UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

X CORP.

Petitioner,

v.

STERLING COMPUTERS CORPORATION

Patent Owner.

Case IPR2025-00299

U.S. Patent No. 7,716,217

PATENT OWNER'S SUR-REPLY

Table of Contents

I. The Evidence Shows That the Inventors of the '217 Patent Conceived of Their Invention Before the Priority Date for Dumais. 1

II. The Court Should Construe "*Recipient*" to Be a "*User*" that Received "*Electronic Content Sent from a Sender*." 4

III. In the Context of the Claims of the '217 Patent, "*Cognate*" Is More Restrictive Than Generic Collaborative Filtering Described in Dumais. 6

TABLE OF AUTHORITIES

Case **Page(s)**

CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG,
224 F.3d 1308 (Fed. Cir. 2000)..……..……4

Dana-Farber Cancer Inst., Inc. v. Ono Pharm. Co.,
379 F. Supp. 3d 53 (D. Mass. 2019)……...2

Linear Tech. Corp. v. Impala Linear Corp.,
379 F.3d 1311 (Fed. Cir. 2004)…….....2

Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005)……4-6

Unified Pats., LLC v. Flexiworld Techs., Inc., No. IPR2022-00775,
2023 WL 7198014 (P.T.A.B. Nov. 1, 2023)…...……..1 n. 1 & 2

EXHIBIT LIST

Patent Owner's Exhibit No.	Exhibit Description
2001	Declaration of Latifur Khan
2002	Curriculum vitae of Latifur Khan
2003	Declaration of Justin Marston
2004	"BlueSpace Mail Search" Document, Sept. 2, 2004
2005	"The Development of the Mathematical Algorithms," May 12, 2005
2006	"BlueSpace Mail Relevance," June 7, 2005
2007	"BlueSpace Mail Relevance," Aug. 16, 2005
2008	"BlueSpace Mail Relevance," Aug. 17, 2005
2009	"Importance," Sept. 18, 2005
2010	"BlueSpace Mail Relevance," Oct. 6, 2005
2011	"BlueSpace Mail Relevance," Oct. 7, 2005
2012	"BlueSpace Mail Relevance," Oct. 7, 2005
2013	"There are many cognate relevance values that must be calculated," Nov. 9, 2004
2014	Claim Chart for BlueSpace Mail Documents

I. The Evidence Shows That the Inventors of the '217 Patent Conceived of Their Invention Before the Priority Date for Dumais.

The evidence shows that the inventors of U.S. Patent No. 7,716,217 ("the '217 Patent"), Justin and Paul Marston, invented before Dumais' patent application was filed. EX2003-EX2013; *see also* EX2014.[1] Notably, with the sole exception of the "*cognate*" limitation, Petitioner **does not dispute** that the evidence shows that the inventors conceived of **every limitation** of the '217 Patent by June 7, 2005. With respect to the "*cognate*" limitation, Petitioner argues that the Conception Documents fail to show identification of a "cognate group" by either (1) "similar past user actions and assessments" or (2) "direct input by user, which Petitioner asserts are the only ways to identify a cognate user. Br., at 2-3. But the '217 Patent states that there are several approaches to identifying other "*cognate*" users, including a "role or group based" approach. '217 Patent, at 43:33-35. And, the Conception Documents disclose identifying another "*cognate*" user using nearly the exact same language:

'217 Patent, at 14:45-58	**Conception Document (EX2006, 22)**
One approach to setting an initial importance value in these cases is to recognize correlated or cognate entities … through the use of tree structures. For example, one human resources employee is generally likely to have	Another approach to these initial values is to recognize correlated entities, described through tree structures. For example, one HR employee is generally likely to have similar

[1] Petitioner asserts that EX2014 is improper & should be ignored (Br., at 3). However, the Board has considered such claim charts in evaluating priority. *Unified Pats., LLC v. Flexiworld Techs., Inc.*, No. IPR2022-00775, 2023 WL 7198014, at *5 (P.T.A.B. Nov. 1, 2023) (considering "a claim chart purporting to show where each limitation … may be found in [the corroborating document]").

similar importance as another one, especially if they are of similar position in a tree structure (e.g., they both work in employee appraisal form processing). …. [I]n one or more embodiments, branched structures, such as knowledge taxonomies for contexts and directories for users and job code hierarchies, may be used as a correlative basis for importance on an ongoing basis. Thus, for example, an importance change for one user may have a cascading "ripple effect" for similar users.	importance to another one, especially if they are of similar position in a tree structure – e.g. they both work in employee appraisal form processing…. Note that if rquired [sic], branched structures – such as knowledge taxonomies for contexts, directories for users and Jobcode hierarchies – can be used as a correlative basis for importance on an ongoing basis. Thus for example, an importance change for one user would have a cascading 'ripple effect' for similar users.

Thus, the Conception Documents show conception of a "*cognate*" user (and every other limitation), and Dumais does not qualify as prior art under Section 102(e).

In response to this evidence, Petitioner argues that all of the corroborating evidence impermissibly comes from Justin Marston. Br., at 1. To the contrary, however, the metadata for the Conception Documents (EX2004, at 35; EX2006, at 61) independently corroborates his testimony. *See Unified Pats., LLC v. Flexiworld Techs., Inc.*, No. IPR2022-00775, 2023 WL 7198014, at *7 (P.T.A.B. Nov. 1, 2023) (metadata "independently corroborate[d]" inventor testimony about conception date "because the operating system created it automatically and contemporaneously"); *see also Dana-Farber Cancer Inst., Inc. v. Ono Pharm. Co.*, 379 F. Supp. 3d 53, 86 (D. Mass. 2019), *aff'd*, 964 F.3d 1365 (Fed. Cir. 2020) (testimony independently corroborated where evidence included metadata). Thus, Patent Owner ("PO") has shown the inventors' conception with "more than their own testimony." *Linear Tech. Corp. v. Impala Linear Corp.,* 379 F.3d 1311, 1327 (Fed. Cir. 2004).

Second, Petitioner argues that Justin Marston is not credible because he stated that he and Paul Marston "made the revisions," while the metadata shows that Jon Fernyhough keyed in some edits. There is no inconsistency. Marston never asserted that **only** he and Paul Marston made edits or that no one else did. His statement that he and Paul Marston made revisions is truthful; it is corroborated by the documents.

Third, Petitioner asserts that the documents do not show conception because more than ordinary skill was required for reduction to practice. Br., at 2. The only evidence Petitioner cites in support of this argument is a notation that "significant changes" to the "initial maths" were needed. *Id*. (citing EX2004, 29 & EX2006, 53). Nothing in that statement, however, states that the "initial maths" did not work or that **more** than ordinary skill was required.

Finally, Petitioner asserts that Mr. Marston's declaration "confirms a lack of reasonable diligence." Br., at 3. As an initial matter, Mr. Marston's declaration does state "when the draft documents were sent to Sterling's prosecution counsel": by January 11, 2006 (EX2003, ¶ 12) – i.e., two days before it was filed. Petitioner also argues that Mr. Marston "does not explain" alleged "gaps." Petitioner's alleged "gaps" are the days between the "last modified" date of each document; however, each of these documents was not, of course, created, developed, and finalized on a single day. And, Mr. Marston did explain the activities that were ongoing during these periods: Paul and him were "refin[ing] the formulas to implement the relevance

model." EX2003, ¶ 10. The documents between June 7 and January 11 demonstrate the work being done by the Marstons to diligently reduce the invention to practice.

II. The Court Should Construe "*Recipient*" to Be a "*User*" that Received "*Electronic Content Sent from a Sender.*"

Patent Owner respectfully requests the Board construe "*recipient*" to be a "*user*" that has received a piece of "*electronic content sent from a sender*." PO's construction is supported by both the claims and specification. Prelim. Resp., at 21. In contrast, Petitioner argues that a "*recipient*" is any user who views or "accesses" a document (e.g., a webpage). Br., at 4-5; Pet., 33 & 65-66. Petitioner's proposed construction, however, would equate "*recipient*" with "*user*," flouting the principle that one "must presume that the use of ... different terms in the claims connotes different meanings." *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000). PO's construction should be adopted because it most naturally aligns with the description of the invention in the specification. *Phillips v. AWH Corp*., 415 F.3d 1303, 1316 (Fed. Cir. 2005).

The specification supports a PO's proposed construction. *See* Prelim. Resp., at 21 (collecting citations describing "*recipient*" as a user who has received content "sent" from a "sender"). Nevertheless, Petitioner argues that these voluminous specification citations should **be ignored** because "[t]here is no indication that these examples were intended to limit the meaning of the word '*recipient*.'" Br., at 5. Again, Petitioner is asking the Board to ignore the fundamental principles of

claim construction set forth in *Phillips*, which state that the specification is "the single best guide to the meaning of a disputed term." *Phillips*, 415 F.3d at 1315.

"[T]he context of the particular claim" also supports PO's proposed construction. *Phillips*, 415 F.3d at 1313. Every claim requires "*electronic content sent from a sender*." The term "*recipient*" should be construed in this context. Nevertheless, Petitioner encourages the Board to ignore the "*sent from a sender*" language, solely because the language does not appear in the "*identify*" **portion** of the claim. Br., at 4. Petitioner cites no law in support of this argument. In the context of the particular claim, as *Phillips* requires, a "*recipient*" is a particular type of a "*user*": a "*user*" who received "*electronic content sent from a sender*." The Board should ignore Petitioner's invitation to ignore the claim language.

Petitioner also argues that PO's proposed construction would limit "*electronic content*" to "emails and messages with senders," conflicting with dependent claims 5 and 15, which recite a "*document*." Br., at 4-5. Not true. Construing "*recipient*" to be a "*user*" who receives "*electronic content sent from a sender*" allows "*electronic content*" to include "*documents*" other than "emails and messages with senders." For example, "*documents*" attached to email messages (e.g., Word files, PDFs, photos, etc.) are also "*sent from a sender*," as are "*documents*" such as calendar invitations and reminders. Thus, PO's proposed construction does not conflict with dependent claims 5 and 15.

Next, Petitioner argues that "Sterling's construction excludes the 'relational mail system' embodiment." Br., at 5. That is incorrect. While some "*users*" in a "relational mail system" (e.g., "allowed readers") can "access" content they did not receive, that does not change the fact that the 'claims require "*identify[ing*]" a type of "*user*": "*a recipient*." A relational mail system can "*identify*" "*a recipient*."

Finally, Petitioner argues that the Board need not construe "*recipient*" because the prior art of record satisfies the claim under either party's construction. Br., at 5-6. Not true. Dumais does not disclose "*identif[ying*]" a "*user*" that received the same piece of content sent by a sender, and Krug (the reference in the Kircher/Krug combination that Petitioner relies upon for the "*recipient*" limitation) does not relate to "*sent*" content at all (it relates to searching the Internet). Because Dumais and Krug do not disclose "*identify[ing]*" a "*recipient*" under PO's construction, it is necessary for the Board to construe the term. PO's proposed construction properly construes the term in view of the claims and specification.

III. In the Context of the Claims of the '217 Patent, "*Cognate*" Is More Restrictive Than Generic Collaborative Filtering Described in Dumais.

The final issue raised in Petitioner's Reply relates to the claim term "*cognate*." Petitioner takes issue with the statement by PO's expert that "cognate users in the '217 Patent are more restricted than the generic collaborative filtering described in Dumais." EX2001, ¶ 100. Petitioner argues that "Claim 1 does not require … identification as part of 'determining a relevance score'" and that "Sterling is

importing limitations from Element 1[g][iv] into Element 1[f]." Br., at 6-7. PO's understanding of "*cognate*," however, considers the context of the entire claim. Every claim requires that the system "*identify*" a "*cognate*" "*user*" **that is also** *"a **recipient** of **the** piece of electronic **content**.*" EX1005, Claim 1; EX2001, ¶ 100. Moreover, the claims go on to explain **why** the system needs to "*identify*" this "*cognate*"/"*recipient*" user: so that the system can "*determine ... relevance*" based on "*actions on the ... content*" by the other "*cognate*"/"*recipient*" user. *Id*. Collaborative filtering in Dumais does not do any of this. Instead, Dumais uses collaborative filtering to "predict likely or possible profiles for new users." *Id*. (citing EX1006, [0055]). For these reasons, "*cognate*" users in the '217 Patent are more restricted than the generic collaborative filtering in Dumais.

Next, Petitioner argues that because the specification discusses using collaborative filtering to identify a "cognate group," "*cognate*" cannot be more restrictive than generic collaborative filtering in Dumais. Br., at 7. The point, however, is that the claims require that "*cognate*" users be "*identif[ied]*" in order to "*track*" their "*actions on the piece of electronic content*." While collaborative filtering **could be** used for that purpose, Dumais does not use collaborative filtering for that purpose. EX2001, ¶ 100. Because Petitioner relies upon Dumais for all limitations, and Dumais does not disclose what every claim requires with respect to "*cognate*" users, Dumais does not render obvious any claim.

Respectfully submitted,

Dated: April 28, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. 42.6(e), I certify that on this 29th day of April, 2025, a true and correct copy of the foregoing **Patent Owner's Sur-Reply** was served by electronic mail on Petitioner's lead and backup counsel at the following addresses:

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