

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.

Petitioner,

v.

STERLING COMPUTERS CORPORATION

Patent Owner.

Case IPR2025-00430

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

PATENT OWNER'S SUR-REPLY

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EXHIBIT LIST

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

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

The evidence presented by Patent Owner ("PO") shows that the inventors of U.S. Patent No. 7,716,217 ("the '217 Patent"), Justin and Paul Marston, invented before Dumais' patent application was filed. EX2003-EX2013; *see also* EX2014.¹

Notably, Petitioner **does not dispute** that the evidence shows that the inventors conceived of **every limitation** of the '217 Patent by June 7, 2005.² Instead, Petitioner argues a lack of corroborating evidence. Br., at 1. In a related proceeding, however, the Board already found that "the Conception Documents *themselves* are evidence of conception, which do not require further corroboration." Order, IPR2025-00299, Paper 13 (June 10, 2025), at 31-32 (emphasis in original & quoting *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993)). Moreover, even if the Conception Documents were not enough, here, there is additional corroboration: the metadata for the Conception Documents (EX2004, at 35; EX2006, at 61). *See Unified Pats., LLC v. Flexiworld Techs., Inc.*, No. IPR2022-00775, 2023 WL 7198014, at *7 (P.T.A.B. Nov. 1, 2023) (metadata "independently corroborate[d]"

¹ Petitioner asserts that EX2014 should be disregarded (Br., at 4), but the Board has considered such claim charts in evaluating priority. *Unified Pats., LLC v. Flexiworld Techs., Inc.*, No. IPR2022-00775, 2023 WL 7198014, at *5 (P.T.A.B. Nov. 1, 2023) (considering "a claim chart purporting to show where each limitation ... may be found in [the corroborating document]").

² Petitioner stresses that "the 'last modified' date of EX2007-EX2013 confirms each of those exhibits were edited after Dumais" (Br., at 1), but PO does not rely upon EX2007-EX2013 to show conception. Instead, PO relies upon EX2004 & EX2006 to show conception.

inventor testimony about conception date “because the operating system created it automatically and contemporaneously”); *see also Dana-Farber Cancer Inst., Inc. v. Ono Pharm. Co.*, 379 F. Supp. 3d 53, 86 (D. Mass. 2019), *aff'd*, 964 F.3d 1365 (Fed. Cir. 2020) (testimony independently corroborated where evidence included metadata). *Accord* Order, IPR2025-00299, Paper 13 (P.T.A.B. June 10, 2025), at 31 (finding PO's argument that the *metadata* independently corroborates Marston's declaration to be “reasonably based on the manner in which metadata is created”). Thus, PO has shown conception with “more than [the inventors'] own testimony.” *Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1327 (Fed. Cir. 2004).

Second, Petitioner argues that Marston is not credible because he stated that he and Paul Marston “made the revisions,” while the metadata shows that Jon Fernyhough keyed in some edits. Br., at 3.³ There is, however, no inconsistency. Marston never asserted that **only** he and Paul Marston made edits or that no one else did. His statement that he and Paul Marston made revisions is truthful; it is corroborated by the documents. *Accord* Order, IPR2025-00299, Paper 13 (P.T.A.B. June 10, 2025), at 32 (“Petitioner ... does not adequately explain how the omission of Mr. Fernyhough's contributions contradicts Mr. Marston's testimony”).

³ PO does not oppose Petitioner's offer to file “a complete version of EX2010.” Had Petitioner done so, the Board would see that the “edits” that Fernyhough “keyed in” consist of comments such as “consider renaming this section” and “[s]hrink and fit [image] on previous page.”

Third, Petitioner asserts that the documents do not show conception because more than ordinary skill was required for reduction to practice. Br., at 1-2. The only evidence Petitioner cites in support of this argument is a notation that “significant changes” to the “initial maths” were needed. *Id.* (citing EX2004, 29 & EX2006, 53). Nothing in that statement, however, states that the “initial maths” did not work or that **more** than ordinary skill was required. *Accord* Order, IPR2025-00299, Paper 13 (P.T.A.B. June 10, 2025), at 32 (finding lack of evidence in present record “that more than ordinary skill would have been required”). Petitioner also argues that Marston’s “revisit[ing] earlier drafts” of the provisional patent application somehow suggests that “he did not have a final idea of his invention.” Br., at 2. Notably, Petitioner does not point to any specific “idea” in the draft application that it asserts was not “final,” and, as discussed above, Petitioner does not dispute that the Conception Documents show that, by June 7, 2005, the inventors had conceived of every limitation of the claims. *See* EX2004, EX2006, EX2014.

Finally, Petitioner asserts that Mr. Marston’s declaration “confirms a lack of reasonable diligence,” because, it alleges, Mr. Marston “does not explain” alleged “gaps.”⁴ Br., at 2-3. Petitioner’s alleged “gaps” are the days between the “last modified” date of each document showing reduction to practice; however, each of

⁴ Contrary to Petitioner’s statement (Br., at 2), Marston’s declaration does state “when the draft documents were sent to Sterling’s prosecution counsel”: by January 11, 2006 (EX2003, ¶ 12) – i.e., two days before it was filed.

these documents was not, of course, created, developed, and finalized on a single day. And, Marston did explain the activities that were ongoing during these periods between “last modified” dates: Paul and he were “refin[ing] the formulas to implement the relevance model.” EX2003, ¶ 10. This testimony is corroborated by documents between June 7, 2005, and January 11, 2006, confirming the work being done to diligently reduce the invention to practice. *Ex Parte Olchanski*, No. Appeal 2010-001333, 2012 WL 5872286, at *3 (P.T.A.B. Nov. 16, 2012) (explaining that inventors “need only show reasonable diligence, and do not have to show work toward a constructive reduction to practice 24 hours a day, 7 days a week”).

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

Patent Owner respectfully requests the Board construe “*recipient*” to be a “*user*” that has received a piece of “*electronic content sent from a sender*.” PO’s construction is supported by both the claims and specification. *See* Prelim. Resp., at 24-26. In contrast, Petitioner argues that a “*recipient*” is any user who “access[es]” any document, including documents that were never “*sent*” (e.g., a webpage). Br., at 4.⁵ Petitioner’s proposed construction, however, would equate “*recipient*” with “*user*,” flouting the principle that one “must presume that the use

⁵ Petitioner alternatively argues that Dumais satisfies the claim under either party’s construction. Br., at 5-6. Not true. Dumais does not disclose “*identif[ying]*” a “*user*” that received the same piece of content sent by a sender. Thus, Dumais does not disclose “*identify[ing]*” a “*recipient*” under PO’s construction. It is necessary to construe the term.

of ... different terms in the claims connotes different meanings.” *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000).

PO's construction most naturally aligns with the description of the invention in the specification. *See* Prelim. Resp., at 24-26 (collecting citations describing “*recipient*” as a user who has received content “*sent*” from a “*sender*”).

Nevertheless, Petitioner argues that these voluminous specification citations should **be ignored** because “[t]here is no indication that these examples were intended to limit the meaning of the word ‘*recipient*.’” Br., at 5. Again, Petitioner is asking the Board to ignore the fundamental principles of claim construction set forth in *Phillips*, which state that the specification is “the single best guide to the meaning of a disputed term.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005).

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

Next, Petitioner argues that PO's proposed construction conflicts with particular embodiments. First, Petitioner argues that PO's proposed construction would exclude "*electronic content*" that is a "*document.*" Br., at 4-5 (citing EX1001, Claims 5 & 15). Not true. Construing "*recipient*" to be a "*user*" who receives "*electronic content sent from a sender*" still permits "*electronic content*" to include "*documents.*" For example, "*documents*" attached to email messages (e.g., Word files, PDFs, photos, etc.) are "*sent from a sender,*" as are "*documents*" such as calendar invitations and reminders. Second, Petitioner argues that PO's construction excludes the "relational mail system" embodiment. Br., at 5. That is also incorrect. While some "*users*" in a "relational mail system" (e.g., "allowed readers") can "access" content they did not receive, that does not change the fact that the claims require "*identify[ing]*" a type of "*user*": "*a recipient.*" A relational mail system can "*identify[]*" "*a recipient.*"

For these reasons and the reasons set forth in the Preliminary Response, PO respectfully requests the Court adopt its proposed construction.

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

The final issue raised in Petitioner's Reply relates to the claim term "*cognate.*" Petitioner takes issue with the statement by PO's expert that "cognate users in the '217 Patent are more restricted than the generic collaborative filtering described in Dumais." EX2001, ¶ 125; Prelim. Resp. at 37. Petitioner argues that "Claim 1 does

not require ... identification as part of ‘determining a relevance score’” and that “Sterling is importing limitations from Element 1[g][iv] into Element 1[f].” Br., at 6. PO’s understanding of “*cognate*,” however, considers the context of the entire claim. Every claim requires that the system “*identify*” a “*cognate*” “*user*” **that is also** “*a recipient of the piece of electronic content.*” EX1005, Claim 1; Prelim. Resp. at 37. Moreover, the claims go on to explain **why** the system needs to “*identify*” this “*cognate*”/“*recipient*” user: so that the system can track the “*actions on the ... content*” by the other “*cognate*”/“*recipient*” user. *Id.* Collaborative filtering in Dumais does not do any of this. Instead, Dumais uses collaborative filtering to “predict likely or possible profiles for new users.” *Id.* (citing EX1006, [0055]).

Next, Petitioner argues that, because the ‘217 Patent specification discusses using collaborative filtering to identify a “cognate group,” the mere mention of collaborative filtering in Dumais necessarily satisfies the “*cognate*” “*user*” limitation. Br., at 7.⁶ The claims, however, require that the system “*identify[]*” other “*cognate*” “*users*,” and Dumais **does not** teach or suggest using collaborative filtering to do so. EX2001, ¶ 100. Using collaborative filtering to build a profile is not the same as using collaborative filtering “*identify*” another “*cognate*” user. Dumais does not disclose what every claim requires with respect to “*cognate*” users.

⁶ Petitioner’s citation to Bieganski (Br., at 7 (citing EX1007, 6:27-36)) is a red herring and does not change the fact that **Dumais** does not teach or disclose using collaborative filtering to “*identify*” another “*cognate*” user.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. 42.6(e), I certify that on this 18th day of July, 2025, a true and correct copy of the foregoing **Patent Owner's Sur-Rely** was served by electronic mail on Petitioner's lead and backup counsel at the following addresses:

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