

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

X CORP.,
Petitioner

v.

STERLING COMPUTERS CORPORATION,
Patent Owner.

IPR2025-00299
Patent 7,716,217 B2

Record of Oral Hearing
Held: March 11, 2026

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

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The above-entitled matter came on for hearing Wednesday, March 11, 2026, commencing at 10:00 a.m. EDT, at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

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

10:00 a.m.

JUDGE HOANG: Please be seated. Okay. Good morning.

MR. OKANO: Good morning.

JUDGE HOANG: We're convened for oral arguments in IPR2025-00299, which pertains to patentability challenges of claims in U.S. Patent number 7,716,217 B2.

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

So we'll start with appearances for Petitioner.

MR. OKANO: Your Honor, David Okano at White & Case for Petitioner X Corp. With me are Ethan Plail and also in the room is Neeraj Gupta. On the public line is our client, Mr. Zach Chibane, C-H-I-B-A-N-E.

JUDGE HOANG: Okay. And Patent Owner?

MR. PADMANABHAN: Good morning, Your Honor. Devan Padmanabhan for Sterling Corporation, Sterling Computers. And with me at counsel table is Britta Loftus. And on the public line, I believe our client has joined, Paige Marks, and potentially Katie Pflueger and maybe Brad Moore.

JUDGE HOANG: Okay. Thank you. So a couple of notes before we begin. So first, the court reporter will provide a transcript of the hearing that

1 will become part of the record in the proceeding at a later date. To ensure
2 that the transcript of this hearing is clear, we ask you to speak directly into
3 the microphone when talking and to identify specific slide numbers,
4 numbering, and figures, and any other pertinent identifying information
5 when referring to demonstratives. That'll also help me because I'm a little
6 hard of seeing, so I can follow along on my computer, if you give me the
7 slide numbers, that's better.

8 Second, the -- per the hearing order, each party is given 60 minutes of
9 total time to argue their case. Petitioner will present their opening argument
10 and may reserve rebuttal time. Patent Owner will then respond to
11 Petitioner's arguments and may reserve surrebuttal time. Petitioner may then
12 present its rebuttal, followed by Patent Owner's surrebuttal.

13 On to the matter of sealed materials, this proceeding includes
14 materials that have been or have been requested to be sealed. This hearing is
15 open to the public and we understand that Patent Owner's client is on the line
16 and also your client is on the line. This is Patent Owner's -- apparently, from
17 what I gather, Petitioner has filed a motion for sealing Patent Owner's
18 material. So I'll start with Petitioner. Is there a way the parties wish to
19 proceed regarding the sealed and requested to be sealed materials?

20 MR. OKANO: Your Honor, Petitioner filed that motion in abundance
21 of caution. We take no position on whether the information needs to be
22 sealed. Our position is that it doesn't. I mean, our position is that we defer
23 to Patent Owner in this regard.

24 JUDGE HOANG: Understood.

25 MR. PADMANABHAN: Your Honor, my guess is those two
26 documents that we're talking about aren't going to come up in the hearing.

1 JUDGE HOANG: Okay. So on objections, we note that there are
2 pending objections and motions to exclude. We've taken those objections
3 and the motions under advisement. You're welcome to use your argument
4 time to address those issues, but we won't be making any decisions on these
5 matters during this hearing.

6 Please remember that your arguments should be limited to only those
7 arguments previously presented in your briefs. Our decision will not reflect
8 any arguments that are not in the briefs. Please make it clear what
9 challenges and claims you're addressing at all times.

10 We ask that the party hold -- the parties hold any objections regarding
11 your arguments and -- regarding parties arguments, until it is your time at
12 the podium to note any of the -- to note any objections. I'll maintain a clock
13 and I'll try to give each of you all a five-minute warning during your opening
14 argument and during your rebuttal time. Our hearing room has a timer and
15 I'll set up -- set it up for each party with the requested time allotment, but
16 please try to keep track of your own time as well.

17 So Petitioner, do you wish to reserve any rebuttal time?

18 MR. OKANO: Petitioner X wishes to - to have 15 minutes of rebuttal
19 time.

20 JUDGE HOANG: And Patent Owner, do you wish to reserve? I'll
21 wait until, actually, the Petitioner's argument is over and then I'll ask you
22 that.

23 You may begin your argument when you're ready.

24 MR. OKANO: Your Honors, this is David Okano for Petitioner X
25 Corp. Today we're talking about U.S. Patent 7,716,217, which is Exhibit

1 1001 in this proceeding. We will refer to that as the '217 Patent, if that is not
2 objectionable to Your Honors.

3 Petitioner X has challenged all claims of this patent, and we assert,
4 and we believe we have shown by a preponderance of the evidence in our
5 petition that all the challenge claims are invalid as obvious under multiple
6 grounds.

7 To begin, I just want to provide context. We will get into the details.
8 So what is this '217 Patent about that we are challenging in this proceeding?
9 The '217 Patent was filed decades after the introduction, the invention of
10 email. The patent admits that it was filed well after email became
11 ubiquitous, and we discussed that in our petition at page 3 and referring to
12 the background section of the patent at columns 1, 13 to 30.

13 The patent seeks to automate on a computer what people intuitively
14 do when they look at an email or a document, to assess and categorize. Is
15 this spam? Is this something everyone else on my team will receive and
16 read? Is this from my child's teacher that all the other parents in his
17 classroom or her classroom will receive and read? That is the core, the focus
18 of the '217 Patent. As X's retained technical expert, Dr. Henry Houh,
19 explained in his declaration, which is Exhibit 1004, Paragraphs 76, 77, and
20 79, in his declaration, we have cited this at -- in our petition at page 3,
21 people had addressed the problems of receiving lots of email and trying to
22 figure out what to do about it for more than a decade before the '217 Patent
23 was filed.

24 There were many filtering and categorizing techniques in the prior art.
25 And as Dr. Houh explained in -- at Exhibit 1004, Paragraphs 79 and 83
26 through 89, which we refer to in our petition at 3 to 4, by 1980 -- sorry,

1 1992, mail systems could filter based on the content of documents. And by
2 the early 2000s, these systems could rank information, such as email, by
3 predicting the relevance of a user's interest, including on correlations of
4 interests between users. Our petition includes three such of these prior art
5 systems within the five asserted grounds.

6 So let's move to slide 27. And I apologize, we're going to jump
7 around a little bit, but I will make sure to read out the slide numbers.

8 So on the left-hand side of this, we have the claim. It is somewhat
9 lengthy. There are several limitations, but we are here today basically on
10 one, and the Board recognized this in its institution decision that the Patent
11 Owner had not challenged the prior art discloses basically all the limitations
12 of this claim except for one that reads, "Identify at least one other of the
13 plurality of users that is a recipient of the piece of electronic content and that
14 is cognate to the user." We believe that the Patent Owner will focus on this
15 in their arguments and break it up into parts.

16 But before we get to that, I mean, this limitation is a piece in a larger
17 claim and it's helpful to understand what is the alleged invention recited by
18 Claim 1? And the Board here addressed Claim 1 as representative neither
19 party really challenges that. For the purpose of this hearing, we believe
20 Claim 1 is fairly representative of the disputes between the party.

21 So what does Claim 1 recite? Track users, that is the monitoring
22 module; receive electronic content, such as an email, a document, a
23 message; calculate some measure of relevance in the form of a score based
24 on what the user does after receiving this content; identify other users who
25 have received the content and are similar in some way to this user, then
26 calculate another score, a measure of relevance; based on some factor, at

1 least one factor associated with these similar users; and then calculate a
2 score based on these two scores. That is what this claim recites.

3 And so within that claim, which is just receiving information,
4 calculating a score for one user, calculating a score for similar users, and
5 then calculating a third score based on these two scores, we are fighting --
6 the disputes today are about this identify -- basically identifying other users.
7 And the limitation up for you on slide 27 says, "Identify at least one other of
8 the plurality of users that is a recipient of the piece of electronic content and
9 that is cognate to the user."

10 So what does this limitation say? It says, "Identify multiple users who
11 receive the same email or document and are similar to each other in some
12 way." That is what this limitation is saying. At the conclusion of the trial
13 that we've been through in the past year, that is the focus of Sterling's
14 defense and what Sterling argues is this concept, having users receive --
15 multiple users receive the same content and be similar is not found in the
16 prior art. At the core, this is their argument.

17 JUDGE EASTHOM: Counsel, for your rejection or your challenge
18 ground based on Krug and -- Kircher and Krug, you're basically saying that
19 Krug, Paragraph 31, for example, if the system determines that there's a
20 group of women and so that women, they -- the system groups women in a
21 group and then they receive the same -- they search for the same item, that
22 that satisfies that limitation when it's in combination with Kircher. Is that --
23 do I hear that right or --

24 MR. OKANO: That is correct, Your Honor. The -- what -- the first
25 thing to note is that our proposed ground, our put -- the ground based on that
26 is not just Krug alone, it's that Krug, Kircher-Krug combined system, and in

1 that combined system, a person of ordinary skill in the art would have
2 combined kind of the filtering and the grouping features of the Krug system
3 to email and understood that, yes, we are taking -- we are identifying similar
4 people, such as you point out, woman and who receive the same content and
5 we're looking to what these people do with that content, and that is going to
6 inform a relevance for another user.

7 JUDGE EASTHOM: Okay. Can you address your friend's argument
8 about, they say that you don't meet the identified limitation of both of those
9 conditions, the recipient and one that's -- recipient of the same piece and one
10 that's cognate?

11 MR. OKANO: Yes, Your Honor. So the way -- what we understand
12 their argument, and they are free to elaborate, is that they're going to look at
13 the preamble and say, well, the preamble says a piece of electronic content
14 sent from a sender to a user. And then they're going to look at the
15 identifying limitation and say, well, it says recipient, and so that must mean
16 with -- from a sender, right? They're saying the middle part, this middle
17 identifying limitation, must include the from a sender from the preamble,
18 and then at the end, you know, they're -- they say, well, look at the last
19 limitation where you're calculating the score. It also says the electronic
20 content from the sender that has a sender.

21 And what we believe they are not fairly characterizing based on the
22 claim, the purpose of the invention, is that it is the system is designed to
23 have someone, you know, a user receive something, whether an email or the
24 patent at column 3, Lines 42 to 51, also make clear it could be a document,
25 but something. They receive it from a sender and they receive some kind of
26 relevance score for the document they receive.

1 But what we believe Patent Owner's argument does not account for, is
2 inconsistent with the patent, is that the purpose of this is not just to
3 understand what the user who receives this piece of content does with it, not
4 just it -- that is what -- I mean, Microsoft Outlook did. It's to figure out what
5 other people who may have somehow come into contact with the same piece
6 of content did. So it makes sense that when you receive the content, it is
7 from a sender, right? Someone might receive a document, might receive an
8 email that's from a sender. And when the ultimate output is spit out, so
9 input, output, that might be the -- for the user who receives it, but the
10 purpose of this patent is to take into account other users, and other users may
11 access this document differently. The patent at -- if -- and I'll go over these
12 examples, I guess I can flip to them right now.

13 Slide 31, if we can go here. For example, this slide makes clear that --
14 this is at column 5, 36 to 43 of the patent -- that for some content, and it's
15 talking about analysts, they might have the right to search all content related
16 to analyst processes written by other analysts, that's what it says. So some
17 content that one analyst might have received, they might be the recipient,
18 they might ultimately see the relevance. Well, the relevance still may be
19 affected by what other people who had access to, but not -- did not
20 necessarily receive it from a sender did or responded to with that content.
21 That is the purpose of the patent. You take what someone receives and you
22 see what other people do with it, and other people might not have received it
23 from a sender. They might have just been a recipient in terms of having
24 access to it, having, you know, having some way to -- well, in this example,
25 this, I guess, being able to search for it.

1 If we go to the -- I think this is the best example, but we can, we can
2 also go to slide 81 next. I mean, and this makes clear, just going back to the
3 last example, again, this is at column 3, 43 to 51, that the alleged invention is
4 not only relevant to traditional electronic email -- I'm reading from the left
5 box on slide 81 -- but it also can be used for determining relevance in
6 document management applications. Again, these are things where one
7 person may initially receive a document and want to know the relevance, but
8 the system says we can -- we, to determine this relevance, we want to
9 understand what other people may have done with it who did not receive it
10 in the same way. That is the purpose of the invention.

11 JUDGE EASTHOM: So you're saying if we go by that example. In
12 Krug Paragraph 31, you're saying these women in a group, because they're in
13 a group, they're cognate, and two of those -- one of those could be the user
14 of the claim. They don't have to, from that limitation, doesn't have to be sent
15 from -- based on the preamble, it doesn't have to be a sender involved with
16 that group, but if two women --

17 MR. OKANO: As long --

18 JUDGE EASTHOM: -- receive -- they receive -- they obtain the same
19 information --

20 MR. OKANO: That is correct.

21 JUDGE EASTHOM: -- then that satisfies both prongs because they're
22 in a group and they receive the same --

23 MR. OKANO: That is correct.

24 JUDGE EASTHOM: Okay.

25 MR. OKANO: And what you, I think what you implied, I think -- and
26 Petitioner will be frank and we looked at the Patent Owner slides. We're not

1 entirely sure what they -- their argument is about cognate, but what your
2 understanding is what we believe the patent's understanding is.

3 If we go to slide 36, you know, first of all, in the Board's institution
4 decision, the Board, I think correctly, Petitioner said correctly, pointed to the
5 Spec at 25:65 to 26:2, and that is the upper left box on slide 36. And
6 basically the Spec says, "Cognate group: For each user over time, the
7 system identifies a cognate group of the N other users regarded as most
8 similar." That is the concept I hear in what you said, Judge Easthom, and
9 that's what we believe defines a cognate group. It is a group of similar
10 people. The Spec says it. And then it says the group is defined by similar
11 past user actions and assessments. So what has -- when -- to call someone a
12 similar user, it means they might have done similar things or treated a piece
13 of content in a similar way and/or a direct input by a user, meaning they
14 have self-selected, self-identified as I am a female, or the patent gives
15 multiple examples of HR. HR may assign someone to a -- an employment
16 group, and then they would be considered cognate, similar.

17 This is a broad concept. Again, this is consistent with the purpose of
18 the invention, the alleged invention. It is --

19 JUDGE EASTHOM: I understand. Thank you. Yeah, you can move
20 or, yeah, go to some --

21 JUDGE HOANG: Sticking with this limitation and sticking with your
22 reliance on proof for it, let's assume recipient means somebody who
23 accessed the content for the sake of this discussion we're going to have. So
24 forget about the sending, having to be -- it having to be an email, just
25 somebody who accesses information is the recipient. Let's assume that.

1 Sounds like you agree that limitation 1F requires that the identified
2 second user or other user, that's the plurality of users has to be two things.
3 One, they have to receive the same content that the first or original user
4 received and, or was sent. And the second thing they need to be is cognate
5 to the original user.

6 Most of your petition relies on Paragraph 31. Can you map exactly
7 what in Paragraph 31 of Krug maps to the recipient and maps to cognate, the
8 specified group, because you're relying on the specified group to teach the
9 identified other users?

10 MR. OKANO: Yes, Your Honor. And for that, I'm going to briefly
11 step down because my colleague, Ethan Plail, is locked and loaded right on
12 that very issue.

13 So I'm going to let him speak.

14 MR. PLAIL: Good morning, Your Honor. Ethan Plail on behalf of
15 Petitioner. So just jumping right into your questions, I think it'd be helpful
16 to set some context. So -- my apologies. If we go to slide 92, this is a
17 portion of our petition. This is our petition at 67, and you'll see here that
18 we're actually describing two different groups in Krug that can satisfy the
19 cognate limitation. We're pointing to the group based off of gender, as
20 we've discussed, but we're also pointing to this second group delineated by
21 Krug, which is the access to specific items. So you know, Krug provides
22 multiple examples of different groups, and each of these examples fit in
23 within the definition of limitation 1F within the claim.

24 If we go to 90, I can break down specifically where in Paragraph 31.
25 So starting with the cognate part of the user, so we can go back to the
26 definition, and here's on slide 90, and this is the definition of a cognate from

1 the patent at 25:65 to 26:2, and it's saying this defined it two ways, based off
2 of similar past actions or direct input. And we see that same idea mirrored
3 in these two different examples in Krug. So we see the specified, the direct
4 input, and we see the automatic, which can be based off usage behaviors, or
5 in this case, specific access control.

6 So stepping forward to slide 91, when we're analyzing the cognate
7 group, we look for the examples of identifying a cognate group in the
8 specification. And the specification provides multiple ways to identify
9 cognate group, and this is in column 43 of the patent here on the left. So it
10 specifically says that this is an identification of a cognate group, and it can
11 use cluster models. It provides an example of cluster models. And one of
12 the examples of a cluster model is people who have access control. So this
13 is the same example we see from Krug of, you know, of people who have
14 access to a specific object.

15 So that's one way that these users are cognate. They can also be
16 cognate based off of their properties as a user. For example, gender. If we
17 step forward to 93, if we think about the users who all have access to the
18 same object, well, they all have access to the same object. So they must also
19 be a recipient of that object, right? If they have that object, if they're part of
20 this group from having that object, then they have to have received that
21 object.

22 JUDGE HOANG: Are you saying the mere ability to access an object
23 shows being -- shows that the user -- the other user is a recipient, just the
24 ability to access, not the actual access, but just the ability?

25 MR. PLAIL: I believe that's consistent with the specification in
26 column 43, where it provides a cluster group based off access rights. So if

1 we go back to 91, you can see that the cluster group is formed by certain
2 allowed readerships and access rights, not necessarily that they have in the
3 past accessed that. But I don't think we have to reach there because this
4 group is of people who access specific objects and a person of skill would
5 understand that these people fit into multiple categories of how a cognate
6 group is defined in the spec.

7 JUDGE HOANG: So to me, it seems like this automatic determining
8 of the user group, which is, for example, all users who access a specific
9 object, that portion you have in green, that seems to me being a recipient.
10 How does that same green portion, right, that identified group of people who
11 have access to a specific object, how does that also show cognition or being
12 cognate to the user?

13 MR. PLAIL: So I think a couple of things. As Dr. Houh explained in
14 his declaration -- and I'll go to 94 for that, yes. There's a value to clustering
15 people together who have performed the same actions on the same item or
16 the same piece of data. And so we would expect to cluster these people
17 together, a person of skill would know to cluster these things together, but
18 also if we just stick back to what the patent says on -- oh, sorry, Your
19 Honor -- on slide 91, it -- it's telling us that these cluster -- that this access
20 control can be a cognate group. It's saying that this is an example of an
21 identification of a cognate group, this access control.

22 JUDGE HOANG: So are you saying that the automatic -- the
23 example in Paragraph 31 for the group of user that is specified, and that's the
24 automatic specification based on all users who have access to a specific
25 object, that it meets both of the limitations, or both of the requirements of
26 limitation 1F?

1 MR. PLAIL: Correct, Your Honor. And, you know, just if we're
2 talking about the system holistically, you know, we see the specification
3 explained that one of the important points of relevance is what users do with
4 an item, including what they don't do with an item. A user who ignores an
5 item, going back to your access rights position, a user who ignores an item,
6 that's an indicator of relevance just as much as heavily working in an item.
7 So --

8 JUDGE HOANG: How is it the case that, if you've satisfied the
9 recipient portion of limitation 1F and it follows that you -- that means you
10 necessarily have satisfied the cognate feature of limitation 1F, how is that
11 not collapsing those two features into one?

12 MR. PLAIL: So Your Honor, I think not all groups are formed that
13 way, but this is an example of a group where each individual is a recipient
14 and where these individuals are cognate. At the end of the day, we are
15 trying to identify a singular group of people, and this is how Krug identifies.
16 If we go to, for example, the gender example, you know, we would expect,
17 again, to cluster together people who have the similar properties and also
18 have received similar content. That would be where these two groups are
19 not necessarily --

20 JUDGE HOANG: Where does Krug show in your gender example,
21 the women example, which is right above that green portion, that the gender
22 grouping also shows that all those women received the, in that specified
23 group, also received the same content as the user?

24 MR. PLAIL: So your question is where does Krug show that the
25 women also receive -- yeah, so I think in Paragraph 31, it explains that the --
26 that Krug bases -- can base these groups based off of their past activity on

1 items. And as Dr. Houh explained, we would group together people who
2 have similar actions on similar items. It also explains -- I'm sorry, but I can
3 get you the paragraph, it eludes me off the top of my head, that these groups
4 can be formed in multiple ways and people can be part of multiple groups.

5 So it is also possible for a person to be part of this group based off
6 gender and also this group of access rights or the other groups that are
7 provided as examples in group.

8 JUDGE HOANG: Okay. Thank you.

9 MR. OKANO: Thank you, Your Honor. This is David Okano again.
10 If we -- so one more thing to add to your question, Judge Hoang, is, which
11 is, again, the -- what I think Patent Owner is seeking to do is to collapse
12 other limitations into the identifying limitation. And one thing to remember
13 is the identifying limitation, if we can go put up slide 27 again. That is not
14 calculating a score. That's a different limitation. The identifying limitation
15 is just saying, here is the group of people that we want to consider to help
16 inform the score. And so in an example of Krug, and the patent says this,
17 and we -- there can be multiple groups, you can have overlapping groups,
18 the idea is to expand, to find other people that might have some bearing on
19 the relevance of this document to one user. And so in the Krug example of
20 the people who are identified as women, we would say that is a -- what is a
21 direct input.

22 So either HR or the users themselves will identify as a woman. That
23 is an example of cognate, right? And then it's not collapsing to say that,
24 well, if we consider something from the users who have received, who are a
25 recipient of the same document, from that group, so what -- that is what
26 satisfies the limitation, is that when there is a piece of content, so not all

1 content -- what Krug is saying is, not all content is going to be received by
2 every other member of a cognate group. And so those would not be
3 considered. But for the ones who do receive it, and that's the two parts, who
4 are also a recipient of the same content and are in a similar group, whether
5 that's -- that is self-selected or HR selected or -- that's what is going to be
6 considered. Again, this is not the scoring. This is just, here's a universe of
7 information we're going to treat as relevant.

8 For -- and we, as Mr. -- my colleague, Mr. Plail, said for certain
9 groups, the ones who are considered cognate based on actions, that is where
10 the -- there is overlap, right? Because if a cognate group is based on what
11 someone did with it, I think a good example is spam. If people received an
12 email or received a document and didn't open it, well, they would -- could
13 potentially be identified as a group under Krug's clustering method, which is
14 also, you know, identified in the patent. And in that sense, like, the group --
15 the creation of the cognate group itself would be based on those groups
16 being a recipient and performing some action.

17 If we can now go to slide 22 of Patent Owner's deck, I think this is
18 where, when we receive this slide, we see there -- what the Patent Owner is
19 trying to do here is rewrite the Spec and change it in ways that obviously are
20 not what the patent intended to limit. What they're trying to do is limit.
21 Again, the purpose of this patent is to expand and to understand, take into
22 account as many potential similar users as possible. So what we believe the
23 Patent Owner is trying to do, is rewrite by saying, someone must have
24 received -- to be a cognate with the user who -- and it -- who receives the
25 email or the document, only users who have done the same things as the first
26 user can count.

1 But that's not what the patent says. The patent says, you can -- what
2 you are -- you consider is anyone in the cognate group. So a -- someone
3 who is in a cognate group, whether by HR or self-selection or past actions,
4 the patent makes clear that those people are similar. It doesn't mean that
5 every single person is similar to each other. It means that the group itself
6 contains similar users. And so that's what we think one thing they're trying
7 to rewrite the Spec to limit.

8 The other thing they're trying to do is somewhat related in this, is
9 where they -- they're -- they are -- basically, they do not like the spec's
10 discussion that a -- an HR or someone, a user themselves, can basically put
11 themselves into a cognate group by saying, I'm a woman, or these people are
12 employees in this department. So they are saying that the only people in
13 cognate groups can be those who share the similar direct input as the user
14 we're considering. So the user received the document, the only users that
15 can be in a cognate group are the ones who have put the same self-
16 identification, who have, you know -- have been assigned the same
17 department. But again, that is not what the Spec says.

18 JUDGE EASTHOM: Counsel, I -- I'm sorry to interrupt. I think we
19 understand your point, your position. How about -- what do you -- what do
20 you -- can we move to the other ground and --

21 MR. OKANO: Yes. Let us turn to -- I think it is going to be most
22 helpful. I -- we would like to start with Dumais. And so that's going to be
23 slide 104. Oh, sorry. Sorry. I -- that is not correct. We're jumping around a
24 little bit, but that's going to be slide 101. Now, to begin, right, I think what
25 is -- may not have been fully fleshed out in the briefing, is that under *In re*
26 *Magnum Oil*, it is obviously Petitioner X's burden to show patent invalidity.

1 But it is, as the Federal Circuit has made clear, in the context of an IPR, it is
2 the patentee's burden to show that its claimed invention is entitled to an
3 earlier invention date. So this is Sterling's burden. They have the burden to
4 show they are entitled to an earlier date than Dumais, which is filed in June
5 29, 2005, about seven months before the provisional application. So on slide
6 101, this is what -- this -- these are the -- this is Dumais, this is the
7 provisional.

8 You can go to slide 102. So what is the critical period here? 198
9 days. It's pretty lengthy.

10 Slide 103. And so what we have here is the evidence that has been
11 produced in this case by the Patent Owner. And again, there's been a motion
12 to, you know, compel on this. But based on the emails that the Patent
13 Owner produced, there is no evidence of any work for significant gaps
14 during this one -- this 198-day period. And looking at slide 103, we see a
15 48-day gap, a 25-day gap -- two 25 day gaps, and a 59-day gap.

16 And so let's go to slide 104. And at the same time during this period,
17 again, this is the evidence that the Patent Owner has produced. We see a
18 total of 108 hours spent allegedly working on the claimed invention over
19 198 days. That is less than a total of three weeks among two people. Not a
20 lot of time.

21 JUDGE HOANG: I mean, Patent Owner made the point that that was
22 just what Marston testified as to his own time, not as far as the time that Paul
23 has been -- spent, right? There's no hours attributable to Paul -- Marston
24 right now.

25 MR. OKANO: What --

26 JUDGE HOANG: The 108 hours, those are Justin Marston's.

1 MR. OKANO: No. That is -- Your Honor --

2 JUDGE HOANG: That is everybody's.

3 MR. OKANO: -- with -- that is total. That -- with respect, Your
4 Honor, and we can go to -- let's go to slide 108.

5 JUDGE HOANG: That was Patent Owner's argument, if I recall
6 correctly. But yes, let's go to 108.

7 MR. OKANO: That is their argument. Oh, let's go to 143. We
8 actually -- we addressed that, Your Honor.

9 JUDGE HOANG: Sure.

10 MR. OKANO: So what the deposition testimony shows is -- and this
11 is Justin Marston's depo. He said that the 108 hours is an estimate of the
12 time, in total, for the entire critical period. And this is in our reply at 24, it's
13 Exhibit 1050 at 297-7 to 315. And so the questions were very clear. You
14 know, 20 hours of work, you and Paul Marston put in approximately 20
15 hours of work; it's a total. And so all the questions were not just your time,
16 but your time and Paul Marston's time.

17 And if we go to the next slide, 144, this is, again, another reply at 24.
18 This is from Paul Marston's depo, Exhibit 1064 at 116:10 through 22, and
19 another snippet at 114:21 through 22, and 84:21 to 24. And so this is Paul
20 Marston basically saying, yeah, whatever Justin said. And, you know, it's --
21 he said it's consistent with his recollections. And he also confirmed that he
22 did not do any work during that last 59 day gap that we saw earlier in the
23 slide.

24 So now we can go back to slide 108. So we have a 198-day critical
25 period, multiple significant gaps, and very little time total spent on the
26 alleged invention. And then we have, you know, I think the most critical

1 failing, which is the Federal Circuit has made clear, again, this is the
2 patentee's burden, that given the -- I mean, human nature, if someone is
3 claiming an earlier invention date, the inventor's testimony is not enough.
4 We are -- as Ronald Reagan used to say, trust but verify. So we need
5 verification of something independent. And what does the Federal Circuit
6 say very clearly? In -- the conception must be proved by something in
7 addition to the inventor's own statements and documents. And what we
8 have here, again, patentee's burden, nothing that does so.

9 Okay. Next, let's go to slide 109. Here's -- the Federal Circuit has
10 actually addressed a very similar circumstance before in this *Apator v.*
11 *Kamstrup* case. This is 887 F.3d 1293 at 1296 Fed. Cir. 2018. The
12 evidence -- I'm reading directly from the case. "The evidence proffered by
13 Mr. Drachmann, the" alleged -- or "the inventor is stuck in a catch 22.
14 Apator attempts to corroborate Mr. Drachmann's testimony with emails and
15 drawings, but the emails and drawings can only provide corroboration with
16 help from Mr. Drachmann's testimony. Mr. Drachmann's witness emails and
17 drawings alone cannot corroborate his testimony of conception."

18 So that's what we have here. We have evidence from the Marstons
19 alone saying they invented it earlier, with no independent corroboration. It's
20 this -- it is a very similar fact and the law is clear here. It's not -- this is --
21 does not meet their burden. Let's go to slide --

22 JUDGE HOANG: So Counsel, real quick.

23 MR. OKANO: Yeah.

24 JUDGE HOANG: You've identified four gaps that you say are --
25 don't have any corroborating evidence, and those are the 48-day gap, 25-day
26 gap, 95-day gap, and 59-day gap. So for the period between those gaps, is it

1 your understanding that there was work occurring, or that there was
2 corroborating evidence that there was work occurring on the invention?

3 MR. OKANO: No, Your Honor. We were being extremely generous.
4 These are just emails that -- these are just the time when there was a lot of
5 emails produced, that there were even any emails at all on dates. It's the --
6 these periods where there was -- where we were seeing gaps, there's just no
7 emails that were even produced. Now what we have here -- let's -- is --

8 Where's the ones with the last --

9 In terms of the -- when actual work was done, we have a much
10 smaller list. So again, the -- I guess the gaps are the most favorable potential
11 view of the evidence, but -- and we have actually, in slide 154, reply 25, this
12 is Exhibit 1068 at 1 to 3.

13 I mean, this is what we've done. So if you notice, a lot of these are not
14 actually documents from the inventor, they do not actually show invention.
15 They're just emails that were produced, right? The -- and they're from other
16 people. But when it comes to the actual invention, let's --

17 Now we can go to that slide. The ones with --

18 The inventors themselves admit that it's a much smaller universe. So
19 they looked at all this evidence and they said, well, which is -- which of
20 the -- these emails were actually having to do with what the alleged
21 invention is?

22 And so Justin Marston says, well, looking at all of them -- and we just
23 have an excerpt; there's a lot more emails. This one, one on the 8th of
24 November, that one likely does. That's what he said. And then later,
25 when -- after the privileged dispute, he said, okay. So this is at Exhibit 1056
26 at 18, exhibit -- and his testimony is Exhibit 1050 at 242-8 to 11. Slide 150,

1 in our reply at 24 to 25, now he's saying only the last four emails relate to
2 the claimed invention. And if you look at the date of these emails, they are
3 from January 11 through January 12, so two days before the filing of the
4 provisional application.

5 So I mean, Petitioner X would concede that it appears that there was
6 diligence beginning on January 11th before the provisional filed two days,
7 but certainly not before June 25th or 26th in 2005.

8 JUDGE HOANG: You've got about two and a half minutes.

9 MR. OKANO: What would -- does -- do Your Honors have any -- the
10 most pressing questions about that we'll spend the rest of our time on?
11 Anything?

12 JUDGE HOANG: Just -- I mean --

13 JUDGE HAGY: I have a question.

14 MR. OKANO: Oh, yes, Judge --

15 JUDGE HAGY: I have a question.

16 MR. OKANO: -- Hagy.

17 JUDGE HAGY: This is Judge Hagy. So are you saying that the
18 conception documents are not evidence? Are you applying the *Apator* case
19 to say the conception documents are not corroboration because -- just
20 because they say that they authored them and that's not enough?

21 MR. OKANO: That is correct, Your Honor. And we'll go through
22 this very quickly. Oh, yes. So here is what they are relying on, is Exhibits
23 2004 and 2006. This is our reply at 19, it's Exhibit 1068 at 1 to 2. And
24 interestingly, and we put this in context, is that you see all these other
25 documents they've produced, and again, they are the ones who said none of
26 these other ones have to do with the invention. But from the metadata, you

1 can see, oh, Marston is an author. Marston edited. And the two that they're
2 relying on actually don't have his name in the metadata; it's blank. And then
3 "last saved by" is something, right? It's not Marston, it's something. So yes,
4 in that sense, this case is on all fours, which is they are claiming that these
5 prove their earlier conception, but there's nothing to corroborate that they are
6 the ones who authored this except their own word, right? It's a catch -- that's
7 the catch 22. They're saying, trust us, we did this. Well, the documents
8 themselves don't say that unless, you know, you rely on their word.

9 And then the evidence surrounding that, and if we can go to -- get you
10 one more slide here. And I know my time is counting down, but this one is
11 good. Slide 135, Exhibit 2000, in our reply at 23, it's that their own
12 documents show that, before the critical date of June '25, everything was
13 incomplete, right? That the -- it needs to be done more, right?

14 You can go to the next slide.

15 The documents change. Like, the ones that eventually become the
16 provisional application, they change after -- between 4-18. Again, that's pre-
17 Dumais and August 16, after Dumais, they changed significantly. And then
18 actually, they changed significantly to the provisional. So the -- there is
19 consistent evolution of the documents. And again, this is their burden. They
20 have not met their burden to show the pre-Dumais, so that's exhibit -- you
21 know, the 4-18 version, provides written description support for any claim.
22 That is their burden. They have not shown that the -- this is a catch 22, just
23 like the *Apator* case.

24 And I see my time has expired. Thank you, Your Honors.

25 JUDGE HOANG: Great. So about 15 minutes and a half for your
26 rebuttal time.

1 Patent Owner, would you like to reserve any rebuttal time?

2 MR. PADMANABHAN: Ten minutes, Your Honor.

3 JUDGE HOANG: Ten minutes. Okay. So that means you've got 50
4 minutes for your initial arguments and you may begin when you're ready.

5 MR. PADMANABHAN: Just give me one second, Your Honor.

6 JUDGE HOANG: Of course.

7 MR. PADMANABHAN: Sorry, Your Honor. I don't know what
8 happened. My mouse won't go up to the top screen.

9 Thank you. Yeah. Okay. Yeah.

10 Sorry, Your Honor.

11 JUDGE HOANG: No worries.

12 MR. PADMANABHAN: May it please the Board. Your Honors, the
13 Patent Owner respectfully requests the Board to hold the claim to the '217
14 Patent patentable over the relied -- or the art relied on by Petitioner, X
15 Corporation. But before I address the merits, I'm going to spend a few
16 minutes on the relevance of the -- on the relevance algorithm as claimed,
17 because I think it'll help focus the argument.

18 So if you look at Claim 1, which we've all said is representative, the --
19 Claim 1 starts with a computer implemented system for determining a
20 relevance score. So the claims determine a relevance score and the -- it's
21 determining a relevance score with regard to a piece of electronic content.
22 I've highlighted that in green as I go through the algorithm, just so you can
23 see how the -- how that piece of electronic content is handled throughout the
24 claim. And as you can see from the claims, the content for which relevance
25 is being determined is sent from a sender to a user, and I've highlighted that
26 user in blue, and the relevance score for that piece of electronic content is

1 determined with respect to that user. Sometimes I'll call them the first user,
2 like we did in our briefs, just to make it clear. And that first user, again, by
3 the claim language, is the person to whom the first piece of electronic
4 content was sent by the sender.

5 I'll quickly run through these. The next two are these computer
6 requirements.

7 JUDGE HOANG: Counsel, please don't forget to --

8 MR. PADMANABHAN: Oh, slide number. I apologize. So I'm on
9 slide 3. I was on slide 2 before. Slide 3. Slide 3 listed two computer
10 requirements that are in the claims, a computer processor for the claimed
11 computer implemented system, and a computer readable storage medium to
12 store the program modules. And the claim specifies that these program
13 modules are configured to execute on the computer processor, which makes
14 it clear, as we've said in our papers and through Dr. Khan, that shows that
15 their computer code is basically software instructions.

16 Now, the first program module that is claimed is the monitoring
17 module. And this module is configured to track the actions of a plurality of
18 users associated with the application. So here, what the claims introduced is,
19 there was that first user that we walked through in the preamble who was
20 sent that piece of electronic content and for whom relevance is being
21 determined. And there's additional users of -- that are also being looked at,
22 are also being monitored.

23 The second program module is the first relevant -- relevance
24 measurement module. And what -- that's configured to determine a first
25 measure of relevance of the piece of electronic content. And so, based on
26 antecedent basis, the piece of electronic content is the one that the sender

1 sent and it's based, at least in part, on one or more actions of the user.
2 Again, by antecedent basis, that user is the first user for whom relevance for
3 this piece of information is being determined on that piece of content.

4 The third program module is the second relevance measurement
5 module, which will be the focus of this argument, and it's configured to do
6 two things. The first one is -- we're going to spend a little bit of time on, is
7 the -- what it's configured to do is identify at least one of -- I'm on slide 7.
8 Identify at least one other of the plurality of users that is a recipient of the
9 piece of electronic content and that is cognate to the user. So the first thing
10 that the third programming module does, is configured to do, is identify
11 another user that is both a recipient of the piece of electronic content and is
12 cognate to that first user. So the electronic piece of content that is received
13 by the recipient is the same piece of electronic content for which relevance is
14 being determined. And the module identifies a second user that is cognate to
15 the first user, the one who has sent the content and for whom relevance of
16 the content is being determined.

17 So in the next two or three slides, what I want to do is, because this is
18 such an important aspect of what we're going to be arguing about today,
19 what does the patent say about why it's important to identify another
20 recipient? The -- as we pointed out in our papers, the actions of other
21 recipients can help determine the relevance of content in a given user's
22 folders. And you can see at -- in the patent also at -- in -- and it's in
23 Paragraph 88, Exhibit 2029, you can see in the second bullet point, "When
24 determining 'the relevance value seen by the recipient,' the system considers
25 'the actions of all other recipients.'"

1 And the last is on communal filtering that's on that slide. "The '217
2 Patent teaches that 'as to communal filtering, this mechanism may use the
3 behavior of other recipients of a given piece of content to determine the
4 content's relevance to the user in question, communal relevance.'" And that's
5 exactly, kind of, what the claim is doing. You have the user in question,
6 which is the first user, and you're looking at the behavior of other users that
7 receive that same content. That's why it's important to identify that
8 recipient.

9 The patent also identifies why it's important to do the second piece,
10 which is identify another user that's cognate to the first user as part of the
11 relevance analysis. And there, if you look at the patent at columns 14, Line
12 59, the columns 15, Line 11, the whole paragraph is in there and I've severed
13 a piece of it on slide 9. And so the first sentence is, "The system may
14 identify a cognate group of the n other users regarded as most similar."
15 Again, it's to the first user. And so if you look at the last sentence that I've
16 quoted on this slide, "The actions of this particular group on an electronic
17 mail object will give more indication of its relevance to the user than would
18 a global reaction to the electronic email."

19 So what that's saying is: say you sent -- say there was a company-
20 wide email sent. What they're saying is, in the cognate group, the actions of
21 a particular group on that email will give more indication of its relevance
22 than just a global reaction to that email. And that's part of the reason that
23 the -- this identification is so important. And in fact, as we point out in Dr.
24 Khan's declaration and in our papers, the '217 Patent describes the math for
25 implementing this insight. And this is the -- this is an insight that's just not
26 in any of the art that Petitioner relies upon.

1 And you can see that in -- also in the description of what's calculated.
2 This information is then used to calculate a number of values, including the
3 cognate relevance value, cognate importance value, and local relevance
4 value, which then lend itself to what the second thing that the third
5 programming module is configured to do, which is to determine a second
6 measure of relevance on the piece of electronic content, meaning the piece
7 of electronic content that was sent to the user and for which relevance is
8 being determined with regard to that first user.

9 And so in that -- various measures are tied to that piece of electronic
10 content, you can see that, and the local importance is describing the sender
11 that sent that content, global importance is the sender that sent that content
12 on the piece of electronic -- content relevance based on that piece of
13 electronic content. And the last one is also a measure which specific to the
14 second user that is a recipient of the piece of electronic content and is
15 cognate to the first user.

16 And the last programming module that's in the claim is called the
17 relevance analysis module.

18 HEARING STAFF: Excuse us. The judge dropped off.

19 JUDGE HOANG: We're going to take a quick break to reconnect.

20 MR. PADMANABHAN: Okay.

21 (Whereupon, the above-entitled matter went off the record at 11:04
22 a.m. and resumed at 11:08 a.m.)

23 JUDGE HOANG: Okay. You may begin when you're ready.

24 MR. PADMANABHAN: Okay. Thank you, Your Honor. So I'm on
25 slide 12 and it's the fourth computer programming module that's been
26 claimed, is the relevance analysis module. And as you can see, it's a module

1 that determines the relevance score for the piece of electronic content that
2 was sent from the sender to the user and it's based in part on the two --
3 based, in part at least, on the first two measures that were calculated above
4 in the claim.

5 So Your Honor, with that overview, I'm on slide 13, and let me just
6 talk about why the prior art doesn't disclose or suggest this claim algorithm
7 for relevance. So if you look at the Dumais reference -- I'm just doing it in
8 order, but if you do look at the Dumais reference, the Dumais reference is a
9 search and retrieval system. And what it does is, it uses what it calls a user
10 model that's developed based on user activity or interaction data to modify
11 the query. And it's that that's used to do an initial search. And when the
12 results are returned, it's that same user model, it's that same thing that's used,
13 the modified query, to then work on the results for showing it. And that's
14 the relevance model.

15 So a few things that are not -- that are missing in Dumais are, one, it's
16 not in the context of the claim, which is to determine content that was sent
17 from a sender to a user. But as to the specific relevance model itself,
18 Dumais does not identify a second user that's cognate to the first user, in
19 other words the person that also received that electronic content for which
20 relevance is being determined.

21 JUDGE HOANG: Why -- Counsel, why aren't the collaborative
22 filtering techniques a way to determine cognate other users?

23 MR. PADMANABHAN: Yeah. And so, Your Honor, the key to it is,
24 I think what Petitioner is focusing on is just simply the words "collaborative
25 filtering." And this point is going to be true for both Dumais and for Krug.
26 Collaborative filtering in Dumais is used to develop a user model, so that's

1 the input into the search. It's what's used to do the search. And whereas
2 what's happening here -- and then, you know, you can use that same
3 modified query to do the analysis, but what's happening in the claim and
4 what's required in the claim is, once you have a document, you're -- based on
5 that document, you're trying to decide who also received it, and are the -- is
6 there a person that's cognate to that first user? And collaborative filtering on
7 its own is simply giving them additional models they can use on the front
8 end to do the search.

9 And that's the same point that's actually with the user group that's in
10 Paragraph 31. The user group itself is just what the user uses as the persona
11 for doing the search. Once you get the result, it's -- as I -- I have a slide on
12 this. But it's basically an algorithm that takes the user group and object
13 profile and does some analysis. And it's -- it should be in that context where
14 somebody is identifying both a recipient of the document that you're trying
15 to determine relevance for and somebody that's cognate that received that
16 document and look at their actions to see if you can say something more
17 about relevance.

18 JUDGE HOANG: Counsel, Paragraph 41 of Dumais explains that the
19 user model modifies search results. That's the ranking of the search results.
20 And so that user model has been developed -- from what I see or Petitioner
21 presents, seems to be developed based on the collaborative filtering. So how
22 isn't collaborative filtering being used in this relevance measurement?

23 MR. PADMANABHAN: So collaborative filtering is being used to
24 determine user models that you can then use to do the search.

25 JUDGE HOANG: It says on Paragraph 41, "In another aspect, results
26 modification takes the user input as is to generate a query to yield results,

1 which are then modified via user model to generate personalized results."
2 So it seems like we've got the search results and then the user model is used
3 to re-rank the search result. It says, "It is noted that modification of results
4 usually include some form of re-ranking and/or selection from a larger set of
5 alternatives."

6 MR. PADMANABHAN: Right. So you're using the user model, but
7 in that context, what you're not doing is -- at that point, you're not saying,
8 hey, for this particular thing that we're ranking for, is there a -- is there
9 another user that actually received it and is cognate to the first user?

10 JUDGE HOANG: So that user model that's shown in figure 5
11 includes other users and that's from what I gather why Paragraphs 52 and 55
12 were cited because 52 and 55 explained how you create that user model.

13 R. PADMANABHAN: Yep. And so when you use that user
14 model, again, what's not happening is, it's a more granular look in the
15 claimed invention, which is you can have user models that you then use as a
16 search, but when you get to a particular document, there's nothing in the
17 model that says, hey, I am now looking at this document for relevance. I am
18 now going to look to see who else received it, identify another person that
19 received it, at least one other person that received it, and determine if that
20 person is cognate.

21 What they've done is use user models from the people in the system
22 and say, okay, here's a user model you can use as that persona to do the
23 search. But that's putting the cart before the horse and then using that same
24 user model again on the returned results is not -- it's just taking the global
25 look at it and saying, okay, well, here are some people that may be similar in
26 some way, but I don't know what they've done specifically. I don't even

1 know if they've received the specific document or not, and I haven't
2 identified either that they received the document or that they really cognate
3 to the user. And what I'm doing is using the model that I've developed and,
4 with that search result, re-running that model to do a ranking. And so you're
5 in Dumais and this is going to be the same argument you hear from me in
6 Krug.

7 What happens is, the user group or the user model is always being
8 used on the front end just to do the search. The claim requires you then to
9 take a specific document that's returned from the search and then for that
10 piece of -- for that document, identify another user that both received that
11 document and identify a person that's cognate to the user for whom you're
12 determining relevance. And using some collaborative filtering at the
13 beginning to come up with a user group or come up with a user model is
14 different because you -- then no one is ever making a -- an attempt after you
15 get your specific results back to then say, oh, here is reference A, who else
16 received reference A? And then -- within the system. And then say, okay,
17 of the people that receive reference A, who are any of those people cognate
18 to the first user, the person for who I'm determining relevance, and for the
19 specific piece of information for which I'm determining relevance?

20 And the claim is very careful to put that together that way and the
21 Spec explains why that's important. And what happens both in Dumais and
22 in Krug, because that's what they're using, are simply user models or user
23 groups. So what they're saying is, I've created all these user models or user
24 groups. The searcher can get up and use one of these, and maybe the user
25 model is around people that like sports or whatever the thing is, but all
26 you're doing is using that persona to help with your search to then get some

1 documents. The next step is, and this is where the relevance model comes
2 in, is to then take those results and say, what are you doing specifically to do
3 the relevance ranking on the result of that search?

4 And in each instance, you're not going to find that what they did was,
5 hey, I've got a particular document that came as a result of the search, let me
6 now identify recipients of that document, first. Second, let me then identify
7 of those recipients who is cognate to the person for whom I'm determining
8 relevance for this particular document. That concept is simply absent there.
9 All they've done is say, here are some models, here is some users, and I've
10 developed using collaborative filtering some models you can use on the front
11 end to start the search and maybe that gives you a better search result than if
12 you just did a search query.

13 But in terms of relevance, which is what's being claimed here, it's just
14 not there.

15 JUDGE EASTHOM: Counsel, can I ask? I thought you argued with
16 respect to limitation 1F that Krug didn't suggest this limitation. And I -- I'm
17 just focusing on 1F now, and you have to identify a plurality of users that is
18 a recipient of a piece of the content and that is cognate to the user.

19 MR. PADMANABHAN: Yes.

20 JUDGE EASTHOM: If you go to Paragraph 31 and you have this --
21 I'll wait until you get there. Of Krug. And that's Exhibit 1008.

22 MR. PADMANABHAN: Yep. I have it.

23 JUDGE EASTHOM: Okay. So for -- I think your friends relied on
24 this sentence. It says, "The groups of users can be specified, for example all
25 women, or determined automatically, for example, all users who access a

1 specific object." And then it says that assignment to a group can be initiated
2 by the user himself and then it can be made implicitly.

3 And then -- so my question is: Suppose all these women, they're in
4 the same group and they -- it says they can also be people who access the
5 specific object, so you -- if a bunch of people access the specific object and I
6 put them in a group, why isn't that satisfying limitation 1F?

7 MR. PADMANABHAN: So two reasons, Your Honor. And let me
8 just start with the most basic reason and then I'm going to hit the language
9 also.

10 JUDGE EASTHOM: Okay.

11 MR. PADMANABHAN: Part one is, when you use the user or the
12 groups of users, what Krug teaches is you use that to do the search.

13 JUDGE EASTHOM: I -- I'm not focusing on another limitation. I'm
14 just going on, what's 1F? Why isn't 1F met?

15 MR. PADMANABHAN: Because the main point is, 1F is in the
16 context of doing relevance. And so Krug never --

17 JUDGE EASTHOM: So -- can I back you up? 1F is met, but you're
18 saying it doesn't meet another part of the claim, the relevance claim.

19 MR. PADMANABHAN: Oh, no. So 1F is also not met because
20 Krug never discloses a group where you're identifying a woman that has also
21 accessed a particular object and that's connected to the first user. This just
22 never happens.

23 JUDGE HOANG: Counsel, would you agree that in Paragraph 31 of
24 Krug, and this is only the limitation -- the portion of the limitation that
25 recites, "identify at least one other of the plurality of users, " not the
26 recipient part and not the cognate part, but just the identification of the one

1 other. Would you say that Paragraph 31, where Krug says the groups of
2 users can be specified, would you say that that meets that portion of that
3 limitation?

4 MR. PADMANABHAN: No, Your Honor, because for the -- just for
5 the identified work, it's got to be done by the system here. All that's going to
6 happen is, you're going to create user groups that the user then can use, self-
7 pick a user group to search. So the -- it's not being used, and I know --
8 you're -- it's not even -- if that -- it's just not identifying -- when I say it's not
9 identifying for relevance, it's just not identifying -- the system is never going
10 to, as part of relevance, identify anybody that both received it and is cognate.

11 JUDGE HOANG: I -- I'm not talking about the reception and the
12 cognate portion. I'm just saying, for the identification of some other users,
13 would the portion in Krug that reads the groups of users can be specified,
14 would that portion meet -- that small portion -- that small recitation of
15 limitation 1F?

16 MR. PADMANABHAN: So if you're just saying just for creating the
17 user group, did they identify some users?

18 JUDGE HOANG: Right.

19 MR. PADMANABHAN: Yeah. I mean, I can't say they don't
20 identify, but the problem -- and again, I just want to be clear, that problem is
21 the users that they're identifying there is not part of any relevance analysis.
22 It's literally to create a group that the user can use to do the search. Where
23 this invention kicks in then is when you get the search results --

24 JUDGE HOANG: So I guess that was Judge Easthom's question,
25 because that gets a different limitation. We're focusing on limitation 1F and
26 whether the art meets limitation 1F, that's different than whether or not the

1 claim in some other recitation, some other limitation actually does
2 something with that identified group.

3 MR. PADMANABHAN: Nope. So the 1F limitation is part of the
4 second relevance measurement module. And so all I'm saying is, as part of
5 the second relevance measurement module, the first thing you have to do is
6 identify at least one of the other, and then this is on slide 7, if you want to
7 see -- slide 6 right there, second relevance module. Slide 7 then says the
8 first thing that has to be done.

9 And so when I say that it's not a different limitation, it's part of the
10 same limitation, whereas when you're determining relevance for this piece of
11 electronic content, one thing that has to happen as part of the second
12 relevance measurement module is you have to identify another user that both
13 received the content for which you're determining relevance and someone
14 that's cognate to the user. And what I'm saying here is in terms of user
15 groups, you are right that they are creating a user group based on people in
16 the system for whatever, whether it's for they all read Tom Sawyer or
17 however they're doing it. But then it's the user that's just going to select that
18 to be the user profile under which he or she is going to search. That's not an
19 identification as claimed in 1F.

20 JUDGE EASTHOM: Well, can I -- maybe I get it this way. All the
21 users access a specific object -- so all these users access specific object, that
22 means they all search for the same thing, they all pull the same thing off the
23 web, right? Is that what that means to you? Maybe I'm wrong, but that's
24 how I --

25 MR. PADMANABHAN: Yeah. All groups specified are determined
26 automatically. Yeah. So they all access some specific object.

1 JUDGE EASTHOM: Okay. Then I say, I'm putting those guys in a
2 group. They access the specific object, so that meets the part about that it's a
3 recipient of a piece of electronic content, and then I put them in a group so
4 they're cognate. Why not?

5 MR. PADMANABHAN: So the problem with that is the piece of
6 electronic content that you're -- that's being claimed, again, is --

7 JUDGE EASTHOM: It's not the same piece that's in the preamble, is
8 that what you're saying?

9 MR. PADMANABHAN: It's not the same piece as in the preamble
10 and it's not the one for which relevance is being determined. So you have
11 that search result that came in.

12 JUDGE EASTHOM: Okay. But other than that, we're set, right?
13 We -- that limitation is met other than those two other limitations. Is that
14 what you're saying?

15 MR. PADMANABHAN: Nope. I'm saying, in this instance, unless
16 your hypothetical also includes that when they created the group around
17 everybody saw particular objects, particular document, that's being used to
18 search. And so if you're saying the result of that search is that document,
19 and from that hypothetical, you're saying, yep, they've identified, you know,
20 it's not in there, but yeah, we can go down that path. But the problem is,
21 when they're doing the user group and they've identified a group of people
22 that have selected some document, all that's being done with that is to now
23 do a search that returns a bunch of results.

24 And in that -- sorry. And that's the piece of content that we're talking
25 about in that claim, is you're now going to determine the relevance of
26 something that you got as a result of it. And so the piece of electronic

1 content, the reason it's in green, leaving aside sent by the sender, all that, is
2 just simply -- you got to look at that result, look at that piece of content and
3 say, okay, we now -- this is what we're going to try to determine the
4 relevance for the user.

5 JUDGE EASTHOM: Okay. And I guess that my understanding was
6 that they were using this to supplement whatever Kircher thought and then
7 that's -- I was thinking you were just saying that Kircher itself does not
8 satisfy 1F and I thought it was because of -- it didn't satisfy both prongs
9 from when I read your brief, but I think I understand your position now.

10 MR. PADMANABHAN: Yeah, no. And I --

11 JUDGE EASTHOM: We can move on.

12 MR. PADMANABHAN: Yeah. And so -- and Kircher doesn't satisfy
13 both prongs, you're right about that, and we are saying -- but the part of the
14 reason we keep saying this in our brief too is, hey, this is just the starting
15 point. We -- in our brief, we keep saying, here's the algorithm they have to
16 do. They have a user group, that user group is then used to search.

17 JUDGE EASTHOM: I still don't -- just to be clear, I don't understand
18 why it doesn't satisfy those two prongs in isolation, you know, without the
19 other parts that you're arguing.

20 MR. PADMANABHAN: Because you don't know in that -- if they're
21 cognate to that first user. All you've done -- all they've done is --

22 JUDGE EASTHOM: Well, I understand they reject their challenges
23 that -- they said that this first user, the one that's in the preamble, they could
24 be part of that whole group that's in limitation 1F.

25 MR. PADMANABHAN: So Your Honor, and this is -- I --

1 JUDGE EASTHOM: It's part of their obviousness showing. That's
2 how I understood their --

3 MR. PADMANABHAN: Yep.

4 JUDGE EASTHOM: -- challenge.

5 MR. PADMANABHAN: And if you look at the patent and why
6 people are doing the cognate relationship, and this was in slide 9, where I
7 quote this paragraph, but it's that -- it's the idea that you could send an email
8 out to the entire organization, and they say, hey, we're going to look in
9 specific to the people in a particular group to which the user belongs in a
10 department so that you can assess the relevance to that person. And so it's
11 not -- it's not an after the fact, it's looking at a particular search result and
12 then looking at that result and saying, hey, here's the document I'm trying to
13 gain relevance to. And based on that, saying, are they both cognate and did
14 they look at that -- receive that document?

15 And so you -- when they put in a cognate group, when they just pre-
16 populate a user group, they're not doing it with respect to any particular user
17 or first user. It's just something they had and the user has been using it to do
18 the search. So it's not the machine identifying anything to the extent
19 anybody is identifying something, it's self-identification by the user that is
20 now saying, I'm going to use that user group to do the search.

21 JUDGE EASTHOM: Okay. I think I understand your position. I
22 appreciate that.

23 MR. PADMANABHAN: Okay.

24 JUDGE HOANG: I apologize. We're going to have to take another
25 quick break. Judge Hagy is unable to connect. Let's go off the record for a

1 minute. I'm going to add a minute or two to your time because of this. I
2 apologize.

3 (Whereupon, the above-entitled matter went off the record at 11:29
4 a.m. and resumed at 11:30 a.m.)

5 JUDGE HOANG: Okay. So we'll resume whenever you're ready,
6 Counsel.

7 MR. PADMANABHAN: Okay. Your Honor, I'm going to continue
8 on, but let me just say one thing and just -- and I'm happy to talk about it
9 some more and it's to the comment that I may be borrowing from other
10 places in the claim.

11 When I'm talking about identified limitation, it's part of the reason, in
12 slide 7, I put the different colors in to tie it together. It's not so much to
13 borrow from other, it's to hold the -- when I say it's the relevance algorithm,
14 it's one step in that algorithm is the only reason I keep saying that, but really,
15 the words that I'm saying there are -- and the distinctions I'm making from
16 just the user group is based on the language that's in that element.

17 So with that, let me also do a broader on Kircher -- the Kircher-Krug
18 combination. So if you look at the Kircher-Krug combination, this is on
19 slide 14 for Kircher, Kircher is really an email system, but its algorithm for
20 relevance is, it looks at the criteria relating to the sender, content of the
21 message, and personalization of the message.

22 Now, in our papers, we list numerous elements that are missing, but in
23 terms of the relevance algorithm, Kircher -- and I'll focus on the second
24 bullet point first. Kircher does not identify a second user that's cognate to
25 the first user that also received the message for which relevance is being
26 determined. Now, the reason that's important is, that's why Petitioner then

1 uses Krug, as you said, Judge Easthom, and -- but Krug's algorithm, the user
2 doing the search is identified, a user profile associated with the user
3 conducting the search is used, and object profiles are compared to the user
4 profiles to determine relevance.

5 And so Krug, the first point is not for relevance as much as it is for
6 our set -- Krug is not in the context of relevance being determined on
7 content that's sent from a sender to a user. And the reason we keep saying
8 that in our papers is because of the inoperability point.

9 JUDGE EASTHOM: Okay.

10 MR. PADMANABHAN: Because of the way Krug does it using the
11 search -- the -- basically the search engine. But also, Kircher -- sorry. Also,
12 Krug does not identify a second user that's cognate to the first user and also
13 receive the message for which relevancy is being determined. And that's
14 because when you -- when they get to the portion where they're not going to
15 do the object profile thing, no one is looking to see, for this particular
16 document that was returned or object that was returned, who specifically
17 received that same object. And when I say received, I just mean in the --
18 their definition accessed it and also is cognate to the user. That analysis is
19 just not done in Krug.

20 Now with that, let me go to slide 26 and continue this discussion.

21 JUDGE EASTHOM: Can I just have another question? I'm glad you
22 raised that. I'm reading further in 31 and it says, "For a search query, the
23 user can select the profile of a user group in order to use that characteristic
24 properties to rate the relevance of the object." So it seems like once they
25 group them together and they get another -- and they get a search, the whole

1 point is to rate the relevance of what they searched based on them being in
2 that group.

3 MR. PADMANABHAN: Yep. So -- but if you think about that, rate
4 the relevance for that group, at that point, when they're doing that analysis,
5 they're -- that -- it's a generic group that accessed it or whatever, they're not
6 then identifying for the -- within that group. People that are like, okay, here
7 is our recipients of it and here's why they're cognate, it's just a generic -- at
8 best, a generic --

9 JUDGE EASTHOM: I'm sorry. We have to stop again.

10 MR. PADMANABHAN: -- profile.

11 JUDGE EASTHOM: Sorry.

12 (Whereupon, the above-entitled matter went off the record at 11:34
13 a.m. and resumed at 11:37 a.m.)

14 JUDGE HOANG: Okay. Apologies again. Whenever you're ready.

15 MR. PADMANABHAN: Okay. So looking at the sentence that we're
16 just talking about later in Paragraph 31 -- sorry. For a search query, a user
17 can select a profile of a user group in order to use their characteristics to rate
18 the relevance of the objects. That does not undercut anything I've said to
19 you, because it's what the next few slides are. It's -- the relevance in Krug is
20 then determined -- you get a set of search results back and the initial
21 relevance is then determined based on the browser. And then those search
22 results are then used to -- with the object profile to further refine that.

23 And so what I'm telling you about the -- in none of that when they're
24 doing the relevance is it ever true that as part of that analysis for a particular
25 document that they're judging for relevance to the user, are they identifying
26 another user that's cognate and received that document. At best, they use

1 some profile to do the searching, they got some results, and at that point,
2 everybody is saying, well, because they use that user group, it's met. But
3 that's just not in the context of actually doing their relevance analysis.

4 And in fact, that sentence makes that clear because it's -- to the extent
5 the profile has a role in that, it's just simply at the search level.

6 JUDGE HOANG: Okay.

7 MR. PADMANABHAN: The next is -- what I'll talk about, and it's
8 in -- it's on slide 27 where I summarize it, where you can see, in Krug, they
9 use object profiles and user profiles. They can also use a group profile. And
10 in my last bullet point, as I say, an individual user may be assigned to a
11 group profile or select one for use in a search.

12 Now -- and this is why we -- we've mentioned in our papers several
13 times, it's on slide 29, that Krug's algorithm is for search on the internet.
14 And the reason that's important here, and it's why it matters for -- it's not
15 content sent by a sender, is for a couple of different reasons. One is, the user
16 groups in Krug exists so that the user doing the searching can search using a
17 group profile instead of the user's own profile. In that context, there's no
18 teaching or suggestion for the desirability of identifying a second user that
19 received the piece of content for which relevance is being determined. And
20 as such, there's no motivation for the person of ordinary skill in the art to add
21 that feature to Kircher.

22 Now, if you go to slide 30, I -- again, I use the example that they had
23 in their papers where they point to a group where all users access a specific
24 object and all users are a group of women. And you can see in 31, what -- in
25 that example, what happens is, during the relevancy analysis, there's nobody
26 that's trying to figure out, hey, is there somebody that overlaps like a Venn

1 diagram between both? If you were -- and what you're assuming there -- and
2 it's a big assumption, but I just want to make sure the Board understands.
3 What you're assuming there is the result of the search result is that same
4 particular object, even though they use that to do the search. So that's just
5 something that is assumed in Petitioner's analysis. It's not the exact
6 relevance model that's used in Krug.

7 And if you go to slide 32, you can now see what the relevance model
8 is, in part, that's used in Krug because their expert, which is Exhibit 1004,
9 tells you. So what they use is the plugin that's shaded in blue, 10, it's a
10 plugin for a commercially-available internet browser. Kircher is not an
11 internet browser, it's an electronic message system. And what Petitioner
12 fails to do is address, much less analyze, how to add Krug's plugin to a non-
13 internet browser environment, and here is why that's important --

14 JUDGE HOANG: Counsel, I think I understand your arguments on
15 inoperability. I'd love to spend a little bit of time discussing your position
16 on qualification of Dumais and conception.

17 MR. PADMANABHAN: Conception. Yes, Your Honor. If you can
18 go to slide 40.

19 JUDGE HOANG: Thank you.

20 MR. PADMANABHAN: So Dumais's priority date is June 29th of
21 2005, and as Justin Marston testified, they conceived the invention at least as
22 early as June 7th of 2005. And this case is unique, Your Honor, in that the
23 documents that you have that corroborate this are -- you know, they have
24 Justin and Paul Marston were custodians and they evidence conception
25 because they show the work done on the math and they show the work -- and
26 they show the content of the claim elements.

1 And you can look at, in this case, Exhibits 2004, 2005, 2006, and
2 2049. And the documents themselves have the dates on them, so it's not like
3 you're relying on anything for those dates. And however you do it, there's --
4 it's conclusive evidence, really, that only the Marstons were authors of those
5 documents. And you can see the progression of those documents all the way
6 through to November, because we've got all -- every draft that we have in
7 there, we've got it through November, and you can see the progression of
8 work through there.

9 And whether -- however you read that testimony, the testimony,
10 really, when -- in the context of what happened at the deposition, was asking
11 Justin Marston about how much time it took because they would show the
12 difference between two versions and say, how much time did it take to draft
13 that? And so that doesn't necessarily account for all the time they spent
14 thinking about it other than just writing it.

15 But also, it's very clear from the testimony, they started working on
16 this and had a first draft sometime in September of '04 and continued to
17 work on it. And you can see the thinking, the drafts, the additional math
18 they worked on. And by June of 2025 -- I mean, sorry, 2005, you can see
19 that they had possession of all the elements of the claim and the math to
20 support it. They continued to refine it, but in that context, it's -- these are
21 documents -- these are the exact type of documents that you -- people rely
22 on to corroborate conception.

23 JUDGE HOANG: Let -- let's start -- let's give that the -- they claim
24 the invention was conceived on June -- I guess before June 29th, 2005. And
25 so let's get to diligence.

26 MR. PADMANABHAN: Okay.

1 JUDGE HOANG: Petitioner points out that there's a 198-day critical
2 period and that there are gaps within that.

3 MR. PADMANABHAN: Yep.

4 JUDGE HOANG: 198-day critical period. Can you explain what
5 evidence, both the testimony and corroborating of this in the record, shows
6 that there was diligence during those gaps?

7 MR. PADMANABHAN: Yep. So Your Honor, I'm looking at
8 Petitioner -- Petitioner's slide 103 so that I can hit the gaps. So the first three
9 gaps, Your Honor, really, when they say gaps, there's no question when you
10 look at the number of different drafts that we have that -- and I think the
11 testimony is consistent with this, is, yeah, they wrote those and that's the
12 date on which we have the last saved date, but there's no reason to think that
13 it was just a one-day effort. And so the first three gaps really go to the time
14 period over which we have drafts of the application all the way through to
15 early November. And so that would be the explanation and it's consistent
16 with the testimony for why there are no delays. It's just people working on
17 things with their other jobs and getting it all done and improving the
18 disclosure.

19 On the last 59-day gap, the only -- the way to think about that is two
20 ways in terms of diligence. One is, Justin Marston was -- and I have some
21 of this on slide 42, but Justin Marston was working on the TransMail
22 product itself throughout this time period. And the TransMail product is
23 what -- the -- it's the product in which they were intending to put this
24 additional improvement into.

25 And he was also running BlueSpace, which is a software company
26 that was developing and marketing TransMail. He was obtaining financing

1 for BlueSpace without which they couldn't continue to develop and to file
2 applications and support their endeavor to patent everything.

3 And in this time period, Paul Marston was teaching full-time for -- at
4 a university in London, in England, and was also writing books. In that
5 context, when you look at the last 59 days and you say, hey, it's late -- it's
6 sometime in mid or early November and now you're filing in early January?
7 You -- it is not an unreasonable delay because there was so much going on at
8 the company and he was talking about getting all of this done.

9 And in that context -- and you -- the part of the reason we put that
10 other login of all the communications with Counsel is to show that he was
11 working with Counsel. I think the testimony is on -- some of it was on
12 acquisition, some of it was on other applications, some of it was on -- it's
13 just -- he -- it shows somebody that's busy running a company, not just doing
14 this one thing. And all of it's related, because this invention was part of
15 what was going to be part of a product they were developing and marketing,
16 and that is the evidence that would show it's -- it -- they were diligent.

17 And on that point, if you look at the Federal Circuit case, the *Perfect*
18 *Surgical* case, you know, the goal of this, using the rule of reason, is to
19 assure that, in light of the evidence as a whole, the invention was not
20 abandoned or unreasonably delayed. And when you look at this time frame,
21 especially for the last 60 days, it would be hard to believe that that's an
22 unreasonable delay, given all that was going on at the company and all that
23 they were doing, and finally to be able to then file in early January.

24 JUDGE HOANG: So for the diligence aspect and some of the bullet
25 points you have on slide 42, you know, the inventors continue to work on
26 refining the disclosure, and Justin Marston was working on the TransMail

1 product, which you said the invention was added to, and running BlueSpace,
2 so that's all in testimony from Marston in the time. What corroborating
3 evidence of that testimony have you presented?

4 MR. PADMANABHAN: So the corroboration for all of that is partly
5 the list of documents that are in the privilege log, that just shows work being
6 done on a wide range of topics, including some meetings with lawyers for
7 the acquisition -- or the financing, sorry, the financing. And there were just
8 communications back and forth around other aspects of other inventions that
9 they were doing for the TransMail system. So it's really that continued work
10 and --

11 JUDGE HOANG: So you're saying a privilege log is the evidence --

12 MR. PADMANABHAN: The --

13 JUDGE HOANG: -- corroborating the testimony?

14 MR. PADMANABHAN: Privilege log is -- the privilege log just
15 showing the activity is the evidence. And there's a couple of letters, and I
16 think it's in the evidence, where it's a letter from Justin Marston to an
17 admiral that's running a -- that -- that's going to finance their -- that's going
18 to finance the company, and there's some letter like that. I think it's from
19 June of 2005.

20 JUDGE HOANG: Did you cite that in your briefing?

21 MR. PADMANABHAN: I'll have to double-check here.

22 JUDGE HOANG: Okay. No worries. It's fine. You don't have to --
23 you can --

24 MR. PADMANABHAN: Okay.

25 JUDGE HOANG: -- let me know in your rebuttal.

1 MR. PADMANABHAN: And so that's there. And then the -- and
2 then the last piece I would say is -- and this is for the -- we'll just -- it's for
3 the unredacted -- it's for the email that we produced, that was unredacted,
4 and we --

5 JUDGE HOANG: Exhibit --

6 MR. PADMANABHAN: -- sent it to them.

7 JUDGE HOANG: -- hold on, I think 1042 or 24, excuse me.

8 MR. PADMANABHAN: Yeah. That document, if you look at that
9 document, you know, Justin Marston says to the -- basically, hey, I'm -- I
10 can't find anybody else to review this to make it any better, so I'm going to
11 go ahead and file it.

12 So that would suggest that he was at least doing -- trying to do
13 something. If you do the negative of that, he's trying to do something to
14 make sure he had everything he wanted in there in that time period, the last
15 60 days. That would be the only other thing I could point to.

16 JUDGE HOANG: Okay.

17 MR. PADMANABHAN: And then -- and in terms of conception of
18 all the elements, the one that they focus in on is the identifying limitation.
19 And again, if you look at, it's my slide 43, Your Honor, you can see an
20 excerpt from Exhibit 2004. And if you look at the language that I bolded on
21 that slide, that disclosure kind of makes it clear that the identifying limitation
22 was in possession of the inventors.

23 You can see it says, "Other users' actions can be used to help
24 determine the relevance of content to a given user." And at the very last
25 sentence, it says, "If the vast majority of the users in a given department read

1 a piece of content sent globally, then the content is likely to be relevant to
2 another user in that department."

3 And again, that -- it paints the picture of, sending a global email to the
4 whole company, you could have a global reaction to it. But what the patent
5 is teaching is, hey, identify other recipients, which in this case would be the
6 people in the department, that are cognate to the user for whom you're
7 determining relevance for, and use that information in doing your relevance
8 analysis, which is exactly what the claim is requiring under the identifying
9 limitation.

10 And so you can see that they had that concept back in 2004, when it
11 was written in the 2004 -- in Exhibit 2004.

12 JUDGE HOANG: You have about two minutes left.

13 MR. PADMANABHAN: Okay. With that, Your Honor, let me just
14 address (inaudible). Your Honor, on cognate, I just want to mention one
15 thing about their slide 36. So you relied on this too, and it's why we
16 proposed the construction we propose on cognate. If you look at what they
17 cite for cognate group at the top left, they highlight that this group is defined
18 by past user actions.

19 But in all the different quotes, you can see it starts with, "for each
20 user." And the reason I highlight that is, that's exactly what's in the claim.
21 For the cognate, it's for -- it -- you're determining a cognate group with
22 respect to that first user, and that's exactly what's in the spec, and that's why
23 it's important, when you do the identification, it's an identification that's
24 done with respect to that first user and that document for which you're trying
25 to determine relevance.

1 JUDGE HOANG: Counsel, a quick question on claim construction.
2 Your claim construction said on -- in your -- get to your POR here, that we
3 should interpret the limitations on page 20 and 21 to mean that at least one
4 of the other plurality of users being identified must share similar past user
5 actions and assessments as the first user, and/or share similar direct input as
6 the first user. That's a little bit different than direct input, as far -- it seems
7 like that is a little bit different than being directly defined as being in a
8 cognate group.

9 MR. PADMANABHAN: Yeah. So the direct input by -- as the first
10 user, Your Honor, is, the only way -- like, if -- on that one, I'm thinking of
11 the -- their example of, you know, identifies as a woman. The way that
12 that's going to happen is, the first users also identify themselves as him or
13 herself as a woman, and that's why I'm saying it's -- when you're doing
14 similar direct input, it's got to be direct input from both sides. Otherwise,
15 it's -- I mean, it's -- it just seems weird that you're going to just assume that
16 the user is a man or a woman, I guess, in the -- in this example. If the direct
17 input is gender, it seems like that's one where you are looking for direct
18 input that the first user is self-identified, so that you're making that
19 judgment.

20 JUDGE HOANG: So I mean, like, if you -- if one user, either the first
21 user or the second user, but they self-identified as, let's say, woman, that
22 would put them in the cognate group of woman.

23 MR. PADMANABHAN: Cognate --

24 JUDGE HOANG: Or they would be in a -- and if the first user self-
25 identified as woman and the second user self-identified as woman, then they

1 would be cognate to each other because they have both identified themselves
2 as women.

3 MR. PADMANABHAN: That's -- I mean, I think that's as broad as
4 we're -- it's --

5 JUDGE HOANG: Yeah.

6 MR. PADMANABHAN: -- it's being --

7 JUDGE HOANG: Okay.

8 MR. PADMANABHAN: -- yeah.

9 JUDGE HOANG: But that's within the scope.

10 MR. PADMANABHAN: Well, that would be, yeah. And then --
11 so -- but the timing of it too, so when they're -- you know, when the system
12 is then looking at that is also important as part of identifying.

13 JUDGE HOANG: Okay. I was just making sure that you could -- a
14 user themselves say, "I am this characteristic."

15 MR. PADMANABHAN: Yes.

16 JUDGE HOANG: Okay.

17 MR. PADMANABHAN: Yes.

18 JUDGE HOANG: Thank you.

19 MR. PADMANABHAN: Yeah. Thank you.

20 JUDGE HOANG: All right. So we've gone a minute over, a minute
21 and a half, but we've had so many interruptions, I'll just leave it at ten for
22 your --

23 MR. PADMANABHAN: Thank you, Your Honor.

24 JUDGE HOANG: -- your rebuttal. Okay. So Petitioner, I'm going to
25 put about 16 minutes up here for your rebuttal time. And I'll let you get set
26 up and we'll begin whenever you're ready.

1 MR. OKANO: Your Honor, David Okano for Petitioner X. We're
2 ready. Listening to Mr. -- counsel for Sterling speak today, the argument
3 appears different from what we read in the papers. We were trying to
4 follow. We're -- it -- the overarching theme that I think they are trying to
5 avoid is that the patent is about determining a potential relevance score. The
6 art we have identified, this is Dumais, this is Kircher, this is Krug, these are
7 all about ranking documents, determining relevance. This is the -- these are
8 the systems we are dealing with in this space. What the Patent Owner seeks
9 to do is somehow splice this in ways that are not reasonable. Let's create
10 groups but not use them.

11 Like, why is a -- even though the references disclose identifying
12 groups, creating groups, based on similar searches of documents, similar
13 access, they're saying, well, it doesn't use -- someone else didn't use it.

14 Well, there's no purpose in identifying groups unless you are using
15 them, and our references show that. And that is what -- that is the problem
16 that these references are trying to address, is how to provide an augmented --
17 you know, something more than just based on what one user does, what
18 multiple users do. What we did not hear is what a POSITA would have
19 done. And again, this was uncontested in this Paper 13, the Institution
20 Decision at 8. "The person of ordinary skill in the art in this field had at
21 least a bachelor's degree in electrical computer engineering and related field,
22 and two or three years of experience with web or email-based content-
23 management systems."

24 So they are working -- they are a software engineer at Microsoft.
25 They are a software engineer at Google. These people are all about mining
26 data. And in fact, Dumais, which my colleague, Mr. Plail, will speak about,

1 is a Microsoft reference. These are people who are seeking to understand
2 connections between data. And we look -- looking at slides, we do not see
3 evidentiary support for the assertions that a POSITA would not have been
4 motivated to use search results, to combine references. Those are -- for
5 example, I'm -- I'll point out slide 29, no references to that.

6 And then this idea of separateness, trying to splice this into separate
7 pieces, again, is not supported by the patent itself. And if we can go to --
8 like, we have taken the liberty of putting this on the -- a screen to respond to
9 a point. It's 14:66 to 15:11 of the '217 Patent. I mean, it's not about
10 searching for a group. The Patent makes clear, we're trying to be broad.

11 It says, starting on 66 -- sorry, this is column 14, Line 66, "It is noted
12 that it may not be inherent that the population of recipients falls into separate
13 and mutually-exclusive cognate groups. Rather, each recipient may have
14 their own cognate group of those in the system most similar to the recipient.
15 Certain case may be" in -- "A may be in B's cognate group, but at the same
16 time, B may not be in A. There are other users more similar," I mean,
17 they're -- what this is saying is that there's multiple groups that are all
18 interacting. The point is to try to find similar users, create connections,
19 create something more than just what the user has done to the document
20 itself.

21 Now, there were some points about Dumais. My colleague, Mr. Plail,
22 is going to speak about those, and then I'll come back to talk about some of
23 the conception documents.

24 MR. PLAIL: Good afternoon, Your Honors. I just wanted to level-
25 set on what Dumais discloses. So Dumais is a system that tracks user
26 actions and determines an importance of those user actions on various data

1 items. So like Your Honors noted, the first thing it does is it tracks all of
2 these actions. And if we look at slide 158, we can see examples of its
3 tracking. It tracks all of these user actions, and it creates an initial weight.
4 And if you look at our slide 159, on the left-hand side, you can see that
5 initial weight is determined.

6 And then after it determines that initial weight, if you go to our next
7 slide, 160, it uses a model to further refine that initial weight based off of,
8 not just collaborative filtering as a word, but collaborative filtering based off
9 of similarity analysis, based on the content and the usage of those items.
10 And so this is very similar to how the claim works, where it creates a first
11 measure of relevance based off of the user's actions, and then it creates a
12 second measure of relevance based off of other factors.

13 Now, I want to briefly touch on the point of breaking the claim into
14 two pieces. So if we look at Patent Owner's slide 31, and this relates to the
15 Krug ground, they're looking at these two groups of distinct things, and
16 they're breaking the claim -- they're basically breaking the claim into the
17 idea of, you have to create a group of identified recipients, and then you
18 have to create a group of people who are cognate, and then look for a Venn
19 diagram. But what the claim is asking for is an identification of at least one
20 person who is a recipient and who is cognate. And so we can have one
21 person, or we can have a group. There is not this idea of overlapping Venn
22 diagrams. It's trying to identify people who have both of these properties,
23 and that's what Krug shows in both of its examples.

24 And, you know, I think if we look at both of these examples, what we
25 pointed out in our reply is that, okay, well, we have the group of all women.
26 That's one example of a group. We have the group of access control. That's

1 another access group -- another type of group. And we think both of those
2 groups -- you know, both of those group practice the identifying limitation.
3 But if you -- or even if you were to take their argument at face value and
4 have two separate groups, what Krug explains is, it's not just a person sitting
5 in one group, but that a single user can be assigned to any number of
6 groups --

7 JUDGE HOANG: Where does Krug show that?

8 MR. PLAIL: It shows that in Paragraph 31. I'm reading from our
9 reply at page 16, where we cite to Paragraph 31 of Krug, and it says that, "A
10 single user can be assigned to any number of groups," and that, "Those
11 groups can be of any nature." That's in Paragraph 110. And so we can form
12 multiple groups of any nature based off of the interactions of the users, and
13 we also cite the testimony of Dr. Houh, which explains that there is a known
14 advantage to grouping together users who have had the same -- apologies,
15 the same actions on the same data item.

16 JUDGE HOANG: But there is no just explicit description in Krug
17 where they're showing that the same user identified, or the same user group
18 is identified or created, based on both being recipient and cognate. It seems
19 like it's just the result of reading 31 in addition to the declarant's testimony.

20 MR. PLAIL: I don't quite agree, Your Honor. I would say that if we
21 use Patent Owner's example of user group 2, this is a group of all people
22 who have access to a particular object. So if we're identifying a group of
23 individuals, or any single individual, that individual has accessed the object,
24 so they are a recipient. And we know, from the specification, that access
25 rights is one way to have a cognate group. So this person satisfies both parts
26 of that identifying limitation.

1 JUDGE HOANG: So then it's, identifying the person who accessed
2 the specific object is both the recipient of the electronic content, and is also
3 cognate to the user.

4 MR. PLAIL: Yes.

5 JUDGE HOANG: How do we know that that person who accessed
6 that specific object is the same -- that object is the same object that the
7 original user received or was sent?

8 MR. PLAIL: So I think we know that based off of a couple things.
9 One is that these individuals have access to a particular object, is what it
10 says in Krug. So you know, we have, you know, a single object, and all
11 these people have access to that same object. I think the second is, you
12 know, Dr. Houh explained, based off of the math of how Krug works, it
13 basically uses a similarity analysis between user profiles, and so we'd expect
14 to cluster people together, who have done the same actions on the same user,
15 on the same items.

16 I also wanted to just level-set on some requirements of the claim real
17 quick. If we go to our slide 90, and I'm just doing this to put up these two
18 passages on the left, the identifying limitation and the definitional portion of
19 the patent, you know, Patent Owner mentioned a lot of different arguments
20 about how -- you know, how Krug uses objects and object profiles. That's
21 not excluded by this claim limitation. They discussed how Krug uses pre-
22 populated objects. Well, it uses pre-populated and automatically-determined
23 objects. We see that here in Paragraph 31. But even if it did use pre-
24 populated -- pre-populated groups, that's expressly allowed by the definition
25 here in the specification.

1 Likewise, they take issue with Krug's usage of search results and
2 search queries. Again, that is not a -- an -- a limitation of this limitation or
3 this claim. And in fact, dependent, broader limitations in these claims
4 specifically cover search limitations. So we see that the claim is broad
5 enough to cover search. It's -- it seems like a -- an unfair distinction to then
6 say Krug is -- it cannot cover the claim in that way. I will hand it back over
7 to my colleague.

8 MR. OKANO: Your Honor, David Okano again for Petitioner X. We
9 want to just briefly, in the time remaining, touch on the conception
10 arguments that we heard from Patent Owner. And again, to emphasize, this
11 is their burden. And what we -- what they did not establish --

12 JUDGE EASTHOM: Counsel, isn't it their burden of -- you have the
13 first burden, and they have to respond, but you have the overall burden.

14 MR. OKANO: We have the burden on invalidity. But what *Magnum*
15 *Oil* says, our burden is on 102, 103. That is our burden. Throughout the
16 whole petition, we agree, but *Magnum Oil* from the Federal Circuit says, "If
17 the Patent Owner is seeking to assert an earlier conception date, that is akin
18 to an affirmative defense, and it is their burden to establish an earlier
19 conception date," even though it is our burden on 102, 103. And we have
20 met our, so to say, initial burden of production with our petition, which was
21 instituted.

22 Now, if they want -- it's their burden to come back and say, "We have
23 an earlier invention date." And I want to say one thing at the outset, which
24 is, they have not established -- again, and it's their burden to do so, that any
25 of the two documents they are relying on, that's Exhibit 2004 and 2006,
26 provide written description support for a claim. And under *Dynamic*

1 *Drinkware*, that is what is required to show entitlement to an earlier priority
2 date. At -- even today, you -- all -- the only limitation you heard them talk
3 about was identifying.

4 And why is that important? This is what I want to jump into. So can
5 we go from -- starting from 113, is that what they admit is that this is
6 software, okay? And if we -- now, if we go to Sterling's slide 3, I mean,
7 again, this is Sterling's assertion, and we don't disagree, these claims are
8 computer-implemented. They're software. It's a program, okay? Let's go
9 back to our slide 22 -- 122. What they do not have is -- again, they're
10 relying on their drafts of these documents. Well, these drafts are undated, so
11 we are -- we have to rely on their word alone. And the -- what the evidence
12 showed is that someone else was contributing to this.

13 Mr. Fernyhough, and to -- even though he's not listening, probably, I
14 apologize, because I'm probably mispronouncing his name. So he was
15 involved with the coding work, and again, the claims require software. It's
16 their burden to show that their conception documents, their inventors,
17 conceived of the entire, you know, every limitation. And so Mr.
18 Fernyhough is the one who was doing this, and this is supported by the
19 documents. It's only the inventor's word, which the Federal Circuit says you
20 cannot consider.

21 Let's go to the next slide, 123. Again, in their deposition, they
22 admit --

23 JUDGE HOANG: Are you suggesting that Justin Marston and Paul
24 Marston didn't conceive of this invention of their ranking system being
25 implemented on a computer?

1 MR. OKANO: I am -- to the extent we -- you know, I -- they are
2 alleging that these limitations require algorithms. You know, the math that
3 we saw one slide said the math is not there. Sterling slide 9, right? They
4 make some argument, this insight, the math, okay, and this is, again,
5 implemented in computer software code. So it is their burden to show that
6 they have provided written description support for the claims. And again,
7 the only evidence that they are putting forward is the inventor's own
8 testimony, and that's the problematic part.

9 So we are not suggesting that, you know -- we don't know. We don't
10 know what the balance is between software and math, but we do know it's
11 their burden to show that they provide written description support for the
12 claims. And everything you -- we've heard is, the evidence is only of the
13 inventors. You know, they identified a letter from Justin Marston. Again,
14 that's his -- we haven't seen it, but that's his own evidence. It's not
15 competent under the Federal Circuit law. They say that these documents are
16 from him as a custodian. Well, that's a litigation counsel decision. That is
17 not contemporaneous evidence, independent evidence. That's what
18 Sterling's counsel elected to identify.

19 And then they talk about TransMail. Well, the evidence in the
20 deposition shows that that was not part of the invention. That's what Justin
21 Marston said. So again, these things are not working on the invention, and
22 they have not met their burden to show an earlier priority date. Your Honor,
23 I see my time is up. Petitioner X believes we have well satisfied the -- its
24 burden to show that all the challenge claims of the '217 Patent are
25 unpatentable on several grounds. And we respectfully rest at this point.

26 MR. PADMANABHAN: Sorry, Your Honor.

1 JUDGE HOANG: Whenever you're ready.

2 MR. PADMANABHAN: Just give me one more second.

3 JUDGE HOANG: No worries.

4 MR. PADMANABHAN: So Your Honor, I'm just going to hit a few
5 points that they raised. So I want to start with, they put up their slide 161,
6 and there's a couple of points I want to make off of that. So they're talking
7 about identifying a recipient, and I -- and this is in our papers, and it's also in
8 our slides, and I think it's 45 and 46. If you look at the evidence that Dr.
9 Houh has on this limitation, there's only three paragraphs. Two of them are
10 Paragraphs 245 and -- sorry. I don't want to get them wrong.

11 Yeah. So you can see it in -- it's 245 and 247 in Dumais, where it's
12 very clear that they don't have any testimony with regard to the identified
13 limitations specific to recipient. They don't have anything where Dr. Houh
14 says that I -- there is identification of a recipient in Dumais. And the same is
15 true for Krug also, and we put that up. It's in Paragraph 505 of Dr. Houh's
16 declaration. And so that, I just as a fundamental point, they lack -- they
17 don't have any evidence on that.

18 The second thing I want to point out is, he -- Mr. Okano looked at
19 column 14 of the patent, on cognate. And if you look at that -- those
20 sentences, Your Honor, at -- starting at Line 59, what the patent reads is, "In
21 regard to recognizing," quote, "cognate entities are referred to above. An
22 electronic mail system in accordance with one or more of the embodiments
23 may identify a cognate group for a user." And again, in the next sentence,
24 when you go on saying, "More particularly, for each user over time."

25 And the reason I keep highlighting that is, when they're identifying
26 cognate groups here, it's for the first user. So it's in that process during

1 relevance, they're saying, hey, here is a piece of content that is where we are
2 determining relevance for. And in that process, what that claim limitation
3 1F is doing is saying, identify, for that piece of content, somebody that
4 received it and is cognate for that user. It's not a pre-planned user group that
5 somebody selects. That's not what's happening in the claim and in --
6 specifically, in that limitation. Oh. Sorry. And I wanted to start here. In
7 our surreply at page 24, we have a citation for that investment round. It cites
8 Exhibit 2041 from 2 to 5, and that includes that letter.

9 So on the drafts, Your Honor, I just want to -- I have an email here. In
10 terms of, if you look at the Marstons' declarations, you can see the number
11 of documents that they've cited in there for corroborating evidence. I mean,
12 I'm not -- I don't want to read all of them into the record, but it's not just
13 2004, 2006. You can look at those in 2049. It goes on to, you know, 2006,
14 2007, 2008, 2010, 2011, 2012, and there's three, four -- there's probably 16
15 or 18 documents in those documents -- in those declarations to support
16 corroboration. So I don't want to leave you with the impression that it's just
17 the logs or the few documents that we've been talking about today, the
18 evidence and the cited evidence in the record for how much corroboration
19 we put in it.

20 And the last point I'll make is on this TransMail, just so you
21 understand. TransMail itself is a product, it's an email system product, that
22 the company was developing. And when they developed this relevance
23 algorithm, it was for use in that, and that's what the testimony is. It's for use
24 in that TransMail system. So -- and that's where it was intended to go. It
25 never ended up going in there, because of this pivot in 2007. But leaving
26 that aside, that was the whole point for why they testified to it. It's why they

1 were developing it. It's why they were doing everything for the company
2 for. Unless --

3 JUDGE HOANG: So you're saying, during the critical -- during the
4 critical period, TransMail, the software program, was focused on this
5 specific invention?

6 MR. PADMANABHAN: This -- TransMail was broader. It's an
7 email system, and it had other aspects to it that they've patented. But the
8 intent of the company was to then add this to that product, and that's why
9 they were developing it. That's why they were trying to patent it. It was
10 going to be a feature that was going to be in that product.

11 JUDGE HOANG: Okay.

12 MR. PADMANABHAN: Okay. All right. Unless you have other
13 questions, that's all I have, Your Honor.

14 JUDGE HOANG: Okay. Thank you all for appearing today and for
15 answering all of our questions. Again, apologies for the technical
16 difficulties. We'll take this case under advisement and we'll issue our
17 decision in due course.

18 MR. PADMANABHAN: Thank you, Your Honor.

19 JUDGE HOANG: Thank you.

20 MR. PADMANABHAN: Thank you. Thank you.

21 (Whereupon, the above-entitled matter went off the record at 12:20
22 p.m.)

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