

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

STERLING COMPUTERS CORPORATION,
Patent Owner.

IPR2025-00270
Patent 8,073,911 B2

Before KARL D. EASTHOM, AMBER L. HAGY, and BACH V. HOANG,
Administrative Patent Judges.

HOANG, *Administrative Patent Judge.*

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

I. INTRODUCTION

On January 17, 2025, Microsoft Corporation (“Petitioner”) filed a petition requesting an *inter partes* review of claims 1–13, 15, 18, 20, 21, and 27 of U.S. Patent No. 8,073,911 B2 (Ex. 1001, “the ’911 patent”). Paper 1 (“Pet.”). Sterling Computers Corporation (“Patent Owner”) timely filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). With our authorization, Petitioner filed a pre-institution reply (Paper 10, “Prelim. Reply”), and Patent Owner filed a pre-institution sur-reply (Paper 11, “Prelim. Sur-reply”).

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any 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.” 35 U.S.C. § 314(a).

Having reviewed the parties’ papers and the evidence of record, we determine that Petitioner has shown a reasonable likelihood it would prevail in establishing the unpatentability of at least one challenged claim. Accordingly, we institute an *inter partes* review on all challenged claims and on all grounds raised in the Petition. *See* 37 C.F.R. § 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”).

A. *Real Parties in Interest*

Petitioner identifies itself, Microsoft Corporation, as the real party in interest. Pet. 1. Patent Owner identifies itself, Sterling Computers Corporation, as the real party in interest. Paper 5, 2 (Patent Owner’s Updated Mandatory Notices).

B. Related Matters

The parties indicate that the '911 Patent has been asserted in *Sterling Computers Corp., v. Microsoft Corp.*, No. 1-24-cv-00406 (W.D. Tex. April 17, 2024). Pet. 1; Paper 5, 2.

C. Asserted References

Petitioner's unpatentability challenges rely on three references:

- Rohall et al., US 2003/0163537 A1 (published August 28, 2003). Ex. 1005 ("Rohall").
- Schiavone et al., US 2002/0120600 A1 (published August 29, 2003). Ex. 1006 ("Schiavone").
- Gomes, US 8,375,008 B1 (issued February 12, 2013). Ex. 1016 ("Gomes").

D. Testimonial Evidence

Petitioner submits a declaration from Dr. John Black, Jr. Ex. 1003.

Patent Owner submits a declaration from Dr. Latifur Khan. Ex. 2002.

E. The Petition's Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 2):

Claims Challenged	35 U.S.C. ¹ §	References/Basis
1–8, 10–13, 15, 18, 20, 21	103(a)	Rohall, Schiavone

¹ The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102 and 103 effective March 16, 2013. Because the challenged patent was filed before March 16, 2013, we refer to the pre-AIA version of § 103.

Claims Challenged	35 U.S.C. ¹ §	References/Basis
9, 27	103(a)	Rohall, Schiavone, Gomes

F. The '911 Patent (Ex. 1001)

The '911 patent describes techniques for enforcing a compliance policy for an electronic messaging system, e.g., an email system. Ex. 1001, code (57), 1:63–2:2. The '911 patent states that a problem facing email systems is that, when an email is replied to and forwarded (and so on), multiple copies of the email being replied to and forwarded are stored, resulting in inefficiencies. *Id.* 1:39–45. Furthermore, enforcing email policies such as retention, access rights, and security is difficult due to the separate instances of that email. *Id.* at 1:45–55.

Addressing those issues, the '911 patent describes an email system that sends a message as a container that “itself does not contain content, but rather points to submessages and/or attachments in which content resides.” *Id.* at 4:61–65. Figures 2 and 3 are reproduced below and show such a message and interactions among messages.

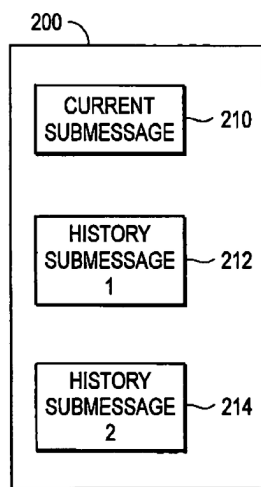


FIG. 2

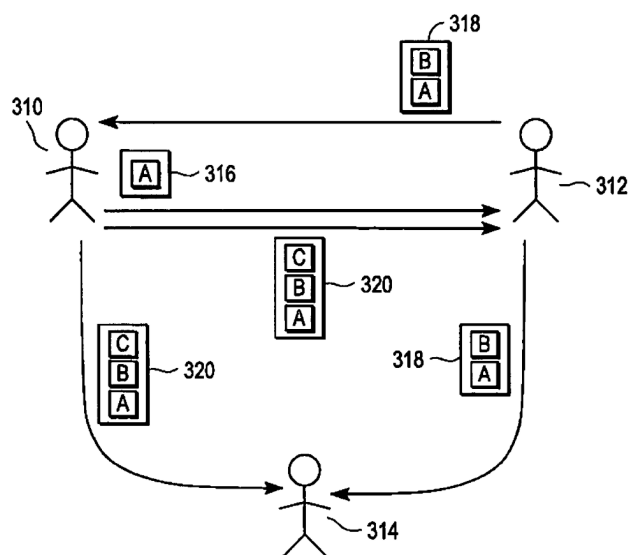


FIG. 3

Figure 2 is a block diagram showing an exemplary message including submessages and Figure 3 is an illustration showing respective messages being sent, replied to, or forwarded from person-to-person. *Id.* at 4:59–64; 5:31–42. In Figure 2, message 200 “is a container having relational references to content,” e.g., the substance of the email itself. *Id.* at 4:59–64. That is, “when an end-user composes and sends a message, she is actually composing a submessage, and then sending a message 200 containing a reference to the . . . submessage composed and sent by the end-user.” i.e., a “current submessage.” *Id.* at 5:10–13. In the case that there are “submessages that were previously in the message,” e.g., the email is a reply, those earlier submessages are referenced in message 200 as history submessages. *Id.* at 5:13–21. For example, as shown in Figure 3,

Alice 310 composes a message 316 containing submessage A and sends it to John 312. John 312 replies 318 and also copies the message to Peter 314. In the reply 318, submessage B is the current submessage and submessage A becomes a history submessage. Next, Alice 310 replies to both John 312 and Peter 314 and sends a third version 320 of the message having a new current submessage C, and two history submessages A and B.

Id. at 5:31–42.

The '911 patent's system further implements a compliance policy that “specifies a collection of rules that govern how content (i.e., message components and related data) is handled by the messaging system,” e.g., “communication rules, readership rules, action rules, retention rules, and search rules.” *Id.* at 9:26–36. Further, “each message component in the messaging system is associated with the compliance policy that was active at the time the content was created . . . when an action occurs that involves a piece of content, the messaging system identifies the relevant compliance policy . . . and applies it.” *Id.* at 8:1–10.

G. Challenged Claims

Petitioner challenges claims 1–13, 15, 18, 20, 21, and 27 of the '911 patent. Pet. 2. Of those, claims 1, 10, 13, and 27 are independent. Claims 1 and 13 are reproduced below with Petitioner's limitation identifiers and line formatting added:

1. [1.0] A computerized messaging server in an electronic messaging system, comprising:

[1.1] a messaging module adapted to control a message database storing messages sent among users of the messaging system,

[1.2] at least one of the sent messages stored in the message database comprising a message container containing relational references pointing to a plurality of sent submessages stored externally to the message container in the message database,

[1.3] at least one of the sent submessages being one of a reply to and a forward of other sent submessages of the sent message; and

[1.4] a governance module adapted to control a governance policy database storing a compliance policy describing rules applicable to the sent submessages,

[1.5] the governance module further adapted to determine rules described by the compliance policy that are applicable to ones of the plurality of sent submessages,

[1.6] wherein different rules of the compliance policy are applicable to different ones of the plurality of sent submessages;

[1.7] wherein the messaging system is utilized by a set of entities in a population structure and

[1.8] wherein a rule of the compliance policy includes one or more rule elements describing whether the rule is applicable to a sent submessage,

[1.9] at least one of the rule elements selected from the group consisting of: a source element describing a population structure entity that is a source of the sent submessage; a target element describing a population structure entity that is a recipient of the sent submessage; and a rank describing a ranking of the rule relative to other rules in the compliance policy.

Ex. 1001, 15:51–16:14; Pet. 80.

13. [13.0] A computer-implemented method of managing messages in an electronic messaging system, comprising:

[13.1] defining a compliance policy describing rules applicable to sent submessages of sent messages in the electronic messaging system;

[13.2] receiving a message sent by one end user of the messaging system to at least one other end user of the messaging system,

[13.3] the sent message comprising a message container containing relational references pointing to a plurality of sent submessages stored in a message database externally to the message container,

[13.4] the plurality of sent submessages including a first sent submessage and a second sent submessage, at least one of the sent submessages being one of a reply to and a forward of another sent submessage of the plurality of sent submessages; and

[13.5] selectively applying rules of the compliance policy to the sent submessages;

[13.6] wherein the messaging system is utilized by a set of entities in a population structure and

[13.7] wherein a rule of the compliance policy includes one or more rule elements describing whether the rule is applicable to a sent submessage,

[13.8] at least one of the elements selected from the group consisting of: a source element describing a population structure entity that is a source of the sent submessage; a

target element describing a population structure entity that is a recipient of the sent submessage; and a rank describing a ranking of the rule relative to other rules in the compliance policy.

Ex. 1001, 17:63–18:26; Pet. 83–84.

II. ANALYSIS

A. *Legal Standards*

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to the patent owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

The legal 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 ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness.² *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). One seeking to establish obviousness based on more than one reference often must articulate sufficient reasoning with rational underpinnings to combine teachings. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir.

² The current record does not include allegations or evidence of objective indicia of nonobviousness.

2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)).

B. Level of Ordinary Skill in the Art

Petitioner asserts a person of ordinary skill in the art

in May 2004 would have had a working knowledge of the telecommunications and networking art that is pertinent to the [’911 patent]. A POSITA would have had a bachelor’s degree in electrical engineering, computer science, computer engineering, or an equivalent, and two years of relevant experience involving computer science fundamentals, including pointers, data structures, object-oriented programming, database principles, internet-based communication technologies and electronic mail systems that is pertinent to the [’911 patent]. Lack of professional experience can be remedied by additional education, and vice versa

Pet. 3 (citing Ex. 1003 ¶ 22).

Patent Owner asserts a

person of ordinary skill in the relevant art — computer science — would have at least a bachelor’s degree in electrical or computer science/engineering, or a related field, with at least two years of experience in the design or implementation of content management and analysis systems or a master[’s] degree in electrical or computer science/engineering, or a related field, with at least one year of experience in the design or implementation of content management and analysis systems. A higher level of education or skill can make up for less experience, and vice versa.

Prelim. Resp. 17 (citing Ex. 2002 ¶ 14).

For purposes of this Decision, we adopt Petitioner’s proposed level of skill, as articulated above. Petitioner’s proposed definition generally

comports with the level of skill necessary to understand and implement the teachings of the '911 patent and the asserted prior art. *Cf. Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (noting that the prior art itself may reflect an appropriate level of skill in the art). This definition is also supported by the testimony of Dr. Black.

To the extent the level of ordinary skill in the art is in dispute and either party contends the defined level of ordinary skill makes a material difference in the obviousness analysis, the parties should brief their respective positions in this regard during trial.

C. 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). Under the principles set forth by our reviewing court, the “words of a claim ‘are generally given their ordinary and customary meaning,’” as would be understood by a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

The parties dispute the meaning of the term “relational references,” recited in all the challenged claims. Prelim. Resp. 18–19; Prelim. Reply 1–3; Prelim. Sur-reply 1–3. Patent Owner asserts “relational references” should be construed to “requir[e] use of a relational model.” Prelim. Sur-reply 1; Prelim. Resp. 18–19. Petitioner asserts that “relational references” do not require the use of a relational model. Prelim. Reply 1–2. Instead, Petitioner asserts the term should be construed as “pointers” that “point to related messages exchanged among users.” *Id.* at 3.

For the purposes of institution, we disagree with Patent Owner that “relational references” require using a relational model (or that they are a relational model) and, for purposes of this decision, we adopt Petitioner’s proffered construction.

The relevant portion of claim 1 recites “a message container containing relational references pointing to a plurality of sent submessages stored externally to the message container in the message database.” Ex. 1001, 15:56–59. That express language does not recite a relational model, let alone that “relational references” connote required use of a relational model. Instead, the language supports Petitioner’s interpretation that “relational references” are pointers that point to related messages because the claim states that the “relational references” perform the task of “pointing to a plurality of sent submessages.” Although Patent Owner asserts that “pointers pointing” would be redundant (Prelim. Sur-reply 3), we disagree. In addition to being different parts of speech, i.e., a pointer is a noun and pointing is a verb defining what the noun is doing, the claim does not merely recite “relational references pointing.” Rather, Petitioner’s proposed construction outlines what the “relational references” include, i.e., “pointers,” and claim 1 further limits *what* the “relational references” are “pointing to,” i.e., “to a plurality of sent submessages.” Prelim. Resp. 9.

Further, the Specification supports adopting Petitioner’s construction over Patent Owner’s. The Specification does not state that “relational references” require the use of, or are, a relational model, as Patent Owner argues. Rather, any discussion of “relational references” in the Specification describes them as message components that refer to content or other data, e.g., a pointer. Ex. 1001, 3:6–16 (“a message is a container having relational references to content and/or audit data”); *see id.* at 1:67–2:2, 4:61–64,

code (57). In fact, patent application number 10/789,461 (“the ’461 application”), which the ’911 patent incorporates by reference, appears to define a reference as a pointer, corresponding to Petitioner’s proposed construction in the present proceeding. Ex. 3002 ¶ 38 (“an S-Mail includes a pointer (i.e., a reference) to the locations of the current submessage 16, along with pointers to any history submessages.”). The Specification also supports Petitioner’s proposed construction that those references are “relational” by “point[ing] to related messages exchanged among users” because the Specification describes that submessages and history submessages are related to messages sent, replied to, or forwarded between users. Ex. 1001, 3:6–16, 1:67–2:2; Ex. 3002 ¶¶ 38–39.

While the Specification (and the ’461 application) describes an embodiment using “a relational model to represent and store messages exchanged among the end-users,” the Specification does not describe any specific correspondence between a relational model and relational references, let alone state that “relational references” require using a relational model. *See* Ex. 1001, 2:57–62; Ex. 3002 ¶ 8. Although Patent Owner argues that a “relational model” is “so well understood, it was unnecessary for the specification to define” it, Patent Owner does not offer a definition showing that a “relational reference” requires the use of a relational model. *See* Prelim. Sur-reply 1 (citing Ex. 2002 ¶ 87; Ex. 2004, 7, 17–23).

Additionally, the extrinsic evidence Patent Owner relies on does not offer a definition of “relational references” supporting Patent Owner’s construction. Patent Owner cites a text titled “Fundamentals of Database Systems,” specifically to portions describing relational databases and “The Relational Data Model[.]” Prelim. Sur-reply 1–2 (citing Ex. 2004, 7, 17–

23). Although Patent Owner emphasizes the text’s discussion of the terms “relational,” “relational databases,” and “relational models,” it does not adequately explain where those cited portions discuss “relational *references*” specifically, in support of its construction. *See id.*

As such, our Decision on Institution does not construe “relational references” to require the use of a relational model. Instead, at this stage and for purposes of this decision, we agree with Petitioner that “relational references” should be construed as including “pointers” that “point to related messages exchanged among users.” Prelim. Reply 3.

We address these claim construction issues to provide guidance to the parties for the upcoming trial. At this stage, it is not necessary to address the construction of any other claim terms or phrases. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe 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))). During the trial, the parties should directly address any claim construction adopted in this Decision if the party contends we should not adopt that construction in the final written decision.

D. Ground 1: Asserted Obviousness Based on Rohall and Schiavone

Petitioner contends that the subject matter of claims 1–8, 10–13, 15, 18, 20, and 21 would have been obvious over Rohall and Schiavone. Pet. 2, 5–66. Patent Owner argues that Petitioner’s showing is insufficient. Prelim. Resp. 27–54.

We have considered the parties’ arguments and the evidence presented at this stage, and we address them in the context of independent

claims 1 and 13. We determine that Petitioner has demonstrated a reasonable likelihood that it will prevail in showing that the subject matter of claim 13 would have been obvious over the combination of Rohall and Schiavone. We also note that Patent Owner raises reasonable questions regarding Petitioner's showing in claim 1. We provide our detailed discussion below.

1. Summary of Rohall (Ex. 1005)

Rohall describes system which organizes emails as “conversation threads.” Ex. 1005 ¶¶ 13, 56. A conversation thread can be represented as a hierarchical tree which relates parent and child emails, e.g., an email and a reply to that email. *Id.* ¶ 56. Rohall's email system further creates “shadow documents” reflecting original email documents and the conversation thread hierarchy. *Id.* ¶¶ 13, 56. Figure 6C, reproduced below, is a conceptual illustration of conversation thread trees showing original documents in relation to shadow documents. *Id.* ¶¶ 25, 68.

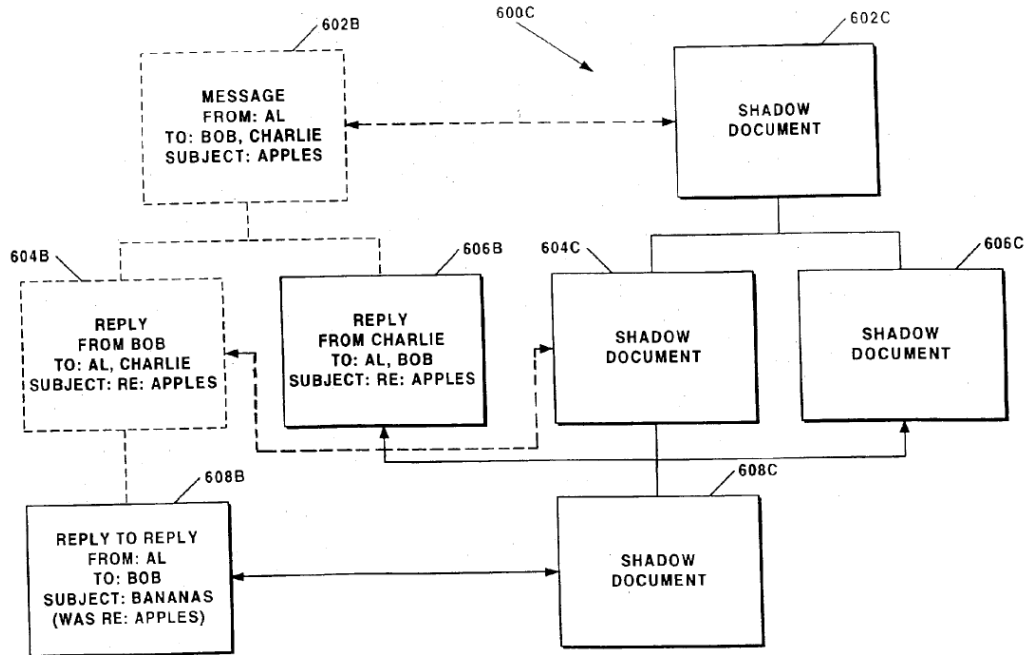


Figure 6C

As shown in Figure 6C, original email documents are organized in a hierarchy with parent/root document 602B, which has reply and reply-to-reply child documents 604B, 606B, and 608B. *Id.* ¶ 68. Those original email documents and hierarchy are mirrored by respectively corresponding shadow documents 602C, 604C, 606C, and 608C. *Id.*

Further, shadow documents have a data structure that includes pointers to email messages including Original Document Identified (ID) Parent Document ID, Root Document ID, and Child Document IDs. *Id.* ¶¶ 23, 57; *see* Fig. 4. For example, Original Document ID “may comprise a pointer to the original document, e.g. an electronic mail message” and Child Document IDs may be “pointers to the immediate children documents,” e.g., replies to that email document, “in the tree hierarchy.” *Id.* ¶¶ 56–57.

2. Summary of Schiavone (Ex. 1006)

Schiavone describes “rules-based processing” for emails. Ex. 1006 ¶ 7. For example, Schiavone explains that “a message may be rejected, and

not delivered to the intended recipient, if a recipient's profile data is incompatible with applicable laws for receiving the message, as specified in a rule associated with the message.” *Id.* ¶ 16.

Schiavone describes a situation where “a sender could select several different rule sets to automate their compliance with selected US federal and local laws and regulations and, if desired, varying laws and regulations enacted by the European Union and elsewhere globally,” e.g., the US Children’s Online Privacy Protection Act (“COPPA”). *Id.* ¶ 29. For example, where an email “recipient lives in the US and is 45 years of age,” that recipient “is in compliance, i.e., compatible, with the applicable rule . . . and the electronic mail message is delivered to the recipient.” *Id.* ¶ 33. Further, “the same message sent to a 10 year old in France could result in a determination of compliance and delivery of the message because the rule (and COPPA law) is applicable only to residents of the US. Compliance with local laws is thereby ensured.” *Id.*

3. *Combination of Rohall and Schiavone*

Generally, Petitioner relies on Rohall to teach an email system that stores and organizes email conversation threads using “shadow documents.” *See* Pet. 5, 14–34. Petitioner explains that Rohall’s shadow documents are representations of original emails. Pet. 20 (citing Ex. 1005 ¶ 68). Further, Petitioner explains that each shadow document defines a parent and child email hierarchy, e.g., a child email is a reply email to its parent email. *Id.* at 21–22 (citing Ex. 1005 ¶ 56).

Petitioner relies on Schiavone to teach compliance and governance features for email systems that identify and enforce rules associated with email messages. *See id.* at 5, 37–46. Petitioner points out an example of

Schiavone's rule-based email processing system where an email is only delivered to a US recipient if the recipient is above a certain age in compliance with US law. *Id.* at 43–44 (citing Ex. 1006 ¶¶ 29–31, 33).

Petitioner combines Schiavone's rules-based email processing system with Rohall's email system. Pet. 5. Petitioner asserts that the ordinarily skilled artisan would have been motivated to include Schiavone's rules-based email processing because Schiavone states that automating enforcement of laws and rules for email transmissions is beneficial. *Id.* at 7–8 (citing Ex. 1006 ¶¶ 1, 6; Ex. 1003 ¶ 119). Petitioner also asserts that the ordinarily skilled artisan would have been motivated to combine Rohall and Schiavone because the combination would have provided beneficial email filtering features. *Id.* at 8–9 (citing Ex. 1005 ¶ 1; Ex. 1006 ¶ 2; Ex. 1003 ¶ 121). Still further, Petitioner asserts that the ordinarily skilled artisan would have been motivated to combine Rohall and Schiavone because the combination is an arrangement of old elements (email techniques) which each perform their known function (applying rules to emails) yielding expected results (an email system which filters emails). *Id.* at 13–14 (citing Ex. 1005 ¶ 12; Ex. 1003 ¶ 127).

We agree with Petitioner that the ordinarily skilled artisan would have been motivated to combine Rohall and Schiavone because Schiavone provides reasons to apply its techniques to email systems such as Rohall's. Schiavone describes a need for “ensuring compliance of e-mail messages with applicable standards and/or laws and/or otherwise determining appropriateness of a message for an intended recipient,” especially because there is “a patchwork of local, federal and international laws.” Ex. 1006 ¶ 6. Schiavone also states that filtering emails, e.g., to remove spam, is beneficial. *Id.* ¶¶ 1–2. As Schiavone describes problems in email systems,

which its rules-based email processing technique addresses, Petitioner adequately shows that the ordinarily skilled artisan would have been motivated to combine Rohall and Schiavone. *See KSR*, 550 U.S. 401 (a reference which teaches, suggests, or motivates its combination may “identify a reason that would have prompted a person of ordinary skill in the art to combine the elements”).

Patent Owner’s arguments that a skilled artisan would not have combined Rohall and Schiavone (Prelim. Resp. 42–51) do not overcome Petitioner’s showing.

Patent Owner argues that “a skilled artisan would not combine Rohall and Schiavone to solve the problems in the ‘911 [p]atent” and “would not look to the Rohall reference at all to solve the problems set forth in the ‘911 [p]atent.” Prelim. Resp. 29–32, 42–46. These arguments are unavailing because, “[i]n determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls.” *KSR*, 550 U.S. 419. As such, Patent Owner’s arguments that the references, alone or in combination, do not solve the problems the ‘911 patent address, i.e., submessage replication, storage concerns, and individual submessage action (Prelim. Resp. 29–32, 42–46), do not negate the motivation Petitioner identifies from Schiavone’s disclosure.

Patent Owner also argues “there is no teaching or suggestion in Rohall that would motivate a skilled artisan to add rules from Schiavone to Rohall.” Prelim. Resp. 47–48. But, obviousness does not rigidly require a teaching, suggestion, or motivation found in a reference itself. *KSR*, 550 U.S. 402. Even if it did, Petitioner points out that Schiavone provides motivation to improve Rohall’s email system, e.g., to address spam and to enforce communication laws. Pet. 6–7.

Patent Owner further argues that Petitioner's motivation is inadequate as lacking evidence or that its evidence in the form of Dr. Black's testimony is "conclusory." Prelim. Resp. 32–33, 46, 48–50. The current record shows otherwise. As discussed above, Petitioner relies on reasons found in Schiavone's disclosure as motivation for its combination. Pet. 6–7 (citing Ex. 1006 ¶¶ 1–2, 6). Petitioner also relies on the testimony of Dr. Black as supporting evidence; Dr. Black explains, with citations to evidence of record, that Rohall and Schiavone both concern email systems, identifies issues in email systems, and explains how email is improved by applying Schiavone's techniques. *Id.* at 6–8; Ex. 1003 ¶¶ 118–127. While Patent Owner faults Petitioner and Dr. Black for not offering explanation that "a skilled artisan would consider the resulting modified inbox to be 'improved'" (Prelim. Resp. 49), both Petitioner and Dr. Black identify email improvements in the form spam filtering and legal compliance. We agree that spam filtering and legal compliance are improvements to email systems that would have motivated the combination of Rohall and Schiavone.

Accordingly, for the purposes of institution, Petitioner adequately shows that a POSITA would have been motivated to combine Rohall and Schiavone in the manner suggested.

4. Independent Claim 13

Below, we address the limitations recited in claim 13 and focus our discussion on the claim features Patent Owner asserts are not disclosed, taught, or obvious over the combination of Rohall and Schiavone.

a) Preamble

Petitioner contends that Rohall discloses the preamble, i.e., “[a] computer-implemented method of managing messages in an electronic messaging system.” Pet 62–63 (citing Ex. 1005 ¶¶ 5, 134); *see id.* at 14–17 (citing Ex. 1005 ¶¶ 14, 48, 51–52, 60, Figs. 1, 3; Ex. 1003 ¶¶ 128–130).³ Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Rohall discloses the preamble.⁴

b) Limitation [13.1]

Petitioner asserts that the combination of Rohall and Schiavone teaches “defining a compliance policy describing rules applicable to sent submessages of sent messages in the electronic messaging system.” Pet. 62–63; *see id.* at 37–41 (citing Ex. 1006 ¶¶ 7, 28–30, 35, 64, 66, Fig. 6, code (57); Ex. 1003 ¶¶ 174–187). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that the combination of Rohall and Schiavone satisfies this limitation.

c) Limitation [13.2]

Petitioner asserts that Rohall discloses “receiving a message sent by one end user of the messaging system to at least one other end user of the

³ Petitioner asserts that certain limitations recited in claim 13 are analogous to certain limitations recited in claim 1. Pet. 62–63. For those assertedly analogous limitations, we refer to Petitioner’s discussion of claim 1.

⁴ Generally, a preamble does not limit a claim. *Allen Eng’g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed. Cir. 2002). Neither party takes a position as to whether the preambles of the claims before us are limiting. At this stage of the proceeding, we need not resolve whether the preamble to claim 1 is limiting because Petitioner shows sufficiently for purposes of institution that the prior art satisfies the recitation in the preamble.

messaging system.” Pet. 62; *see id.* at 17–22 (citing Ex. 1005 ¶¶ 14, 15, 54–56, 68, 73, 125, Figs. 2, 6C; Ex. 1003 ¶¶ 135–143). Patent Owner does not dispute this contention. On this record, we agree with Petitioner that Rohall discloses this limitation.

d) Limitation [13.3]

Petitioner asserts that Rohall discloses “the sent message comprising a message container containing relational references pointing to a plurality of sent submessages stored in a message database externally to the message container.” Pet. 62; *see id.* at 22–34 (citing Ex. 1005 ¶¶ 13, 17, 48–50, 52, 54–56–60, 62–64, 68, 70–73, 95, 100, 129, Figs. 3, 4, 5B, 17B; Ex. 1003 ¶¶ 146–165). Relevantly, Petitioner asserts that Rohall’s shadow document, representing an email, discloses “a message container.” Pet. 23–24 (citing Ex. 1005 ¶¶ 56, 129). Petitioner further asserts that the shadow document has a data structure which includes pointers to other messages in a conversation thread, e.g., Parent Document IDs and Child Document IDs which point to message replies; Petitioner asserts those pointers disclose “relational references pointing to a plurality of sent submessages.” Pet. 25–27 (citing Ex. 1005 ¶¶ 56–57, 129, Fig. 4, 17B). Petitioner adequately shows that Rohall discloses this limitation.

Patent Owner contends that Rohall does not disclose “relational references pointing to a plurality of sent submessages.” Prelim. Resp. 28–29, 36–39. That contention is based on its asserted claim construction — that “relational references” requires the use of a relational model — which we do not adopt at this stage in the proceeding. *See* § II.C. Accordingly, Patent Owner’s arguments that Rohall uses a hierarchical model rather than a relational model (Prelim. Reps. 29, 36–39) argues features the claim does

not require and, so, does not overcome Petitioner’s showing that Rohall’s pointers disclose this claimed feature.

Patent Owner also argues it would not have been obvious to add “relational references” to Rohall. Prelim. Resp. 39–42. As Petitioner adequately shows that Rohall discloses those features, we need not opine on whether those features would have been obvious over Rohall.

Accordingly, on this record, Petitioner adequately shows that Rohall discloses this limitation.

e) Limitation [13.4]

Petitioner asserts that Rohall discloses “the plurality of sent submessages including a first sent submessage and a second sent submessage, at least one of the sent submessages being one of a reply to and a forward of another sent submessage of the plurality of sent submessages.” Pet. 62; *see id.* at 35–36 (citing Ex. 1005 ¶¶ 56, 60, 91, 93; Ex. 1003 ¶¶ 167–173). Patent Owner does not dispute this contention.

On this record, we agree with Petitioner that Rohall discloses this limitation.

f) Limitation [13.5]

Petitioner asserts that the combination of Rohall and Schiavone teaches “selectively applying rules of the compliance policy to the sent submessages.” Pet. 63; *see id.* at 44–46 (citing Ex. 1006 ¶¶ 7, 16, 29, 33; Ex. 1003 ¶¶ 194–199). In particular, Petitioner relies on Schiavone’s rule compliance system in which “a sender could select several different rule sets to automate their compliance with selected US federal and local laws and regulations and, if desired, varying laws and regulations enacted by the

European Union and elsewhere globally.” *Id.* at 45 (citing Ex. 1006 ¶ 29). Petitioner cites an example where one email message is sent to a “recipient [who] lives in the US and is 45 years of age” and “the same message [is] sent to a 10 year old in France.” *Id.* at 44–45; Ex. 1006 ¶ 33. In that example, both recipients receive the email because, even though COPPA is a US law which forbids delivery of commercial electronic mail communications to children aged thirteen and under, the French 10 year old is not subject to US law and, so, receives the email. *Id.* ¶¶ 29, 33.

Patent Owner contends Schiavone does not teach this limitation. Prelim. Resp. 27–28, 33–36. Patent Owner argues this limitation “requires different treatment of different submessages, but Schiavone does not discuss submessages at all.” *Id.* at 33. Patent Owner highlights that the example Petitioner relies on “relate[s] to applying different rules to the same message.” *Id.* at 34–36.

Patent Owner argues features not recited in the claim. The claim does not recite, and does not implicitly require, that there are different rules for different submessages. Instead, the claim only requires rules selectively applied to sent submessages. Schiavone’s example appears to do that; in Schiavone’s example, COPPA applies to submessages sent to US residents but not to French residents. Ex. 1006 ¶ 29, 33.

Patent Owner also argues “a skilled artisan would not be motivated to add this feature to the Rohall-Schiavone combination” because “Rohall discourages, or teaches away from, a skilled artisan from applying different rules to different submessages.” Prelim. Resp. 35–36 (citing Ex. 1005 ¶ 8). As above, the features Patent Owner argues are not required by the claim. Moreover, the criticisms Patent Owner highlights in Rohall are not related to the features the combination incorporates. The cited portion of Rohall

states, in context, that “users must locate and act on each message individually” to locate and share an entire thread of conversations, i.e., the history of emails and replies. Ex. 1005 ¶ 8. Rohall does not criticize applying rules to messages, Rohall criticizes the difficulty in sending entire message threads. As such, Rohall does not teach away from the combination.

Accordingly, Petitioner adequately shows on this record that the combination of Rohall and Schiavone teaches this limitation.

g) Limitations [13.6]–[13.8]

Petitioner asserts that Rohall discloses “wherein the messaging system is utilized by a set of entities in a population structure.” Pet. 63; *see id.* at 46–47 (citing Ex. 1005 ¶¶ 6–7, 12, 60, 107, 126; Ex. 1003 ¶¶ 203–204).

Petitioner asserts that the combination of Rohall and Schiavone teaches “wherein a rule of the compliance policy includes one or more rule elements describing whether the rule is applicable to a sent submessage.” Pet. 63; *see id.* at 47–49 (citing Ex. 1006 ¶¶ 31–34, Fig. 2; Ex. 1004 ¶¶ 205–210).

Petitioner asserts that the combination of Rohall and Schiavone teaches

at least one of the elements selected from the group consisting of: a source element describing a population structure entity that is a source of the sent submessage; a target element describing a population structure entity that is a recipient of the sent submessage; and a rank describing a ranking of the rule relative to other rules in the compliance policy.

Pet. 63; *see id.* at 49–51 (citing Ex. 1006 ¶ 16; Ex. 1003 ¶¶ 211–215).

Patent Owner does not dispute these contentions. On this record, we agree with Petitioner that Rohall or the combination of Rohall and Schiavone teach these limitations.

h) Conclusion as to Claim 13

For the reasons discussed above and based on Petitioner's contentions and evidence, summarized above, we are persuaded, on this record, that Petitioner shows a reasonable likelihood of prevailing in demonstrating that claim 13 would have been obvious over the combination of Rohall and Schiavone.

i) Institution of Inter Partes Review

Because we are persuaded that Petitioner has shown a reasonable likelihood of prevailing in demonstrating that the subject matter of claim 13 would have been obvious over the combination of Rohall and Schiavone, we institute an *inter partes* review of all claims and all challenges raised in the Petition. *See SAS Inst. Inc. v. Iancu*, 584 U.S. 357, 365 (2018) (stating 35 U.S.C. § 314 “simply requires [the Director] to decide whether the petitioner is likely to succeed on ‘at least 1’ claim. Once that single claim threshold is satisfied, it doesn’t matter whether the petitioner is likely to prevail on any *additional* claims; the Director need not even consider any other claim before instituting review.”); 37 C.F.R. § 42.108(a).

Nevertheless, in order to further guide the parties after institution, we provide additional observations regarding the parties’ arguments for the other grounds and challenged claims.

5. Independent Claim 1

Petitioner contends claim 1 would have been obvious over the combination of Rohall and Schiavone based on similar teachings and rationale as it did for claim 13. *See* Pet. 62–63. Patent Owner argues claims 1 and 13 together, and, so, relies on the same arguments as it did in claim 13 to contend Petitioner’s showing on claim 1 is inadequate.

See Prelim. Resp. 33–51.

Although we determine that Petitioner adequately shows, for purposes of institution, a reasonable likelihood of prevailing on its assertions that claim 13 would have been obvious over the combination of Rohall and Schiavone (*see* § II.D.4), Patent Owner’s arguments raise reasonable questions regarding claim 1 because claim 1 includes a limitation that recites meaningfully different features than claim 13. In particular, limitation [1.6] distinctly recites “wherein different rules of the compliance policy are applicable to different ones of the plurality of sent submessages.” Ex. 1001, 15:67–16:2.

Petitioner asserts the combination of Rohall and Schiavone teaches this limitation based on Schiavone’s example in which a US law applies to a 45 year old US resident receiving an email but not to a French 10 year old receiving the same email. Pet. 44–45 (citing Ex. 1006 ¶¶ 29, 33).

Patent Owner’s argument that this limitation “requires different treatment of different submessages,” but “Schiavone relate[s] to applying different rules to the same message” raises reasonable questions in Petitioner’s showing for this limitation. Prelim. Resp. 33–34. This limitation recites, and so requires, that “different rules . . . are applicable to different ones of the plurality of sent submessages.” Ex. 1001, 15:67–16:2. The claim also recites that “at least one of the sent submessages being one of

a reply to and a forward of other sent submessages of the sent message,” (*id.* at 15:59–61), which Petitioner asserts is taught by email replies and forwards in an email conversation thread (Pet. 24, 35–36). Although Petitioner cites to and reproduces disclosures in Schiavone regarding the same message being treated differently based on its recipients, on this preliminary record, we are uncertain as to how those disclosures describe “different rules” that are applied to “different . . . submessages.”. *See* Pet. 44–45.

Although Patent Owner raises a valid question about Petitioner’s contention that the combination of Rohall and Schiavone teaches this limitation, we need not reach a particular determination on this issue for the purposes of institution. As discussed in above in § II.D.4, Petitioner adequately shows claim 13 is obvious over the combination of Rohall and Schiavone, and, hence, we institute on all claims and all grounds. We invite the parties to further address this ground at trial.

E. Ground 2: Asserted Obviousness Based on Rohall, Schiavone, and Gomes

Petitioner contends that claims 9 and 27 would have been obvious over the combination of Rohall, Schiavone, and Gomes. Pet. 2, 66–74. Patent Owner argues that Petitioner’s showing is insufficient. Prelim. Resp. 54–61.

Although it is sufficient to institute based on Petitioner’s obviousness challenge of claim 1 over the combination of Rohall and Schiavone, we provide additional observations regarding the parties’ arguments for the other grounds and challenged claims below, to further guide the parties after institution. *See* Patent Trial and Appeal Board Consolidated Trial Practice

Guide 6, 64 (Nov. 2019), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated>. We focus on issues raised by Patent Owner's arguments in those grounds.

1. Summary of Gomes (Ex. 1016)

Gomes describes a system for managing email data. Ex. 1016, code (57). Gomes's system allows authorized users different levels of access email data, e.g., read-only access or read and write access. *Id.* at 12:46–55, 13:1–6. Gomes also describes email de-duplication features. *Id.* at 2:4–16.

2. Combination of Rohall, Schiavone, and Gomes

As discussed above, Petitioner relies on the combination of Rohall and Schiavone to teach an email system using submessages and applying rules to those submessages. *See* § II.D.3. From that combination, Petitioner asserts that the ordinarily skilled artisan would have been further motivated to improve that email system by incorporating Gomes's search access policies. Pet. 68–69 (citing Ex. 1016, 9:21–42, 11:40–47, 12:46–55, code (57)). As Petitioner sufficiently shows, the combination would have improved email filtering capabilities and enhanced legal and statutory requirements for data retention policies. *Id.* at 67–68 (citing Ex. 1003 ¶ 276).

Petitioner also asserts that a skilled artisan would have been further motivated to improve email systems by incorporating Gomes's email de-duplication features in order to reduce memory requirements and costs. *Id.* at 67 (citing Ex. 1005 ¶¶ 43, 64; Ex. 1006 ¶ 2; Ex. 1003 ¶ 275).

Patent Owner does not dispute Petitioner's contention that a skilled artisan would have been motivated to combine Rohall, Schiavone, and

Gomes. On this record, we agree with Petitioner that the ordinarily skilled artisan would have been motivated to combine Rohall, Schiavone, and Gomes for the reasons offered by Petitioner.

3. *Dependent Claim 9*

Petitioner contends claim 9 would have been obvious over the combination of Rohall, Schiavone, and Gomes. Pet. 66–70. Claim 9 depends from claim 1 and recites “wherein the rules described by the compliance policy include search rules describing which population structure entities can view which sent submessages when searching the sent submessages stored by the messaging system.” Ex. 1001, 16:63–67.

Petitioner contends Gomes, in combination with Rohall and Schiavone, teaches the features recited in claim 9 based on Gomes’s description of rules which define access policies to emails including read-only access for authorized users. *Id.* at 69–70 (citing Ex. 1016, 6:21–31, 11:40–47, 12:46–55, 13:1–6; Ex. 1003 ¶ 280).

Patent Owner argues Gomes does not teach, disclose, or suggest this limitation because “Gomes does not address ‘submessages’ at all.” Prelim. Resp. 56–57.

However, Petitioner’s combination relies on Rohall, not Gomes, to teach an email system having “submessages.” *See* Pet. 22–34, 66–69. In particular, Petitioner’s combination first “combine[s] Rohall’s messaging system server with Schiavone’s rule-based processing” (*id.* at 66) and asserts that combination is further improved by incorporating Gomes’s email search and access features (*id.* at 68–69). As such, Patent Owner’s argument, which only addresses Gomes’s disclosures, does not address Petitioner’s challenge based on the combination of Rohall, Schiavone, and Gomes.

Accordingly, Petitioner adequately shows that the combination of Rohall, Schiavone, and Gomes teaches the features recited in claim 9.

4. Independent Claim 27

Petitioner contends claim 27 would have been obvious over the combination of Rohall, Schiavone, and Gomes. Pet. 66–69, 72–74.

Claim 27 recites, in pertinent part,

each of the sent submessages is stored exactly once within the email database, and

upon receipt of a reply to a first email having a first email container containing a first sent submessage, the reply is added to the message container as an additional sent submessage but the first sent submessage is not duplicated within the email database.

Ex. 1001, 20:21–28.

Petitioner contends Gomes, in combination with Rohall and Schiavone, teaches this limitation based on Gomes’s description of de-duplication of emails, e.g., “de-duplication of attachments, message bodies and metadata . . . such that only one copy of the content is” stored. Pet. 72–74; Ex 1016, 2:4–16, code (57).

Patent Owner argues Gomes does not teach, disclose, or suggest this limitation because “Gomes does not disclose de-duping at the submessage level, such that each submessage is stored only once.” Prelim. Resp. 58–59.

However, Petitioner’s combination relies on Rohall, not Gomes, to teach an email system having “submessages.” See Pet. 22–34, 66–69. In particular, Petitioner’s combination first “combine[s] Rohall’s messaging system server with Schiavone’s rule-based processing” and asserts that combination is further improved by incorporating Gomes’s email de-duplication features (*id.* at 66–67). As such, Patent Owner’s argument,

which only addresses Gomes's disclosures, does not address Petitioner's challenge based on the combination of Rohall, Schiavone, and Gomes.

Accordingly, Petitioner adequately shows that the combination of Rohall, Schiavone, and Gomes teaches this feature recited in claim 27.

III. CONCLUSION

As explained above, we determine that Petitioner has established a reasonable likelihood of prevailing in its challenge to at least one claim of the '911 patent. Thus, we institute an *inter partes* review of all challenged claims on all asserted grounds.

The factual findings and conclusions of law in this Decision are preliminary and based on the current record. They are made for the sole purpose of determining whether Petitioner meets the threshold for initiating review. Any final decision as to the patentability of the challenged claims will be based on the full record developed during trial, including any response timely filed by Patent Owner. Any arguments not raised by Patent Owner in such a response may be deemed forfeited.

IV. ORDER

It is:

ORDERED that an *inter partes* review is instituted on all challenged claims, i.e., claims 1–13, 15, 18, 20, 21, and 27 of the '911 patent, on all grounds of unpatentability specified in the Petition, as identified in § I.E of this Decision; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '911 patent shall commence

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on the entry date of this Decision, and notice is hereby given of the institution of a trial.

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