



March 29, 2023

Via Email (ctextip@gmail.com)

Anthony Vecchione
CText IP, LLC
6500 Greenville Ave., Suite 100
Dallas, TX 75206

Re: U.S. Patent Nos. 9,246,857 and 10,009,304

Dear Mr. Vecchione,

I write in response to your correspondence dated January 5, 2023 regarding U.S. Patent Nos. 9,246,857 ("the '857 patent") and 10,009,304 ("the '304 patent") (collectively "CText Patents").

Apple respects the valid intellectual property of others and takes very seriously allegations of infringement. Your January 5 correspondence included claim charts purporting to map claims 1 and 15 of the '857 patent and claims 1 and 14 of the '304 patent to the "Reply" functionality of iMessage. Thus, we have focused our response on the contentions set forth in those charts. If you have any additional information you would like us to consider, please provide it. But after review of the CText Patents, their file history, the claims charts you provided, and other relevant materials, we do not believe Apple requires a license.

Prosecution History and Scope of the CText Patent Claims

The '304 patent was filed as a continuation of the '857 patent. The patents share the same specification and relate to systems and methods for correlating conversations in a messaging environment. See '304 patent at 1:19-21. Specifically, the patents describe incorporating a visual cue in a discussion interface where the cue is shared by a subset of the messages that are part of an active conversation string. *Id.* at 2:18-22.

The specification discloses several different embodiments for incorporating a visual cue shared by messages in an active conversation. For example, the specification explains that "[t]he visual cue may be, for example, the color coding of messages." *Id.* at 2:22-23. In addition, the specification explains that "[i]n some embodiments, visual elements are

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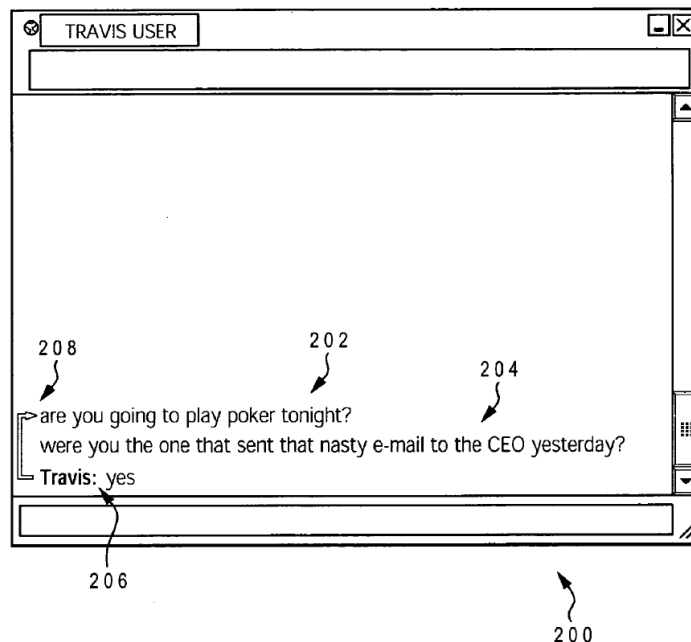
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applied to the discussion interface or the message entry location” and that the visual cue “may be reflected in the visual elements, or the visual elements may be a tint in the same color as the visual cue.” *Id.* at 2:43-48. For example, “the message entry location may be modified so that text entered appears in the same format and with the same visual cues as will appear when the text is transmitted . . . [or] at tint is applied so that the current active conversation is clear.” And, in other embodiments, “the visual cue may be a proximity from message to message[.]” *Id.* at 2:49-53.

While the specification discloses these various embodiments, the issued claims of the CText Patents are far more narrow. To overcome prior art during prosecution of the CText Patents, the claims were limited to the embodiment in which the visual cue uses visual elements applied to the message entry location. For example, during prosecution of the ’857 patent, the Examiner rejected claims broadly directed to displaying a new message with a visual cue that is shared by other messages in the conversation string. See ’857 patent file history, May 29, 2015 Non-Final Rejection at 4-6, 12. To overcome the rejection, the claims were amended to add the requirement of “**changing a visual element of the message entry location** upon receipt of the first indication **to match a first visual cue shared by message associated with the active conversation.**” See ’857 patent file history, September 19, 2015 Notice of Allowance at 3. Thus, the issued claims require not only that the messages in an active conversation share a visual cue, but that there be a change in a visual element of the message entry location to match that visual cue.

The same limitation was added during prosecution of the ’304 patent to overcome prior art. Again, the original claims of the ’304 patent were broadly directed to displaying a new message with a visual cue that associates a response text message with other texts in a conversation string. The prior art disclosed a text messaging application with visual cue indicating the new message was responsive to an earlier message in the string (arrow 208 indicating association of message 202 and 206):



See '304 patent file history, July 6, 2017 Non-Final Rejection at 7-8 (citing US2007/0203985 "Abernathy"). Thus, the '304 patent claims were amended to add the same requirement of "changing a visual element of the message entry location . . . to match a first visual cue shared with the first message." See '304 patent file history, December 27, 2017 Amendment at 2, 9-10. Specifically, the applicant explained:

[O]nce the method receives an indication that a new message will respond to some existing message, a visual element of the message entry location is transformed to reflect that visual cue. This could be by, for example, mirroring a color associated with the selected message or by mirroring text, an icon, or some other identifier associated with the selected message. Only once a user finishes entering a new message and it is received at the message entry location does the method then display the submitted message along with the visual cue in the discussion interface.

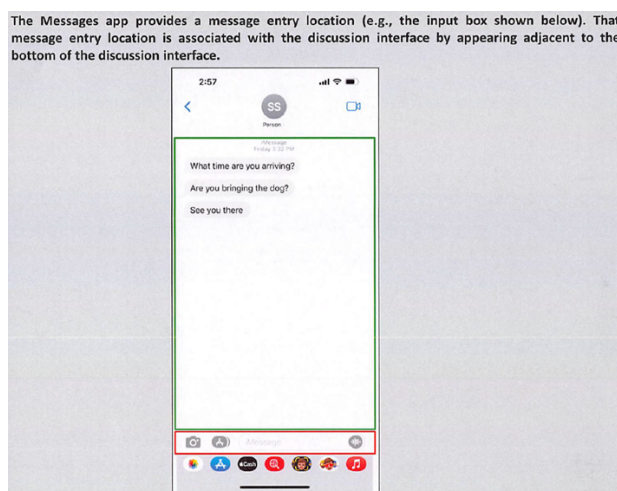


Id. at 10. Thus, both the '857 and '304 patent claims very clearly require changing a visual element of the message entry location to match a visual cue.

iMessage Does Not Meet the Requirements of the '857 and '304 Patent Claims

iMessage does not change a visual element of the message entry location to match a visual cue shared by messages in a conversation string.

The claim charts for both the '857 and '304 patents identify the text input box in iMessage as the "message entry location associated with the discussion interface":



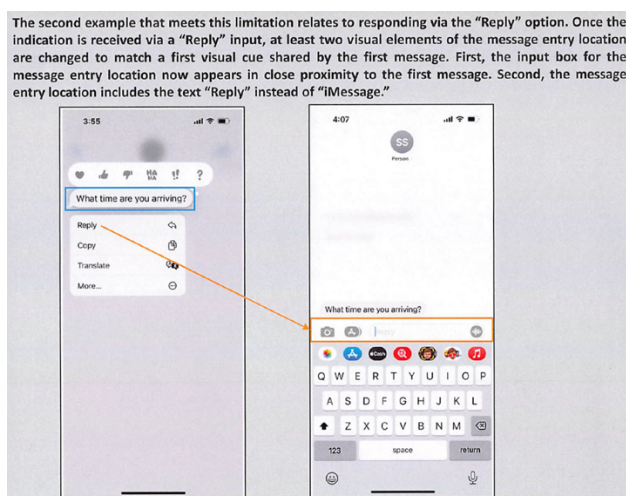
See '857 claim chart at 11; '304 claim chart at 11. The charts then point to two examples as meeting the "changing a visual element of the message entry location . . . to match a first visual cue shared with the first message" requirement. For the first example, the charts contend when using the "Tapback options such as the heart, thumbs up, or question mark," the "visual element" of the message entry location that is changed is proximity, where the Tapback bubble is placed above the first message. '857 claim chart at 13; '304 claim chart at 13.

The Tapback options bubble is not, however, what you have alleged is the "message entry location." As noted above, your claim charts point to the text input box as the "message entry location." The Tapback bubble is a distinct feature from the text input box, not just a



change of a visual element of the text input box. Placing the Tapback bubble in proximity to the first message is not changing a visual element of the text input box (i.e., the alleged “message entry location”).

For the second example, your claim charts point to responding via the “Reply” button:



'857 claim chart at 14; '304 claim chart at 14. Your chart first identifies the proximity of the reply input box to the first message as the change in the visual element of the “message entry location.” The reply input box is not, however, the same text input box alleged to be the “message entry location.” Indeed, it cannot be. The claimed “message entry location” must be “visually associated with the discussion interface.” See '857 patent, claim 1; '304 patent, claim 1. The reply input box is not visually associated with the discussion interface; it is visually associated with a different interface that has only a subset of the messages in the discussion.

Moreover, your claim chart fails to identify what is the alleged “visual element” distinct from the “visual cue.” While the specification explains that in some embodiments, the visual cue may be “proximity” from message to message (see '304 patent at 2:49-53), the embodiments covered by the claim require a visual element distinct from the visual cue that is changed to match the visual cue. Your charts conflate these two separate requirements, effectively reading out the “visual element” requirement from the claims.



Alternatively, the claim charts point to the reply input box's display of the word "reply" as the change in the visual element of the "message entry location." Again, as explained above, the reply input box is not the "message entry location." Additionally, the claims require the visual element be changed to match a visual cue shared by messages in a conversation string. To the extent your charts contend the visual cue is proximity, it is not clear how displaying the word "reply" matches message proximity.

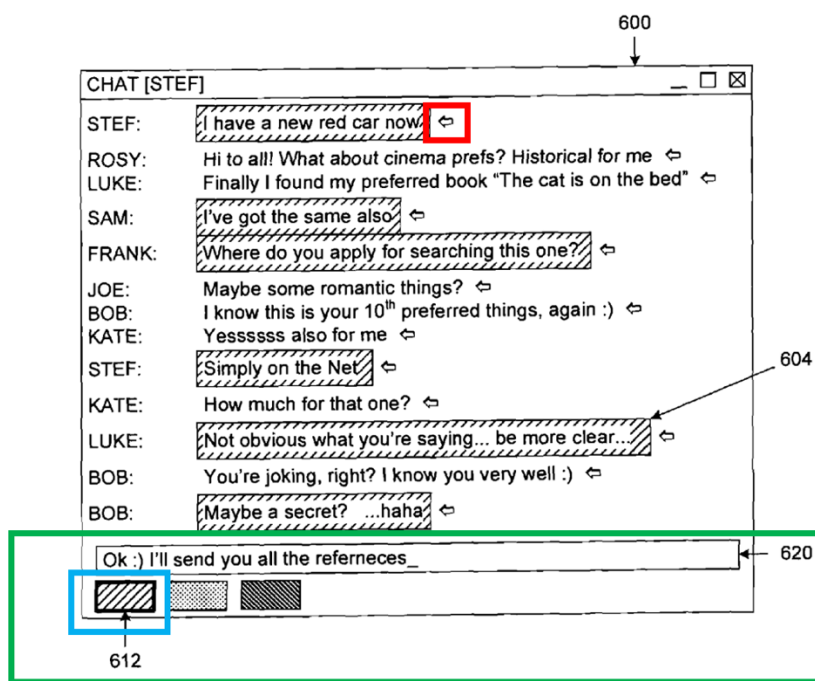
Thus, for at least these reasons, we do not believe the '857 and '304 patent claims apply to iMessage.

The '857 and '304 Patent Claims Are Invalid

Furthermore, the '857 and '304 patent claims are invalid in light of the prior art. As noted during prosecution of the '857 and '304 patents, solutions that use visual cues to correlate messages in a messaging environment that belong to a specific conversation string were known prior to December 23, 2013, the earliest claimed priority. As discussed above, Abernathy, for example, disclosed use of visual cues like an arrow to indicate what prior message a new message was responsive to as a way of correlating messages.

The applicant distinguished art like Abernathy by claiming the invention was directed to "changing a visual element of the message entry location . . . to match a first visual cue shared with the first message." But the prior art also teaches changing visual elements in a message input location to match a visual cue associated with a message string.

For example, U.S. Patent No. 8,166,408 ("Castelucci") issued on April 24, 2012 discloses each of the limitations of claim 1 of the '857 patent and claim 1 of the '304 patent, including the "changing a visual element of the message entry location" limitation.



As shown above in Fig. 6B, Castelucci's conferencing system discloses a "discussion interface" that displays a "first and second message." Specifically, Castelucci discloses a conferencing system with an interface with messages belonging to different conversation strings. See Castelucci at 1:55-62.

The discussion interface has associated with it a "message entry location," shown in the green box. Castelucci's discussion interface also provides a mechanism for "receiving a first indication that a first new message is responsive to the first message." Specifically, Castelucci's system includes an evidence mode in which users use graphical indicators (shown in the red box above) to select messages to respond to. See Castelluci at 8:27-59, FIGS. 6A and 6B.

Id., FIG. 6B (annotated). In response to receiving the first indication, the Castelucci system teaches "changing a visual element of the message entry location to match a first visual cue shared with the first message." As shown in Figure 6B, the message entry location has a background pattern "visual element" (shown in the blue box) that changes to match the



"visual cue" background pattern of the first message being responded to. The new message 620 in the message entry location is then assigned to the discussion string with the highlighted background pattern, thus disclosing teaching "displaying the first new message with the first visual cue" that is shared with the first message. Thus, Castelucci discloses all the limitations of the '857 and '304 patent claims, including the exact element – changing a visual element of the message entry location – that the applicant claimed as the inventive feature during prosecution.

In short, the materials you provided do not suggest that iMessage is covered by the '857 and '304 patent claim, and our analysis suggests that the claims are invalid in light of the prior art. Therefore, for at least the reasons discussed above, Apple believes that it does not need a license to the '857 and '304 patents. The arguments set forth above are merely examples of why Apple does not need a license, and are not intended to be exhaustive. We reserve any omitted non-infringement, invalidity, or other defenses. If you disagree with our assessment, please provide a detailed explanation of your position. Otherwise, we will consider this matter closed.

Sincerely,

A handwritten signature in black ink that reads "Michael West". The signature is written in a cursive, flowing style.

Michael West

Corporate Counsel, IP Transaction