

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

X CORPORATION,
Petitioner,

v.

STERLING COMPUTERS CORPORATION,
Patent Owner.

Case No. IPR2025-00299
U.S. Patent No. 7,716,217

PETITIONER'S PRELIMINARY REPLY TO PATENT OWNER'S POPR

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EXHIBIT LIST

No.	Short Name	Reference
1001	217 Patent	Certified Copy of U.S. Patent 7,716,217
1002	217 File History	Certified File History of 7,716,217
1003	828 Provisional	Certified United States Provisional Patent Application No. 60/758,828.
1004	Houh Decl.	Expert Declaration of Dr. Henry Houh
1005	Houh CV	Curriculum Vitae of Dr. Henry Houh
1006	<u>Dumais</u>	U.S. Patent Application Publication 2007/0016553A1
1007	<u>Kircher</u>	U.S. Patent Application Publication 2003/0195937A1
1008	<u>Krug</u>	Certified Translation of WIPO Patent 2003/023650A2
1009	Sch. Order	Order 32 (Scheduling Order) in <i>Sterling Computers Corporation v. X Corp.</i> , Case No. 1:24-cv-00552 (W.D. Tex. May 22, 2024)
1010	Sch. Hr. Tr.	Oct. 21, 2024, Transcript of Initial Pretrial (Scheduling) Conference in <i>Sterling Computers Corporation v. X Corp.</i> , Case No. 1:24-cv-00552 (W.D. Tex. May 22, 2024).
1011	Goldberg	David Goldberg, et al., <i>Using Collaborative Filtering To Weave An Information Tapestry</i> , COMMUNICATIONS OF THE ACM, 35:12 (Dec. 1992).
1012	Kennedy	U.S. Patent 6,134,582
1013	Mailk	U.S. Patent Application Publication 2004/0078447
1014	587 Application	International Application PCT/US07/60587
1015	587 File History	File History of PCT/US07/60587
1016	RESERVED	
1017	118 File History	File History of 11/426,118

1018	605 Provisional	Provisional Patent Application No. 60/693,605.
1019	Shaw	U.S. Patent 6,249,807
1020	Karamchedu	U.S. Patent Application Publication 2004/0054744
1021	Fitzpatrick	U.S. Patent Application Publication 2006/0168029
1022	Yao	U.S. Patent Application Publication 2003/0187937
1023	Segal	Richard Segal, et al., <i>SpamGuru: An Enterprise Anti-Spam Filtering System</i> , CEAS 2004, FIRST CONFERENCE ON EMAIL AND ANTI-SPAM, (July, 2004).
1024	Carlson	U.S. Patent Application Publication 2005/0267973
1025	Sood	U.S. Patent 7,941,491
1026	Kirsch	U.S. Patent Application Publication 2005/0091319
1027	Boykin	P. Oscar Boykin, et al., <i>Personal Email Networks: An Effective Anti-Spam Tool</i> , ARXIV.ORG, 4 (Feb. 2004)
1028	Horvitz	International PCT Application WO2001/069432
1029	Lui	Andrew K. Lui, et al., <i>An Advanced Organizer for Asynchronous Discussion Forums</i> , IEEE (2005).
1030	Claypool	Mark Claypool, et al., <i>Combining Content-Based and Collaborative Filters in an Online Newspaper</i> , ACM SIGIR WORKSHOP ON RECOMMENDER SYSTEMS (Aug. 1999).
1031	Brun	U.S. Patent Application Publication 2007/0168430
1032	Linden	Greg Linden, et al., <i>Amazon.com Recommendations Item-to-Item Collaborative Filtering</i> , IEEE INTERNET COMPUTING (2003).
1033	Frankowski	International PCT Application WO2001/53973
1034	Dabbish	Laura A. Dabbish, et al., <i>Understanding Email Use: Predicting Action on a Message</i> , CHI (2005).
1035	Basu	Chumki Basu, et al., <i>Recommendation as Classification: Using Social and Content-Based Information in Recommendation</i> , AAAI-98

		PROCEEDINGS (1998).
1036	Melville	Prem Melville, et al., <i>Content-Boosted Collaborative Filtering for Improved Recommendations</i> , PROCEEDINGS OF THE EIGHTEENTH NATIONAL CONFERENCE ON ARTIFICIAL INTELLIGENCE (Jul. 2002).
1037	Alspector	Joshua Alspector, et al., <i>Comparing Feature-Based and Clique-Based User Models for Movie Selection</i> , PROCEEDINGS OF THE THIRD ACM CONFERENCE ON DIGITAL LIBRARIES (1998).
1038	Balabanovic	Marko Balabanovic, et al., <i>Content-Based Collaborative Recommendation</i> , COMMUNICATIONS OF THE ACM (Mar. 1997).
1039	Kussmaul	U.S. Patent 7,860,933
1040	Rose	U.S. Patent 6,202,058
1041	MSFT Comp.	Microsoft Computer Dictionary, 3ed (1997).
1042	Levenshtein	Jan 2005 – Levenshtein Distance – Wikipedia
1043	<u>Marston</u>	U.S. Patent Application Publication 2004/0260710
1044 (NEW)	EX2010 Markup	EX2010 with comments and redlines enabled
1045 (NEW)	EX2010 metadata	System metadata for EX2010

As shown in the Petition, every claim of the '217 Patent is obvious. Sterling's attempt to antedate Dumais is undercut by its own conception evidence. Likewise, Sterling's narrowing claim constructions run afoul of the intrinsic record.

I. The '217 Patent Is Not Entitled to An Earlier Invention Date

Sterling fails to satisfy its burden that the '217 Patent's named inventors conceived of the claimed invention earlier than Dumais' June 29, 2005 priority date. POPR, 24. The Board should reject Sterling's challenge to Grounds 1-3.

Sterling relies on the declaration and personal documentation of a named inventor, Mr. Justin Marston. But to prove conception through an inventor's testimony, there must be corroborating evidence, "*in addition to* [the inventor's] own statements and documents." *Apator Miitors ApS v. Kamstrup A/S*, 887 F.3d 1293, 1295 (Fed. Cir. 2018). "[E]vidence of corroboration must not depend solely on the inventor himself." *Id.* Sterling offers *only* unwitnessed inventor documents and metadata, both of which are insufficient to prove an earlier conception date.

The metadata associated with Sterling's conception documents also contradict Mr. Marston's declaration. Referencing EXS2010-2012, Mr. Marston states that in Oct. 2005, "[b]oth Paul and I made the revisions" to the Blue Space Mail Relevance document. EX2003, ¶11(f). However, the native version of EX2010 (produced under Routine Discovery) shows that extensive edits were made to EXS2010-2012 by a third individual, Jon Fernyhough. The native version of EX2010 was last saved by,

and includes redlines and comments made by Mr. Fernyhough. *See e.g.*, EX1044, 80-82 (purple comments and redlines by Mr. Fernyhough); EX1045. Mr. Fernyhough's added material is reflected in the claims, including: (1) relevance calculations (EX2010, 80-81) and (2) the calculation of local importance. *Cooper v. Goldfarb*, 240 F.3d 1378, 1383–85 (Fed. Cir. 2001) (no inurement of work done by a doctor where the specific claim limitation at issue had never been conveyed to the doctor). Mr. Marston's failure to even *mention* Mr. Fernyhough's contributions undercuts the credibility of his declaration.

Mr. Marston states that the “math involved” in the invention is “highly complex,” and “took significant effort to develop.” EX2003, ¶11(c). However, the math and “algorithms” sections of the Conception Documents (EX2004; EX2006) state: “INITIAL MATHS HAS BEEN DRAFTED WITH A MATHEMATICIAN, BUT IS IN NEED OF SIGNIFICANT CHANGES.” EX2004, 29; EX2006, 53. Further, the “algorithms” section was rewritten in August 2005. EX2007, 77; *compare* EX2006, §9 with EX2007, §9. Since more than “ordinary skill [was] necessary to reduce the invention to practice,” conception did not occur before June 29, 2005. *Dawson v. Dawson*, 710 F.3d 1347, 1352-56 (Fed. Cir. 2013).

The Conception Documents (EX2004; EX2006) also fail to disclose identification of a user “*that is cognate to the user*,” under either parties' construction. The specification states that identification of a “cognate group” can be

based on “similar past user actions and assessments” or “direct input by a user.” EX1001, 14:59-15:11, 43:30-37. The Conception Documents show neither. Instead, they show tracking actions by users and making generalized relevance determinations, without any identification of a cognate user. Indeed, Sterling’s documents show that the inventors did not possess the calculation for “cognate relevance values” until Nov. 9, 2005. EX2013, 3; EX2003, ¶11(g).

In its claim chart (EX2014), Sterling cites to EX2004, 4, 13, 15-16 and EX2006, 58. But no citation in EX2014 provides evidence of conception for this limitation under either party’s construction. First, Sterling’s claim chart should be ignored as improper incorporation by reference. POPR, 24-25; 37 C.F.R. §42.6(a)(3); Practice Guide, 35-36. Even if considered, each citation is an example of determining “content relevance” based on how other users interacted with a piece of content. No citation describes identification of a cognate user, assessment of “similar past user actions,” or assignment of users through “direct input by a user.” EX2004, 4; 13, 15-16. Sterling also cites to EX2006, 22. EX2006, 22 describes assigning an initial relevance value to a “new entity” (person) based on a “tree structure,” not identification of another user who is “*cognate to the user.*”

Mr. Marston’s declaration also confirms a lack of reasonable diligence. Mr. Marston states: “[b]y June 7, 2005, Paul and I had conceived a system with . . . all features of the claims.” EX2003, ¶14. However, Mr. Marston does not indicate when

the draft documents were sent to Sterling’s prosecution counsel—other than before they were filed on Jan. 11, 2006. EX2003, ¶12. Mr. Marson also does not explain gaps in the named inventors’ activities between (1) June 7 and Aug. 16, 2005 (70 days) (EX2006, 61; EX2007, 77), (2) Aug. 17 and Oct. 3, 2005 (47 days) (EX2008, 78; EX2010, 95); and (3) Nov. 9, 2005, and Jan. 11, 2006 (63 days) (EX2013, 3; EX2003, ¶12). *In re Meyer Mfg. Corp.*, 411 F. App’x 316, 319 (Fed. Cir. 2010) (finding lack of diligence due to an “unexplained gap of just over two months.”) Sterling has failed to show reasonable diligence for 180 days of the critical period.

II. Sterling’s Construction of “*Recipient*” Is Unsupported

Sterling attempts to distinguish Dumais and Kircher/Krug by importing a “sender” requirement into the claim term “*a recipient*.” POPR 30-33, 40-42. Sterling argues that “*a recipient*” “must be a user that actually received the piece of electronic content **sent from a sender**.” POPR, 21. But the plain and ordinary meaning of a recipient is someone who receives the content, by any means (*e.g.*, access control).

First, Sterling’s construction contradicts the claim language. Element 1[pre] recites: “*content sent from a sender to a user*.” The “*identification*” limitation (Element 1[f]) does **not** recite a “sender” or “sending.” Because the patentee decided not to recite a “sender” with relation to the “*recipient*” in Element 1[f], it should carry its broader meaning, as someone who receives. Sterling’s construction also limits “*electronic content*” in the independent claims to emails and messages with

senders. This conflicts with dependent claims 5 and 15, which recite a “*document*.”

Second, Sterling’s improperly limits “*recipient*” to a single embodiment. The claims of the ’217 Patent occur within “*an application for managing electronic content*.” One example of such an application is an email system—where content is “sent from a sender.” POPR, 21. But the specification also describes a “document management system,” such as a “relational mail system,” where each message is centrally managed according to a “compliance model.” EX1001, 3:46-48, 3:54-56, 5:28-33. This “compliance model” can be used to determine “who can access content.” *Id.* Using “cluster models,” the system “segments users... into categories based on their actions or attributes.” *Id.* 44:37-39. One example of a “cluster,” is “allowed readers” (i.e., “users who are allowed to read the mail”). *Id.* 9:51-10:8. Sterling’s construction excludes the “relational mail system” embodiment.

None of Sterling’s citations to the specification (POPR, 21) describe a “*recipient*” in the context of identification of cognate users. Instead, each example is a generic description of an email message. There is no indication that these examples were intended to limit the meaning of the word “*recipient*,” especially where other examples describe identification of users based on access controls.

Finally, the Board need not construe this term because the prior art of record satisfies the claim under either party’s construction. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). The

Petition explains how identification of a cognate user in Dumais is based on “content and/or usage of items” and “global database 490” which analyze activity by multiple users “on a single data item.” EX1004, ¶245; Pet., 33. Dumais’ “data items” can include “email messages,” that can be monitored for various actions including when they are “forwarded, replied to, [and] **sent to**” other users. EX1004, ¶192; Pet. 24; POPR 28. Likewise, Kircher ranks email “according to the likely importance of each message **to the recipient.**” Pet. 58-60. In the combination, Kircher’s emails are ranked using Krug’s “prioritization and filtering techniques.” Pet. 50. Krug analyzes “usage behavior” of a “group of users” on a piece of content (such as email) to calculate a “comparison value indicative of the relevance of the objects.” Pet. 48-49; EX1008, [0019]. As part of calculating the “comparison value,” Krug can analyze the actions of “users who access a specific object.” Pet. 65-66; EX1004, ¶503-505.

In short, “*recipient*” does not require a “sender” and should be given its plain and ordinary meaning.

III. Sterling’s Construction of “*Cognate*” Is Unsupported

Sterling argues that “cognate users in the ’217 Patent are **more restricted** than” the prior art and must be based on actions performed “on the same piece of content” while “*determining a relevance score.*” POPR, 34.

Claim 1 does not require analysis of past user actions, or identification as part of “*determining a relevance score.*” Sterling is importing limitations from Element

1[g][iv] (determining relevance based on actions of the cognate user) into Element 1[f]. Dependent claim 8 requires “*identifying*” cognate users by “*analyzing historical actions*,” suggesting the independent claim is not limited as Sterling contends.

Sterling’s construction also conflicts with specification. The specification explains that identification of a “cognate group” can be determined using “**collaborative filtering**.” Pet. 13. Sterling’s argument that “’217 Patent are **more restricted** than the generic **collaborative filtering** described in Dumais” is, therefore, inconsistent with the specification. There are multiple ways to identify a cognate user described in the specification—not only based on user actions.

The prior art satisfies the claim under either party’s construction. *Nidec*, 868 F.3d at 1017. As explained in the Petition, Dumais discloses a “relevance feedback” score which ranks search results based on “previous user activities from a group of users” and “usage of items” and is used to calculate a “relevance score.” Pet. 40. Sterling argues that Krug’s “group profiles” are not the same as “cognate groups,” because “you cannot track the actions of a [second] ‘profile’/’user’ in Krug.” POPR, 43. However, Krug calculates an “action equivalence” for a specific piece of content based on “user interactions.” Pet., 61–63. A “collective action equivalence” factors in “**aggregated usage intensity**” for each object.” *Id.* 71; Pet., 42; 75 (claims 8/22).

Sterling’s attempt to redraft the claims is inconsistent with the intrinsic record and should be rejected.

Dated: April 14, 2025

Respectfully Submitted,

/s/David Okano

David Okano

(Reg. No. 66,657)

WHITE & CASE LLP

3000 El Camino Real

2 Palo Alto Square Suite 900,

Palo Alto, CA 94306

david.okano@whitecase.com

Telephone: (650) 213-0363

Attorney for Petitioner X Corp.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I hereby certify that on this 14th day of April, 2025, I caused to be served a true and correct copy of the foregoing and any accompanying exhibits by e-mail on the following counsel:

Devan V. Padmanabhan
Michelle E. Dawson
Britta S. Loftus
Sterling_IPR2025-0299@paddalawgroup.com
PADMANABHAN & DAWSON, PLLC
9800 Shelard Parkway, Suite 120
Minneapolis, MN 55441

Dated: April 14, 2025

Respectfully Submitted,
/s/David Okano
David Okano
(Reg. No. 66,657)
WHITE & CASE LLP
3000 El Camino Real
2 Palo Alto Square Suite 900,
Palo Alto, CA 94306
david.okano@whitecase.com
Telephone: (650) 213-0363

Attorney for Petitioner X Corp.