

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

Record of Oral Hearing
Held: July 16, 2026

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

APPEARANCES:

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The above-entitled matter came on for hearing Monday, July 16, 2026, commencing at 10:00 a.m., at the U.S. Patent and Trademark Office, 600 Dulany St., Alexandria, Virginia.

P-R-O-C-E-E-D-I-N-G-S

(10:00 a.m.)

JUDGE HOANG: Please be seated. Okay. Good morning. We're convened here for oral arguments in IPR 2025-00270, which pertains to the patentability challenges in U.S. Patent 8,073,911.

So let's get started with some appearances for both parties for those of who will be arguing today. If anyone else is attending in person or remotely with you today but will not be speaking, please identify them, as well. So, for example, please state if your client is attending. Following the hearing, please confer with the court reporter to ensure that there are no questions regarding the spelling of names or terms.

So we'll start with appearances for Petitioner.

MR. EDWARDS: Good morning, Your Honors. I'm Dustin Edwards with Winston & Taylor on behalf of Petitioner, Microsoft Corporation. No one else is attending on behalf of Microsoft.

JUDGE HOANG: Thank you. And Patent Owner?

MR. PADMANABHAN: Morning, Your Honor. Devan Padmanabhan on behalf of Sterling. With me at counsel table is Britta Loftus, also from Padmanabhan & Dawson. And then on the phone are our Sterling reps, Brad Moore, Katie Pflueger, and Paige Marks.

JUDGE HOANG: Thank you. A couple of notes before we begin. First, the court reporter will provide a transcript of the hearing that will become part of the record in the proceeding at a later date. To ensure that the transcript of this hearing is clear, we ask you to please speak directly into the microphone when talking and identify specific slide numbers,

1 numbering, and figures and any other pertinent identifying information when
2 you're referring to your demonstratives.

3 Per the hearing order, each side has 60 minutes of total time to argue
4 your cases. Petitioner will have the opening argument and may reserve
5 rebuttal time. Patent Owner will then respond to Petitioner's arguments and
6 may reserve surrebuttal time. Petitioner may then present its rebuttal,
7 followed by Patent Owner surrebuttal. There're some pending
8 objections and motions to exclude. We've taken those under advisement.
9 You're welcome to use your argument time to address those issues if you'd
10 like, but we won't be making any decisions on those matters during the
11 hearing.

12 And please remember that your argument should be limited only to those
13 arguments previously presented in your briefs. Our decisions will not reflect
14 any arguments not in the briefs.

15 Please make it clear which challenges you are addressing at all times.
16 We ask the parties to hold any objections regarding a party's arguments until
17 it is your time to speak at the podium and to note any objections.

18 All right, I'll maintain the clock, and I'll try to give each party a five-
19 minute warning during their opening argument and a warning near the end
20 of any reserved rebuttal time. Our hearing room has a timer, and I'll set it up
21 for each party with the requested time allotment, but please keep track of
22 your own time, as well.

23 So, for rebuttal time, Petitioner, do you wish to reserve any rebuttal
24 time?

25 MR. EDWARDS: Yes, Judge Hoang, I'd like to reserve 15 minutes
26 rebuttal time.

1 JUDGE HOANG: Fifteen. Okay, Petitioner, you've got 45 minutes
2 on this clock, and you may start whenever you're ready.

3 MR. EDWARDS: Judges, does anybody need a copy of the
4 petitioner's hearing demonstratives?

5 JUDGE HOANG: No, I don't think so. Thank you.

6 MR. EDWARDS: Judge Hagy -- Hagy. Is -- I'm sorry, is it Hagy or
7 Hagy?

8 JUDGE HAGY: Hagy.

9 MR. EDWARDS: Hagy.

10 JUDGE HAGY: Hagy, yes.

11 MR. EDWARDS: Judge Hagy, you have a copy?

12 JUDGE HAGY: And we have the demonstratives.

13 MR. EDWARDS: Okay, great. Thank you.

14 JUDGE HAGY: Yes.

15 JUDGE HOANG: I'm going to pause your timer while you do that.

16 MR. EDWARDS: Thanks. I appreciate it.

17 JUDGE HOANG: Of course.

18 MR. EDWARDS: Okay, I'm ready. So, Your Honors, again, this is
19 Dustin Edwards on behalf of Petitioner, Microsoft Corporation. Let me start
20 by directly diving into the disputed issues in this case.

21 I'd first like to start on Slide 49 with the Rohall, Schiavone, and
22 Rohall, Schiavone, Gomes combinations that are part of grounds one and
23 ground two and the motivation to combine each of those. So moving on to
24 Slide 50, Your Honors. Patent Owner incorrectly asserts that a skilled
25 artisan would not look to combine Rohall and Schiavone because neither
26 references discuss or disclose the problem addressed by the '911 Patent.

1 That's irrelevant of the obvious analysis, Your Honors. As you correctly
2 determined in the institution decision, neither the particular motivation nor
3 the avowed purpose of the patentee controls --

4 JUDGE HOANG: Counsel, I'm sorry to interrupt you. Can you move
5 the microphone a little bit closer?

6 MR. EDWARDS: Sure.

7 JUDGE HOANG: Thank you.

8 MR. EDWARDS: Is that better? As I was saying, Your Honor,
9 neither the particular motivation nor the avowed purpose of the patentee
10 controls; rather, what matters is whether a reference or a combination of
11 references teaches, suggests, or motivates the combination, and that's what
12 exactly we have here with the combination of Rohall and Schiavone. The
13 combination of Rohall and Schiavone allows a person of ordinary skill in the
14 art to arrive at the claimed invention.

15 So the motivation is found in both the prior art references, Rohall and
16 Schiavone. Rohall complains of the problem of managing email volume.
17 That's at Exhibit 1005, at paragraph 6. In order to deal with that problem,
18 Rohall, which is shown here on Slide 50, at paragraph 12, talks about greater
19 integrations of functions to enhance usability and productivity. And it
20 applies certain broad principles in order to implement usability and
21 productivity. Those principles include helping to focus on what's important,
22 number three --

23 JUDGE EASTHOM: Counsel, I'm sorry to interrupt you again.

24 MR. EDWARDS: Sure.

25 JUDGE EASTHOM: Is the button light on, on your mic there or --

26 MR. EDWARDS: It is.

1 JUDGE EASTHOM: Oh, okay. Well, I think Judge Hagy's still
2 having some trouble hearing, but maybe speak up a little bit, I guess.

3 MR. EDWARDS: Yeah, sure.

4 JUDGE EASTHOM: Thanks.

5 MR. EDWARDS: Thank you. You're welcome. So going back to
6 what I was saying, Your Honors, Rohall Exhibit 1005, at paragraph 12, talks
7 about enhancing usability and productivity, and it does those based on
8 certain guiding principles. Those include number 2, helping to focus on
9 what's important; 3, finding the information and people needed for a task or
10 activity; and 4, keeping things moving forward over time.

11 With respect to, for example, number 2, helping to focus on what's
12 important, Rohall, at paragraph 59, of its specification talks about making
13 calls to filter modules. So what that -- and I can actually show you, Your
14 Honors -- if y'all want to go back to Slide 38. If you look at the bottom left
15 on Slide 38, Rohall Exhibit 105, at 59, it talks about creating a shadow
16 document. A shadow document is one in which includes pointers or
17 references to parent documents and children documents. And when the
18 system generates that shadow document, it does what's called parsing. It
19 parses certain data using a parser to a 234, and that includes parsing the
20 original document and any header and other data fields.

21 And then it goes on to say -- is when it -- when it's doing that, so
22 when it's setting up the shadow document and it's constructing all the links
23 between the parent document and all child document sub messages, it says
24 that it also can make calls to filtering software modules as necessary.

25 So putting those disclosures together, Your Honor, those filtering
26 modules help to focus on data with respect to what is important under the

1 guiding principles of Rohall. And Schiavone, going back to Slide 50,
2 Schiavone at Exhibit 1006, at paragraph 1, talks about electronic mail and
3 particularly a method and apparatus for rule-based processing of electronic-
4 mail messages, where, for example, there is automated verification of
5 compliance with privacy, legal, regulatory, and/or best-practices standards.
6 So, Schiavone enhances those guiding principles of Rohall to, for example,
7 help filter based on a variety of different laws and regulations and policies.
8 And so that helps the principles of Rohall to arrive at the claimed invention
9 of the '911 Patent.

10 JUDGE EASTHOM: So you're contending that Rohall specifically
11 discloses filtering each one of those shadow messages?

12 MR. EDWARDS: As part of creating the shadow document, it --
13 when it's constructing the shadow document, it is taking the orig -- it's taking
14 all of the messages that are stored, original submessages, so original parent
15 and all the child documents. And when it constructs the shadow document,
16 it parses out data from those documents. That includes the original
17 document, the content, and other data fields. And when it does that, it,
18 Rohall, discloses that it can also implement filtering modules in order to
19 filter data.

20 JUDGE EASTHOM: Okay. Thank you.

21 MR. EDWARDS: You're welcome. Moving on to Slide 51, Rohall
22 does not teach away from submessages.

23 JUDGE HOANG: Counsel?

24 MR. EDWARDS: Yes.

25 JUDGE HOANG: So, let's assume that there is a motivation to
26 combine Rohall and Schiavone. I want to focus on the combination and

1 meeting the limitations. Can you walk me through how you've combined
2 Rohall and Schiavone to meet limitation 1.6?

3 MR. EDWARDS: Yes, Your Honor. 1.6 is --

4 JUDGE HOANG: Limitation 1.6 is the limitation reciting “wherein
5 different rules of the compliance policy are applicable to different ones of
6 the plurality of sent submessages.” And I think you start your arguments on
7 Slide 61 of your --

8 MR. EDWARDS: Yes, certainly, Your Honor, I can move forward.
9 So as you pointed out, Your Honor, Slide 61 is where we start discussing the
10 disputed issues about rules being applied to submessages and different rules
11 being applied to different submessages.

12 And so moving on to Slide 62, Patent Owner, again, throughout its
13 briefing attacks Schiavone in isolation. Patent Owner ignores the combined
14 teaches of Rohall and Schiavone in the combination. Petitioner specifically
15 relies on Schiavone to disclose the rules and Rohall to disclose the
16 submessages in the Rohall-Schiavone combination.

17 Moving on to 63, this just provides a basic mapping of how Rohall's
18 shadow documents disclose the various components of the claim. This slide
19 maps Rohall's shadow documents and shows they serve as the containers for
20 the conversation thread. They contain child document IDs, which are also
21 notes IDs under Rohall, as pointers to the child document submessages, and
22 they store child document submessages, excuse me, in the notes mail
23 database and organize replies and forwards in that parent-child hierarchy.

24 Moving on to Slide 64, so Rohall's child documents are the functional
25 equivalent or counterpart of sent submessages under the '911 Patent because
26 they are replies or forwards within a conversation thread. Patent Owner's

1 expert conceded that Rohall discloses submessages as part of a conversation
2 thread at Exhibit 1022, 6122 to
3 621. So there's no real dispute that Rohall has submessages within its
4 disclosure.

5 JUDGE HOANG: Counsel, when you say "submessages," you mean
6 the reply email itself, as opposed to -- do you mean the reply email itself, as
7 opposed to the particular pairing of the reply email and who it goes to? So I
8 guess I'm getting to, in your reply, you discussed sender-receiver pairs --

9 MR. EDWARDS: Yes.

10 JUDGE HOANG: -- as submessages, and what I'm trying to figure
11 out is, are you saying the reply email itself is a submessage and then a reply
12 to that is another submessage? Or are you saying that the reply email
13 address, the to and from lines, that itself is a submessage? So, for example,
14 if there was a reply email from user A to users B and C, the email between
15 user A and B is one submessage, and the email between users A and C is a
16 second submessage. Is that what you're saying, or are you saying just the
17 different replies are different submessages?

18 MR. EDWARDS: I still don't understand your distinction, Your
19 Honor. I'm saying that if there's an email from A to B, it has a sender and a
20 recipient, and it has content. That's sub-message 1.

21 JUDGE HOANG: Mm-hmm.

22 MR. EDWARDS: And then you have a reply from B to A. It has a
23 different sender and recipient --

24 JUDGE HOANG: Right.

25 MR. EDWARDS: -- and a different content. That's sub-message 2.

1 JUDGE HOANG: Okay, so you're not trying to say one reply email is
2 somehow, you know, based on the permutations of who's on that chain,
3 multiple different sub-messages?

4 MR. EDWARDS: Well, you could have a conversation thread, Your
5 Honor, where there is original --

6 JUDGE HOANG: Right.

7 MR. EDWARDS: Reply, reply, reply, reply.

8 JUDGE HOANG: Right.

9 MR. EDWARDS: So then you would have multiple submessages
10 within that conversation thread.

11 JUDGE HOANG: Right. I think I understand what you're saying. I
12 was just making sure that what you weren't -- what the reply wasn't trying to
13 assert was that in one email message between one user and multiple users,
14 that somehow the message between the original user and the second user in
15 that same message and then the message between the original user and the
16 other added users were their own submessages.

17 MR. EDWARDS: I see. I see what you're saying.

18 JUDGE HOANG: But that's -- is that your position or no?

19 MR. EDWARDS: So, tell me your hypothetical again.

20 JUDGE HOANG: So, if you have a email from me to you and from
21 me to your opposing Counsel, and it's the same email, that email is itself a
22 submessage, not the email from -- not the addressing of the email from me to
23 you and the addressing of me to your opposing Counsel.

24 MR. EDWARDS: Email from you to me, submessage 1. Email from
25 you to opposing Counsel would be another submessage if they -- not

1 necessarily in this, in -- if you're saying they're in different conversation
2 threads, then the --

3 JUDGE HOANG: No, not in a different conversation. Like, if I
4 wrote an original email, just one email --

5 MR. EDWARDS: Yeah.

6 JUDGE HOANG: -- and it was addressed to both you and your
7 opposing Counsel.

8 MR. EDWARDS: I see.

9 JUDGE HOANG: Are you saying that -- would you -- I just want to
10 make sure what your position is, whether or not the email, even if it's the
11 original email, isn't somehow two different messages because it's addressed
12 from me to you and from me to your opposing Counsel, right? Because
13 you're each getting separate emails.

14 MR. EDWARDS: Yeah. I don't --

15 JUDGE HOANG: I don't think you are. I was just making sure.

16 MR. EDWARDS: I'm not, but I don't see a particular distinction there
17 with respect to what our position is with respect to the claims.

18 JUDGE HOANG: Because I think what I understand is that you're
19 saying that the replies and the replies of those replies, those are the
20 submessages, versus just one email somehow describing both one
21 submessage and a second submessage.

22 MR. EDWARDS: Yeah.

23 JUDGE HOANG: And I guess I'm getting two different submessages,
24 yeah.

1 MR. EDWARDS: We're not arguing -- I'm not -- if your question is
2 whether an email from me and to my co-Counsel contains two sub-
3 messages, that's not our position.

4 JUDGE HOANG: Okay. Yeah.

5 MR. EDWARDS: And we don't deal with that scenario. We're
6 dealing with scenarios where there's an original, a reply to that original, a
7 reply to that reply --

8 JUDGE HOANG: I see.

9 MR. EDWARDS: -- and so on and so forth.

10 JUDGE HOANG: I see. Okay.

11 MR. EDWARDS: Okay. I hope that cleared it up.

12 JUDGE HOANG: No, no, that's what I thought you were saying, and
13 I just wanted to make sure for myself.

14 MR. EDWARDS: Yeah. So I can't remember if we finished 64 or
15 not, so I'll quickly touch base on it. So in Slide 64, essentially, it's showing
16 that Rohall's child documents are the functional counterparts of submessages
17 because they are replies or forwards within a conversation thread. And
18 Patent Owner's expert conceded this point, as you can see and as now I've
19 realized I've already mentioned.

20 So if we go on to 65, it's undisputed, again, that Rohall discloses
21 submessages. Here it shows that Rohall identifies, tracks, and processes all
22 the parts of a conversation thread, describing on the -- describing on the left-
23 hand side at Rohall paragraph 64 that shadow documents in a tree include
24 linking data for the individual nodes, which are the child documents. And if
25 you go to paragraph 62 of Rohall, it explains very clearly that documents are
26 the same thing as nodes.

1 Going on to 66, here is a clip from Dr. Khan admitting that Rohall
2 teaches submessages within a conversation thread. That's Exhibit 1022,
3 61,22 to 62,1. So the submessage architecture is present in Rohall, and as
4 the Board already explained in its institution decision at papers, excuse me,
5 pages 21 through 24, Rohall's criticisms do not discourage applying
6 Schiavone's rules to message components; they merely relate to user
7 difficulty in old email systems in maintaining entire message threads.

8 Moving on to Schiavone, this is a mapping of Schiavone's elements to
9 those of the '911 Patent claims. And so this is where Schiavone contributes
10 its governance module with its compliancy policy applying rules. In the
11 combination, Schiavone's rule-based engine operates on Rohall's
12 submessage-level architecture to yield a governance module that applies
13 different compliance rules to different submessages. And it's undisputed
14 that Schiavone teaches applying rules to messages in general. Patent Owner
15 admits that in its reply at page 1, which is page, excuse me, paper 21.

16 So here you can see that in Slide 68, Schiavone discloses rule-based
17 processing. On the left-hand side at paragraph 7 of Exhibit 1006, it talks
18 about rule-based processing of electronic-mail messages; the rules include
19 logic for processing of incoming messages. If you go down to 16, it says the
20 rules may be implemented for a wide variety of applications, including
21 applicable laws, including a patchwork.

22 So, also, back up, it says they can be -- messages can be automatically
23 processed and consequently filtered or routed based on a patchwork of
24 applicable laws, regulations, and best practices that are applicable to, and
25 this is important, the specific sender, receiver, or content of the email
26 message, and that's at paragraph 16 of 1006. And why that is important is

1 because that's exactly, as you'll see later, what Dr. Khan admits that
2 Schiavone does, and that's also what, at Exhibit 1010, at page 6, that's
3 exactly what Patent Owner asserts is infringing in our infringement
4 contentions with different rules applicable to different submessages. They
5 say identity of the sender and identity of recipients disclose what you refer
6 to, Your Honor, as limitation 1.6.

7 So going back to Slide 62 -- 68 -- I'm sorry. What these disclosures
8 from Schiavone show is that the automatic processing by specific sender,
9 receiver, and content of the message is targeted, not just applicable to an
10 entire conversation thread. When Schiavone's rule-based processing is
11 implemented in Rohall's structure, rules apply to Rohall's submessages
12 within a thread.

13 Moving on to 69, because Schiavone's rule based is content, sender,
14 and recipient based, Schiavone would apply its logic to any defined unit of a
15 conversational thread in Rohall, including its individual submessages.
16 Indeed, so I know the Board's institution decision raised a question about
17 this, but just to make clear, in our papers we clearly argued that different
18 rules would apply to different submessages.

19 In the Petition at paper 1, at page 45, we talked about or explained
20 Schiavone discloses different rules that would be applied to a reply message,
21 compared to the original submessage, because the sender, receiver, and
22 content are different. If you go on to our reply, which is paper 20, at 11
23 through 12, we went on to explain as an example that one law regulation
24 would be applicable to a first sender-receiver pair and a second law or
25 regulation would be applicable to a second sender-receiver pair. In other

1 words, if a reply changes the sender or recipient, Schiavone's sender-receiver
2 rule criteria may change the applicable law or rule.

3 So moving on to Slide 71, if you look at Schiavone paragraph 33, kind
4 of in the top right, that's sort of the COPPA example that was the subject of
5 some debate in the party's papers that discusses applying the particular
6 COPPA rule in two different scenarios. But that's not the only disclosures
7 that we rely on. That's just one example of how a rule would be applied.
8 Other disclosures in Schiavone discuss applying different rules for different
9 submessages because Schiavone's rule applications vary, again, on the
10 specific sender, receiver, and content of the email message. And like I said
11 before, that's exactly how Patent Owner mapped this in their infringement
12 contentions at Exhibit 1010, page 6.

13 JUDGE HOANG: What specifically in Schiavone teaches different
14 rules? I'm not getting to the different submessages, because you're relying
15 on Rohall for that, from what I understand. But what specifically in
16 Schiavone teaches different rules?

17 MR. EDWARDS: So some examples are showed here on Slide 71, at
18 paragraph 29, of Schiavone. It says a sender itself could select several
19 different rule sets to automate their compliance with selected U.S. federal
20 and local laws and regulations and, if desired, varying laws and regulations
21 enacted by the European Union. So, it applies a variety of different methods
22 by which a user can select a patchwork of laws. And that's also repeated
23 again in 16, sort of in a different form, on Slide 71, where it talks about the
24 rules can be automatically processed and consequently filtered or routed
25 based on a patchwork of applicable laws.

1 JUDGE HOANG: And then you go on to say, “because of different
2 sender-receiver pairs.” And when you say “receiver pairs,” what I
3 understand is you meant replies.

4 MR. EDWARDS: Sure. In a conversation thread, the reply, the reply
5 to that reply, and so on and so forth.

6 JUDGE HOANG: And the reason I'm asking that, again, is because
7 paragraph 33, I don't see a reply. I see one email, right? Paragraph 33, the
8 COPPA example, is just the one email from one person to a U.S. person and
9 then a French person.

10 MR. EDWARDS: Yes, exactly. What that is talking about -- I mean,
11 it's just an example of how you can apply a rule to a particular message
12 depending on what the sender and receiver are. But if you apply that in the
13 reply context, then a different rule may be applicable because you've
14 switched the sender-receiver and the content is different. And I'm getting to
15 that. That's what Dr. Khan -- that's what we discussed in Dr. Khan's
16 deposition testimony.

17 So, here at Slide 72, this shows some important testimony from Dr.
18 Khan. What his testimony confirmed was only the sort of the commonsense
19 fact that replies can reverse and change the sender and recipient. So if you
20 look at the top left, at 62:18 to 63:1, he was asked, “In a conversation thread
21 or an email thread, different submessages can have different senders. Do
22 you agree with that?” Answer: “Yes, so they have different senders,
23 correct.” At 63:6 through 12, he was asked, question: “So in an email
24 thread, different submessages can have different recipients. Do you agree
25 with that?” Answer: “Yeah, it can be different recipients, yes.”

1 And then moving on to 67:24 to 68:5 at Exhibit 1022, question is, “If
2 someone were to reply to this message that you referenced in paragraph 151,
3 Patent Owner contends that is the COPPA example we looked at back in 33.
4 So, if with that context, if someone were to reply to this message that you
5 referenced in paragraph 151, that would change who the sender is and that
6 would change who the recipient is. Isn't that right?” “Correct.”

7 Okay. So what Dr. Khan has done here is, he's admitted the basic
8 building blocks for Schiavone, and Schiavone would apply different rules to
9 different Rohall submessages because of different sender-receiver pairs,
10 exactly as Patent Owner argued in their infringement intentions. So we have
11 enough to show that Schiavone discloses different rules applicable to
12 different submessages in its combination with Rohall.

13 JUDGE HOANG: Counsel, do you think your case rests on this
14 deposition of Dr. Khan?

15 MR. EDWARDS: No. I think Dr. Khan only confirmed what I
16 already previously showed you, for example, in Slide 71 with the
17 disclosures. And I'd also like to point out, Your Honor, for Slide 72, this
18 testimony is not subject to Patent Owner's motion to exclude. Only
19 testimony that's in Slide 73 is subject to the motion to exclude. And even
20 there, Dr. Khan went further, and when he was asked at 68:6, at 69:8 --
21 excuse me, 68:6 through 69:8 -- at Exhibit 1022, question: “So there would
22 be different rules that would be applied to that subsequently sent message?”,
23 referring back to the previous example. In case of Schiavone, he answers,
24 “They don't talk about what would happen in that case, what rule would be
25 applied.

1 The role has been reversed here in this case, the sender and the
2 recipient. In that case, there is a possibility that a different rule may be
3 applied.” And then at 69:12 to 77, at Exhibit 1022, he was asked, “So is it
4 your testimony that the reply message in this instance would have different
5 rules applied than the original message? Is that right?” “Correct.” So he
6 confirmed what our theory is beyond the basic building blocks that we've
7 already talked about.

8 So, Your Honor, I'll stop there and see if you have any questions
9 about the rules applied to submessages.

10 JUDGE HOANG: Is your theory on this limitation, limitation 1.6 --
11 and it's what the Petitioner refers to, so that's why I'm using it -- is it that this
12 limitation is just obvious, or is it that the combination just teaches it
13 naturally? Like, is it that, you know, you would make a system that, using
14 these two teachings from these two references, it would be obvious to make
15 this system that features limitation 1.6, or is it somehow that the
16 combination itself is just straight disclosing this limitation?

17 MR. EDWARDS: Well, I guess I think it's both.

18 JUDGE HOANG: Mm-hmm.

19 MR. EDWARDS: I mean, our -- if you look at our paper, our
20 Petition, at pages 5 through 14, that's where we walk through the motivation
21 to combine, and that incorporates Dr. Black's, our expert's, declaration in
22 paragraphs 117 through 127, which is Exhibit 1003. There, it talks
23 specifically about the various reasons for the motivation to combine. And I
24 highlighted some of that reasoning in my very first slide, Slide 50, where,
25 you know, we talk about Rohall's concerns about email management,

1 Rohall's focus on usability and productivity, and those pillars that Rohall
2 would like to implement.

3 And one of those pillars, you know, relates to filtering when the
4 shadow document is constructed. Schiavone also applies filters using its
5 rule-based processing, right? It applies laws, rules, policies to different
6 messages or submessages, and then it either delivers them or rejects them.
7 So it filters them out. So they naturally come together, and Rohall and
8 Schiavone's disclosures motivate a person of ordinary skill in the art to
9 combine those two to arrive at the claimed invention. To the second part
10 of your question, I think -- but I think they -- the two pieces do have to come
11 together, right? Rohall has to disclose the submessages, which it does as
12 part of its shadow documents, and Schiavone discloses the different rule
13 bases that are applicable to sender, receiver, and content of those messages.
14 Judge Hoang, does that answer your question?

15 JUDGE HOANG: Yes, thanks.

16 MR. EDWARDS: Okay, great. Okay, so I'd like to jump back. Let's
17 go back to Slide 54 and talk about the definition --

18 JUDGE EASTHOM: Can we go back? So you, I think I asked you
19 this before, maybe I should ask you a different way, but you're saying Rohall
20 itself will filter different submessages?

21 MR. EDWARDS: Rohall, I can show you. Let's find that disclosure
22 again.

23 JUDGE EASTHOM: And I understand Rohall calls them shadow
24 documents or whatever.

25 MR. EDWARDS: Yeah, so, Your Honor --

26 JUDGE EASTHOM: Slide --

1 MR. EDWARDS: Yeah, so here's -- so if you look at Slide 38, Rohall
2 Exhibit 1005 of 59, this is what I was talking about, and this is in Motivation
3 to Combine section of our demonstratives. And if you don't mind, can I step
4 over here?

5 JUDGE EASTHOM: Sure.

6 MR. EDWARDS: So if you can see here what I was talking about
7 earlier was, it talks about at the top, shadow document generator includes
8 codes, routines, or objects, which upon invocation sets up a shadow
9 document, and then it identifies any parent or child documents of the subject
10 document, and so on and so forth. So, as I was talking about earlier, it sets
11 up the shadow document, determines what are all the components in the
12 email message thread --

13 JUDGE EASTHOM: Oh, I'm sorry.

14 MR. EDWARDS: -- and places them all together.

15 JUDGE EASTHOM: I'm sorry. You probably have to step back to
16 the microphone because of the hearing.

17 MR. EDWARDS: Oh, sorry. No, no worries.

18 JUDGE EASTHOM: Okay.

19 MR. EDWARDS: So, apologize, Judge Hagy. So as you go further,
20 so if you're looking at the highlighted portion, it says, "A similar process is
21 performed by the shadow document generator, 234 mail agent 230,
22 including executing on a Domino server." And then this is where it gets to
23 the part where I was talking about. It says, "Parser 234 includes codes,
24 routines, or objects which upon invocation sets up a shadow document and
25 parses the original document and any header and other data fields." And

1 then it goes on to say “and makes calls to filtering software modules as
2 necessary.” Okay, so that's where it talks about filtering.

3 JUDGE EASTHOM: Okay. Thank you.

4 MR. EDWARDS: You're welcome.

5 JUDGE EASTHOM: So, you're basically saying it can filter based on
6 who the receiver and sender is from those paragraphs?

7 MR. EDWARDS: What I'm saying is, those -- the suggestion that it
8 can wrap in filtering modules at that point provides a motivation because
9 Schiavone also discloses that it can use filtering modules, right? Such as
10 those where we apply different laws or rules to filter emails. And Rohall
11 talks about wanting to increase productivity, wanting to manage email
12 volume, wanting to sort what's important from what's not as important. So,
13 that link provides a motivation to combine Schiavone to Rohall because you
14 can apply those filtering-based rules from Schiavone into Rohall.

15 JUDGE EASTHOM: Based on senders and receivers?

16 MR. EDWARDS: Sure.

17 JUDGE EASTHOM: Right. Okay.

18 JUDGE HOANG: Right. But what I understand is, you're only
19 saying Rohall describes email filtering as a general matter.

20 MR. EDWARDS: Yeah, it --

21 JUDGE HOANG: But Schiavone describes a specific type of email
22 filtering, which is the rules-based one.

23 MR. EDWARDS: That is correct, Your Honor. That is correct.

24 JUDGE EASTHOM: I'm sorry, because I thought paragraph 59 says,
25 “upon invocation, sets up a shadow document and parses the original

1 document and any header of the following data fields: sender, receiver.” So
2 it sounds like it can parse based on sender and receiver.

3 MR. EDWARDS: Sure. It can do that. It does parse that, and I agree
4 with you. But I think the overarching position --

5 JUDGE EASTHOM: Right, it's obvious. Just trying to figure out
6 exactly what Rohall teaches and how much it makes us -- to do. Obviously,
7 it teaches more, might suggest more if it doesn't.

8 MR. EDWARDS: Yeah. So it can parse the document, the content.
9 It can also parse all the data fields, including sender and receiver.

10 JUDGE EASTHOM: Okay.

11 MR. EDWARDS: And then it can apply filtering. It suggests it can
12 apply filtering modules as necessary, which is a motivation to bring in
13 Schiavone.

14 JUDGE EASTHOM: Okay. Okay. Thank you.

15 MR. EDWARDS: So, I want to move on to the claim construction of
16 relational references. I'm going to scoot back here a little bit. So as to the
17 meaning of “relational references,” relational reference should mean what
18 the Board already decided at the institution decision, that relational
19 references mean pointers that point to related messages, as you have already
20 determined. The '911 Patent claims and the specification make that clear.
21 And regardless, Rohall's notes ID, which are also used for child document
22 IDs, meet Patent Owner's narrow claim construction based on Dr. Khan's
23 testimony.

24 So moving on to Slide 56, here are the different claim limitations and
25 the various challenge claims that discuss relational reference. And the
26 relational reference referred to in these claims specifically says that

1 relational reference point to a plurality of sent submessages stored in the
2 message database. Patent Owner's constructions ask you to import terms
3 that are not required by the claims, terms like relational model or relational
4 database or the components of the database, such as tables and keys. If
5 Patent Owner wanted to claim these concepts, then they could have put those
6 terms in the claims, but they chose not to.

7 Moving on to Slide 57, here, if you look at the top left, that is the only
8 portion of the '911 Patent specification that talks about or mentions a
9 relational model. This is at 257 through 62 of Exhibit 101001. And in this
10 particular snippet, the specification at best refers to it in the context of an
11 embodiment with certain characteristics, but it doesn't say what those
12 characteristics are, and it doesn't define what a relational model is. And so,
13 Patent Owner is improperly taking an implementation detail and trying to
14 import that in the claims when there are no -- there is no support in the claim
15 language itself.

16 So, the specification beyond the '461 -- I'm sorry -- going over to the
17 bottom left, you see Exhibit 210 at paragraph 41. This is a snippet from the
18 specification of the '461 application. And in there it indicates that the
19 message, the S mail includes, quote, "a pointer, i.e., a reference to the
20 locations of the current submessage 16." So that is definitional under
21 *Interval Licensing*, 766 F.3d at 1374. Also, the reference to locations in that
22 snippet confirms that relational references do not require a relational model
23 because it's referring to physical storage and memory.

24 Indeed, paragraph 41 goes on to discuss that the submessage with its
25 data fields are stored in database 14. So the fact -- and then if you look at
26 the bottom right, which is Exhibit 1001, 4:59 to 64, that talks about the fact

1 that the message can be thought of as a container with relational references.
2 The container itself does not contain content but, rather, points to
3 submessages and/or attachments in which content resides.

4 So, again, going back to this location issue which is not a relational
5 model. So these disclosures are unambiguous evidence that relational
6 references are not limited to a relational model. So if we go on to the '911
7 Patent specification, some more disclosures here in Slide 58, you will see
8 that here there's no mention of a relational database or the components or
9 tables or keys; rather, the specification describes the message as a container
10 that, quote, "points to submessages which are part of the conversation tree."
11 That's at Exhibit 1001, 4:59 to 64. The specification also explains that that it
12 does this through the use of unique IDs that point to submessages. So you
13 see there at the bottom right at Exhibit 1001, at 5:55 to 60, it says, "Message
14 database associates a unique ID with each message component. These IDs
15 are utilized throughout the messaging system to refer to the components."
16 Adopting Patent Owner's proposal, again, would import an inappropriate
17 relational database implementation that the claims do not recite at the
18 expense of all these embodiments disclosed in the specifications of the '461
19 and '911 Patent.

20 And this is important, Your Honors, at Slide 59. The language that
21 Rohall uses to describe its shadow documents, it uses the same language as
22 in the '461 application describing pointers to submessages or child
23 documents. So if you look at the top right, which we've already seen before,
24 that's Exhibit 210, at 41, it says, "An S mail includes a pointer, i.e., reference
25 to the locations of the current submessage."

1 And if you look at Rohall, at Exhibit 1005 to 57, it says, “Child
2 document IDs in the shadow document may comprise a list of pointers to
3 immediate children documents, whether shadow or original.” If you go over
4 to paragraph 129 of Rohall, it says, again, “Child document IDs may
5 comprise a list of pointers to the immediate children documents, whether
6 shadow or original.” And then it explains, as I mentioned before, in the
7 illustrative embodiment, the value of the child document IDs, maybe the
8 notes IDs values for the document.

9 So, here's testimony from Dr. Khan at Slide 60. And so this shows
10 that Rohall's shadow documents include relational references even under
11 Patent Owner's interpretation. Here, Dr. Khan testified at Exhibit 1022, 43,
12 7 through 15, Question: “Is it your opinion that a relational reference as
13 used in the '911 Patent can be a unique ID?” Answer: “So a unique ID,
14 yes.” Question: “Okay, and unique ID is one example of a relational
15 reference. Is that right?” Answer: “Correct.” And then going on, talking
16 about Rohall, Dr. Khan, at Exhibit 1022, 51, 13 to 16, testified, Question:
17 “Do you agree that the note ID value is a unique identifier in the context of
18 Rohall?” Answer: “Yes.” In the context of Rohall, it is a unique identifier.
19 So, Dr. Khan admitted that a relational reference is a unique ID and that
20 Rohall's notes IDs are unique IDs, providing the link between the '911 Patent
21 and Rohall.

22 JUDGE EASTHOM: So you're not really relying on the plain
23 meaning. You're relying on what you called a definition and also that the
24 claim defines the term itself. Is that a summary of your position or --

25 MR. EDWARDS: In terms of the claim construction?

26 JUDGE EASTHOM: Right.

1 MR. EDWARDS: So, I think if you look at the claim -- if you look at
2 the claim and spec in terms of what "relational" means, plain and ordinary
3 meaning, it's clear that "relational" just means it relates to related
4 submessages under the language of the claim and the specification. If you
5 look at the specification with respect to reference, the '461 patent, which is
6 incorporated by reference in the 911, refers to a pointer, i.e., a reference.
7 That's definitional under the law that I mentioned earlier in my presentation.
8 So those two combinations equal the construction that we propose and the
9 one that you adopted at your institution decision.

10 JUDGE EASTHOM: Right. But Patent Owner's position, your
11 friend's position, is relational reference is a term of art almost, that it has a
12 plain meaning, its own plain meaning when you use them together. Is that
13 fair characterization of their position?

14 MR. EDWARDS: I think that's a fair characterization. I think what
15 you asked them to do at the Institution Decision is say, provide a definition
16 for us. They still haven't done that. They provided a bunch of extrinsic
17 evidence with a whole bunch of different disclosures and components, but
18 they have yet to provide a definition. Their definition is, relational reference
19 should be included in a relational model, very broad, not supported by the
20 specification or the claims.

21 JUDGE EASTHOM: But, and you're --

22 MR. EDWARDS: And it's unclear to what even that would mean.
23 What would relational model mean?

24 JUDGE EASTHOM: Right. Yeah, but your proposal doesn't
25 preclude using this in a relational model, right?

26 MR. EDWARDS: I would say it does, based on all of the disclosures.

1 JUDGE EASTHOM: Oh, it seems to me it's just broader. You're
2 saying it's a pointer, so wouldn't that also read on a relational, with a pointer
3 that's goes to a relational database? In other words, this claim could be
4 practiced with something pointing to those submessages even if, regardless
5 of whether or not, they're in a relational database.

6 MR. EDWARDS: Yeah, but there's no evidence the reference to
7 pointer was in the context of a relational database, Your Honor.

8 JUDGE EASTHOM: Right. I'm not saying it's required; I'm saying it
9 doesn't preclude it. It's broad enough to read. Your construction is broad
10 enough to read on someone practicing this with a relational database.

11 MR. EDWARDS: Well, I --

12 JUDGE EASTHOM: Because all you're asking is that there's a
13 pointer to something.

14 JUDGE HOANG: Counsel, you're into your rebuttal time, and I think
15 Judge Easthom's point is that you could use these relational references
16 recited in the claim in a relational model. He's not saying that you can only
17 use them in it. It's --

18 MR. EDWARDS: No, I understand.

19 JUDGE HOANG: Yeah. Right.

20 MR. EDWARDS: He's saying the definition of relational reference is
21 broad enough to cover a relational model plus our definition.

22 JUDGE EASTHOM: Right. Right.

23 MR. EDWARDS: Right. I understand. Can I mean, I can continue to
24 go. It'll take me a while.

25 JUDGE HOANG: It's up to you.

26 MR. EDWARDS: Yeah, I don't want to --

1 JUDGE HOANG: You're welcome to. Yeah.

2 MR. EDWARDS: How about I address it on rebuttal? Is that okay?

3 JUDGE HOANG: Yeah. All right. I'll give you 15 minutes on your
4 rebuttal even though we're a little bit into it.

5 MR. EDWARDS: Thanks.

6 JUDGE HOANG: Okay. So, Patent Owner, whenever you're ready,
7 I'll start the timer, and let me know if you want any rebuttal time.

8 MR. PADMANABHAN: Yeah, sure. Just give me one second. Give
9 me one second to set up here, Your Honor.

10 JUDGE HOANG: Mm-hmm.

11 MR. PADMANABHAN: Ready, Your Honor.

12 JUDGE HOANG: And did you want some rebuttal time?

13 MR. PADMANABHAN: I'm sorry. Yes, Your Honor.

14 I would like ten minutes, please.

15 JUDGE HOANG: Ten minutes. Okay. Let me set up the clock.
16 Great. You've got 50 minutes. Begin when you're ready.

17 MR. PADMANABHAN: Thank you, Your Honor. May it please the
18 Board, Patent Owner respectfully requests the Board to deny Petitioner's
19 because the two bases it relies upon fail to invalidate any of the claims of the
20 '911 Patent. And really for two fundamental reasons that I'll walk through –
21 actually, three, but one is related. What you'll see, and I think it's true based
22 on Petitioner's presentation, is when you look at Rohall and what Petitioner
23 called in, I think it's Slide S-50, he called it the guiding principles. When
24 you look at Rohall, what Rohall really teaches is a shadow document and
25 treating it as a single entity. And so it's not really acting; it's not teaching
26 acting on that document at a submessage level. And then when you look at

1 Schiavone, again, it teaches application of rules, but, again, not at the
2 submessage level.

3 JUDGE EASTHOM: Why would Rohall break up the messages and
4 have different IDs for each submessage?

5 MR. PADMANABHAN: So the reason that Rohall is doing that,
6 Your Honor, and it comes through in Rohall and it's in our expert's
7 declaration also that we cite to, is Rohall uses a hierarchical database
8 architecture, and so it's not a relational architecture. And a problem that
9 Rohall's system had was that each of the what we're calling submessages,
10 each one was stored separately as a document. And so, for instance,
11 when someone forwarded that document in Rohall, it was a problem because
12 no one knew what was being forwarded. And so you had to have a way to
13 tie it together. And so what Rohall then said is, hey, if you're going to have
14 this kind of a system, let me provide my invention, which is -- and you can
15 see it in paragraph 10, you can see it in this title, you can see it in paragraph
16 13 -- but what you see is somebody taking the different portions of a
17 conversation thread, pulling it together for them. In fact, Rohall goes as far
18 as saying if, say, somebody deleted a portion of a conversation thread, his
19 system somehow still is able to put that thread together. But the key to
20 Rohall is, he pulls it together into what we're calling the shadow -- what he
21 calls the shadow document, and all the actions are then done on that shadow
22 document.

23 JUDGE EASTHOM: I thought each sub -- there was a bunch of
24 shadow documents in each --

25 MR. PADMANABHAN: Nope.

26 JUDGE EASTHOM: So the reply is one? Did I have that wrong?

1 MR. PADMANABHAN: Yeah, I believe that's incorrect, Your
2 Honor. So the shadow document is the entire conversation thread. It is the
3 original message, any other messages, and it becomes the entire
4 conversation thread. And what Rohall is teaching, and you can see it in
5 paragraph 13 very clearly where he talks about, Hey, you've got this single
6 entity. He uses that same phrase in paragraph 10, single entity, and you can
7 do all these actions on it. To make it very clear, at the end of that sentence
8 he even says, you know, the operations are on this data structure. And,
9 again, the data structure is that shadow document.

10 And so, Rohall is going in the opposite direction. It's not -- it starts
11 out with the problem of having each individual, what we're calling each
12 reply, each thing sitting separately, and he's pulling it together for the use in
13 that system. And so when Petitioner relied on the techniques of Rohall,
14 what they're relying on is that shadow document, which is not at the
15 submessage level. It's actually rebuilding that conversation thread. It's got
16 submessages in it, but it's now pulled it all back together in a conversation
17 thread, which then everything acts upon.

18 JUDGE EASTHOM: But you could still address each one separately.
19 As you said, they're stored separately, right? Each submessage is stored
20 separately.

21 MR. PADMANABHAN: But the invention of Rohall and the result
22 of Rohall is that not that each message is not -- it's stored separately, but the
23 invention of Rohall is to pull it all together into this shadow document for
24 further use. And so if that's part of the combination, what you end up in
25 Rohall is a shadow document, and then you have Schiavone, which applies

1 rules to the message -- not to -- there's no teaching of, in Schiavone, of
2 applying rules to submessages.

3 And Gomes also doesn't address submessages, or Gomes doesn't
4 address submessages. And so you have this situation where in Rohall, it's
5 teaching, it's actually going in the other direction. It actually has a system
6 where you have these disparate messages sitting there, pulling it together as
7 a shadow document and then operating on that shadow document. And part
8 of Petitioner's problem is, they need the shadow document to try to show
9 pointers, however we're going to define that in a second, but however we're
10 going to do that to get to the message container, but they need it to go back
11 to the pre-shadow document days of having separate submessages to be able
12 to say, hey, there's a rule that can act on a submessage.

13 And you can't have it both ways because what Rohall teaches, and,
14 again, it's easiest to see just from the title, go to paragraph 10, where at the
15 end of the background section, they kind of say, I'm quoting, I'm
16 paraphrasing slightly, but at the end it said, there's a need to have this be a
17 single entity, the conversation thread. And then look at paragraph 13,
18 where, again, it talks about it all, and it says there are all these operations
19 you can do, but you can do it on the single entity. And that's exactly what
20 they're talking about: operations on the data structure or operations on the
21 single entity. And the single entity there is that conversation thread, the
22 email thread.

23 So with that, let me start -- I was going to address 1.6 to start and then
24 talk about the submessage level generally, and then talk about the relational
25 references, claim construction point, and lastly, talk about the Rohall-
26 Schiavone-Gomes combination. So I want to -- the Board, as you know,

1 addressed this limitation in the institution decision. And what the Board said
2 was, there was a meaningfully different feature in Claim 1 than in Claim 13.
3 And that feature was what is found in Claim 1, which is wherein different
4 rules of the compliance policy are applicable to different ones of the
5 plurality of sent messages.

6 The same limitation is also found in Claims 10 and 27. And I'm
7 going to address 27 in this argument, even though Petitioner does not use the
8 Rohall-Schiavone combination for Claim 27. It solely relies on the Rohall-
9 Schiavone-Gomes combination for Claim 27. But this argument applies
10 equally to that combination. So the only independent claim that doesn't have
11 this language is in Claim 13 and the dependent claims that go with it.

12 So in the institution decision, what you said was, quote, "Although
13 Petitioner cites to and reproduces disclosures in Schiavone regarding the
14 same message being treated differently based on its recipients, on this
15 preliminary record, we are uncertain as to how those disclosures describe,
16 quote, 'different rules that are applied to,' quote, 'different submessages.'"
17 Now, Petitioner's reply at pages 9 to 14 does not even acknowledge the
18 Board's findings on this limitation, let alone point to evidence to overcome
19 them.

20 Now, as you can see from the institution decision, the disclosures that
21 the Board addressed were on Petition pages 44 and 45. So let's take a quick
22 look at those disclosures because there's a lot of what you saw today from
23 Petitioner. The Petition quotes paragraph 33 of Schiavone, and paragraph 33
24 states as follows: "In the example of figure 2, consider that recipient's
25 profile data indicates that the recipient lives in the U.S. and is 45 years of
26 age. Accordingly, it is determined that the recipient's profile data is in

1 compliance, i.e., compatible with the applicable rule in step 32, and the
2 electronic-mail message is delivered to the recipient, e.g., placed in the
3 recipient's electronic inbox and/or displayed to the recipient as shown at step
4 34. The transaction then ends as shown at step 37.

5 For example, the same message sent to a 10-year-old in France could
6 result in a determination of a compliance and delivery of the message
7 because the rule, and in parentheses, COPPA law, is applicable only to
8 residents of the U.S. Compliance with local laws is thereby ensured.”

9 Now, the Board was right to be concerned because the paragraph does
10 not disclose, teach, or suggest applying different rules to different
11 submessages. In this example only one rule is applied, but more
12 importantly, it's to the same message. It's to the one message that you can
13 see that I highlighted in the quote. Now, so this example does not describe
14 applying different rules to different submessages. Petitioner then also relies
15 -- next quotes a portion from paragraph 29 at page 45 of the Petition, and
16 that portion reads, “Consequently, a sender could select several different rule
17 sets to automate their compliance with selected U.S. federal and local laws
18 and regulations and, if desired, varying laws and regulations enacted by the
19 European Union and elsewhere globally.”

20 Again, this sentence does not describe application of rules to
21 messages at all, much less submessages. It simply addresses selection of
22 rules. And so this passage does not describe different rules that are applied
23 to different submessages.

24 JUDGE HOANG: So I get your point that Schiavone doesn't describe
25 different submessages, but Petitioner's been discussing and pointing out that

1 Rohall is what they're relying on for these different submessages and it's the
2 combination that meets this limitation. What's the response to that?

3 MR. PADMANABHAN: So if you look at Rohall, let me do two
4 parts of Rohall. So Petitioner agrees that Rohall doesn't disclose -- this is
5 from Petitioner's expert's declaration -- he says, "Rohall does not expressly
6 disclose these elements, which includes 1.6, 10.6, and even 13.5, applying
7 rules." That's from their Petition. But let me talk about Rohall specifically
8 here. So as I said --

9 JUDGE HOANG: I'm sorry, what slide are we on?

10 MR. PADMANABHAN: I'm sorry. I was about to say it, Slide 18.
11 That's my fault.

12 JUDGE HOANG: No worries.

13 MR. PADMANABHAN: Oh. So if you look at Slide 18, right,
14 Petitioner relies on Rohall for the submessages requirement, but Rohall does
15 not teach handling submessages individually. Rohall teaches handling an
16 email thread as a single entity. And you can start in Rohall -- in this slide,
17 let me just do the sentence from paragraph 13. And I'm --

18 JUDGE EASTHOM: But didn't your expert admit that Rohall has
19 separate messages that could be handled separately?

20 MR. PADMANABHAN: Nope. He didn't admit that it could be
21 handled separately. What he said was, Rohall does have submessages,
22 which is true. Rohall has submessages, but then what Rohall does is, it
23 converts them into a shadow document, which is the entire conversation
24 thread. And so then what Rohall is teaching is --

25 JUDGE EASTHOM: Well, I'm looking at Figure 6D, and it looks
26 like each one of these replies and the message, they're all, each one is a

1 different shadow document. But you're saying -- so, like, for example,
2 Figure 6c shows a reply from Charlie, and that's pointing to a box that says,
3 "Shadow Document 606c."

4 MR. PADMANABHAN: I'm sorry, Your Honor, which --

5 JUDGE EASTHOM: It'd be Figure 6c of Rohall. There's a shadow
6 tree it refers to, and then there's shadow documents in the tree.

7 MR. PADMANABHAN: Right. And so -- but the shadow document
8 is going to be referring to a conversation thread. If it's -- if what I'm saying
9 where you're disagreeing with me is that it's the entire thread and there may
10 be several shadow documents for the conversation thread, that may be true.
11 But what the shadow document does is it takes a conversation and it
12 organizes it in the shadow document, and that is the single entity that is then
13 used to process to -- to do the further processing, whatever the actions are,
14 which is what paragraph 13 says. So --

15 JUDGE EASTHOM: So you agree that --

16 MR. PADMANABHAN: Oh, sorry. Shadow tree is the thread, and
17 shadow document, I apologize, is the submessage.

18 JUDGE EASTHOM: Okay. We agree.

19 MR. PADMANABHAN: Yeah.

20 JUDGE EASTHOM: Thanks. No worries.

21 MR. PADMANABHAN: Sorry.

22 JUDGE EASTHOM: I just wanted to get on the same page, but -- so I
23 thought that was your friend's point, that, well, you have these different
24 shadow documents, and so they're each separately addressable at least. I
25 think you agree to that because they're separately stored.

1 MR. PADMANABHAN: They're separately stored, but what Rohall's
2 entire invention is, is to pull them together into a single conversation thread.

3 JUDGE EASTHOM: I understand that, but that doesn't mean that you
4 can't address them separately, right?

5 MR. PADMANABHAN: Well --

6 JUDGE EASTHOM: I mean, that's just another --

7 MR. PADMANABHAN: I'm sorry to cut you off, and I understand
8 where you're going. I just want to make this clear. So when -- once you say
9 it that way, you're just saying because Rohall has them individually there,
10 regardless of his teaching that he, you know, regardless of his teaching that
11 his whole point is to -- his whole point is to bring it all together, we're going
12 to still read his problem where he had all of these documents separately and
13 say you can still apply rules to those documents is an unfair application of
14 Rohall.

15 JUDGE EASTHOM: Why don't we go to what Petitioner says, and
16 could you address that, please? I think your -- I think his position is that
17 these shadow documents, each one of them in a reply, are separate replies
18 from different people. Rohall talks about applying different filtering
19 techniques, and they could selectively home in on a message from a different
20 sender or a receiver and apply --

21 MR. PADMANABHAN: Yep. So let me go to -- I'm going to come
22 back to Slide 18, but let me go to Slide 28. So, Rohall's message -- entire
23 invention is titled "Method and Apparatus for Handling Conversation
24 Threads as a Single Entity." And so what Petitioner --

25 JUDGE EASTHOM: But that's their invention. So that means what
26 happened before that, they didn't have to do that?

1 MR. PADMANABHAN: Yeah. Before that, and that's the problem
2 they had, before that, you are right that all of those individual components
3 were stored separately in their database.

4 JUDGE EASTHOM: But they still are. They have different IDs.

5 MR. PADMANABHAN: Yep. They're -- they still are, but what the
6 whole invention is, to be able to use Rohall, is the end of Rohall -- is then
7 Rohall constructs and stores the entire message thread or a complete thread
8 tree as a single entity. And that --

9 JUDGE EASTHOM: But how does that defeat the ability to address
10 each one of those submessages?

11 MR. PADMANABHAN: Because the end result of Rohall is that you
12 have -- what it teaches then in paragraph 13 is all of those actions:
13 forwarding, replying, everything is done at that full thread level. And that's
14 what paragraph 13 says. So if you go back to -- and I can just read
15 paragraph 13 from the spec. If you look at paragraph 13 of Rohall, and I'm
16 just going to start at the first line of paragraph 13: "In accordance with the
17 present invention, the electronic-mail conversation thread may be handled or
18 processed as a single entity with functions similar to those typically applied
19 to an individual electronic message." So they're saying --

20 JUDGE EASTHOM: So, it doesn't say must be, it says "it may be,"
21 right?

22 MR. PADMANABHAN: Right. It says "may be," but that's the
23 entire invention is that it's going to handle it as a single entity. Then it says
24 all the different actions it can take: select, drag and copy -- sorry -- drag and
25 drop, copy, paste. It goes on, and when you finish that entire forward, print,

1 move, file, archive, it says, "or operation on the data structure," meaning that
2 thread, representing all ancestor documents in the conversation thread.

3 Again, the operation is not on the individual pieces, but it's on the data
4 structure, and that is what Rohall teaches. Rohall has submessages. No one
5 disputes that it has submessages. But the problem that Rohall is actually
6 dealing with is saying, hey, I don't want submessages sitting in -- I don't
7 know what to do with them because of all the different problems he has,
8 because people can't connect them. And so he goes out of his way to figure
9 out a way to deal with that problem in his hierarchical database.

10 And so what he does is, he creates the tree to be able to have this
11 exact single data structure that has the submessages. And no one says it
12 doesn't have submessages, but Rohall is actually going in the other direction.
13 Rohall is trying to pull it all together into one conversation thread so that
14 you can then say, oh, you can apply, you can do your actions on that thread,
15 which goes exactly opposite of what the claims are saying, which is, hey,
16 you've got a relational data -- I mean, you've got a relational database,
17 whether we agree with that or not. It's a message container with pointers to
18 the submessages, and then you can apply rules to those submessages and, in
19 some instances, different rules to different submessages.

20 And that combination is just not going to be found if you apply Rohall
21 for its teaching, which is, no one disputes that Rohall has these individual
22 pieces sitting there, but where the dispute is between the parties really comes
23 down to whether you're going to hold Rohall to its teaching that, hey, what
24 we're doing is bringing it in as a single entity and then acting on that single
25 entity.

1 JUDGE HOANG: So, Counsel, sorry. Sorry. Petitioner might
2 correct me if I'm wrong about what they're presenting, but they're relying on
3 the structure of original emails, replies, and replies to those replies for the
4 submessages. And even if Rohall is treating that chain, I'll call it a chain or
5 a thread, as a single entity, when you apply multiple rules to that thread, so
6 the original email and the reply, I think what Petitioner is saying is that when
7 you've got this bundle of rules applied to the original message, one set of the
8 rules applies. But then when you go to the reply message, because you've
9 changed the recipients and who's sending it, then different rules will apply.
10 That is what I think Petitioner has said.

11 MR. PADMANABHAN: So --

12 JUDGE HOANG: I could be wrong.

13 MR. PADMANABHAN: And --

14 JUDGE HOANG: You'll correct me if I am.

15 MR. PADMANABHAN: And so, Your Honor, if you -- the problem
16 with this argument really is, unless you're saying I have decoupled so that I
17 can address a submessage with a rule, you're not treating the entire thread.
18 Like, you just take the most recent reply and you apply the rule to that chain.
19 That's -- you're applying the rule to all the messages basically because there
20 is no breaking up. There's no disclosure to say, I'm applying this to the --
21 this rule would apply this way to the first submessage. It would apply
22 differently to the second submessage. There is no such --

23 JUDGE HOANG: Wouldn't -- sorry, sorry to interrupt. Wouldn't it
24 by just the nature of a reply message? So we were talking about the COPPA
25 example where you've got a sender, and I don't remember where the original

1 sender was from. But let's say they were from the U.S., and then they sent a
2 message to another U.S. person and then a French person.

3 And so in that case, you know, COPPA only applied to the recipient.
4 But what if the reverse happened, and then the recipients replied to the
5 original sender? Wouldn't COPPA not apply in certain cases, like if the
6 French person was sending it, replying to the U.S. person, because COPPA
7 doesn't apply there, even though -- so you've got the same rule set, but they
8 are being applied differently in the reply because just the nature of the
9 people are different.

10 MR. PADMANABHAN: So they're being applied differently, and
11 what you're saying there is the result is different, but you're still going to go
12 through and apply the rule that you need to apply. If they say, Here's the
13 rule that you apply to emails, it's going to get applied. The result may be
14 different, but it also, it's not to each individual submessage. It's just to the
15 message, and whether it's the top message that drives that or not, I'm not
16 going to argue, but it's the entire thread that's being treated by the same rule.
17 Whereas, what the claims require is application of the rules to the ability of
18 the -- applying the rules to each submessage, and that's just never in -- I
19 mean, that's certainly not in Schiavone.

20 And even if you do Rohall for submessages, the reason you can't pull
21 Rohall apart and say, well, the submessages still are in the database
22 separately, and so I can still apply rules to each submessage, what Rohall is
23 teaching is the shadow document, and they're using the shadow -- shadow
24 tree, sorry, shadow tree, I apologize, shadow tree. And the reason they're
25 using that thread, and it's important to them to have that structure in Rohall
26 for their invalidity position, is they need it for the pointers. They need it for

1 the message container. But then when they want it to be that they need the
2 rules to apply to each submessage, it's not that Rohall doesn't teach applying
3 rules to each submessage within that -- within the tree when they have the
4 entire conversation. There is no such discussion.

5 And what they're then having to do is say, well, the submessages are
6 there. Why can't we just apply it there? That's now just writing a different
7 invention than what Rohall is. What Rohall did was take submessages that
8 were sitting in the database saying, hey, people can't understand these
9 because you get a forward. You don't know what been forwarded. If people
10 say FYI, you don't know what it is. And so let me help. Let me put this all
11 together, and everybody does an operation on that entire reconstructed tree
12 family, the hi -- the entire message.

13 JUDGE HAGY: Counsel, I have a question. When you said that you
14 are still applying the same rule even though the result is different, so, like,
15 for example, if I have a spam filter on my email, like, I create the little rules
16 in Outlook or whatever, and only some of them get filtered to trash, am I
17 applying the same rule to all the messages in my inbox even though only
18 some of them get caught in the filter and go to trash?

19 MR. PADMANABHAN: I believe so. If I'm understanding your
20 question right, Your Honor, every email that comes through, you're going to
21 have in that example, and I'm assuming what you're saying there is, because
22 I don't think there is in that hypothetical, we're not going to the submessage
23 level. We're basically taking the entire email thread and saying, we'll look at
24 the top email, maybe the most recent one, and then run it through, and either
25 it's going to get delivered or not.

1 What the disclosure's always missing is this ability to then break up
2 that email chain and say, that first email may go through because of the rule.
3 The second email shouldn't go through because of a rule. I mean, the second
4 part of the -- in the thread, say there are three emails. First email passes.
5 Second email doesn't pass. Maybe the third email passes. And you don't
6 have that ability to control at that submessage level by applying rules to the
7 submessages.

8 And so what all -- when they say, hey, the email is going through, it's
9 the whole thread, you're just applying the same rule to all of the messages
10 because you're just, man, maybe you're just looking at the first message to
11 do it, but that's all you're doing is just applying that rule and saying, okay,
12 it's through. And that disclosure of being able to apply rules to the
13 submessage in my, you know, the ancestral messages or submessages --
14 being able to apply rules to the submessages is simply missing. And reading
15 Rohall, we're not disputing Rohall doesn't disclose submessages. What
16 we're saying is, Rohall, the problem Rohall is solving, and you can look at it
17 in paragraph 13, you can look at paragraph 10 also, where he tells you the
18 need. He says, "Accordingly, need exists for a mechanism that allows
19 complete electronic-mail conversation threads to be generated and stored as
20 a single entity."

21 And that's what Rohall is doing. He's re-creating these disparate
22 pieces and saying, Let's put it into a single entity, and then let's act on it as a
23 single entity, which cuts against this entire combination where you say, now
24 I'm going to apply rules at the submessage level. Whether it's different rules
25 at different submessage level or just rules at the submessage level, in either
26 instance, Rohall does not give you submessages to be able to apply rules to,

1 and Schiavone just does not teach applying rules at the submessage level.

2 And Gomes is also not at the submessage level. And so --

3 JUDGE HOANG: How would that function if you didn't apply the
4 rules at a submessage level? Would you just -- I'm struggling to understand
5 how this email thread, even if it's a shadow document that's pointing to
6 shadow or shadow container pointing to shadow documents. I'm struggling
7 to understand why the rules aren't applied at the submessage level when you
8 just have a set of rules and you're applying them to submessages.

9 MR. PADMANABHAN: Because you're not applying them to
10 submessage, Your Honor. So in the -- and I think this is in the background
11 of the '911 Patent. I'm pretty sure it's where it is. So, the problem before
12 this invention, Your Honor, I don't -- and you may be too young to
13 remember this, but there used to be --

14 JUDGE HOANG: Thank you.

15 MR. PADMANABHAN: You're welcome. But it used to be where
16 emails, when you sent an email and there was a response and there's -- it all
17 became one document, and it was stored as one document. And that's why
18 you had this, you know, when they mentioned the storage problem or
19 anything else. And this decoupling of it, and in the finance world where you
20 had compliance and somebody else and somebody else, they needed to have
21 a way to stop something from going across because eight years later,
22 somebody says, oh, that's insider trading because your compliance
23 department told somebody else, blah, blah, blah.

24 And so, they need a way to stop on a thread something that's
25 contained within this conversation thread to not go to somebody. And it's in
26 that context that this invention came to life, which is, hey, we need to give

1 control to apply rules so that the entire conversation thread doesn't go
2 through. And then typically what happened was, it was the lead document,
3 lead email that kind of went through, and then the rest of it just kind of, I say
4 followed the same rule, but they just tested it against that, and then it would
5 go through.

6 You don't see disclosure in these things of saying, hey, apply the rules
7 to each submessage, because it just wasn't -- it's not something that was
8 done. And certainly, Rohall went the other direction because he's actually
9 trying to pull the thread together and teaching do all the actions on that
10 thread. And Schiavone teaches applying rules, but, again, to the message,
11 not to submessages. Gomes teaches deduplication, again, to the message,
12 not to submessages. And the reason is, that's how it was done back then.
13 And this, the part of the real, you know, next step in this world, was
14 breaking it up and then being able to do this, so that you broke it up in a
15 relational database, and then you were able to apply rules to be able to say,
16 hey, I can now control it at the submessage level.

17 JUDGE HOANG: I think I see what you're saying. Can you point me
18 to where the claim prevents in a reply somehow, you know, taking the
19 original message out if a rule applies to that but not the reply message?
20 Because I think that's what your distinction is. It sounds like you're saying
21 that, you know, this invention, if you forwarded a reply email, then because
22 the reply email is actually pointers to the original email and the reply email,
23 you're applying different rules to each of those, and then the reply email
24 wouldn't have -- wouldn't show up, wouldn't include the original email based
25 on a different rule set. But where does the claim say that?

1 MR. PADMANABHAN: So, Your Honor, I believe that, you know,
2 the language that we've all been talking about, which is applying different
3 rules to different submessages, captures that, right? Because --

4 JUDGE HOANG: Sorry, where does it require that, I guess is my
5 point. Because if you're simply just applying a different rule to a different
6 submessage, why doesn't that meet the claim, right? All this other stuff
7 where you're discussing a reply email that then blocks the original email
8 from being forwarded, that's not in the claim.

9 MR. PADMANABHAN: But when you apply -- when you have the
10 ability to apply different rules to different submessages, right? Even just at
11 the submessage level, that's different from saying, I've got the entire email
12 thread, and I have no ability to -- I'm not disclosing in any way applying a
13 rule to the second message down. I mean, I'm just applying the rule and
14 letting this through. You're just not at the submessage level. You're just
15 doing it at the message level. And typically, what the message level means,
16 and this is kind of what Dr. Khan was testifying to, when you send A to B,
17 and B back to A, yeah, they're just taking the top email and running it
18 through for the rule. The rest of it is just one document to them. It's not a
19 separate submessage that's being analyzed separately.

20 And so when we say, hey, you're analyzing at the submessage level,
21 you're already saying you've disconnected the document, which is what that
22 message container is able to do, and then now you're able to apply rules to
23 the second, third ancestor document down. Whereas, nothing -- and that's
24 what the claim is saying when it says apply rules at the submessage level --
25 nothing in Schiavone, certainly Gomes, talks about applying rules at the
26 submessage level. They're just saying message, and they're saying different

1 emails, but no one is saying within the same email thread, I've got -- we've
2 always used three -- I've got three communications that form this email
3 thread.

4 There's no disclosure in any of these saying, hey, here's -- let me apply
5 the rule, and it affects the original email in the thread or it affects the second
6 email in the thread. Everybody's just taking it as really, as one email
7 message, and they're just applying it to that top email. And that's not what
8 the claims require -- so carefully is to say submessages. Patent says
9 submessages are the, you know, the messages of the thread. There is no
10 disclosure within Schiavone to apply rules at that level.

11 And Rohall, while it teaches that there are these messages, and no one
12 disputes that there were these messages, what it's really pulling together is
13 saying, hey, that's a problem for us because no one understands what's
14 happening in some of these contexts and no one has the full understanding of
15 the conversation thread. So let me fix that problem in my hierarchical
16 database and pull it together. And that's very different than what's
17 happening in the invention. And so when the claim says submessages and
18 applying, whether you say rules or different rules, but certainly with
19 different rules, to submessages, that's just not in the art, and it's certainly not
20 in the art that Microsoft is relying on in this IPR.

21 With that, Your Honor, I'm happy to answer more questions, but I'm
22 going to quickly touch on the claim construction issue on relational -- on the
23 relational model. So I'm going to go to Slide 31, or relational references,
24 Your Honor. So the claim language that we're construing is, message
25 database comprising a message container containing relational references

1 pointing to a plurality of sent submessages stored externally to the message
2 container in the message database.

3 Now, what we say that phrase should be construed as is, references in
4 a relational model. Now, just a word on the evidentiary record for this claim
5 construction issue in front of you, Your Honor. Only Patent Owner provides
6 expert testimony on the phrase "relational references." Patent Owner's
7 expert explains hierarchical database models, relational database models,
8 and addresses pointers and provides testimony that pointers in languages like
9 C and C++ cannot be used to connect tables in a relational model. Petitioner
10 does not provide expert testimony to challenge the teachings of Patent
11 Owner's expert, and it's only Petitioner's attorneys who argue what a person
12 of skill in the art would understand the term to be. And, as you know,
13 attorney argument is not evidence and cannot rebut admitted evidence.

14 JUDGE EASTHOM: So this claim requires a relational database?

15 MR. PADMANABHAN: This claim requires a, yes, a relational
16 model, yes.

17 JUDGE EASTHOM: It does? I mean, it doesn't claim a database.

18 MR. PADMANABHAN: It claims a database. It claims a database
19 and specifically says there's a relational reference.

20 JUDGE EASTHOM: There's no database. It just says there's a --
21 there's somewhere where it stores, and there's also a processor, right? First
22 two limitations.

23 MR. PADMANABHAN: I'm sorry. Sorry. It says a message
24 database comprising a message container containing relational references.
25 So it does claim a message database.

1 JUDGE EASTHOM: Okay. You're right. That's right, but it doesn't
2 claim a relational database.

3 MR. PADMANABHAN: It doesn't say specifically relational, but it -
4 - what it describes is using the relational model; it incorporates that, the '461
5 application, specifically for the disclosure of the relational model. But
6 what's key here in terms of the relational model, and I want to address this
7 because it was one of your concerns in the institution decision, is, there's not
8 a description of what the relational model is. And even Petitioner's Counsel
9 also made that point just now. What is unrebutted testimony here is that the
10 relational model is well understood. It's a term that's well understood by
11 those skilled in the art.

12 It is -- this is from Patent Owner's expert at paragraph 104 where he
13 says, "A skilled artisan would understand the meaning of a relational model
14 in the '911 Patent." Entire chapters of textbooks on database systems from
15 the early 2000s are devoted to the relational model. And if you look at the
16 textbook, Your Honor, you know, it's Fundamentals of Database Systems,
17 Third Edition.

18 JUDGE EASTHOM: But you don't claim a relational model.

19 MR. PADMANABHAN: But what we claim is, and it's what, you
20 know, this is claim construction, and you can look at the spec for what
21 relational references should mean. And in this context, where the spec is
22 very clear to say, we use the relational model, a person's understanding of
23 the relational model.

24 JUDGE EASTHOM: That's in the '461, the provisional, right? That's
25 not in the patent.

1 MR. PADMANABHAN: Yep, it's in the -- that patent explicitly
2 incorporates the '461 for this relational model.

3 JUDGE EASTHOM: Right, but the language, the relational model
4 itself, is that --

5 MR. PADMANABHAN: Yep, that's a phrase.

6 (Simultaneous speaking)

7 JUDGE EASTHOM: -- is that in 1000 and --

8 MR. PADMANABHAN: If you look at Slide 33, Your Honor, I'm
9 quoting from the '911 Patent: “In the embodiment of figure 1, the messaging
10 system shares characteristics with the system described in U.S. patent
11 application serial number 10/789,461, which is incorporated by reference
12 herein. As described in that application, the messaging system uses a
13 relational model to represent and store messages exchanged among the end
14 users.”

15 JUDGE HOANG: Counsel, I guess Petitioner made the point that this
16 is a single embodiment, and it's the only time the word “relational model” is
17 used, I guess, in both the spec and the provisional it incorporates. So my
18 concern is taking one embodiment and creating a whole definition from
19 what's very explicitly described as an embodiment.

20 MR. PADMANABHAN: And, Your Honor, the answer to that is
21 twofold. One is it's undisputed in this that the '911 Patent does not describe
22 a hierarchical model. That's point one. So it is -- the relational model is the
23 only model that's being used. But the other point, and I can use Slide 42,
24 and if you look at -- if you look at what, Dr. -- oh, Patent Owner's expert has
25 taught in his declaration, this point becomes clearer. But what he says is,
26 “Recall that in the '911 Patent, each tuple or submessage is assigned a

1 unique ID, which serves as a primary key for that relation.” And then he
2 goes on to quote some stuff about keys and all that. But the main point is,
3 that type of language is for a relational model, and he has language that says
4 that's why he says you can't use C++ to -- the pointers, traditional pointers
5 can't be used to connect tables in a relational model because --

6 JUDGE HOANG: Sorry. Is Unique ID is in bold? Are you saying
7 that the use of a unique ID shows that this has to be a relational model?

8 MR. PADMANABHAN: And only if -- but you have to read it in the
9 context of the patent. And that's one of the things. So, I'll be very clear.
10 Unique ID is a concept in a relational model, but you have to read the, like,
11 when he says “tuples” and “keys,” those are all technical terms that show
12 you it's a relational model, in contrast to unique IDs that may be in a
13 hierarchical model, which is undisputedly what Rohall is, because patent
14 Petitioner does not dispute that.

15 And so, part of what one skilled in the art gets when you're reading
16 the '911 Patent and its embodiments is that it's using the relational model and
17 the words that they're using to describe it, in addition to the incorporation by
18 reference of the '461 application, is that what's being described is the use of
19 the relational model or a relational database. It's not a hierarchical database,
20 and that's what the evidence in the record shows. And it's actually
21 un rebutted evidence in the record. Petitioner has never disputed that the
22 '911 Patent relates to a disclosure of the relational model and has never
23 disputed that Rohall is to a hierarchical model. Those are fundamentals of --
24 and so, a person of ordinary skill in the art would read those in the context of
25 those databases because those are well-known database architectures.

1 JUDGE HOANG: Are you saying that if somebody read the '911
2 Patent, they would only think that that invention could be applied or used
3 with a, you know, would need to use a relational model?

4 MR. PADMANABHAN: Yes. I am saying that, only because of
5 some of the things -- you certainly wouldn't use the type of pointers, and
6 that's why his -- where did I have that? -- Dr., Patent Owner's expert's
7 testimony at paragraph 122, where he specifically talks about, Hey, how you
8 wouldn't use pointers in languages like C and C++ cannot be used to connect
9 tables in a relational model. And he goes on through to say why these are
10 relational references, meaning logical connectors. The reason he's saying
11 that is, you couldn't use those in that embodiment of the '911 Patent. You
12 can't use those type of connectors.

13 JUDGE EASTHOM: But your incorporation by reference, if you go
14 back to your slide, it says on Exhibit 1001, "The messaging system shares
15 characteristics of the system described in the '461 patent, which is
16 incorporated by reference." And it says it's described in that application,
17 "The system uses a relational model." But it doesn't say that's what you're
18 sharing here.

19 MR. PADMANABHAN: I think it's -- I think --

20 JUDGE EASTHOM: It's kind of vague, really.

21 MR. PADMANABHAN: I respectfully would ask you to reconsider
22 that view only because they -- it's so, like, you've seen patents where people
23 just say, we're incorporating something by reference.

24 JUDGE EASTHOM: Well, there's a case. I'll cite it to you now. It's
25 *M&K Holdings Inc. v. Samsung Electronics*. I don't have the -- it's 985 Fed
26 3rd at 1376. And in that case, a similar situation, there was a provisional

1 that described a certain feature; it was a start button. But the patent itself
2 didn't really say that it was using that feature. And the court said the fact
3 that it was described in the provisional and not in the patent means that one
4 of skill in the art would look at that and say that the patent wasn't trying to
5 limit it to that feature.

6 MR. PADMANABHAN: So here, it -- this patent is actually saying --
7 I think a fair read of the first sentence is saying, Hey, the messaging system
8 of figure 1 shares a characteristic with the system that's described in the '461
9 application, and it tells you what that feature is. As described in that
10 application, the messaging system uses a relational model. I think a fair read
11 of that is, what is the shared characteristic is the one that's very specific,
12 which is that it's a system, a messaging system that uses a relational model.
13 And --

14 JUDGE EASTHOM: Yeah, but there's -- and that relational model
15 term also doesn't even appear in the claim, so --

16 MR. PADMANABHAN: But so, when you look at the word
17 “relational,” and this is, again, evidence that we put in, right? Relational is
18 used in this area by people to modify other nouns and to connect it to the
19 relational model.

20 JUDGE EASTHOM: Okay, so what characteristics of a relational
21 model does this claim require?

22 MR. PADMANABHAN: So it requires basically, the ability to have a
23 -- you know, I think the main thing to say about the relational model in this
24 context is that ability to have that decoupled set of submessages using that
25 message container where there are logical references to it, and that's what

1 our expert specifically points out. Those are logical references that the
2 message container uses to reference the submessages.

3 JUDGE EASTHOM: Well, that's just the IDs, what your friend said,
4 right?

5 MR. PADMANABHAN: Well, so that's the difference. When we
6 just say "it's the IDs," that's where we're parting company slightly is, one
7 skilled in the art reading Rohall wouldn't just say "IDs." What they'd
8 understand is that's in the context of a hierarchical model, and those type of
9 physical pointers, what our expert has said is, won't work in a relational
10 model.

11 And here, what they're describing is a relational model. So, one
12 skilled in the art would actually know that you can't have such physical
13 pointers, and that's why he says pointers, as using in programming languages
14 such as C and C++, can't be used here. That's an actual piece of evidence
15 showing you why reading it that broadly is not consistent with what's in the
16 '911 Patent, and one of skill would understand it. And, really, and I'm only
17 saying this because either you're going to agree with our expert or you're not,
18 but there is no contrary piece of evidence for you to look at. It's just simply
19 whether you agree with him or you don't.

20 JUDGE EASTHOM: Well, claim construction isn't necessarily rooted
21 in experts. That's part of our purview, too, and yours.

22 MR. PADMANABHAN: Yeah. And I agree with you 100 percent on
23 that. My only rule that I'm coming back with is to say, when it's a technical
24 term like this and you're looking at ordinary meaning, and the volume of
25 evidence we've cited to you for why one of skill would know what this term,
26 this phrase means, and what it means in this context is undisputed and

1 overwhelming; it's something that's been around since the '70s. It's taught to
2 everybody. It's used in articles. In fact, even that reference of the actual
3 phrase is used in an article from 1998 that we cite. It's exactly in the
4 relational database model. It has to do with tables. It has to do with almost
5 this exact structure and showing you what references, you know, how they're
6 using that term. And we have technical discussions from our expert pointing
7 out why physical pointers can't be used in this architecture.

8 JUDGE HOANG: Counselor, you're almost into rebuttal time here.

9 MR. PADMANABHAN: Okay, I think I'll stop there unless you have
10 other questions.

11 JUDGE HOANG: Nope.

12 JUDGE EASTHOM: No.

13 JUDGE HOANG: Okay. Petitioner, you've got 15 minutes of
14 rebuttal time. And so when you're ready, I'll start the clock.

15 MR. EDWARDS: Thank you, Your Honor. So let's start, since he
16 left off with claim construction, let's start with that. So Patent Owner's
17 Counsel mentioned that we don't dispute that the '911 Patent is a relational
18 model. We do, and we do argue with intrinsic evidence, not extrinsic
19 evidence. And intrinsic evidence, as Judge Easthom rightly pointed out, is
20 the most important evidence for purposes of claim construction. Patent
21 Owner goes all in on a lot of extrinsic evidence, but that doesn't defeat what
22 the specification and the claims clearly show.

23 And as Judge Easthom rightly pointed out in the section of the '911
24 Patent that talks about the '461 application, it describes shared characteristics
25 in one embodiment, and it doesn't define what those characteristics are, and

1 it doesn't say those shared characteristics include a relational model. Okay?
2 That's very important.

3 So I'd also like to talk about Patent Owner's Slide 42, and this is where
4 they put up the testimony or the declaration of their expert at paragraph 20,
5 which cites to Exhibit 1001 at 5:55 to 60. And they use that for the point
6 that in the '911 Patent, each tuple or sub-tuple -- excuse me, strike that. In
7 the '911 Patent, each tuple or submessage is assigned a unique ID. But
8 remember Dr. Khan's previous admission where he admitted that the '911
9 Patent's unique ID is one example of a relational reference, and Rohall's
10 notes ID is a unique identifier. Okay, that's at Exhibit 1022 4:37 to 15 and
11 51:13 to 51:16. So even under Patent Owner's construction that relational
12 reference includes relational model, their expert has conceded that it is met
13 by the prior art.

14 One other thing to point out is that in Slide 42 and other slides of
15 Patent Owner's presentation, if you go back to, I think the other one that he
16 mentioned was Slide 38, when he's talking about these pointers that it's --
17 that those are referencing whenever they're used in a relational model,
18 they're referencing some kind of key or logical relationship, right? But I
19 think one of the critical things I want to point out is that their expert relies on
20 a particular textbook that Patent Owner's council put up. It's Exhibit 2004.
21 And the specific page that he uses to make the point that relational models
22 have a logical key is on page 948. But if you look at that page -- it is in
23 appendix D of that textbook -- that appendix D is talking about hierarchical
24 databases. And so when he says at the -- in the snippet on Slide 33 that a
25 pointer can be, quote, "a physical one containing an address or a logical one
26 containing a key," that's in the textbook section that's talking about a

1 hierarchical database, not a relational one. So, their extrinsic evidence fails
2 for that particular reason.

3 I want to kind of circle back to the discussion about Rohall and
4 submessages. And let me grab my -- Patent Owner said, admitted during his
5 argument, and I think it's clear from the Rohall reference, that submessages
6 are stored individually. There's no dispute about that. The discussion
7 devolved into, well, with shadow documents, you're building a tree that has
8 pointers to where these original submessages are stored and somehow
9 Rohall only permits you to act on an entire conversation thread, as opposed
10 to individual messages that are stored.

11 But if you look at Rohall, Exhibit 1005, which the Board previously
12 pointed out in its institution decision at paragraph 8, the problem that Rohall
13 is addressing is a user problem. It's a problem where users are often carbon-
14 copied, blind-carbon-copied on message that do not make any sense without
15 the entire conversation thread. In other instances, it would be convenient to
16 send an entire conversation thread to a party that has not previously been a
17 recipient of any message in an electronic-mail conversation. Typically,
18 users must locate and act on each message individually.

19 So those are the problems that Rohall is trying to solve. So that's the
20 context you have to read paragraph 13, which Patent Owners spend quite a
21 bit of time on. That the idea that it has to be handled or processed as a single
22 entity relates to user convenience. And all of these things that they're
23 showing here--select, drag, drop, copy, paste, delete, forward, print, move--
24 that focuses on the user. That doesn't focus on that the individual
25 submessages are stored on the back end, and they can be processed
26 individually. That doesn't prohibit that. This is talking about user

1 convenience and user functionality that the user has at a inbox or viewer,
2 which is talked about in paragraph 12.

3 JUDGE EASTHOM: What about your friend's contention that
4 applying a rule like a spam filter or something is just really applying the
5 same rule to different messages even if you get to the different messages?

6 MR. EDWARDS: Well, if you apply one rule to a bunch of
7 messages, you're applying one rule to a bunch of messages, but that's not my
8 --

9 JUDGE EASTHOM: That's not what your --

10 MR. EDWARDS: That's not Petitioner's contention or Dr. Black's
11 contention for the combination. The combination would apply different
12 rules to different messages. So, I'll give you an example. And so -- and I
13 think this goes to your question and also Judge Hoang's question about, you
14 know, if a message had a series of submessages contained within it, that
15 doesn't -- that's not precluded under the different rules to different
16 submessages in claim limitations. And so, for example, in, let's take the
17 example where there's an email from person A to person B, that is
18 submessage 1. The patent says a message that is composed is a submessage
19 at Exhibit 10015, 10 through 13. So an original message from A to B, from
20 me to Judge Hoang, okay? And then rule 1 is applied to that, saying it's --

21 JUDGE EASTHOM: That's a submessage. The original --

22 MR. EDWARDS: As a submessage; that's correct. That's a
23 submessage.

24 JUDGE EASTHOM: Right, right.

25 MR. EDWARDS: That's a submessage. Rule 1 is, rule 1 is applied to
26 submessage 1. Then Judge Hoang replies back to me, okay? Submessage 2;

1 rule 2 is applied to submessage 2. Okay? Rule 2 is a different rule applied
2 to submessage 2. It seems like -- sorry, rule 2 is a different rule applied to
3 submessage 2 than it is to submessage 1.

4 JUDGE EASTHOM: And that's based on your reading of each
5 reference that can address these separate senders? Is that --

6 MR. EDWARDS: Correct. Under Schiavone, it focuses on sender,
7 recipient, and content-specific filtering, automatic filtering. And so, again,
8 in that hypothetical or that example, rule 2 is a different rule applied to
9 submessage 2 than to submessage 1 because it has a different sender,
10 receiver, and/or content. Okay? I think Patent Owner seems to suggest
11 somehow if the submessage 2 also includes the submessage 1, then it falls
12 outside the claim language because it's not being applied to specific
13 submessage 2 only. But that's not what the claim says. The claim says
14 different rules applicable to different submessages. Applicable is very
15 broad, pertains to capable being applied to. So that's not what the claim
16 language says. Also, the claims in all those claims use "comprising," which
17 do not preclude other elements being in there. So even under Patent Owner's
18 interpretation, we meet Schiavone in combination with Rohall meets the
19 claim construction or the appropriate claim limitation. And, Judge Easthom,
20 I think you had an outstanding question for me.

21 JUDGE EASTHOM: No, I think --

22 MR. EDWARDS: Claim question?

23 JUDGE EASTHOM: I think you answered it. I can't remember.

24 MR. EDWARDS: Okay.

25 JUDGE EASTHOM: Oh, right, no, it was, yeah, from last time,
26 right? Go ahead. Sorry.

1 MR. EDWARDS: I think you were positing, if I remember correctly,
2 tell me if I'm wrong, whether or not the construction of a relational
3 references should include the concept of a relational model.

4 JUDGE EASTHOM: Not should include it. I was just wondering if,
5 you know, you're saying that a pointer is -- I mean, the relational reference is
6 basically a pointer. And so my question is, well, why can't that apply even if
7 it does -- even if the system that's using the pointer is a relational database?

8 MR. EDWARDS: Well, because the '461 application defines pointer
9 as a reference.

10 JUDGE EASTHOM: Mm-hmm.

11 MR. EDWARDS: Right? And as you pointed out and I just repeated,
12 in the section of the '911 Patent, it talks about the '461 app. It says it has
13 shared characteristics, but it doesn't say those shared characteristics are the
14 relational model.

15 JUDGE EASTHOM: I think you're misunderstanding my question.
16 I'm sorry. I'm probably not being that clear, but --

17 MR. EDWARDS: Yeah.

18 JUDGE EASTHOM: I guess my point is that I don't think your
19 definition requires a relational database to meet it, but it doesn't preclude
20 somebody practicing the claim under your interpretation that's also using a
21 relational database. In other words, it's still broad enough to be used in a
22 relational database or a hierarchical database. The pointer that you've
23 defined it is broad enough to be used in both systems.

24 MR. EDWARDS: I mean, I'm -- I think the better way to say it, it's
25 agnostic.

26 JUDGE EASTHOM: Agnostic is a good way to say it. Okay.

1 MR. EDWARDS: Yeah. Yeah. I think that's right without conceding
2 that it should be --

3 JUDGE EASTHOM: It's not required. It's --

4 MR. EDWARDS: Correct. There's no requirement that it include
5 relational model. Okay. With that, Your Honors, I appreciate it --
6 appreciate the opportunity. Thank you very much.

7 JUDGE HOANG: Okay.

8 JUDGE EASTHOM: Thank you.

9 JUDGE HOANG: Thank you. And, Counsel for Patent Owner, you
10 have ten minutes. Whenever you're ready, I'll start the clock.

11 MR. PADMANABHAN: Thank you, Your Honor. Your Honor, I
12 think I'm going to start with -- Petitioner in this argument has not disputed
13 that Rohall is a hierarchical database, and that's an important point because
14 when he's pointing to, and I think it's in Slide 59 or Slide 60 of their slides,
15 when they asked Patent Owner's expert about the unique identifier in Rohall,
16 what Patent Owner's expert said was, "In the context of Rohall, it's a unique
17 identifier." And the reason I keep bringing up this context is, the only expert
18 testimony on this point is from Patent Owner's expert, and Patent Owner's
19 expert's the only one that's addressed hierarchical databases versus relational
20 databases.

21 JUDGE HOANG: I might be mistaken, Counsel, but didn't
22 Petitioner's Counsel point out that Patent Owner's declarant relied on a
23 definition which included -- which was under hierarchical model?

24 MR. PADMANABHAN: And I was going to get to that, Your Honor,
25 so let me address that now. So that is one I'm not able to address right away
26 because that's a brand-new argument. They've never made that argument.

1 So I'd have to look at Appendix D and kind of really dig into it to give you a
2 real answer.

3 JUDGE HOANG: Okay.

4 MR. PADMANABHAN: And so I'm just not prepared on that one.

5 JUDGE HOANG: Understood.

6 MR. PADMANABHAN: And I apologize, but I --

7 JUDGE HOANG: No, understood.

8 MR. PADMANABHAN: It's just not coming to mind. But if you
9 read Patent Owner's expert's declaration, the parts that we cite -- I'm not
10 asking for a full read, Patent Owner's expert -- you will see that this concept
11 of keys and tables and how it's done in the relational model is unique to the
12 relational model. In fact, that's what the textbook teaches in those concepts.
13 It's not -- this is not something where it just runs across to the hierarchical
14 model. In fact, it's one of the powers of the relational model.

15 If you read the 1998 article that we cite where they use the actual
16 claimed phrase "relational references," you can see that what they say is, the
17 power of the relational model is these tables and the way you're able to be
18 able to use them in database management. And so, I'd be surprised if what
19 he's saying is true, but I also can't immediately refute it with something
20 specific from Appendix D.

21 JUDGE HOANG: Understood.

22 MR. PADMANABHAN: Okay. Also, the argument that Petitioner's
23 Counsel just made on the problem in Rohall, and I'm going to address it
24 regardless, but that's also a new argument in terms of saying it's user
25 convenience and that somehow changes the analysis on Rohall. That's also
26 not something that's specifically addressed, but let me point this out. Rohall,

1 however you do the tree, what they're coming down to is, pulling that thread
2 together, and that's the data structure on which operations are done.

3 And so, what Rohall teaches is not anything to do with somehow
4 preserving that submessage and then everybody -- what they're pulling the
5 submessages together. I'm not disputing with you that the submessages
6 themselves exist in the database. But what I am saying is, fairly read, what
7 Rohall teaches, and you can see it in paragraph 10 and 13 the easiest and the
8 title, because they're pulling it into a single entity, and its operations are
9 done on that single entity. And so then if you apply rules, you apply it to
10 that single entity, which is different from applying rules to a submessage.

11 The other thing that I want to then jump to is his example of A to B
12 being one message, and then you get -- and you call that a submessage. I
13 want to be a little careful about this language. If you read the spec, when
14 submessages really start to come in is when you have an email thread so that
15 you have a set of messages. It's not -- if you just send the one message,
16 that's just a message. That is not necessarily a -- because what that -- what
17 the claim says is a plurality for them, a plurality of messages in for the
18 message container, but I'm not even going that far. Just the context of this
19 is, you have an email thread, and we're using three. You're able to address
20 the original message or the second message or the current message, and each
21 of those is a submessage.

22 The whole thing is a message. That's what they -- that's how they
23 kind of describe it with regard to figure 2 in column 5 in the '911 Patent. So,
24 when he just gets up and says, Well, the first message was sent. Some rule
25 was applied. Second message was sent. That was applied to the second one;
26 that's a submessage. Note the second one, if it's the thread, what -- the

1 reason it's not applying at the submessage level is, now that's a whole
2 document where they're only applying it based off of the first email. But it's
3 not -- there's no ability and no disclosure to then apply that rule to the first
4 message that caused the reply.

5 JUDGE EASTHOM: But at the bottom, aren't you just arguing these
6 references separately? For example, if you go to Figure 5B of Rohall, it's
7 got the table that says you can access a root document; you can access the
8 child documents. And I get your point: You're going to put them all
9 together in one thread, but you can still access each of these documents, each
10 one of -- each level of the tree, separately. And you just said that that's not -
11 - you're not able to do that, but you are able to do that in Rohall.

12 MR. PADMANABHAN: But they're doing that just to create the
13 document.

14 JUDGE EASTHOM: They may have a different reason for doing it.
15 That's probably not in dispute. They have one good reason for doing it, to
16 string them all together, but that's not their case. Their case is that it would
17 be obvious to access each one separately and apply different rules so that
18 you would have better filtering.

19 MR. PADMANABHAN: But at that point, Your Honor, and I'm
20 saying this very respectfully but firmly, is what you're then doing is saying,
21 Hey, I'm going to use Rohall and what they're doing it for, which is the tree,
22 when I need to have analysis of the message container because I need
23 pointers. And then, separately, when I need to apply rules, there's no
24 disclosure in Rohall to be able to apply rules to anything other than the full
25 thread. But there, because it's an individual thing, somebody skilled can

1 then automatically start applying it to the individual pieces, and I think that's
2 an unfair read of Rohall. Unfair use of Rohall, I should say.

3 JUDGE EASTHOM: And I think that's just an example of, you
4 know, separating the teachings, isolating the teachings, because they're not
5 relying on Rohall to apply to separate messages. They're -- but, you know,
6 your first point was that you're not even able to do that. I thought you said
7 you couldn't address these different submessages in Rohall, that there's no
8 capability for that. But Rohall itself said there's a capability for that.

9 MR. PADMANABHAN: I think what I said about Rohall, and it's
10 true about Rohall, is the submessages exist, but what Rohall teaches is, for
11 you to pull it together into a thread and then do all the actions on that thread.

12 JUDGE EASTHOM: But you don't dispute that they're each
13 separately addressable, right? Each sub-message in Rohall?

14 MR. PADMANABHAN: And I don't know. When you say
15 "separately addressable" --

16 JUDGE EASTHOM: Separately accessible, you can get them out of
17 the database.

18 (Simultaneous speaking.)

19 MR. PADMANABHAN: I suppose you can get each one out of the
20 database, but that is very different than being able to call them all
21 submessages in a thread and being able to apply rules separately to each one.
22 Where here it's --

23 JUDGE EASTHOM: Right. Here it's what relies on the other
24 reference for.

25 MR. PADMANABHAN: But the other one does not teach it at that
26 submessage level. It just applies rules.

1 JUDGE HOANG: So, if I -- sorry -- if I have a set of rules, let's say
2 rules 1, 2, and 3, and then I've got this conversation thread, same users, how
3 is that not -- and in the original message, certain rules apply, and then in the
4 reply message, those rules don't apply anymore. And that's what I'm getting
5 at. And we were talking about the COPPA example, and that's why I was
6 kind of discussing what happens when the French person replies, because
7 then COPPA doesn't apply in the reply message. So that's the submessage
8 where that COPPA rule didn't apply to the submessage, but it did apply to
9 the original message because it was a U.S. sender, right? So how is that not
10 a different rule being applied to a different submessage?

11 MR. PADMANABHAN: Because when we say apply to a
12 submessage and it's got to be -- it's got to be fair. You're not -- when you're
13 applying it on the reply back, you're only saying, I'm applying it to the most
14 current email. There's no application of a rule other than that same rule. I
15 mean, they're not -- you're not splitting them up and saying, okay, now I'm
16 applying another rule to another -- this submessage. It's just treating the
17 entire document as one document. So the original email goes through, and
18 what's being tested is the first email, the most current email. And so, it's just
19 one document really; you're just applying the rule based on whatever the
20 current sender and recipient are.

21 And so, what the claims require is, those are two different
22 submessages in a message, and you have to have the ability to selectively, in
23 claim 13, selectively apply a rule to each of those submessages or be able to
24 apply different rules to different submessages. In the hypothetical where
25 somebody's responded in the COPPA example, there is no disclosure of
26 looking at that first message and doing anything to it. It's just taking the

1 most current email and saying, Okay, I've now tested that new document
2 really against this rule.

3 And so, what the claims are requiring is much more granular in that
4 once you have, whether you've used two emails or three emails, once you
5 have a message with three submessages in it, you've got to be able to have
6 the ability to apply the rule to each submessage that make up the -- each of
7 the three submessages that make up the message, and that just simply is not
8 there. Thank you.

9 JUDGE HOANG: All right. Thank you.

10 JUDGE EASTHOM: Okay. Well, thank you all for appearing today
11 and answering our questions. We will take this case under advisement, and
12 we'll issue our decision in due course.

13 MR. EDWARDS: Thank you.

14 (Whereupon, the above-entitled matter went off the record at 12:07
15 p.m.)

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