

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION,
Petitioner,

v.

STERLING COMPUTERS CORPORATION,
Patent Owner.

IPR2025-00270
Patent 8,073,911 B2

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

HOANG, *Administrative Patent Judge.*

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
Dismissing Patent Owner's Motion to Exclude
35 U.S.C. § 318(a)

I. INTRODUCTION

On September 23, 2025, we instituted an *inter partes* review of claims 1–13, 15, 18, 20, 21, and 27 (“the challenged claims”) of U.S. Patent No. 8,073,911 B2 (Ex. 1001, “the ’911 Patent”). Paper 12 (“Inst. Dec.”). Having considered the full record at trial, and for the reasons explained below, we determine that Petitioner has shown by a preponderance of the evidence that all challenged claims are unpatentable. In addition, we dismiss Patent Owner’s Motion to Exclude (Paper 29).

A. History of this Proceeding

On January 17, 2025, Microsoft Corporation (“Petitioner”) filed a petition requesting an *inter partes* review of the challenged claims of the ’911 Patent. Paper 1 (“Pet.”). Sterling Computers Corporation (“Patent Owner”) timely filed a Preliminary Response (Paper 9), Petitioner filed an authorized pre-institution reply (Paper 10), and Patent Owner filed an authorized pre-institution sur-reply (Paper 11). Based on the preliminary record, we determined that Petitioner demonstrated a reasonable likelihood that it would prevail in establishing the unpatentability of at least one challenged claim, and we instituted an *inter partes* review of all challenged claims on all asserted grounds. Inst. Dec. 31.

After institution, Patent Owner filed a Response (Paper 14, “Response” or “PO Resp.”), Petitioner filed a Reply (Paper 20, “Reply” or “Pet. Reply”), and Patent Owner filed a Sur-reply (Paper 21, “Sur-reply” or “PO Sur-reply”). An oral hearing in this proceeding was held on July 16, 2026, and a transcript of the hearing is included in the record. Paper 39 (“Tr.”).

During trial, Patent Owner filed a Motion to Exclude certain testimonial evidence (Paper 29), Petitioner opposed (Paper 33), and Patent Owner filed a reply (Paper 34). For the reasons explained below in § III, we dismiss Patent Owner’s Motion to Exclude as moot.

B. Related Matters

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

C. Asserted References

Petitioner’s unpatentability challenges rely on three references:

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

D. Testimonial Evidence

Petitioner, prior to institution, submitted a declaration from Dr. John Black, Jr. Ex. 1003. During trial, Petitioner submitted deposition transcripts of Dr. Latifur Khan. Ex. 1022.

Patent Owner, prior to institution, submitted a declaration from Dr. Latifur Khan. Ex. 2002. Patent Owner, following institution, submitted another declaration from Dr. Latifur Khan. Ex. 2005.

E. The Petition's Asserted Grounds

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

Claims Challenged	35 U.S.C. ¹ §	References/Basis
1–8, 10–13, 15, 18, 20, 21	103(a)	Rohall, Schiavone
9, 27	103(a)	Rohall, Schiavone, Gomes

F. The '911 Patent (Ex. 1001)

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

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

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

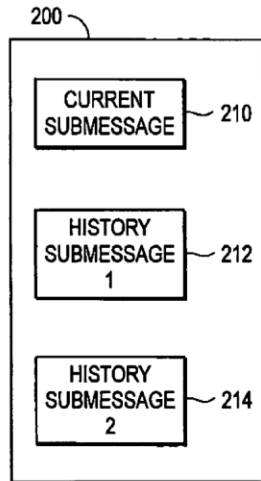


FIG. 2

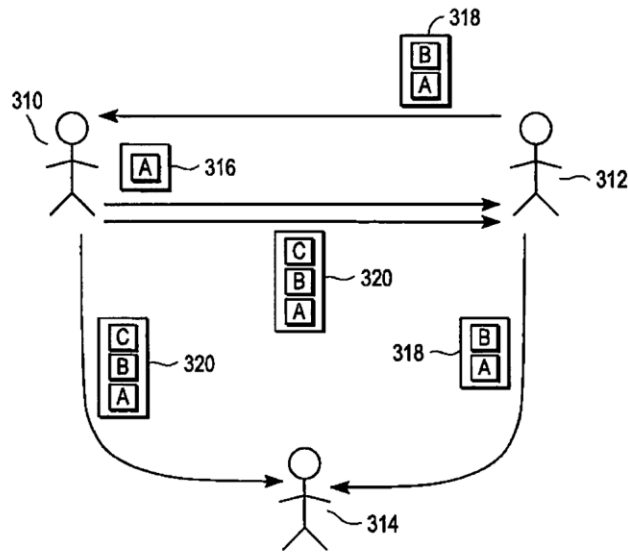


FIG. 3

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

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

Id. at 5:31–42.

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

G. Challenged Claims

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

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

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

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

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

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

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

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

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

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

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

Ex. 1001, 15:51–16:14; Pet. 80.

II. ANALYSIS

A. Legal Standards

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

shifts to the patent owner. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

The legal question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness.² *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). One seeking to establish obviousness based on more than one reference must articulate sufficient reasoning with rational underpinnings to combine teachings. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)).

B. Level of Ordinary Skill in the Art

Petitioner asserts a person of ordinary skill in the art (“POSITA”) in May 2004 would have had a working knowledge of the telecommunications and networking art that is pertinent to the [’911 Patent]. A POSITA would have had a bachelor’s degree in electrical engineering, computer science, computer engineering, or an equivalent, and two years of relevant experience involving computer science fundamentals, including pointers, data structures, object-oriented programming, database principles, internet-based communication technologies and electronic mail systems that is pertinent to the [’911 Patent].

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

Lack of professional experience can be remedied by additional education, and vice versa

Pet. 3 (citing Ex. 1003 ¶ 22).

Our Institution Decision adopted Petitioner’s definition of a person of ordinary skill in the art. Inst. Dec. 9–10. In its Response, Patent Owner adopts Petitioner’s proposed level of ordinary skill. *See* PO Resp. 16 (“Patent Owner and its expert adopt the Board’s definition for purposes of this Response.”).

Having considered the record, we continue to adopt Petitioner’s proposed level of skill, as articulated above. We are satisfied that Petitioner’s proposal comports with the level of skill necessary to understand and implement the teachings of the ’911 Patent. *Accord* Inst. Dec. 9–10.

C. Claim Construction

We interpret claim terms using “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b).” 37 C.F.R. § 42.100(b). Under the principles set forth by the Federal Circuit, the “words of a claim ‘are generally given their ordinary and customary meaning,’” as would be understood by a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

We address the construction of the disputed term “relational references,” recited in all the challenged claims. PO Resp. 17–25; Pet. Reply 2–8; PO Sur-reply 9–19. Patent Owner asserts “relational references” should be construed to mean “references in a relational model,” i.e., that the term requires a relational model. PO Resp. 17 (citing Ex. 2005

¶¶ 103–124), 25. Petitioner asserts “relational references” do not require a relational model and more broadly include pointers that point to related messages. Pet. Reply 3.

We agree with Petitioner and determine that the construction of “relational references” does not require the use of a relational model and, further, includes pointers that point to related messages exchanged among users. The intrinsic evidence leads us to this construction.

First, the relevant language of claim 1 recites “a message container containing relational references pointing to a plurality of sent submessages stored externally to the message container in the message database.” Ex. 1001, 15:56–59. A relational model is not recited in that language or anywhere else in the claim. *See id.* at 15:51–16:14. Therefore, the claim does not expressly require a relational model. Furthermore, the claim language supports Petitioner’s interpretation that “relational references” include pointers that point to related messages because the claim states that the “relational references” perform the task of “*pointing to a plurality of sent submessages.*” Pet. Reply 7. Accordingly, the language of the claim supports a construction that does not require a relational model and at least suggests relational references include pointers.

Next, we turn to the Specification, which also supports Petitioner’s construction over Patent Owner’s. The Specification does not state that “relational references” require the use of, or are, a relational model. Patent Owner has not identified, nor do we readily find, an express definition in the Specification stating that the term “relational reference” requires the use of a relational model. Rather, any discussion of “relational references” in the Specification describes them as message components that refer to content or other data. *E.g.*, Ex. 1001, 3:6–16 (“a message is a container having

relational references to content and/or audit data”); *see also id.* at 1:67–2:2, 4:61–64, code (57). Further, Petitioner’s construction that those references are “relational” by “point[ing] to related messages exchanged among users” is supported by the Specification. Pet. Reply 7. In particular, the Specification states that a “message can be thought of as a container with relational references. The container itself does not contain content, but rather points to submessages.” Ex. 1001, 3:6–16, 4:61–64. Those submessages are related to emails sent, replied to, or forwarded between users. *Id.* at 1:67–2:2, 3:6–16; *see also* Ex. 2010 ¶¶ 38–39. Furthermore, patent application number 10/789,461 (“the ’461 Application”), which the ’911 Patent incorporates by reference, expressly states a pointer is a “reference,” corresponding to Petitioner’s proposed construction. Ex. 2010 ¶ 41 (“[A]n S-Mail includes a pointer (i.e., a reference) to the locations of the current submessage 16, along with pointers to any history submessages.”).

While Patent Owner points out that, in one instance, the Specification states “the messaging system **uses a relational model**,” as described in the referenced ’461 Application (PO Resp. 17–18 (citing Ex. 1001, 2:57–60)), that single embodiment does not serve to read a relational model into the claim. The cited portion does not discuss or define, “relational references,” let alone explain that relational references require a relational model (and the referenced ’461 Application does not use the term “relational reference” at all). *See* Ex. 1001, 2:57–60. Instead, that discussion expressly states a relational model is used in “the *embodiment* of Fig. 1.” *Id.* (emphasis added). It would be a mistake to use one embodiment to limit the term “relational references” and read an unrecited relational model into the claims. *See In re Am. Acad. Of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed.

Cir. 2004) (“We have cautioned against reading limitations into a claim from the preferred embodiment described in the specification, even if it is the only embodiment described, absent clear disclaimer in the specification.”).

Patent Owner also argues that a relational model is necessarily used because “[i]n the ’911 Patent, each tuple or submessage is assigned a **unique ID**, which serves as the primary key for that relation,” and “the ’461 Application discusses tables in a relational data base.” PO Resp. 19 (citing Ex. 2005 ¶¶ 30, 112–112, 120; Ex. 1001, 5:55–60; Ex. 2010 ¶ 21). First, Patent Owner has not presented adequate evidence and explanation showing the use of a unique ID that serves as the primary key or the use of a table means that a relational model *must* be used. *See id.* But, even if the use of a unique ID or a table did require the use of a relational model, the claim does not recite, and so does not require, a unique ID serving as a primary key or a table. *See* Ex. 1001, 15:51–16:14. Without a unique ID or table to link to a relational model, Patent Owner’s argument fails. Even further, as before, Patent Owner relies on selected embodiments, rather than definitions, to inappropriately read features into the claim. Ex. 1001, 5:44–53. *See In re Am. Acad. of Sci.*, 367 F.3d 1369.

Patent Owner also argues that the ’461 Application uses the term “‘relational’ . . . repeatedly to modify nouns when using a relational model” and, so, “when the word ‘relational’ is used before a noun in the ’911 Patent (or ’461 Application), a skilled artisan would understand ‘relational’ to refer to use of a relational model.” PO Resp. 18–19 (citing Ex. 2010 ¶¶ 17, 18, 21, 44; Ex. 2005 ¶ 111). It is natural that the term “relational” appears repeatedly in the ’461 Application’s description of a “messaging system [that] uses a relational model” (Ex. 2010, code (57)), but that expected use of the term “relational” in the ’461 Application does not show that we

should interpret the adjective “relational” to mean a “relational model” in the ’911 Patent. Moreover, neither the ’461 Application nor the ’911 Patent provide a definition of the adjective “relational” that requires a “relational model.”

We also disagree with Patent Owner and Dr. Khan that “relational references” do not include “pointers.” PO Resp. 23–2; Ex. 2005 ¶¶ 119–124). Patent Owner and Dr. Khan allege that “traditional programming-language ‘pointers’ are not an appropriate mechanism for linking a container with its sub-messages stored in a database.” PO Resp. 23–24; Ex. 2005 ¶¶ 119–124. First, that allegation is based on features the claim does not recite or require, e.g., “tables [that] are linked via shared attribute values,” and the use of “languages like C/C++.” Ex. 2005 ¶¶ 121–122. As such, the claim is not limited to the type of traditional programming language pointers Patent Owner’s arguments rely on.

Moreover, Patent Owner’s allegation contradicts the incorporated ’461 Application. The ’461 Application states that “an S-Mail includes a pointer (i.e., a reference) to the locations of the current submessage 16, along with pointers to any history submessages” (Ex. 2010 ¶ 41), expressly stating that a pointer is a reference and can be used. While Patent Owner and Dr. Khan assert that the “pointer” described in the ’461 Application is specific to a relational model excluding hierarchical models because it is a logical pointer (PO Resp. 12, 17; Ex. 2005 ¶ 52), the specific evidence cited by Dr. Khan for that proposition (Exhibit 2004, bates page number 31 (reference page number 948)), is described in regards to a *hierarchical model*, not a relational model (*see* Ex. 2004, 24 (Appendix D titled “An Overview of the Hierarchical Data Model”)). As such, a claim construction that excludes pointers from the meaning of “reference” contradicts the

express definition of a reference, or at least inappropriately excludes an embodiment. *See Vitronics*, 90 F.3d 1583 (noting that a claim interpretation which excludes a preferred embodiment “is rarely, if ever, correct”). And, even if the reference is “relational,” as discussed above, the modifier “relational” does not require the use of a relational model.

Accordingly, the intrinsic evidence does not support narrowing the construction of “relational references” to require a relational model but, instead, supports Petitioner’s construction which includes pointers that point to related messages. As the meaning of “relational reference” is “clear from the intrinsic evidence here, there is no reason to resort to extrinsic evidence.” *See Seabed Geosolutions (US) Inc. v. Magseis FF LLC*, 8 F.4th 1285, 1287 (Fed. Cir. 2021); *Phillips*, 415 F.3d 1317 (“[W]hile extrinsic evidence ‘can shed useful light on the relevant art,’ we have explained that it is ‘less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’”). However, as Patent Owner has offered extrinsic evidence in support of its position (*see* PO Resp. 19–23 (citing Exs. 2004–2009, 2011); PO Sur-reply 10–12), for completeness, we further explain why Patent Owner’s cited extrinsic evidence does not outweigh Petitioner’s showing on the intrinsic evidence or otherwise show that a skilled artisan would have understood “relational references” to refer to references in a relational model.

Much of Patent Owner’s cited extrinsic evidence is of limited value because it does not squarely discuss the complete term “relational references” and, instead, relies on derivations of the words “relational” and “reference” used in proximity. *See e.g.*, PO Resp. 21–23 (citing and emphasizing Ex. 2004, 206–207 (“A set of attributes FK in **relation** schema R1 is a foreign key of R1 that **references relation** R₂ . . . tributes FK are

said to **reference** or **refer** to the **relation** R_2 . . . the **referencing relation** and R_2 is the **referenced relation**)); PO Sur-reply 12 (emphasizing “**referencing relations**” and “**referenced relations**”). In any case, at best, the cited extrinsic evidence shows that relational models use relational references. *See, e.g.*, Ex. 2004, 18 (“The relational model represents the database as a collection of relations.”); Ex. 2006, 3 (“The relational database model uses a series of references”); Ex. 2007 (“[A] relational database which constitutes a reference database.”). But, even if relational models use relational references, it does not follow that a relational reference therefore requires, or is exclusive to, a relational model. Like the intrinsic evidence, the extrinsic evidence does not provide a definition, or otherwise show, that a “relational reference” necessarily requires the use of a relational model. Therefore, we disagree with Patent Owner that the extrinsic evidence shows a skilled artisan would understand that a “relational reference” refers to a relational model.

Accordingly, based on the claim language and Specification and even considering the extrinsic evidence, we determine that the construction of “relational references” does not require a relational model and, further, includes pointers that point to related messages.

No other claim terms need construction for our decision here and we decline unnecessarily doing so. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

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

Petitioner contends that the subject matter of claims 1–8, 10–13, 15, 18, 20, and 21 would have been obvious over the combination of Rohall and Schiavone. Pet. 2, 5–66. Patent Owner argues that Petitioner has not shown that the combination meets certain limitations recited in the independent claims. PO Resp. 31–44. Patent Owner further argues that a skilled artisan would not have combined Rohall and Schiavone. *Id.* at 45–54.

We conclude that the respectively challenged claims would have been obvious over the combination of Rohall and Schiavone. We provide our analysis below.

1. Summary of Rohall (Ex. 1005)

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

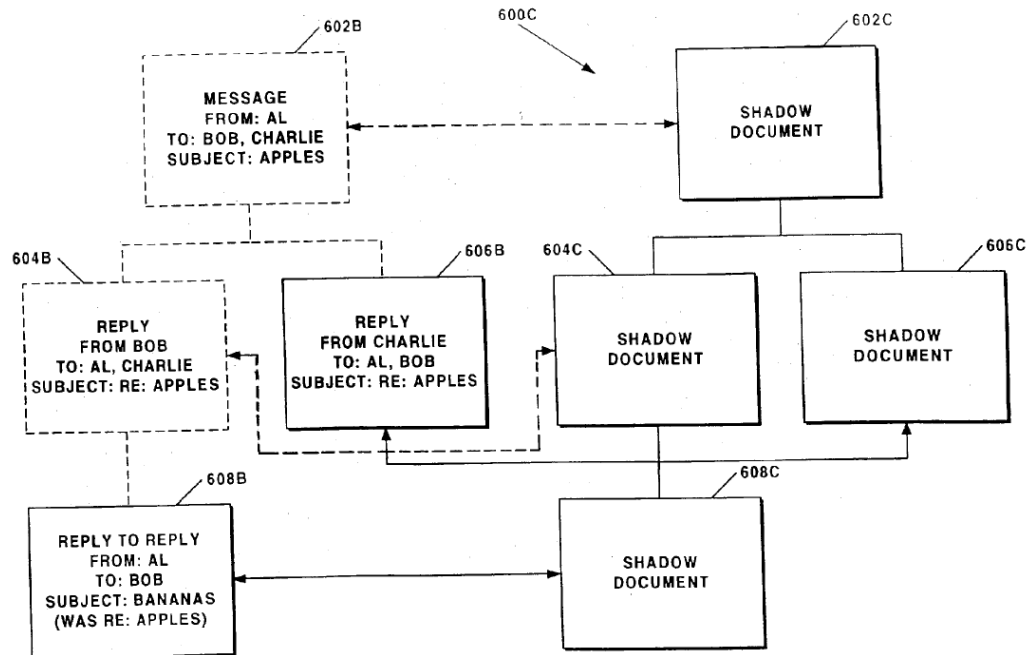


Figure 6C

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

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

2. *Summary of Schiavone (Ex. 1006)*

Schiavone describes “rules-based processing” for emails. Ex. 1006 ¶ 7. For example, Schiavone explains that “a message may be rejected, and not delivered to the intended recipient, if a recipient’s profile data is incompatible with applicable laws for receiving the message, as specified in a rule associated with the message.” *Id.* ¶ 16.

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

3. *Combination of Rohall and Schiavone*

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

Petitioner relies on Schiavone to teach compliance and governance features for email systems that identify and enforce rules associated with email messages. *See* Pet. 5, 37–46. Petitioner points out that Schiavone teaches selecting different rule sets from various US federal and local laws and European Union laws and further discusses an example of Schiavone’s rule-based email processing system where an email is only delivered to a US recipient if the recipient is above a certain age in compliance with US law. *Id.* at 43–44 (citing Ex. 1006 ¶¶ 29–31, 33).

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

We agree with Petitioner that the ordinarily skilled artisan would have been motivated to combine Rohall and Schiavone because Schiavone provides reasons to apply its techniques to email systems such as Rohall’s. Schiavone describes a need for “ensuring compliance of e-mail messages

with applicable standards and/or laws and/or otherwise determining appropriateness of a message for an intended recipient,” especially because there is “a patchwork of local, federal and international laws.” Ex. 1006 ¶ 6. Schiavone also states that filtering emails, e.g., to remove spam, is beneficial. *Id.* ¶¶ 1–2. As Schiavone describes problems in email systems, which its rules-based email processing technique addresses, we determine that the ordinarily skilled artisan would have been motivated to combine Rohall and Schiavone. *See KSR*, 550 U.S. at 401 (a reference which teaches, suggests, or motivates its combination may “identify a reason that would have prompted a person of ordinary skill in the art to combine the elements”).

Patent Owner’s arguments that a skilled artisan would not have combined Rohall and Schiavone (PO Resp. 45–54) do not overcome Petitioner’s showing. Patent Owner argues that “skilled artisan would not look to combine Rohall and Schiavone to solve the problems in the ’911 Patent” and “would not look to the Rohall reference at all to solve the problems addressed by the ’911 Patent.” *Id.* at 45–49. These arguments are unavailing because, “[i]n determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls.” *KSR*, 550 U.S. at 419. As such, Patent Owner’s arguments that the references, alone or in combination, do not solve the problems the ’911 Patent address, i.e., submessage replication, storage concerns, and individual submessage action (PO Resp. 46–49), do not negate the motivation Petitioner identifies from Schiavone’s disclosure.

Patent Owner also argues that “Rohall criticizes, or teaches away from, systems in which users must ‘act on each message individually’ because doing so is ‘time consuming’ and results in message items being

‘disconnected.’” PO Resp. 49 (citing Ex. 1005 ¶ 8); *see also id.* at 36–37, 39–40. Those arguments are unavailing because the criticisms Patent Owner highlights in Rohall are not criticisms of the features the combination incorporates. *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1069 (Fed. Cir. 2018) (“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.”). The cited portion of Rohall states, in fuller context, that “users must locate and act on each message individually” in order “to understand the context in which an electronic mail message should be interpreted” when they are “carbon copied or blind carbon copied on messages that do not make any sense without the entire conversation thread.” Ex. 1005 ¶ 8. As such, Rohall does not criticize applying rules to messages; rather, Rohall criticizes a system in which “users must locate and act on each message individually.” *Id.* Petitioner’s combination does not attempt to create a system in which *users* must act on each message individually, nor does the claim require such a system. Instead, Petitioner’s combination provides “an improved electronic mail system/inbox that includes *automated* filtering capabilities.” Pet. 13–14 (emphasis added); *see id.* 8–9 (“the combined *electronic mail message processing system* would enforce various rules to ensure compliance, as well as provide filtering features”) (emphasis added). And, even if Rohall describes a system that acts on conversation threads as a whole, Rohall does not criticize applying rules to that thread such that rules are applied to emails within that thread. Accordingly, we disagree with Patent Owner that Rohall teaches away from the combination. *See Polaris*, 882 F.3d at 1069.

Patent Owner also argues “there is no teaching or suggestion in Rohall that would motivate a skilled artisan to add rules from Schiavone to Rohall” and instead Petitioner relies on improper hindsight. PO Resp. 50–51. But, obviousness does not rigidly require a teaching, suggestion, or motivation found in a reference itself. *KSR*, 550 U.S. at 402. Even if it did, Petitioner points out that Schiavone provides motivation to improve Rohall’s email system, e.g., to address spam and to enforce communication laws. Pet. 6–7.

Patent Owner further argues that Petitioner’s motivation is inadequate as lacking evidence or that Petitioner’s evidence in the form of Dr. Black’s testimony is “conclusory.” PO Resp. 51–53. The record shows otherwise. As discussed above, Petitioner relies on reasons found in Schiavone’s disclosure as motivation for its combination. Pet. 6–7 (citing Ex. 1006 ¶¶ 1, 2, 6). Petitioner also relies on the testimony of Dr. Black as supporting evidence; Dr. Black explains, with citations to evidence of record, that Rohall and Schiavone both concern email systems, identify issues in email systems, and explain how email is improved by applying Schiavone’s techniques. *Id.* at 6–8; Ex. 1003 ¶¶ 118–127. While Patent Owner faults Petitioner and Dr. Black for not offering explanation that “a skilled artisan would consider the resulting modified inbox to be ‘improved’” (PO Resp. 53), both Petitioner and Dr. Black identify email improvements in the form spam filtering and legal compliance. We agree that spam filtering and legal compliance are improvements to email systems that would have motivated the combination of Rohall and Schiavone.

Accordingly, we find that a person of ordinary skill in the art would have been motivated to combine Rohall and Schiavone.

4. Independent Claim 1

a) Preamble

Petitioner contends that Rohall discloses the preamble, i.e., “[a] computerized messaging server in an electronic messaging system, comprising.” Pet. 14–17 (citing Ex. 1005 ¶¶ 14, 48, 51–52, 60, Figs. 1, 3; Ex. 1003 ¶¶ 128–130). Indeed, Rohall describes a networked computer system, e.g., servers, “executing a communication process for sending and receiving electronic mail documents.” Ex. 1005 ¶¶ 14, 51–52. Patent Owner does not dispute this contention. *See* PO Resp. We find that Petitioner has shown, by a preponderance of the evidence, Rohall discloses the preamble.³

b) Limitation [1.1]

Petitioner contends that Rohall discloses “a messaging module adapted to control a message database storing messages sent among users of the messaging system.” Pet. 17–22 (citing Ex. 1005 ¶¶ 14, 15, 54–56, 68, 73, 125, Figs. 2, 6C; Ex. 1003 ¶¶ 135–143). Indeed, Rohall describes a “Mail Agent module” which process email messages which stores email shadow documents in a mail database. Ex. 1005 ¶¶ 54–56. Patent Owner does not dispute this contention. *See* PO Resp. We find that Petitioner has shown, by a preponderance of the evidence, that Rohall discloses this limitation.

³ Accordingly, we need not determine whether the preamble is limiting. *See Vivid Techs.*, 200 F.3d at 803.

c) Limitation [1.2]

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

Patent Owner does not contest that Rohall’s conversation thread emails, e.g., original emails and reply emails, teach “a plurality of sent submessages,” and instead contends that Rohall does not teach “relational references pointing to” those submessages. *See* PO Resp. 40–45. That contention is based on its asserted claim construction—that “relational references” require the use of a relational model—which, as discussed above, our construction does not require. *See* § II.C. Accordingly, Patent Owner’s arguments that Rohall uses a hierarchical model rather than a relational model (PO Reps. 40–42) argues features the claim does not require and, so, does not overcome Petitioner’s showing that Rohall’s pointers disclose this claimed feature.

Patent Owner also argues it would not have been obvious to add “relational references” to Rohall. PO Resp. 42–45. As Petitioner adequately shows that Rohall discloses that feature, we need not opine on whether that feature would have been obvious over Rohall.

Accordingly, we find that Petitioner has shown, by a preponderance of the evidence, that Rohall discloses this limitation.

d) Limitation [1.3]

Petitioner asserts that Rohall discloses “the plurality of sent submessages including a first sent submessage and a second sent submessage, at least one of the sent submessages being one of a reply to and a forward of another sent submessage of the plurality of sent submessages.” Pet. 35–36 (citing Ex. 1005 ¶¶ 56, 60, 91, 93; Ex. 1003 ¶¶ 167–173). Indeed, Rohall describes “a parent/child tree hierarchy representing a conversation thread” having an original email message, replies to the original email, and replies to the replies. Ex. 1005 ¶¶ 56, 60, Fig. 6C. Patent Owner does not dispute this contention. *See* PO Resp. We find that Petitioner has shown, by a preponderance of the evidence, that Rohall discloses this limitation.

e) Limitation [1.4]

Petitioner asserts that the combination of Rohall and Schiavone teaches “a governance module adapted to control a governance policy database storing a compliance policy describing rules applicable to the sent submessages.” Pet. 37–41 (citing Ex. 1006 ¶¶ 7, 28–30, 35, 64, 66, Fig. 6, code (57); Ex. 1003 ¶¶ 174–187).

Patent Owner argues the combination does not “disclose applying rules from a compliance policy at the submessage level.” PO Resp. 33–36. These arguments are related to and overlap with our discussion of limitation [1.6] and, so, we consider these arguments in our discussion below. *See* § II.D.4.g. For the reasons discussed below, we find that Petitioner has shown, by a preponderance of the evidence, that the combination of Rohall and Schiavone teaches this limitation.

f) Limitation [1.5]

Petitioner asserts that the combination of Rohall and Schiavone teaches “the governance module further adapted to determine rules described by the compliance policy that are applicable to ones of the plurality of sent submessages.” Pet. 42–44 (citing Ex. 1006 ¶¶ 10, 29–31, 33, Fig. 2; Ex. 1003 ¶¶ 188–193). Indeed, Schiavone describes “a data store of rules,” which “controls how [an] e-mail message will be processed.” Ex. 1006 ¶ 30. Patent Owner does not dispute this contention. *See* PO Resp. We find that Petitioner has shown, by a preponderance of the evidence, that the combination of Rohall and Schiavone teaches this limitation.

g) Limitation [1.6]

In our Institution Decision, we did “not reach a particular determination” regarding this limitation, but we did note that we were “uncertain as to how [Schiavone’s] disclosures describe ‘different rules’ that are applied to ‘different . . . submessages.’” Inst. Dec. 26–27. Now, with the benefit of the record and arguments more fully developed during trial in which Petitioner emphasizes that the Petition relies on the combination of references to teach this limitation, we determine that Petitioner has shown,

by a preponderance of the evidence, that the combination of Rohall and Schiavone teaches this limitation. Our analysis follows.

Petitioner asserts that the combination of Rohall and Schiavone teaches “wherein different rules of the compliance policy are applicable to different ones of the plurality of sent submessages.” Pet. 44–46 (citing Ex. 1006 ¶¶ 7, 16, 29, 33; Ex. 1003 ¶¶ 194–199). As discussed above in § II.D.2, Petitioner relies on Rohall to teach a plurality of sent submessages. Petitioner further relies on Schiavone’s email rule compliance system in which “a sender could select several different rule sets to automate their compliance with selected US federal and local laws and regulations and, if desired, varying laws and regulations enacted by the European Union and elsewhere globally.” *Id.* at 45 (citing Ex. 1006 ¶ 29). Petitioner further cites an example where one email message is sent to a “recipient [who] lives in the US and is 45 years of age” and “the same message [is] sent to a 10 year old in France.” *Id.* at 44–45; Ex. 1006 ¶ 33. In that example, both recipients receive the email because, even though COPPA is a US law which forbids delivery of commercial electronic mail communications to children aged thirteen and under, the French 10 year old is not subject to US law and, so, receives the email. *Id.* ¶¶ 29, 33.

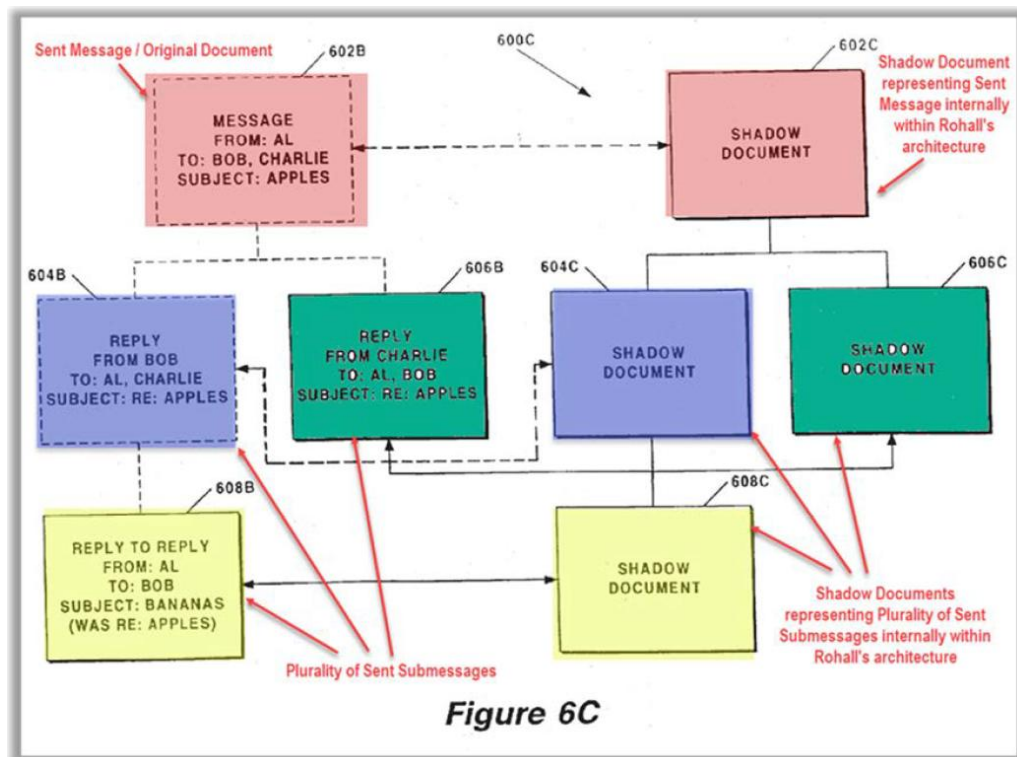
Patent Owner contends that the combination of Rohall and Schiavone does not teach “applying rules from a compliance policy at the submessage level” (PO Resp. 33–37; PO Sur-reply 5–9), and, more specifically, that this limitation “requires different treatment of different submessages, but Schiavone does not discuss submessages at all” (PO Resp. 37–40; PO Sur-reply 2–5). Patent Owner highlights that the example Petitioner relies in Schiavone on “relate[s] to applying different rules to the same message.” PO Resp. 38; PO Sur-reply 6–7. Patent Owner also argues that

the combination would “handle[] operations on messages at the **entire-thread level**,” as opposed to each submessage in the thread. PO Sur-reply 8–9; PO Resp. 39–40.

Petitioner’s explanation that its “combination yields the ability to apply rules to each submessage, because Schiavone’s conditional logic operates on attributes of the sender, recipient, and underlying content, and Rohall identifies the specific content units (submessages) to which those rules can be applied” (Pet. Reply 13) is compelling. Petitioner explains that Schiavone applies email compliance rules, e.g., COPPA rules, based on the “**specific sender, receiver and content of the e-mail message.**”

Pet. Reply 11–12 (citing Ex. 1006 ¶¶ 7, 16, 29, 33). Petitioner states that “indicates . . . that a first law/regulation is ‘*applicable to*’ an e-mail message associated with a first sender/receiver pair” while “**a second law/regulation** (*i.e.*, a ‘*different rule of the compliance policy*’) is ‘*applicable to*’ an e-mail message associated with a second sender/receiver pair.” *Id.* at 12.

We agree that, when those teachings are applied to Rohall, their combination yields “different rules of the compliance policy are applicable to different ones of the plurality of sent submessages” as required by the claim. Rohall teaches different submessages with different senders and receivers, as shown in Petitioner’s annotation of Figure 6C of Rohall, reproduced below:



Pet. 21. For example, Petitioner asserts that original message 602B from Al to Bob and Charlie is a different submessage than reply 604B from Bob to Al and Charlie, which is a different submessage than reply 608B from Al to Bob (as well as their shadow document counterparts). *Id.* Because Schiavone filters messages based on rules “applicable to the specific sender, receiver and content of the e-mail message” (Ex. 1006 ¶ 16), it follows that when Schiavone’s technique applies rules that are specific to the sender and receiver, different rules are applicable to the different submessages having different senders and receivers Rohall teaches (Ex. 1005, Fig. 6C). That is, for example, rules applicable to emails from Bob to Al and Charlie may not be applicable to emails from Al to Bob.

This reasoning similarly applies to Schiavone’s example of compliance with “selected” different rules: “US federal and local laws and regulations,” e.g., COPPA, and “varying laws and regulations enacted by the European Union.” Ex. 1006 ¶ 29. Schiavone describes sending an email to

a US resident and a French resident; COPPA applies to the US resident but not the French resident. Ex. 1006 ¶¶ 33. As Rohall teaches reply emails, which are “different submessages” than original emails, when the US resident sends their reply or when the French resident sends their reply, different rules are applicable to those different replies than the original email, depending on the residency of the reply recipient and the particular rules applicability.

Patent Owner argues the combination does not apply different rules to different submessages, as required by the claim, based on its factual allegation that Schiavone describes rules “treatment of the message **as a whole** (i.e., a complete conversation thread)” (PO Resp. 34–35 (citing Ex. 1006 ¶ 7), 37–38 (citing Ex. 1006 ¶ 33)). The first problem with this argument is that the cited portions of Schiavone do not describe applying rules to “a complete conversation thread,” i.e., the original email and its replies, as Patent Owner alleges. *See* Ex. 1006 ¶ 7, 33. The factual premise underpinning Patent Owner’s argument is not supported by the record.

Moreover, this argument also fails because it addresses Schiavone alone and not the combination of Schiavone with Rohall. While we agree that Schiavone’s examples describe applying different rules to the same email (PO Resp. 38; PO Sur-reply 3–4 (citing Inst. Dec. 26; Ex. 1006 ¶¶ 29, 33, 36)), the combination relies on Rohall to teach different submessages such as original emails and reply emails that have different senders and receivers. As Schiavone teaches its various rules should be applied based on “the specific sender, receiver and content of the e-mail message” (Ex. 1006 ¶ 16), the resulting combination with Rohall applies different rules to different submessages because Rohall’s senders and receivers are different in different submessages. *See* Ex. 1005, Fig. 6C.

Patent Owner also argues that, rather than apply different rules to different submessages, “given Rohall’s teachings, a skilled artisan would be motivated to apply a rule from a compliance policy to the entire conversation thread.” PO Resp. 37; PO Sur-reply 7. That argument is based on a hypothetical combination instead of Petitioner’s stated combination. As such, that argument does not show that Petitioner’s combination would not have been obvious to one of ordinary skill in the art. Further, even assuming Patent Owner’s hypothetical is an alternative manner of combining the references, the existence of an alternative does not undermine Petitioner’s showing of obviousness based on Petitioner’s proposed combination. *See Intel Corp. v. Qualcomm Inc.*, 21 F.4th 784, 797 (Fed. Cir. 2021) (“It’s not necessary to show that a combination is ‘the best option, only that it be a suitable option.’”).

Still further, even assuming, for the sake of argument, that Petitioner’s combination resulted in a system that applies rules “on messages at the **entire-thread level**” (PO Sur-reply 7–8; *see id.* at 5), such a combination still meets this limitation. As discussed above, Schiavone teaches applying a set of selected rules based on the specific sender, receiver, and message content. Ex. 1006 ¶ 16. Applying the selected rules to the entire email conversation thread therefore applies rules according to the specific sender, receiver, and message content within that thread. Since the sender, receiver, and message content change within the email thread (e.g., relies and replies-to-replies (*see* Ex. 1005, Fig. 6C)), the applicable rules change accordingly, meeting “different rules of the compliance policy are applicable to different ones of the plurality of sent submessages,” as required by this limitation.

Patent Owner additionally repeats its arguments that Rohall teaches away from Petitioner’s combination in address this limitation. *See* PO Resp.

34, 39–40. As discussed above in § II.D.3, we disagree with Patent Owner that Rohall teaches away from Petitioner’s combination.

Accordingly, for the reasons discussed above, Petitioner shows, by a preponderance of the evidence, that the combination of Rohall and Schiavone teaches or suggests this limitation.

h) Limitation [1.7]

Petitioner asserts that Rohall discloses “wherein the messaging system is utilized by a set of entities in a population structure.” Pet. 46–47 (citing Ex. 1005 ¶¶ 6–7, 12, 60, 107, 126; Ex. 1003 ¶¶ 203–204). Indeed, Rohall describes its email system is used by a group of users/people. Ex. 1005 ¶¶ 49, 60, 107, 126. Patent Owner does not dispute this contention. *See* PO Resp. We determine that Petitioner has shown, by a preponderance of the evidence, that the combination of Rohall and Schiavone teaches this limitation.

i) Limitation [1.8]

Petitioner asserts that the combination of Rohall and Schiavone teaches “wherein a rule of the compliance policy includes one or more rule elements describing whether the rule is applicable to a sent submessage.” Pet. 47–49 (citing Ex. 1006 ¶¶ 31–34, Fig. 2; Ex. 1004 ¶¶ 205–210). Indeed, Schiavone describes applying an email rule based on the email recipient’s profile, e.g., applying COPPA “only to recipients living in the US, and [specifying] that the mail message should be delivered to a U.S. recipient only if the recipient is over the age of 13.” Ex. 1006 ¶¶ 31–32, Fig. 2. Patent Owner does not dispute this contention. *See* PO Resp. We determine

that Petitioner has shown, by a preponderance of the evidence, that the combination of Rohall and Schiavone teaches this limitation.

j) Limitation [1.9]

Petitioner asserts that the combination of Rohall and Schiavone teaches

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

Pet. 49–51 (citing Ex. 1006 ¶ 16; Ex. 1003 ¶¶ 211–215). Indeed, Schiavone teaches applying its rules based on specific email senders and email recipients. Ex. 1006 ¶ 16. Patent Owner does not dispute this contention. *See* PO Resp. We determine that Petitioner has shown, by a preponderance of the evidence, that the combination of Rohall and Schiavone teaches this limitation.

k) Conclusion as to Claim 1

For the reasons provided above, having considered the entirety of the arguments and evidence presented at trial, we are persuaded that the subject matter of claim 1 is taught or suggested by the combination of Rohall and Schiavone. Accordingly, we determine that Petitioner has shown, by a preponderance of the evidence, that the subject matter of independent claim 1 would have been obvious over the combination of Rohall and Schiavone.

5. Independent Claim 10

Petitioner analyzes claim 10 along with its analysis of claim 1, relying on the same argument and evidence. *See* Pet. 14–51. Claim 10 recites similar subject matter as independent claim 1. *See* Ex. 1001, 17:1–36. As such, we determine that Petitioner has shown that subject matter of claim 10 would have been obvious over the combination of Rohall and Schiavone for the same reasons discussed above in § II.D.4.

Patent Owner does not separately address claim 10 beyond linking it to arguments that Rohall and Schiavone do not teach limitations recited in independent claims 1, which we addressed in claim 1. *See* PO Resp. 33, 37, 40. For reasons provided above in § II.D.4, Patent Owner’s arguments are unavailing.

Accordingly, we conclude that Petitioner has shown, by a preponderance of the evidence, that the subject matter of claim 10 would have been obvious to one of ordinary skill in the art over the combination of Rohall and Schiavone.

6. Independent Claim 13

Petitioner’s analysis of claim 13 relies on its analysis of claim 1, relying on the same argument and evidence, and provides a mapping of each limitation in claim 13 to an “[a]nalogous” limitation in claim 1. Pet. 62–63. Generally, independent claim 13 recites limitations similar to the limitations recited in claim 1 but is broader than claim 1 in one aspect. *See id.* at 15:51–16:14, 17:63–18:26. As we noted in our Institution Decision (Inst. Dec. 23), claim 13 does not require “wherein different rules of the compliance policy are applicable to different ones of the plurality of sent submessages,” as recited in limitation [1.6], and instead more broadly recites “selectively

applying rules of the compliance policy to the sent submessages,” as recited in limitation [13.5]. Ex. 1001, 16:1–2, 18:13–14. In particular, limitation [13.5] only requires selectively applying rules to sent submessages but does not recite different rules applied to different submessages.

Patent Owner does not argue any of the limitations of claim 13 separately from the limitations of claim 1. *See* PO Resp. 31–37, 40–45. For reasons provided above in § II.D.4, Patent Owner’s arguments are unavailing. Further, limitation [13.5] recites differing, but broader language than limitation [1.6], and, so, is necessarily met by the combination which teaches limitation [1.6]. *See* § II.D.4.g. In addition to that, the combination of Rohall and Schiavone independently meets the requirements of limitation [13.5]. For example, in Schiavone’s example where US and European Union laws are applicable, COPPA rules are applied to submessages sent to US residents but not to submessages sent to French residents, thereby teaching “selectively applying rules of the compliance policy to the sent submessages.” Ex. 1006 ¶¶ 29, 33.

Accordingly, we conclude that Petitioner has shown, by a preponderance of the evidence, that the subject matter of claim 13 would have been obvious to one of ordinary skill in the art over the combination of Rohall and Schiavone.

7. Remaining Claims 2–8, 11, 12, 15, 18, 20, 21

Petitioner provides argument and evidence in support of its contention that remaining dependent claims 2–8, 11, 12, 15, 18, 20, and 21 are taught, suggested, or would have been obvious over the combination of Rohall and Schiavone. Pet. 14–66. Patent Owner does not specifically address the limitations recited in claims 2–8, 11, 12, 15, 18, 20, or 21 beyond linking

those claims to arguments that Rohall and Schiavone do not teach limitations recited in independent claims 1, 10, or 13. *See* PO Resp. 33, 37, 40. For reasons provided above in §§ II.D.4–II.D.6, Patent Owner’s arguments are unavailing.

As to Petitioner’s analysis addressing the subject matter recited in claims 2–8, 11, 12, 15, 18, 20, and 21, Petitioner provides citations and reasoned analysis supported by the record to show that the claims would have been obvious by a preponderance of the evidence. *See* Pet. 51–66. Regarding claim 2, Schiavone describes “personal/demographics information” for “providing enhanced preference-based filtering, targeting and/or compliance” in its email system. Ex. 1006 ¶¶ 4, 22, 32. Regarding claim 3, Schiavone describes “rules can be added, deleted and/or revised easily without a need for revisions to the data stored in the private profiles of individual users.” *Id.* ¶ 35. Regarding claim 4, Schiavone describes personal and demographics information “may be compiled, for example, during the recipient’s completion of a questionnaire” and stored in the user’s profile. *Id.* ¶¶ 22, 60. Regarding claims 5, 11, and 18, Schiavone describes requiring individual “approval before the message is able to be sent.” *Id.* ¶ 36. Schiavone also describes only allowing compliant users to view messages. *Id.* ¶ 29. Regarding claims 6 and 12, Schiavone describes “a recipient’s profile data may contain time-based limitations for receiving electronic mail, which may be useful for filtering purposes.” *Id.* ¶ 67. Regarding claim 7, Schiavone describes an exemplary rule in which for “period of two months, e.g. after purchasing a house, the recipient wishes to receive sale offers relating to purchases of new homes, or home furnishings, etc.” *Id.* Regarding claim 8, as Schiavone describes business communicating with different parties with different needs, we agree with

Petitioner and Dr. Black that it would have been obvious for a business to have multiple compliance policies for different situations. *Id.* ¶ 7; Pet. 60–61; Ex. 1003 ¶¶ 251–254. Regarding claim 15, Schiavone describes rules requiring approvals from personnel groups holding positions of rank, e.g., “a supervisor . . . and a vice-president.” Ex. 1006 ¶ 36. Regarding claim 20, Schiavone describes an “auction rule” that sends messages “every time any individual places a bid by e-mailing the seller” and “to the highest bidder after expiration of a predetermined auction period (e.g. a predetermined length of time or number of bids).” *Id.* ¶ 37. Regarding claim 21, Rohall describes that its email system is used by a group of users/people. Ex. 1005 ¶¶ 49, 60, 107, 126.

Accordingly, we conclude that Petitioner has shown, by a preponderance of the evidence, that the subject matter of claims 2–8, 11, 12, 15, 18, 20, 21 would have been obvious to one of ordinary skill in the art over the combination of Rohall and Schiavone.

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

Petitioner contends that claims 9 and 27 would have been obvious over the combination of Rohall, Schiavone, and Gomes. Pet. 2, 66–74. Patent Owner argues that Petitioner has not shown that the combination teaches either claim. PO Resp. 57–63.

Having considered the arguments and evidence presented at trial, we conclude that claims 9 and 27 would have been obvious over the combination of Rohall, Schiavone, and Gomes. We provide our analysis below.

1. Summary of Gomes (Ex. 1016)

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

2. Combination of Rohall, Schiavone, and Gomes

As discussed above, Petitioner relies on the combination of Rohall and Schiavone to teach an email system that applies rules to submessages. *See* § II.D.3. From that combination, Petitioner asserts that the ordinarily skilled artisan would have been further motivated to improve that email system by incorporating Gomes’s search access policies. Pet. 68–69 (citing Ex. 1016, 9:21–42, 11:40–47, 12:46–55, code (57)).

Petitioner, supported by Dr. Black, offers motivation for that combination by asserting that the combination would have improved email filtering capabilities and enhanced legal and statutory requirements for data retention policies. *Id.* at 67–68 (citing Ex. 1003 ¶ 276). Petitioner and

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

Patent Owner does not dispute Petitioner's contention that a skilled artisan would have been motivated to combine Gomes with Rohall and Schiavone. *See* PO Resp. 55–63. We agree with Petitioner that its identified improvements would have motivated an ordinarily skilled artisan to combine Rohall, Schiavone, and Gomes.

3. Dependent Claim 9

Claim 9 depends from claim 1 and recites “wherein the rules described by the compliance policy include search rules describing which population structure entities can view which sent submessages when searching the sent submessages stored by the messaging system.” Ex. 1001, 16:63–67.

Petitioner contends claim 9 would have been obvious over the combination of Rohall, Schiavone, and Gomes. Pet. 66–70. Petitioner contends Gomes, in combination with Rohall and Schiavone, teaches the features recited in claim 9 based on Gomes's description of rules that define access policies to emails including read-only access for authorized users. *Id.* at 69–70 (citing Ex. 1016, 6:21–31, 11:40–47, 12:46–55, 13:1–6; Ex. 1003 ¶ 280).

Patent Owner argues claim 9 requires rules applied to submessages, but “Gomes does not address ‘submessages’ at all.” PO Resp. 57–58.

Petitioner's combination, however, relies on Rohall, not Gomes, to teach an email system having “submessages.” *See* Pet. 22–34, 66–69. In

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

Further, in its Sur-reply, Patent Owner references its earlier arguments regarding Ground 1 and argues that Gomes’ search rules would not apply to submessages because “Rohall teaches that each ‘thread’ should be ‘handled or processed as a single entity.’” PO Sur-reply 24. However, as we explain above in §§ II.D.3 and II.D.4.g, we disagree that the combination results in such treatment.

Accordingly, we conclude that Petitioner has shown, by a preponderance of the evidence, that the subject matter of claim 9 would have been obvious to one of ordinary skill in the art over the combination of Rohall, Schiavone, and Gomes.

4. Independent Claim 27

Most of Petitioner’s analysis of claim 27 references its analysis of claim 1, relying on the same argument and evidence, and provides a mapping of limitations in claim 27 to “[a]nalogous” limitations in claim 1. Pet. 70–71. As discussed above, Petitioner has shown, by a preponderance of the evidence, that those limitations would have been obvious to one of ordinary skill in the art over the combination of Rohall and Schiavone.

Claim 27 recites additional features not recited in claim 1:
each of the sent submessages is stored exactly once within the email database, and
upon receipt of a reply to a first email having a first email container containing a first sent submessage, the reply is added to the message container as an additional sent submessage but the first sent submessage is not duplicated within the email database.

Ex. 1001, 20:21–28. Petitioner contends Gomes, in combination with Rohall and Schiavone, teaches these limitations based on Gomes’s description of de-duplication of emails, e.g., “de-duplication of attachments, message bodies and metadata . . . such that only one copy of the content is” stored. Pet. 72–74; Ex 1016, 2:4–16, code (57).

Patent Owner argues claim 27 requires actions on submessages, but “Gomes does not address ‘submessages’ at all,” i.e., “the internal structure of email threads, such as original messages, replies, and forwards.” PO Resp. 61. Patent Owner also argues “when the de-duplication process described in Gomes is applied to e-mail strings, the process will **not** result in de-duplication of “*submessages*”; it will only result in de-duplication of the entire e-mail string/thread” because Gomes de-duplicates using hashed values. PO Resp. 62.

Petitioner’s combination, however, relies on Rohall, not Gomes, to teach an email system having “submessages.” See Pet. 22–34, 66–69. In particular, Petitioner’s combination first “combine[s] Rohall’s messaging system server with Schiavone’s rule-based processing” and asserts that combination is further improved by incorporating Gomes’s email de-duplication features (*id.* at 66–67, 72–73). As such, Patent Owner’s argument, which only addresses Gomes’s disclosures, does not address

Petitioner's challenge based on the combination of Rohall, Schiavone, and Gomes.

Furthermore, Patent Owner's argument that entire email threads would be deleted because Gomes describes a hash-based technique for de-duplication requires the bodily incorporation of features that Petitioner's combination does not attempt to add. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (““The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.”). Specifically, Petitioner's combination does not attempt to incorporate the hash-based techniques from Gomes. *See* Pet. 66–69, 72–75. As such, Patent Owner's assertions based on Gome's hash-based techniques do not address Petitioner's proposed combination of Rohall, Schiavone, and Gomes.

Further, in its Sur-reply, Patent Owner references its earlier arguments regarding Ground 1, and argues that Gomes's de-duplication would not apply to submessages because Rohall “states that threads should be handled ‘as a single entity.’” PO Sur-reply 25. However, as we explain above in §§ II.D.3 and II.D.4.g, we disagree that the combination results in such treatment.

Accordingly, we conclude that Petitioner has shown, by a preponderance of the evidence, that the subject matter of claim 27 would have been obvious to one of ordinary skill in the art over the combination of Rohall, Schiavone, and Gomes.

III. PATENT OWNER’S MOTION TO EXCLUDE

Patent Owner moves to exclude certain portions of Dr. Khan’s cross-examination testimony. Paper 29, 1; *see* Ex. 1022, 68:9–70:10. Patent Owner argues that the identified line of “questioning (1) assumes facts not in evidence (i.e., facts not present in any prior art reference) and, consequently, called for the witness to speculate; (2) is an incomplete hypothetical and, consequently, is not effective for determining the truth; and (3) is outside the scope of direct.” *Id.*

We have not considered any of the evidence Patent Owner moves to exclude in this Decision. As a result, Patent Owner’s Motion to Exclude this evidence is dismissed is moot.

IV. CONCLUSION

Based on the evidence presented with the Petition, the evidence introduced during the trial, and the parties’ respective arguments, we conclude Petitioner has shown by a preponderance of the evidence that claims 1–13, 15, 18, 20, 21, and 27 of the ’911 Patent are unpatentable.

In summary:

Claims	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–8, 10–13, 15, 18, 20, 21	103(a)	Rohall, Schiavone	1–8, 10–13, 15, 18, 20, 21	
9, 27	103(a)	Rohall, Schiavone, Gomes	9, 27	
Overall Outcome			1–13, 15, 18, 20, 21, 27	

V. ORDER

In consideration of the full trial record before us, and for the foregoing reasons, it is:

ORDERED that claims 1–13, 15, 18, 20, 21, and 27 of U.S. Patent No. 8,073,911 B2 are determined to be unpatentable;

FURTHER ORDERED that Patent Owner’s Motion to Exclude (Paper 29) is *dismissed* as moot; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2025-00270
Patent 8,073,911 B2

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