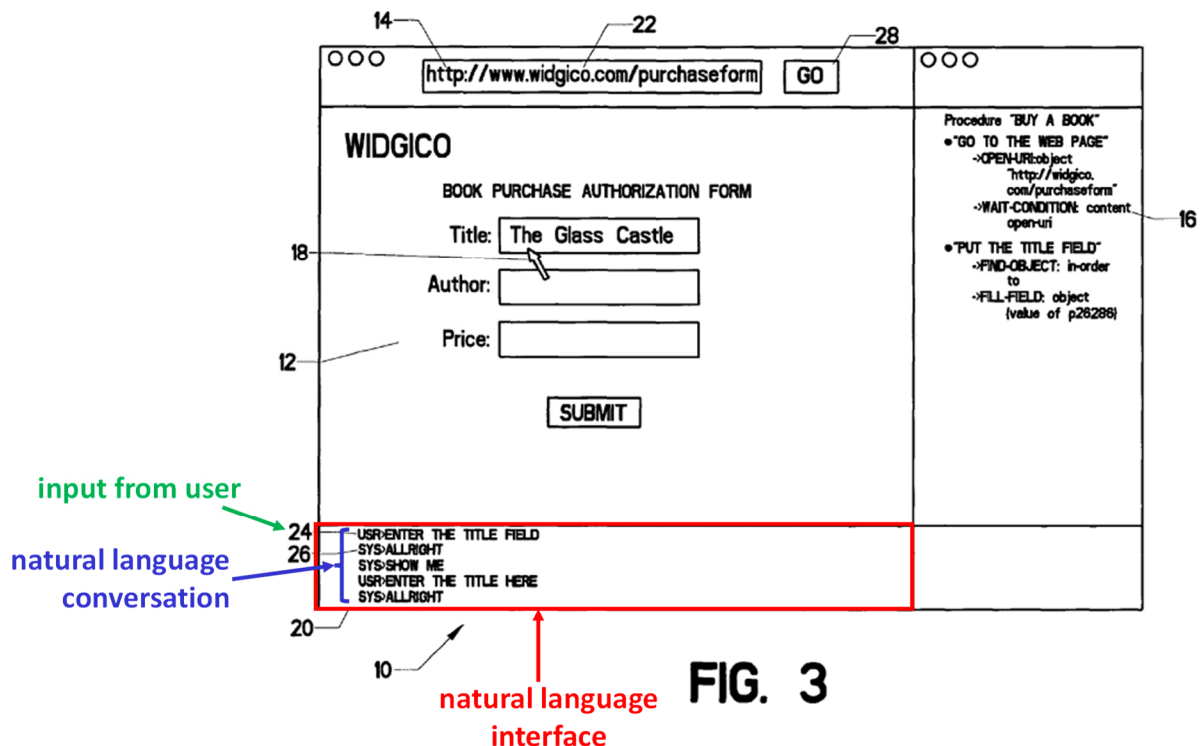
(i) Preamble: “A method comprising:”

Allen discloses an “interactive method for learning and executing executable tasks using [natural] language and demonstration inputs from a user.” (EX1014,

18:38-40; EX1003, ¶116.)

- (ii) 1[a]: “using a natural language interface, receiving input from a user as part of a natural language conversation between the natural language interface and the user,”

Allen’s “software includes a *natural dialog-based interface* whereby said *user can communicate with said software* using natural dialog-based language.” (EX1014, 18:47-49 (emphases added); EX1003, ¶117.) Fig. 3 (annotated below) shows the user’s speech 24 and the system’s speech 26 (shown in the speech interface display 20 (natural language interface)). (EX1003, ¶117.)



- (iii) **1[b]: “wherein the natural language conversation comprises a first natural language input from the user, a natural language feedback on the first natural language input from the natural language interface, and a second natural language input from the user in response to the natural language feedback:”**

In Allen, “[o]nce a task has been successfully taught to the system, a user can ask the system to perform that task. The system will then execute the steps it previously learned.” (EX1014, 3:44-46.) For example, the user says, “I want to buy a book” (first natural language input from the user). (EX1014, 12:64-66; EX1003, ¶118.) In response, the system asks, “What is the title of the book?” (natural language feedback on the first natural language input from the natural language interface). (*Id.*) In response, the user provides an answer (second natural language input from the user), namely the title of the book, to the system’s question (natural language feedback). (EX1003, ¶118.)

- (iv) **1[c]: “determining, based on the first and second natural language inputs from the user, an automation process configured to perform an automation of a sequence of interactions with a displayed user interface of a computer program and to simulate user interactions with the displayed user interface of the computer program,”**

In Allen, the first and second natural language inputs from the user comprise the user’s request to buy a book and its title. (*See* element 1[b]; EX1003, ¶119.)

Based on the request and title (first and second natural language inputs from the user), the system “then perform[s] the steps it was previously taught and complete[s] the transaction.” (EX1014, 12:66-13:1; EX1003, ¶120.) If the user instead requests a search for hotels, the system would perform a different automaton process. (EX1014, 16:33-40; EX1003, ¶121.)

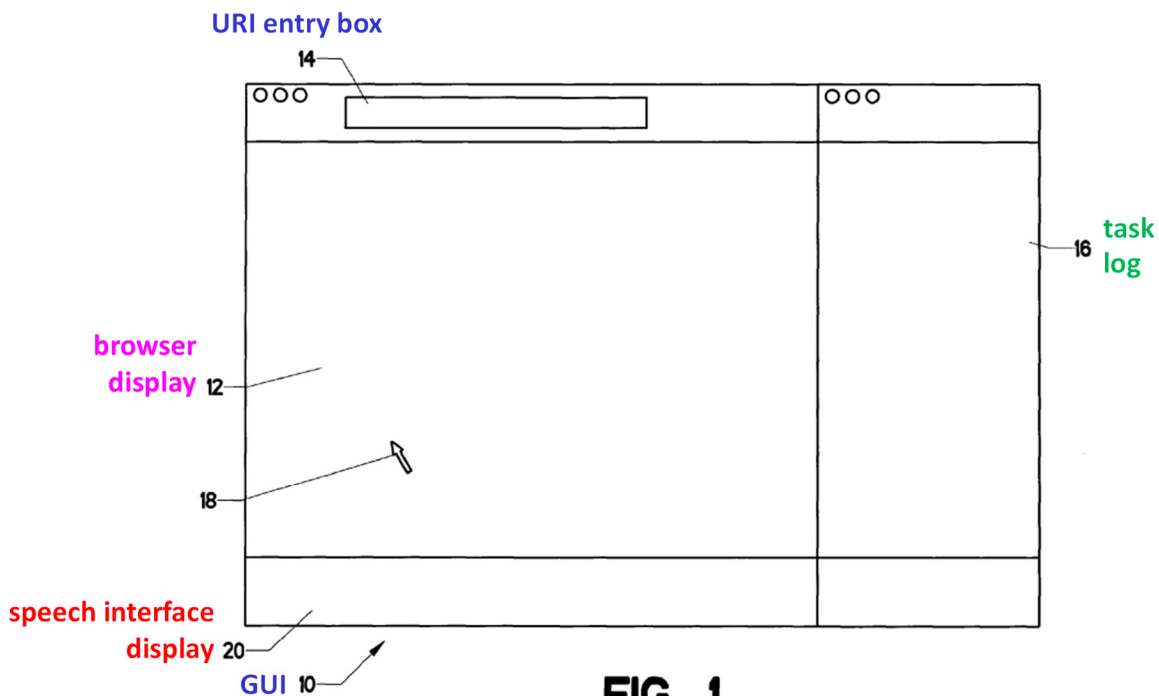
The automation process performs an automation of a sequence of interactions. (*Id.*, ¶122.) “For each step a user teaches the system, the system attempts to recognize the user’s intent. The system then learns to automatically execute steps by observing the user’s actions and analyzing the verbal instructions the user provides.” (EX1014, 6:61-65.)

The system learns how to execute the steps of the book buying automation process by observing a sequence of user interactions with a displayed UI of a computer program, such as inputting the title in the title entry box 30, navigating to an online vendor site, pulling down and selecting the “Books” category, picking and inputting data in the text entry box 58, actuating the “GO” button, opening a specific book page, identifying the book price, and entering the book price on the purchase form. (EX1014, 12:11-61; EX1003, ¶¶123-124.) Since the system learns how the user interacts with the displayed UI of the computer program, performing the steps it was previously taught means it simulates user interactions with the displayed UI. (EX1003, ¶¶125-126.)

To the extent that Allen does not disclose performing an automation of a sequence of interactions with a displayed UI and simulating user interactions with the displayed UI, it would have been obvious. Allen discloses “graphical user interface (‘GUI’) is preferably provided so that the *user can easily monitor [the system’s] actions.*” (EX1014, 4:66-5:1 (emphasis added).) It would have been obvious that in order for the user to easily monitor the system’s actions, the system’s actions would have to be displayed. (EX1003, ¶127.) As a result, the system’s actions (simulated user interactions) would be with a displayed UI. (*Id.*)

(v) **1[d]: “wherein the user interface of the computer program is configured to be displayed on a screen,”**

Allen’s system “us[es] the device’s graphical user interface” to both teach and automatically execute tasks (EX1014, Abstract; EX1003, ¶128.) Fig. 1 (annotated below) shows a GUI 10 comprising a web browser display 12, web page URI entry box 14, system task log 16, and speech interface display 20 (displays the conversation between the system and user). (EX1014, 5:6-20; EX1003, ¶128.) The device is the user’s computer, so the GUI is displayed on a screen. (EX1014, 4:64; EX1003, ¶128.)

**FIG. 1**

- (vi) 1[e]: “wherein each interaction of the sequence of interactions comprises an action selected from a group consisting of inputting data to the displayed user interface and executing a functionality of the displayed user interface; and”

Allen’s system is taught how to execute actions with a GUI, including clicking a GUI button using a mouse, moving a mouse cursor, pulling down a drop-down box, typing into an input field, and waiting for a web page to load. (EX1014, Abstract, 6:5-7, 6:10-11, 6:20-22, 7:43-45, 12:38-41, 12:45-46; EX1003, ¶129.) Each interaction comprises inputting data to the displayed UI or executing a functionality of the displayed UI. (EX1003, ¶129.)

- (vii) **1[f]: “executing the automation process, wherein said executing comprises utilizing the displayed user interface of the computer program to perform the sequence of interactions.”**

Allen discloses “[a]fter a complete task has been taught, the system is able to automatically execute the task,” where the “user ‘teaches’ task steps by inputting natural language and demonstrating actions with the GUI.” (EX1014, Abstract.) Since the system is taught to perform actions with the GUI for executing a task, its automatic execution of the task must comprise utilizing the displayed UI of the computer program to perform the sequence of interactions. (EX1003, ¶130.)

b. Claim 19

- (i) **Preamble: “A non-transitory computer readable medium retaining program instructions, which program instructions when read by a processor, cause the processor to perform:”**

Allen discloses “[t]he system includes software running on a user’s computation device.” (EX1014, Abstract.) The software comprises program instructions, and a computation device comprises a non-transitory computer readable medium retaining program instructions and a processor. (EX1003, ¶131.) The processor performs steps according to the program instructions when read by the processor. (*Id.*)

(ii) Elements 19[a]-19[f]

Elements 19[a]-19[f] mirror elements 1[a]-1[f], which Allen discloses or render obvious. (EX1003, ¶¶132-137.)

3. Claim 10: “The method of claim 1 further comprises: generating a link, wherein the link is configured to cause said executing upon clicking thereon, wherein the natural language interface provides the link to the user.”

As discussed in Section A.5, Ben-Itzhak discloses a conversation agent (natural language interface). (EX1003, ¶¶138-140.) “[T]he user may interact with the provided URL link associated with the personalized content recommendation to access and consume the recommended content.” (EX1034, [0018].)

It would have been obvious to combine Allen and Ben-Itzhak. Allen discloses “the system can [] function in a web-based environment in which information is transferred using HTML, XHTML, CSS, and/or scripts.” (EX1014, 3:26-31.) Ben-Itzhak similarly generates and provides a link for accessing and consuming associated content. (EX1034, [0018]; EX1003, ¶140.) Applying Ben-Itzhak’s teachings (generating and providing a link) to Allen’s system results in accessing content associated with webpages, such as amazon.com, mapquest.com. (EX1014, 2:48-49, 11:46-47.) Generating and providing a link is a way to transfer information in a web-based system, such as Allen’s system. (EX1003, ¶140.)

Allen's system collects information from the user, and then transfers the information collected from the chatbot to the automation process. Interacting with the link (as Ben-Itzhak teaches) helps the user consume content associated with the webpages. Consuming content in Allen corresponds to the computer interacting with the webpage (causing execution of the automation process). Allen discloses giving the user the ability to see that the user's uttered speech was understood correctly by the system: "[t]he language understanding module deciphers the spoken sounds and presents them as user speech 24 in speech interface display 20. . . . The system displays the message 'USR>I WILL TEACH YOU HOW TO BUY A BOOK.' The label 'USR>' indicates that this is the speech uttered by the user, as understood by the software. In this instance, *the user can see that the speech was understood correctly.*" (EX1014, 5:32-40 (emphasis added).) Allen discloses its system allowing the user to see whether the task was properly executed by the system. "Following receiving the initial statement from the user, [the system] PLOW creates a title for the new process it is about to learn and displays the title in task log 16. The task is presented in the text 'Procedure 'BUY A BOOK'.' The reader can thereby monitor whether PLOW has correctly understood the present objective. In the event of an error, corrective procedures are provided." (*Id.*, 5:56-61.) A POSITA would have been motivated with interaction of the link causing execution of the automation process because then

the user would be able to see whether the system understood the speech correctly and see whether the task was properly executed by the system (consistent with Allen’s objectives). (*Id.*, 5:24-40; EX1003, ¶140.) Without interaction of the link, the automation process may be executed without the user being able to see whether the system understood the speech correctly and/or whether the system executed the task properly. (EX1003, ¶140.)

- 4. Claim 24: “The non-transitory computer readable medium of claim 19, wherein the program instructions further cause the processor to generate a link, wherein the link is configured to cause said executing upon clicking thereon, wherein the natural language interface provides the link to the user.”**

Claim 24 mirrors claim 10, which Allen and Ben-Itzhak render obvious.

(EX1003, ¶141.)

VI. THE BOARD SHOULD NOT DENY INSTITUTION UNDER *FINTIV*

A. A Final Written Decision Will Issue Before Any Trial

A schedule has not yet been issued, and no trial date has been set, in the corresponding district court litigation. A Final Written Decision will issue in February 2025, whereas the trial date for the district court case (which has not been set) will likely be after.

B. Merits of the Petition Support Institution

As discussed above, the prior art teaches every element of the challenged claims, and are unpatentable. Thus, the merits of the petition weigh strongly in

favor of institution. *See* USPTO Interim Procedure for Discretionary Denials, 2 (“the PTAB will not rely on the *Fintiv* factors to discretionarily deny institution . . . where a petition presents compelling evidence of unpatentability.”).

C. Stipulation Not to Rely on the Petition’s Grounds in District Court

Petitioner agrees to stipulate that, if this IPR is instituted, Petitioner will not advance the grounds in this Petition in the district court litigation. *Sand Revolution II, LLC v. Cont’l Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 12 (PTAB June 16, 2020) (“Petitioner’s stipulation, however, mitigates to some degree the concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.”).

In sum, the *Fintiv* factors in the aggregate weigh against the Board exercising its discretion to deny institution.

VII. THE BOARD SHOULD NOT DENY INSTITUTION UNDER 35 U.S.C. § 325(D)

The Petition does not raise the same or substantially the same art previously presented to the Office, nor does the Petition raise the same or substantially the same arguments previously presented to the Office in the examination of the ’664 patent. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020). The Examiner identified five prior art references during prosecution as the closest art to the substance of the

independent claims. (EX1002, 208, 242, 243, 245, 283 285.) However, none of Petition’s prior art was characterized or discussed during prosecution. The Petition’s prior art teaches the limitations that Applicant needed to overcome the prosecution’s prior art, making up for the deficiencies, and thus are not cumulative. (EX1003, ¶¶37-38.) Thus, the Board should not deny institution under 325(d).

VIII. THE BOARD SHOULD NOT DENY INSTITUTION UNDER *GENERAL PLASTIC*

Although Petitioner filed an earlier petition for IPR of the ’664 Patent on August 30, 2023, in IPR2023-01368 (“First Petition”), Patent Owner has not yet responded, and no institution decision has issued. Moreover, there is no overlap in the challenged claims of the instant Petition and the First Petition. Indeed, the instant Petition presents patentability challenges for unique claims from the First Petition. These facts combined with the Board’s guidance in *General Plastic* and the July 2019 Trial Practice Guide Update support the Board declining to exercise its discretion and instead considering this Petition on the merits. *General Plastic Industrial Co., Ltd., v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential).

The *General Plastic* factors weight against using the Board’s discretion to deny this Petition. The seven factors adopted by *General Plastic* in exercising discretion to deny institution of an *inter partes* review under 35 U.S.C. § 314 are:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, Paper 19, 9-10; 16 (citations omitted).

The seven factors are considered for the purpose of preventing abusive practices by a petitioner in view of the limited resources of the Board, balanced against the usefulness of invalidating patents in view of the most relevant prior art. As set forth below, the application of the factors to the present circumstances demonstrates that the filing of the instant Petition is not abusive.

General Plastic Factor 1: Factor 1 weighs in favor of considering this Petition on the merits because, as stated above, Petitioner has not previously challenged the claims of the instant Petition (claims 10 and 24) in any prior petition.

General Plastic Factor 2: As part of the preparation of a Petition for the child '732 patent (IPR2023-01379), Petitioner continued to diligently discover prior art after filing the First Petition. This diligence is reflected in the instant Petition. Thus, at worst, factor 2 is a neutral factor.

General Plastic Factor 3: Factor 3 weighs heavily in favor of considering this Petition on the merits. This Petition is being filed approximately three weeks after the date the First Petition was filed and well before the date that the Patent Owner Preliminary Response is due in that IPR.

General Plastic Factor 4: As discussed in factor 2, Petitioner diligently searched for art while preparing a Petition for the child '732 patent and shortly after filing the First Petition. The Petition for the child '732 patent was filed on

Sept. 20, 2023, two days before the filing of the instant Petition. Thus, at worst, factor 4 is a neutral factor.

General Plastic Factor 5: Factor 5 weighs heavily in favor of considering this Petition on the merits. The instant Petition is being filed approximately three weeks after the date the First Petition was filed, and this Petition is not challenging the same claims as the First Petition. Petitioner filed a Petition for the child '732 patent two days before the filing of the instant Petition. In preparing the Petition for the child '732 patent, Petitioner discovered the prior art Ben-Itzhak which is reflected in the instant Petition.

General Plastic Factors 6 and 7: The sixth and seventh factors also weigh in favor of considering this Petition when consider the limited resources of the Board, balanced against the usefulness of invalidating patents in view of the relevant prior art. Here, this Petition presents unique grounds challenging claims that have not been previously considered by the Board in any post-grant review. Moreover, the First Petition and the instant Petition have been filed well before the one year bar date, and Petitioner does not expect timing to be an issue. Petitioner, however, would be amenable to the Board using its discretion to consolidate the instant Petition with the First Petition, which could help to preserve resources, create efficiency, and ensure that the final determination issues on time. Petitioner is willing to work with the Board and Patent Owner on a modified schedule to help

align the trials as necessary to achieve these goals.

IX. NOTICES AND STATEMENTS

Pursuant to 37 C.F.R. § 42.8(b)(1), Whatfix Inc. and Whatfix Private Limited are the real parties-in-interest for Petitioner.

Pursuant to 37 C.F.R. § 42.8(b)(2), Petitioner identifies the following related matters:

WalkMe Ltd., v. Whatfix Inc., No. 1:23-cv-00227-MN (D. Del.);

Whatfix Inc. v. WalkMe Ltd., IPR2023-01379 (P.T.A.B. September 20, 2023);

Whatfix Inc. v. WalkMe Ltd., IPR2023-01368 (P.T.A.B. August 30, 2023).

Pursuant to 37 C.F.R. § 42.8(b)(3), Petitioner identifies the following counsel (and a power of attorney accompanies this Petition).

Lead Counsel	First Backup Counsel
Alex S. Yap Registration No.: 60,609 MORRISON & FOERSTER LLP 707 Wilshire Boulevard Suite 6000 Los Angeles CA 90017-3543 Tel: (213) 892-5688 Fax: (213) 892-5454 Email: AYap@mofo.com	Mehran Arjomand Registration No.: 48,231 MORRISON & FOERSTER LLP 707 Wilshire Boulevard Suite 6000 Los Angeles CA 90017-3543 Tel: (213) 892-5630 Fax: (213) 892-5454 Email: MArjomand@mofo.com Jean Nguyen Registration No.: 71,051 MORRISON & FOERSTER LLP 707 Wilshire Boulevard Suite 6000 Los Angeles CA 90017-3543

Lead Counsel	First Backup Counsel
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Pursuant to 37 C.F.R. § 42.8(b)(4), service information for lead and back-up counsel is provided above. Petitioner consents to electronic service by email to Whatfix-Walkme-IPR@mofo.com.

Pursuant to 37 C.F.R. § 42.104(a), Petitioners certify that the '664 patent is available for *inter partes* review and that Petitioners are not barred or estopped from requesting an *inter partes* review challenging the patent claims on the grounds identified in this Petition.

The USPTO is authorized to charge any required fees, including the fee as set forth in 37 C.F.R. § 42.15(a) and any excess claim fees, to Deposit Account No. **03-1952** referencing Docket No. **28132-00000.06**.

IPR2023-01443

Dated: September 22, 2023

Respectfully submitted,

By: /s/ Alex S. Yap
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Certification of Word Count (37 C.F.R. § 42.24)

I hereby certify that this Petition for *Inter Partes* Review has 7,114 words (as counted by the “Word Count” feature of the Microsoft Word™ word-processing system), exclusive of “a table of contents, a table of authorities, mandatory notices under § 42.8, a certificate of service or word count, or appendix of exhibits or claim listing.”

Dated: September 22, 2023

By: /s/ Alex S. Yap

Alex S. Yap

Certificate of Service (37 C.F.R. § 42.6(e)(4) and 42.205(a))

I hereby certify that the attached Petition for *Inter Partes* Review and supporting materials were served as of the below date by UPS, which is a means at least as fast and reliable as U.S. Express Mail, on the Patent Owner at the correspondence address indicated for U.S. Patent No. 10,819,664:

Mark Koffsky
Gary Serbin
Koffsky Schwalb LLC
Customer Number: 106928
500 Seventh Avenue
8th Floor
New York, NY 10018

Dated: September 22, 2023

/s/ Alex S. Yap
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