

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.
Petitioner

v.

Rally AG LLC
Patent Owner

Case No. IPR2024-01446
U.S. Patent No. 11,361,107

PETITIONER'S REQUEST FOR REHEARING

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Petitioner respectfully requests rehearing of the Decision Denying Institution of *Inter Partes* Review (“Order”). IPR2024-01446, Paper 9 (March 31, 2025).

I. INTRODUCTION

The Order determined that Petitioner failed to establish Lee taught or suggested limitation 13(e), requiring an email “configured with a reply-to email address comprising the [sender’s alias].” *Id.*, 17. This misapprehended Lee’s teachings and the proper scope of limitation 13(e). Indeed, Lee’s teachings are ***identical*** to the ’107 Patent’s with respect to this limitation. In both, the sender’s alias populates a “From” field address defined in the governing email standard (“Standard”),¹ ensuring responsive communications are addressed to that alias when the user ***replies to*** the email.

The Board’s misapprehensions are directly attributable to the ’107 Patent using the term “reply-to email address” in a manner different than the Standard’s “Reply-to” field and the Patent Owner’s (“PO”) conflation of the same. PO does not deny that limitation 13(e) requires configuring an email so that any response is directed to the sender’s alias when a user ***replies to*** the email. PO also does not deny that the ’107 Patent uses a Standard “From” field to accomplish this limitation.

¹ The Standard is referenced in the patent as RFC-822. Ex. 1001, 17:62-67, 18:11-15. This version was replaced by RFC-2822 in 2001. The relevant teachings are the same, and Petitioner’s expert discusses the latter (submitted as Ex. 1015).

Finally, PO does not dispute—nor could it—that Lee teaches precisely this functionality using the exact same Standard “From” field.

The Board correctly rejected PO’s sole material argument about limitation 13(e) (i.e., that it requires, in addition to the express “reply-to” configuration, configuring the email with a *distinct* “from” address). But the Board misapprehended the record as a direct result of PO arguing inconsistently with ’107 Patent’s use of “reply-to” as something *different* than the Standard “Reply-to” field. The ’107 Patent’s “reply-to” is unrelated to the Standard “Reply-to” field. It is instead language the patentee chose to refer to the address portion of a Standard “From” field—a field that directs responses when the user *replies to* the email. The Order relied on this incorrect understanding of the ’107 Patent’s “reply-to” address. Petitioner respectfully asks that the Board grant rehearing and institute review.

II. LEGAL STANDARD

“A party dissatisfied with a decision may file a single request for rehearing” that “specifically identif[ies] all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, a reply, or a sur-reply.” 37 C.F.R. § 42.71(d).

III. LEE TEACHES AN IDENTICAL PROCESS TO THE PATENT WITH RESPECT TO LIMITATION 13(e)

A. Overview of the Relevant Technology

Underlying the Board’s misapprehension is the ’107 Patent’s non-standard use

of standardized terminology, so a brief overview of the technology is clarifying.

i. The Governing Standard's Terminology

The Standard defines “From” and “Reply-to” as distinct fields within the class of “originator fields.” Apple’s expert discussed this standard in his declaration (Ex. 1003) and explained that the “From” field designates the author and also dictates where a reply email is directed by default. He explained that a separate (and optional) “Reply-to” field can be used to override the “From” field, directing any reply email to a *different* address. Ex. 1003, ¶83. In other words, both fields can be used to dictate where a responsive communication is directed. The “From” field address defines this return path by default, and a “Reply-to” field address can be added to override “From.” When a “Reply-to” field is used to override the “From” field for responsive communications, both fields are contained within the email:

```
-----  
From: Mary Smith <mary@example.net>  
To: John Doe <jdoe@machine.example>  
Reply-To: "Mary Smith: Personal Account" <smith@home.example>  
Subject: Re: Saying Hello  
Date: Fri, 21 Nov 1997 10:01:10 -0600  
Message-ID: <3456@example.net>  
In-Reply-To: <1234@local.machine.example>  
References: <1234@local.machine.example>  
  
This is a reply to your hello.  
-----  
  
Note the "Reply-To:" field in the above message. When John replies  
to Mary's message above, the reply should go to the address in the  
"Reply-To:" field instead of the address in the "From:" field.
```

Ex. 1015 (RFC-2822), 44 (annotated). In this example from the Standard, the “From” field (green) indicates the author of the email. A “Reply-to” field is included to override the “from” field (red) for any responsive communications.

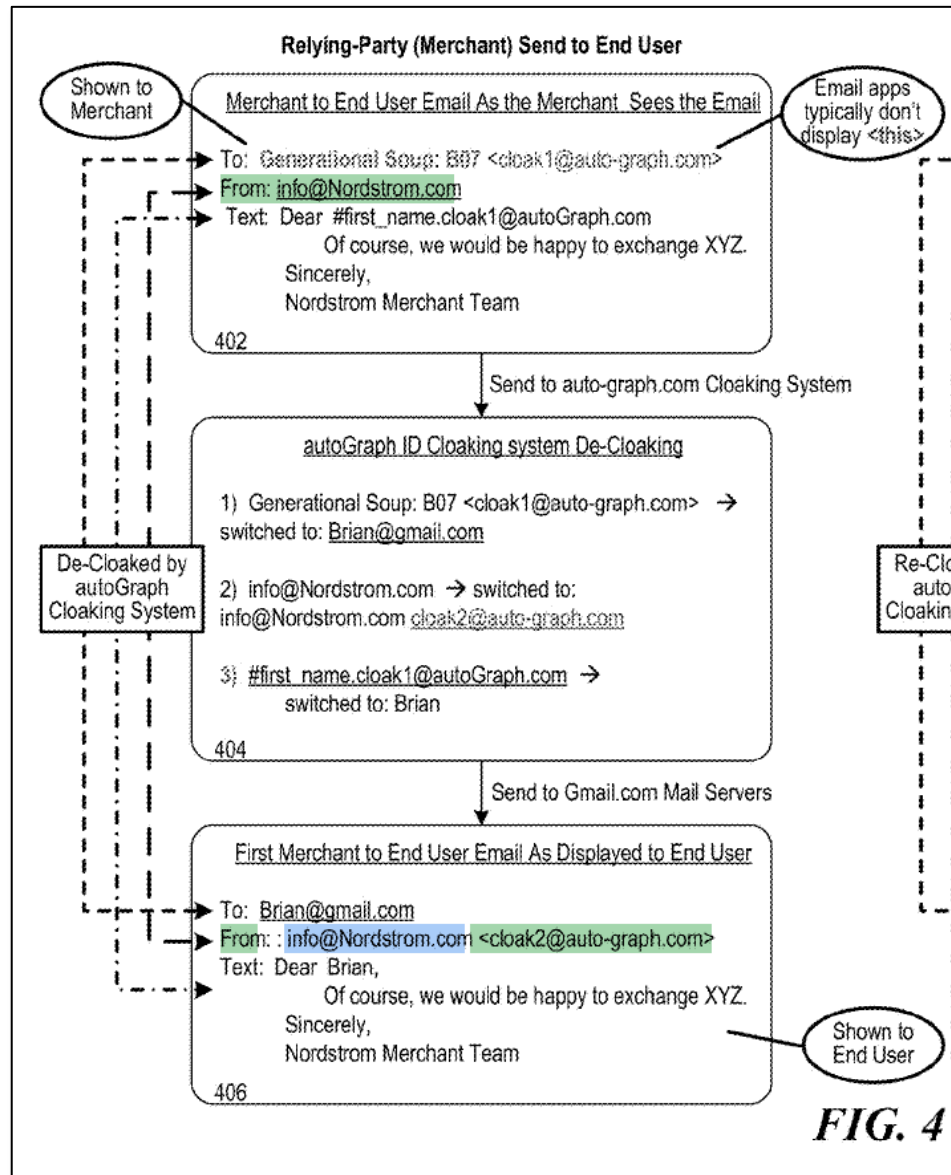
In both cases, there is a display name (blue) associated with the email addresses. As the Standard explains, the display name is an optional description of the email address that “could be displayed to the user of a mail application[.]” *Id.* at 15-16. Actual email addresses contained in these fields, distinguished from what’s displayed to the user, are contained within angle brackets (“<” and “>”). *Id.*

ii. The ’107 Patent’s Terminology

Despite acknowledging the governing standard, the ’107 Patent confusingly uses the phrase “reply-to” to describe something *different* than the Standard’s “Reply-to” field. The patent’s “reply-to” address—the address that is the center of the parties’ dispute and the Order—is the address contained in the Standard “From” field. Put another way, the patent’s “reply-to” address has nothing to do with the Standard “Reply-to” field but is instead language the patentee chose to refer to the address portion of a Standard “From” field—a field that functionally directs responsive communications when the user *replies to* the email.

As discussed in the Petition (Paper 1, 2-5), Fig. 4 depicts the patent’s process of using an alias for the sender to ensure responsive emails go through the alias server. As illustrated, the original sender’s address (info@Nordstrom.com) is

replaced with an alias (cloak2@auto-graph.com), ensuring that any responsive communications are routed through the alias server when a user *replies to* the email.



Ex. 1001, Fig. 4 (annotated); *see also* Petition, 2-5, 33-35; Ex. 1003, ¶¶37-38, 83. Critically, this sender alias populates the “From” field address in the communication that is sent from the alias server to the end user (Step 406). Indeed, there is no

separate “Reply-to” field depicted anywhere in Fig. 4. The entire process of populating a “reply-to” address occurs within the Standard “From” field.

A related function described in the patent and depicted in Fig. 4 is populating the “From” field’s display name with the original sender’s address. Fig. 4 illustrates that feature, showing the original sender (info@Nordstrom.com) as the display name (blue) in the “From” field and an alias for the sender (cloak2@auto-graph.com) as the address (green) in the “From” field. The patent introduces confusion by using standardized terms in a non-standard way. Namely, although the sender’s alias is contained in the Standard “From” field, the patent refers to it as a “reply to” address:

As illustrated, **these replaced addresses are info@Nordstrom.com <cloak2@autograph.com> which provides a different “reply to” address than the original sender/relying party, yet gives the end user context of the real/actual sender of the email 402 which was info@Nordstrom.com.** The above information may be associated and stored in the end user’s profile.

Ex. 1001, 11:60-67 (emphasis added). In the next column, however, the patent clarifies that both email addresses are part of the Standard “From” field:

Given the configuration of **the “from” address of the relying-party in 406 (e.g., From: info@Nordstrom.com <cloak2@auto-graph.com>)**, the message that is to be sent back to the relying-party in 408 will be routed to the ID cloaking systems and not directly to the email address (e.g., not directly to info@Nordstrom.com).

Id. at 12:22-28 (emphasis added). This passage recognizes the standardized usage of these terms—that info@Nordstrom.com is the display name portion of the “From” field and cloak2@auto-graph.com is the address portion of the “From” field.

B. Lee Teaches an Identical “Reply-To” Address to the ’107 Patent, Differing Only in its Use of Standardized Terminology

Lee—the base reference underlying all Proposed Grounds—populates the Standard “From” field address with the sender’s alias, ensuring that any responsive communications are routed through the alias server when a user *replies to* the email. *See* Petition, 32 (explaining that, in Lee, “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”), 33-34 (Lee “expressly teach[es] 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” because “the sender’s alias address (i.e., new_from@flt.dom) populates the “from” field); *see also* Prelim. Reply (Paper 7), 2-3 (reiterating that Lee teaches identical functionality with identical purpose—preserving user anonymity—to the ’107 Patent). Accordingly, Lee teaches *identical* functionality as is described in and claimed by the ’107 Patent and uses the *identical* Standard “From” field address to accomplish this functionality.

The Petition also established a POSITA would have found it obvious to use a Standard “Reply-to” address in Lee because it provides *the same functionality* as a Standard “From” address in the context of the claims—either can be used to dictate

the return path of a responsive email when a user *replies to* the received email. Petition, 33-35 (citing Ex. 1003 at ¶¶83-85, which establish that “from” and “reply-to” are “functionally identical” with respect to dictating the destination of a responsive email). Accordingly, even if limitation 13(e) were interpreted to require a Standard “Reply-to” field address (it should not be), the Petition established that it would have been obvious to use the Standard “Reply-to” field because, in the context of limitation 13(e), it is functionally identical to the “From” field Lee uses.

C. PO Confused the Record, Improperly Conflating the Patent’s Terminology with the Standard’s Terminology

i. PO does not dispute that the claimed “reply-to” address is a component of the Standard “From” field in all embodiments

As an initial matter, PO does not dispute that limitation 13(e) is directed to populating a Standard “From” address with the sender’s alias or that the purpose is to preserve user anonymity, routing all responses through the alias server when a user *replies to* the email. Indeed, both PO² and the district court have expressly acknowledged this in the parallel litigation. For example, describing how the invention of Claim 13 “enable[s] anonymous email communications,” PO confirmed that Claim 13 rewrites the “From” field with the sender’s alias:

² If relevant post-institution, Petitioner will introduce PO’s district court infringement allegations, showing that its infringement theories also focus exclusively on the Standard “From” field.

Claim 13 explicitly reflects this restriction, as the cloaked email from the relying party is “configured” by the ID cloaking system, “with a reply-to email address comprising the new cloaked relying party email address.” ’107 Patent at Claim 13. In other words, **the “from” field in the email is altered, or rewritten, by the ID cloaking system.**

Rally v. Apple, Case No. 1:23-cv-01106-JHS, Dkt. 45, at *14 (D. Del. June. 14, 2024) (emphasis added). The district court described limitation 13(e) similarly:

Claim 13’s final limitation instructs the ID cloaking system to swap the relying party’s de-cloaked email address with its cloaked email address before it sends the email to the end user. (See SAC at ¶ 56.) This final limitation states: “wherein the email is configured with a reply-to email address comprising the new cloaked relying party email address.” (*Id.*) In other words, when the ID cloaking system intercepts an email from a relying party to an end user and generates a cloaked email address for the relying party, as required by Claim 13’s domain name limitations, **this final limitation instructs the system to replace the relying party’s de-cloaked email address in the “From” line with its cloaked email address before it forwards the email onto the end user.** (See Doc. No. 45 at 19). For example, if Nordstrom emails an end user, the ID cloaking system will alter the de-cloaked “From: info@nordstrom.com” line of the email to instead read “From: info@autograph.me.”

Rally v. Apple, Case No. 1:23-cv-01106-JHS, Dkt. 52, at *19 (D. Del. Nov. 20, 2024) (emphases added).

ii. PO argued inconsistently with the patent's terminology

PO's primary argument is that limitation 13(e) requires not only a "reply-to" address populated with the sender's alias, but also a **different** "from" address. According to PO, including different "reply-to" and "from" addresses preserves the user's experience by displaying the original sender's address. POPR (Paper 6), 41-45. In its Preliminary Sur-Reply, PO acknowledges that the claim expressly recites only the "reply-to" address, but insists a different "from" address is also required based on how a POSITA would understand the "reply-to" and "from" fields:

Petitioner argues claim 13 requires "populating a 'reply-to' field with the sender's alias" but does not require "populating a 'from' field with a distinct email address." Reply, 1. This is contrary to how a POSITA would understand the claim. Petitioner's own expert testified, "***A POSITA would have understood*** that these two fields serve distinct roles . . . [where] the 'reply-to' field is an optional field . . . that is only used in case the sender wishes a reply to be sent to a different address than that found in the 'from' field." Ex. 1003, ¶ 83.

Because a POSITA knew that the Reply-To field, when used, contains distinct data from the From field, the claim should be read accordingly.

Prelim. Sur-Reply (Paper 8), 2 (emphasis in original).

Patent Owner has not submitted its own expert declaration in this proceeding, relying instead on testimony from Petitioner's declarant. *Id.* Fatal to Patent Owner's reliance on this testimony, Petitioner's expert, Dr. Terveen, was explaining the Standard "From" field and the Standard "Reply-to" field, rather than the patent's

“reply-to address.” Ex. 1003, ¶83 (acknowledging the patent’s use of “reply-to” and “from” and discussing their meaning in the Standard (Ex. 1015)). As set forth in detail above and as conceded by PO, the ’107 Patent’s “reply-to” and “from” addresses are both contained in the Standard “From” field.³ Petitioner’s expert’s discussion of differences between fields in the Standard does not inform the meaning of the Challenged Claims because the ’107 Patent’s “reply-to” address is *different from* the Standard “Reply-to” field.

Advancing this argument, PO improperly conflated the ’107 Patent’s “reply-to” address with the Standard “Reply-to” field. This conflation resulted in the Board’s misapprehension. The Board correctly declined PO’s invitation to import this unclaimed feature from the specification, but it did misapprehend the record by adopting PO’s mischaracterization of the claimed “reply-to address.”

In sum, PO does not deny that limitation 13(e) requires configuring an email so that any response is directed to the sender’s alias when a user *replies to* the email.

³ Although the detailed embodiment relies on the Standard “From” field, the ’107 Patent does briefly refer to Standard “From” and “Reply-to” fields, suggesting that *both* may be populated with a sender’s alias, “ensur[ing] that any replies. . . get routed back through the [alias server].” Ex. 1001, 17:62-67; Paper 7, 2-3; Ex. 1003, ¶83 (explaining that populating both Standard fields with the same address would be redundant). PO’s attempt to import a limitation requiring *different* “from” and “reply-to” addresses is in direct opposition to this teaching. Paper 7, 2-3.

PO also does not deny that the '107 Patent uses the Standard "From" field to accomplish this limitation. Finally, PO does not dispute—nor could it—that Lee teaches precisely this functionality using the exact same Standard "From" field.

D. The Board's Decision Misapprehended the Requirements of Limitation 13(e) and Petitioner's Theory of Invalidity

Confusion introduced by PO conflating the '107 Patent's terminology with the Standard's caused the Board to misapprehend two critical issues.

First, the Board misapprehended limitation 13(e). While the Board correctly declined PO's invitation to import a limitation into the Challenged Claims, it did interpret the claimed "reply-to" address consistent with the Standard, rather than applying the meaning ascribed to this phrase by the '107 Patent. Namely, it demanded verbatim support for the claimed "reply-to" address:

[L]imitation 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. 33.⁴ 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

⁴ Petitioner acknowledged only that Lee fails to rely on a Standard "Reply-to" field. Because the '107 Patent's "reply-to" address is not the same as a Standard "Reply-to" field, Petitioner did not concede that Lee fails to teach the limitation.

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.

Order, 21. But not even the '107 Patent describes using a “reply-to” address as that term is understood in the art, i.e., an address in the Standard “Reply-to” field. So the Board demanded more of the prior art than is disclosed by patent. This was error—error that is directly attributable to PO conflating the '107 Patent's chosen terminology with the Standard's terminology. Lee uses Standard-compliant terminology to describe the *same* process as the '107 Patent (i.e., configuring an email with the sender's alias, so responsive communications are directed to that alias address when the user *replies to* the email). And Lee uses the same Standard field as the '107 Patent to accomplish this functionality, replacing the Standard “From” field address with the sender's alias. It cannot be correct that Lee fails to teach limitation 13(e) where its teachings are identical to the '107 Patent.

Second, the Board misapprehended Petitioner's obviousness theory by accepting Patent Owner's mischaracterizations of the Petition's rationale. As the Board recognized, Petitioner and its expert accounted for the possibility of the claims would be interpreted to require verbatim support for Standard “Reply-to” field. Order, 22 (“Per the Terveen Declaration, a [POSITA] ‘would have understood that it would have been obvious to populate a ‘reply-to’ field with the sender's alias.”).

Analyzing this obvious theory, the Board credits and agrees with Patent Owner's criticism of the motivation:

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.***

Order, 24 (emphasis added). But Patent Owner's criticism of Petitioner's theory gets it exactly backwards. Dr. Terveen did not testify that the *distinct roles* between Standard "From" and "Reply-to" fields motivated using one instead of the other. He testified that they are *functionally identical* in the context of limitation 13(e). Ex. 1003, ¶83 ([W]hile technically distinct, the 'reply-to' field and 'from' field would have been understood to be functionally identical unless the 'reply-to' field is given a different value than the 'from' field."). Given their identical functionality in this context, Dr. Terveen explained that, as an alternative to using the "From" field to ensure responsive communications are routed through the alias server, "the '[R]eply-to' field" would be used "to accomplish the same function[.]" Ex. 1003, ¶85. Having

accepted Patent Owner’s mischaracterization of Dr. Terveen’s analysis, the Board critically misapprehended the theory presented by Petitioner. Accordingly, even if limitation 13(e) did require a Standard-compliant “Reply-to” address (it should not), Petitioner and its expert advanced a theory that captures this interpretation.

IV. CONCLUSION

The Board correctly declined PO’s invitation to import an unclaimed feature into the claims. But PO’s arguments confused the record, conflating the ’107 Patent’s language—“reply-to” address—with the Standard’s “Reply-to” field. This conflation cause the Board to misapprehend both the scope of limitation 13(e) and Petitioner’s theories regarding the same. As set forth herein, Lee’s teachings are *identical* to the ’107 Patent’s with respect to this limitation. It was thus error to conclude that Lee fails to teach or suggest the claimed concept. Petitioner respectfully requests rehearing and asks that IPR be instituted.

Respectfully submitted,

By: /s/ Paul R. Hart
Paul R. Hart, Reg. No. 59,646

COUNSEL FOR PETITIONER

**CERTIFICATE OF SERVICE ON PATENT OWNER
UNDER 37 C.F.R. § 42.105**

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105, the undersigned certifies that on April 30, 2025, a true and correct copy of the foregoing Petitioner's Request for Rehearing was served electronically on counsel for Patent Owner at the following address:

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