

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLE INC.,  
Petitioner,

v.

RALLY AG LLC,  
Patent Owner.

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IPR2024-01446  
Patent 11,361,107 B2

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Before GREGG I. ANDERSON, ARTHUR M. PESLAK, and  
ANDREW L. NALVEN, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314

## I. INTRODUCTION

Apple Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–19 (“the challenged claims”) of U.S. Patent No. 11,361,107 B2 (Ex. 1001, “the ’107 patent”). Petitioner also filed a Declaration of Loren Terveen (Ex. 1003, “Teervan Declaration”) with the Petition. Rally AG LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Petitioner filed a Preliminary Reply to Patent Owner’s Preliminary Response. Paper 7 (“Pet. Prelim. Reply”). Patent Owner filed a Preliminary Sur-Reply to Petitioner’s Preliminary Reply. Paper 8 (“PO Prelim. Sur-Reply”).

We have authority to determine whether to institute an *inter partes* review. *See* 35 U.S.C. § 314 (2024); 37 C.F.R. § 42.4(a) (2023). Under 35 U.S.C. § 314(a), we may not authorize an *inter partes* review unless the information in the petition and the preliminary response “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

Upon consideration of the Petition, the Preliminary Response, Preliminary Reply, Preliminary Sur-Reply, and the evidence of record, for the reasons given below, we determine there is not a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of at least one challenged claim of the ’107 patent.

Accordingly, we do not institute an *inter partes* review of the ’107 patent.

## II. BACKGROUND

### *A. Related Proceedings*

The parties identify the following related district court cases involving the '107 patent: *Rally AG LLC v. Apple Inc.*, No. 1-23-cv-01106 (D. Del.) Del.) (“District Court Lawsuit”). Pet. 72; Paper 5 (“Patent Owner’s Mandatory Notices Under 37 C.F.R. § 42.8(a)(2)”).

### *B. Real Parties-in-Interest*

Petitioner identifies itself as the real party-in-interest. Pet. 72. Patent Owner identifies itself as the real party-in-interest. Paper 5.

### *C. The '107 Patent*

The '107 patent was filed on May 1, 2020, as U.S. Patent Application No. 16/865,053 (“the '053 application”). Ex. 1001, codes (21), (22). The '053 application incorporates by reference and claims priority to Provisional Application Nos. 62/841,726, filed May 1, 2019 and 62/850,459, filed May 20, 2019. *Id.* at 1:6–11.<sup>1</sup>

### *1. Technical Background*

The '107 patent relates to preserving the privacy of consumers in placing transactions over the Internet. Ex. 1001, 2:59–61. Specifically, the '107 patent is directed to protecting the disclosure of consumer personal information including email, name and phone number. *Id.* at 2:61–65.

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<sup>1</sup> Thirteen other provisional applications and twenty-seven pending applications are also incorporated by reference. Ex. 1001, 1:13–2:52.

## 2. *The Cloaking System of the '107 Patent*

The '107 patent solves the problem of protecting consumer private information by providing tools that enable an end user or consumer's device to communicate via email with others such as "relying-parties," i.e., merchants,<sup>2</sup> without revealing information to the merchant. Ex. 1001, Abs. The private information includes "email address, name or any other information she desires to keep confidential while still being able to have commercially useful transactions with the relying parties and others." *Id.*

The '107 patent describes an ID cloaking system that "serves as an intermediary between the end user's email system and the relying-party's email system." Ex. 1001, 4:5–8. The ID cloaking system provides consumers with a cloaked email address they can provide to a merchant. *Id.* at 6:8–14.

Cloaking and decloaking may be initiated: "1) by operation of a webform initiation and 2) by operation of sending an initial email to the relying party 'end user email initiation'." Ex. 1001, 6:11–14. The webform "routes information from the ID cloaking system to the relying party as opposed to the end user sending an initial email to the relying party." *Id.* at 6:25–29.

Figure 4 of the '107 patent is reproduced below.

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<sup>2</sup> We agree with Petitioner that the '107 patent describes an "end user" as a "consumer" and a "relying-party" as a "merchant" and, for purposes of this Decision, those terms are used interchangeably. *See* Pet. 1 n.1.

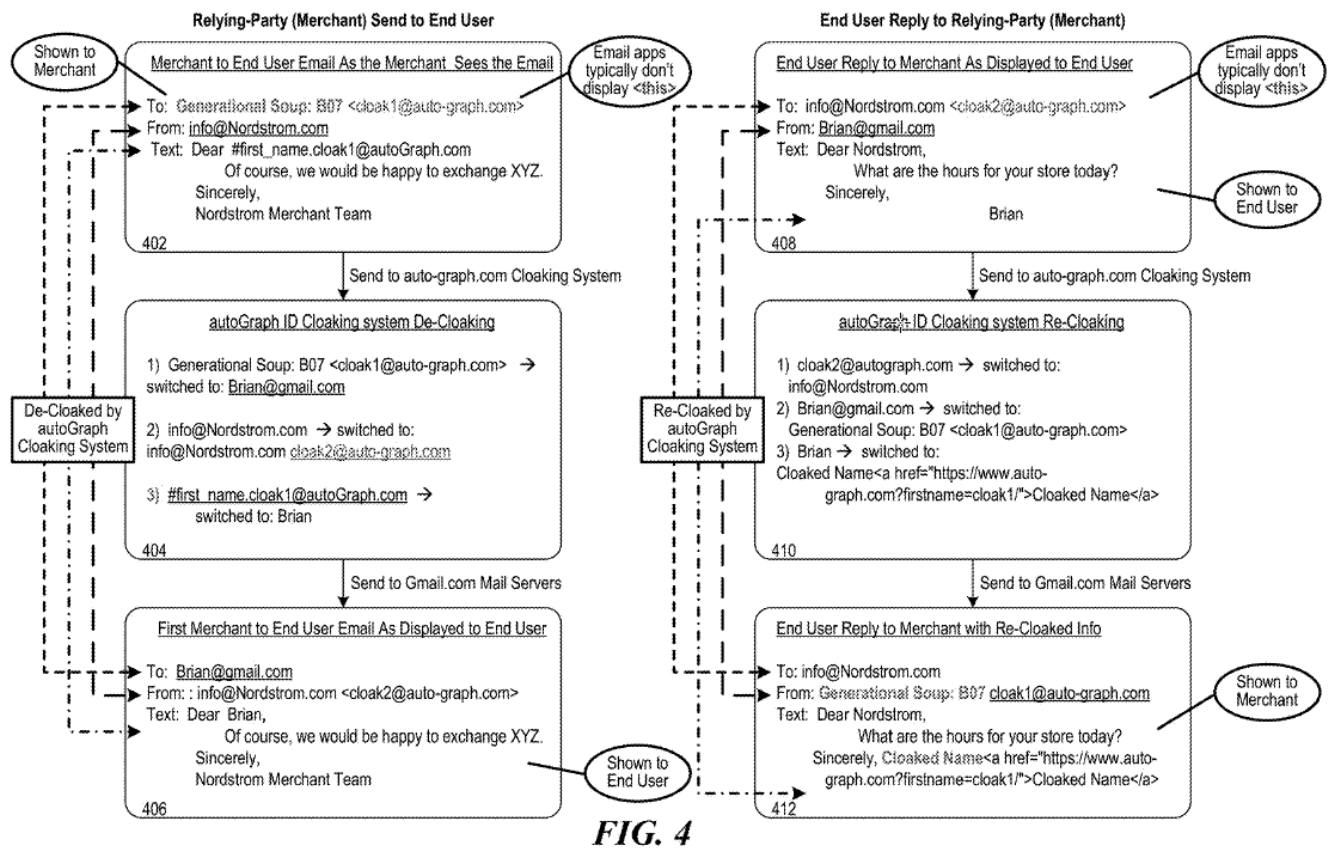


**Figure 4 illustrates an exemplary embodiment of email communication between a relying-party who received information from a webform and an end user who filled out the webform.**

Ex. 1001, 3:12–15, 9:64–66. As depicted in Figure 4, the end user chose to “‘cloak’ his first name, last name and email address while filing out a webform at the Nordstroms.com™ URL to return an item ‘XYZ’ (such as a shirt or hat).” *Id.* at 10:4–7. At 404, the “ID cloaking system, replaces the cloaked information that was previously submitted to the relying party with the associated end user’s confidential information and any other desired information such as any information in his profile.” *Id.* at 11:5–8.

In 406, the email arrives for display to the end user. Then this email arrives the end user's private information has been de-cloaked by the ID cloaking system and augmented with the second cloaked address (cloak.2@auto-graph.com) associated

to the relying party sender for use when responding to the relying-party . . .

Ex. 1001, 12:6–11.

“Once the end user sends the email in 408, the email is routed to the ID cloaking system.” Ex. 1001, 12:52–54. The ID cloaking systems “aid in changing/swapping the end user's email address back to the cloaked address.” *Id.* at 12:55–57. “Thus, the re-cloaking from 408 to 410 thus uses the ID cloaking system as a facilitator for this process. The tools disclosed do not require any expensive or tedious changes to the end user or relying-party's computing device.” *Id.* at 13:7–11.

#### *D. Illustrative Claim*

The Petition challenges claims 1–19, of which independent claim 1 is directed to a system and independent claims 7 and 13 are directed to a non-transitory computer readable medium. Ex. 1001, 29:41 (claim 1), 30:27 (claim 7), 31:8 (claim 13). Claims 2–6, 8–12, and 14–19 depend variously and ultimately from one of independent claims 1, 7, or 13. *Id.* at 3:8–26 (claims 2–6), 31:27–31:7 (claims 8–12), 32:5–29 (claims 14–19). Claim 13 is illustrative of the claimed subject matter and reproduced below:

[13(P)]<sup>3</sup> A non- transitory computer readable medium for a ID cloaking system having instructions stored thereon that are executable by processor electronics to:

[13(a)] receive an email addressed to a cloaked end user address, wherein the email is sent from a relying party email

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<sup>3</sup> Paragraph labeling in brackets is based on Petitioner's format identifying the claim elements. *See* Pet. 13–35 (showing for claim 13). Patent Owner follows this format. *See* Prelim. Resp. 34 (limitation 13(a)). We adopt the same format for purposes of this Decision.

address, and wherein the domain of the cloaked end user address and the domain associated to the cloaked end user address associated to the cloaked ID system are the same domain;

[13(b)] identify an end user specified address associated to the cloaked end user address by an end user profile;

[13(c)] determine whether *the end user profile contains a previous association between the relying party address and a cloaked relying party email address*, wherein the relying party address has a different domain than the cloaked relying party email address;

[13(d)] where the end user profile *does not contain a previous association between the relying party address and the cloaked relying party email address*, then generate a new cloaked relying party email address and associate the new cloaked relying party email address to the end user profile, the cloaked end user address, wherein the new cloaked relying party email address is generated with a domain different than the relying party address; and

[13(e)] *send the email to the identified end user specified address, wherein the email is configured with a reply-to email address comprising the new cloaked relying party email address.*

Ex. 1001, 31:8–32:4 (emphasis added for disputed limitations).

### *E. References and Other Evidence*

Petitioner relies on the following references along with the Teerven Declaration:

Lee, et al., US Pat. No. 8,458,264 B1, issued June 4, 2013 (Ex. 1004, “Lee”);

Hardt, US Pat. No. 7,783,741 B2, issued August 24, 2010 (Ex. 1005, “Hardt”); and

Le Jouan, US 2016/0323229 A1, published November 3, 2016 (Ex. 1006, “Le Jouan”).

*F. Asserted Grounds of Unpatentability*

Petitioner asserts the challenged claims are unpatentable on the following grounds:

| <b>Grounds</b> | <b>Claims Challenged</b> | <b>35 U.S.C. §<sup>4</sup></b> | <b>References/Basis</b>                  |
|----------------|--------------------------|--------------------------------|------------------------------------------|
| 1              | 13, 14                   | 103                            | Lee, Person of Ordinary Skill in the Art |
| 2              | 1, 2, 7, 8, 19           | 103                            | Lee, Hardt                               |
| 3              | 15–18                    | 103                            | Lee, Le Jouan                            |
| 4              | 3–6, 9–12                | 103                            | Lee, Hardt, Le Jouan                     |

Pet. 19.

*G. Overview of the Prior Art*

*1. Lee (Ex. 1004)*

Lee describes an “email proxy server that receives a registration request from a client having a private email address.” Ex. 1004, Abs. “The proxy server generates a public email address and associates the public

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<sup>4</sup> Because the earliest application from which the ’107 patent claims priority was filed before March 16, 2013, and neither party argues that the America Invents Act applies, the pre-AIA version of § 103 applies. Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011). Applying the AIA version of the statute would not alter our analysis.

email address with the private email address.” *Id.* The function of the proxy server “is to conceal the recipient 206 private email address and to receive, but not forward, any email from a sender such as 202 which does not contain the registered public email address for this sender.” *Id.* at 4:48–51.

Figure 5 is reproduced below.

**Figure 5**  
Data Structures

502     Record for Key1 (Uniquely derived from incoming public1@flt.dom)  
STATE = one of {WAIT, ESTABLISH}     -:-  
ALLOW\_FROM = from@snd.com  
XLATE\_FROM = new\_from@flt.dom  
XLATE\_TO = private1@rcv.dom

504     Record for Key2 (Uniquely derived from incoming new\_from@snd.dom)  
XLATE\_TO = from@snd.dom  
XLATE\_FROM = to@flt.dom

**Figure 5 shows data structures for an embodiment.**

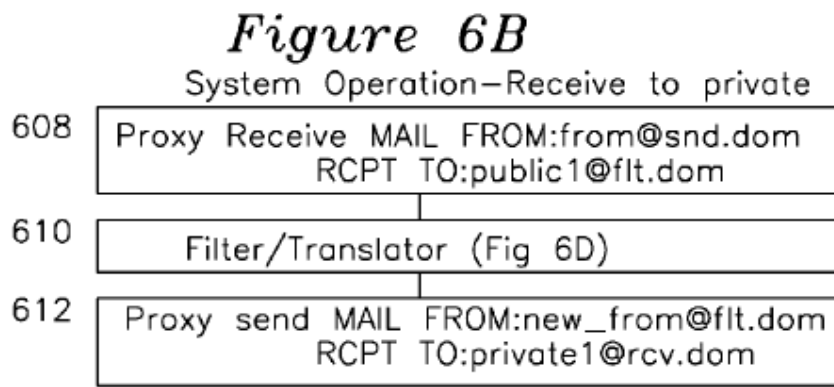
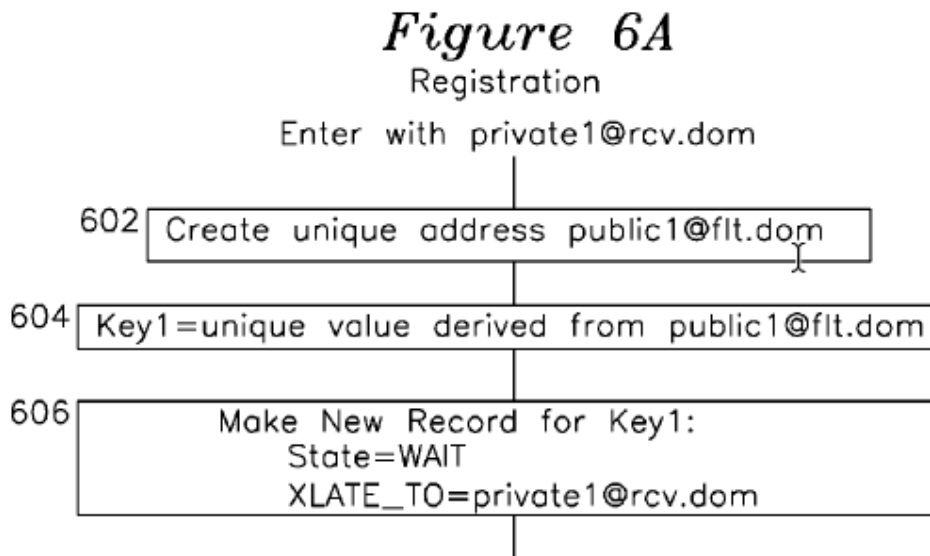
Ex. 1004, 6:9–10. As discussed in connection with Figure 6A below, upon registration of a user private email address a data structure is generated and stored in a record addressable “using a first key, which may be generated from the public email address associated with the record.” *Id.* at 6:13–14. “Each public email address must be unique so that the resolution of public email address to a record having a XLATE TO field may be unambiguously performed.” *Id.* at 6:14–17. “Each record associated with the first key has a STATE field which is settable, and ALLOW FROM field indicating which sender is allowed for this public email address, XLATE FROM and XLATE\_TO fields which are used to translate new message sender and

recipient, respectively.” *Id.* at 6:17–22. Usable STATE values are WAIT, indicating the public address has not been used and “ESTABLISH, which means a message has been received, and all fields in the record are complete.” *Id.* at 6:25–26. A second key Key2 includes values XLATE TO and XLATE FROM which are used for reply messages. *Id.* at 6:23–29.

A first record indexed from the first key contains all the address translations required for sending messages from a sender to a private email address, and a second record allows for replies from the private email to be translated back to addresses which correspond to the original sender.

Ex. 1004, 7:19–26. The “second record which is indexed by a second key derived from the XLATE FROM field of the first record allows for replies from the private email to be translated back to addresses which correspond to the original sender.” *Id.* at 7:23–26.

Figures 6A and 6B are reproduced below.



**Figures 6A and 6B are flowcharts respectively for a user registration and for a sender sending a message to a recipient.**

Ex. 1004, 6:33–37, 6:47–48. In Figure 6A at 602, a user with “a private email address such as ‘private1@rcv.dom’ requests a public email address, which is uniquely generated 602 and assigned in the example as ‘public1@flt.dom.’” *Id.* at 6:34–37. In Figure 6B at 610, an email to the public address is received which is either rejected or sent at 612 “using the translated values.” *Id.* at 6:52.

Figure 6D is reproduced below.

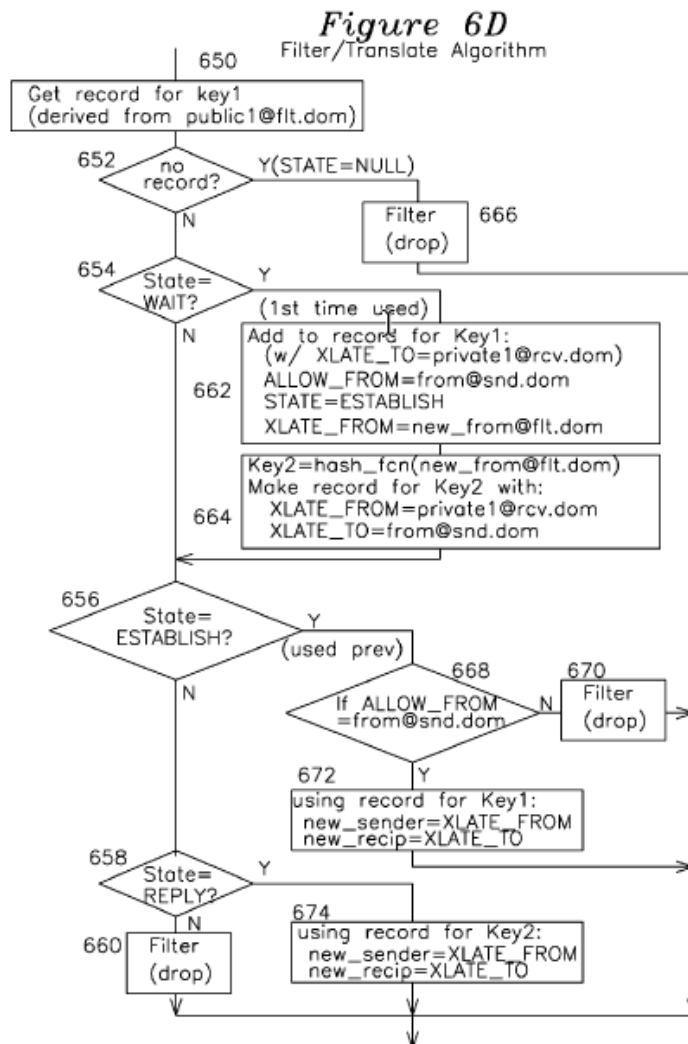


**Figure 6D shows the operation of the filter and translator.**

Ex. 1004, 6:60–61. “The filter and translator is entered with a public email address, such as ‘public1@flt.dom’ and a sender email address, such as ‘from@snd.com’, and a key is generated from the public email address value.” *Id.* at 6:61–64. “[A] first record which is indexed by a first key derived from the public email address contains all the address translations required for sending messages from a sender to a private email address.”

*Id.* at 7:19–22. “[A] second key derived from the XLATE FROM field of the first record allows for replies from the private email to be translated back to addresses which correspond to the original sender.” *Id.* at 7:23–26.

If the message is a reply message originating from a private address known to the system, the second key is formed from the unique sender address as known to the private recipient, which in the present example would be new [from@flt.dom](#). The second key record associated with new [from@flt.dom](#), such as 504 of FIG. 5, provides the translated sender and recipient addresses in step 674, which contain values initialized in previously executed step 664. The storage of values with associated first and second key may be done using either a database with database records, or they may be stored in a lookup memory such as any random access memory (RAM), a disk file, or in any manner known for maintaining records.

Ex. 1004, 7:36–47.

## 2. *Hardt (Ex. 1005)*

Hardt is directed to a “system and method of automated pseudonymous email address creation and management.” Ex. 1005, Abs. Hardt creates aliases “for web pages, mailing lists, untrusted recipients and online forms” and “creat[es] rules that determine the routing associated with the alias.” *Id.* at 8:32–36.

User aliases are generated by applications which provide users “the ability to automatically submit information to web based forms.” Ex. 1005, 19:60–65. “[T]he form filling application, be it a web browser add on or a part of an identity management system, includes a component to request an alias from alias generator 100 and provide the generated alias to the web based form.” *Id.* at 20:1–4. When an alias is generated pursuant to the

webform embodiment, the “form filler provides the URL of the form in which the information will be entered, so that the alias generator 100 can store the information to later determine if privacy policies have been breached.” *Id.* at 20:6–9. “[A]lias generator 100 obtains, either directly from the plug-in, or from the website privacy policy, a set of email addresses that mail will be received from, so that any message received from another address can be discarded.” *Id.* at 15:2–6.

### 3. *Le Jouan (Ex. 1006)*

Le Jouan is directed to “[p]rotecting personal information by generating entity-specific aliases for use in communications with third parties.” Ex. 1006, Abs. Le Jouan discloses an alias-aware email server system.

[A]n alias email address is used instead of a personal email address to register or update a profile on a site, and if the site sells or provides such information to another company that uses the email alias to contact the user (perhaps without having received authorization), the user can learn of this event using the alias-aware email server system 500.

*Id.* ¶ 136, Fig. 5.

The email server system contains an email personalization engine and an email server. Ex. 1006 ¶ 144. “When a user sends an email to a third party, the email personalization engine 514 can remove sensitive information, replace the sensitive information with dummy values or aliases, or the like.” *Id.* ¶ 144. Le Jouan specifies sensitive information “is intended to mean personal information that is useful for contacting or identifying the user outside of the system [], such as an email address, a physical address, a phone number, or the like.” *Id.* ¶ 77. This email

personalization engine also performs standard email alias functionalities, including replacing “the user’s email alias . . . with the user’s actual email address” when a third party sends an email to the user. *Id.* ¶ 145.

### III. ANALYSIS OF THE CHALLENGED CLAIMS

#### *A. Level of Ordinary Skill in the Art*

Petitioner alleges a person of ordinary skill in the art would have had a bachelor’s degree in computer science, electrical engineering, computer engineering or equivalent from an accredited academic program with at least two years of work experience with electronic communications. A [person of ordinary skill in the art] would have had an understanding of the privacy concerns relevant to electronic communications. Additional education or experience might substitute for the above requirements.

Pet. 7 (citing Ex. 1003 ¶ 24). Patent Owner does not comment on Petitioner’s proposal nor does it propose a level of ordinary skill. Prelim. Resp. 25.

At this stage, the level of ordinary skill is not at issue. Petitioner’s undisputed definition is supported by the testimony of its experts and is consistent with the ’107 patent and the asserted prior art. Accordingly, for purposes of this Decision, we apply Petitioner’s articulation.

#### *B. Claim Construction*

We interpret claim terms using “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b). In this context, claim terms “are generally given their ordinary and customary meaning,” as would have been understood by a person of ordinary skill in the art in question at the time of

the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc) (citations omitted). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Extrinsic evidence is “less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’” *Phillips*, 415 F.3d at 1317 (citations omitted).

Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

We construe only those claim terms that require analysis to determine whether to institute an *inter partes* review. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

Neither party proposes any term for express claim construction. Pet. 20; Prelim. Resp. 24. We determine that no express construction of any claim term is necessary for purposes of this Decision.

### *C. Obviousness*

A claim is unpatentable as obvious under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

the claimed invention pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called “secondary considerations,” including commercial success, long-felt but unsolved needs, failure of others, and unexpected results. *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966). At this stage, neither party has presented any evidence on the fourth *Graham* factor.

*D. Claims 13 and 14 as Obvious over Lee and Knowledge of Person of Ordinary Skill in the Art (Ground 1)*

Petitioner provides a limitation-by-limitation analysis as to how claims 13 and 14 would have been obvious over Lee and the knowledge of a person of ordinary skill in the art. Pet. 19–35. Petitioner relies on the Terveen Declaration. Ex. 1003 ¶¶ 59– 86.

*1. Claim 13*

Patent Owner disputes Petitioner’s showing as to limitations 13(c), 13(d), and 13(e). PO Resp. 33–45. We determine Petitioner has not sufficiently shown that limitation 13(e) is taught or suggested by Lee. Accordingly, we analyze only limitation 13(e).

Limitation 13(e), recites

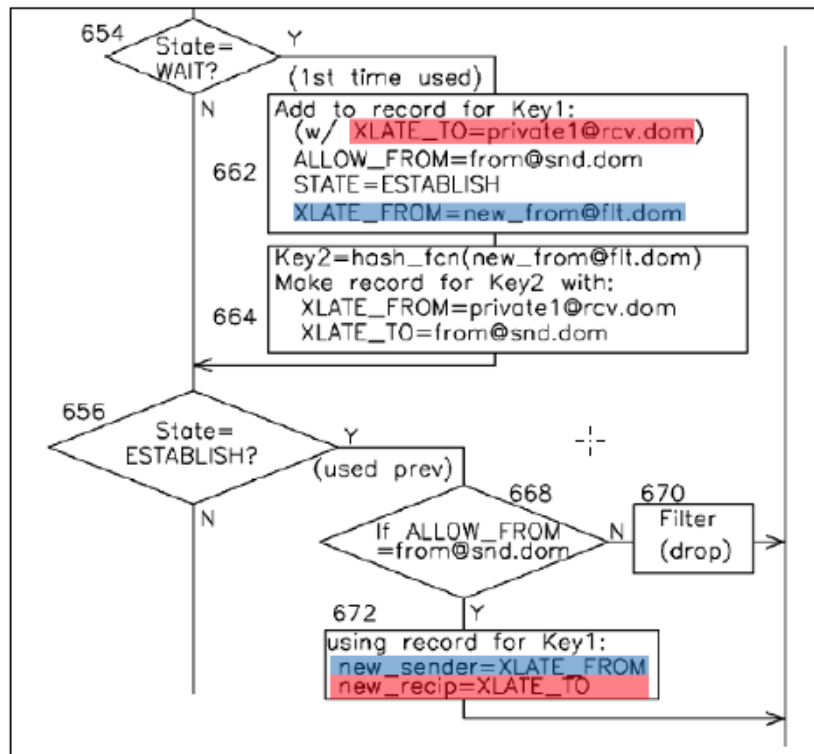
send the email to the identified end user specified address, wherein the email is configured with a *reply-to email address* comprising the new cloaked relying party email address.

Ex. 1001, 32:1–4 (emphasis added).

*Petitioner's Showing for Limitation 13(e)*

Petitioner argues “Lee teaches sending the ‘email in step 612 using the translated values.’” Pet. 31 (citing Ex. 1004, 6:51–52, Fig. 6B).

Petitioner’s annotation of Lee’s Figure 6D is reproduced below.



**Annotated Figure 6D.**

*Id.* at 32; *see also* Section II.G.1 above (Lee Fig. 6D). Petitioner explains its annotation by quoting Lee’s description that “[T]ranslation fields XLATE\_FROM and XLATE\_TO associated with the received public address (first key) are extracted from the associated record, and these fields are used for the new\_sender and new\_recipient address translations, respectively.” Pet. 32 (quoting Ex. 1004, 7:31–35). Petitioner concludes that “the sender’s alias, new\_from@flt.dom, populates the ‘From’ address of the email sent by the email proxy server to the end user.” *Id.*

Petitioner acknowledges that “Lee does not expressly discuss distinct ‘from’ and ‘reply-to’ fields, but it does expressly teach that, when an end user responds to an email received pursuant to the embodiment described above, the responsive email will be addressed to the sender’s alias address.” Pet. 33–34 (citing Ex. 1004, Figs. 6B and 6C). Petitioner argues

Namely, Fig. 6B shows that the sender’s alias (new\_from@flt.dom) populates the ‘from’ field in a translated email sent to the user’s private email address (private1@rcv.dom). And Fig. 6C shows that the user’s responsive email is addressed to the same sender’s alias ([new\\_from@flt.dom](#)).

*Id.* at 34. Relying on the Terveen Declaration, Petitioner argues a person of ordinary skill in the art “would have understood that it would have been obvious to populate a ‘reply-to’ field with the sender’s alias.” *Id.* (citing Ex. 1003 ¶ 85 (“Lee’s described functionality accomplishes the same result as populating a ‘reply-to’ field with the sender’s alias”)). *Id.* at 34–35.

Petitioner’s Preliminary Reply addresses limitation 13(e), arguing the “anonymity goal of the ‘reply-to’ limitation.” Pet. Prelim. Reply 2. Petitioner argues this anonymity goal was shown in the Petition because the Terveen Declaration establishes that the “‘reply-to’ and ‘from’ fields are ‘functionally identical’ in this context, so it would have been obvious to populate the ‘reply-to’ field, as claimed.” *Id.* at 2–3 (citing Pet. 31–35; Ex. 1003 ¶¶ 82–85). Petitioner also argues “the ’107 Patent itself teaches using identical ‘from’ and ‘reply-to’ addresses, ensuring responsive communications are routed through the alias server.” *Id.* at 3 (citing Ex. 1003 ¶ 83 (citing Ex. 1001, 17:62–67)). Thus, Petitioner’s Preliminary Reply argues limitation 13(e) is shown because in Lee the “from” and

“reply-to” fields are populated with “the same sender alias, ‘ensur[ing] that any replies . . . get routed back through the [alias server].” *Id.* (quoting Ex. 1001, 17:62–67).

*Patent Owner’s Argument Limitation 13(e)*

Patent Owner argues that Petitioner admits that the “Lee disclosure fails to meet Limitation 13(e)’s requirement that ‘the email is configured with a reply-to email address comprising the new cloaked relying party email address.’” PO Resp. 41. Patent Owner argues limitation 13(e) addresses “the need for increasing data privacy while minimizing effects on the user’s email experience.” *Id.* at 42. Further, Patent Owner argues the “‘reply-to email address comprising the new cloaked relying party email address’ facilitates the functionality of the ID cloaking system with limited effects on user experience.” *Id.* Patent Owner also argues the showing made by Petitioner is conclusory and lacks any reason for combining the knowledge of a person of ordinary skill in the art with Lee. *Id.*

Patent Owner points to the ’107 patent description that “[t]he email is then sent to the end user’s real email address by end user email system 104, with the ‘from’/reply-to address of info@nordstroms.com <cloak2@autograph.me>[.]” PO Resp. 43 (quoting Ex. 1001, 17:21–24). In contrast to the claimed invention, Patent Owner argues Lee’s XLATE\_FROM field does not indicate the originating party of the email received by the user. PO Resp. 43–43 (citing Ex. 1004, Fig. 6B at 612). Patent Owner argues Lee discloses only a “From” field and not a “Reply-To” field and there is no showing of why Lee would be modified to include a “Reply-To” field. *Id.* at 44.

Patent Owner's Preliminary Sur-Reply argues the Terveen Declaration does not establish that the "from" and "reply-to" fields are functionally identical. PO Prelim. Sur-Reply 1. Patent Owner states the actual showing from the Terveen Declaration is that the two fields have "distinct roles" except when they are populated by the same value. *Id.* (citing Ex. 1003 ¶ 83). As to the "anonymity" argument, Patent Owner's Preliminary Sur-Reply contends anonymity is not the only purpose of the "reply-to" field. *Id.* at 2.

*Analysis of Limitation 13(e)*

We agree that there is an insufficient showing that Lee teaches or suggests a "reply-to" field. We apply the ordinary meaning of "the email is configured with a reply-to email address." As highlighted above, limitation 13(e) specifically recites "the email is configured with a *reply-to email address*."

Petitioner admits that Lee does not disclose a "reply-to" field. Pet. 33. Patent Owner points to this admission and specifically argues Lee does not teach "the email is configured with a reply-to email address comprising the new cloaked relying party email address." PO Resp. 41.

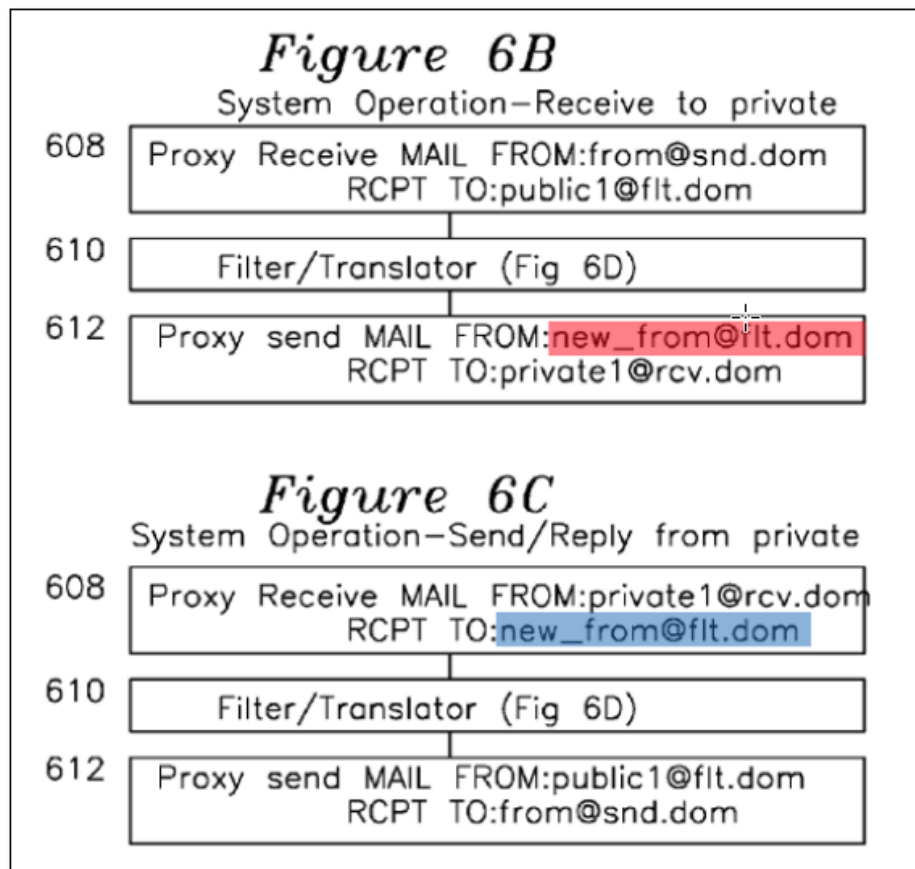
We agree with the parties and find that there is no specific disclosure of the "reply-to email address" in Lee. The issue is then whether Petitioner has shown another basis for us to conclude that limitation 13(e) would have been obvious to a person of ordinary skill in the art.

The Petitioner alleges that Lee's Figures 6B and 6C "show that the sender's alias address (i.e., new\_from@flt.dom) populates the 'from' field in an email to the user's private address and also is the 'to' address in

responsive communications.” Pet. 33–34. Petitioner further contends that Lee’s “Fig. 6C shows that the user’s responsive email is addressed to the same sender’s alias ([new\\_from@flt.dom](#)).” *Id.* How the preceding shows “reply-to email address” is not explained, only assumed. As close to being a “reply-to email address” as it may be, more is necessary to demonstrate that limitation 13(e) would have been obvious to a person of ordinary skill in the art.

Petitioner attempts to add what is necessary by combining Lee with the knowledge of a person of ordinary skill in the art. Pet. 34–35. Specifically, Petitioner argues a person of ordinary skill in the art, “would have understood that it would have been obvious to populate a ‘reply-to’ field with the sender’s alias.” *Id.* at 34 (citing Ex. 1003 ¶ 85).

This argument is of no avail. As already discussed, Petitioner admits that Lee lacks a “reply-to” field. Pet. 33. Per the Terveen Declaration, a person of ordinary skill in the art “would have understood that it would have been obvious to populate a ‘reply-to’ field with the sender’s alias.” *Id.* ¶ 85; *see also* Pet. 34 (making same argument and citing Ex. 1003 ¶ 85). The above opinion expressed in the Terveen Declaration is purportedly based on Lee’s Figures 6B and 6C. *See* Ex. 1003 ¶ 84. Annotated Figures 6B and 6C from the Terveen Declaration are reproduced below.



**Annotated Figures 6B and 6C.**

*Id.* The Terveen Declaration alleges annotated Figure 6B shows “the sender’s alias (new\_from@flt.dom) populates the ‘from’ field in a translated email sent to the user’s private email address ([private1@rcv.dom](#)).” *Id.* Annotated Figure 6C is alleged to show that the user’s responsive email is addressed to the same sender’s alias ([new\\_from@flt.dom](#)).” *Id.*

The above evidence shows a “reply” but does not teach a “reply-to email address.” The Terveen Declaration does not allege otherwise. As such, the Terveen Declaration does not cite to evidence in support of his opinion which is entitled to little, if any, weight on this point. *Xerox Corp.*

*v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential) (“the cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion from which is offered to support, and is entitled to little weight.”).

What is lacking is a teaching of a “reply-to” field. Conclusory expert testimony is not a substitute for what a prior reference does not teach. *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1363 (Fed. Cir. 2016) (where the prior art reference is missing a particular limitation the missing element is not supported by “conclusory statements and unspecific expert testimony.”).

We also agree with Patent Owner that

[t]he Petition does nothing to explain why a [person of ordinary skill in the art] would find it obvious to modify Lee to utilize the Reply-To field, beyond noting that a [person of ordinary skill in the art] would have known of the existence of the Reply-To field and the Reply-To field’s “distinct role.”

Prelim. Resp. 44. As Patent Owner argues, this alleged understanding of “From and Reply-To fields and their ‘distinct role[s] is not a motivation to modify Lee to meet Limitation 13(e).” *Id.*

A “motivation to combine may be found explicitly or implicitly in market forces; design incentives; the ‘interrelated teachings of multiple patents’; ‘any need or problem known in the field of endeavor at the time of invention and addressed by the patent’; and the background knowledge, creativity, and common sense of the person of ordinary skill.” *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328–29 (Fed. Cir. 2009) (citing *KSR*, 550 U.S. at 418–21). While common sense might form a basis for showing limitation 13(e), Petitioner does not allege reliance on common

sense or any other motivation to combine. We are not “free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016).

Petitioner’s Preliminary Reply does not address the basis for our determination because it does not explain how Lee and any supporting evidence teach a “reply-to email address.” As already explained, that Lee teaches that the “from” and “reply” fields of Lee “are populated with “the same sender alias” does not show a “reply-to email address.” *See* Pet. Prelim. Reply 3.

### *Summary Claim 13*

On this record, Petitioner has not shown sufficiently for purposes of institution that Lee combined with the knowledge of a person of ordinary skill in the art teaches all of the limitations of claim 13.

### *2. Claim 14*

We have reviewed Petitioner’s showing of unpatentability of claim 14, which depends from claim 13.

On this record, we find Petitioner has not sufficiently shown for purposes of institution that the combination of Lee and the knowledge of a person of ordinary skill in the art teaches all limitations of claim 14.

### *3. Conclusion (Ground 1)*

Petitioner has not shown a reasonable likelihood that claims 13 and dependent claim 14 would have been obvious over Lee and the knowledge of a person of ordinary skill in the art.

*E. Claims 1, 2, 7, 8, and 19 as Obvious Over Lee and Hardt (Ground 2)*

Petitioner provides a limitation-by-limitation analysis as to how claims 1, 2, 7, 8, and 19 would have been obvious over Lee and Hardt as well as the reasons and motivation to combine the two. Pet. 36–44 (element by element analysis), 44–52 (reasons to combine). Petitioner further relies on the Terveen Declaration. Ex. 1003 ¶¶ 87–120.

*1. Claims 1 and 7*

Patent Owner contends independent claims 1 and 7 “contain analogous limitations as those for which deficiencies were noted above” with respect to claim 13. *See* Prelim. Resp. 45. On this record, we agree that the disputed limitations of claims 1 and 7 are identical to those analyzed above for claim 13. *Compare* Ex. 1001, 29:56–57, 29:61–66 (limitations 13(c) and 13(d) respectively) *with* Pet. 49 (quoting Ex. 1001, 30:38–40, 30:43–46 (limitations 1(c)(iii) and 1(c)(iv) respectively)) *with* Pet. 51 (quoting Ex. 1001, 31:17–9, 13:22–26 (limitations 7(c) and 7(d) respectively)). Petitioner’s reliance on Hardt does not cure the deficiencies of Lee.

For the reasons stated for claim 13, on this record, we find Petitioner has not sufficiently shown for purposes of institution that Lee and Hardt teach all of the limitations of claims 1 and 7. Accordingly, Petitioner has not shown a reasonable likelihood that claims 1 and 7 are unpatentable.

*2. Claims 2, 8, and 19*

Claims 2, 8, and 9 depend from claims 1 and 7. On this record, for the reasons described above, we find Petitioner has not sufficiently shown

for purposes of institution that Lee and Hardt teach all the limitations of claims 2, 8, and 19.

### *3. Conclusion (Ground 2)*

Petitioner has not shown a reasonable likelihood that claims 1, 2, 7, 8, and 19 would have been obvious over the combination of Lee and Hardt.

#### *F. Claims 15–18 as Obvious over Lee and Le Jouan (Ground 3)*

Specific to this ground, Petitioner provides a limitation-by-limitation analysis as to how claims 15–18 would have been obvious over Lee and Le Jouan. Pet. 53–63. Petitioner relies on the Terveen Declaration for the analysis and reasons to combine Lee and Le Jouan. Ex. 1003 ¶¶ 121–133. Patent Owner does not separately argue patentability of claims 15–18. Le Jouan is not relied on anything that would cure Lee’s deficiencies.

### *Conclusion (Ground 3)*

For the reasons discussed above as to independent claims 1, 7, and 13, Petitioner has not shown a reasonable likelihood that dependent claims 15–18 would have been obvious over the combination of Lee and Le Jouan.

#### *G. Claims 3–6 and 9–12 as Obvious Over Lee, Hardt, and Le Jouan (Ground 4)*

Specific to this ground, Petitioner provides a limitation-by-limitation analysis as to how claims 3–6 and 9–12 would have been obvious over the combination of Lee, Hardt, and Le Jouan as well as the reasons and motivation to combine the two. Pet. 63–67, (element by element analysis), 63–64 (reasons to combine). Petitioner relies on the Terveen Declaration. Ex. 1003 ¶¶ 134–135.

*Conclusion (Ground 4)*

For the reasons discussed above as to independent claims 1, 7, and 13, Petitioner has not shown a reasonable likelihood that dependent claims 3–6 and 9–12 would have been obvious would have been obvious over the combination of Lee, Hardt, and Le Jouan.

IV. DISCRETIONARY ANALYSIS

Patent Owner argues that in view of the pending district court case between Patent Owner and Petitioner (noted in the Related Matters section above), we should exercise our discretion to deny institution under *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”). Prelim. Resp. 45–49. Petitioner argues *Fintiv* does not preclude institution. Pet. 67–70.

Because we have determined that Petitioner has not shown a reasonable likelihood that any challenged claim is unpatentable, we need not decide whether we should apply our discretion to deny institution under *Fintiv*.

V. CONCLUSION

For the foregoing reasons, we have determined on this record that Petitioner has not shown a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the Petition. We therefore do not institute trial.

VI. ORDER

For the foregoing reasons, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review of the ’107 patent is not instituted.

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