Exhibit 6A

Practitioner's Docket No. 3324/103 ***PATENT***

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Atle Hedloy
Application No.: 11/745,186 Group No.: 2166
Filed: 05/07/2007 Examiner: Pham, Khanh B.
For: Method, System and Computer Readable Medium for Addressing Handling from an Operating System

RESPONSE UNDER 37 C.F.R. § 1.116 EXPEDITED PROCEDURE EXAMINING GROUP 2166

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT OR RESPONSE AFTER FINAL REJECTION--TRANSMITTAL

1. Transmitted herewith is an amendment after final rejection (37 C.F.R. 1.116) for this application.

STATUS

2. Applicant is a small entity.

EXTENSION OF TERM

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply. Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

	(Col.1)		(Col. 2)	(Col. 3)	SMALL ENTITY				
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO PREVIOUSLY PAID FOR	PRESENT EXTRA		RATE			ADDIT. FEE
TOTAL	33	MINUS	70	= 0	x	$ 26.00	=	$	0.00
INDEP	7	MINUS	9	= 0	x	$ 110.00	=	$	0
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM					+	$ 0.00	=	$	0.00
						TOTAL ADDIT. FEE		$	0.00

No additional fee for claims is required.

Please charge any fees required by this paper to deposit account number 19-4972.

Date: August 16, 2011

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Hedloy	Attorney Docket:	3324/103
Serial No.:	11/745,186	Art Unit:	2166
Filing Date:	May 7, 2007	Examiner:	Pham
Invention:	METHOD, SYSTEM AND COMPUTER READABLE MEDIUM FOR ADDRESSING HANDLING FROM AN OPERATING SYSTEM		

Supplemental Response H

Dear Sir/Madam:

Further to Response H, filed on July 22, 2011, Applicant submits this supplemental response responsive to the Examiner Interview of August 3, 2011.

Amendments to the Claims are reflected in the listing of claims which begin on page 2 of this paper.

Remarks begin on page 21 of this paper.

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions and listings of claims in the application:

What is claimed is:

Claims 1-118. (Cancelled).

119. (Currently Amended) A computer implemented method for information handling, the method comprising:

providing access to a contact database that can also be separately accessed and edited by a user and wherein the contact database includes at least three fields for storing contact information associated with each of one or more contacts, each of the at least three fields within the contact database being specific to a particular type of contact information selected from the group consisting of name, title, address, telephone number, and email address;

in a document configured for communication between people and comprising textual information, analyzing in a computer process textual information in the document electronically displayed to identify a portion of that textual information as first contact information, without user designation of a specific part of the electronically displayed textual information to be subject to the analyzing, wherein the first contact information is at least one of a name, a title, an address, a telephone number, and an email address;

after identifying the first contact information, performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing, wherein the set of potential actions includes:

(i) initiating an electronic search in the contact database for the first contact information identified as a portion of the textual information in the document in

order to find whether the first contact information is included in the contact database;

when a contact in the contact database includes the first contact information, if second contact information in the contact database is associated with that contact, electronically displaying at least a portion of the second contact information, wherein the second contact information is at least one of a name, a title, an address, a telephone number, and an email address; and

(ii) initiating electronic communication using the first contact information;

wherein the computer implemented method is configured to perform both action (i) and action (ii) using the first contact information previously identified as a result of the analyzing; and

providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing.

120. (Cancelled)

121. (Previously Presented) A method according to claim 119, wherein the computer implemented method is embodied in a client and the client is selected from a group consisting of a computer, a cell phone, a palm top device, and a personal organizer.

122. (Previously Presented) A method according to claim 121, wherein the first contact information is a name, the second contact information is an address, and the client is a computer.

123. (Previously Presented) A method according to claim 121, wherein the first contact information is a telephone number.

124. (Previously Presented) A method according to claim 121, wherein the first contact information is a telephone number, the second contact information is a name, and the client is a cell phone.

125. (Currently Amended) At least one non-transitory computer readable medium encoded with instructions which when loaded on at least one computer, establish processes for information handling, the processes comprising:

providing access to a contact database that can also be separately accessed and edited by a user and wherein the contact database includes at least three fields for storing contact information associated with each of one or more contacts, each of the at least three fields within the contact database being specific to a particular type of contact information selected from the group consisting of name, title, address, telephone number, and email address;

in a document configured for communication between people and comprising textual information, analyzing in a computer process textual information in the document electronically displayed to identify a portion of that textual information as first contact information, without user designation of a specific part of the electronically displayed textual information to be subject to the analyzing, wherein the first contact information is at least one of a name, a title, an address, a telephone number, and an email address;

after identifying the first contact information, performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing, wherein the set of potential actions includes:

(i) initiating an electronic search in the contact database for the first contact information identified as a portion of the textual information in the document in order to find whether the first contact information is included in the contact database;

when a contact in the contact database includes the first contact information, if second contact information in the contact database is associated with that contact, electronically displaying at least a portion of the second contact information, wherein the second contact information is at least one of a name, a title, an address, a telephone number, and an email address; and

(ii) initiating electronic communication using the first contact information;

wherein the ~~computer implemented method is~~ processes are configured to perform both action (i) and action (ii) using the first contact information previously identified as a result of the analyzing; and

providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing.

126. (Cancelled).

127. (Previously Presented) At least one non-transitory computer readable medium according to claim 125, wherein the at least one non-transitory computer readable medium is embodied in a client and the client selected from a group consisting of a computer, a cell phone, a palm top device, and a personal organizer.

128. (Previously Presented) At least one non-transitory computer readable medium according to claim 127, wherein the first contact information is a name, the second contact information is an address, and the client is a computer.

129. (Previously Presented) At least one non-transitory computer readable medium according to claim 127, wherein the first contact information is a telephone number.

130. (Previously Presented) At least one non-transitory computer readable medium according to claim 127, wherein the first contact information is a telephone number, the second contact information is a name, and the client is a cell phone.

131. (Currently Amended) An apparatus for information handling, the apparatus comprising:

a processor; and

a memory storing instructions executable by the processor to perform processes that include:

providing access to a contact database that can also be separately accessed and edited by a user and wherein the contact database includes at least three fields for storing contact information associated with each of one or more contacts, each of the at least three fields within the contact database being specific to a particular type of contact information selected from the group consisting of name, title, address, telephone number, and email address;

in a document configured for communication between people and comprising textual information, analyzing in a computer process textual information in the document electronically displayed to identify a portion of that textual information as first contact information, without user designation of a specific part of the electronically displayed textual information to be subject to the analyzing, wherein the first contact information is at least one of a name, a title, an address, a telephone number, and an email address;

after identifying the first contact information, performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing, wherein the set of potential actions includes:

(i) initiating an electronic search in the contact database for the first contact information identified as a portion of the textual information in the

document in order to find whether the first contact information is included in the contact database;

when a contact in the contact database includes the first contact information, if second contact information in the contact database is associated with that contact, electronically displaying at least a portion of the second contact information, wherein the second contact information is at least one of a name, a title, an address, a telephone number, and an email address; and

(ii) initiating electronic communication using the first contact information;

wherein the ~~computer implemented method is~~ processes are configured to perform both action (i) and action (ii) using the first contact information previously identified as a result of the analyzing; and

providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing.

132. (Cancelled).

133. (Previously Presented) An apparatus according to claim 131, wherein the apparatus is selected from a group consisting of a computer, a cell phone, a palm top device, and a personal organizer.

134. (Previously Presented) An apparatus according to claim 133, wherein the first contact information is a name, the second contact information is an address, and the apparatus is a computer.

135. (Previously Presented) An apparatus according to claim 133, wherein the first contact information is a telephone number.

136. (Previously Presented) An apparatus according to claim 133, wherein the first contact information is a telephone number, the second contact information is a name, and the apparatus is a cell phone.

137. (Previously Presented) A computerized method for information handling, the method comprising:

displaying information in a document electronically using a computer program;

electronically analyzing the information to identify a portion of that information as contact information including at least one of a name without an address and a name with an address;

providing an input device configured to allow a user to use the input device to command the program to perform at least one of:

(i) inserting address information from an information source and associated with the name into the document, and

(ii) storing at least part of the contact information in the information source;

wherein the program is configured to perform both actions (i) and action (ii);

during the displaying, receiving an execute command from the input device, wherein accessing and manipulating the input device are the only user actions required to cause initiation and completion of the analyzing;

when the contact information is identified as including a name without an address, electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes the name, if address information in the information source is associated with the name, causing insertion of the address information into the document; and

when the contact information is identified as including a name with an address, (a) electronically prompting the user with an option to save electronically in the information source at least some of the contact information, and (b) electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes at least one contact with the name, prompting the user to make a decision whether to store the name and address as a new contact or to update one of the at least one contact.

138. (Previously Presented) At least one non-transitory computer readable medium encoded with instructions which when loaded on at least one computer, establish processes for information handling, comprising:

displaying information in a document electronically using a computer program;

electronically analyzing the information to identify a portion of that information as contact information including at least one of a name without an address and a name with an address;

providing an input device configured to allow a user to use the input device to command the program to perform at least one of:

(i) inserting address information from an information source and associated with the name into the document, and

(ii) storing at least part of the contact information in the information source;

wherein the program is configured to perform both action (i) and action (ii);

during the displaying, receiving an execute command from the input device, wherein accessing and manipulating the input device are the only user actions required to cause initiation and completion of the analyzing;

when the contact information is identified as including a name without an address, electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes the name, if address information in the information source is associated with the name, causing insertion of the address information into the document; and

when the contact information is identified as including a name with an address, (a) electronically prompting the user with an option to save electronically in the information source at least some of the contact information, and (b) electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes at least one contact with the name, prompting the user to make a decision whether to store the name and address as a new contact or to update one of the at least one contact.

139. (Previously Presented) A computerized method for information handling, the method comprising:

displaying information in a document electronically using a computer program;

electronically analyzing the information to identify a portion of that information as contact information including at least a name;

providing an input device configured to allow a user to use the input device to command the program to perform at least one action selected from the group consisting of:

(i) inserting address information from an information source and associated with the name into the document, and

(ii) storing at least part of the contact information in the information source;

wherein the program is configured to perform both action (i) and action (ii);

during the displaying, receiving an execute command from the input device, wherein accessing and manipulating the input device are the only user actions required to cause initiation and completion of the analyzing;

when the program performs action (i), electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes the name, if address information in the information source is associated with the name, causing insertion of the address information into the document; and

when the program performs action (ii), electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes at least one contact with the name, prompting the user to make a decision whether to store the name as a new contact or to update one of the at least one contact.

140. (Previously Presented) A computerized method for information handling according to claim 139, further comprising:

when the program performs action (i) and the information source includes more than one address associated with the name, prompting the user to choose one of the addresses to use for insertion into the document.

141. (Previously Presented) At least one non-transitory computer readable medium encoded with instructions which when loaded on at least one computer, establish processes for information handling, comprising:

displaying information in a document electronically using a computer program;

electronically analyzing the information to identify a portion of that information as contact information including at least a name;

providing an input device configured to allow a user to use the input device to command the program to perform at least one action selected from the group consisting of:

(i) inserting address information from an information source and associated with the name into the document, and

(ii) storing at least part of the contact information in the information source;

wherein the program is configured to perform both action (i) and action (ii);

during the displaying, receiving an execute command from the input device, wherein accessing and manipulating the input device are the only user actions required to cause initiation and completion of the analyzing;

when the program performs action (i), electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes the name, if address information in the information source is associated with the name, causing insertion of the address information into the document; and

when the program performs action (ii), electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes at least one contact with the name, prompting the user to make a decision whether to store the name as a new contact or to update one of the at least one contact.

142. (Previously Presented) At least one non-transitory computer readable medium according to 141, wherein the instructions further establish processes wherein:

when the program performs action (i) and the information source includes more than one address associated with the name, prompting the user to choose one of the addresses to use for insertion into the document.

143. (Previously Presented) A method according to claim 119, wherein the input device is a menu and the single execute command includes the user's selection of a menu choice from the menu.

144. (Previously Presented) At least one non-transitory computer readable medium according to claim 125, wherein the input device is a menu and the single execute command includes the user's selection of a menu choice from the menu.

145. (Previously Presented) An apparatus according to claim 131, wherein the input device is a menu and the single execute command includes the user's selection of a menu choice from the menu.

146. (Previously Presented) A method according to claim 119, wherein the input device is a button within a window.

147. (Previously Presented) At least one non-transitory computer readable medium according to claim 125, wherein the input device is a button within a window.

148. (Previously Presented) An apparatus according to claim 131, wherein the input device is a button within a window.

149. (Previously Presented) A method according to claim 119, wherein when the first contact information is an e-mail address, initiating electronic communication using the first contact information comprises creating an e-mail using the e-mail address.

150. (Previously Presented) At least one non-transitory computer readable medium according to claim 125, wherein when the first contact information is an e-mail address, initiating electronic communication using the first contact information comprises creating an e-mail using the e-mail address.

151. (Previously Presented) An apparatus according to claim 131, wherein when the first contact information is an e-mail address, initiating electronic communication using the first contact information comprises creating an e-mail using the e-mail address.

152-154. (Cancelled)

155. (New) A method according to claim 119, wherein the set of potential actions further includes:

(iii) allowing the user to cause addition of at least some of the first contact information into the contact database.

156. (New) At least one non-transitory computer readable medium according to claim 125, wherein the set of potential actions further includes:

(iii) allowing the user to cause addition of at least some of the first contact information into the contact database.

157. (New) An apparatus according to claim 131, wherein the set of potential actions further includes:

(iii) allowing the user to cause addition of at least some of the first contact information into the contact database.

REMARKS

The Applicant thanks Examiner Pham and Examiner Alam for their time during the examiner interview on August 3, 2011, in which the Goodwin reference and the Miller reference were discussed with Bruce Sunstein and Jakub Michna, attorneys for the applicant. During the interview, Examiner Pham and Examiner Alam asked the applicant to provide more context for the analyzing process in the claims. Also, Examiner Pham and Examiner Alam were concerned about the phrase "allowing the user to make a decision."

The present amendments to the claims are responsive to the Examiners' concerns and the remarks are submitted to show that the rejection of the pending claims on the basis of the Goodwin reference and the Miller reference is improper.

1. Amendments and Support

Claims 119, 121-125, 127-131, 133-151 and 155-157 are currently pending in the application. Claims 137-142 are allowed and claims 119, 121-125, 127-131, 133-136, and 143-151 are rejected. Claims 119, 125, and 131 are amended and claims 155, 156, and 157 are new. No new matter has been added to the claims with these amendments.

Independent claims 119, 125, and 131 are amended to provide more context for the analyzing process. As amended, the claims require analyzing textual information in a document "configured for communication between people and comprising textual information." Support for this amendment can be found in, for example, page 6, lines 13-15 and page 8, lines 3-5 of the application.

Additionally, claims 119, 125, and 131 have been amended to require "initiating an electronic search in the contact database for the first contact information *identified as*

a portion of the information in the document." Support for this amendment can be found in the application at, for example, Figure 1, numerals 4, 6, 10, and 14 and page 6, lines 13-23.

Also, the language of "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database" is not included in the claims with this amendment. This language was added in Response H filed on July 22, 2011 and the amendments in that response have not been entered. *See* Advisory Action of August 10, 2011.

New dependent claims 155, 156, and 157 are identical to previously cancelled claims 152, 153, and 154.

2. Independent Claims 119, 125, and 131

Claim 119 (along with corresponding medium and apparatus claims 125 and 131 respectively) are directed to information handling. The claims require "providing access to a contact database that can also be separately accessed and edited by a user."

As amended, the claims now require "in a document configured for communication between people and comprising textual information, analyzing in a computer process textual information in the document electronically displayed to identify a portion of that textual information as first contact information."

After the analyzing to identify first contact information, the claims require "performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing."

The first potential action includes "(i) initiating an electronic search in the contact database for the first contact information identified as a portion of the textual information in the document in order to find whether the first contact information is included in the contact database" and "when a contact in the contact database includes the first contact information, if second contact information in the contact database is associated with that contact, electronically displaying at least a portion of the second contact information."

The second potential action includes "(ii) initiating electronic communication using the first contact information."

The claims also include "providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing."

3. Distinction of the Claimed Subject Matter from the Art of Record

Independent claims 119, 125, 131 and their dependent claims are rejected as obvious by the Goodwin reference in view of the Miller reference. Alone or in combination, however, these references do not meet the limitations of independent claims 119, 125, and 131.

I. The Cited References Fail to Disclose or Suggest a Search in a Contact Database for First Contact Information Identified as a Portion of the Textual Information in a Document.

As amended, the claims first require "analyzing in a computer process textual information in a document electronically displayed to identify a portion of that textual information as first contact information." Then, after the analyzing identifies a portion of the textual information as first contact information, the claims require "initiating an electronic search in the contact database for at least a part of the first contact information

identified as a portion of the textual information in the document in order to find whether the part of the first contact information is included in the contact database."

Searching in the contact database for contact information that has been "identified as a portion of the textual information in the document" does not appear in any of the cited references. There is nothing in the Miller reference that discloses or suggests searching in a contact database. The focus of the Miller reference is parsing information in a document and linking the parsed information with candidate actions. Miller, Abstract.

Moreover, the processes taught by Miller are spelled out in detail in the logical flow diagrams of Miller's figures 8, 9, and 10, and nowhere in any of these processes is there a reference to searching a contact database. The office action argues that the passage at col. 4, line 58 to col. 5, line 50 discloses an electronic search for an identified e-mail address. Below is an excerpt from the cited passage:

> FIG. 4 illustrates an example of an analyzer server 220, which includes grammars 410 and a string library 420 such as a dictionary, each with associated actions. One of the grammars 410 is a telephone number grammar with associated actions for dialing a number identified by the telephone number grammar or placing the number in an electronic telephone book. Analyzer server 220 also includes *grammars* for post-office addresses, *e-mail addresses* and dates, and a *string library* 420 containing important names. When analyzer server 220 identifies an address using the "e-mail address" grammar, actions for sending e-mail to the identified address and putting the identified address.

Miller reference, col. 5, lines 6-18 (emphasis added). At most, the passage and the excerpt above disclose using "grammars" and a "string library" to detect contact information within the contents of a document. *See also* Miller reference, col. 6, line 34-55. Nowhere does the above passage disclose a search for identified contact information

in a document in order to find whether the contact information is included in a contact database, let alone a search which is distinct from analyzing, as required by the claims.

The identification of contact information using grammars and a string library in Miller does not meet the claim limitation of searching for contact information in the specified contact database for at least three reasons. Firstly, the claims require a search for at least a part of the first contact information that was *already identified* by the analyzing. The Miller reference takes the opposite approach by using the grammars and a string library to *detect* an item of contact information *for the first time*. Secondly, the grammar of an item of contact information is not the item of contact information itself, which is what the claims require. Thirdly, neither the grammars nor the string library disclosed by the Miller reference qualify as a contact database, let alone the specific contact database required by the claims. The claims require "a contact database that can also be separately accessed and edited by a user." Furthermore, the contact database "includes at least three fields for storing contact information associated with each of one or more contacts, each of the at least three fields within the contact database being specific to a particular type of contact information." For these reasons, the Miller reference fails to disclose or suggest "initiating an electronic search in the contact database for at least a part the *first contact information identified as a portion of the textual information in the document*", as required by the claims.

The Goodwin reference also fails to disclose this limitation of the claims. In the Goodwin reference, the user enters the search string into a search screen and the search string is used to perform a search in an address book. Goodwin reference, col. 4, lines 52-58. Thus, the Goodwin reference simply searches for the string that the user enters into

the search screen, as opposed to the claimed subject matter which requires first identifying first contact information within a document and then searching in the contact database "for at least a portion of the first contact information *identified as a portion of the textual information in the document*." Furthermore, as amended, the claims require identifying first contact information in a document "configured for communication between people." The search screen of Goodwin does not constitute a document, let alone a document configured for communication between people, as required by the claims. Accordingly, for this additional reason, searching in a contact database for at least a portion of the first contact information identified within a document is neither disclosed nor suggested by Miller or by Goodwin. The combination of Miller with Goodwin fares no better, as we show below.

II. The Proposed Combination of the Goodwin Reference and the Miller Reference is Impossible.

In rejecting the claims for obviousness, the office action admits that the Goodwin reference does not disclose "analyzing … without user designation", as required by the claims. Final Office Action, page 4. Furthermore, as amended, the claims additionally require identifying first contact information in a document "configured for communication between people." Both of these features are lacking in Goodwin.

The Goodwin reference discloses searching in an address book for a search string that is entered into a "search screen" by the user. Goodwin reference, col. 4, lines 52-58. The search screen of Goodwin does not constitute a document, let alone a document configured for communication between people, as required by the claims. In an attempt to address the shortfall of the Goodwin reference in relation to the claimed subject matter,

the office action relies on the Miller reference to meet the limitation of "analyzing … without user designation" in the claims.

The hallmark of the Goodwin reference is that *the user* points out information-of-interest by entering a search string into a search screen, configured specifically for searching, to initiate a search query:

> Thus, the user can press folder "A" in order to retrieve all of those persons whose last name begins with an "A". This is fine and good, except in instances where the user may have forgotten the name of the individual, or can remember only certain aspects of the individual which may not even be related to his name. For example, the user may only remember that the person who he wants to find is someone who lives in "Mainville", or someone who works for a company "ABC". Or, for that matter, the only thing the user remembers is that the person's first name is "John". Given the incomplete recollection, with the present invention, the user only needs to press the search button of the FIG. 6 screen to retrieve the search screen such as that shown in FIG. 7.

Goodwin, col. 4, lines 41-55. Thus, the system disclosed by the Goodwin reference allows the user to search for information-of-interest to him (*e.g.*, specific information that he can remember about an individual), and Goodwin fails to disclose or suggest analyzing a document as required by the claims herein. In direct contrast, the Miller reference, which lacks a contact database altogether, is that the computer system points out the information-of-interest within a document. In particular, the focus of the Miller reference is to provide a user with potential actions for grammars that are detected within a document.

Thus, the proposed combination of Miller with Goodwin is impossible. In the Goodwin reference, the user enters a search string into a "search screen" (not a document) and thereby designates what should be processed and searched in the contact database. Manual entry of the search string into a "search screen" is at the heart of

Goodwin's technology. It is impossible to enter information into a search screen without the user designating the information to be searched.

Simply saying the Miller reference does not require user designation for analyzing is insufficient to provide a rationale for combining it with Goodwin, because the office action is trying to use the claim itself to justify the combination used to reject the claim. This is improper hindsight. Indeed, the law requires that there must be a rationale found in the prior art for the combination. A conclusory statement cannot support a *prima facie* case of rejection. *KSR v. Teleflex*, 550 U.S. 398 (2007), requires an explicit analysis by the office action. "To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ('[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness')." 550 U.S. 398 at 418. *See also* MPEP 2142.

Goodwin's requirement of manual entry of the search string into a "search screen" to find contact information in a contact database is not further informed by Miller, because Miller in fact lacks a contact database altogether. Therefore the Miller reference can teach nothing to a skilled artisan familiar with the Goodwin reference about accessing information in a contact database. In other words, the office action's combination of Miller with Goodwin is impossible and driven entirely by impermissible hindsight.

Because manual entry of the search string into a "search screen" taught by Goodwin is not further informed by Miller and because such manual entry is utterly

inconsistent with the claim requirement of "analyzing … without user designation", the rejection of the claims is improper and must be withdrawn.

III. There is No Basis for Combining the Distinct Approaches of the Goodwin and Miller References.

Besides the impossibility of the combination of Miller with Goodwin, such a combination would have to modify the Goodwin reference's operating principles, and in fact would render it inoperable for its intended purpose. As described above in detail, the system disclosed by the Goodwin reference allows the user to search for information-of-interest designated by the user within a "search screen" (*namely*, specific information that he can remember about an individual). In direct contrast, the hallmark of the Miller reference is that the computer system points out the information-of-interest within a document. In particular, the focus of the Miller reference is to provide a user with potential actions for grammars that are detected within a document.

The office action simply ignores these distinct approaches. In fact, the rational itself impermissibly changes the operating principle of the Goodwin reference:

> Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Miller with Goodwin in order to provide an automated process for identifying contact information and therefore reduce burden on the user *by eliminating manual user input of contact information*.

Final Office Action, page 4 (emphasis added). Indeed, the entire purpose of the Goodwin reference is to search for information that the user manually inputs into a search screen that is not a document, as required by the claims pending herein, but rather is specifically designed to receive a user-specified search input. This rational expressly modifies this operating principle by entirely eliminating it. *See* MPEP 2143.01 ("If the proposed modification or combination of the prior art would change the principle of operation of

the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.") (*In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). Furthermore, without a manual user input, the system taught by the Goodwin reference would be rendered inoperable for its intended purpose because there would be no way for the user to input and search for information-of-interest. *See* MPEP 2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."). In the Miller reference, the user cannot specify information-of-interest and thereafter search for that information-of-interest. Instead, in the Miller reference, only information that fits a grammar or string library entry is identified. This identification process has nothing to do with the user's interests. Even if by chance the identified information was considered to be "information-of-interest" by the user, the Miller reference fails to disclose or suggest searching for that identified information.

As shown above, instead of explaining why and how the references could be combined in a logical way, the office action impermissibly reconstructs the elements and limitations of the claims based solely on "knowledge gleaned" from the Applicant's disclosure, particularly his teaching to combine an analysis process with a searching process. MPEP 2145(X)(A). For this additional reason, the claims are patentable over the Goodwin and Miller references.

And furthermore, as explained above, even if the combination of Miller and Goodwin were proper (which it is not), both Miller and Goodwin fail to disclose or

suggest searching in a contact database for first contact information identified as a portion of the textual information in a document.

For at least these reasons, independent claims 119, 125, and 131 are patentable over the Goodwin and Miller references, either alone or in combination. Dependent claims 121-124, 127-130, 133-136, and 143-151 are patentable for similar reasons.

Applicant believes that all of the rejections have been addressed and a notice of allowance is respectfully solicited. If any fees are required for consideration of this amendment, please charge account number 19-4972. To further expedite prosecution, the Examiner may call Bruce Sunstein or Jakub Michna at 617-443-9292 if he has any further questions.

Respectfully submitted,

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/Jakub M. Michna, #61,033/

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03324/00103 1496260.1

Exhibit 6B

Practitioner's Docket No. 3324/103 ***PATENT***

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Atle Hedloy
Application No.: 11/745,186 Group No.: 2166
Filed: 05/07/2007 Examiner: Pham, Khanh B.
For: Method, System and Computer Readable Medium for Addressing Handling from an Operating System

RESPONSE UNDER 37 C.F.R. § 1.116 EXPEDITED PROCEDURE EXAMINING GROUP 2166

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT OR RESPONSE AFTER FINAL REJECTION--TRANSMITTAL

1. Transmitted herewith is an amendment after final rejection (37 C.F.R. 1.116) for this application.

STATUS

2. Applicant is a small entity.

EXTENSION OF TERM

3. The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply. Applicant petitions for an extension of time under 37 C.F.R. 1.136 (fees: 37 C.F.R. 1.17(a)(1)-(4)) for one month:

Fee: $65.00

FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

	(Col.1)		(Col. 2)	(Col. 3)	SMALL ENTITY				
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE			ADDIT. FEE	
TOTAL	33	MINUS	70	= 0	x	$	26.00	= $	0.00
INDEP	7	MINUS	9	= 0	x	$	110.00	= $	0
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM					+	$	0.00	= $	0.00
							TOTAL ADDIT. FEE	$	0.00

No additional fee for claims is required.

FEE PAYMENT

5. Authorization is hereby made to charge the amount of $65.00 to Deposit Account No. 19-4972.

Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

Date: September 9, 2011

/Jakub M. Michna, #61,033/

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Hedloy	Attorney Docket:	3324/103
Serial No.:	11/745,186	Art Unit:	2166
Filing Date:	May 7, 2007	Examiner:	Pham
Invention:	METHOD, SYSTEM AND COMPUTER READABLE MEDIUM FOR ADDRESSING HANDLING FROM AN OPERATING SYSTEM		

Supplement to Supplemental Response H

Dear Sir/Madam:

Further to Supplemental Response H, filed on August 16, 2011, Applicant submits this supplemental response responsive to the Examiner Interview of September 1, 2011.

Amendments to the Claims are reflected in the listing of claims which begin on page 2 of this paper.

Remarks begin on page 21 of this paper.

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions and listings of claims in the application:

What is claimed is:

Claims 1-118. (Cancelled).

119. (Currently Amended) A computer implemented method for information handling, the method comprising:

providing access to a contact database that can also be separately accessed and edited by a user and wherein the contact database includes at least three fields for storing contact information associated with each of one or more contacts, each of the at least three fields within the contact database being specific to a particular type of contact information selected from the group consisting of name, title, address, telephone number, and email address;

in a document configured to be stored with textual information for later retrieval ~~for communication between people and comprising textual information~~, analyzing in a computer process textual information in the document electronically displayed to identify a portion of that textual information as first contact information, without user designation of a specific part of the electronically displayed textual information to be subject to the analyzing, wherein the first contact information is at least one of a name, a title, an address, a telephone number, and an email address;

after identifying the first contact information, performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing, wherein the set of potential actions includes:

(i) initiating an electronic search in the contact database for the first contact information identified as a portion of the textual information in the document in order to find whether the first contact information is included in the contact database;

when a contact in the contact database includes the first contact information, if second contact information in the contact database is associated with that contact, electronically displaying at least a portion of the second contact information, wherein the second contact information is at least one of a name, a title, an address, a telephone number, and an email address; and

(ii) initiating electronic communication using the first contact information;

wherein the computer implemented method is configured to perform both action (i) and action (ii) using the first contact information previously identified as a result of the analyzing; and

providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing.

120. (Cancelled)

121. (Previously Presented) A method according to claim 119, wherein the computer implemented method is embodied in a client and the client is selected from a group consisting of a computer, a cell phone, a palm top device, and a personal organizer.

122. (Previously Presented) A method according to claim 121, wherein the first contact information is a name, the second contact information is an address, and the client is a computer.

123. (Previously Presented) A method according to claim 121, wherein the first contact information is a telephone number.

124. (Previously Presented) A method according to claim 121, wherein the first contact information is a telephone number, the second contact information is a name, and the client is a cell phone.

125. (Currently Amended) At least one non-transitory computer readable medium encoded with instructions which when loaded on at least one computer, establish processes for information handling, the processes comprising:

providing access to a contact database that can also be separately accessed and edited by a user and wherein the contact database includes at least three fields for storing contact information associated with each of one or more contacts, each of the at least three fields within the contact database being specific to a particular type of contact information selected from the group consisting of name, title, address, telephone number, and email address;

in a document configured to be stored with textual information for later retrieval ~~for communication between people and comprising textual information~~, analyzing in a computer process textual information in the document electronically displayed to identify a portion of that textual information as first contact information, without user designation of a specific part of the electronically displayed textual information to be subject to the analyzing, wherein the first contact information is at least one of a name, a title, an address, a telephone number, and an email address;

after identifying the first contact information, performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing, wherein the set of potential actions includes:

(i) initiating an electronic search in the contact database for the first contact information identified as a portion of the textual information in the document in order to find whether the first contact information is included in the contact database;

when a contact in the contact database includes the first contact information, if second contact information in the contact database is associated with that contact, electronically displaying at least a portion of the second contact information, wherein the second contact information is at least one of a name, a title, an address, a telephone number, and an email address; and

(ii) initiating electronic communication using the first contact information; wherein the processes are configured to perform both action (i) and action (ii) using the first contact information previously identified as a result of the analyzing; and

providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing.

126. (Cancelled).

127. (Previously Presented) At least one non-transitory computer readable medium according to claim 125, wherein the at least one non-transitory computer readable medium is embodied in a client and the client selected from a group consisting of a computer, a cell phone, a palm top device, and a personal organizer.

128. (Previously Presented) At least one non-transitory computer readable medium according to claim 127, wherein the first contact information is a name, the second contact information is an address, and the client is a computer.

129. (Previously Presented) At least one non-transitory computer readable medium according to claim 127, wherein the first contact information is a telephone number.

130. (Previously Presented) At least one non-transitory computer readable medium according to claim 127, wherein the first contact information is a telephone number, the second contact information is a name, and the client is a cell phone.

131. (Currently Amended) An apparatus for information handling, the apparatus comprising:

a processor; and

a memory storing instructions executable by the processor to perform processes that include:

providing access to a contact database that can also be separately accessed and edited by a user and wherein the contact database includes at least three fields for storing contact information associated with each of one or more contacts, each of the at least three fields within the contact database being specific to a particular type of contact information selected from the group consisting of name, title, address, telephone number, and email address;

~~in a document configured for communication between people and comprising textual information,~~ analyzing in a computer process textual information in ~~the~~ a document electronically displayed to identify a portion of that textual information as first contact information, without user designation of a specific part of the electronically displayed textual information to be subject to the analyzing, wherein the first contact information is at least one of a name, a title, an address, a telephone number, and an email address;

after identifying the first contact information, performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing, wherein the set of potential actions includes:

(i) initiating an electronic search in the contact database for the first contact information identified as a portion of the textual information in the

document in order to find whether the first contact information is included in the contact database;

when a contact in the contact database includes the first contact information, if second contact information in the contact database is associated with that contact, electronically displaying at least a portion of the second contact information, wherein the second contact information is at least one of a name, a title, an address, a telephone number, and an email address; and

(ii) initiating electronic communication using the first contact information;

wherein the processes are configured to perform both action (i) and action (ii) using the first contact information previously identified as a result of the analyzing; and

providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing.

132. (Cancelled).

133. (Previously Presented) An apparatus according to claim 131, wherein the apparatus is selected from a group consisting of a computer, a cell phone, a palm top device, and a personal organizer.

134. (Previously Presented) An apparatus according to claim 133, wherein the first contact information is a name, the second contact information is an address, and the apparatus is a computer.

135. (Previously Presented) An apparatus according to claim 133, wherein the first contact information is a telephone number.

136. (Previously Presented) An apparatus according to claim 133, wherein the first contact information is a telephone number, the second contact information is a name, and the apparatus is a cell phone.

137. (Previously Presented) A computerized method for information handling, the method comprising:

displaying information in a document electronically using a computer program;

electronically analyzing the information to identify a portion of that information as contact information including at least one of a name without an address and a name with an address;

providing an input device configured to allow a user to use the input device to command the program to perform at least one of:

(i) inserting address information from an information source and associated with the name into the document, and

(ii) storing at least part of the contact information in the information source;

wherein the program is configured to perform both actions (i) and action (ii);

during the displaying, receiving an execute command from the input device, wherein accessing and manipulating the input device are the only user actions required to cause initiation and completion of the analyzing;

when the contact information is identified as including a name without an address, electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes the name, if address information in the information source is associated with the name, causing insertion of the address information into the document; and

when the contact information is identified as including a name with an address, (a) electronically prompting the user with an option to save electronically in the information source at least some of the contact information, and (b) electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes at least one contact with the name, prompting the user to make a decision whether to store the name and address as a new contact or to update one of the at least one contact.

138. (Previously Presented) At least one non-transitory computer readable medium encoded with instructions which when loaded on at least one computer, establish processes for information handling, comprising:

displaying information in a document electronically using a computer program;

electronically analyzing the information to identify a portion of that information as contact information including at least one of a name without an address and a name with an address;

providing an input device configured to allow a user to use the input device to command the program to perform at least one of:

(i) inserting address information from an information source and associated with the name into the document, and

(ii) storing at least part of the contact information in the information source;

wherein the program is configured to perform both action (i) and action (ii);

during the displaying, receiving an execute command from the input device, wherein accessing and manipulating the input device are the only user actions required to cause initiation and completion of the analyzing;

when the contact information is identified as including a name without an address, electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes the name, if address information in the information source is associated with the name, causing insertion of the address information into the document; and

when the contact information is identified as including a name with an address, (a) electronically prompting the user with an option to save electronically in the information source at least some of the contact information, and (b) electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes at least one contact with the name, prompting the user to make a decision whether to store the name and address as a new contact or to update one of the at least one contact.

139. (Previously Presented) A computerized method for information handling, the method comprising:

displaying information in a document electronically using a computer program;

electronically analyzing the information to identify a portion of that information as contact information including at least a name;

providing an input device configured to allow a user to use the input device to command the program to perform at least one action selected from the group consisting of:

(i) inserting address information from an information source and associated with the name into the document, and

(ii) storing at least part of the contact information in the information source;

wherein the program is configured to perform both action (i) and action (ii);

during the displaying, receiving an execute command from the input device, wherein accessing and manipulating the input device are the only user actions required to cause initiation and completion of the analyzing;

when the program performs action (i), electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes the name, if address information in the information source is associated with the name, causing insertion of the address information into the document; and

when the program performs action (ii), electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes at least one contact with the name, prompting the user to make a decision whether to store the name as a new contact or to update one of the at least one contact.

140. (Previously Presented) A computerized method for information handling according to claim 139, further comprising:

when the program performs action (i) and the information source includes more than one address associated with the name, prompting the user to choose one of the addresses to use for insertion into the document.

141. (Previously Presented) At least one non-transitory computer readable medium encoded with instructions which when loaded on at least one computer, establish processes for information handling, comprising:

displaying information in a document electronically using a computer program;

electronically analyzing the information to identify a portion of that information as contact information including at least a name;

providing an input device configured to allow a user to use the input device to command the program to perform at least one action selected from the group consisting of:

(i) inserting address information from an information source and associated with the name into the document, and

(ii) storing at least part of the contact information in the information source;

wherein the program is configured to perform both action (i) and action (ii);

during the displaying, receiving an execute command from the input device, wherein accessing and manipulating the input device are the only user actions required to cause initiation and completion of the analyzing;

when the program performs action (i), electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes the name, if address information in the information source is associated with the name, causing insertion of the address information into the document; and

when the program performs action (ii), electronically searching for the name in the information source, in order to find whether the name is included in the information source; and

when the information source includes at least one contact with the name, prompting the user to make a decision whether to store the name as a new contact or to update one of the at least one contact.

142. (Previously Presented) At least one non-transitory computer readable medium according to 141, wherein the instructions further establish processes wherein:

when the program performs action (i) and the information source includes more than one address associated with the name, prompting the user to choose one of the addresses to use for insertion into the document.

143. (Previously Presented) A method according to claim 119, wherein the input device is a menu and the single execute command includes the user's selection of a menu choice from the menu.

144. (Previously Presented) At least one non-transitory computer readable medium according to claim 125, wherein the input device is a menu and the single execute command includes the user's selection of a menu choice from the menu.

145. (Previously Presented) An apparatus according to claim 131, wherein the input device is a menu and the single execute command includes the user's selection of a menu choice from the menu.

146. (Previously Presented) A method according to claim 119, wherein the input device is a button within a window.

147. (Previously Presented) At least one non-transitory computer readable medium according to claim 125, wherein the input device is a button within a window.

148. (Previously Presented) An apparatus according to claim 131, wherein the input device is a button within a window.

149. (Previously Presented) A method according to claim 119, wherein when the first contact information is an e-mail address, initiating electronic communication using the first contact information comprises creating an e-mail using the e-mail address.

150. (Previously Presented) At least one non-transitory computer readable medium according to claim 125, wherein when the first contact information is an e-mail address, initiating electronic communication using the first contact information comprises creating an e-mail using the e-mail address.

151. (Previously Presented) An apparatus according to claim 131, wherein when the first contact information is an e-mail address, initiating electronic communication using the first contact information comprises creating an e-mail using the e-mail address.

152-154. (Cancelled)

155. (Previously Presented) A method according to claim 119, wherein the set of potential actions further includes:

(iii) allowing the user to cause addition of at least some of the first contact information into the contact database.

156. (Previously Presented) At least one non-transitory computer readable medium according to claim 125, wherein the set of potential actions further includes:

(iii) allowing the user to cause addition of at least some of the first contact information into the contact database.

157. (Previously Presented) An apparatus according to claim 131, wherein the set of potential actions further includes:

(iii) allowing the user to cause addition of at least some of the first contact information into the contact database.

REMARKS

The Applicant thanks Examiner Pham and Examiner Alam for their time during the examiner interview on September 1, 2011, in which the Goodwin reference was discussed with Jakub Michna, attorney for the applicant. During the interview, applicant's representatives explained that the claim amendment of "a document configured for communication between people and comprising textual information" distinguished a search screen disclosed by the Goodwin reference. Examiner Pham disagreed, but did not suggest any alternative amendments. In a phone call on September 2, 2011, Examiner Alam asked Applicants to present an alternative amendment that distinguished the search screen of Goodwin. The present amendment to the claims is responsive to Examiner Pham's concerns and Examiner Alam's request.

Claim Amendments and Support

Claims 119, 121-125, 127-131, 133-151 and 155-157 are currently pending in the application. Claims 137-142 are allowed and claims 119, 121-125, 127-131, 133-136, and 143-151 are rejected. Claims 119, 125, and 131 are amended. No new matter has been added to the claims with these amendments.

Claims 119, 125, and 131 have been amended by removing the claim limitation that the document is "configured for communication between people and comprising textual information." Claims 119 and 125 have been amended to require a document "configured to be stored with textual information for later retrieval."

Applicant believes the term "document" is well understood in the application. The word "document" is used repeatedly in the application and always in the same sense. See,

for example, p. 6, line 14; p. 8, line 5; p. 9, line 18; and p. 16, line 2. To address the examiner's concerns regarding the search screen of Goodwin, applicant is further amending claims 119 and 125 to refer to "a document configured to be stored with textual information for later retrieval." Such a meaning for document is supported throughout the application. For example, it is clear that a document can be a Word™ document. See, for example, p. 10, line 23-24; p. 11, lines 8-9; and p. 16, line 7. It is well known that a Word™ document is configured to be stored with textual information for later retrieval. Also, Figs 3, 4, and 5, illustrating an embodiment of the invention, show a document in Microsoft Word™ with its well known user interface including icons for saving the document and for opening documents that have been saved. Thus, the additional wording surrounding the term "document" as used in the claim is well supported by the application.

Distinction of the Claimed Subject Matter from the Art of Record

The claims require "analyzing … textual information *in the document* electronically displayed on the cell phone to identify a portion of that textual information as first contact information." (emphasis added). As amended, the document is "configured to be stored with textual information for later retrieval." There is nothing in the Goodwin reference that discloses or suggests analyzing information in such a document. The Goodwin reference is directed to a process for searching in an address book, based on a user entry of a string in a search screen. The search screen described in the Goodwin reference is not a document, let alone a document that is configured to be stored with textual information for later retrieval, as required by the claims. Accordingly,

the Goodwin reference fails to disclose or suggest analyzing information in a document, as required by the claims.

This amendment further supports the patentability of the claims over the combination of the Miller and Goodwin references because neither reference discloses searching in a contact database for first contact information identified as a portion of the textual information in a document. This distinguishing feature is presented in further detail in Supplemental Response A filed on August 16, 2011 (Section I). The other reasons for patentability presented in that supplemental response apply equally to the claims herein. The Examiner should consider and address those reasons when analyzing the claims herein.

Applicant believes that all of the rejections have been addressed and a notice of allowance is respectfully solicited. If any fees are required, please charge deposit account number 19-4972. To further expedite prosecution, the Examiner may call Bruce Sunstein or Jakub Michna at 617-443-9292 if he has any further questions.

Respectfully submitted,

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Exhibit 6C

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google Inc. and Motorola Mobility LLC,

Petitioners,

v.

Arendi S.A.R.L.,

Patent Owner.

Case No. IPR2014-00452

Patent No. 6,323,853

PATENT OWNER ARENDI S.A.R.L.'S PRELIMINARY RESPONSE

UNDER 35 U.S.C. § 313 and 37 C.F.R. § 42.107

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Statutes

EXHIBIT LIST

Arendi Exhibit Number	Description
2001	Office action dated September 18, 2000 on application for ’853 Patent
2002	Interview Summary for October 17, 2000 relating to application for the ’853 Patent
2003	Tso, United States patent 6,085,201
2004	Amendment dated December 18, 2000 to application for ’853 Patent
2005	Notice of allowability of application for ’853 Patent
2006	File Wrapper of ‘853 Patent
2007	Order re Claim Construction in *Arendi U.S.A., Inc. v. Microsoft Corporation*, CA No. 02-343-T, District of Rhode Island, September 27, 2004

I. INTRODUCTION

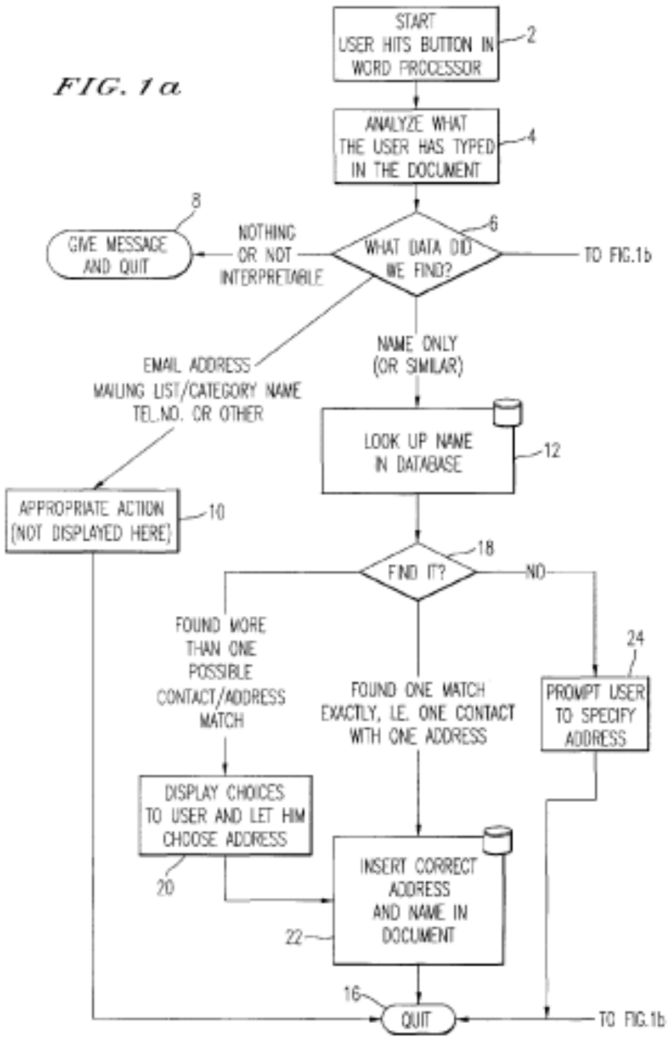
Patent Owner Arendi S.A.R.L. ("Arendi" or "Patent Owner") respectfully requests that the Board decline to initiate *inter partes* review of claims 1-24 of U.S. Patent No. 6,323,853 (the "'853 Patent") because Google Inc. and Motorola Mobility LLC ("Petitioners") have failed to show that they have a reasonable likelihood of prevailing with respect to any of the challenged claims. 35 U.S.C. § 314.

Petitioners have submitted proposed grounds for challenge based on anticipation or obviousness. However, for each proposed ground, at least one claim element is missing from the relied-upon reference or combination of references. Thus, Petitioners have failed to meet their initial burden to show that each element was known in the prior art.

II. OVERVIEW OF THE '853 PATENT

The '853 Patent is directed, among other things, to computer-implemented processes for automating a user's interaction between a first application, such as a word processing application or spreadsheet application, on the one hand, and a second application, such as contact management application having a database, on the other hand. In the '853 Patent, Exhibit 1001, Figs. 1 and 2 are flow charts showing for these interactions a number of scenarios, which are described from col. 4, line 22 to col. 5, line 53. Further details of the interactions are provided in discussion thereafter of the other figures of the '853 Patent, and the discussion includes references back to relevant portions of the flow charts in Figs. 1 and 2. Fig. 1, which includes Fig. 1a and Fig. 1b, is reproduced below.

FIG. 1a


START
USER HITS BUTTON IN WORD PROCESSOR
2
ANALYZE WHAT THE USER HAS TYPED IN THE DOCUMENT
4
WHAT DATA DID WE FIND?
6
NOTHING OR NOT INTERPRETABLE
GIVE MESSAGE AND QUIT
8
TO FIG.1b
EMAIL ADDRESS
MAILING LIST/CATEGORY NAME
TEL.NO. OR OTHER
NAME ONLY (OR SIMILAR)
LOOK UP NAME IN DATABASE
12
APPROPRIATE ACTION (NOT DISPLAYED HERE)
10
FIND IT?
18
NO
FOUND MORE THAN ONE POSSIBLE CONTACT/ADDRESS MATCH
FOUND ONE MATCH EXACTLY, I.E. ONE CONTACT WITH ONE ADDRESS
PROMPT USER TO SPECIFY ADDRESS
24
DISPLAY CHOICES TO USER AND LET HIM CHOOSE ADDRESS
20
INSERT CORRECT ADDRESS AND NAME IN DOCUMENT
22
16
QUIT
TO FIG.1b

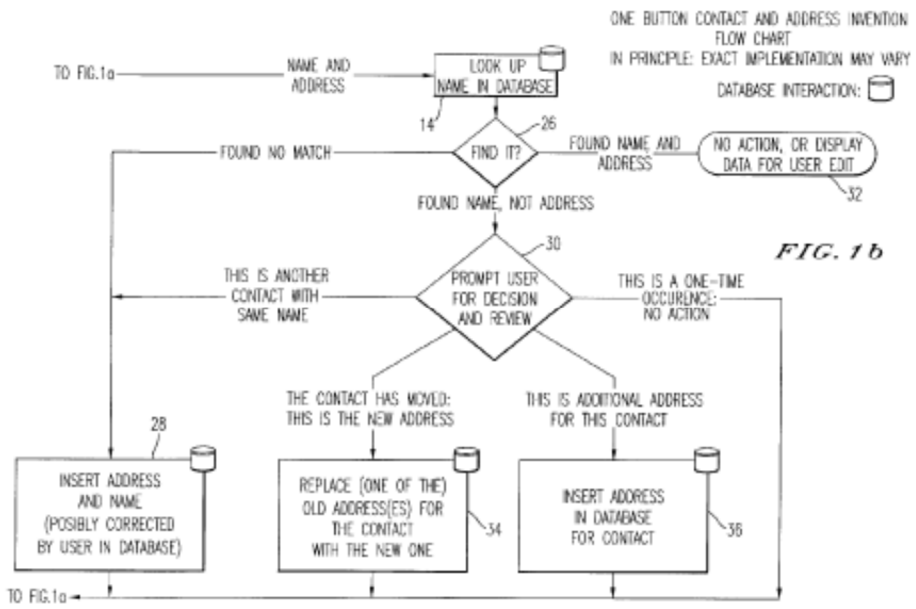


FIG. 1b

In various scenarios, text in a document in the first application is analyzed (in step 2 of Fig. 1) to identify contact information. Exhibit 1001, col. 4, line 55 to col. 5, line 2. The analysis process is described thus:

> In FIG. 1, after the user has inserted the address in the word processor, the user commands the button at step 2 and the program analyses what the user has typed in the document at step 4. At step 6, the program decides what was found in the document and if the program found nothing in the document or what it found was uninterpretable the program goes to step 8 and outputs an appropriate message to the user and then quits at step **16.** The program analyzes what the user has typed in the document at step 4, for example, by analyzing (i) paragraph/line separations/formatting, etc.; (ii) street, avenue, drive, lane, boulevard, city, state, zip code, country designators and abbreviations, etc.; (iii) Mr., Mrs., Sir, Madam, Jr., Sr. designators and abbreviations, etc.; (iv) Inc., Ltd., P.C., L.L.C,

> designators and abbreviations, etc.; and (v) a database of common male/female names, etc.

Ex. 1001, col. 4, lines 22-37.

It can be seen, from a reading of this passage, that the program performs the analysis without requiring the user to select a specific part of the document to be subject to the analyzing. Thus, in example 1, it is stated that "The user hits the button 42, for example, marked "OneButton" and the program according to the present invention retrieves the name 40 from the document, searches a database for the name 40, and inserts the retrieved address 44 associated with the name 40 into the document as shown in, for example, FIG. 4." Ex. 1001, Col. 5, lines 62-67. Similar language appears in Example 2 (col. 6, lines 8-12): "The user commands the button 42, for example, marked 10 'OneButton,' and the program according to the invention retrieves the new contact 46 from the document, searches a database for the name of the new contact 46…." Examples thereafter are to similar effect; the user is not required to select a specific part of the document to be subject to the analyzing: Example 3, col. 6, lines 39-44; Example 4, col. 6, lines 59-63; Example 5, col. 7, lines 20-24; etc.

Once the analyzing identifies contact information in the document, a number of different scenarios can follow, depending on the circumstances. In one scenario, if the identified contact information includes a name, a search is initiated in the

database associated with the second application for the name. *Id*., Fig. 1, steps 6, 12, and 14. If the contact information identified in the document included only a name, and if only a single entry is found in the database for the name and the entry includes a single address, then the address is inserted into the document. *Id*. Fig. 1, steps 6, 12, 18, and 22; Fig. 4; col. 5, line 58 to col. 6, line 2. Fig. 4, which is reproduced below, shows the document displayed in Microsoft Word after the address has been inserted.

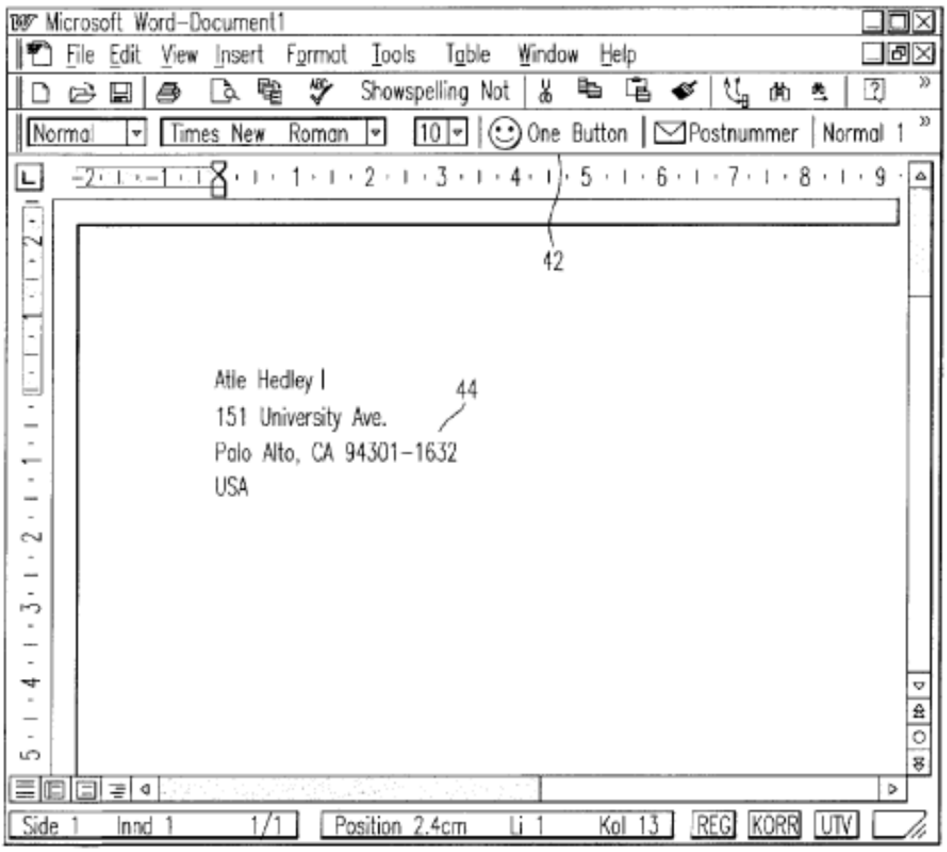


FIG. 4

Shown in Fig. 4 is the One Button 42, which, when pressed, launches the processes just recited, including analyzing the document to identify contact

information, the searching in the database, and inserting of the address. *Id.*, Fig. 1; col. 5, line 58 to col. 6, line 2.

On the other hand, if multiple addresses are found in searching the database for the identified name, these found addresses are displayed, and the user is presented with a choice of which of the addresses to insert. *Id.*, Fig. 1, steps 18, 20, and 22; Fig. 10; col. 7, lines 15-61.

As shown in Fig. 1 and Fig. 2, numerous other scenarios are also disclosed in the ’853 Patent, and these scenarios are explained in the description in connection with later figures of the ’853 Patent.

III. CLAIM CONSTRUCTION

In an *inter partes* review, the Patent Trial and Appeal Board gives patent claims their "broadest reasonable construction in light of the specification of the patent." 37 C.F.R. § 42.100(b); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*). "To ascertain the scope and meaning of the asserted claims, we look to the words of the claims themselves, the specification, the prosecution history, and, lastly, any relevant extrinsic evidence. *Phillips v. AWH Corp*., 415 F. 3d 1303, 1315-17 (Fed. Cir. 2005) (en banc)." *In re Baxter Int'l*, 678 F. 3d. 1357, 1362 (Fed. Cir. 2012) (Standard on appeal from *ex parte* reexamination.). Extrinsic evidence is relevant only to the extent it is consistent with the specification and file history. *Id.*, 1319.

Patent Owner Arendi proposes construction of certain claim terms below pursuant to the broadest reasonable construction consistent with the specification standard.

A. **"Application program"**

Claim 1 of the '853Patent uses the term "application program" in referring to "[a] computerized method for information handling within a document created using an application program". As to the kinds of "application program" used to create a document, in describing embodiments of the invention, the '853 Patent

gives examples of documents created using Microsoft Word (see Examples 1-6, col. 5, line 58 to col. 8, line 37) and Excel (see Example 7, which is said to be for a "Spreadsheet *Application*" (emphasis added), col 8, line 39 to col. 9, line 12). Accordingly, the term "application program" should be construed in accordance with its ordinary and customary meaning and the clear usage of the term within the intrinsic evidence as "an independently executable computer program designed to assist in the performance of a specific task, such as word processing or spreadsheet processing."

This construction is also consistent with claim 10, which depends on claim 1, and requires that "using the application program comprises: / using one of a word processing program and a spreadsheet program …."

B. The requirement of "analyzing the document to determine if the first information is contained therein"

To elucidate the meaning of "analyzing the document to determine if the first information is contained therein" in claim 1 of the '853 Patent, we consider the phrase, appearing immediately thereafter, concerning "searching":

> … if the first information is contained in the document, *searching*, using the record retrieval program, the information source for second information associated with the first information…

(Emphasis added.) The claim structure requires (first) "analyzing the document to determine if the first information is contained therein" and (second) "if the first information is contained in the document," then "searching … the information source for second information associated with the first information". The analyzing process precedes the searching process, which is a separate process. A determination by the analyzing process that "the first information is contained in the document" is a pre-condition for the searching process.

In Section II above, presenting an overview of the '853 Patent, we discussed disclosure in the '853 Patent wherein the program analyzes text in the document to identify contact information without requiring the user to select a specific part of the document to be subject to the analyzing.

The analyzing process is significant as more than merely a condition to the searching process. The limitation of "analyzing the document to determine if the first information is contained therein" in claim 1 of the '853 Patent was added in the course of prosecution of the '853 Patent, following a final office action dated September 18, 2000 (Ex. 2001). (The File Wrapper of the '853 Patent is reproduced in full in Exhibit 2006.) Claim 8, which was the predecessor to issued claim 1, had been rejected on the basis Tso, United States patent 6,085,201 (Ex.

2003), in the September 28, 2000 final office action. Exhibit 2001, pages 2-6. Tso discloses a template engine that analyzes text in an incoming e-mail message and then generates a context-sensitive text message based on the incoming text. See Ex. 2003, Tso, Abstract and col. 2, lines 59-67. However, it is necessary for the user to select the text that is to be analyzed: "When a user wishes to compose a new e-mail message or generate a reply to a received e-mail message, the user selects a text string to be processed, for example, by clicking-on it." *Id*., col. 4, lines 32-35.

In an interview with the examiner, this very point was discussed, that in Tso it is necessary for the user to select the text to be analyzed. See Exhibit 2002, Interview Summary for October 17, 2000 relating to application for the '853 Patent: "Applicant's representative discussed the differences between the Tso and Borovoy references and the present invention. For instance, it was pointed out that in the Tso reference, the user must select the text string to be processed, whereas in the present invention, the user does not have to select the text string to be analyzed. Applicant's representative may submit an After-Final Amendment that amends the independent claim to include this difference."

Pursuant to that understanding, by an amendment received by the Patent and Trademark Office on December 18, 2000, Ex. 2004, the present limitation was added to the claim: "analyzing the document to determine if the first information is

contained therein". Now that the claim limitation required "analyzing" to determine if the first information is present in the document, the amendment additionally added the condition "if the first information is contained in the document" ahead of the requirement of "searching, using the record retrieval program, the information source for second information associated with the first information".

The amendment referenced the interview with the Examiner. "During the discussion, it was noted that columns 4-5 of Tso teach a user selecting a text string to be processed by clicking on the text string using various selection means. In this respect, the present invention does not require the user to select a text string to be processed since it functions automatically upon a single click of an input device, such as a button, menu item, etc." Ex. 2004, pages 2-3.The Notice of Allowability similarly addresses this distinction:

> The closest prior art, Tso (U.S. patent 6,085,201) similarly teaches a context sensitive template engine which "generates a context-sensitive text message corresponding to an input text string". However, in Tso, the text string to be processed is determined by the current cursor position as specified by the user [see col. 4, line 31 to col. 5: line 67], whereas the present invention "does not require the user to select the text string to be processed since it functions automatically upon a single click of an input device" to determine if the first information is contained within the document.

Ex. 2005, Notice of Allowability, dated January 2, 2001.

The prosecution history therefore shows that the limitation of "analyzing the document to determine if the first information is contained therein" in the claim rules out user selection of the first information. Additionally, the term "document" in the requirement of "analyzing the document" is referred to in the preamble as "a document created using an application program". (We have discussed "application program" in section III(A) above.) Consequently, the limitation of "analyzing the document to determine if the first information is contained therein" in claim 1 requires a computer process that identifies the first information in the document, without recourse to user selection of the text to be analyzed, and it does so as a pre-condition for conducting the search, which is a separate process.

This claim construction is consistent with the Order re Claim Construction in *Arendi U.S.A., Inc. v. Microsoft Corporation*, CA No. 02-343-T, District of Rhode Island, September 27, 2004, (Exhibit 2007) a proceeding in which the '853 Patent was asserted against Microsoft. The Court held that "the analysis and search take place without any need for the user to, first, select any text in the document by accenting it, highlighting it, or otherwise selecting it. Text selection by the user was clearly disavowed by Arendi during prosecution of the patent as demonstrated by the following: [citing, among other things, the documents and events summarized above]." Exhibit 2007, pages A5-A6.

It is proper to consider prosecution history in determining the meaning of a claim that is being evaluated in a contested proceeding in the Patent and Trademark Office. In *Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973 (Fed. Cir. 2014), a case reviewing a determination made in an *inter partes reexamination*, the Federal Circuit ruled that the PTAB correctly rejected the broad dictionary-based claim construction adopted by the patent examiner in favor of the correct claim construction based on a meaning supplied by the patent applicant during prosecution of the original patent application. On appeal from the PTAB, the Federal Circuit stated, "In claim construction, this court gives primacy to the language of the claims, followed by the specification. Additionally, the prosecution history, while not literally within the patent document, serves as intrinsic evidence for purposes of claim construction. This remains true in construing patent claims before the PTO. *See In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997)." *Tempo Lighting*, 742 F.3d at 977.

IV. OVERVIEW OF THE PRIOR ART

A. Overview of Goodhand

Goodhand concerns features associated with an e-mail module in an environment such as Microsoft Outlook. Ex. 1003, col. 8, lines 37-40. The e-mail module, among other things, allows a user to compose an e-mail message using a "template" or "form", which has an address field (the "To:" portion of the e-mail template), in which the e-mail address of the recipient of the message is entered. *Id*., col 15, lines 54-55 ("To:" field"); col. 16, lines 7-29 (every item is created from a template); col. 16, lines 40-46 (address field); col. 17, lines 12-14 (address field of e-mail form used to create a message item).

Goodhand specifically concerns processes that are followed when a user enters one or more names into the "To:" field of an e-mail template. Fig. 6a shows a typical set of user entries:

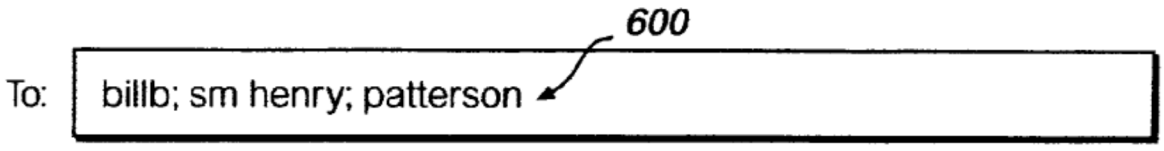


FIG.6a

"FIG. 6a illustrates an address field 600 of an e-mail form that is being used to compose a message item. The form and address field 600 are displayed on the monitor 31 (FIG. 1)." *Id*., col. 17, lines 12-14. Moreover, "[w]hen an e-mail user

composes an e-mail message, the user identifies the recipient(s) of the message by entering one or more display names in the message's address field." *Id*., Col. 16, lines 39-42.

After the user has entered one or more names or e-mail addresses in the address field of the e-mail template, the technology of Goodhand and the prior art processes the entered text by attempting to match the entered names with e-mail addresses: "Before the message can actually be transmitted by the e-mail system, the system must match each display name entered in the address field to the specific e-mail address (or address book entry) of a registered user." *Id.*, col. 16, lines 43-46. Goodhand explains that the "process of matching the display name(s) to an e-mail address or alias is referred to as 'resolving' the names." *Id*., col. 16, lines 51-53. The innovation introduced by Goodhand is to resolve the names in the background: "The present invention provides a method for resolving names in the background, which means that the user may continue to use the computer to perform other tasks while the display names are being resolved." *Id*., col. 16, lines 62-65.

B. Overview of Allen

Allen describes a "natural language-based information organization and collaboration tool for a computer system". Ex. 1005, abstract. Allen states that the system described "relates to the analysis of natural language input to produce structured information output and the processing of notes in a computer system." *Id*., col. 1, lines 9-11. These notes are generally referred to in Allen as "keynotes". *Id*., col. 5, lines 24-29.

> The actual "analysis" in Allen involves a dictionary lookup of each word or group of words that have been placed by a user in a note. The dictionary lookup is performed by a parser. The parser first identifies "tokens" in the text of the document: A user provides natural language text expressions (i.e., keynotes) representing notes, thoughts, or action requests which are provided to user interface 200. User interface 200 passes these text expressions to parser 300. Parser 300 is responsible for identifying the type of keynote and for linking the keynote to one or more corresponding information objects based upon identified keywords or date/time expressions found in the input text expression.... Parser 300 uses lexical analysis tool 400 to partition the input text expression into a plurality of tokens. Tokens are sequential or adjacent portions of the input text expression between pre-specified delimiters.

Ex. 1005, col. 5, line 57 to col. 6, line 5. A "token", as defined in the quoted passage, is consequently a word or group of words or a special character, such as a

"/". See col. 16, lines 2-23 ("two", "Monday", and "/" are tokens) and col. 11, lines 30-34 (several types of tokens including "alpha character, alpha numeral, date, date span, etc.")

The parser performs an automatic lookup of each word or group of words entered by the user. "The parser 300 of the present invention is used to analyze this keynote in real-time as the user enters the keynote character by character. Note that the entire keynote is parsed after the entry of each new character." *Id.*, col. 9, lines 51-54. "In processing block 1410, the user input keynote is parsed into tokens by lexical analysis tool 400. Each token can then be compared with the keyword dictionary 852 to determine if the token is already a predefined keyword (processing block 1414)" Col. 15, lines 6-10.

Consequently, as the user types as characters are fed into the keynote region, on a-character-by-character basis, they are parsed by the parser 300 into tokens. Each token is made the subject of a lookup in the keyword dictionary to determine if the token is a predefined keyword. "If the contents of the keyword buffer are found in keyword dictionary 852, processing continues with processing block 1026 where the contents of the keyword buffer are stored in the current keyword buffer." *Id*. col. 12, line 64, to col 13, line 1. If the token has an entry in the keyword dictionary 852, then the parser retrieves the definition from the keyword dictionary 852. *Id*. , col. 13, lines 22-30. The retrieved definitions are the

associated objects: "The corresponding keyword definition includes the list, the project, and the contact object information corresponding to the matched keyword from the keyword dictionary." *Id*., col. 13, lines 29-34.

V. SINCE THE PRIOR ART DOES NOT ANTICIPATE OR RENDER ANY CLAIM OBVIOUS, NO *INTER PARTES* REVIEW SHOULD BE INITIATED

A. Overview of Reasons for Denying Inter Partes Review

Petitioner has failed to show that any prior art alone or in combination addresses all of the limitations of any of the independent claims.

The limitation of "analyzing the document to determine if the first information is contained therein" has no counterpart in Goodhand. We have shown in section III(B) that this claim limitation was added in order to distinguish over Tso, United States patent 6,085,201 (Exhibit 2003), which discloses user selection of text as a condition to processing of that text. The "analyzing" limitation precludes user selection of text in the document, created by the application program, as a condition for processing of the text.

In Goodhand, which discloses a module for handling e-mail messages, the user enters one or more "display names" into the dedicated address field (the section of the e-mail form that is labeled "To:") of an e-mail template. See, for example, Figs. 6a, 6b, 6c, 7a, 7b, and 7c. After the user has entered one or more names or e-mail addresses in the address field of the e-mail template, the technology of Goodhand and the prior art processes the entered text by attempting to match the entered names with e-mail addresses. *Id.*, col. 16, lines 43-46.

In Goodhand, just as in the Tso patent, as a condition to processing of text, the user must first select the text to be processed. In Goodhand the selection is made by entering the text in a section of the e-mail template that is designated for the address field. For that reason, Goodhand fails to disclose or suggest the claim limitation of "analyzing the document to determine if the first information is contained therein".

Allen similarly fails to disclose this claim limitation. The "analyzing" process required by claim 1 of the '853 Patent is a pre-condition to the searching process that follows the analyzing process:

> … if the first information is contained in the document, *searching*, using the record retrieval program, the information source for second information associated with the first information…

(Emphasis added.) The claim structure requires (first) "analyzing the document to determine if the first information is contained therein" and (second) "if the first information is contained in the document," then "searching … the information source for second information associated with the first information".

Allen fails to disclose carrying out the analyzing process, required by the claim, to determine, as a condition for performing the search, if a word or group of words is first information suitable for use in a search. Instead the parser of Allen indiscriminately performs a dictionary lookup for every word or group of words in the document as the words have been typed into the document, in order to

determine whether the words typed are keywords. "In processing block 1410, the user input keynote is parsed into tokens by lexical analysis tool 400. Each token can then be compared with the keyword dictionary 852 to determine if the token is already a predefined keyword (processing block 1414)" Col. 15, lines 6-10. Since every word or group of words is the subject of a dictionary lookup, there is no analyzing process that operates as a precondition to the lookup.

Tellingly, the Petitioners reference the dictionary lookup as corresponding to both (i) the limitation of "analyzing the document to determine if the first information is contained therein" (Petition, 49) and (ii) the limitation of "… if the first information is contained in the document, searching, using the record retrieval program, the information source for second information associated with the first information" (Petition, 50). Since these are two different claim limitations involving two different processes, the single process in Allen of performing a dictionary lookup of every word or group of words in the document cannot meet both claim limitations.

B. Because the Goodhand system requires the user to select text that is to be searched by entering it in the "To" field of an e-mail template, Goodhand fails to disclose or suggest "analyzing the document to determine if the first information is contained therein", and therefore Ground 1 fails to establish a *prima facie* case for obviousness.

Independent claim 1includes the limitation of "analyzing the document to determine if the first information is contained therein". Although Petitioners argue that this limitation is found in Goodhand (Petition, pages 24-25), they fail to identify anything in Goodhand that corresponds to this limitation. We first discuss the meaning of this limitation, and then show that Goodhand, relied upon by the Petitioners in Ground 1, fails to disclose this limitation.

We have shown in section III(B) above that, the limitation in claim 1 of "analyzing the document to determine if the first information is contained therein" was added in order to distinguish over Tso, United States patent 6,085,201 (Exhibit 2003), which discloses user selection of text as a condition to processing of that text. The prosecution history therefore shows that this claim limitation rules out user selection of text as a condition to processing of that text.

Moreover, as also discussed in Section III(B), the limitation of "analyzing the document" refers to "a document created using an application program" as recited in the preamble of claim 1. Consequently, the requirement of "analyzing the document to determine if the first information is contained therein" in claim 1

means that the claim precludes user selection of text in the document, created by the application program, as a condition for processing of the text.

The Petitioners argue that the "application program" in Goodhand is the mail system, and that the "document" is an e-mail. Petition, 22. In using the technology of Goodhand, the user enters one or more names or e-mail addresses in a particular, designated section of an e-mail template, namely, in the address field. Ex. 1003, col 15, lines 54-55 ("To:" field"); col. 16, lines 7-29 (every item is created from a template); col. 16, lines 40-46 (address field); col. 17, lines 12-14 (address field of e-mail form used to create a message item). "When an e-mail user composes an e-mail message, the user identifies the recipient(s) of the message by entering one or more display names in the message's address field." Exhibit 1003, Col. 16, lines 39-42.

After the user has entered one or more names or e-mail addresses in the address field of the e-mail template, the technology of Goodhand and the prior art processes the entered text by attempting to match the entered names with e-mail addresses: "Before the message can actually be transmitted by the e-mail system, the system must match each display name entered in the address field to the specific e-mail address (or address book entry) of a registered user." *Id.*, col. 16, lines 43-46. Goodhand explains that the "process of matching the display name(s) to an e-mail address or alias is referred to as 'resolving' the names." *Id.*, col. 16,

lines 51-53. The innovation introduced by Goodhand is to resolve the names in the background: "The present invention provides a method for resolving names in the background, which means that the user may continue to use the computer to perform other tasks while the display names are being resolved." *Id*., col. 16, lines 62-65.

The Petitioners, relying on testimony of their expert, argue that Goodhand discloses the limitation of "analyzing the document to determine if the first information is contained therein":

> This happens in two ways. First, the system determines (as in Fig. 6a) whether there is one or more than one name in the To: line. Ex. 1002 at ¶122.
>
> Second, Goodhand discloses that display names (first information) are analyzed and identified, because the system later uses the display names as search terms. In order to identify the names, the system must determine that they are there. Ex. 1002 at ¶122.

Petition, 24.

However, processes of Goodhand do not match the claim limitation of "analyzing the document to determine if the first information is contained therein", because in Goodhand the user must enter text in a dedicated section of the e-mail template, namely the address field. In Goodhand, just as in the Tso patent, as a condition to processing of text, the user must first select the text to be processed.

The user interface of Goodhand is illustrated in Figs. 6 and 7. *Id*., col. 17, line 6 to col. 18, line 48. In all cases, the user first enters one or more "display names" into the address field (the section of the e-mail form that is labeled "To:"). See, for example, Figs. 6a, 6b, 6c, 7a, 7b, and 7c.

This discussion shows that, according to the Petitioners, the e-mail in Goodhand corresponds to the "document" of claim 1, and, as a condition to the processing of text carried out by Goodhand, the user is required to enter the text in a designated part of that document, namely, the address field. In other words, the Goodhand technology requires a user selection of text as a condition to the processing of that text. However, as we have seen, the limitation in claim 1 of "analyzing the document to determine if the first information is contained therein" requires a computer process that identifies the first information in the document without recourse to user selection of text in the document as a condition for processing of the text. The limitation was specifically added to the claim to disavow user selection of the text in the document to be analyzed. Accordingly claim 1 fails to read on Goodhand for the same reason that claim 1was found to avoid Tso as prior art.

We have shown that Goodhand requires user selection of information by requiring the user to place the names in the "To:" section of an e-mail template. Petitioners have thus failed to show that Goodhand discloses "analyzing the

document to determine if the first information is contained therein". For these reasons, Ground 1 fails to make a *prima facie* case for obviousness of claim 1 and the claims 2-24 dependent on claim 1.

C. Because Allen fails to disclose "analyzing the document to determine if the first information is contained therein", Ground 3 fails to establish anticipation.

As discussed in part III(B), the limitation in claim 1 of "analyzing the document to determine if the first information is contained therein" precedes the claim limitation "if the first information is contained in the document, *searching*, using the record retrieval program, the information source for second information associated with the first information" (emphasis added). Thus, as stated in part III(B), the analyzing process precedes the searching process. A determination by the analyzing process that "the first information is contained in the document" is a pre-condition for the searching process.

As described in further detail below, Allen fails to disclose the process of "analyzing the document to determine if the first information is contained therein" as a pre-condition to the searching process. Allen lacks the analyzing process, required by the claim, to determine, as a condition for performing the search, if a word or group of words is first information suitable for use in a search. Instead, the parser of Allen indiscriminately performs a dictionary lookup for every word or

group of words in the document as the words have been typed into the document, in order to determine whether the words typed are keywords.

Ironically, without pointing out the circularity of their reasoning, the Petitioners argue that Allen's use of "natural language parsing to identify keywords" —*by a dictionary lookup of every word or group of words* in the document as the words have been typed—meets the claim limitation of the analyzing process to determine, *as a condition for performing the search*, if a word or group of words is first information suitable for use in a search. Petition, p. 49, citing Allen, col. 5, lines 27-28.

Allen describes a "natural language-based information organization and collaboration tool for a computer system". Exhibit 1005, abstract. Allen states that the system described "relates to the analysis of natural language input to produce structured information output and the processing of notes in a computer system." Exhibit 1005, col. 1, lines 9-11.Allen's "analysis" is accomplished by a parser that in fact performs a dictionary lookup of each word or group of words in the document. The parser first identifies "tokens" in the text of the document:

> A user provides natural language text expressions (i.e., keynotes) representing notes, thoughts, or action requests which are provided to user interface 200. User interface 200 passes these text expressions to parser 300. Parser 300 is responsible for identifying the type of keynote and for linking the keynote to one or more

> corresponding information objects based upon identified keywords or date/time expressions found in the input text expression.... Parser 300 uses lexical analysis tool 400 to partition the input text expression into a plurality of tokens. Tokens are sequential or adjacent portions of the input text expression between pre-specified delimiters.

Ex. 1005, col. 5, line 57 to col. 6, line 5. A "token", as defined in the quoted passage, is consequently a word or group of words or a special character, such as a "/". See col. 16, lines 2-23 ("two", "Monday", and "/" are tokens) and col. 11, lines 30-34 (several types of tokens including "alpha character, alpha numeral, date, date span, etc.")

Operation of the parser is automatic. "As each key stroke is input to keynote region 220, the individual key stroke is transferred to user interface 200 and subsequently to parser 300…." *Id*., col. 6, lines 64-66. Similarly, "[t]he parser 300 of the present invention is used to analyze this keynote in real-time as the user enters the keynote character by character. Note that the entire keynote is parsed after the entry of each new character." *Id.*, col. 9, lines 51-54. "In processing block 1410, the user input keynote is parsed into tokens by lexical analysis tool 400. Each token can then be compared with the keyword dictionary 852 to determine if the token is already a predefined keyword (processing block 1414)" Col. 15, lines 6-10.

Consequently, as the user types characters into the keynote region, on a-character-by-character basis they are parsed by the parser 300 into tokens. Processes carried out by the parser are described in connection with Figs. 10 and 11. *Id*., col 12, lines 46-48. "If the contents of the keyword buffer are found in keyword dictionary 852, processing continues with processing block 1026 where the contents of the keyword buffer are stored in the current keyword buffer." *Id*. col. 12, line 64, to col 13, line 1. If the token has an entry in the keyword dictionary 852, then the parser retrieves the definition from the keyword dictionary 852. *Id*. , col. 13, lines 22-30. The retrieved definitions are the associated objects: "The corresponding keyword definition includes the list, the project, and the contact object information corresponding to the matched keyword from the keyword dictionary." *Id*., col. 13, lines 29-34.

This discussion of Allen has highlighted two features. First, the parser of Allen is triggered by every keystroke used to enter text, and is operated therefore in the course of entering text into the system. Second, in operation, the parser uses the keynote dictionary as part of its processes. Specifically, in operation, the parser tests every keyword that is read into the buffer to determine if it is an entry in the keynote dictionary. See decision branch 1024 of Fig. 10 of Allen, and the path to point B in Fig. 10 as well as item 1110 of Fig. 11, which proceeds from the same point B; and col. 12, line 63 to col. 13, line 30.

The strategy employed by the parser in Allen, therefore, is to search in the dictionary for each word, or set of words, in the document, and if there is a corresponding entry in the dictionary, then the parser performs a retrieval of the definition. Although and because the parser in Allen performs searching every time a word or group of words is entered into the intelligent note editor, there is no recited process for "analyzing the document to determine if the first information is contained therein" as a pre-condition to the searching process, as required by claim 1 of the '853 Patent.

As we have mentioned, the Petitioners argue that this analyzing determination is satisfied by Allen's use of "natural language parsing to identify keywords". Petition, 45, citing Allen, col. 5, lines 27-28. As part of this theory, the Petitioner equates keywords with "first information" in the claim and argues that "The identified text strings in the document are looked up in a keyword dictionary to determine if they are keywords." Petition, 45, citing Allen, Ex. 1005, col. 12, line 46 to col. 13, line 6 and paragraphs 251-257 of the Allison declaration, Exhibit 1002.

Petitioners' theory proves that Allen fails to disclose "analyzing the document to determine if the first information is contained therein", because, in Allen, a string is determined to be a keyword (allegedly the "first information") only as a result of a dictionary search. However, the claim requires "analyzing the

document to determine if the first information is contained therein" *as a pre-condition to the searching process*. In other words, claim 1 requires analyzing as a pre-condition to a search, and Allen performs a search on each word without analyzing as a pre-condition.

The flaw in Petitioners' position is further evident in Petitioner's argument that the same dictionary lookup corresponds to the "searching" process required by claim 1. Petition, 50 ("As discussed above for element [1a], keywords are used to search the keyword definition table, as shown in the excerpt from Fig. 11"). Having already cited the dictionary lookup as corresponding to "analyzing the document to determine if the first information is contained therein" and the Petitioners cite the same dictionary lookup again as corresponding to the "searching" process. One process in Allen—the dictionary lookup of each word or group of words—cannot correspond to two separate processes in the claim. The point is that, in the parser of Allen, there is no analyzing to identify first information in the document as a pre-condition to performing a search. Instead, every item is subject to a dictionary search.

Thus, because the claim requires that (i) the analysis is a pre-condition for the search and (ii) the search is a process separate from the analysis, the automatic lookup in Allen of every word or group of words cannot satisfy both requirements.

Because Allen fails to disclose "analyzing the document to determine if the first information is contained therein", Count 3 fails to establish anticipation of claim 1 and of claims 2-24 dependent on claim 1 on the basis of Allen.

VI. CONCLUSION

For the foregoing reasons, Petitioner have failed to establish a reasonable likelihood of prevailing as to any claim of the '853 Patent, and *inter partes* review of claims 1-79 of U.S. Patent No. 6,323,853 should be denied.

Date: May 22, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

It is certified that on May 22, 2014, copies of the Patent Owner Arendi S.A. R.L.'s Preliminary Response Under 35 U.S.C. §313 and 37 C.F.R. §42.107 have been served on Petitioner as provided in 37 C.F.R. § 42.6(e) via electronic mail transmission addressed to the persons at the following addresses:

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Exhibit 6D

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Paper 10
Entered: August 20, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC. and MOTOROLA MOBILITY LLC,
Petitioners,

v.

ARENDI S.A.R.L.,
Patent Owner.

Case IPR2014-00452
Patent 6,323,853 B1

Before MICHAEL R. ZECHER, NEIL T. POWELL, and KEVIN W. CHERRY, *Administrative Patent Judges.*

POWELL, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Google Inc. and Motorola Mobility LLC ("Petitioners") filed a Petition requesting *inter partes* review of claims 1–79 of U.S. Patent No. 6,323,853 B1 (Ex. 1001, "the '853 patent"). Paper 1 ("Pet."). Arendi S.A.R.L. ("Patent Owner") timely filed a Preliminary Response. Paper 8 ("Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

We determine that the information presented in the Petition and supporting evidence shows that there is a reasonable likelihood that Petitioners would prevail with respect to the challenged claims. Accordingly, we institute an *inter partes* review of claims 1–79 of the '853 patent.

A. Related Proceedings

Petitioners indicate that the '853 patent has been asserted in several district court cases, including *Arendi S.A.R.L. v. Motorola Mobility LLC*, Case No. 1-12-cv-01601, and *Arendi S.A.R.L. v. Google Inc.*, Case No. 1-13-cv-00919, both filed November 29, 2012. Pet. 1; *see* Paper 6, 2.

B. The '853 Patent (Ex. 1001)

The '853 patent discloses a method, system, and computer readable medium that provide a function of searching a database or file for information corresponding to what a user types or has partially typed in a program, such as a word processor. Ex. 1001, Abstract. If the database or file includes the corresponding information searched for, the information is displayed and possibly inserted into the word processor. *Id.* The '853 patent

discusses an example of this function in connection with Figures 3 and 4. *Id.* at col. 5, l. 60–col. 6, l. 2. Figure 3 is reproduced below.

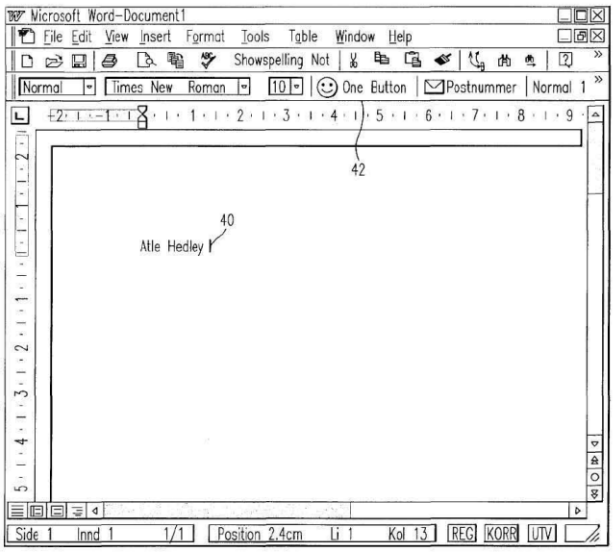

FIG. 3

Figure 3 shows a word processor document in which a user has typed name 40. *Id.* at col. 5, ll. 60–62. When the user hits button 42, the program according to the '853 patent retrieves name 40 from the document and then searches for name 40 in a database. *Id.* at col. 5, ll. 62–65. As a result of this search, the program retrieves address 44, which is associated with name 40, and inserts address 44 in the document, as shown in Figure 4, reproduced below. *See id.* at col. 5, ll. 65–67.

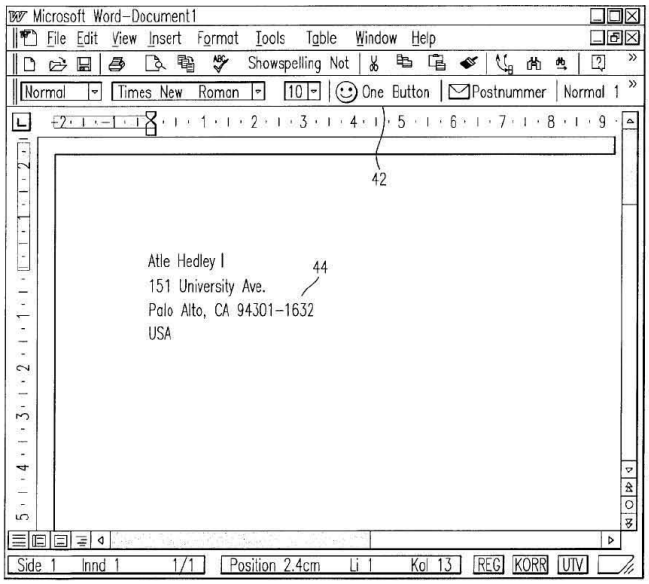

FIG. 4

Figure 4 shows the word processor document of Figure 3 with address 44 inserted. *See id.* The '853 patent discusses its process in greater detail in connection with Figure 1a, reproduced below. *Id.* at col. 4, l. 22–col. 5, l. 57.

FIG. 1a

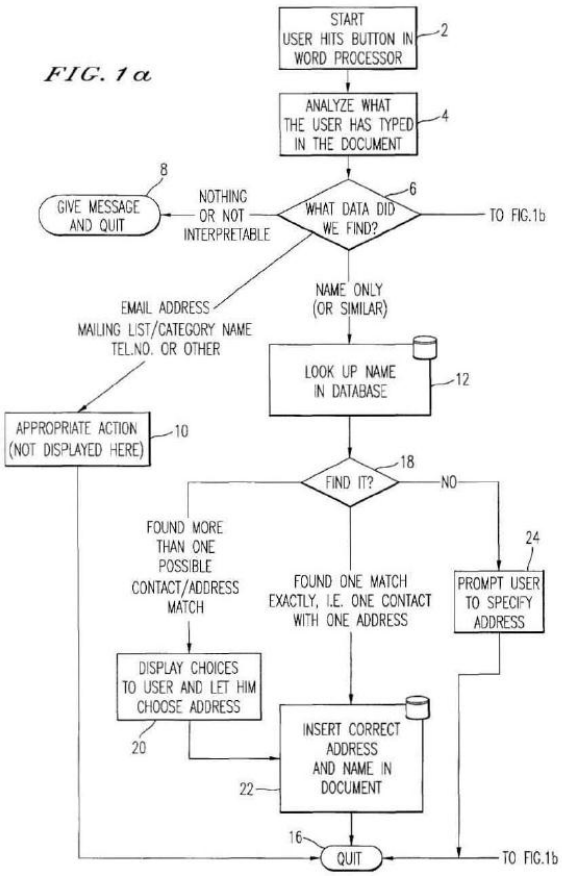

Figure 1a shows a flow chart illustrating a method according to the '853 patent. *Id.* at col. 2, ll. 38–40. At step 2, the user initiates the analyzing and searching processes by commanding a button, such as button 42 shown in Figures 3 and 4. *See id.* at col. 4, ll. 23–25; col. 5, ll. 62–65; col. 6, ll. 1–2. At step 4, "the program analyzes what the user has typed in the document." *Id.* at col. 4, ll. 24–25.

At step 6, the program determines what it found in the document. *Id.* at col. 4, ll. 25–26. If the program found nothing or uninterpretable information in the document, the program proceeds to step 8, in which the program provides an appropriate message for the user. *Id.* at col. 4, ll. 26–29. If the program found "an e-mail address mailing list/category name

telephone number or other information, at step 10 an appropriate action is performed by the program." *Id.* at col. 4, ll. 38–41.

If the program found only a name, initials, or the like, "the program looks up the name in the database at step 12" and determines at step 18 what it found. *Id.* at col. 4, ll. 39–44. If the program found that the name matches only one contact associated with only one address in the database, the program inserts the address and name in the document at step 22. *Id.* at col. 4, ll. 50–53. If the program found multiple possible addresses associated with the name in the database, the program presents the user with menu choices that allow the user to select the correct name and address for insertion in the document at step 22. *Id.* at col. 4, ll. 44–49.

At the end of the written description, the '853 patent discusses various ways in which its disclosure is not limited to the examples discussed in connection with Figures 1–16. For example, the '853 patent states:

> Although the present invention is defined in terms of a program retrieving information from a document before searching a database, the user may select the information in the document to be searched by the program in the database (e.g., by highlighting, selecting, italicizing, underlining, etc.), as will be readily apparent to those skilled in the art.

Id. at col. 10, ll. 5–9.

C. Illustrative Claim

Petitioners challenge claims 1–79 of the '853 patent. Claim 1 is the only independent claim and reads as follows:

> 1. A computerized method for information handling within a document created using an application program, the document including first information provided therein, the method comprising:

providing a record retrieval program;

providing an input device configured to enter an execute command which initiates a record retrieval from an information source using the record retrieval program;

upon a single entry of the execute command by means of the input device:

analyzing the document to determine if the first information is contained therein, and

if the first information is contained in the document, searching, using the record retrieval program, the information source for second information associated with the first information; and

when the information source includes second information associated with the first information, performing at least one of,

(a) displaying the second information,

(b) inserting the second information in the document, and

(c) completing the first information in the document based on the second information.

Ex. 1001, col. 10, l. 28–col. 11, l. 7.

D. The Prior Art

Petitioners rely on the following prior art references:

U.S. Patent No. 5,923,848, issued July 13, 1999 ("Goodhand") (Ex. 1003).

Gordon Padwick et al.,[1] USING MICROSOFT OUTLOOK 97 (Que® Corporation[2] 1997[3]) ("Padwick") (Ex. 1004).

U.S. Patent No. 6,026,410, issued Feb. 15, 2000 ("Allen") (Ex. 1005).

[1] Our citations to Padwick refer to the page numbers inserted at the bottom center of each page. The Petition cites to the page numbers that appear in either the upper left or upper right portion of most pages of Padwick. We do not cite to these page numbers because some pages do not include these page numbers.

[2] The Petition identifies "Microsoft Press" as the source of Padwick. Pet. iii. Padwick, however, identifies "Que® Corporation" as the publisher. Ex. 1004, 5. Petitioners do not identify any evidence that Microsoft Press is the source of Padwick. Indeed, Mr. Dennis R. Allison, Petitioners' declarant, testifies that Padwick was published by Que® Corporation. Ex. 1002 ¶ 198.

[3] Padwick identifies 1997 as its copyright date. Ex. 1004, 5. The Petition identifies 1996 as the date of Padwick. Pet iii. Mr. Allison testifies that "Padwick has a copyright date of 1997," but that he "can also see from the bibliographic information that Padwick has a Library of Congress control number having the first two digits '96', which indicates that it was deposited with the Library of Congress in 1996" and that "[e]xperts in this field would reasonably rely on this data to establish a publication date." Ex. 1002 ¶ 199. For purposes of this decision, we need not decide whether the evidence regarding the Library of Congress control number establishes a publication date earlier than the 1997 copyright date explicitly listed in Padwick.

E. The Asserted Grounds of Unpatentability

Petitioners challenge the patentability of claims 1–79 of the '853 patent based on the following grounds:[4]

Reference[s]	Basis	Claims Challenged
Goodhand	§ 103(a)	1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79
Goodhand and Padwick	§ 103(a)	6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78
Allen	§ 102(e)	1, 2, 7–11, 13–17, 22, 23, 28–30, 35–38, 43–46, 57, 62–66, 68, 73–77, and 79

II. ANALYSIS

A. Claim Interpretation

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). However, if an inventor acts as his or her own lexicographer, the definition must be set

[4] Petitioners support their challenge with a Declaration executed by Dennis R. Allison on February 14, 2014 ("Allison Declaration") (Ex. 1002).

forth in the specification with reasonable clarity, deliberateness, and precision. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998).

1. "input device" (Claims 1, 9, 11, 23, 24–29, and 38–46)

Petitioners argue that "[i]n the '853 patent the term 'input device' includes a GUI element on a screen, and is thus not limited to only hardware devices," citing Mr. Allison's testimony in support of this contention. Pet. 13 (citing Ex. 1002 ¶ 78). Mr. Allison testifies that "[a]lthough the term 'input device' sounds like a piece of hardware, the '853 patent makes clear that the input device can be a graphical element on a screen, such as a button or menu that the user can interact with via a mouse, touchpad, etc." Ex. 1002 ¶ 78 (citing Ex. 1001, col. 9, l. 65–col. 10, l. 4). In the Preliminary Response, Patent Owner does not suggest an alternative construction.

The evidence cited by Petitioners provides support for Petitioners' claim construction argument. Additionally, upon reviewing the specification of the '853 patent, we do not find any disclosure that provides an explicit definition of "input device" contradicting Petitioners' proposed claim construction. For purposes of this decision, we adopt Petitioners' proposed claim construction of "input device" as including a GUI element on a screen, in addition to hardware.

2. "A computer system configured to perform the steps recited in one of claims 1-14" (Claim 15) and "A storage medium storing a program for performing the steps recited in one of claims 1–14" (Claim 16)

Petitioners argue that the broadest reading for "a computer system configured to perform the steps recited in one of claims 1–14" and the broadest reading for "a storage medium storing a program for performing the

steps recited in one of claims 1–14" results from selecting claim 1 as the "one of claims 1–14" recited. Pet. 13. Accordingly, Petitioners argue, the broadest reasonable interpretation of claim 15 is a system configured to perform the steps recited in claim 1. *Id.* Likewise, Petitioners argue that the broadest reasonable interpretation of claim 16 is a storage medium storing a program for performing the steps recited in claim 1. *Id.* In the Preliminary Response, Patent Owner does not suggest an alternative construction for either claim 15 or claim 16. Petitioners' argument is logical because claims 2–14 depend from and add limitations to claim 1, making claim 1 broader than claims 2–14. For purposes of this decision, we adopt Petitioners' proposed construction of claims 15 and 16.

3. "first information includes an identification of a list of addressees" (Claims 6, 12, and 47–56)

Petitioners note that the written description of the '853 patent uses the phrase "mailing list," but does not include the phrase "list of addressees" or the phrase "identification of a list." Pet. 13–14 (citing Ex. 1001, col. 4, ll. 14–15, 38–42; Ex. 1002 ¶ 81). In concert with this, Petitioners argue that the broadest reasonable interpretation of the claim recitation "[the] first information includes an identification of a list of addressees" is "[the] first information is sufficient to identify multiple addressees." *Id.* at 14 (citing Ex. 1002 ¶ 83). In the Preliminary Response, Patent Owner does not suggest an alternative construction.

Upon reviewing the specification of the '853 patent, we do not find an explicit definition for the claim phrase "first information includes identification of a list of addressees." Therefore, we refer to its ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504

F.3d at 1257. For purposes of this decision, we adopt Petitioners' proposed claim construction because it is consistent with its ordinary and customary meaning as would be understood by one with ordinary skill in the art in light of the specification of the '853 patent.

4. "application program" (Claims 1, 8, 10, 17–22, and 30–37)

Petitioners do not propose a construction for the claim language "application program." Patent owner argues that this claim language should be interpreted as meaning "an independently executable computer program designed to assist in the performance of a specific task, such as word processing or spreadsheet processing." Prelim. Resp. 9. Patent Owner notes that claim 1 uses the term "application program" when referring to "a document created using an application program." *Id.* at 8. In concert with this, Patent Owner asserts that the '853 patent discusses examples of working with documents created using Microsoft Word and Excel. *Id.* at 8–9 (citing Ex. 1001, col. 5, l. 58–col. 8, l. 37; col. 8, l. 39–col. 9, l. 12). Based on these assertions, Patent Owner argues that its proposed construction of "application program" is "in accordance with its ordinary and customary meaning and the clear usage of the term within the intrinsic evidence." *Id.* at 9.

The evidence cited by Patent Owner provides support for Patent Owner's claim construction argument. Additionally, upon reviewing the specification of the '853 patent, we do not find any disclosure that provides an explicit definition of "application program" contradicting Patent Owner's proposed claim construction. For purposes of this decision, we adopt Patent Owner's proposed construction of "application program" as consistent with

its ordinary and customary meaning as would be understood by one with ordinary skill in the art in light of the specification of the '853 patent.

5. "analyzing the document to determine if the first information is contained therein" (Claim 1)

Petitioners do not propose a construction for the claim language "analyzing the document to determine if the first information is contained therein." Patent Owner argues that this claim language requires an action separate from the action recited in the claim language "if the first information is contained in the document, searching, using the record retrieval program, the information source for second information associated with the first information." Prelim. Resp. 9–10. In concert with this, Patent Owner argues that the analyzing action must determine that "the first information is contained in the document" as a pre-condition to the recited searching process. *Id.* at 10.

On the record before us, we agree. The plain language of the claim sets out "analyzing" and "searching" as separate actions, conditioning the execution of the searching action on a determination that the document contains the first information. The written description discloses a system consistent with the plain meaning of the claim language (*see, e.g.*, Ex. 1001, col. 4, l. 22–col. 5, l. 7), and there is no cited evidence that the proper construction of the claim differs from its plain meaning.

Patent Owner also argues that the claim language "analyzing the document to determine if the first information is contained therein" "requires a computer process that identifies the first information in the document, without recourse to user selection of the text to be analyzed." Prelim. Resp. 13. Patent Owner points out that the '853 patent discloses a program that analyzes document text to identify contact information without requiring a

user to first select part of the document for the analysis. *Id.* at 10. Additionally, Patent Owner cites the '853 patent's prosecution history, during which the following occurred: (1) the claim language in question was added by amendment; and (2) it was argued that "the present invention does not require the user to select a text string to be processed since it functions automatically upon a single click of an input device, such as a button, menu item, etc." Ex. 2004, 2–3; Prelim. Resp. 10–13. In concert with this, Patent Owner points out that its proposed interpretation is consistent with the way that the U.S. District Court for the District of Rhode Island, in *Arendi U.S.A., Inc. v. Microsoft Corporation*, Case No. 02-343-T, construed the claim in light of the prosecution history of the '853 patent. Prelim. Resp. 13. Patent Owner argues that "[i]t is proper to consider prosecution history in determining the meaning of a claim that is being evaluated in a contested proceeding in the Patent and Trademark Office." *Id.* at 14 (citing *Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973 (Fed. Cir. 2014)).

Patent Owner does not persuade us that the broadest reasonable interpretation of the claim limitation "analyzing the document to determine if the first information is contained therein" requires identification of the first information without recourse to user selection of the text to be analyzed. The plain meaning of the claim language conveys nothing about whether a user may or must select text to be subject to the analyzing process. Regarding Patent Owner's observation that the '853 patent discloses a system that does not require the user to select text, the '853 patent also discloses that "[a]lthough the present invention is defined in terms of a program retrieving information from a document before searching a

database, the user may select the information in the document to be searched by the program in the database." Ex. 1001, col. 10, ll. 5–8. We also are unpersuaded by Patent Owner's arguments that its proposed construction is consistent with that of the District of Rhode Island and that we should consider prosecution history when construing the claim. Patent Owner does not explain adequately why consideration of the prosecution history leads to its proposed construction under the broadest reasonable interpretation standard, which we apply in this proceeding, as opposed to the claim construction standard applied in district court. *See* Ex. 2007, 1.

B. Obviousness of Claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 Based on Goodhand

1. Goodhand (Ex. 1003)

Goodhand discloses a system and method that handles e-mail. Ex. 1003, Abstract. Goodhand discloses that "the preferred application program is divided into several modules, including a calendar manager, a task list manager, a contact manager, a message manager (e-mail), and a notes manager." *Id.* at col. 8, ll. 46–49. Goodhand notes that either a stand-alone or a distributed computing environment could be used to implement its system and method. *Id.* at col. 8, ll. 55–58. Goodhand further notes that "the primary interaction between the preferred program and the operating system involves message related tasks," and that "[t]he preferred operating system incorporates the Messaging Application Programming Interface (MAPI)." *Id.* at col. 12, ll. 38–43. Goodhand discloses that MAPI provides a number of messaging functions, including access to address books. *Id.* at col. 12, ll. 40–49.

When a user is composing a new e-mail message, Goodhand's system helps the user by resolving automatically recipient display names. *Id.* at

col. 4, ll. 49–51. Goodhand explains that "'resolving' the names means attempting to match the display names in the address field to specific user aliases that are included in a centralized address book or directory, which is typically stored on a remote server, such as a remote memory storage device 33." *Id.* at col. 17, ll. 25–29. Goodhand discusses an example of this process in connection with Figures 6a–6c. *Id.* at col. 17, ll. 6–9. Figure 6a is reproduced below.

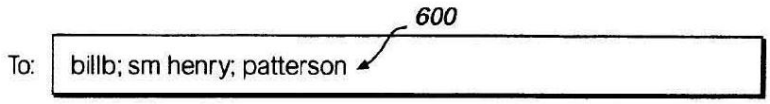

FIG. 6a

Figure 6a shows an address field of an e-mail form in use to compose a message. *Id.* at col. 17, ll. 12–13. At the point shown in Figure 6a, a user has entered into address field 600 three display names, each providing identifying information about an intended recipient. *Id.* at col. 17, ll. 15–17. Each display name may include all or part of a first name, last name, and/or e-mail alias of an intended recipient. *Id.* at col. 17–19. To resolve the display names "billb," "sm henry," and "patterson," the system searches address book fields in an attempt to match each display name with the first name, last name, or alias of a registered user. *Id.* at col. 17, ll. 29–36. As part of this process, the system may call MAPI functions, including a MAPIResolveName function, to match informal names with actual e-mail aliases. *Id.* at col. 19, ll. 44–48.

Goodhand discusses a subsequent stage of the process in connection with Figure 6b, reproduced below. *Id.* at col. 17, ll. 38–52.

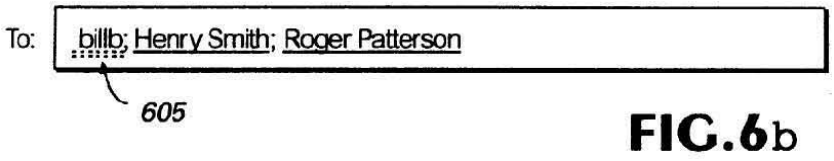

FIG. 6b

Figure 6b "illustrates the results of the effort to resolve the names." *Id.* at col. 17, ll. 38–39. If searching the address books identifies an unambiguous match for the display name of an intended recipient, the system inserts the full name of the intended recipient with a regular underline beneath it in the address field. *See id.* at col. 17, ll. 45–49; col. 19, ll. 26–52. In Figure 6b, because the system unambiguously matched the display names "sm henry" and "patterson" to "Henry Smith" and "Roger Patterson," the system displays "Henry Smith" and "Roger Patterson" with a regular underline beneath each. *Id.* at col. 17, ll. 45–49.

Figure 6b further illustrates that squiggly line 605 appears underneath the display name "billb," indicating that the system could not find a unique match for that display name. *Id.* at col. 17, ll. 49–52; *also* col. 19, ll. 52–53. Goodhand discloses that its system includes features that help a user address such an unresolved display name. *Id.* at col. 17, l. 53–col. 18, l. 13.

2. Discussion

Petitioners contend that each limitation of claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 is taught expressly by, is inherent in, or is obvious over Goodhand. Pet. 14–37. Petitioners argue that the claim recitations of "record retrieval program" and "initiates a record retrieval from an information source using the record retrieval program" are disclosed by or obvious over Goodhand. *Id.* at 16–20.

Petitioners argue that "to the extent that the Patent Owner argues that Goodhand does not teach a separate 'record retrieval program', it would have been obvious to provide one." *Id.* at 17. Petitioners cite a number of Goodhand's disclosures as teaching or rendering obvious a separate record retrieval program. For example, Petitioners cite Goodhand's disclosure that its system includes a contact manager as a separate module from the message manager, Goodhand's disclosure of a centralized address book stored on a remote server, and Goodhand's disclosure of using a MAPI to search the address book. *Id.* at 17–20.

Petitioners also contend that the claim limitation "analyzing the document to determine if the first information is contained therein" is disclosed inherently by or is obvious in view of Goodhand. *Id.* at 20–21. Petitioners note that Goodhand discloses entry of partial names or e-mail addresses, which Goodhand refers to as "display names," into an address field in an e-mail document. *Id.* at 20. Petitioners contend that these display names correspond to the claimed "first information." *Id.* Petitioners note that Goodhand discloses checking each display name against a nickname list and using each display name separately to perform searches. *Id.* at 20–21. Given these cited disclosures in Goodhand, Petitioners argue that Goodhand's system must analyze the text in the address field to determine if it contains anything to process and, if so, must be identifying correctly each display name to use as a search term. *Id.* at 21. Accordingly, Petitioners argue that the claim limitation "analyzing the document to determine if the first information is contained therein" is "inherent in Goodhand's disclosure" or "[a]t a minimum . . . would have been trivially obvious . . . because performing that analysis would allow the system to use the

identified display names in the searches expressly taught by Goodhand." *Id.* at 21.

Patent Owner argues that Petitioners do not demonstrate that Goodhand teaches "analyzing the document to determine if the first information is contained therein," as recited in independent claim 1. Prelim. Resp. 23–27. Patent Owner bases this contention on its argument that the claim limitation excludes any system that requires a user to select text in the document as a condition for processing the text. *Id.* at 23–24. In combination with this claim construction argument, Patent Owner argues that entering text into the address field of an e-mail constitutes selection of the text. *Id.* at 25–26. Thus, Patent Owner argues that because Goodhand discloses that a user enters text in the address field before the system analyzes the text, Goodhand requires "a user selection of text as a condition to the processing of that text." *Id.* at 26.

As discussed above in Section II.A.1, Patent Owner's arguments have not persuaded us that the broadest reasonable interpretation of the claim limitation "analyzing the document to determine if the first information is contained therein" precludes a method that requires user selection of text prior to processing the text. Thus, Patent Owner's argument that Goodhand's method requires a user to select text as a condition to processing the text is inapposite.

On the record before us, based on our review of the Petition and supporting evidence, we are persuaded by Petitioners' arguments regarding each of the limitations of claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 that Petitioners have demonstrated a reasonable likelihood of prevailing on its assertion that these claims are unpatentable over Goodhand.

C. Obviousness of Claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 Based on Goodhand and Padwick

1. Padwick (Ex. 1004)

Padwick discusses Microsoft Outlook 1997 and how to use it. *See, e.g.*, Ex. 1004, 1, 35. Padwick discloses that Outlook allows a user to, among other things, send and receive information by e-mail. *Id.* at 36. Padwick discloses that "Microsoft Outlook can be configured to use Microsoft Word as its e-mail editor." *Id.* at 199. Additionally, Padwick discloses that Outlook includes a Personal Address Book, which can include "personal distribution lists for use with messages frequently addressed to standard groups of people." *Id.* at 146–147. Padwick explains that "[y]ou may want to create, for example, a distribution list with the names of everyone in your department or one for preferred vendors." *Id.* at 147.

2. Discussion

Each of the claims challenged in the ground based on Goodhand and Padwick depends from one or more of the claims challenged in the ground based on Goodhand. *See* Ex. 1001, cols. 11–16. The ground based on Goodhand and Padwick refers to the arguments and evidence presented in the ground based on Goodhand to address the limitations of the claims challenged in the ground based on Goodhand (*see* Pet. 38, 40, 43), as well as certain limitations of claims 21, 27, 42, 46, 61, 65, 67, 72, 76, and 78 (*see id.* at 40–41, 43–44). The ground based on Goodhand and Padwick relies on Padwick, in combination with Goodhand, as rendering obvious certain limitations recited in claims 6, 10, 12, 30–37, and 47–56. *See id.* at 40–44.

For example, the ground based on Goodhand and Padwick relies on Padwick to teach "using one of a word processing program and a spreadsheet program to enter first information into a respective one of a

word processing document and a spreadsheet document," as recited in claims 10 and 30–37. *Id.* at 40–41, 43. Petitioners explain that Goodhand suggests using the Microsoft Outlook program for entering e-mail messages. *Id.* at 40. In combination with this, Petitioners note that Padwick describes the Microsoft Outlook program and teaches configuring Microsoft Outlook to use a word processing program as its e-mail editor. *Id.* at 39–40. Petitioners argue that Padwick teaches that doing so provides certain advantages, specifically it provides "more tools and options from which to choose when creating messages." *Id.* For these and other reasons, Petitioners contend that it would have been obvious to combine with the teachings of Goodhand and Padwick. *Id.* at 38–41.

The ground based on Goodhand and Padwick also relies on Padwick to teach the recitation in claim 6 that "said first information includes an identification of a list of addressees, further comprising: addressing said document to all of said addressees based on the second information associated with said identification of said list of addressees." *Id.* at 41–42. Similarly, the ground based on Goodhand and Padwick relies on Padwick to teach the recitation in claims 12 and 47–56 that "said first information includes an identification of a list of addressees, further comprising: creating copies of said document, each addressed to one of addressees in said list identified by said first information, based on said second information associated with said identification of said list of addressees." *Id.* at 41–43.

In addressing claim 6, Petitioners note that Padwick discloses creating distribution lists that have nicknames and allow sending e-mail to a number of people at once. *Id.* at 41. In view of this, Petitioners argue, it would have been obvious to use the method of Goodhand to replace a distribution list

nickname with individual addresses associated with the distribution list. *Id.* at 42. Petitioners argue that doing so would have involved the following: (1) merely recognizing that the distribution list nickname (corresponding to the claimed "first information") is associated with more than one e-mail address (corresponding to the claimed "second information"); and (2) providing each of the e-mail addresses. *Id.* Petitioners also argue that doing so would represent mere automation of what a user could do manually, providing the advantage of allowing the user to confirm individual addresses in the distribution list with fewer mouse clicks. *Id.* Petitioners further argue that Goodhand discloses a desire to reduce the number of mouse clicks. *Id.* For these reasons, Petitioners contend that claim 6 would have been obvious. *Id.* at 41–42. Petitioners argue that claims 12 and 47–56 would have been obvious for the foregoing reasons and because "emails sent to distribution lists would obviously have a separate copy arrive at each recipient's inbox, and would need to be addressed to that recipient in order to arrive correctly." *Id.* at 42–43.

Each of claims 21, 27, 42, 46, 61, 65, 67, 72, 76, and 78 depends from one of claims 6, 10, 12, 30–37, and 47–56 and recites the same limitations as one of the claims addressed in the ground based on Goodhand. Accordingly, Petitioners refer to the ground based on Goodhand to address the limitations recited in claims 21, 27, 42, 46, 61, 65, 67, 72, 76, and 78. *See id.* at 40–41, 43–44.

On the record before us, Petitioners demonstrate a reasonable likelihood of prevailing on its challenge of claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 as obvious over Goodhand and Padwick.

D. Anticipation of Claims 1, 2, 7–11, 13–17, 22, 23, 28–30, 35–38, 43–46, 57, 62–66, 68, 73–77, and 79 by Allen

The patent rules promulgated for AIA post-grant proceedings, including those pertaining to institution, are "construed to secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b); *see also* 35 U.S.C. § 316(b) (regulations for AIA post-grant proceedings take into account "the efficient administration of the Office" and "the ability of the Office to timely complete [instituted] proceedings"). Therefore, we exercise our discretion and do not institute a review of the ground based on Allen for reasons of administrative necessity to ensure timely completion of the instituted proceeding. *See* 37 C.F.R. § 42.108(a).

III. CONCLUSION

Based on the arguments in the Petition and Preliminary Response as well as the evidence of record, we determine that Petitioners have demonstrated a reasonable likelihood that they would prevail on their challenge to claims 1–79 of the '853 patent.

We have not made a final determination as to the patentability of any challenged claim.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that *inter partes* review is instituted as to claims 1–79 of the '853 patent with respect to the following grounds:

Claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 under 35 U.S.C. § 103(a) as unpatentable over Goodhand; and

Claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 under 35 U.S.C. § 103(a) as unpatentable over the combination of Goodhand and Padwick.

FURTHER ORDERED that no ground other than those specifically granted above is authorized for the *inter partes* review as to the '853 patent; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '853 patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial.

IPR2014-00452
Patent 6,323,853 B1

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Exhibit 6E

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Google Inc. and Motorola Mobility LLC,

Petitioners,

v.

Arendi S.A.R.L.,

Patent Owner.

Case No. IPR2014-00452

Patent No. 6,323,853

PATENT OWNER ARENDI S.A.R.L.'S RESPONSE

UNDER 37 C.F.R. §42.120

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EXHIBIT LIST

Arendi Exhibit Number	Description
2001	Office action dated September 18, 2000 on application for '853 Patent [filed with Preliminary Response]
2002	Interview Summary for October 17, 2000 relating to application for the '853 Patent [filed with Preliminary Response]
2003	Tso, United States patent 6,085,201 [filed with Preliminary Response]
2004	Amendment dated December 18, 2000 to application for '853 Patent [filed with Preliminary Response]
2005	Notice of allowability of application for '853 Patent [filed with Preliminary Response]
2006	File Wrapper of '853 Patent [filed with Preliminary Response]

2007	Order re Claim Construction in *Arendi U.S.A., Inc. v. Microsoft Corporation*, CA No. 02-343-T, District of Rhode Island, September 27, 2004 [filed with Preliminary Response]
2008	Declaration of John V. Levy, Ph.D. [filed herewith]

I. INTRODUCTION

Patent Owner Arendi S.A.R.L. ("Arendi" or "Patent Owner") respectfully requests that the Board determine that Google Inc. and Motorola Mobility LLC ("Petitioners") have failed to establish by a preponderance of the evidence, with respect to U.S. Patent No. 6,323,853 (the "'853 Patent"), that any of claims 1-79 are unpatentable under 35 U.S.C. §103(a) over Goodhand taken alone or in combination with Padwick.

The Goodhand system depends on the user to select contact information by placing it into the "To" field of an e-mail template. In contrast, the limitation in claim 1 of "analyzing the document to determine if the first information is contained therein" requires distinguishing between first information, such as contact information, and other text in the document. Because Goodhand lacks a computer process that distinguishes between contact information and other text in the document, Goodhand lacks a computer process corresponding to "analyzing the document to determine if the first information is contained therein".

Moreover, claim 1 requires that the process of "analyzing the document to determine if the first information is contained therein" is triggered "*upon* a *single* entry of the execute command by means of the input device. The explicit role of the execute command in the process leaves no place for user selection of text in the document. Because Goodhand depends on user selection of contact information by

entering it into the address field of the e-mail template, for this additional reason Goodhand fails to meet the terms of claim 1.

Because the broadest reasonable claim construction cannot be inconsistent with the explicit basis for allowance of the application leading to issuance of the '853 Patent, wherein subject matter was expressly surrendered, claim 1 rules out user selection of contact information, whereas Goodhand requires user selection.

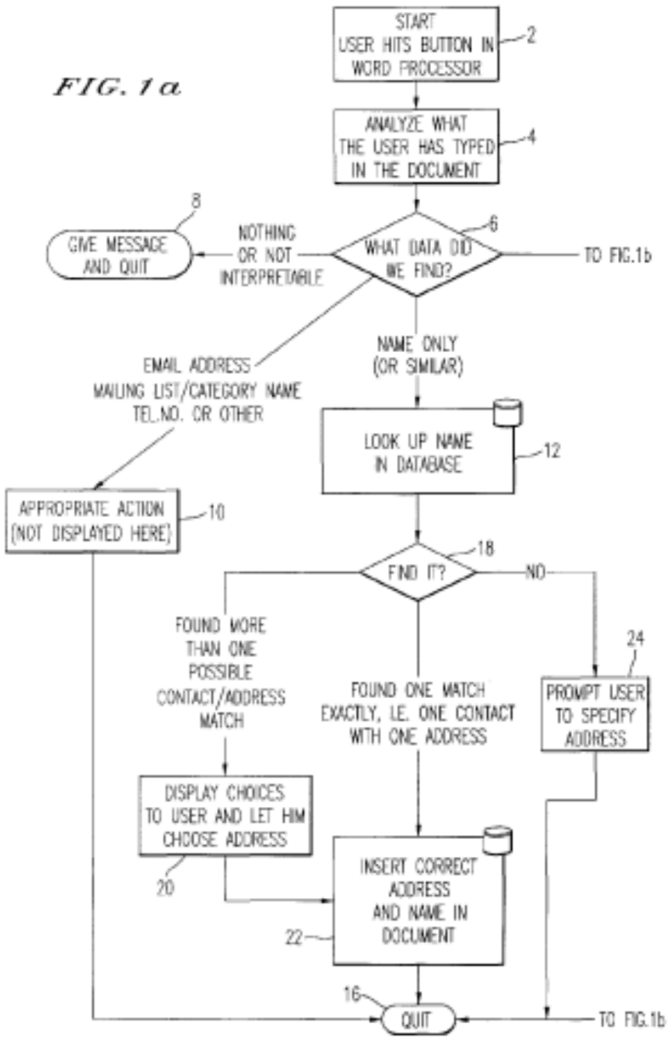
Because Inter Partes Review is an adjudicatory process applied to an issued patent, the standard for claim interpretation should be the judicial standard under *Phillips v. AWH Corp*., 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

II. OVERVIEW OF THE '853 Patent

The '853 Patent is directed, among other things, to computer-implemented processes for automating a user's interaction between an application program, such as a word processing application or spreadsheet application, on the one hand, and a record retrieval application, such as contact management application having a database, on the other hand. In the '853 Patent, Exhibit 1001, Figs. 1 and 2 are flow charts showing for these interactions a number of scenarios, which are described from col. 4, line 22 to col. 5, line 53. Further details of the interactions are provided in discussion thereafter of the other figures of the '853 Patent, and the

discussion includes references back to relevant portions of the flow charts in Figs. 1 and 2. Fig. 1, which includes Fig. 1a and Fig. 1b, is reproduced below.

FIG. 1a



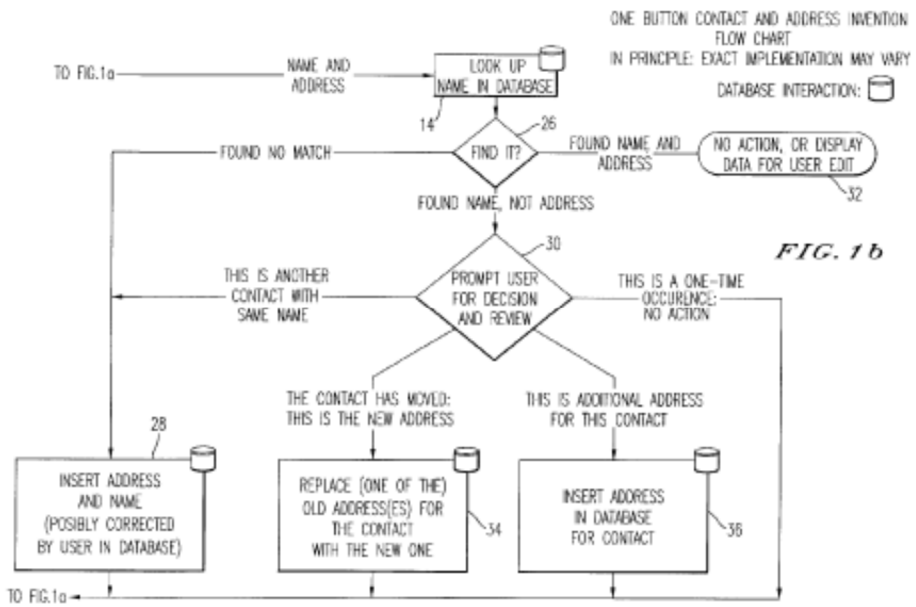


FIG. 1b

In various scenarios, the user enters an execute command (in step 2 of Fig. 1) in the application program, following which text in a document in the application program is analyzed (in step 4 of Fig. 1) to identify if first information, such as contact information, is contained therein. Exhibit 1001, col. 4, line 55 to col. 5, line 2. The analysis process is described thus:

> In FIG. 1, after the user has inserted the address in the word processor, the user commands the button at step **2** and the program analyses what the user has typed in the document at step **4**. At step **6**, the program decides what was found in the document and if the program found nothing in the document or what it found was uninterpretable the program goes to step **8** and outputs an appropriate message to the user and then quits at step **16.** The program analyzes what the user has typed in the document at step **4**, for example, by analyzing (i) paragraph/line separations/formatting, etc.; (ii) street, avenue, drive, lane, boulevard, city, state, zip code, country

> designators and abbreviations, etc.; (iii) Mr., Mrs., Sir, Madam, Jr., Sr. designators and abbreviations, etc.; (iv) Inc., Ltd., P.C., L.L.C, designators and abbreviations, etc.; and (v) a database of common male/female names, etc.

Ex. 1001, col. 4, lines 22-37.

The computer process analyzes the document to determine if contact information is present. The above passage shows that contact information is distinguished from other information by techniques such as "analyzing (i) paragraph/line separations/formatting, etc.; (ii) street, avenue, drive, lane, boulevard, city, state, zip code, country designators and abbreviations, etc.; (iii) Mr., Mrs., Sir, Madam, Jr., Sr. designators and abbreviations, etc.; (iv) Inc., Ltd., P.C., L.L.C, designators and abbreviations, etc.; and (v) a database of common male/female names, etc." Several possibilities exist, and they are enumerated at step **6** of Fig. 1.

It might be that no contact information is found or that the information is uninterpretable. This is shown in Fig. 1 as the path to step **8**, wherein the process quits and an appropriate message is supplied. If a name only is found, then the logical flow in Fig. 1 is to step **12**, involving a database look-up of the name, etc. If a name and an address are found, the logical flow is to step **14** (in Fig. 1b), involving slightly different processing after a data-base look-up of the name, depending on whether an address is or is not found with the name, and whether or

not there is a match as to the addresses, etc. If an e-mail address or other contact information is found, the logical flow is to step **10**, where different processing occurs. Declaration of John V. Levy, Ph.D, Exhibit 2008, paragraph 20.

The logical flow diagram of Fig. 1 therefore shows that a computer process corresponding to "upon a single entry of the execute command by means of the input device:/ analyzing the document to determine if the first information is contained therein" in claim 1 of the '853 Patent distinguishes contact information from other text in the document. In Fig. 1, it also distinguishes among types of contact information. (In the discussion herein, contact information is an example of "first information" required by claim 1.) The logical flow in Fig. 2 of the '853 Patent is similar to the logical flow in Fig. 1 and also includes the corresponding recited steps **2**, **4**, **6**, **8**, **12**, and **14**. Ex. 1001, col. 5, lines 8-10 and following. Declaration of Dr. Levy, Exhibit 2008, paragraph 21.

Accordingly Figs. 1 and 2 and the accompanying description in the '853 Patent confirm that "upon a single entry of the execute command by means of the input device:/ analyzing the document to determine if the first information is contained therein" requires a computer process that distinguishes between "first information" in the document and other text in the document. Declaration of John Levy, Exhibit 2008, paragraph 23.

Additionally, it can be seen, from a reading of the above passage, that the program performs the analysis without requiring the user to select a specific part of the document to be subject to the analyzing. Thus, in example 1, it is stated that "The user hits the button 42, for example, marked "OneButton" and the program according to the present invention retrieves the name 40 from the document, searches a database for the name 40, and inserts the retrieved address 44 associated with the name 40 into the document as shown in, for example, FIG. 4." Ex. 1001, Col. 5, lines 62-67. Similar language appears in Example 2 (col. 6, lines 8-12): "The user commands the button 42, for example, marked 10 'OneButton,' and the program according to the invention retrieves the new contact 46 from the document, searches a database for the name of the new contact 46…." Examples thereafter are to similar effect; the user is not required to select a specific part of the document to be subject to the analyzing: Example 3, col. 6, lines 39-44; Example 4, col. 6, lines 59-63; Example 5, col. 7, lines 20-24; etc.

As we have discussed above, once the analyzing identifies contact information in the document, a number of different scenarios can follow, depending on the circumstances. In one scenario, if the identified contact information includes a name, a search is initiated in the database associated with the record retrieval application for the name. *Id*., Fig. 1, steps 6, 12, and 14. If the contact information identified in the document included only a name, and if only a

single entry is found in the database for the name and the entry includes a single address, then the address is inserted into the document. *Id*. Fig. 1, steps 6, 12, 18, and 22; Fig. 4; col. 5, line 58 to col. 6, line 2. Fig. 4, which is reproduced below, shows the document displayed in Microsoft Word after the address has been inserted.

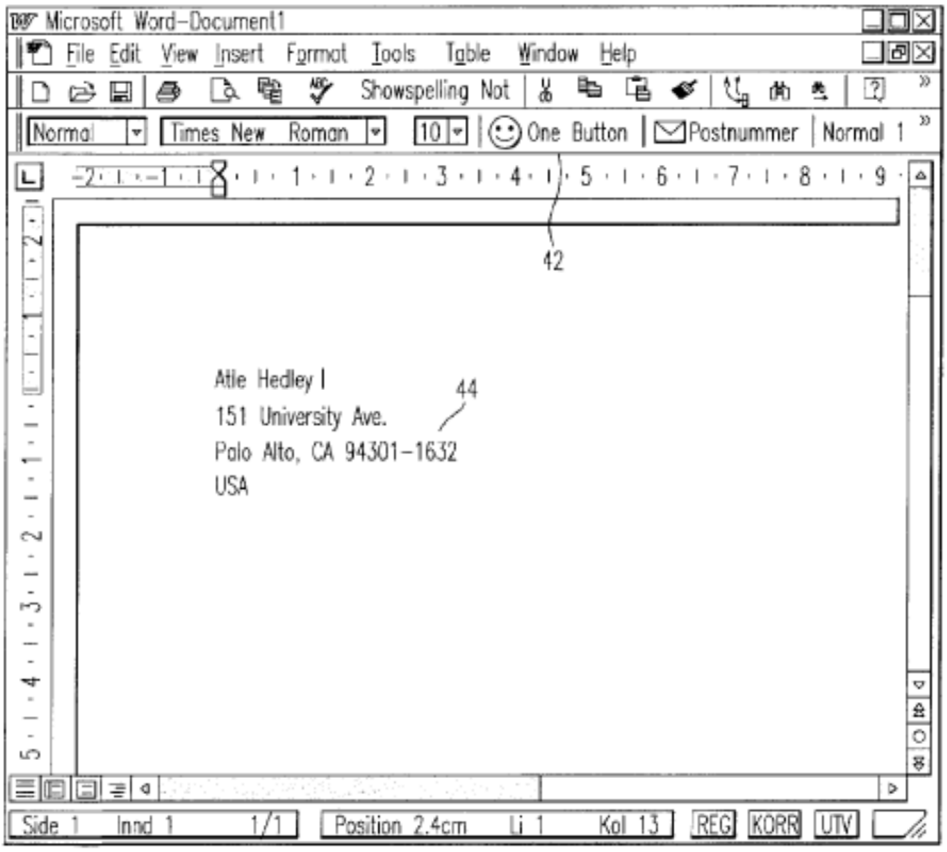


FIG. 4

Shown in Fig. 4 is the One Button 42, which, when pressed, launches the processes just recited, including analyzing the document to identify contact information, the searching in the database, and inserting of the address. *Id*., Fig. 1; col. 5, line 58 to col. 6, line 2.

On the other hand, if multiple addresses are found in searching the database for the identified name, these found addresses are displayed, and the user is presented with a choice of which of the addresses to insert. *Id.*, Fig. 1, steps 18, 20, and 22; Fig. 10; col. 7, lines 15-61.

As shown in Fig. 1 and Fig. 2, numerous other scenarios are also disclosed in the '853 Patent, and these scenarios are explained in the description in connection with later figures of the '853 Patent.

III. CLAIM CONSTRUCTION

In an *inter partes* review according to 37 C.F.R. §42.100(b), the Patent Trial and Appeal Board gives patent claims their "broadest reasonable construction in light of the specification of the patent." "To ascertain the scope and meaning of the asserted claims, we look to the words of the claims themselves, the specification, the prosecution history, and, lastly, any relevant extrinsic evidence." *Phillips v. AWH Corp*., 415 F. 3d 1303, 1315-17 (Fed. Cir. 2005) (en banc)." *In re Baxter Int'l*, 678 F. 3d. 1357, 1362 (Fed. Cir. 2012) (Standard on appeal from *ex parte* reexamination.). Extrinsic evidence is relevant only to the extent it is consistent with the specification and file history. *Phillips v. AWH Corp*. at 1319.

Patent Owner Arendi proposes construction of certain claim terms below pursuant to the broadest reasonable construction consistent with the specification standard.

A. "Application program"

Claim 1 of the '853 Patent uses the term "application program" in referring to "[a] computerized method for information handling within a document created using an application program". As to the kinds of "application program" used to create a document, in describing embodiments of the invention, the '853 Patent gives examples of documents created using Microsoft Word (see Examples 1-6, col. 5, line 58 to col. 8, line 37) and Excel (see Example 7, which is said to be for a "Spreadsheet *Application*" (emphasis added), col 8, line 39 to col. 9, line 12). Accordingly, the term "application program" should be construed in accordance with its ordinary and customary meaning and the clear usage of the term within the intrinsic evidence as "an independently executable computer program designed to assist in the performance of a specific task, such as word processing or spreadsheet processing."

This construction is also consistent with claim 10, which depends on claim 1, and requires that "using the application program comprises: / using one of a word processing program and a spreadsheet program …."

The Board adopted this construction in its Institution Decision (pp. 12-13).

B. The limitations of "upon a single entry of the execute command by means of the input device:/ analyzing the document to determine if the first information is contained therein" require distinguishing the presence of first information, from other text in the document, and this process is triggered by a single entry of the execute command

Although in its Institution Decision of August 20, 2014, the Board rejected the view that "the broadest reasonable interpretation of the claim limitation 'analyzing the document to determine if the first information is contained therein' requires identification of the first information without recourse to user selection of the text to be analyzed" (page 14), still, under the broadest reasonable interpretation standard, the meaning of this claim limitation must still be ascertained. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Accordingly, we consider this limitation in the context of the rest of the claim to ascertain its meaning, and do so in further detail than in the Preliminary Response.[1]

[1] We address, for the first time in this proceeding, the limitation "upon a single entry of the execute command by means of the input device:"—this

To elucidate the meaning of "analyzing the document to determine if the first information is contained therein" in claim 1 of the '853 Patent, we consider the context including the phrases appearing immediately before and after this limitation:

> upon a single entry of the execute command by means of the input device:
>
> analyzing the document to determine if the first information is contained therein, and
>
> if the first information is contained in the document, searching, using the record retrieval program, the information source for second information associated with the first information…

The claim structure requires the process of analyzing to occur "upon a single entry of the execute command by means of the input device". We discuss this condition in detail below.

The processes required are (first) "analyzing the document to determine if the first information is contained therein" and (second) "if the first information is contained in the document," then "searching, using the record retrieval program,

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limitation was not briefed in the Preliminary Response, even though it played a role in the procedural history and in the Rhode Island federal court proceeding involving the '853 Patent, both of which are discussed below.

the information source for second information associated with the first information." The analyzing process precedes the searching process, which is a separate process. A determination by the analyzing process that "the first information is contained in the document" is a pre-condition for the searching process. The Board adopted this construction in its Institution Decision (p. 13).

Moreover, the limitation requires that the analyzing of the document is "to determine *if* the first information is contained therein" (emphasis added). The conditional "*if*" means that, possibly, the first information is contained in the document or, possibly, the first information is not contained in the document. The process of "analyzing" determines "if" the first information is contained in the document. Since nothing in the claim limits contents of the document as to other text, it must be necessary that the process of "analyzing the document to determine if the first information is contained therein" requires distinguishing between first information in the document and other text in the document. See Declaration of Dr. Levy, Exhibit 2008, paragraph 23.

Specifically, the limitation would make no sense if this process were incapable of discriminating between first information in the document and other text in the document. Since it is required that the "analyzing" of the document must be capable of determining if the first information is contained in the document, and since such a determination is made in a context wherein no

limitation is placed on contents of the document generally, then, under any reasonable interpretation, "analyzing the document to determine if the first information is contained therein" requires distinguishing between "first information" in the document and other text in the document. *Id*., paragraph 23.

Such an interpretation is consistent with the logical flow shown in Fig. 1 and as the logical flow is described in the text of the '853 Patent. As discussed in section II above, we cited this passage as exemplary:

> In FIG. 1, after the user has inserted the address in the word processor, the user commands the button at step **2** and the program analyses what the user has typed in the document at step **4**. At step **6**, the program decides what was found in the document and if the program found nothing in the document or what it found was uninterpretable the program goes to step **8** and outputs an appropriate message to the user and then quits at step **16.** The program analyzes what the user has typed in the document at step **4**, for example, by analyzing (i) paragraph/line separations/formatting, etc.; (ii) street, avenue, drive, lane, boulevard, city, state, zip code, country designators and abbreviations, etc.; (iii) Mr., Mrs., Sir, Madam, Jr., Sr. designators and abbreviations, etc.; (iv) Inc., Ltd., P.C., L.L.C, designators and abbreviations, etc.; and (v) a database of common male/female names, etc.

Ex. 1001, col. 4, lines 22-37.

This passage shows that, in this example, the computer process analyzes the text of the document to determine if contact information is present. (Contact information is an example of "first information".) Contact information is identified by techniques such as "analyzing (i) paragraph/line separations/formatting, etc.; (ii) street, avenue, drive, lane, boulevard, city, state, zip code, country designators and abbreviations, etc.; (iii) Mr., Mrs., Sir, Madam, Jr., Sr. designators and abbreviations, etc.; (iv) Inc., Ltd., P.C., L.L.C, designators and abbreviations, etc.; and (v) a database of common male/female names, etc." Several possibilities exist, and examples are enumerated at step **6** of Fig. 1. It might be that no contact information is found or that the information is uninterpretable. This is shown as the path to step **8**, wherein the process quits and an appropriate message is supplied. If a name only is found, then the logical flow is to step **12**, involving a database look-up of the name, etc. If a name and an address are found, the logical flow is to step **14** (in Fig. 1b), involving slightly different processing after a data-base look-up of the name, depending on whether an address is or is not found with the name, and whether or not there is a match as to the addresses, etc. If an e-mail address or other contact information is found, the logical flow is to step **10**, where different processing occurs. Declaration of Dr. Levy, Exhibit 2008, paragraph 20.

The logical flow diagram of Fig. 1 therefore shows that a computer process corresponding to "analyzing the document to determine if the first information is contained therein" in claim 1 of the '853 Patent examines text in the document to distinguish contact information from other text in the document, and also to distinguish among types of contact information. The logical flow in Fig. 2 of the '853 Patent is similar the logical flow in Fig. 1 and also includes the corresponding recited steps **2**, **4**, **6**, **8**, **12**, and **14**. Col. 5, lines 8-10 and following. Declaration of Dr. Levy, Exhibit 2008, paragraph 21.

Accordingly, Figs. 1 and 2 and the accompanying description in the '853 Patent confirm that "analyzing the document to determine if the first information is contained therein" requires a computer process that examines text in the document to distinguish between "first information" in the document and other text in the document. Declaration of Dr. Levy, Exhibit 2008, paragraph 22.

There is an additional basis for characterizing the limitations "upon a single entry of the execute command by means of the input device:/ analyzing the document to determine if the first information is contained therein" .

As shown above, the analyzing process is required by the claim to be one that is launched "upon a single entry of the execute command by means of the input device". The claim therefore makes the process of "analyzing" conditioned "*upon* a single entry of the execute command by means of the input device"

(emphasis added). The word "upon" means "on", and is "used to say that someone or something is very close or has arrived". (Free Merriam-Webster Dictionary, accessed on October 6, 2014 at http://www.merriam-webster.com/dictionary/upon.) In this context, the meaning of "upon" is clearly that the analyzing process occurs as a result of and proximate in time to entry of the execute command. Declaration of Dr. Levy, Exhibit 2008, paragraph 24.

Moreover, the analyzing is triggered not simply by "entry" of the execute command, but rather "upon a *single* entry" of the execute command. The limitation "upon a single entry" therefore makes a single entry of the execute command sufficient to trigger the analyzing. A person of ordinary skill in the art would understand from this limitation that a single entry of the execute command is sufficient to trigger analyzing to occur, and that it occurs automatically after the execute command. Declaration of Dr. Levy, Exhibit 2008, paragraph 25 Since the single entry of the execute command is sufficient to trigger the analyzing, these limitations rule out action by the user, such as selection of text in the document to be analyzed, as a condition for the analyzing to take place. *Id*.

The "execute command", moreover, comes from the "input device". Earlier, claim 1 requires "providing" the "input device" and recites that the input device is "configured to enter an execute command which initiates a record retrieval from an information source using the record retrieval program". And the analyzing process

operates on the document "to determine if the first information is contained therein". The consequence of these limitations in combination is that the execute command triggers the "analyzing of the document to determine if the first information is contained therein" and "if the first information is contained in the document" there follows the process of "searching, using the record retrieval program, the information source for second information associated with the first information".

The structure of the claim shows that the single execute command triggers the "analyzing of the document to determine if the first information is contained therein." If the user has already selected the first information, the analyzing step would not be needed. The requirement of a computer process for "analyzing the document to determine if the first information is contained therein" would not be needed, because the determination would have already been made by the user. A claim may not be construed to read an express limitation out of a claim or render the disputed claim language mere surplusage. *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 1105 (Fed. Cir. 1996) (holding that a court cannot construe claims to read an express limitation out of the claim or render it meaningless); *Texas Instruments Inc. v. Int'l Trade Comm'n*, 988 F.2d 1165, 1171 (Fed. Cir. 1993) (noting that it is improper to "read an express limitation out of the claims" or "render the disputed claim language mere surplusage"). Moreover, as we explain in section V(C)

below, the broadest reasonable claim construction cannot be inconsistent with the explicit basis for allowance of the application leading to issuance of the '853 Patent.

For these reasons, "upon a single entry of the execute command by means of the input device:/ analyzing the document to determine if the first information is contained therein" means examining the document to distinguish the presence of first information from other text in a process, triggered by a single entry of the execute command, that is inconsistent with user selection of the text to be analyzed.

In section IV(A) below, we show that the Goodhand system is not structured to distinguish contact information from other textual content, and, in contrast to these claim requirements, the user the Goodhand system selects text by choosing to enter it into the Address field.

IV. OVERVIEW OF THE PRIOR ART

A. Overview of Goodhand

Goodhand concerns features associated with an e-mail module in an environment such as Microsoft Outlook. Ex. 1003, col. 8, lines 37-40. The e-mail module, among other things, allows a user to compose an e-mail message using a

"template" or "form", which has an address field (the "To:" portion of the e-mail template), in which the e-mail address of the recipient of the message is entered. *Id*., col 15, lines 54-55 ("To:" field"); col. 16, lines 7-29 (every item is created from a template); col. 16, lines 40-46 (address field); col. 17, lines 12-14 (address field of e-mail form used to create a message item). See also Declaration of Dr. Levy, Exhibit 2008, paragraph 18.

Goodhand specifically concerns processes that are followed when a user enters one or more display names into the "To:" field of an e-mail template. "[T]he display names may include all or part of the recipient's first name, last name, or email alias." Ex, 1003, col. 18, lines 61-62; Ex. 2008, paragraph 18. Fig. 6a shows a typical set of user entries:

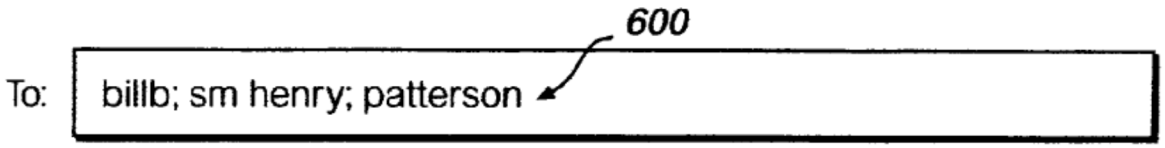


FIG.6a

"FIG. 6a illustrates an address field 600 of an e-mail form that is being used to compose a message item. The form and address field 600 are displayed on the monitor 31 (FIG. 1)." *Id*., col. 17, lines 12-14. Moreover, "[w]hen an e-mail user composes an e-mail message, the user identifies the recipient(s) of the message by

entering one or more display names in the message's address field." *Id.*, Col. 16, lines 39-42.

The address field of Goodhand, in other words, as we describe in further detail below, provides a mechanism by which the user can select contact information (names and e-mail addresses) and identify such information to the Goodhand system. After the user has entered one or more names in the address field of the e-mail template, the technology of Goodhand and the prior art processes the entered text by attempting to match the entered names with e-mail addresses: "Before the message can actually be transmitted by the e-mail system, the system must match each display name entered in the address field to the specific e-mail address (or address book entry) of a registered user." *Id.*, col. 16, lines 43-46. Goodhand explains that the "process of matching the display name(s) to an e-mail address or alias is referred to as 'resolving' the names." *Id.*, col. 16, lines 51-53; Ex. 2008, paragraph 18. The innovation introduced by Goodhand is to resolve the names in the background: "The present invention provides a method for resolving names in the background, which means that the user may continue to use the computer to perform other tasks while the display names are being resolved." *Id.*, col. 16, lines 62-65. Ex. 2008, paragraph 18.

In explaining how the names are "resolved," Goodhand states that "[t]he entered display name may include all or part of the intended recipient's first name,

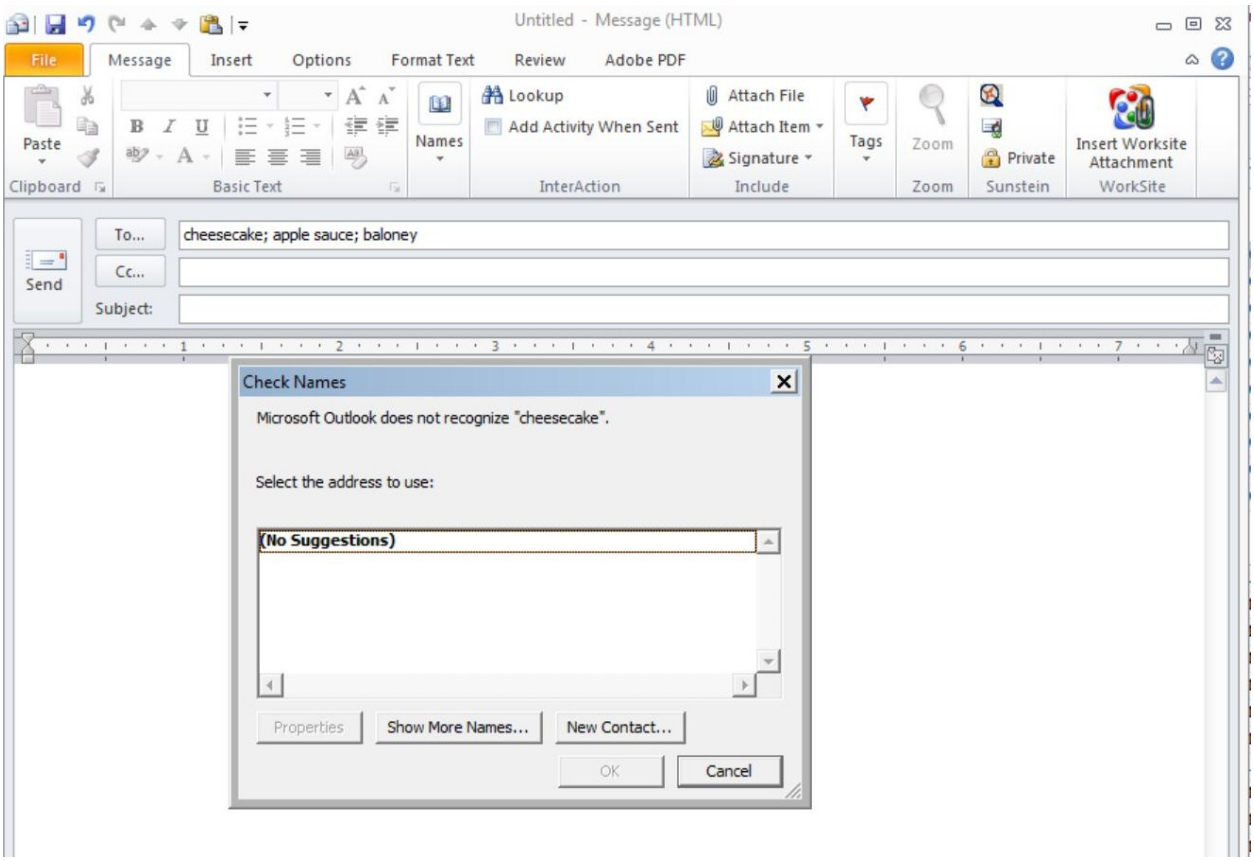
last name, and/or e-mail alias. Each display name is preferably separated by an appropriate delimiter, such as a semicolon." *Id*., Col. 17, lines 18-21. The resolving is initiated "[a]s soon as the user moves the cursor to another field on the e-mail form". *Id*., col. 17, lines 22-25. The description in Goodhand then reminds the reader that "'resolving' the names means attempting to match the display names in the address field to specific user aliases that are included in a centralized address book or directory". *Id*., col. 17, lines 25-29. ("Aliases" are e-mail addresses. *Id*., col. 16, lines 46-53.) Declaration of Dr. Levy, Exhibit 2008, paragraph 18.

The requirement that "[t]he entered display name may include all or part of the intended recipient's first name, last name, and/or e-mail alias" in the context of the described Goodhand system conveys to a person of ordinary skill in the art that the Goodhand system cannot distinguish between contact information and other text, but rather assumes that all text entered into the address field of the e-mail template is contact information. In other words, the Goodhand system subjects any and all text that is typed into the address field of the e-mail template to the same process, namely "attempting to match the display names in the address field to specific user aliases that are included in a centralized address book or directory". Declaration of Dr. Levy, Exhibit 2008, paragraphs 26-27.

Since the Goodhand system in a preferred embodiment is implemented in Microsoft Outlook (Ex. 1003, col. 15, lines 38-40), and this functionality is preserved in Outlook 2010, one can employ Outlook 2010 to demonstrate the effect of the Goodhand system. In this example, Dr. Levy enters into the address field of the e-mail template of Outlook, a shopping list thus:

cheesecake; apple sauce; baloney

In response to entry of these items, Outlook attempts to "resolve" these entries by seeking corresponding entries in the Outlook contact database. Because these textual items do not in fact appear as names of contacts in the Outlook contact database, they have not been resolved into e-mail addresses. When one graphically invokes the "send" button on the e-mail template, a window containing an error message pops up, with the heading "**Check Names**" and the message "Microsoft Outlook does not recognize 'cheesecake'./ Select the address to use: / (No suggestions)." Two graphically selectable boxes also appear in the same window: "Show more names..." and "New Contact..." Declaration of Dr. Levy, Exhibit 2008, paragraph 28. The result is reproduced below (*Id*.).



This experiment offers further confirmation that all textual entries made in the address field of the e-mail template are treated, without analysis, as contact information. "Thus, no analysis is required to "determine if 'first information' is present" in this field. By entering text into the Address field, the user has designated that text as address information, just as if the user had selected particular text in a general-purpose field of a document to designate it as address information. The user 'selects' text by choosing to enter it into the Address field rather than by entering it in any other field of the email form. All textual entries that are made in the address field of the e-mail template are treated by the system as contact information. Thus, the Goodhand system is not structured to distinguish

between contact information and other textual content. It has no need to distinguish contact information from other text, and thus fails to meet the requirement in claim 1 of 'analyzing the document to determine if the first information is contained therein'". Declaration of Dr. Levy, Exhibit 2008, paragraph 29. We show below, in section V, that, because Goodhand does not distinguish between contact information and other textual content, it cannot satisfy the claim limitation of "analyzing the document to determine if the first information is contained therein".

Moreover, because claim 1 rules out user selection of first information, Goodhand, which, depends upon user selection of contact information, fails to meet the limitations of claim 1 that rule out user selection of first information: "upon a single entry of the execute command by means of the input device:/"analyzing the document to determine if the first information is contained therein".

V. BECAUSE GOODHAND DOES NOT RENDER CLAIM 1 OBVIOUS, THE CLAIMS ARE PATENTABLE OVER GOODHAND

A. Overview of reasons why the claims are patentable over Goodhand and Padwick.

Petitioner has failed to show that any prior art alone or in combination addresses all of the limitations of any of the independent claims.

The limitation of "analyzing the document to determine if the first information is contained therein" has no counterpart in Goodhand. Specifically, the Goodhand system depends on the user to select contact information by placing it into the "To" field of an e-mail template.

In Goodhand, which discloses a module for handling e-mail messages, the user enters one or more "display names" into the dedicated address field (the section of the e-mail form that is labeled "To:") of an e-mail template. See, for example, Figs. 6a, 6b, 6c, 7a, 7b, and 7c. After the user has entered one or more names or e-mail addresses in the address field of the e-mail template, the technology of Goodhand (and the prior art) processes the entered text by attempting to match the entered names with e-mail addresses. *Id.*, col. 16, lines 43-46.

The only text considered by Goodhand in the purported "analyzing" is the text typed into the address field, i.e. text the Goodhand system already knows is contact information, and therefore it is not necessary for the Goodhand system to perform the analyzing as required by the claim, namely "analyzing … to determine if the first information is contained therein". The Goodhand system subjects any and all text that is typed into the address field of the e-mail template to the same process, namely "attempting to match the display names in the address field to specific user aliases that are included in a centralized address book or directory".

Goodhand thus lacks a computer process that distinguishes between contact information and other information in the document, and therefore lacks a computer process corresponding to "analyzing the document to determine if the first information is contained therein".

Furthermore, the claim requires that the process of analyzing is triggered "*upon* a *single* entry of the execute command by means of the input device." As discussed in section III(B) above, the explicit role of the single entry of the execute command in the processes leaves no place for user selection of text in the document. In addition to requiring an execute command, Goodhand depends on user selection of contact information by entering it into the address field of the e-mail template, and for this additional reason Goodhand fails to meet the terms of claim 1.

Moreover, the broadest reasonable claim construction cannot be inconsistent with the explicit basis for allowance of the application leading to issuance of the '853 Patent. Just before it was allowed, claim 1 was amended by adding the underlined material so that the claim read in part:

"upon a single entry of the execute command by means of the input device:

"<u>analyzing the document to determine if the first information is contained therein, and</u>

"if the first information is contained in the document, searching, using the record retrieval program, the information source for second information associated with the first information;"

In allowing the application, the Examiner characterized this surrender of subject matter in the public record of the prosecution as follows

> The closest prior art, Tso (U.S. patent 6,085,201) similarly teaches a context sensitive template engine which "generates a context-sensitive text message corresponding to an input text string". However, in Tso, the text string to be processed is determined by the current cursor position as specified by the user [see col. 4, line 31 to col. 5: line 67], whereas the present invention "does not require the user to select the text string to be processed since it functions automatically upon a single click of an input device" to determine if the first information is contained within the document.

Ex. 2005, Notice of Allowability, dated January 2, 2001.

The surrendered subject matter causes the claim to rule out user selection of contact information, whereas Goodhand requires user selection. The broadest reasonable interpretation cannot be "reasonable" if it is inconsistent with the explicit basis for allowance of the application leading to issuance of the '853 Patent.

For each of these reasons, which we discuss in further detail below, Petitioners have failed to establish that claim 1 is unpatentable for obviousness on the basis of Goodhand.

B. Because the Goodhand system depends on the user to identify contact information by placing it into the "To" field of an e-mail template, Goodhand lacks a computer process that distinguishes between contact information and other text in the document, and therefore lacks a computer process corresponding to "upon a single entry of the execute command by means of the input device:/ analyzing the document to determine if the first information is contained therein"; Petitioners consequently have failed to establish that claim 1 is unpatentable for obviousness on the basis of Goodhand.

Independent claim 1 includes the limitation of "analyzing the document to determine if the first information is contained therein". Although Petitioners argue that this limitation is found in Goodhand (Petition, pages 24-25), they fail to identify anything in Goodhand that corresponds to this limitation. We first discuss the meaning of this limitation, and then show that Goodhand, relied upon by the Petitioners in Ground 1, fails to disclose this limitation.

We have shown in section III(B) above that, the limitation in claim 1 of "analyzing the document to determine if the first information is contained therein" requires a computer process that distinguishes between "first information" in the document and other text in the document.

The Petitioners argue that the "application program" in Goodhand is the mail system, and that the "document" is an e-mail. Petition, 22. In using the technology of Goodhand, the user enters one or more names or e-mail addresses in a particular, designated section of an e-mail template, namely, in the address field. Ex. 1003, col 15, lines 54-55 ("To:" field"); col. 16, lines 7-29 (every item is created from a template); col. 16, lines 40-46 (address field); col. 17, lines 12-14 (address field of e-mail form used to create a message item). "When an e-mail user composes an e-mail message, the user identifies the recipient(s) of the message by entering one or more display names in the message's address field." Exhibit 1003, Col. 16, lines 39-42.

As discussed in section IV(A) above, after the user has entered one or more names in the address field of the e-mail template, the Goodhand system processes (as the prior art) the entered text by attempting to match the entered names with e-mail addresses: "Before the message can actually be transmitted by the e-mail system, the system must match each display name entered in the address field to the specific e-mail address (or address book entry) of a registered user." *Id.*, col. 16, lines 43-46. Goodhand explains that the "process of matching the display name(s) to an e-mail address or alias is referred to as 'resolving' the names." *Id.*, col. 16, lines 51-53. The innovation introduced by Goodhand is to resolve the names in the background: "The present invention provides a method for resolving

names in the background, which means that the user may continue to use the computer to perform other tasks while the display names are being resolved." *Id*., col. 16, lines 62-65.

In explaining how the names are "resolved," Goodhand states that "[t]he entered display name may include all or part of the intended recipient's first name, last name, and/or e-mail alias. Each display name is preferably separated by an appropriate delimiter, such as a semicolon." *Id*., Col. 17, lines 18-21. The resolving is initiated "[a]s soon as the user moves the cursor to another field on the e-mail form". *Id*., col. 17, lines 22-25. The description in Goodhand then reminds the reader that "'resolving' the names means attempting to match the display names in the address field to specific user aliases that are included in a centralized address book or directory". *Id*., col. 17, lines 25-29. ("Aliases" are e-mail addresses. *Id*., col. 16, lines 46-53.) Declaration of Dr. Levy, Exhibit 2008, paragraphs 18 and 26.

The Petitioners, relying on testimony of their expert, argue that Goodhand discloses the limitation of "analyzing the document to determine if the first information is contained therein":

> This happens in two ways. First, the system determines (as in Fig. 6a) whether there is one or more than one name in the To: line. Ex. 1002 at ¶122.

> Second, Goodhand discloses that display names (first information) are analyzed and identified, because the system later uses the display names as search terms. In order to identify the names, the system must determine that they are there. Ex. 1002 at ¶122.

Petition, 24.

As to the Petitioner's first point: "First, the system determines (as in Fig. 6a) whether there is one or more than one name in the To: line. Ex. 1002 at ¶122—such an activity fails to relate to "analyzing the document to determine if the first information is contained therein"—because in each case first information is present. Hence there is no determination *if* first information is present. Goodhand's own description (Ex. 1003, col. 19, ll. 24-31and corresponding Fig. 9) confirms that the Goodhand process starts only after the user has placed something in the To:field. ("The method 900 begins at start step 905 and proceeds to step 905 when the user moves the cursor out of the address field and to another field on the e-mail form.")

Alternatively, if Petitioners mean to argue that the Goodhand system determines whether the user has entered any name into the To: field, we have shown previously that the Goodhand system fails to examine text in a document to distinguish between contact information and other text in the document. In this context, there is simply the presumption in the Goodhand system that whatever is entered into the To: field is first information.

As to the Petitioners' second point: "Second, Goodhand discloses that display names (first information) are analyzed and identified"—such an activity also fails to relate to "analyzing the document to determine if the first information is contained therein"—since this activity takes place only after the system has been provided with first information. Hence there is no determination *if* first information is present, because the Goodhand system relies on the user to identify first information to the system by entering the first information into the To: field.

More generally, the processes of Goodhand do not match the claim limitation of "analyzing the document to determine if the first information is contained therein", because, as described in further detail below, the Goodhand system depends on entry by the user of contact information, and only contact information, into the address field of the template: "The entered display name may include all or part of the intended recipient's first name, last name, and/or e-mail alias. Each display name is preferably separated by an appropriate delimiter, such as a semicolon." Exhibit 1003, col. 17, lines 18-21.

The user interface of Goodhand is illustrated in Figs. 6 and 7. *Id*., col. 17, line 6 to col. 18, line 48. In all cases, the user first enters one or more "display names" into the address field (the section of the e-mail form that is labeled "To:"). See, for example, Figs. 6a, 6b, 6c, 7a, 7b, and 7c. The Goodhand system subjects any and all text that is typed into the address field of the e-mail template to the

same process, namely "attempting to match the display names in the address field to specific user aliases that are included in a centralized address book or directory". Declaration of Dr. Levy, Exhibit 2008, paragraphs 26-28. In other words, all textual entries that are made in the address field of the e-mail template are treated as contact information. The Goodhand system is not structured, nor does it need to be structured, to distinguish between contact information and other textual content. Declaration of Dr. Levy, Exhibit 2008, paragraph 29.

Yet, as we have shown in section III(B) above, the claim requirement of "analyzing the document to determine if the first information is contained therein" requires precisely that: examining the document to distinguish between "first information" in the document and other text in the document. Accordingly, because the Goodhand system fails to disclose distinguishing between first information and other text in the document, it fails to disclose "analyzing the document to determine if the first information is contained therein".

Moreover, as shown in detail in section III(B) above, claim 1 requires that the process of "analyzing the document to determine if the first information is contained therein" is triggered "*upon a single entry* of the execute command by means of the input device". As further explained in section III(B) , the explicit role of the single entry of the execute command in the processes leaves no place for user selection of text in the document. The structure of the claim shows that the

single entry of the execute command triggers—and is sufficient to trigger—the "analyzing of the document to determine if the first information is contained therein". Declaration of Dr. Levy, Exhibit 2008, paragraphs 24-25. The analyzing step would be meaningless if it were read to permit the user to make the selection of first information. Because Goodhand depends on user selection of contact information by entering it into the address field of the e-mail template, for this additional reason Goodhand fails to meet the terms of claim 1.

For at least these reasons, Petitioners have failed to establish that claim 1 is unpatentable for obviousness on the basis of Goodhand, and thus claim 1 and claims 2-79 dependent on claim 1 are patentable over Goodhand. Since Petitioners fail to identify Padwick as applicable to any limitation of claim 1 (see Petition, pages 14-27) and identify Padwick only as applicable to claims dependent on claim 1 (see Petition, pages 37-44), Padwick adds nothing to Goodhand in relation to claim 1. Accordingly, claims 1-79 are patentable over Goodhand in combination with Padwick.

C. Because the broadest reasonable claim construction cannot be inconsistent with the explicit basis for allowance of the application leading to issuance of the '853 Patent, claim 1 rules out user selection of contact information, whereas Goodhand requires user selection, and so Petitioner has failed to establish that Goodhand renders claim 1 unpatentable for obviousness.

The '853 Patent's prosecution history includes a surrender of subject matter that has an important bearing on the construction of claim 1. The limitation of "analyzing the document to determine if the first information is contained therein" in claim 1 of the '853 Patent was added in the course of prosecution of the '853 Patent, following a final office action dated September 18, 2000 (Ex. 2001). (The File Wrapper of the '853 Patent is reproduced in full in Exhibit 2006.) The limitation was added to distinguish over Tso, United States patent 6,085,201 (Ex. 2003). Claim 8, which was the predecessor to issued claim 1, had been rejected on the basis Tso, in the September 28, 2000 final office action. Exhibit 2001, pages 2-6. Tso discloses a template engine that analyzes text in an incoming e-mail message and then generates a context-sensitive text message based on the incoming text. See Ex. 2003, Tso, Abstract and col. 2, lines 59-67. However, the system of Tso requires the user to select the text that is to be analyzed: "When a user wishes to compose a new e-mail message or generate a reply to a received e-mail message, the user selects a text string to be processed, for example, by clicking-on it." *Id*., col. 4, lines 32-35.

In an interview with the examiner, this very point was discussed, that in Tso it is necessary for the user to select the text to be analyzed. See Exhibit 2002, Interview Summary for October 17, 2000 relating to application for the '853 Patent: "Applicant's representative discussed the differences between the Tso and Borovoy references and the present invention. For instance, it was pointed out that in the Tso reference, the user must select the text string to be processed, whereas in the present invention, the user does not have to select the text string to be analyzed. Applicant's representative may submit an After-Final Amendment that amends the independent claim to include this difference."

Pursuant to that understanding, by an amendment received by the Patent and Trademark Office on December 18, 2000, Ex. 2004, the claim was amended by adding the underlined material so that the claim read in part:

"upon a single entry of the execute command by means of the input device:

"analyzing the document to determine if the first information is contained therein, and

"if the first information is contained in the document, searching, using the record retrieval program, the information source for second information associated with the first information;"

The amendment added that "upon a single entry of the execute command by means of the input device:" a requirement that there must occur the process of

"analyzing the document to determine if the first information is contained therein". Furthermore, now that the claim limitation required "analyzing" to determine if the first information is present in the document, the amendment additionally added the condition "if the first information is contained in the document" ahead of the requirement of "searching, using the record retrieval program, the information source for second information associated with the first information".

The amendment referenced the interview with the Examiner. "During the discussion, it was noted that columns 4-5 of Tso teach a user selecting a text string to be processed by clicking on the text string using various selection means. In this respect, the present invention does not require the user to select a text string to be processed since it functions automatically upon a single click of an input device, such as a button, menu item, etc." Ex. 2004, pages 2-3. The Notice of Allowability similarly addresses this distinction:

> The closest prior art, Tso (U.S. patent 6,085,201) similarly teaches a context sensitive template engine which "generates a context-sensitive text message corresponding to an input text string". However, in Tso, the text string to be processed is determined by the current cursor position as specified by the user [see col. 4, line 31 to col. 5: line 67], whereas the present invention "does not require the user to select the text string to be processed since it functions automatically upon a single click of an input device" to determine if the first information is contained within the document.

Ex. 2005, Notice of Allowability, dated January 2, 2001.

The public record of the USPTO therefore shows that the limitations of "upon a single entry of the execute command by means of the input device:/ analyzing the document to determine if the first information is contained therein" in the claim rule out user selection of the first information.

Adversely to arguments made at the time by Arendi, a similar construction was applied in the case of *Arendi U.S.A., Inc. v. Microsoft Corporation*, CA No. 02-343-T, District of Rhode Island, September 27, 2004, (Exhibit 2007), a proceeding in which the '853 Patent was asserted at trial against Microsoft. The Court held[2] that "'upon a single entry of the execute command' means that:

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[2] In this litigation, the court determined that there was a blanket disavowal of user text selection. Patent Owner's predecessor in interest argued that the claim did not rule out all user selection before or after the execute command, but rather only user text selection that substitutes for analysis upon entry of the execute command. In an appeal to the Federal Circuit from the Rhode Island district court decision, the brief argued that "The Court's Construction of the Phrase 'Upon a Single Entry of the Execute Command' as Precluding 'Any Need for the User to Select Any Text' Is Legally Erroneous" Appellant's brief, April 25, 2005, p. 16 and following. While arguing that the disavowal should not be interpreted to rule

"a. analysis of the document to determine if it contains first information and searching sources external to the document for second information associated with the first information must occur upon or after entry of the execute command, and

"b. the analysis and search take place without any need for the user to, first, select any text in the document by accenting it , highlighting it, or otherwise selecting it.

"Text selection by the user was clearly disavowed by Arendi during prosecution of the patent as demonstrated by the following: [citing, among other things, the documents and events summarized above]." Order re Claim Construction, Exhibit 2007, pages 2-3. The decision in this case was affirmed by the Federal Circuit Court of Appeals. *Arendi U.S.A., Inc. v. Microsoft Corp.*, 168 Fed.Appx. 939 (Fed. Cir. 2005).

A patent is a fully integrated written instrument and the claims must be read in view of the specification of which they are a part. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc). A court should also consult the

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out all forms of user selection of text, Patent Owner did then, and continues to, assert that the disavowal encompasses user text selection that substitutes for the analysis to be performed by the computer upon entry of the execute command.

patent's prosecution history, which, like the specification, provides evidence of how the PTO and the inventor understood the claimed invention. *Id.* at 1317. In reviewing those sources, if the specification or prosecution history defines a claim term, then that definition shall apply even if it differs from the term's ordinary meaning. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366-67 (Fed. Cir. 2002). Moreover, if a patentee makes a clear and unambiguous disavowal of claim scope during prosecution, that disclaimer informs the claim construction analysis by "narrow[ing] the ordinary meaning of the claim congruent with the scope of the surrender." *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003).

In its Institution Decision of August 20, 2014, page 14, the Board took the position that, under the broadest reasonable interpretation standard, it was entitled to ignore the Patent Owner's disavowal of subject matter in the prosecution history of the '853 Patent as well as the judicial interpretation of claim 1, in which recognition of the disavowal formed a part of the claim construction: "Patent Owner does not persuade us that the broadest reasonable interpretation of the claim limitation 'analyzing the document to determine if the first information is contained therein' requires identification of the first information without recourse to user selection of the text to be analyzed. The plain meaning of the claim

language conveys nothing about whether a user may or must select text to be subject to the analyzing process."

The Institution Decision is incorrect, because the broadest reasonable interpretation must be consistent with the procedural history of the application. A construction cannot be "reasonable" if it is inconsistent with the explicit basis for allowance of the application leading to issuance of the '853 Patent.

It is respectfully submitted that the Board's position—that the broadest reasonable interpretation standard entitles it to ignore a clear surrender of subject matter made in prosecution of a patent that is being subjected to Inter Partes Review—makes no sense. Such a position guarantees that every patent prosecuted with such a surrender of subject matter will be subject to institution of the inter partes review proceeding, since the surrender will not be considered by the Board. In such an instance, the Board ignores an agreed meaning given to the claim, of the now issued patent, by both the examiner and the patentee, and, in the present case, by the Article III courts as well.

Ignoring a surrender of subject matter made in prosecution of a patent is similar in effect to ignoring a claim limitation. Indeed, surrendered subject matter does constitute a claim limitation. It manifestly affects the manner in which the claim is treated in prosecution of the patent and it affects the manner in which the claim is interpreted in a judicial proceeding. *Cf. In re Wilson*, 424 F.2d 1382, 1385

(CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art").

The Federal Circuit has recognized that it is proper to consider prosecution history in determining the meaning of a claim that is being evaluated in a contested proceeding in the Patent and Trademark Office. In *Tempo Lighting, Inc. v. Tivoli, LLC*, 742 F.3d 973 (Fed. Cir. 2014), a case reviewing a determination made in an *inter partes reexamination*, the Federal Circuit ruled that the PTAB correctly rejected the broad dictionary-based claim construction in favor of the correct claim construction based on a meaning supplied by the patent applicant during prosecution of the original patent application. On appeal from the PTAB, the Federal Circuit stated, "In claim construction, this court gives primacy to the language of the claims, followed by the specification. Additionally, the prosecution history, while not literally within the patent document, serves as intrinsic evidence for purposes of claim construction. This remains true in construing patent claims before the PTO. *See In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997)." *Tempo Lighting*, 742 F.3d at 977. While the PTO might not always be bound by a prosecution history disclaimer, when, as in this case, the examiner recommended amending to distinguish over user selection and the patent applicant complied with the PTO request with its approval, the PTO must construe the claim consistently with its previous actions. *Tempo Lighting*, 742 F.3d at 978

("However, in this instance, the PTO itself requested Tivoli rewrite the "non-photoluminescent" limitation in positive terms. Tivoli complied…")

In *Kyocera Corp. v. SoftView LLC*, IPR2013-00004 and IPR2013-00257, Final Written Decision, Paper 53, 8-9 (March 27, 2014), the Board considered the prosecution history of a related patent, in which the patent owner provided an explanation of an added claim limitation in the remarks section of a response, and interpreted the claim accordingly. In *Intellectual Ventures Mgt., LLC v. Xilinx, Inc.*, IPR2012-00019, Final Decision, Paper 33, 14-15 (February 10, 2014), the Board considered the prosecution history, but concluded that statement relied on by the patent owner failed to provide either an explicit definition or a clear disclaimer of a broader definition, and furthermore "does not represent a limit on the claims or a disavowal of claim scope".

The present case represents a marked contrast to *Intellectual Ventures Mgt , LLC v. Xilinx, Inc.*, since the present case involves a clear disavowal of claim scope supported by reliance upon the PTO's amendment request and acceptance, and recognized by the courts.

It is sufficient for the Board in the present case to determine that, under the broadest reasonable interpretation standard, it is appropriate to consider the prosecution history where there is a clear disavowal that formed the basis in the administrative record of prosecution for allowance of the patent application and

issuance of the patent. For this additional reason, claims 1-79 are patentable over Goodhand alone and in combination with Padwick.

D. Because Inter Partes Review is an adjudicatory process applied to an issued patent, the standard for claim interpretation should be the judicial standard under *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005).

Even if the Board, contrary to the approach in *Tempo Lighting*, *Kyocera Corp*., and *Intellectual Ventures Mgt.*, believes that the broadest reasonable interpretation standard entitles the Board to ignore a clear disavowal of claim scope on the record, then, nevertheless, independent grounds, discussed in this section, require the Board to apply the standard of *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), and to interpret the claims in a manner consistent with judicial precedent for an issued patent.

Above we have addressed the issues in this review under an assumption that the Board will follow 37 C.F.R. §42.100(b) by construing the claims with the broadest reasonable construction in light of the specification. However, claim construction is a matter of substantive patent law. The USPTO is not empowered to alter the law applicable to the interpretation of patents in adjudicatory proceedings. The proper meaning of a patent claim is determinable according to

the standard set forth in *Phillips v AWH Corp.*, 415 F.3d 1303, 1312-19 (Fed. Cir. 2005) (en banc).

"The PTO lacks substantive rulemaking authority." *Koninklijke Philips Electronics N.V. v. Cardiac Science Operating Co.*, 590 F.3d 1326, 1336 (Fed. Cir. 2010) ("We remind … the Board that they must follow judicial precedent instead of 37 C.F.R. §41.200(b)"which reads "A claim shall be given its broadest reasonable construction in light of the specification of the application or patent in which it appears"). The provisions of 35 U.S.C. §2(b)(2) set out the PTO's power to "establish regulations, not inconsistent with law, which… shall govern the conduct of proceedings in the Office." "This is 'the broadest of the Office's rulemaking powers'…To comply with section 2(b)(2)(A), a Patent Office rule must be 'procedural' –i.e., it must "govern the conduct of proceedings in the Office.'" *Cooper Technologies Co. v. Dudas*, 536 F.3d 1330, 1335 (Fed. Cir. 2008).

Accordingly, 35 U.S.C. §316(a) does not add a power to regulate substantive patent law. The USPTO relies on 35 U.S.C. §316 for granting the USPTO the authority to promulgate substantive rules. 77 F.R. 48680, 48688, August 14, 2012. 35 U.S.C. §316(a)(4) grants the PTO the authority to prescribe regulations "establishing and governing inter partes review under this chapter and the relationship of such review to other proceedings. However, 35 U.S.C. §316 is

silent as to any grant of any authority to allow the USPTO to prescribe substantive rules. Moreover, 35 U.S.C. §316 does not expand the scope of rulemaking authority provided by 35 U.S.C. §2(b)(2), either expressly or implicitly. A reading of §2(b)(2) together with §316 makes clear that 35 U.S.C. §316 sets out only the PTO's power to establish regulations, not inconsistent with law, to govern only the procedural conduct of proceedings in the Office. In addition, the USPTO relies on 35 U.S.C. §318 for granting the USPTO the authority to promulgate substantive rules by arguing that the broadest reasonable standard is appropriate for determining patentability of proposed amendments to claims. 77 F.R. 48680, 48688, August 14, 2012. Even if the USPTO's argument were to be accepted, however, it would apply only to a substitute claim proposing an amendment, as opposed to evaluation of patent claims in the issued patent.

Nevertheless, the Office enacted 37 C.F.R. §42.100(b), which governs the substance of the patent right adjudicated in an inter partes review. The scope of a patent claim defines the property right to be evaluated in view of the prior art. Regardless of any particular procedural conduct, this rule affects all substantive outcomes of inter partes reviews. If Congress intended to give the PTO rulemaking authority over substantive law, it would have amended the laws accordingly. It has not done so. As for the PTO, by creating rules and practices that effectively preclude claim amendments and establishing a claim construction

standard that finds its justification in the availability of claim amendments, the PTO arbitrarily and capriciously exceeds its authority and denies patent owners substantive patent rights.

An inter partes review is an adjudicatory proceeding conducted before the Patent Trial and Appeal Board. Indeed, this is a trial. The inter partes review trial should ascertain the proper meaning of claims. A reissue or reexamination, on the other hand, is an examination conducted by a patent examiner in the USPTO. In a PTO examination, claims are not construed, they are examined, giving them a broadest reasonable interpretation so that greater precision can be encouraged through amendments to the claims.

> The protocol of giving claims their broadest reasonable interpretation …. This protocol is solely an examination expedient, not a rule of claim construction. Its purpose is to facilitate exploring the metes and bounds to which the applicant may be entitled, and thus to aid in sharpening and clarifying the claims during the application stage, when claims are readily changed. See *In re Buszard*, 504 F.3d 1364, 1366 (Fed. Cir. 2007); *In re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999). As explained in the Manual of Patent Examining Procedure (MPEP) at §2111, entitled "Claim Interpretation; Broadest Reasonable Interpretation," "Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified." This practice may also be

> useful in reissue examination. See *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983).

In re Skvorecz, 580 F.3d 1262, 1267-8 (Fed. Cir. 2009). The Federal Circuit in *In re Yamamoto*, 740 F.2d 1569 (Fed. Cir. 1984) extended application of the broadest reasonable interpretation to ex parte reexaminations. The court emphasized the ability to amend in reissue applications and ex parte reexaminations.

> The same policies warranting the PTO's approach to claim interpretation when an original application is involved have been held applicable to reissue proceedings because the reissue provision, 35 U.S.C. §251, permits amendment of the claims to avoid prior art. *In re Reuter*, 651 F.2d 751, 756, 210 USPQ 249, 253-54 (CCPA 1981).

In re Yamamoto, 740 F. 2d at 1572.

As emphasized in *In re American Academy of Science Tech Center,* 367 F.3d 1359, 1364 (Fed. Cir. 2004), *ex parte* reexaminations seek to produce patents with allowable precisely stated claims:

> Giving claims their broadest reasonable construction "serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified." *In re Yamamoto,* 740 F.2d at 1571; *accord In re Hyatt,* 211 F.3d 1367, 1372 (Fed. Cir. 2000); *In re Zletz,* 893 F.2d 319, 322 (Fed. Cir. 1989) ("An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can

uncertainties of claim scope be removed, as much as possible, during the administrative process.").

The question whether an examination expedient like "broadest reasonable interpretation" can be applied to claim construction in the new AIA inter partes review trials, therefore, comes down to whether the trial is more like an examination procedure that permits amendments to make claims more precise before an examiner or is it a trial that adjudicates issues of validity with estoppel effect without affording a comparable ability to amend the claims. Original prosecution, reissue and reexamination freely allow patent applicant or patent owner to amend claims and add new claims that are supported by the specification. The patent applicant or owner is also able to speak with the examiner and work through acceptable claim language in all these proceedings except inter partes reexamination.

The rules for inter partes review eliminate the freedom to amend claims. In an effort to be sure these trials can be completed within twelve months of institution, strict barriers to amending claims have been implemented. 37 C.F.R. §42.107 states that the patent owner's preliminary response "shall not include any amendment." 37 C.F.R. §42.121 states that "A patent owner may file one motion to amend a patent, but only after conferring with the Board. …any additional motion to amend may not be filed without Board authorization." Even if a motion

is allowed to be filed, the demonstration required is onerous. Within the confines of a 15 page motion, patent owner must include a listing of the amended or substitute claims, a showing of support for the claims in the original disclosure of the patent for each claim, a showing overcoming the burden to demonstrate patentability of the claims over not only the references asserted in the inter partes review but over the prior art in general, and a discussion of the level of ordinary skill in the art and of what was known about features relied upon to show patentability. To Patent Owner's knowledge, this burden has been satisfied only one time in the history of inter partes review and that was for an unopposed motion to amend. *Int'l Flavors & Fragrances, Inc. v. U.S.A.*, IPR2013-00124 (Paper 12).

The purpose of inter partes reviews to eliminate invalid claims in a cost efficient manner, with a strictly limited opportunity to amend a claims, puts this procedure in a category quite separate from reissues or reexaminations, which allow patent owners to seek more precise claims before an examiner. The AIA legislation sets inter partes reviews apart from examination procedures by giving them immediate legal impact in court. Indeed, even court decisions may lack the immediacy imposed by a PTAB final decision. Estoppel from a PTAB decision is effective immediately against an unsuccessful petitioner upon issuance of the final written decision. 35 U.S.C. §315(e)(2).

Given that, for most practical purposes, claim amendments are not possible in inter partes reviews and that given the legal effect in court of inter partes reviews, proper claim construction demands abiding by the principles set forth in the *Phillips* case. All of the intrinsic evidence must be considered. Thus, as interpreted by the examiner who conducted the original prosecution, analyzing the document is accomplished without user selection. The task of distinguishing first information from other text in the document is determined by a computer process, not by a user action which negates the need for such analysis.

As we have discussed above in detail in section V(C), the prosecution history of the '853 Patent requires interpreting the limitations, in claim 1, "upon a single entry of the execute command by means of the input device:/ analyzing the document to determine if the first information is contained therein" to rule out prior user selection of the text to be analyzed as a condition of "analyzing the document to determine if the first information is contained therein." Similarly, we have shown in section V(C) that the Order re Claim Construction in *Arendi U.S.A., Inc. v. Microsoft Corporation*, CA No. 02-343-T, District of Rhode Island, September 27, 2004, (Exhibit 2007), affirmed by the Federal Circuit, reached the same conclusion. In this proceeding, the '853 Patent was asserted against Microsoft. Considering the prosecution history and applying *Phillips* construction

principles, the Court held that "'upon a single entry of the execute command' means that:

> "a. analysis of the document to determine if it contains first information and searching sources external to the document for second information associated with the first information must occur upon or after entry of the execute command, and
>
> "b. the analysis and search take place without any need for the user to, first, select any text in the document by accenting it, highlighting it, or otherwise selecting it."

In accordance with Goodhand, the user determines what constitutes first information by entering it into the "To" field of the email. Whatever the user enters is treated as first information and no analysis is performed. Padwick fails to satisfy this deficiency of Goodhand. Thus, when construed in accordance with the principles of *Phillips* fully taking the prosecution history into account, Goodhand and Padwick fail to make the claimed invention obvious. In particular, neither of these references discloses or suggests a computer process for analyzing the document to determine if first information is present. They instead rely upon user determination and selection of the first information.

VI. CONCLUSION

For the foregoing reasons, Petitioners have failed to establish by a preponderance of the evidence, with respect to U.S. Patent No. 6,323,853 (the "'853 Patent"), that any of claims 1-79 are unpatentable under 35 U.S.C. §103(a) over Goodhand taken alone or in combination with Padwick.

.

Date: November 3, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

It is certified that on November 3, 2014, copies of the Patent Owner Arendi S.A. R.L.'s have been served on Petitioner as provided in 37 C.F.R. § 42.6(e) via electronic mail transmission addressed to the persons at the following addresses:

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Exhibit 6F

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

Google Inc.

Petitioner,

v.

Arendi S.A.R.L.

Patent Owner

_____

Case No. IPR2014-00450

Patent No. 7,921,356

_____

PATENT OWNER ARENDI S.A.R.L.'S PRELIMINARY RESPONSE UNDER 35 U.S.C. § 313 and 37 C.F.R. § 42.107

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I. INTRODUCTION

Patent Owner Arendi S.A.R.L. ("Arendi" or "Patent Owner") respectfully requests that the Board decline to initiate *inter partes* review of claims 1-20 of U.S. Patent No. 7,921,356 (the "'356 Patent") because Petitioner Google Inc. ("Petitioner") has failed to show that it has a reasonable likelihood of prevailing with respect to any of the challenged claims. 35 U.S.C. § 314.

Petitioner has submitted proposed grounds for challenge based on obviousness. However, for each proposed ground, at least one claim element is missing from the relied-upon combination of references. Thus, Petitioner has failed to meet its initial burden to show that each element was known in the prior art.

II. OVERVIEW OF THE '356 PATENT

The '356 Patent is directed, among other things, to computer-implemented processes for automating a user's interaction between a document editing program, such as a word processing application or spreadsheet application, on the one hand, and an information management program, such as contact management application having a database, on the other hand.

The invention as claimed provides a significant simplification of prior art methods. In the prior art, a user who has entered first information (e.g., a person's name) in a document must leave the document editing program (e.g., a word

processor) and open and search using an information management program (e.g., a contact management program) when the user wishes to locate second information related to the first information from the information management program. The user of such prior art systems must search for the first information (e.g., a name) and the second information (e.g., an address) using the information management program and then return to the document editing program and manually enter the second information into the document. This process requires a plurality of actions by the user in order to obtain information related to the information typed within the document. Thus, according to embodiments of the present invention, "the process of creating and updating records in an address database is significantly simplified, since this may now be performed directly from the word processor." Ex. 1001, col. 9, lines 61-63.

In the '356 Patent, Figs. 1 and 2 are flow charts showing for these interactions a number of scenarios, which are described from col. 4, line 24 to col. 5, line 58. Further details of the interactions are provided in discussion thereafter of the other figures of the '356 Patent, and the discussion includes references back to relevant portions of the flow charts in Figs. 1 and 2. Fig. 1 is reproduced below.

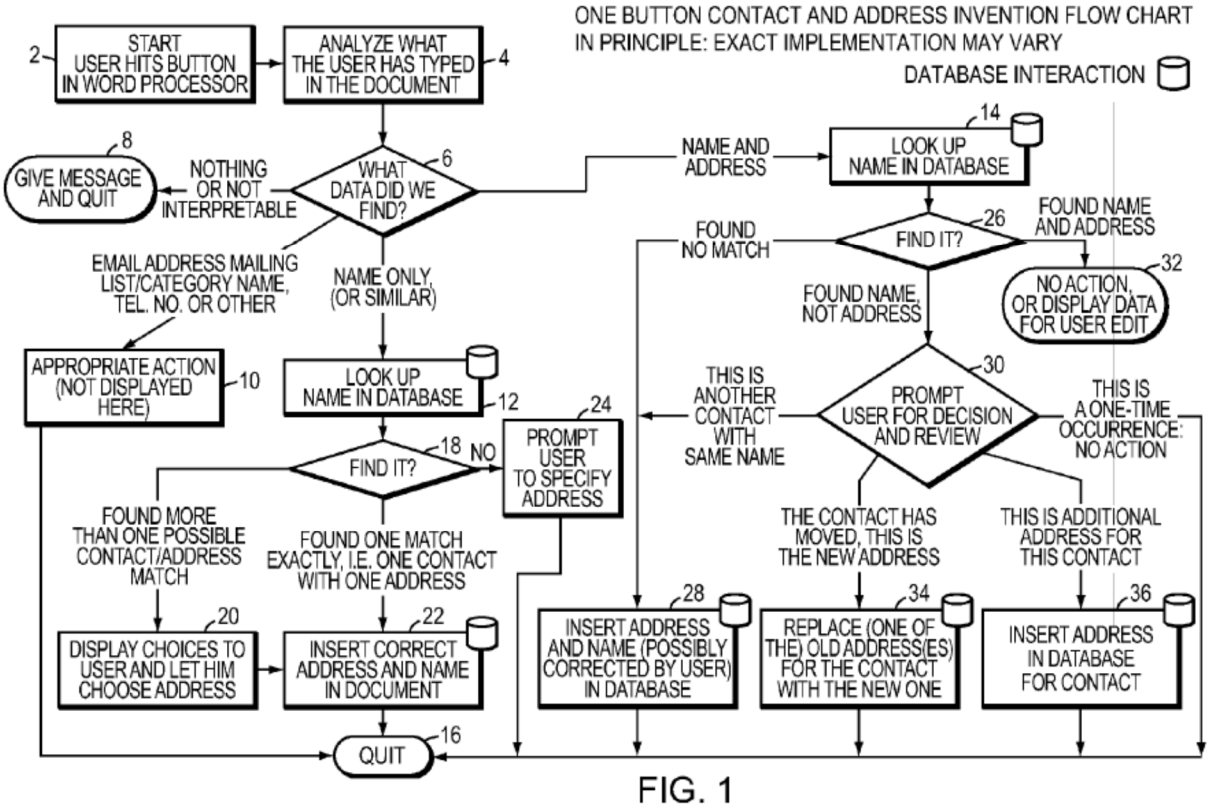

FIG. 1

In various scenarios, text in a document in the document editing program is analyzed (in step 2 of Fig. 1) to identify first information. See Ex. 1001, col. 4, line 28-52.

Once first information has been identified, a number of different scenarios can follow, depending on the circumstances. In one scenario, if the first information includes a name, a search is initiated in the database associated with the information management program for the name. *Id*. at Fig. 1, steps 6, 12, and 14. If the contact information identified in the document included only a name, the course taken depends on whether the second information, in particular, an address is found in the database. If an address cannot be found, the action taken will be to

"Prompt User to Specify Address." Fig. 1 steps 12, 18, 24. If on the other hand, a single entry is found in the database for the name and the entry includes a single address, then the action taken will be to insert the address into the document. *Id.*: at Fig. 1, steps 6, 12, 18, and 22; Fig. 4; col. 5, line 64 to col. 6, line 4. Fig. 4, which is reproduced below, shows the document displayed in Microsoft Word after the address has been inserted.

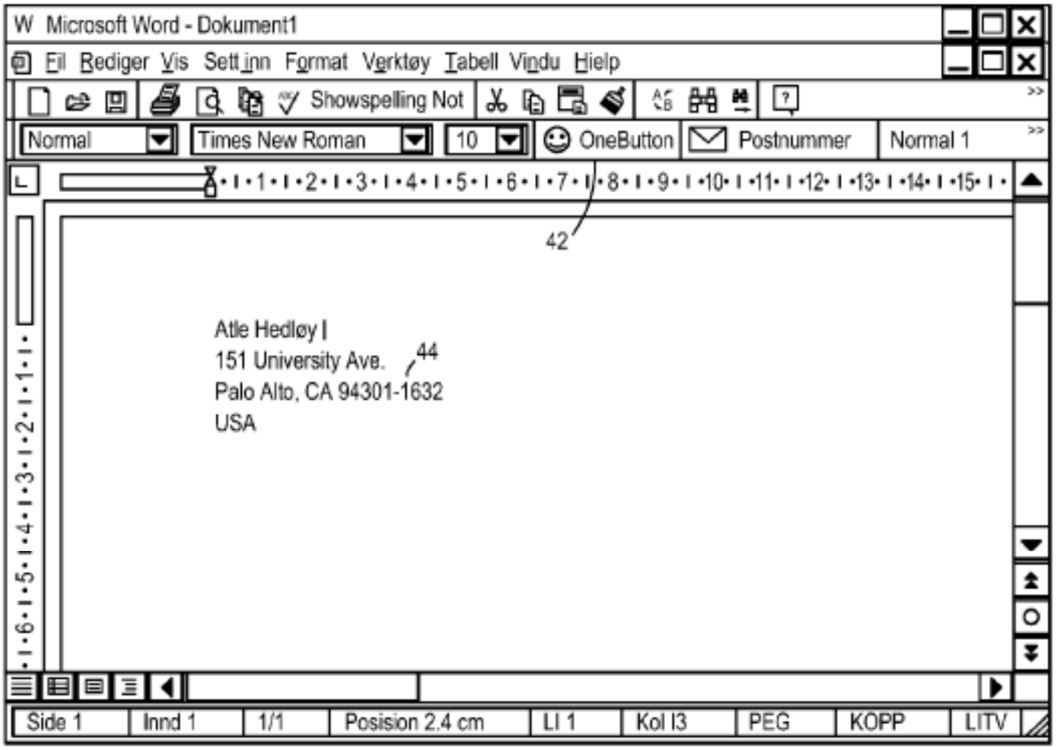

FIG. 4

Also shown in Fig. 4 is the One Button 42, which, when pressed, launches the processes just recited, including analyzing the document to identify first information, the searching in the database, and inserting of the address. *Id.* at Fig. 2, steps 2, 4; col. 4, lines 28-31; col. 5, line 62-col. 6, line 6.

On the other hand, if multiple addresses are found in searching the database for the identified name, these found addresses are displayed, and the user is presented with a choice of which of the addresses to insert. *Id*. at Fig. 1, steps 18, 20, and 22; Fig. 10; col. 7, line 25-col. 8, line 5.

In another scenario, when the user clicks on the "OneButton" in a document containing a name and an address, the document is analyzed as before (per Fig. 1, step 4) to identify the name and the address. Next, the database is searched for the identified name (per Fig. 1, step 14). If the name happens to be in the contact database but the address in the contact database for that name differs from the address typed by the user into the document (per Fig. 1, step 26), then the user is prompted to make a choice (per Fig. 1, step 30). The user is presented with a screen shown in Fig. 9, which is reproduced below.

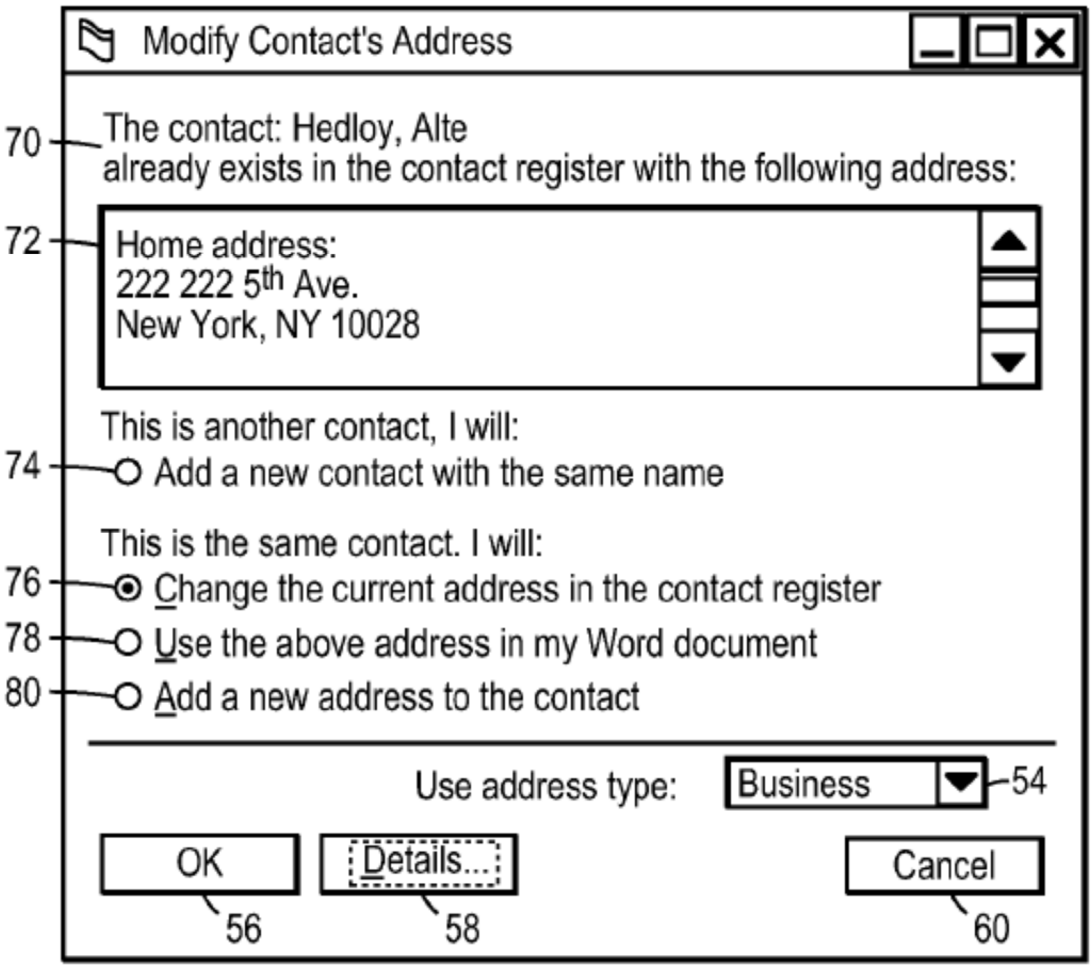

FIG. 9

Fig. 9 represents a screen presented to the user in which the user is given a series of choices that can be made in this specific context. *Id*. at col. 6, line 66-col. 7, line 23. The screen reproduces the name that is both in the document and in the contact database, and it also displays the address that is in the contact database for that name. Below this information, the screen offers four choices in two categories. As shown in Fig. 9 and explained in the '356 Patent, the user is enabled to select one of the four choices. *Id*. The first category is that "This is another contact" and

the choice under this category is to "Add a new contact with the same name". The second category is that "This is the same contact", and the user is given three other choices for the contact: (1) "Change the current address in the contact register"; (2) "Use the above address [reproduced from the contact database] in my Word document"; and (3) "Add a new address to the contact".

These same four choices are also illustrated in connection with item 30 of Fig. 1 of the '356 Patent, which shows logical flow followed in described embodiments of the invention. Item 30 is labeled "PROMPT USER FOR DECISION AND REVIEW", and there are four outcomes shown from this item: (1) "THIS ANOTHER CONTACT WITH THE SAME NAME"; (2) "THE CONTACT HAS MOVED, THIS IS THE NEW ADDRESS"; (3) "THIS IS A ONE-TIME OCCURRENCE: NO ACTION"; and (4) "THIS IS ADDITIONAL ADDRESS FOR THIS CONTACT". These choices are described in the '356 Patent. See Ex. 1001, col. 4, line 65-col. 6, line 6.

It can be seen that the first of the four choices is to add a new contact, and two of the remaining choices are specific ways of updating an existing contact. (Another choice offered is to do neither of these and simply use the address in the Word document as typed.) Consequently, the screen of Fig. 9 presents to the user a choice, among other things, between competing alternatives of storing a new contact or updating an existing contact.

III. OVERVIEW OF THE PRIOR ART

A. Overview of Pandit

Pandit describes a program that enables users to identify text of interest and select an operation applicable to the text. Pandit identifies classes of text in a document and enables a user to select programs, based on the identified classes, applicable to the text. When a document is open in the program, the program provides a menu bar 13 that displays classes of text, such as "Date," "EMail," and "Phone #." See Ex. 1004, Figs. 1a-1f. The user selects text in the document by shading, underlining, or pointing and clicking on the text. See Ex. 1004, col. 2, lines 4-8. The program identifies the class of the selected text and highlights that class in the menu bar 13 using boldface type. See Ex. 1004, col. 2, lines 8-16, 51-53, 64-66, and Figs. 1a, 1c, and 1e. The boldface type indicates that the programs for that class of text have been enabled. See Ex. 1004, col. 2, lines 11-12.

When the user selects the bolded class, the program displays the programs for the class. See Ex. 1004, col. 2, lines 15-18, 20-21, 33-35. For example, if a user selects the highlighted option "Date" from the menu bar 13, the program displays potential programs that display a calendar or create an appointment based on the selected date in the document. See Ex. 1004, Fig. 1b. If a user selects the highlighted option "Email" from the menu bar 13, the program displays potential

programs that create an email message addressed to the selected email address or add the address to an address book. See Ex. 1004, Fig. 1d. If a user selects the highlighted option "Phone #" from the menu bar 13, the program displays potential programs of dialing the selected phone number, adding the phone number to an address book, or preparing a fax to be sent to the phone number. See Ex. 1004, Fig. 1f. The user selects a program to be performed by clicking on the operation or executing one or more keyboard strokes. See Ex. 1004, col. 2, lines 41-46.

B. Overview of Luciw

Luciw describes logical processes, usable by a pen-based computer system that functions as a personal organizer, to provide "implicit or explicit assistance" for "user supportive information functions". See Ex. 1005, col. 4, lines 14-18 (pen-based computer system); col. 2, lines 16-19 (implicit or explicit assistance).

The pen-based computer system has a database that can be queried. *Id.* at col. 8, lines 31-34. Luciw describes "implicit" assistance, wherein a user has used a smart field to enter a word used for look up in the database or has otherwise similarly triggered a database lookup, and "explicit" assistance, wherein the user explicitly invokes assistance from the device as by using pen 38 of Fig. 2. *Id.* at col. 8, lines 11-62.

The logical processes used by the Luciw device for providing implicit and explicit assistance are shown in Fig. 3 of Luciw. *Id.* at col. 8, lines 2-6. A review of Fig. 3 shows that the database is queried in step 106 if it is determined in step 104 that there is an implicit assist. On the other hand, if in step 104 it is determined that there is not an implicit assist, and if it is further determined that there is an explicit assist, then there is no database query because the only database query indicated is in step 106, *i.e.*, exclusively where there is an implicit assist.

As an example of an implicit assist, Luciw provides Figs. 4b, 4c, 5, 6a and 6b, which describe use of a "smart field". *Id.* at col. 10, line 23 *et seq.* (beginning discussion of smart fields in connection with Fig. 4b). According to Luciw, "[a] smart field is considered to be a predefined region on screen 52 of computer system 10 shown in FIG. 2, or a predefined region within a window which appears on screen 52". *Id*. at col. 8, lines 16-19. Fig. 4b is reproduced below.

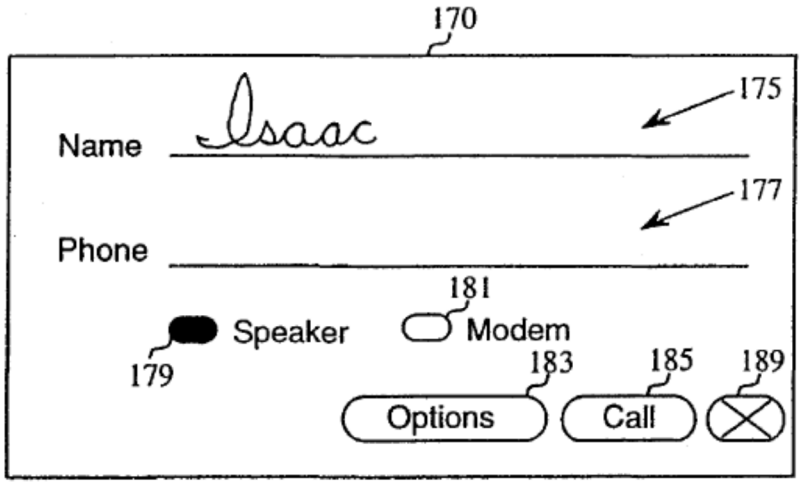

Figure 4b

According to Luciw, Fig. 4b "shows a phone slip window 170 with a smart name field 175 which has for example been evoked by either highlighting the verb 'call' or by simply writing the word on the display surface either before or after establishment of window 170." *Id.* at col. 10, lines 24-28. Operation of the phone slip window is explained in the lines thereafter in Luciw:

> Once the particular window 170 is presented to the user, the name ISAAC can be handwritten into the particular smart field 175. The assistance process recognizes the handwritten name "Isaac," and either continues operation as suggested at step 106 in FIG. 3 directly, or concurrently displays the recognized name in formal font form, as suggested in FIG. 4c, in the same position of the smart field, where formerly the handwritten name "Isaac" had been established. As will readily be recognized, window 170 in FIG. 4b may contain several smart fields, in this case for example definable for either the "name" field 175 or a "phone" field shown at step 177.
>
> *Id.* at col. 10, lines 27-39.

Because the user of the Luciw device uses the smart field to specify the field for which a database search is desired—a name in the name field 175 or a phone number in the phone field 177—the Luciw device can then use the entered item to search in the database for a record (termed a "frame") that has the same value as the entered item for a corresponding attribute. *Id.* at col. 10, line 51-col. 12, line 11. The database may return multiple entries (each corresponding to a different frame), each of which has a field that matches the user inputted value for the

particular attribute. *Id.* at col. 11, line 60-col. 12, line 6. After the user selects an entry, Luciw determines if the entry includes a smart field that is linked to the smart field of the user inputted value. *Id.* at col. 12, lines 47-52. If so, Luciw obtains the information from the linked smart field and displays it in the window 170. *Id.* at col. 12, lines 52-54.

C. Overview of Tso

Tso describes a system for the selection of a template for responding to an e-mail communication based upon a received e-mail. See Ex. 1009, Abstract. Fig. 2 of Tso presented below shows the basic elements of the system.

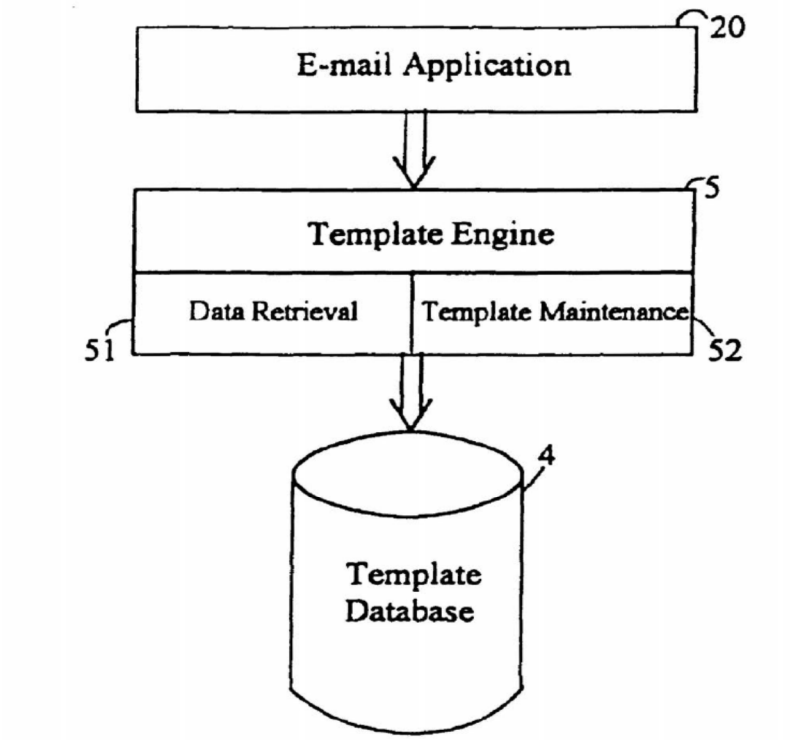

Figure 2

Tso parses an input text string from an e-mail within an e-mail application and identifies a plurality of words within the text string by parsing the text string in accordance with standard string processing techniques. *Id.* at col. 4, lines 48-67. The template engine "uses the extracted words to search the set of predefined templates stored in the template database." *Id.* at col. 5, lines 7-9. Tso compares the identified words to keywords in the template database. The template database includes a plurality of response templates wherein each template is associated with

a plurality of keywords. A template itself is a text string that includes one or more phrases that may include one or more choices. *Id.* at col. 3, lines 6-8. In the comparison of the identified words from the input text string to the keywords, the system of Tso calculates a score that determines a degree of match between the input text string and the keywords. *Id.* at col. 5, lines 11-17. Thus, a score for each template is calculated based upon the degree of match wherein keywords are assigned a weighted value. Tso selects the template that has the associated highest score and presents this template to the user of the system as the input for a response e-mail. The user of the Tso system can then accept the template for use or reject the template. If the template is accepted the user can then select between choices within the template to minimize the amount of typing that is required to generate a reply. *Id.* at col. 5, lines 60-65.

IV. SINCE THE PRIOR ART DOES NOT PRESENT A *PRIMA FACIE* CASE AS TO ANY CLAIM, NO *INTER PARTES* REVIEW SHOULD BE INITIATED

A. Overview of Reasons for Denying Inter Partes Review

For each ground asserted in the present Petition [IPR2014-00450] the reference or references relied upon fail to teach at least one element of the claims to which those references are applied. Consequently, the grounds asserted fail to even present *a prima facie* case of obviousness under 35 U.S.C. §103(a).

Because Ground 1of the Petition fails to identify in Luciw the limitation "causing insertion of at least part of the second information into the document", Ground 1 fails to establish a *prima facie* case of obviousness. On the one hand, the Petition argues that the "document editing program" and the "document" required by these claims correspond respectively to the "notepad" and the entries one can make in the note area using the notepad. Petition, page 20, sections [1a] ("notepad") and 1[b] (entries in "note area"). On the other hand, for the limitation "causing insertion of at least part of the second information into the document", the Petition dispenses with the notepad area altogether and argues that insertion into the document is shown in the phone slip window 170. Petition, pages 26-27, section [1h].

Instead of teaching "insertion" into a document, Luciw merely displays a database search result as a separate field in the same template (the phone slip window 170) that is used to launch a database query. Initially the user enters into a first field of the template the value of the field to be searched. The search results are simply displayed in a second field of the same template. Displaying the results of a database query in a second field of the same template carrying the queried term in a first field has nothing to do with "causing insertion of at least part of the second information into the document".

Because Tso fails to disclose or suggest "causing insertion of at least part of the second information into the document" conditioned on "if the search term is included in the information source" and "if the information source includes ….second information", Ground 5 fails to establish a prima facie case of obviousness. The last clause of independent claim 1 and corresponding independent method claim 12 and independent apparatus claim 20 require that "the type of action depends at least in part on whether the search term is included in the information source, and *if the search term is so included*, and *if the information source includes the second information*, the action comprises causing insertion of at least part of the second information into the document." (emphasis added). As a result of these limitations, in order for the insertion to be performed: (1) the search term must be present in the information source, and (2) the second information associated with the search term must also be present in the information source. In contrast to these requirements, Tso *always* offers a template for insertion regardless of the degree of match of the keywords. Consequently, Tso fails to disclose the binary conditions of insertion that is dependent on both: (1) presence of the search term in the database, and (2) presence of second information associated with the search term located within the information source.

Moreover, because Tso always offers the same type of action, namely, providing a template, Tso fails to disclose or suggest that "the type of action

depends at least in part on whether the search term is included in the information source" and "if the information source includes second information", and therefore Ground 5 of the Petition fails to establish a *prima facie* case of obviousness.

Because Ground 5 fails to articulate any reason one of ordinary skill in the art would modify Tso with the teachings of Pandit, Ground 5 fails to establish a prima facie case of obviousness for the claims. Given the lack of a rationale that one of ordinary skill in the art might follow, Petitioner haphazardly argues sometimes asserting Pandit as the primary reference, and other times relying on Tso.

Finally, because the Petition fails to show that Tso discloses "causing insertion of at least part of the second information into the document", Ground 5 fails to establish a prima facie case of obviousness for this additional reason.

B. Because Luciw and Pandit fail to disclose or suggest "causing insertion of at least part of the second information into the document", Ground 1 fails to establish a *prima facie* case of obviousness.

The Petition fails to demonstrate how Luciw[1] discloses or suggests "causing insertion of at least part of the second information into the document", wherein "a

[1] The Petition does not even suggest that Pandit relates to this limitation.

document editing program" allows "a user to enter textual information into [the] document", as required by independent claims 1, 12, and 20. The claims

On the one hand, the Petition argues that the "document editing program" and the "document" required by these claims correspond respectively to the "notepad" and the entries one can make in the note area using the notepad. Petition, page 20, sections [1a] ("notepad") and 1[b] (entries in "note area"). On the other hand, for the limitation "causing insertion of at least part of the second information into the document", the Petition dispenses with the notepad area altogether and argues that insertion is shown in the phone slip window 170. Petition, pages 26-27, section [1h].

Notwithstanding the assertion of the Petition, as can be seen in Figs. 6a, 6b, 6c, and 8b, the phone slip window 170 is distinct from the note area and is simply a template for querying Luciw's database. In other words, one uses the phone slip window as a template to launch a search of the database. Initially the user enters into a first field of the template the value of the field to be searched. The search results are simply displayed in a second field of the same template. Displaying the results of a database query in a second field of the same template carrying the queried term in a first field has nothing to do with "causing insertion of at least part of the second information into the document". The phone slip window 170, which is the template used to query the Luciw database, is distinct from the notepad and

entries in the note area, which are asserted by the Petition as corresponding to the document editing program and the document.

Luciw displays the template, the phone slip window 170, when a user invokes an implicit assist. See Ex. 1005, steps 104 and 106 of Fig. 3; col. 8, lines 7-13. The window 170 includes "smart fields" that are each associated with a different type of information. The exemplary window 170 depicted in Figs. 6a, 6b, 6c and 8b includes a dedicated smart field 175 for a name and a dedicated smart field 177 for a telephone number, and the window 170 of Fig. 6a is replicated below:

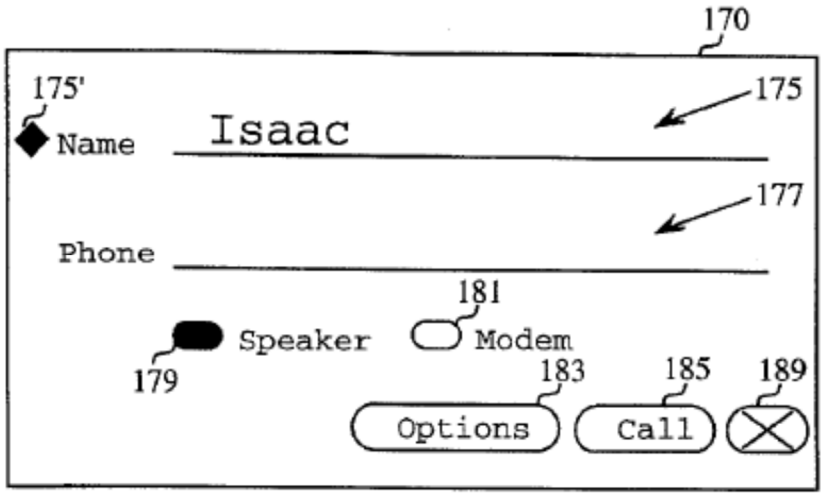

Figure 6a

After a user inputs a name into the name field 175, the computer system of Luciw queries a database for entries that include the name. See Ex. 1005, col. 10, line 49-col. 11, line 39. If an entry is found, the computer system checks for linked smart fields, and displays the linked information in the separately presented corresponding smart field of the phone slip window 170. See Ex. 1005, col. 12,

lines 47-54. For example, as depicted in Fig. 8b, when Luciw finds a database entry with "Isaac" as the name field, Luciw determines that the telephone number in the entry is linked to the name and displays the number in the dedicated phone field 177 of the window 170:

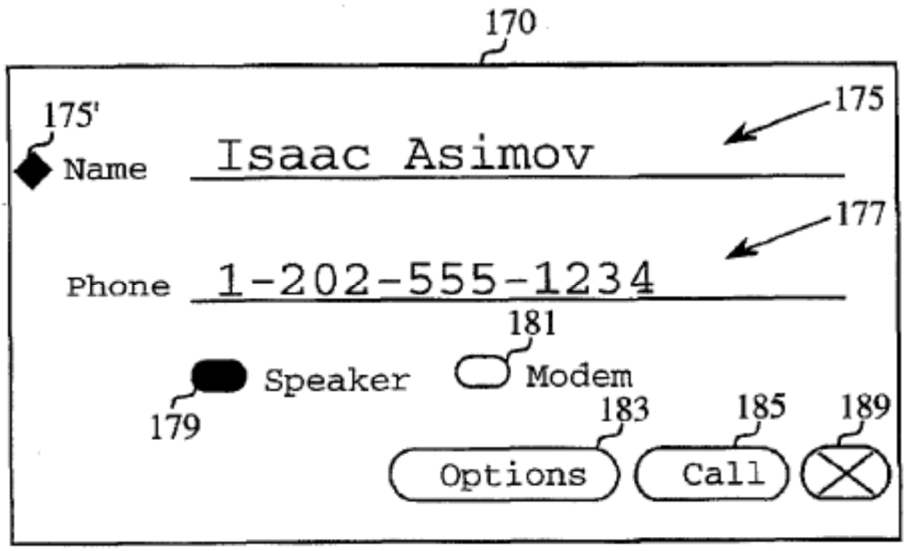

Figure 8b

Thus, in response to a database query initiated via an entry in a field of the template, Luciw populates a distinct field of the template with the search result. Since the phone slip window 170 is simply a conduit for searching and displaying information, and is distinct from the notepad, asserted by Petitioner to be the document editing program, Luciw fails to disclose or suggest "causing insertion of at least part of the second information into the document".

Moreover, even assuming that Luciw were to teach insertion —which it does not—the Petition fails to explain how the dissimilar functionalities of Luciw and Pandit can be combined in the manner urged by the Petitioner. In particular,

Luciw involves a database program and Pandit involves a word processing program. Documents and word processing functions are irrelevant to Luciw's task of making a database query using a template (e.g., phone slip window 170) and displaying the search result in a different field of the same template. See Ex. 1005, Fig. 6a, 6b, 6c, and 8b; col. 8, lines 7-13; col. 12, lines 47-56. Likewise, a template serving as a user interface for a database query is irrelevant to Pandit's word processing program that displays and processes a document. See Ex. 1004, col. 2, lines 4-13. The functionality of a database program differs from the functionality of a word processing program, and it is precisely the mediation between those two functionalities that is the subject of the Patent claims. The Petition provides no explanation for why the gap between these two different programs should be bridged or how this feat can be accomplished.

In fact, the Petition fails to disclose any mechanism by which the disparate functionalities of a database program and a word processing program can be combined. Instead, the Petition relies on general teaching that the functionality of Pandit can be extended via modular, dynamic libraries:

> Along with databases, Pandit discloses integrating with other programs as a means to provide functionality using the recognized text….But Pandit emphasizes that "any program" related to the recognized text can be invoked to perform actions using it. Ex. 1004 at 3:8; see also Ex. 1004 at 2:61; Ex. 1002 at ¶¶195-196. Furthermore, Pandit discloses a modular, dynamic

> library approach to implementation, with the express goal of facilitating extensibility: "Other libraries may be added to, for example, operate on URLs, nouns, verbs, names[,] street addresses, etc." Ex. 1004 at 4:28-31 (emphasis added). See also Ex. 1004 at 4:32- 45 (disclosing additional details of its modular approach); Ex. 1002 at ¶197.
> See Petition, page 15.

Then, the Petition alleges that in Luciw, "The "Frame" approach to contact databases and the user assistance module of Luciw are precisely the types of databases and information processing programs that Pandit was designed to integrate and cooperate with." See Petition, pages 16-17. However, Pandit simply refers to extendibility in general terms, failing to provide any rationale for why contact databases, such as those in Luciw, would be incorporated into its computer system.

Further, by emphasizing the modular nature of Pandit and the purported presence of modules in Luciw, the Petition suggests that Pandit and Luciw *would* be combined because their embodiments *can* be physically combined. Even assuming, for the sake of argument, that a physical combination were possible, which has not been demonstrated, the modules would still lack functionality for integrating a word processing program with a database program. There is no teaching of how the result of a search would be inserted into the Pandit document. Indeed, there are no external applications disclosed in Pandit which can insert

information into a document. Since modules in Pandit and Luciw are directed to different programs, their combination would provide functionality for separate, standalone programs, but would not enable the programs to interact with one another. Thus, the combination would still fail to meet the requirements of independent claims 1, 12, and 20.

For at least the foregoing reasons, the Petition fails to prove that Pandit and Luciw disclose or suggest "causing insertion of at least part of the second information into the document", as required by independent claims 1, 12, and 20. Luciw describes a user interface that is a conduit for displaying database search results, not a document into which such results are incorporated and thus inserted. Further, since Pandit and Luciw fail to teach how database programs and word processing programs may be integrated, combination of the references would fail to produce the subject matter of the Patent claims. Therefore, the Petition fails to establish a *prima facie* case of obviousness for independent claims 1, 12, and 20 based on Pandit and Luciw.

C. Because Tso fails to disclose or suggest "causing insertion of at least part of the second information into the document" conditioned on "if the search term is included in the information source" and "if the information source includes ….second information", Ground 5 fails to establish a *prima facie* case of obviousness.

The last clause of independent claim 1 and corresponding independent method claim 12 and independent apparatus claim 20 require that "the type of action depends at least in part on whether the search term is included in the information source, and *if the search term is so included*, and *if the information source includes the second information*, the action comprises causing insertion of at least part of the second information into the document." (emphasis added).

This clause requires a search of an information source, and use of the results of the search to be subject to a first binary condition depending on the presence of the search term in the information source. If the condition is satisfied and the search term is present in the information source, a second binary condition depends on the presence of second information associated with the first term in the information source. If and only if both binary conditions are satisfied, does insertion of second information occur within the document. In other words, in order for the insertion of the second information to be performed: (1) the search term must be in the information source, and (2) the second information associated with the search term must also be in the information source.

Although the Petition, at page 57 *et seq.*, argues that Tso meets these limitations and that Tso discloses a database search, Tso *always* offers a template for insertion regardless of the degree of match of the keywords. Consequently, Tso fails to disclose the binary conditions of insertion that is dependent on both: (1) presence of the search term in the database, and (2) presence of second information associated with the search term located within the information source. As a result, Tso fails to disclose the required "insertion" of second information conditioned on satisfaction of the two binary conditions.

Tso is directed to a context-sensitive template engine for providing possible templates in response to a received e-mail message. See Ex. 1009, Abstract, col. 1, line 66-col. 2, line 6. Although Tso discloses searching a database of predefined templates, Tso fails to disclose insertion of second information if the search term is found in the information source and if second information is found in the information source associated with the search term. *Id.* at col. 4, line 48-col. 5, line 17. Specifically, claim 1 states that the action of insertion depends on if "the search term is included in the information source," and the claim further requires:

> and if the information source includes the second information….
> causing insertion of at least part of the second information into the document.

In contrast, Tso parses a text string from an e-mail message identifying each term within the text string and then passes all of the terms to a template engine. *Id.* at col. 4, lines 43-60. The template engine searches for keywords contained within each template of a template database. *Id.* at col. 5, lines 1-5. The template engine then determines a score based upon a weighting of keywords that are found in each template. "The template with the highest total weight value is then designated as the most appropriate template for the text string being processed." *Id.* at col. 5, lines 15-17. Thus, a template is always selected independent of whether or not one or more of the keywords is found within the identified text string. The search within Tso for the search term ("the identified text") does not require satisfying the condition that the search term is found within the information source and the condition that second information is found associated with the search term in the information source.

To make the distinction clear, Tso describes an example of how an identified text string is processed at col. 5, lines 23-44. In this passage, the selected text is "When and where would you like to meet?" The identified text is parsed and eight search terms are located: (1) when; (2) and; (3) where; (4) would; (5) you; (6) like; (7) to; and (8) meet. The search terms are compared to keywords associated with a template to determine a score for the template. The keywords for an example template are presented in the chart at col. 5, lines 27-35:

keyword	weight
where	50
when	50
meet	45
place	25
time	25

The template engine identifies that three of the eight search terms have corresponding keywords for a given template ("when", "where", "meet"). Thus, five of the eight search terms ("and", "would", "you", "to", "like") are not present within the keywords for the associated template. The template engine determines that the template score is "145". If this template had the highest associated score, the template would be provided to the user, even though more than half of the search terms were not found in the database. Thus, Tso does not depend upon a determination of "whether" the search term(s) (i.e., selected text) are present within the template database. The present independent claims require satisfaction of two binary conditions before the action type of insertion is reached.

A direct correspondence between the search term (first information) and second information is an important feature of the present invention and therefore, the binary conditions as required in the independent claims are not superfluous. When contact information is identified as the first information (e.g., a name), a user desires to have corresponding contact information (e.g., address, telephone

number, etc.) inserted into the document. The invention would not function if the analysis process of Tso were used. Tso always selects a template with the highest probability, even if one or more of the words that are searched for are not found within the template database for a template. Tso uses the score as a "degree of match" rather than determining "whether" the search term is present. As a result, Tso fails to depend on a determination "whether the search term is included in the information source" and to cause insertion conditionally as claimed.

Although the Petitioner argues, in the claim chart for section [1h] on pages 57-58, that Tso meets the requirements of this claim limitation, the Petitioner fails to identify any support for the two binary conditions, and admits that a weighted value is used by Tso. Neither does Petitioner rely in any way on Pandit for satisfaction of the claim limitation.

Further, Petitioner simply relies on its expert for the conclusion that col. 5, lines 11-17 of Tso meets the claim requirement for insertion based on the binary conditions of (1) "whether the search term is included in the information source " and (2) "if the information source includes second information" .

Col. 5, lines 11-17 of Tso are reproduced below:

> If a keyword is found in the array, the weight value associated with that keyword is added to a running total weight value for that template. In this fashion, the template engine 5 determines a total weight value for each template in the database 5. The template with the highest total weight value

is then designated as the most appropriate template for the text string being processed.

The Petitioner's expert at ¶185 of Ex. 1002 merely requotes the above passage from Tso and provides no further argument or evidence that the claim language is taught or suggested by Tso.

Col. 5, lines 11-17 cannot be read to teach the determination whether a binary condition has been successfully met based on the search term. Nor does this passage inherently suggest that the second binary condition of determining "if the information source includes second information" is met. Thus, Ground 5 fails to establish a *prima facie* case of obviousness, since Tso does not require the satisfaction of two binary conditions before the action of insertion is performed.

D. Because Tso always offers the same type of action, i.e., insertion, Tso fails to disclose or suggest that "the type of action depends at least in part on whether the search term is included in the information source" and therefore Ground 5 of the Petition fails to establish a *prima facie* case of obviousness.

The independent claims 1, 12 and 20 each require "performing an action having a type, *wherein the type of action depends* at least in part on whether the search term is included in the information source …." (emphasis added)

This claim limitation requires, at a minimum, two types of actions: (1) one action if the search term is included in the information source and (2) another action if the search term is not found in the information source.

The Petitioner claims to address this limitation at pages 57-58 of the Petition, in their claim chart for section [1h]. However, the Petitioner fails to account for "an action having a type" and the requirement of at least two types of actions. The Petitioner suggests that "Tso teaches that if a template match is found, the template can be inserted directly into the email document." This is the only type of action identified by Petitioners, as it is the only type of action disclosed by Tso.

As shown below in Fig. 3 of Tso, in response to the performance of the search in block 232 of the template database for the best matching template, there is only one outcome that leads to block 233 where the best matching template is presented to the user. Exhibit 1009 at col. 5 lines 1-9 (emphasis added) states:

> Once the text string to be processed is identified, the template engine 5 decomposes the text string into search words that will be used to *search for a template (step 232)*. The template engine 5 may, for example, build an array in which each member contains a different word extracted from the text string. The template engine 5 then uses the extracted words to search the set of predefined templates stored in the template database 4 (step 232).

Exhibit 1009 at col. 5 lines 42-44 states:

> Once the template engine 5 determines the most appropriate template, it passes that template to the user interface 2 for presentation to the user (step 233).

Therefore, Tso teaches only a single path in response to the search (232). The type of action does not depend on the search given that the same path toward passing the template is always followed. Tso never provides an alternative action, since the search always provides the "best matching" template.

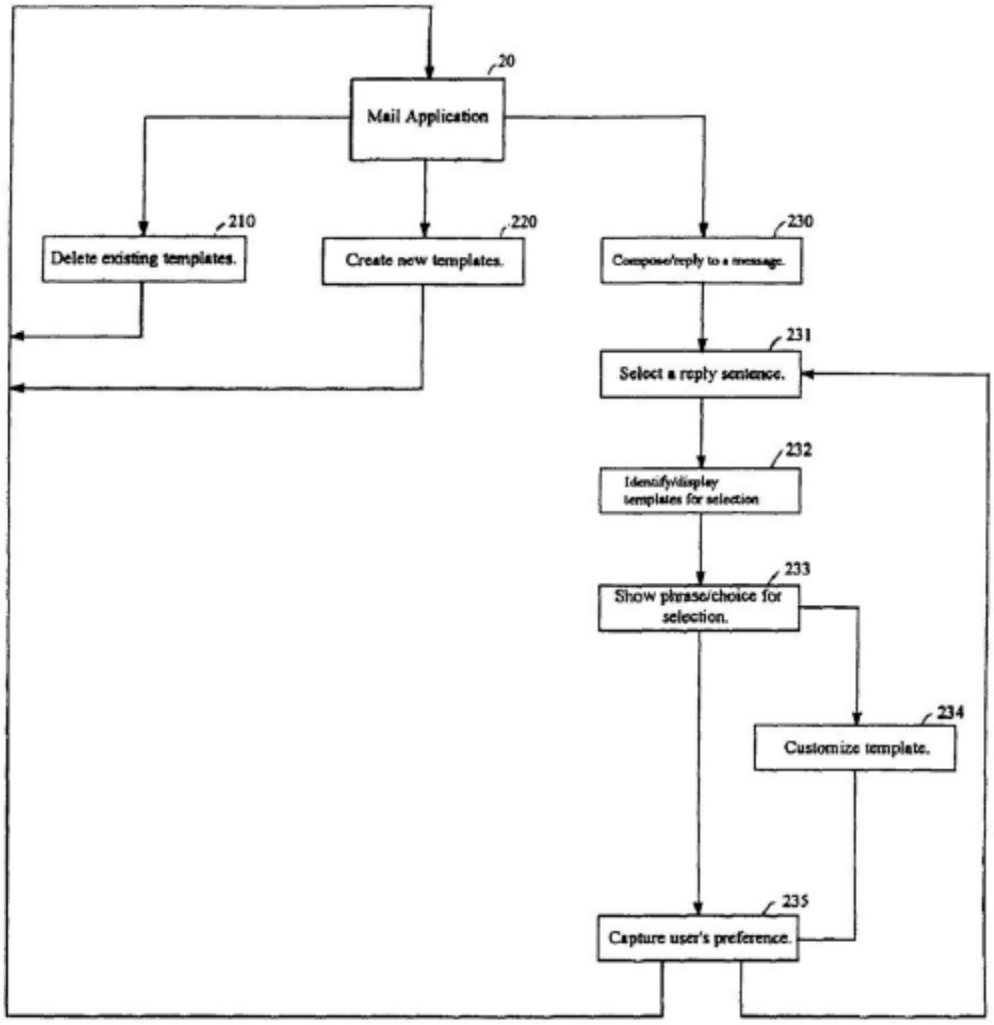

Figure 3

Although blocks 234 and 235 may be considered separate actions, these actions are not dependent on presence or absence of a search term in the database as required by the independent claims. Rather the template is always presented and

it is the user who makes a decision as a result of the presented template to either customize the template in 234 or to accept the template in 235.

Fig. 1 of the '356 Patent, which is a flow chart of an embodiment of the invention and reproduced in relevant part below, shows that different actions take place depending at least in part on a binary condition, which is if the search term is included in the information source. See Ex. 1001, col. 4, line 28- col. 5, line 11 and block 18 in Fig. 3.

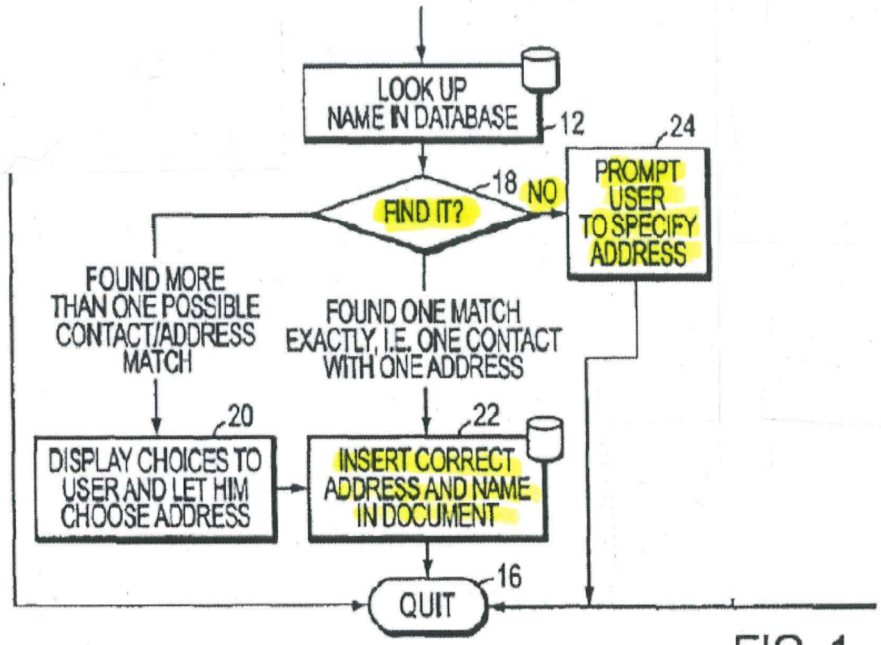

FIG. 1

The methodology as shown in Fig. 1 performs a search for a search term (i.e., a name) in a database. The methodology determines whether or not the search term is found within the database 18. If the search term is found in the database

and has associated second information, a first action of "insertion" occurs in accordance with block 22 so that the "address" (i.e. second information) is inserted into the document. If the search term is not found in the database, a second type of action occurs wherein the user is prompted to specify the address that is associated with the name 24.

This second type of action is also specified in claim 2 of the '356 patent by the language "when the information source does not include the search term, the action comprises causing indication to the user that the information source does not include the search term".

Thus, the present independent claim requires at least two types of actions, so that the choice of action "depends at least in part on" if the binary conditions are satisfied. In particular if the search term is found, the action of insertion is available to be causes. If not, a second type of action is available to be caused.

Because Tso fails to teach a condition based on the search leading to a choice of different "types of actions", Tso fails to teach "performing an action having a type, wherein the type of action depends at least in part on whether the search term is included in the information source..." as required by each independent claim 1, 12, and 20.

Likewise, Pandit does not meet this limitation and the Petitioner does not suggest that Pandit teaches this limitation when addressing [1h] in the claim chart.

As a result, Ground 5 of the Petition does not establish a *prima facie* case of obviousness for the independent claims.

E. Because Ground 5 fails to articulate any reason one of ordinary skill in the art would modify Tso with the teachings of Pandit, Ground 5 fails to establish a *prima facie* case of obviousness for the claims.

In order to establish a prima facie case of obviousness, a clear articulation of the reason or reasons why the claimed invention would have been obvious *must be presented*. The Supreme Court in *KSR* noted that the analysis supporting a rejection for obviousness should be made explicit. The Court, in quoting *In re Kahn,* 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), stated that "'[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *KSR Int'l Co. v. Teleflex Inc.,* 550 U.S. 398, 418, 82 USPQ2d 1385, 1396 (2007).

The Petitioner's rationale for combining references initially argues that Pandit, as the primary reference, may be modified with the teachings of Tso. The Petitioner states that "Pandit expressly suggests, however, that its system can be used to create an email templating system (like the one discussed in Tso)". Petition, page 50. Specifically, the Petitioner points to Pandit (Ex. 1004) at col. 2 lines 56-63 and col. 3 lines 27-33 to suggest that Pandit may include a pull-down

e-mail menu that includes an e-mail template. The Petitioner then states that Pandit can be used with many kinds of text processing operations "including those operating in e-mail programs". Ex. 1004, col. 3, lines 27-33.

However, after first making Pandit the primary reference, the Petitioner then inconsistently argues on the basis that Tso is the primary reference. The Petitioner switches to arguing, "It would thus have been obvious to use Pandit's recognition of certain types of contact information in Tso's system". This statement presumes that Tso is the primary reference that is being modified with the features of Pandit. Similarly in the claim chart beginning at page 52 of the Petition, the Petitioner again uses the Tso reference as the primary reference and modifies the teaching of Tso with the features of Pandit where needed (e.g., "Pandit further teaches recognizing particular types of contact information"). See Petition, page 56.

The Petitioner does not provide any reason that would have prompted a person of ordinary skill in the art to modify Tso with the teachings of Pandit. Without a clearly articulated rationale, the Petitioner has failed to meet the minimum requirements as stated by the Supreme Court in *KSR*.

Turning to the Petitioner's claim chart, the Petitioner's claim chart suggests that the template engine of Tso meets the claim limitation of "analyzing, by the document editing program, the selected textual information" and that Pandit teaches the next part of the clause, "to determine if the selected textual information

is regarded by the document editing program as contact information and what type or types of contact information the selected textual information is". *Id.* at 55. However, no reason is provided in the claim chart or the remainder of the Petition as to how or why the determined contact information would be used by the templating system of Tso to perform the remaining elements of the independent claims.

Claim 1 also requires "providing an input device configured by the document editing program to allow the user to initiate an operation, such operation being of a type depending at least in part on the type or types of contact information of the selected textual information." In the claim chart on page 56, the Petitioner provides no rationale as to how or why the recognition of types of contact information by Pandit would be used to select a type of action in Tso. The Petitioner merely points to claims 1 and 7 of Pandit to suggest that the type of contact information is used to select an operation. *Id.* at 56. Although the Petitioner does cite to its Expert's declaration (Ex. 1002, page 87), this citation fails to provide any reason for combining Pandit with Tso to teach how or why the type of contact information would be used to select a type of operation as required by the independent claims. In fact, page 87 of the Expert's declaration makes no reference to Pandit at all. Thus, one of ordinary skill in the art is not provided with a rationale that explains how the identified type of contact information in Pandit

can be used to select a type of operation wherein the operation is performed by Tso.

Since Ground 5 fails to provide a rationale for the modification of Tso with the teaching of Pandit, the Petitioner has failed to establish a *prima facie* case of obviousness.

F. Because the Petition fails to show that Tso discloses "causing insertion of at least part of the second information into the document", Ground 5 fails to establish a prima facie case of obviousness for this additional reason.

The Petitioner points to Tso as meeting the claim limitation of "causing insertion of at least part of the second information into the document", and argues that the Tso's template-generated text is the second information that is inserted into the document. Petition, at 58. In order for there to be "second information" that is inserted into the document, there must be information that is selected in the document, because the claims require "allowing a user to enter textual information into a document" and also "allowing…the user to select in the document at least a portion of the textual information while the textual information is displayed". The claim further requires "identifying at least part of the selected textual information to use as a search term in order to find second information".

The Petitioner's argument fails to establish that there is any textual information in the document into which the insertion is made. The Petitioner's own

quote of Tso states this technology applies "When a user wishes to compose *a new e-mail message* or generate *a reply* to a received e-mail message". Petition at 53 (emphasis added). There is nothing in this passage stating the presence of text in the e-mail receiving the insertion. The reader is left to guess where any text resides that is selected by the user. Further, Petitioner's claim chart covering section [1h] does nothing to alleviate this problem. Petition at 57-58. Hence, the Petitioner's argument fails to establish that there is any textual information in the document into which the insertion is made.

Accordingly, because the Petition fails to show that Tso discloses "causing insertion of at least part of the second information into the document", Ground 5 fails to establish a prima facie case of obviousness for this additional reason.

V. CONCLUSION

Since Grounds 1 and 5 attack the independent claim and the remaining Grounds rely on Ground 1, all of the Grounds will fall upon finding that Grounds 1 and 5 are not reasonably likely to succeed. For the foregoing reasons, Petitioner has failed to establish a reasonable likelihood of prevailing as to any claim of the '356 Patent, and *inter partes* review of claims 1-20 of U.S. Patent No. 7,496,356 should be denied.

Dated: May 23, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

It is certified that on May 23, 2014, copies of the Preliminary Response of the Patent Owner under 35 U.S.C. § 313 and 37 C.F.R. § 42.107 have been served on Petitioner as provided in 37 C.F.R. § 42.6(e) via electronic mail transmission addressed to the persons at the following addresses:

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Exhibit 6G

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Apple Inc., Google Inc., and Motorola Mobility LLC

Petitioners,

v.

Arendi S.A.R.L.

Patent Owner.

Case No. IPR2014-00208

Patent No. 7,917,843

PATENT OWNER ARENDI S.A.R.L.'S PRELIMINARY RESPONSE UNDER 35 U.S.C. § 313 and 37 C.F.R. § 42.107

TABLE OF CONTENTS

EXHIBIT LIST

Arendi Exhibit Number	Description
2001	American Heritage College dictionary 3rd edition 1997 definition of the term "configure".

TABLE OF AUTHORITIES

Cases

Statutes

INTRODUCTION

Patent Owner Arendi S.A.R.L. ("Arendi" or "Patent Owner") respectfully requests that the Board decline to initiate *inter partes* review of claims 1-44 of U.S. Patent No. 7,917,843 (the "'843 Patent") because Petitioners Apple Inc., Google Inc., and Motorola Mobility LLC ("Petitioners") have failed to show that they have a reasonable likelihood of prevailing with respect to any of the challenged claims. 35 U.S.C. § 314.

Petitioners have submitted proposed grounds for challenge based on anticipation or obviousness. However, for each proposed ground, at least one claim element is missing from the relied-upon reference or combination of references. Thus, Petitioners have failed to meet its initial burden to show that each element was known in the prior art.

I. OVERVIEW OF THE '843 PATENT

The '843 Patent is directed, among other things, to computer-implemented processes for automating a user's interaction between a first application, such as a word processing application or spreadsheet application, on the one hand, and a second application, such as contact management application having a database, on the other hand. In the '843 Patent, Exhibit 1001, Figs. 1 and 2 are flow charts showing for these interactions a number of scenarios, which are described from col. 4, line 25-col. 5, line 53. Further details of the interactions are provided in

discussion thereafter of the other figures of the '843 Patent, and the discussion includes references back to relevant portions of the flow charts in Figs. 1 and 2. Fig. 1 is reproduced below.

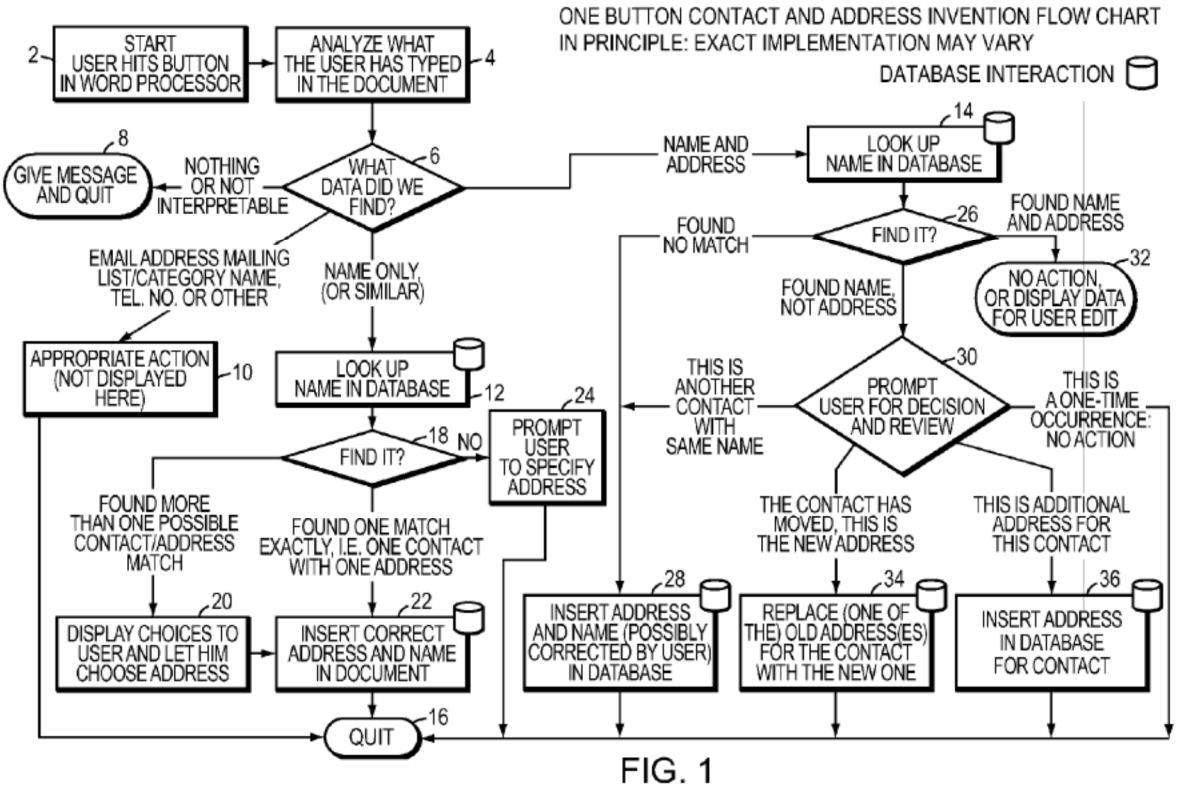


FIG. 1

The user interface of the first application includes a One Button 42 that the user can select to initiate the Patent's functions. See '843 Patent, Exhibit 1001, Fig. 1, step 2; Fig. 3. In various scenarios, after the user has clicked on the One Button 42, text in a document in the first application is analyzed (in step 2 of Fig. 1) to identify information, such as names, persons, companies, and addresses. *Id.*, col. 4, lines 32-39. The second application receives this information as a search term, which it uses to look up and retrieve related information from its database.

Id., Fig. 3, steps 12 and 14. The type of the latter information depends on the type of the former. For example, if the search term is a name, the second application may retrieve an address, related to the name, from the database. *Id*., col. 5, line 61-col. 6, line 3. Likewise, if the search term is a name of a mailing list, the second application may retrieve mailing or e-mail addresses for members of the group. *Id*., col. 4, lines 16-18.

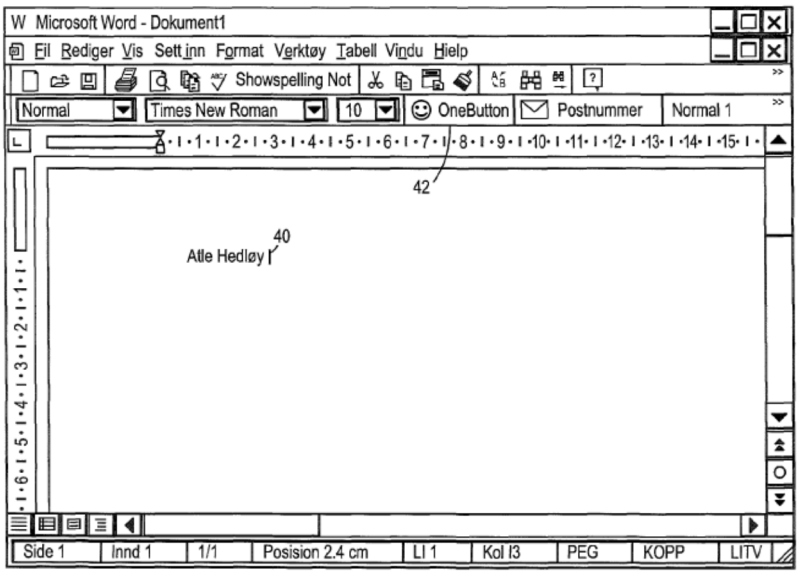


FIG. 3

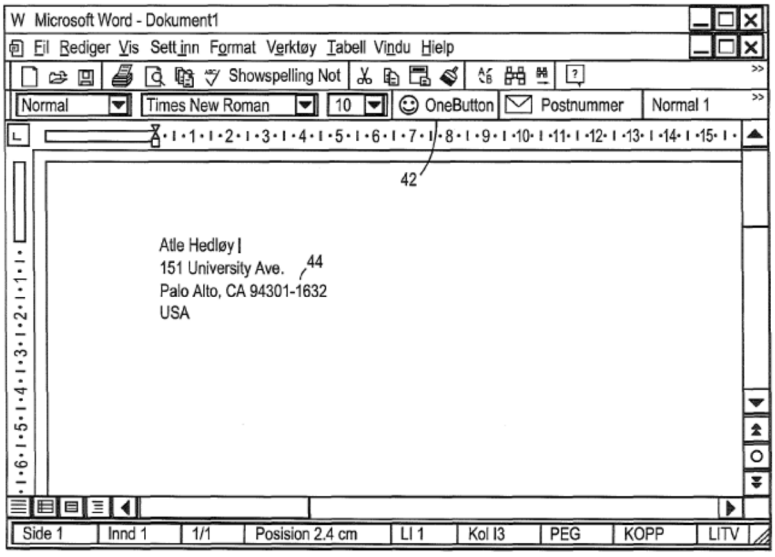


FIG. 4

Once the related information has been obtained from the database, a number of different scenarios can follow. In particular, the word processing application can either insert the related information into the document, or display the related information. Which

action the application performs depends on the type of information (e.g., name, name and address) identified in the document.

For example, if the identified information includes only a name, a search is initiated in the database associated with the second application for the name. *Id*., Fig. 1, steps 6 and 12. If only a single entry is found in the database for the name and the entry includes a single address, then the address is inserted into the document. *Id*., Fig. 1, steps 6, 12, 18, and 22; Fig. 4; col. 3, lines 63-67; col. 4, lines 43-54; col. 5, line 61-col. 6, line 5. Figs. 3 and 4 are reproduced above. Fig. 3 shows a document displayed in Microsoft Word when the document includes solely a name, "Atle Hedloy" 40. Fig. 4 shows the document after the address has been inserted.

In another example, if the identified information includes a name and an address, a search is initiated in the database associated with the second application for the name. *Id*., Fig. 1, steps 6 and 14. If an entry matching the name and address is found, both may be displayed for the user to edit. *Id*., Fig. 1, step 32; col. 4, lines 57-64. If the name happens to be in the contact database but the address in the contact database for that name differs from the address typed by the user into the document (per Fig. 1, step 26), then the user is prompted to make a choice (per Fig. 1, step 30). The user is presented with a screen shown in Fig. 9, which is reproduced below.

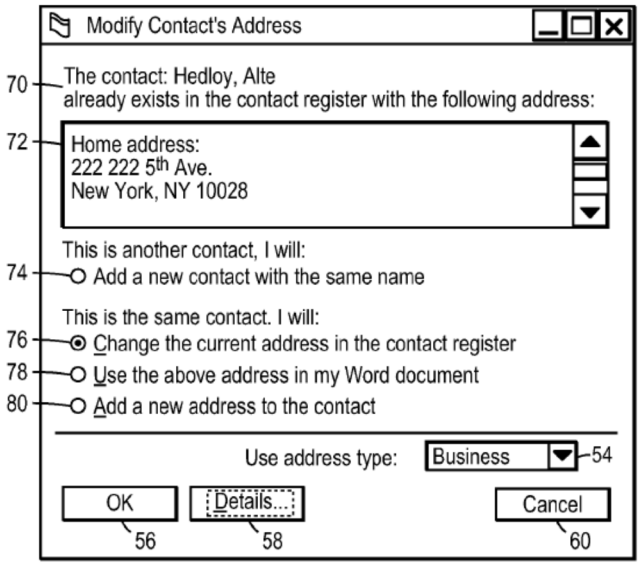


FIG. 9

Fig. 9 represents a screen presented to the user in which the user is given a series of choices that can be made in this specific context. *Id.*, col. 6, line 66-col. 7, line 14. The screen reproduces the name that is both in the document and in the contact database, and it also displays the address that is in the contact database for that name. Thus, the screen displays the name and address retrieved from the database that is related to the name and address from the document.

II. CLAIM CONSTRUCTION

In an *inter partes* review, the Patent Trial and Appeal Board gives patent claims their "broadest reasonable interpretation in light of the specification of the patent". 35 C.F.R. § 42.100(b); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*). The prosecution history is also relevant to identify the correct construction of claim terms. *Phillips v. AWH Corp.*, 415 F.3d at 1317. Extrinsic evidence may also be relevant to establish the meaning of terms, but such

evidence is only relevant to the extent it is consistent with the specification and file history. *Id.* at 1319.

Patent Owner Arendi proposes construction of certain claim terms below pursuant to the broadest reasonable interpretation consistent with the specification standard. The proposed claim constructions are offered for the sole purpose of this proceeding and thus do not necessarily reflect appropriate claim constructions to be used in litigation and other proceedings wherein a different claim construction standard applies.

A. "an input device, configured by the first computer program"

Independent claims 1, 20, 23, and 42 all recite the limitation "providing an input device, configured by the first computer program". Therefore, according to this limitation, a first computer program must "configure" the input device. Words of a claim must be given their plain meaning, which refers to the ordinary and customary meaning given to the words by one of ordinary skill in the art. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (*en banc*). Dictionary definitions may be used to determine the ordinary and customary meaning of words. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338 (Fed. Cir. 2003) (Dictionary definitions were used to determine the ordinary

and customary meaning of the words "normal" and "predetermine" to those skilled in the art.)

In this situation, we turn to the American Heritage College Dictionary 3rd edition 1997 for a definition of "configure". This dictionary defines "configure" as "to design, arrange, set up, or shape with a view to specific applications or uses". See Exhibit 2001. When this definition is applied to the claim limitations, the claims consequently require that the first computer program set up the input device so that it can be used. Therefore, "an input device, configured by the first computer program" should be construed as "an input device, set up by the first computer program for use".

Petitioners seek to interpret the limitation differently by ignoring a word in the claim. The independent claims of the subject patent require "providing an input device, configured by the first computer program" (emphasis added). The claim requires both "providing" and "configuring" and both words must be considered in evaluating the claim for obviousness. "All words in a claim must be considered in judging the patentability of that claim against the prior art". *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

In violation of this principle, Petitioners seek to construe "providing an input device, configured by the first computer program" as "providing an interface to receive the user command". See Petition, page 7. In their proposed claim

construction, Petitioners have ignored the word "configuring" altogether by collapsing the separate requirements of "providing" and "configuring" into the single requirement of "providing". As a result, the Petitioners' proposed claim construction fails to account for each and every limitation of the claims in violation of the requirement that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art". *In re Wilson*, *id*.

Therefore, the Patent Trial and Appeal Board should reject Petitioners' proposal and adopt Patent Owner's construction of "an input device, configured by the first computer program" as "an input device, set up by the first computer program for use".

III. OVERVIEW OF THE PRIOR ART

A. Overview of LiveDoc

LiveDoc concerns structure detection within a document where a "structure" represents meaningful bits of syntactically - regular information. LiveDoc allows a user to perform a function based upon an identified structure. To accomplish this goal LiveDoc constructs "a means of passing text from a user's document for matching against a collection of recognizers". Exhibit 1006, page 53. Thus, LiveDoc operates outside of any application program and outside of the document under the control of the application program.

The LiveDoc architecture is shown in Fig. 3 at page 56. As can be seen from the labels in the right-hand column in Fig. 3, the Applications (such as word processing) are shown separately from the LiveDoc Manager and from the Analyzer server. Further, the LiveDoc manager communicates with an external application (i.e. a text editor) using API callbacks. *Id*. at 57.

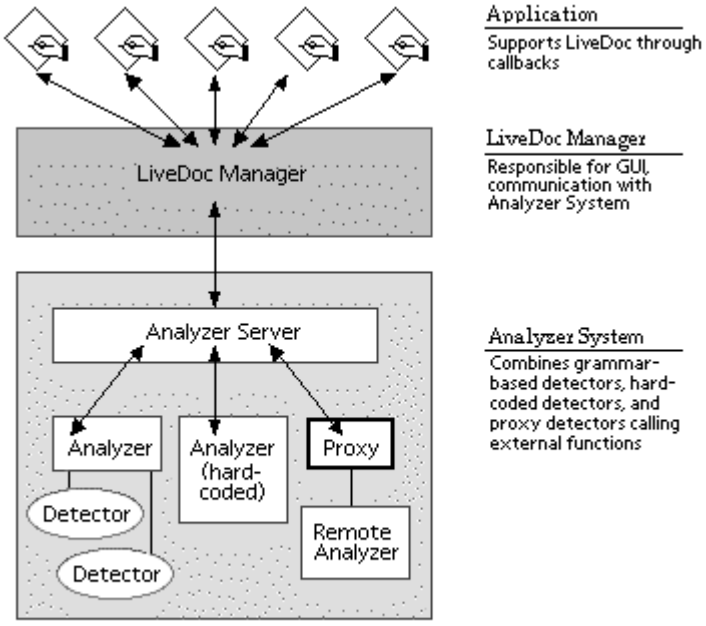


Figure 3: The high-level LiveDoc architecture.

The LiveDoc application receives only the text from the text editor (application in Fig. 3) and analyzes the text independently of the actual document in the text editor using a set of detectors under the control of an analyzer server.

If one is viewing a document in a word processing program on a computer that is running LiveDoc, the structures identified by LiveDoc are not visible in the word processing program itself. In order for the discovered structures to be visible to a user, the user must enter "LiveDoc mode" by pressing and holding the function key, causing the LiveDoc Manager to update "the display to present the highlight information over the discovered structures". *Id*. at 56. The user can then

use the mouse to move over a highlighted item and press the mouse button that causes the LiveDoc Manager to present a menu of functions associated with the highlighted item.

> LiveDoc knows where these structures appear in the text passed to it- an e-mail address might appear in characters 150 through 162 of the window's contents - but it has no idea where in the window those characters physically appear, and, thus, where the highlights should appear: this is information held by the application, not by LiveDoc. Hence, LiveDoc must ask the application for the information about the structures it has found via a callback. Once this information is available, the highlights and their associated mouse-sensitive regions can be constructed.

Id. The overlaid highlights are independent and separate from the text editor and the document. Fig. 2 shown below show some of the actions that LiveDoc allows for a recognized structure.

Each of the functions shown involves using the recognized text with an external application.

"Our initial implementation of LiveDoc as LiveSimpleText assumed that actions would be handled by external applications, such as a Web browser presenting the page pointed to by a URL[:]" *Id.* at 57.

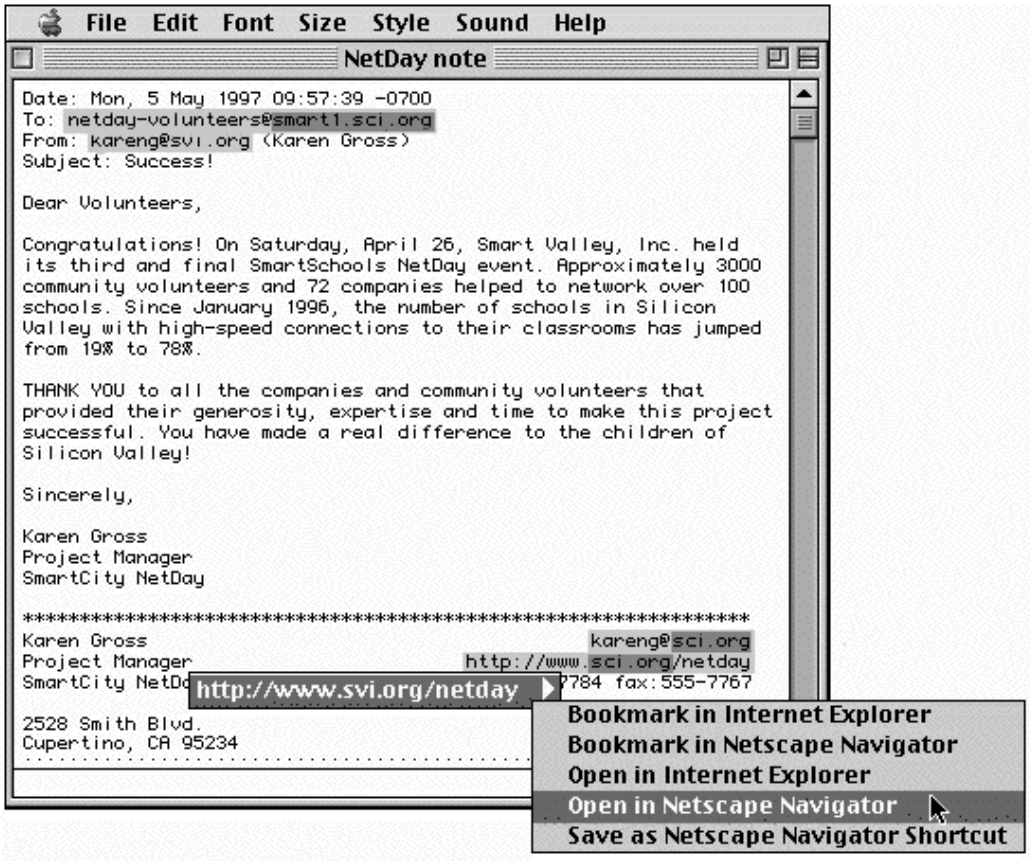
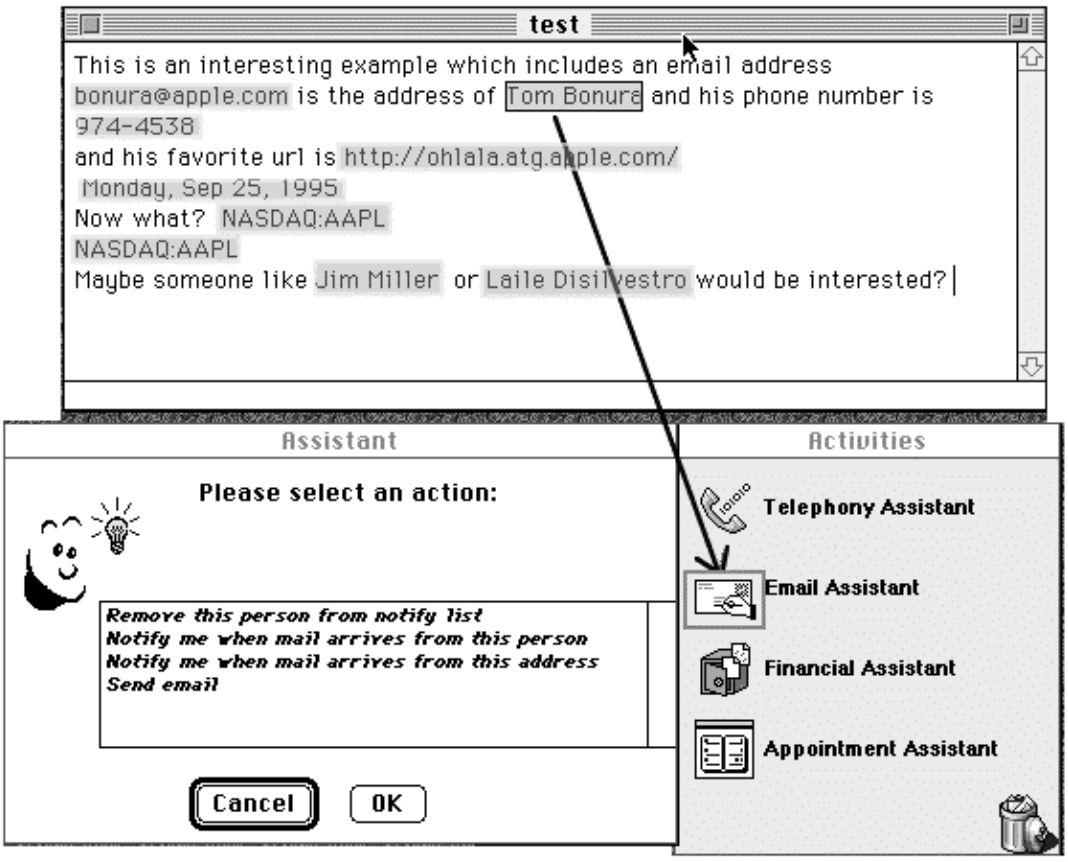


Figure 2: A sample interaction with LiveDoc. Note the highlighting of the discovered structures, the menu of actions available or the selected structure, and the nested highlighting of nested structures.

B. **Overview of Drop Zones**

Drop Zones extends on LiveDoc where a user that has entered LiveDoc mode may be presented with an interface that interprets the meaning of the identified and selected structure and presents recommended appropriate actions. Operation of the Drop Zones system uses Live Doc windows, as shown in Figures 1 and 2 of Drop Zones. The caption for Figure 1 states that "Drop zone is shown in

the window labeled 'Activities'. The window at the top called 'Test' is a LiveDoc window showing proper names, e-mail addresses, phone number, URL, date and stock market ticker codes". *Id*. at 60. These identified "structures" are shown in the LiveDoc window as highlighted. *Id*. Similarly in Figure 2 (reproduced below), which illustrates "A user interaction with Drop Zones", the same LiveDoc window is displayed. *Id.* To use Drop Zones, the user must first enter "LiveDoc mode" by pressing and holding a function key in order to cause highlighting to be displayed



over the document. Then, as discussed in connection with Figure 2, the user must select a structure in a LiveDoc window. *Id.*

In the LiveDoc window (identified as the window "test" in Figure 2), the user uses the mouse to select an item of information that has been highlighted (here the name Tom Bonura) and (while still holding down the mouse button), then drags the selected item to the window labeled "Activities" over a desired category (here "Email Assistant") and then drops the selected name on the category (by releasing the mouse button). Dropping the item causes a menu of actions to appear in the Assistant window (shown to the left of the Activities window in Figure 2), and from that menu, the mouse is used to select a desired action. *Id*. at 60-61.

C. Overview of Miller

Miller discloses systems and methods for "detecting structures in data and performing actions on detected structures" (claim 1). To achieve this function, Miller uses a computer program 165 that works outside of a document, such as a word processor document 210. Exhibit 1007, Fig. 2. The program 165 is initiated in response to user selection of a detect structures button 520: "Window 510 includes a [detect structures] button 520 for initiating program 165, although alternative mechanisms such as depressing the "option" key may be used. Upon initiation of program 165, system 100 transmits the contents of document 210 to analyzer server 220 [of the program 165]". *Id*., col. 5, lines 22-28.

This analyzer server 220 "receives data having recognizable patterns from a document 210". *Id*., Abstract, col. 3, lines 57-58. Then, Miller uses "pattern

analysis units, such as a parser and grammars or a fast string search function and dictionaries" to parse the data "for recognizable structures". *Id*., col. 3, lines 57-64. Therefore, Miller assesses the text of the document to determine if it contains any grammars or strings from the libraries: "[A]ssuming program 165 initiates with the receipt of any text, the received content or portion is scanned 820 for identifiable structures using the patterns in analyzer server 220". *Id*., col. 5, lines 56-59. Then, "[U]pon detection of a structure, analyzer server 220 links actions associated with the responsible pattern to the detected structure, using conventional pointers". *Id*.

After the structures are detected, an application program interface 230 within the program 165 subsequently "communicates with application 167 to obtain information on the identified structures so that user interface 240 can successfully present and enable selection of the actions". *Id*., col. 4, lines 2-5. Miller's user interface (240) "highlights the detected structures". *Id*., col. 4, line 10; col. 5, lines 35-37.

D. Overview of Luciw

Luciw describes logical processes, usable by a pen-based computer system that functions as a personal organizer, to provide "implicit or explicit assistance" for "user supportive information functions". Exhibit 1008, col. 4, lines 14-18 (pen-based computer system); col. 2, lines 16-19 (implicit or explicit assistance).

The pen-based computer system has a database that can be queried. *Id.*, col. 8, lines 31-34. Luciw describes "implicit" assistance, wherein a user has used a smart field to enter a word used for look up in the database or has otherwise similarly triggered a database lookup, and "explicit" assistance, wherein the user explicitly invokes assistance from the device as by using pen 38 of Fig. 2. *Id*., col. 8, lines 11-62.

The logical processes used by the Luciw device for providing implicit and explicit assistance are shown in Fig. 3 of Luciw. *Id.*, col. 8, lines 2-6. A review of Fig. 3 shows that the database is queried in step 106 if it is determined in step 104 that there is an implicit assist. On the other hand, if in step 104 it is determined that there is not an implicit assist, and if further it is determined that there is an explicit assist, there is no database query, because the only database query indicated is in step 106, exclusively where there is an implicit assist.

As an example of implicit assist, Luciw provides Figs. 4b, 4c, 5, 6a and 6b, which describe use of a "smart field". *Id.*, col. 10, line 23 et seq. (beginning discussion of smart fields in connection with Fig. 4b). According to Luciw, "[a] smart field is considered to be a predefined region on screen 52 of computer system 10 shown in FIG. 2, or a predefined region within a window which appears on screen 52". *Id.,* col. 8, lines 16-19. Fig. 4b is reproduced below.

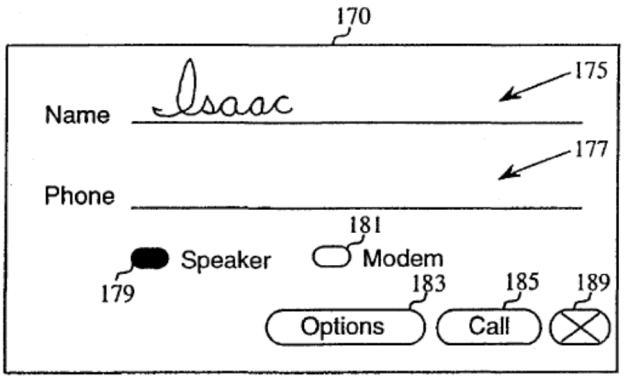


Figure 4b

According to Luciw, Fig. 4b "shows a phone slip window 170 with a smart name field 175 which has for example been evoked by either highlighting the verb 'call' or by simply writing the word on the display surface either before or after establishment of window 170". *Id.*, col. 10, lines 24-28. Operation of the phone slip window is explained in the lines thereafter in Luciw:

> Once the particular window 170 is presented to the user, the name ISAAC can be handwritten into the particular smart field 175. The assistance process recognizes the handwritten name "Isaac", and either continues operation as suggested at step 106 in FIG. 3 directly, or concurrently displays the recognized name in formal font form, as suggested in FIG. 4c, in the same position of the smart field, where formerly the handwritten name "Isaac" had been established. As will readily be recognized, window 170 in FIG. 4b may contain several smart fields, in this case for example definable for either the "name" field 175 or a "phone" field shown at step 177.

Id., col. 10, lines 27-39.

Because the user of the Luciw device uses the smart field to specify the field for which a database search is desired—a name in the name field 175 or a phone number in the phone field 177—the Luciw device uses the entered item to search

for in the database for an item that has the same value for a corresponding attribute. *Id.*, col. 10, line 51- col. 12, line 11.

E. Overview of Pandit

Pandit describes a program that enables users to identify text of interest and select an operation applicable to the text. Pandit identifies classes of text in a document and enables a user to select programs, based on the identified classes, applicable to the text. When a document is open in the program, the program provides a menu bar 13 that displays classes of text, such as "Date", "EMail", and "Phone #". Exhibit 1009, Figs. 1a-1f. The user selects text in the document by shading, underlining, or pointing and clicking on the text. *Id*., col. 2, lines 4-8. The program identifies the class of the selected text and highlights that class in the menu bar 13 using boldface type. *Id*., col. 2, lines 8-16, 51-53, 64-66 and Figs. 1a, 1c, and 1e. The boldface type indicates that the programs for that class of text have been enabled. *Id*., col. 2, lines 11-12.

When the user selects the bolded class, the program displays the programs for the class. *Id*., col. 2, lines 15-18, 20-21, 33-35. For example, if a user selects the highlighted option "Date" from the menu bar 13, the program displays potential programs that display a calendar or create an appointment based on the selected date in the document. *Id*., Fig. 1b. If a user selects the highlighted option "Email"

from the menu bar 13, the program displays potential programs that create an email message addressed to the selected email address or add the address to an address book. *Id*., Fig. 1d. If a user selects the highlighted option "Phone #" from the menu bar 13, the program displays potential programs of dialing the selected phone number, adding the phone number to an address book, or preparing a fax to be sent to the phone number. *Id*., Fig. 1f. The user selects a program to be performed by clicking on the operation or executing one or more keyboard strokes. *Id*., col. 2, lines 41-46.

IV. SINCE THE PRIOR ART DOES NOT ANTICIPATE OR RENDER ANY CLAIM OBVIOUS, NO *INTER PARTES* REVIEW SHOULD BE INITIATED

A. Overview of Reasons for Denying Inter Parties Review

Petitioners have failed to show any prior art alone or in combination to address all of the limitations of any of the independent claims. Because LiveDoc and Drop Zones describe a text editor that displays a document and a LiveDoc Manager that configures highlighting, LiveDoc and Drop Zones fail to disclose or suggest that the same "first computer program" performs both "displaying the document electronically" and "providing an input device, configured by the first computer program", and therefore Ground 1 fails to establish a *prima facie* case of obviousness.

Because, the LiveDoc Manager, and not the text editor, receives the user's selection of highlighting, LiveDoc and Drop Zones fail to disclose or suggest the claim limitation of "receipt by the first computer program of the user command from the input device" – another defect of Ground 1.

Because Miller fails to disclose how the "Detect Structures" button is configured, Miller fails to disclose or suggest "providing an input device, configured by the first computer program" – a defect in Ground 2.

Because Miller's Program 165, and not the Application 167, receives the user's selection of the "detect structures" button, Miller fails to disclose or suggest the claim limitation of "receipt by the first computer program of the user command from the input device" – another defect in Ground 2.

Because Miller searches within the document for strings or grammars, Miller fails to disclose or suggest "performing a search using at least part of the first information as a search term … in an information source external to the document" – another defect in Ground 2.

Because the user informs the Luciw apparatus of the input's type of information, Luciw fails to disclose "analyzing, in a computer process, first information from the document to determine if the first information is at least one of a plurality of types of information" – a defect in Ground 3.

Because Pandit's nouns and verbs are not the "types of information" contemplated by the claims, and, at best, the type of second information is decided by the user, and not dependent at least in part on the type or types of first information, Pandit fails to disclose or suggest "performing a search … wherein the specific type or types of second information [found] is dependent at least in part on the type or types of the first information [used as the search term]"—a defect in Ground 4.

Because Pandit's does not disclose searching in the address book, Pandit fails to disclose or suggest "performing a search using at least part of the first information as a search term in order to find the second information" and "causing a search for the search term" – another defect in Ground 4.

B. Because LiveDoc and Drop Zones describe a text editor that displays a document and a LiveDoc Manager that configures highlighting, LiveDoc and Drop Zones fail to disclose or suggest that the same "first computer program" performs both "displaying the document electronically" and "providing an input device, configured by the first computer program", and therefore Ground 1 fails to establish a *prima facie* case of obviousness.

Independent claim 1 requires the "first computer program" to perform at least two tasks. First, the "first computer program" must display a document electronically: "displaying the document electronically using the first computer program" (first subparagraph of claim 1). Second, the "first computer program" must configure an input device: "providing an input device, configured by the first

computer program" (fourth subparagraph of claim 1). Therefore, the same computer program must perform both of these tasks. However, in LiveDoc and Drop Zones, different computer programs perform these two tasks. In particular, the text editor displays a document electronically and the LiveDoc Manager configures the input device. Therefore, LiveDoc and Drop Zones fail to disclose or suggest a "first computer program" that performs "displaying the document electronically" and "providing an input device, configured by the first computer program, that allows a user to enter a user command to initiate an operation", as required by independent claim 1. Indeed, this limitation is found in all the independent claims and hence is required by all of the claims challenged in Ground 1.

Turning now to Petitioners' arguments, Patent Owner first agrees that the text editor displays the document electronically. Then, with respect to the "input device" limitation, Petitioners have equated the highlighting positioned over detected structures with this limitation: "Configured by the first computer program - LiveDoc/Drop Zones knows where to place the selectable highlights because the first application [the text entry application program] tells it where the structures are located in the document (i.e., the input device is configured by the first computer program)". See Petition, page 13.

Claim 1 requires that the input device, namely the highlighting, be "configured by the first computer program". As discussed in Section II(A), for the text editor to "configure" the highlighting, the text editor must set up the highlighting for use. We will demonstrate herein that setting up the highlighting for use is the exclusive domain of the LiveDoc Manager. The LiveDoc Manager alone analyzes the text in a document, identifies the characters in the text that corresponds to structures, obtains the physical locations within a display for those particular characters, and applies highlighting to those locations.

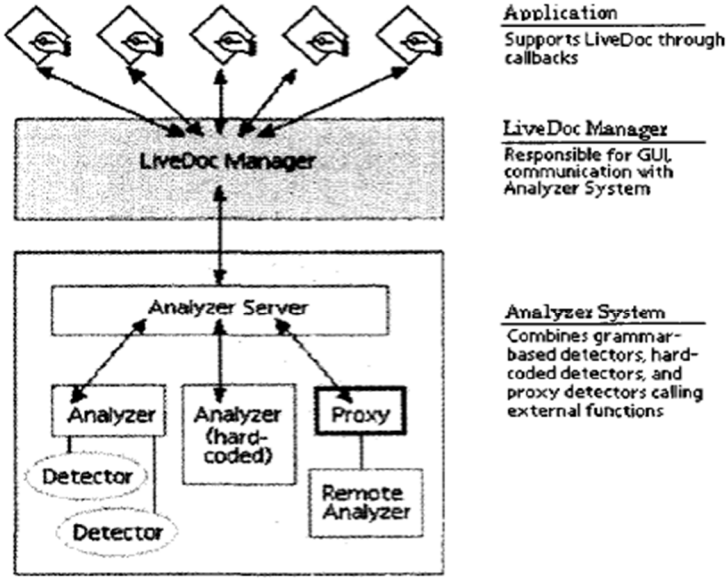


Figure 3: The high-level LiveDoc architecture

For some of these steps, the LiveDoc Manager does send calls to the text editor to obtain needed information. However, as described in Fig. 3, the LiveDoc Manager and applications (*e.g.*, text editor) are separate programs that are being executed independently:

As an independently executing program, the LiveDoc Manager unilaterally determines the information needed to set up the highlighting and requests this information from the text editor. The text editor merely responds by giving the LiveDoc Manager the screen positions of the structures to be highlighted. Since the text editor, has only a passive role in the LiveDoc Manager's preparation of the highlighting, and in fact is provided with no data whatsoever relating to the highlighting, the LiveDoc Manager implements the highlighting to "configure" the input device.

In more detail, when the user views the document, the user is in the text editor. To invoke LiveDoc, the user must exit the text editor and access the LiveDoc Manager. To do so, the user presses and holds down a function key: "Holding down a function key places the document in `LiveDoc mode' and presents the highlighted structures; releasing the function key returns the document to normal". Exhibit 1006, page 55.

"The LiveDoc Manager also controls the events that occur when the user presses the function key to enter LiveDoc mode, and when the mouse button is pressed while over a LiveDoc item. The LiveDoc Manager updates the display to present the highlight information over the discovered structures when the function key is pressed, and to remove the highlights when the function key is released. The LiveDoc Manager also receives the notification that the mouse button has been

pressed over a highlighted item; it then gets the list of actions appropriate to the selected item and presents a menu of them to the user". *Id*. at 56. There can be no mistake: the Petitioners' statement that the text editor configures the highlights (input device), and receives the user command simply has no basis in fact.

To begin, the LiveDoc Manager asks the text editor for a copy of the text currently visible in its window, the text editor sends the text to the LiveDoc Manager, and the LiveDoc Manager analyzes this text: "The receipt of these calls by the LiveDoc Manager signals the Analyzer Server to analyze the text provided by the calling application; this will typically be the text currently visible in the applications' front-most window". *Id*. Based on this analysis, the LiveDoc Manager identifies structures such as e-mail addresses. *Id*.

At this point, the LiveDoc Manager only knows which characters in the string of characters from the text editor correspond to structures: "LiveDoc knows where these structures appear in the text passed to it – an e-mail address might appear in characters 150 through 162 of the window's contents – but it has no idea where in the window those characters physically appear[.]" *Id*. Thus, the LiveDoc Manager does not know where the characters of interest physically appear in the window, and by extension, where the LiveDoc Manager should apply highlighting. To obtain this information, the LiveDoc Manager sends a call to the text editor requesting the physical locations of characters of interest: "LiveDoc must ask the

application for the information about the structures it has found via a callback". *Id*. Of course, there would be no need for the LiveDoc Manager to ask for this information if the text editor were to set up the highlight and receive the user command. Upon attaining this information, the LiveDoc Manager can apply the highlighting in the applicable locations: "Once this information is available, the highlights and their associated mouse-sensitive regions can be constructed". *Id*. This is done by "adding the notion of a sometimes-visible layer to the front of the display". *Id*. at 58. As demonstrated by these excerpts, the LiveDoc Manager sets up the highlighting for display and subsequent use and not the text editor.

Petitioners concede that the LiveDoc Manager asks the text editor for this information, and the text editor supplies the same using a callback: "See, e.g., LiveDoc at 56 ("LiveDoc knows where these structures appear in the text passed to it...but it has no idea where in the window those characters physically appear, and, thus, where the highlights should appear: this is information held by the [text editor] application, not by LiveDoc. Hence, LiveDoc must ask the application for the information about the structures it has found via callback". See Petition, pages 13-14.

In this situation, the LiveDoc Manager has not informed the text editor that the characters correspond to a structure, nor has the LiveDoc Manager indicated that the displayed characters shall be highlighted to be identified as a structure to a

user. Thus, the text editor does not know the significance of the identified characters or the intended use of the physical locations that it sends to the LiveDoc Manager. In fact, the text editor does not even know that highlighting exists or will exist, and the LiveDoc and Drop Zones references do not give any evidence that the text editor even knows that it exists when it exists, and indeed, *the text editor has no need for this information in the LiveDoc or Drop Zones systems*. The text editor just processes a request for information, which the LiveDoc Manager unilaterally uses to prepare highlighting for display.

Therefore, as just demonstrated, it is the LiveDoc Manager that sets up the highlighting to be used, whereas the text editor electronically displays the document. In this manner, LiveDoc describes a different program performing each of these two activities. Therefore, LiveDoc fails to disclose or suggest a "first computer program" used to configure the input device, as required by claim 1.

Further, even if Petitioners' proposed construction for the "input device, configured by the first computer program" were adopted, LiveDoc would still fail to disclose this limitation. Under Petitioners' proposal, configuring the input device would be construed as "providing an interface to receive the user command". See Petition, page 7. Since Petitioners have equated the text editor with the first computer program, when Petitioners' proposed construction is

applied to LiveDoc, the text editor must provide the highlighting to receive the user command.

However, as we have already demonstrated, the LiveDoc Manager and not the text editor provides the highlighting: "LiveDoc Manager constructs the various highlights for the discovered structures and their corresponding menu of actions". Exhibit 1006, page 56. Further, even Petitioners admit the LiveDoc Manager performs this step: "LiveDoc/Drop Zones highlights detected information". See Petition, page 13.[1] Regardless of the manner in which "an input device, configured by the first computer program" is construed, the LiveDoc Manager performs the configuring, not the text editor. Therefore, LiveDoc and Drop Zones fail to disclose or suggest a "first computer program" used to display the document

[1] Citing their expert, Menascé, Petitioners argue that "it would have been obvious for LiveDoc to contact the word processor via callback and inform it of the position of the detected structures within text, such that the word processor would then construct the highlights (input device) by mapping positions in text to positions in the visible window. See Petition, page 14. This hindsight-driven argument is inconsistent with placement, in the LiveDoc Manager, of the functionality of identifying structures and offering actions associated with the identified structures. Moreover, shifting the highlighting function does not change the fact that LiveDoc performs the configuring, not the text editor.

electronically and to configure the input device, and Ground 1 fails to make a *prima facie* case that claims 1-44 would have been obvious.

C. Because the LiveDoc Manager, and not the text editor, receives the user's selection of highlighting, LiveDoc and Drop Zones fail to disclose or suggest the claim limitation of "receipt by the first computer program of the user command from the input device", and therefore for this additional reason Ground 1 fails to establish a *prima facie* case of obviousness.

Independent claim 1 requires "receipt by the first computer program of the user command from the input device". This limitation of the claim explicitly requires the first computer program to receive the user command from the input device. We will demonstrate that in contrast to the claim, in LiveDoc and Drop Zones, the LiveDoc Manager and not the text editor receives the user command. Since the incorrect entity receives the user command, LiveDoc and Drop Zones fail to disclose or suggest "receipt by the first computer program of the user command from the input device", as required by claim 1. Indeed, this limitation is found in all the independent claims and hence is required by all of the claims challenged in Ground 1.

As discussed above in Section IV(B), Petitioners and Patent Owner agree that the text editor is the "first computer program", and Petitioners have further equated the displayed highlighting with the "input device". Further, in Petitioners'

discussion of section 1e of claim 1, which includes the limitation of the "user command", Petitioners equate this limitation with the user selection of the highlighting: "When the user selects a highlighted structure (an input device) the system determines the related actions that can be performed (initiates an operation). See, e.g., Drop Zones at 60 ("When an object is selected, it is sent to the Drop Zone control system…)". See Petition, page 13. The Petitioners do the same regarding section 1h, which includes the claim limitations of interest: "As discussed in claim le, when a user selects a highlighted structure the system determines the related actions that can be performed". See Petition, page 15.

Petitioners fail to point to anything in LiveDoc and Drop Zones disclosing or suggesting that the purported first computer program, the text editor, receives the user selection of highlighting. When the Petitioners apply LiveDoc and Drop Zones to section 1h, their analysis fails to address how the user selection is received. *Id*. Further, nowhere do the Petitioners even mention the text editor. *Id.* Petitioners' analysis of section 1h ignores the first clause, "in consequence of receipt of the first computer program of the user command from the input device", and focuses exclusively on the second clause, "causing a search: "As discussed in claim le, when a user selects a highlighted structure the system determines the related actions that can be performed. This determination is made by performing the search discussed in claim lf - *e.g.*, searching an address book (information

source) using an address book application (second computer program) to find the email address associated with an identified name. See, e.g., Drop Zones at 61 (`When objects are selected, they are inspected by the assistants in the Drop Zone. These assistants are built around a collection of facts and axioms that determine whether and how they can operate in some meaningful way on various kinds of objects.'). See also claims le and 1f". See Petition, page 15.

In fact, the LiveDoc Manager, not the text editor, receives the user selection of highlighting. LiveDoc explicitly states that the LiveDoc Manager receives the selection of a highlighted item: "The LiveDoc Manager also controls the events that occur…when the mouse button is pressed while over a LiveDoc item. The LiveDoc Manager also receives the notification that the mouse button has been pressed over a highlighted item". Exhibit 1006, page 56.

Additionally, in LiveDoc, the section titled "LiveDoc: Beyond Data Detectors" describes how the LiveDoc Manager functions; the last paragraph of this section states "What is described above is, of course, only a general design for LiveDoc". *Id*. at 55. In this section, LiveDoc describes how "[p]ointing at a highlight and pressing a mouse button then displays the menu of actions that can be applied to the structure, as shown in Fig. 2". *Id*. LiveDoc thus teaches that displaying menus of action in response to user selection of a highlighted item is part of the LiveDoc Manager's design and consequently, they must be features

within the LiveDoc Manager itself. Since the LiveDoc Manager performs an action (i.e., displays a menu) in response to a user action (i.e., selecting a highlighted item), the LiveDoc Manager necessarily receives the user action itself.

Likewise, with respect to Drop Zones, Drop Zones teaches that the LiveDoc system and not the text editor receives the user selection of highlighting. The Petitioners selectively quote Drop Zones: "See, e.g., Drop Zones at 61 ('When objects are selected, they are inspected by the assistants in the Drop Zone. These assistants are built around a collection of facts and axioms that determine whether and how they can operate in some meaningful way on various kinds of objects')", seemingly implying that the Drop Zones assistants receive the user selection of the highlighted structure. However, a further inspection of the Drop Zones reference reveals that "An interaction with the Drop Zone interface is shown in Figures 1 and 2. The window named 'test' in Figure 1 belongs to a LiveDoc-enabled word processor, LiveSimpleText (see [6]), and shows a number of structures within the document in view having been recognized by the analyzers". Exhibit 1006, page 60. "Consider Figure 2, in which the user has selected the structure Tom Bonura, which LiveDoc has identified with its personalName recognizer. When an object is selected, it is sent to the Drop Zone control system". *Id.* Clearly then, it is the LiveDoc system functionality that receives the user selection of the highlighted structure, and only then it sends it to the Drop Zone control system. Therefore, the

user command, defined by the Petitioners as the user selection of the highlighted structure, is not received by the first application, i.e. the text editor, but by the LiveDoc system.

Furthermore, in Drop Zones, selecting an object (structure), does not initiate an operation as required by the claim, but simply, as admitted by the Petitioners, sends the object "to the Drop Zone control system. Each of the assistants determines if it is able to accept and act upon the set of currently selected objects". *Id*. Only after the user has selected an assistant and an action is the operation initiated. *Id*. ("These assistants make their capabilities visible when the user selects various structures identified by LiveDoc and drags them to the assistants."). Thus, the Petitioners' analysis of the user command for the Drop Zones reference, furthermore fails because the user command does not initiate an operation as required by the claim, but simply, as admitted by the Petitioners, sends the object "to the Drop Zone control system. Each of the assistants determines if it is able to accept and act upon the set of currently selected objects". *Id*.

Nor can it be argued that it is the Drop Zones "assistants" that receive the user command as required by the claim. Drop Zones states that the "assistants" that receive the dropped items are all part of Drop Zones: "[t]he window labeled *Activities* is a Drop Zone interface to a set of interpreters or `assistants.' Each of these assistants, *E-mail*, *Telephony*, *Finance* and *Appointment*, implements a

knowledge base that can operate on appropriate sets of LiveDoc structures" (emphasis added). *Id*. Therefore, when the user drops a selected highlighted item on a Drop Zone "assistant", Drop Zones receives the command to process the highlighted item with the "assistant". Therefore, Drop Zones receives the user command.

For at least the forgoing reasons, the LiveDoc Manager in LiveDoc receives the user command, and the LiveDoc system of Drop Zones in the Drop Zones reference receives its respective user command. Neither reference describes the text editor, which Petitioners have equated with the "first computer program", as receiving the user command from the input device. As a result, both LiveDoc and Drop Zones fail to disclose or suggest "receipt by the first computer program of the user command from the input device", as required by independent claim 1 and therefore for this additional reason Ground 1 fails to make a *prima facie* case of obviousness.

D. Because Miller fails to disclose how the "Detect Structures" button is configured, Miller fails to disclose or suggest "providing an input device, configured by the first computer program", and therefore Ground 2 fails to establish a *prima facie* case of obviousness.

As discussed above, all of the claims require "providing an input device, configured by the first computer program". This claim limitation requires the first

computer program to configure the input device. However, Miller is silent regarding the manner in which the input device is configured. Therefore, Miller fails to describe the first computer program as configuring the input device. Petitioners effectively concede this deficiency in Miller, arguing that it would have been obvious for the first computer program in Miller to configure the input device. Petitioners rely on their expert's testimony for this point, but this testimony regarding the state of the art contradicts Miller's teachings. Therefore, the testimony of Petitioners' expert should be disregarded. As a result, Miller fails to disclose or suggest "providing an input device, configured by the first computer program", as required by the claims.

Turning now to Petitioners' arguments, Petitioners equate the application 167, a word processor, with the "first computer program" and the detect structures button 520 with the "input device". When applying Miller to section 1b of claim 1, "displaying the document electronically using the first computer program", Petitioners note that the application 167 performs the displaying: "Documents are displayed using a first computer program, such as a word processor (application 167 in Fig. 1)". See Petition, page 25. When applying Miller to section 1e of claim 1, "providing an input device, configured by the first computer program", Petitioners note that the detect structures button 520 receives user input: "The `detect structures' button 520 in Fig. 5 is an input device that allows the user to

enter a command to initiate the parsing operation. See, e.g., 5:22-37[.]" See Petition, page 26. Therefore, under Petitioners' interpretation of Miller, for Miller to fulfill the requirements of the claim limitation, the application 167 must configure the detect structures button 520.

The Petition fails to explain how the word processor in Miller configures the detect structures button 520. Nowhere does the Petition cite to passages in Miller that support this position. In fact, in Petitioners' analysis of "providing an input device, configured by the first computer program", Petitioners do not even mention configuration. Instead, their analysis for section 1e merely identifies the detect structures button 520 as the "input device:" "The `detect structures' button 520 in Fig. 5 is an input device that allows the user to enter a command to initiate the parsing operation". See Petition, page 26. Instead of relying on Miller's disclosures, Petitioners turn to their expert to discuss how configuration purportedly occurs. See Petition, pages 26-27. In this manner, Petitioners concede that Miller does not disclose "providing an input device, configured by the first computer program", as required by claim 1.

Experts may testify on what a reference implicitly describes, namely, what one of ordinary skill in the art would understand from the teachings of the reference. However, these "implicit teachings" must be consistent with the reference's explicit ones. If the reference explicitly teaches certain features, an

expert cannot credibly suggest that one of ordinary skill in the art would understand the reference to teach or contemplate contradictory features. Nevertheless, that is precisely what the expert for Petitioners does.

In his testimony, Petitioners' expert claims that "[I]t would have been obvious for the word processor program 167 to provide an interface, such as button 520, to receive a user command". Menascé Decl. 1, ¶71. "[I]t was well known to configure word processing programs to add GUI elements, such as additional menu options or button, to provide desired functionality". See Petition, pages 26-27. Here, Petitioners' expert emphasizes that configuring "word processing programs" (i.e., the application 167, or "first computer program") was well known. However, that is not what the claim limitation requires. The claim recites an "input device, configured by the first computer program". By focusing on configuration of the word processing program and not the detect structures button 520, the expert has directed his attention to the incorrect configuration process.

Regardless, the expert's testimony is still inconsistent with Miller's teaching. Although the expert has claimed that adding GUI elements to word processors was well known, applying this practice to Miller relies on a critical assumption: Miller must contemplate integrating the program 165 and the application 167. The expert envisions an embodiment in which the application 167 has been configured to

incorporate the program 165 so that it can offer the functionality of program165 as a feature.

This assumption is not supported by Miller. Nothing in Miller suggests that the program 165 is or could be integrated into the word processor 167. In fact, Miller teaches the opposite. Miller teaches that the program 165 and word processing application 167 are separate programs that execute simultaneously: "the program may be executed *during the run-time of another program*, i.e. the application which presents the document, such as Microsoft Word" (emphasis added). Exhibit 1007, col. 2, lines 42-44. Because the programs are separate, the program 165 and application 167 must communicate through the application program interface of program 165: "Since the program may be executed during the run-time of another program, *i.e.* the application which presents the document, such as Microsoft Word, an application program interface provides mechanisms for interprogram communications" (emphasis added). *Id.*, col. 2, lines 42-49.

Miller provides a few examples of how these separate programs communicate through the application program interface 230. For example, the program 165 uses this interface 230 to obtain information from the application 167 about the structures: "[A]fter identifying structures and linking actions, application program interface 230 [of program 165] communicates with application 167 to obtain information on the identified structures so that user interface 240 can

successfully present and enable selection of the actions". *Id*., col. 4, lines 1-5. In another example, the program 165 obtains a user's interactions with highlighted structures from the application 167: "User interface 240 communicates with application 167 through application program interface 230 to determine if a user has performed a mouse-down operation in a particular mouse-sensitive presentation region, thereby selecting the structure presented at those coordinates". *Id*., col. 4, lines 22-27. In this manner, instead of being integrated together, the program 165 and application 167 interact through a designated interface.

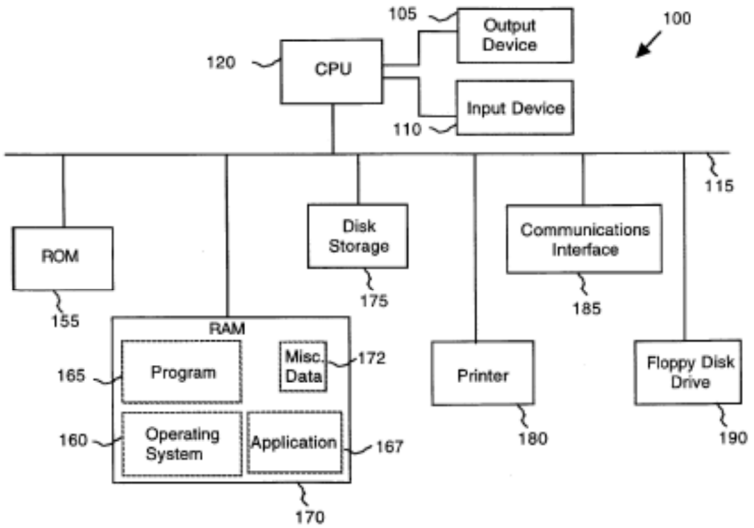


FIG. 1

Additionally, Miller consistently refers to the program 165 and application 167 as distinct entities. For example, in Fig. 1, Miller depicts the program 165 and application 167 as stored separately in random access memory (RAM) 170. Thus, Fig. 1 presents the program 165 and application 167 as discrete entities residing in different portions of the RAM 170. If the program 165 been integrated into the application 167, the program 165 would have appeared within the application 170 as a sub-entity.

In summary, Miller describes the program 165 and application 167 as separately executing entities, capable of communicating with one another via the program's 165 application program interface 230. Further, Miller describes the separate storage in memory of the program 165 and application 167. For at least the forgoing reasons, Miller's teachings indicate that the program 165 and application 167 are separate and distinct, not integrated together. Additionally, nowhere does Miller suggest that such integration is possible or advantageous. Rather, the motivation for such integration is provided entirely by the Petitioners' expert.

Since Miller presents the program 165 and application 167 as separate programs and is silent regarding benefits of their integration, Miller opposes the Petitioners' expert testimony contending that integrating structure detection into the word processor as an additional feature would have been obvious. In light of Miller's contradictions of the expert testimony's assumptions, Miller cannot be interpreted to suggest that the "first computer program", i.e. the word processor, configures the "input device", i.e. the detect structures button 520.

Furthermore, claim element 1e has additional requirements as to the "input device" required by the claims, not addressed at all by the Petitioners, namely that "the input device …allows the user to enter a user command to initiate an operation, the operation comprising (i) performing a search …" However, the

"Detect Structures" button, identified by the Petitioners as the "input device", does not initiate any search at all, but merely, at best, causes highlighting of the structures.

For at least the forgoing reasons, Miller fails to teach or suggest "providing an input device, configured by the first computer program", as required by the claims. Therefore, Ground 2 fails make a *prima facie* case that claims 1-44 would have been obvious based on Miller.

E. Because Miller's Program 165, and not the Application 167, receives the user's selection of the "detect structures" button, Miller fails to disclose or suggest the claim limitation of "receipt by the first computer program of the user command from the input device", and therefore Ground 2 fails to establish a *prima facie* case of obviousness.

As discussed in Section IV(C), all of the claims require the limitation "receipt by the first computer program of the user command from the input device". This limitation of the claims explicitly requires the first computer program to receive the user command from the input device. We will demonstrate that in contrast to the requirements of the claim, in Miller, the program 165 and not the application 167 receives the user command. Since the incorrect entity receives the user command, Miller fails to disclose or suggest "receipt by the first computer program of the user command from the input device", as required by the claims.

As discussed above in Section IV(D), Petitioners have equated application 167, a word processor, with the "first computer program" and the detect structures button 520 with the "input device". When Petitioners discuss of section 1h of claim 1, which includes the limitation of interest, the user selection of the detect structures button 520 must be the "user command" because it is the sole action mentioned in the analysis that is taken by the user: "When the user selects the `detect structures' button 520, a search is performed". See Petition, page 27.

The Petition points to nothing in Miller that discloses or suggests that the text editor receives the user selection of the detect structures 520 button. When the Petitioners apply Miller to section 1h, the manner in which the button selection is received is absent from their discussion. *Id*. Additionally, nowhere do the Petitioners even mention the text editor. *Id*. As with Petitioners' analysis of LiveDoc and Drop Zones, Petitioners' analysis of Miller with respect to section 1h ignores the first clause, "in consequence of receipt of the first computer program of the user command from the input device", and focuses exclusively on the second clause, "causing a search:" "Program 165 is a second program and includes analyzer server 220 that performs the search discussed in claim 1f". See Petitioner, page 27.

Miller indicates that the program 165, and not the application 167, receives the selection of the detect structures button 520. Since the program 165 performs

the namesake function of the detect structures button 520, the program 165 necessarily receives an instruction from the button 520: "The program 165 of the present invention is stored in RAM 170 and causes CPU 120 to identify structures in the data presented by application 167". Exhibit 1007, col. 3, lines 38-41. Further, Miller explicitly connects operating the button 520 with initiating the program 165: "Window 510 includes a [detect structures] button 520 for initiating program 165, although alternative mechanisms such as depressing the "option" key may be used. Upon initiation of program 165, system 100 transmits the contents of document 210 to analyzer server 220, which parses the contents based on grammars 410 and strings 420 (FIG. 4)". *Id.*, col. 5, lines 22-28. Because the detect structures button 520 initiates program 165, which, as pointed out above, executes independently, program 165 must receive an instruction to begin in response to a user selecting the detect structures button 520. Consequently, program 165 likely receives the user command. Nowhere does Miller disclose or suggest that the application 167 receives the user command and sends the user command to the program 165, via the application program interface 230, for the program 165 to begin executing. Therefore, in Miller, the program 165 and not the application 167 receives the user command.

Because Miller fails to disclose or suggest "receipt by the first computer program of the user command from the input device", as required by independent claim 1, Ground 2 fails to establish a *prima facie* case of obviousness.

F. Because Miller searches within the document for strings or grammars, Miller fails to disclose or suggest "performing a search using at least part of the first information as a search term … in an information source external to the document", and therefore Ground 2 fails to establish a *prima facie* case of obviousness.

Independent claim 1 requires "performing a search using at least part of the first information as a search term … in an information source external to the document". This limitation poses at least two requirements that are not met by Miller. First, the limitation requires the performance of a search that uses a search term. Second, the search must be conducted "in an information source external to the document". We will show that Miller fails to disclose or suggest either of these limitations. Further, these limitations are found in all the independent claims and hence are required by all of the claims challenged in Ground 2.

Regarding the first requirement for performing a search, in Petitioners' analysis of the limitation in section 1f, Petitioners argue that Fig. 4 shows a phone number being found using a name. See Petition, page 27: "For example, in the bottom box with the identified name, the actions are "Write letter" or "Call person (retrieve #)". (Fig. 4, 420.) In order to call the person, the name must be searched

in an address book to retrieve the associated phone number, as contemplated in Fig. 4". Although the Petitioners allege that "the name must be searched in an address book to retrieve the associated phone number", there is nothing whatsoever in Miller that discloses an automated search of the address book. The description of Fig. 4, in col. 5, lines 6-17, fails to disclose a search. In fact in all of Miller, the word "search" is mentioned only in connection with searching the document. Exhibit 1007, col. 3, lines 61-64 ("Analyzer server 220 comprises one or more pattern analysis units, such as a parser and grammars or a fast string search function and dictionaries, which uses patterns to parse document 210 for recognizable structures"), col. 4, lines 58-64 ("fast string search function" in analyzer server 220), col. 6, lines 34-55 ("fast string search function" for detecting patterns in document), col. 6, lines 64-66 ("neural net for searching a graphical document 210" or "a musical library for searching a stored musical piece 210"), columns 7 and 8 (claims to "fast string search"). Miller discloses nothing about what happens if the user selects the action that is the subject of speculation by Petitioners. In fact, the action recites no search, and states, instead, "Call person (retrieve #)". The fact that the phrase "retrieve #" is in parentheses and no other action includes a phrase in parentheses, suggests that the portion of the action "retrieve #" is in a different category from other actions, possibly because it is carried out manually.

Accordingly, there is nothing in Miller that discloses or suggests searching outside of the document. Even assuming that Miller were to implement such a functionality in the "Call person" action in Fig. 4 (though it does not), it would be the only action involving a search, and therefore this single search would fail to satisfy the claim requirement that "the specific type or types of second information is dependent at least in part on the type or types of the first information". The simple reason is that there would be only one type of first information (the name) and only one type of second information (the phone number). Moreover, there would be also only one action (since there is only one operation, namely "Call person (retrieve #)", and since there is only one action, the single action would fail to meet the claim requirement that "the action is of a type depending at least in part on the type or types of the first information".

Although it is not clear, the Petitioners may also attempt to equate structure detection with the "search": "Figs. 8-10 and 5:51-6:55 describe recognizing patterns and performing actions". See Petition, page 27. The pattern recognition referenced is finding grammars in the text of a document: "Parser 310 retrieves a grammar from grammar file 320 and parses text using the retrieved grammar". Exhibit 1007, col. 4, lines 62-64. However, the grammar file does not include the actual text of the structure, i.e. the actual telephone number, e-mail address. If the grammar repository were searched for the actual text of the structure (which Miller

does not do), the search would not yield any results. Therefore, the search for grammars is not "performing a search using at least part of the first information as a search term", as required by claim 1.

Regarding the second requirement for a search "in an information source external to the document", in Petitioners' application of Miller to this limitation, the sole entities that Petitioners identify as being "external to the document" are the dictionary (sometimes called "strings") and grammars of the analyzer server 220: "Analyzer server 220 includes dictionaries or `grammars' that are external to the document". See Petition, page 27.

In fact, Miller uses the grammars to parse the contents of a document to find structures, and obtains strings from the string library and searches for them in the document. Exhibit 1007, col. 3, lines 61-64. We will first discuss Miller's treatment of grammars and then his treatment of strings to show that in each case, they are applied to the document itself and fail to disclose or suggest "performing a search … in an information source external to the document", as required by claim 1.

Regarding "grammars", Miller says: "Parser 310 retrieves a grammar from grammar file 320 and parses text using the retrieved grammar". *Id*., col. 4, lines 62-64. Regarding the "dictionary" or "string library" (also called "name library"), in Fig. 10 of Miller, box 1070 recites the step "receive library of strings" and box

1080 recites the step "detect identical strings in data" (emphasis added). Miller elaborates by teaching that "[a]s illustrated in block 1060, a fast string search function retrieves 1070 the contents of string library 420, [and] detects 1080 the strings in the data identical to those in the string library 420" (emphasis added). *Id*., col. 6, lines 43-47. Miller also teaches that "[a]ssuming program 165 initiates with the receipt of any text, the received content or portion is scanned 820 for identifiable structures using the patterns in analyzer server 220". *Id.*, col. 5, lines 56-59. Miller also refers to a "fast string search" in the sting library. A fast string search is an algorithm in which one finds a string in a document, *i.e*., each entry in the dictionary is used in a search in the document (using the fast string search algorithm) to see if the string is in the document. In other words, it is the *text* in the document that is searched to identify *strings in the dictionary/string library*, not vice versa as required by the claim. Furthermore, the claims require *first* analysis, and in a *second step* using the result of the analysis as a search term. The purported searches regarding grammars and the dictionary/string library, would have been a part of this first step, analysis, and thus cannot also be used to satisfy the second step of the claim, namely the search.

Thus, Miller compares patterns (*i.e.*, strings, grammars) against the text of a document to determine if a pattern can be found therein. In this manner, Miller searches in the document for a pattern as a part of the analysis for structures. Thus,

Miller fails to disclose or suggest "performing a search using at least part of the first information as a search term … in an information source external to the document", as required by claim 1. For this additional reason, Ground 2 fails to make a *prima facie* case that claims 1-44 would have been obvious based on Miller.

G. Because the user informs the Luciw apparatus of the input's type of information, Luciw fails to disclose "analyzing, in a computer process, first information from the document to determine if the first information is at least one of a plurality of types of information", and therefore Ground 3 fails to establish a *prima facie* case of obviousness.

Independent claim 1 requires "analyzing, in a computer process, first information from the document to determine if the first information is at least one of a plurality of types of information that can be searched for in order to find second information related to the first information". Indeed, this limitation is found in all the independent claims and hence is required by all of the claims challenged in Ground 3.

In their application of Luciw to this limitation in section 1c, the Petitioners argue that Luciw analyzes a user entry in a smart field: "While the document is being displayed, the device in Luciw analyzes a user's entry (first information from the document) to determine if implicit assistance is possible and the kind of implicit assist indicated (determine whether first information can be used to find

second information). See, e.g., Figs. 3 and 4a; 10:15-20 (`If the entry in the smart field has been made by the user, the assistance process takes action to identify or recognize the kind of implicit assistance indicated at a step 154.'); 8:7-13 (`At step 104, the process recognizes whether or not an implicit assistance function is to be provided by computer system 10. … If a user does enter information into a `smart field,' the computer database will be queried at step 106 to determine whether assistance is possible given the user input.')". See Petition, page 38.

Although the claim limitation requires "analyzing…to determine if the first information is at least one of a plurality of types of information", the cited portions of the Luciw patent fail to disclose any such analyzing whatsoever. In fact, as we demonstrate in detail below, the cited portions of the Luciw patent show that the user must tell the computing device of Luciw what type of information – *e.g.*, a name – is being entered. Therefore, whatever is entered by the user into the specified field is used without any analysis.

Petitioners apply the "implicit" assistance of Luciw to the "analyzing" of the subject patent's claims. During "implicit" assistance, a user uses a smart field to enter a word that can be looked up in a database, or executes predefined events that result in a database query. Exhibit 1008, col. 8, lines 14-33. Fig. 6a depicts the smart fields in question. Regarding this interface, the Luciw patent states that "The phone slip window 170 in FIG. 6a is shown with a smart name field 175". *Id.*, col.

11, lines 46-47. As explained earlier in Luciw, in order to use a smart field, the user must select a name or phone field depending on whether the textual item that the user wants to be searched is a name or a phone number:

> Once the particular window 170 is presented to the user, the name ISAAC can be handwritten into the particular smart field 175.… As will readily be recognized, window 170 in FIG. 4b may contain several smart fields, in this case for example definable for either the "name" field 175 or a "phone" field shown at step 177.

Id., col. 10, lines 28-39.

This passage makes clear that in order to retrieve information from the database, the user is expected to enter a name into the name field 175 or a phone number into the phone field 177. Note that in Figs. 6a, 6b, and 6c the name field and the phone field are given the same item numbers, 175 and 177 respectively, as in Figs. 4b and 4c discussed above. Thus, by using a smart field, a user tells the computing device what type of information the user is entering. In fact, no analysis to identify the type of text is performed or needed: the system simply assumes a type (*e.g.*, a name) because the user entered text into the corresponding smart field. Since smart fields are designed for user characterization of the type of information that is being entered, the user tells the computer system what type of information is being provided as an input by virtue of the field that receives the text. Since the user already provides the type of information, Luciw need not and

does not perform any "analyzing...to determine if the first information is at least one of a plurality of types of information" (emphasis added).

Further, since each smart field corresponds to a predefined type, the computer system knows the type of information the user entered simply by the identity of the smart field that receives the entered text. The computer system does not analyze the user input itself. For example, when a user enters the word "Isaac" into the name field 175, the computer system assumes that it has received a name simply because the name field 175 received the text. *Id.*, Fig. 6b. Nowhere does Luciw teach that the computer system has analyzed the word "Isaac" to determine that it is a name. Because the computer system does not consider the content of the input at all, the content of the "first information" is irrelevant for determining its type. Rather, the computer system just assumes that the type of information matches the type for the smart field. Therefore, Luciw fails to disclose or suggest "analyzing...first information from the document to determine if the first information is at least one of a plurality of types of information" (emphasis added).

Luciw indicates that other methods can be used to initiate a search based on text entered by a user. Luciw indicates that other forms of implicit assists "can be triggered by the happening of any of a number of predefined allowable events". *Id.*, col. 8, lines 30-41. However, the sole example that Luciw describes is writing a particular word or indication outside of a particular smart field: "Certain kinds of

events on screen 52, for example, such as the writing of a particular indication or word on screen 52 outside of a particular smart field may trigger an implicit assist". *Id*., col. 8, lines 30-41.

The assumption appears to be that whatever "particular indication or word" is entered will be used by the device for "a query of the database at step 106" of Fig. 3. Indeed, an inspection of Fig. 3, which "is a flow diagram of a process according to the invention for providing controlled computer-assisted user assistance", fails to uncover any step of analyzing text in a document to determine whether text "is at least one of a plurality of types of information that can be searched for in order to find second information". *Id*., Fig. 3; col. 2, lines 65-67, and col. 8, line 1-col. 10, line 5. An inspection of Fig. 3 shows that the only instance wherein the database is queried is in step 106, and that step is preceded simply by a determination, in step 104, whether an "implicit assist" has been invoked, and the database query follows if the determination is that an "implicit assist" has been invoked. There is no analyzing step.

In summary, Luciw fails to disclose any mechanism for "analyzing, in a computer process, first information from the document to determine if the first information is at least one of a plurality of types of information". Rather, the user alerts the device as to the type of information that the user is inputting via selection of the appropriate smart field. Thus, the user informs the Luciw device of the type

of information, such as a name or phone number. Since Luciw fails to disclose each and every limitation of the subject patent's claims, Ground 3 fails to make a prima facie case for obviousness of claims 1-44.

H. Because Pandit's nouns and verbs are not the "types of information" contemplated by the claims, and, at best, the type of second information is decided by the user, and not dependent at least in part on the type or types of first information, Pandit fails to disclose or suggest "performing a search … wherein the specific type or types of second information [found] is dependent at least in part on the type or types of the first information [used as the search term]", therefore Ground 4 fails to establish a prima facie case of obviousness.

Independent claim 1 recites "performing a search … wherein the specific type or types of second information [found] is dependent at least in part on the type or types of the first information [used as a search term]". Indeed, this limitation is found in all the independent claims and hence is required by all of the claims challenged in Ground 4.

Petitioners attempt to apply two examples in Pandit to this limitation of the claim: searching a dictionary for a meaning of a word, and adding an identified telephone number to an address book. See Petition, pages 50-51. We will first address how searching a dictionary fails to meet this limitation, and in Section III(I), we will address how adding a telephone number to an address book also fails to meet the limitation.

The recited "search" of the subject patent's claims includes a number of requirements that are not met by obtaining a word's meaning. First, because the claim refers to the types of information for the first and second information, the "first information" and "second information" each must be of a specific type or types of information. We will show that the types of information used in the dictionary search as not the "type or types of information" contemplated by the claims. Second, the latter half of the limitation requires the type of the "second information" to depend upon the type of the "first information". We will show that even if Pandit's dictionary were to involve the types of information required by claim 1, which it does not, the type of word input into the dictionary program is irrelevant to the type of information obtained. Since dictionaries always obtain meanings of words, the dictionary necessarily retrieves the same type of information.

The first embodiment of Pandit that the Petitioners use detects nouns or verbs in a document. See Petition, page 51. To the best of Patent Owner's understanding, Petitioners appear to equate the detected noun or verb with the "first information". Since Petitioners cite a dictionary function for the "search", Petitioners equate the dictionary entry of the noun or verb with the "second information". Also, because the Petitioners reference executable programs in Pandit beyond the dictionary, other potential types of "second information" would

include synonyms of the word, the singular or plural version of a noun, or the conjugation of a verb. See Petition, page 51. However, the subject patent describes telephone numbers, fax numbers, and e-mail addresses as exemplary types of information. Exhibit 1001, col. 4, lines 12-14. In light of the specification, one of ordinary skill in the art would recognize that mere nouns and verbs are non-analogous to entities such as telephone numbers, fax numbers, and e-mail addresses. As such, one of ordinary skill in the art would not recognize nouns and verbs as the "types of information" contemplated by the claims. Therefore, the first embodiment of Pandit that Petitioners rely upon is inapplicable to the subject patent's claims.

Further, even if the entities in this embodiment of Pandit were "types of information", Pandit still fails to describe or suggest that the "specific type or types of second information is dependent at least in part on the type or types of the first information". Instead, the type of second information depends on the selection that a user makes from a pull-down menu of programs: "Where the invention is capable of recognizing nouns or verbs, pull-down menus can, for example, identify executable programs which provide the meaning of the highlighted word, appropriate synonyms and the singular or plural version of the noun or conjugation of the verb". Exhibit 1009, col. 3, lines 12-16. We note that Pandit fails to teach

how these identified programs operate. Nowhere does Pandit indicate that any of these programs "performing a search", as required by claim 1.

Regardless, the particular program that the user selects from the pull-down menu determines the type of information that Pandit will retrieve. Once the user selects a program, the system of Pandit obtains the type of information associated with that program, regardless of the type of information associated with the input. For example, if a user selects the dictionary program, the dictionary will retrieve the dictionary entry of a word, regardless of whether that word is a noun or verb. Likewise, if a user selects the thesaurus program, the thesaurus will retrieve the synonym entry of a word, regardless of whether that word is a noun or verb. Thus, the type of information that Pandit retrieves (e.g., the type of the "second information") is actually dependent on the user request for a program that obtains that particular type of information, not on the type of the information that is input to the program (e.g., the type of the "first information", such as a noun or verb).

For at least the forgoing reasons, Petitioners have failed to demonstrate that Pandit discloses or suggests "performing a search … wherein the specific type or types of second information [found] is dependent at least in part on the type or types of the first information [used as the search term]". Therefore, Ground 4 fails to make a prima facie case that claims 1-44 of the subject patent would have been obvious.

I. Because Pandit's does not disclose searching in the address book , Pandit fails to disclose or suggest "performing a search using at least part of the first information as a search term in order to find the second information" and "causing a search for the search term", and therefore Ground 4 fails to establish a *prima facie* case of obviousness.

We now turn to the second example of Pandit that Petitioners attempt to apply to the claimed "search:" adding an identified number to an address book. See Petition, page 51. Petitioners attempt to equate a telephone number with the "first information" and contact information associated with the telephone number with the "second information" based on Pandit's disclosure of "adding an identified number to an address book". See Petition, page 51. However, and as admitted by the Petitioners, Pandit only discloses adding a telephone number to an address book which does not require a search in the address book, and indeed Pandit does not disclose any such search. Pandit does not, contrary to the statements by Menascé, disclose ensuring that there are no multiple entries of the same address in the address book.

As with Miller, Petitioners cannot rely on text or figures within the four corners of Pandit to disclose all of the limitations of the subject patent's claims. Again, they resort to expert testimony to interpret Pandit in their favor: "[I]t would have been obvious to a person of ordinary skill in the art that the first step in adding to an address book is searching the address book to determine if an entry

already exists with this information and displaying any associated information which is located. (Menascé Decl. ¶99.) This would have been a matter of common sense to one of ordinary skill, in order to avoid multiple entries of the same address". See Petition, page 51. Therefore, Petitioners admit that Pandit fails to disclose "performing a search", but attempt to argue that this search "would have been obvious".

Petitioners cannot point to any teachings in Pandit that might lead one of ordinary skill in the art to this conclusion. Since Pandit does not describe any process by which its system adds e-mail addresses or telephone numbers to an address book, Pandit lacks any teachings from which one of ordinary skill in the art could deduce its operation. Instead, Petitioners rely on the subjective, and amorphous, basis of "common sense". However, in light of Pandit's silence, one of ordinary skill could just as readily use "common sense" to conclude that selecting the "Add to address book" option would cause the computer system to open the address book itself and create a new entry. Since nothing in Pandit teaches a search through the address book, Petitioners' argument is based on their importation of the subject patent's limitation into their understanding of the text.

Even assuming for the sake of argument that Pandit were to contemplate searching for duplicate entries, which he does not, such a search would still fail to meet the requirements of the claim. Suppose Pandit received a request to add a

telephone number to the address book. To determine if an entry for this telephone number already existed, Pandit would search its entries for the telephone number. Further, Pandit would be concerned only with finding the telephone number in its records, not with any other information. Therefore, a search for duplicate entries would be a search for "first information", not a search "in order to find the second information, of a specific type or types", as required by claim 1.

For at least the forgoing reasons, Petitioners have failed to demonstrate that Pandit discloses or suggests "performing a search using at least part of the first information as a search term in order to find the second information" and "causing a search for the search term". Therefore, Ground 4 fails to make a prima facie case of demonstrating that claims 1-44 of the subject patent would have been obvious.

CONCLUSION

For the foregoing reasons, Petitioners have failed to establish a reasonable likelihood of prevailing as to any claim of the '843 Patent, and *inter partes* review of claims 1-44 of U.S. Patent No. 7,917,843 should be denied.

Dated: March 12, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

It is certified that on March 12, 2014, copies of the Preliminary Response of the Patent Owner under 35 U.S.C. § 313 and 37 C.F.R. § 42.107 has been served on Petitioners as provided in 37 C.F.R. § 42.6(e) via electronic mail transmission addressed to the persons at the following addresses:

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Exhibit 6H

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Paper 33
Date Entered: June 9, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., GOOGLE INC., and MOTOROLA MOBILITY LLC,
Petitioner,

v.

ARENDI S.A.R.L.,
Patent Owner.

Case IPR2014-00208
Patent 7,917,843 B2

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and TREVOR M. JEFFERSON, *Administrative Patent Judges.*

BLANKENSHIP, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. BACKGROUND

Apple Inc., Google Inc., and Motorola Mobility LLC (collectively "Petitioner") filed a request for *inter partes* review of claims 1–44 of U.S. Patent No. 7,917,843 B2 ("the '843 patent") (Ex. 1001) under 35 U.S.C. §§ 311–319. *See* Paper 1 ("Petition" or "Pet."). On June 11, 2014, the

Board instituted an *inter partes* review of claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 on an asserted ground of unpatentability for obviousness. Paper 8 ("Dec. on Inst.").

Subsequent to institution, Patent Owner Arendi S.A.R.L. filed a patent owner response (*see* Paper 17, "PO Resp."). Petitioner filed a reply to the Patent Owner Response (*see* Paper 21, "Pet. Reply"). Patent Owner filed a motion to exclude evidence (Paper 24), Petitioner opposed (Paper 27), and Patent Owner replied (Paper 28).

Oral hearing was held on February 4, 2015.[1]

The Board has jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 of the '843 patent are unpatentable.

The Challenged Patent

The '843 patent relates to a computer program that receives information typed by a user into a document (as in a word processor) and searches an external source, such as a database, to determine if the typed information exists in the database. The computer program may add a user-selectable button to the word processor that causes execution of another program to receive the typed information and to search the database. Ex. 1001, col. 3, ll. 35–54. Consequently, the user does not have to learn how to use and have access to the database. *Id*. at col. 1, ll. 43–49.

Figure 3 of the '843 patent is reproduced below.

[1] The record includes a transcript of the oral hearing. Paper 32.

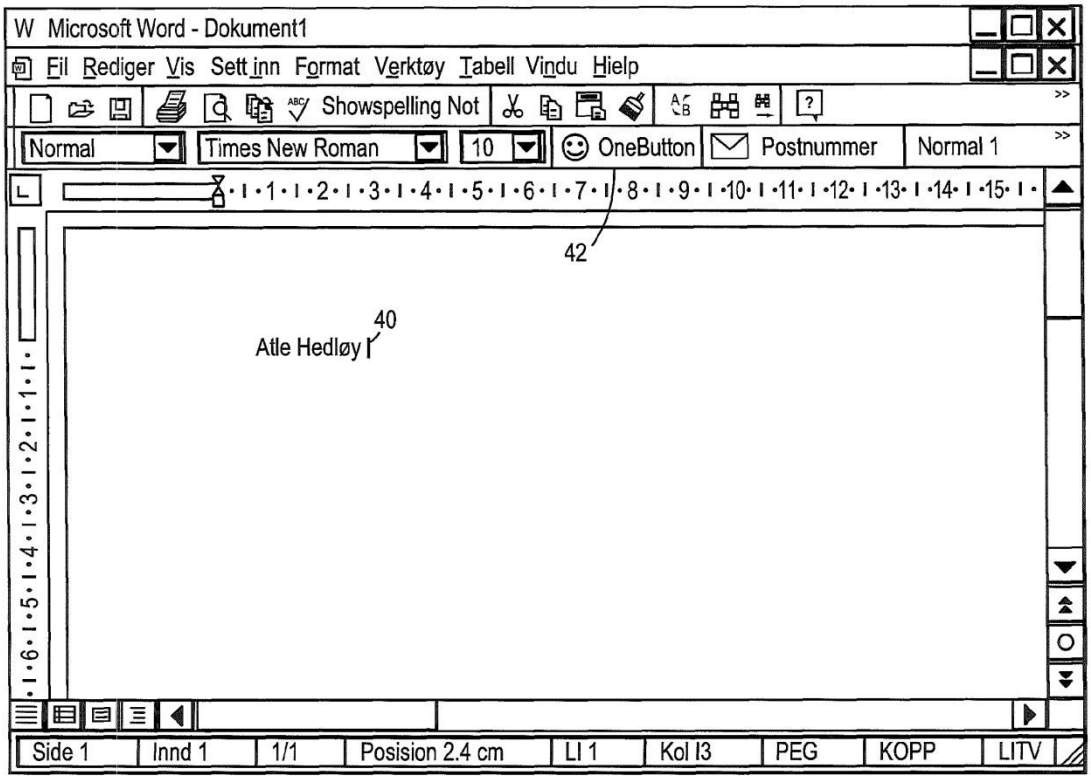

FIG. 3

Figure 3 is said to be a screen shot that illustrates the inputting of a name to be searched and an address handling button within a word processor. *Id.* at col. 2, ll. 51–54. The user has typed the name of an existing contact 40. The user selects button 42, marked "OneButton." In response, the program of the invention retrieves existing contact 40 from the document and searches a database for the name of the existing contact. *Id.* at col. 7, ll. 30–37.

Figure 4 of the '843 patent is reproduced below.

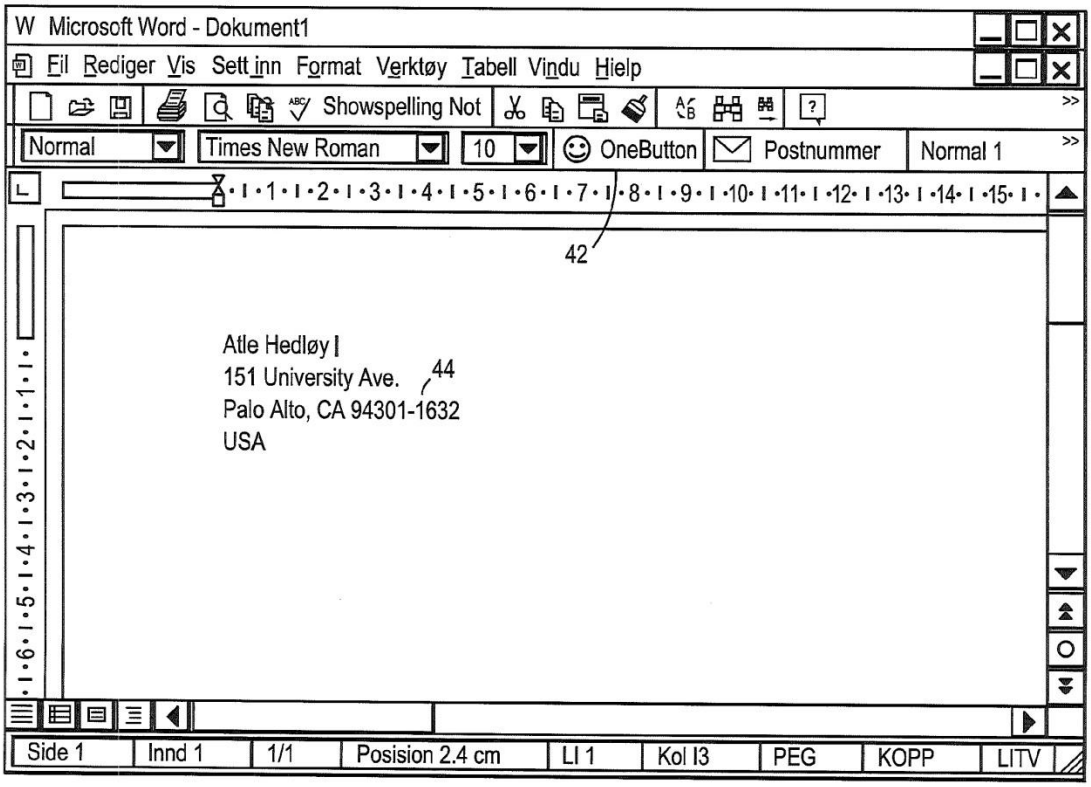

FIG. 4

Figure 4 is said to be a screen shot illustrating a retrieved address in a word processor. *Id*. at col. 2, ll. 55–57. The user has typed a name and new address of existing contact 44. The user selects "OneButton" 42 and the program of the invention retrieves existing contact 44 from the document and searches a database for the name of the existing contact. *Id*. at col. 8, ll. 13–19.

Illustrative Claim

1. A computer-implemented method for finding data related to the contents of a document using a first computer program running on a computer, the method comprising:

displaying the document electronically using the first computer program;

while the document is being displayed, analyzing, in a computer process, first information from the document to determine if the first information is at least one of a plurality of types of information that can be searched for in order to find second information related to the first information;

retrieving the first information;

providing an input device, configured by the first computer program, that allows a user to enter a user command to initiate an operation, the operation comprising (i) performing a search using at least part of the first information as a search term in order to find the second information, of a specific type or types, associated with the search term in an information source external to the document, wherein the specific type or types of second information is dependent at least in part on the type or types of the first information, and (ii) performing an action using at least part of the second information;

in consequence of receipt by the first computer program of the user command from the input device, causing a search for the search term in the information source, using a second computer program, in order to find second information related to the search term; and

if searching finds any second information related to the search term, performing the action using at least part of the second information, wherein the action is of a type depending at least in part on the type or types of the first information.

Related Proceedings

According to the parties, the '843 patent is involved in the following lawsuits: *Arendi S.A.R.L. v. Apple Inc.*, No. 1:12-cv-01596-LPS (D. Del.); *Arendi S.A.R.L. v. Motorola Mobility LLC*, No. 1:12-cv-01601-LPS (D. Del.); *Arendi S.A.R.L. v. Yahoo! Inc*., No. 1:13-cv-00920 (D. Del.); *Arendi S.A.R.L. v. Google Inc.*, No. 1:13-cv-00919 (D. Del.); *Arendi S.A.R.L. v. HTC Corp.*, No. 1:12-cv-01600 (D. Del.); *Arendi S.A.R.L. v. Sony Mobile Communications (USA) Inc.*, No. 1: 12-cv-01602 (D. Del.); *Arendi S.A.R.L. v. Nokia Corporation*, No. 1:12-2cv-01599 (D. Del.); *Arendi S.A.R.L. v. Blackberry Limited*, No. 1:12-cv-01597 (D. Del.); *Arendi S.A.R.L. v. LG Electronics Inc.*, No. 1:12-cv-015959 (D. Del.); and *Arendi S.A.R.L. v. Samsung Electronics Co. Ltd*., No. 1:12-cv01598 (D. Del.). According to Patent Owner, patents related to the '843 patent are or were involved in the following *inter partes* reviews: IPR2014-00206, IPR2014-00207, IPR2014-00203, and IPR2014-00214. The Board denied *inter partes* review in IPR2014-00203 and IPR2014-00214. The Board instituted trial in IPR2014-00206 and IPR2014-00207.

Prior Art

Pandit	US 5,859,636	Jan. 12, 1999	Ex. 1009

Asserted Ground of Unpatentability

The Board instituted *inter partes* review on the following asserted ground of unpatentability under 35 U.S.C. § 103(a) (Dec. on Inst. 19): claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 on the ground of obviousness over Pandit.

II. ANALYSIS

Claim Interpretation

Consistent with the statute and the legislative history of the Leahy-Smith America Invents Act (AIA), the Board will construe the claims of an unexpired patent using the broadest reasonable interpretation. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). The claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

Only terms which are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). Because the meaning of claim terms is not in controversy in this trial proceeding, we do not construe any claim limitations for purposes of this Final Decision.

Section 103(a) Patentability

Pandit

Each of the independent claims of the '843 patent recites "performing a search . . . wherein the specific type or types of second information [found] is dependent at least in part on the type or types of the first information [used

as a search term]." Petitioner submits (Pet. 50–51) that Pandit discloses performing a search in an information source external to the document, which is a further requirement of the claim. Petitioner submits that Pandit discloses adding an identified number to an address book. Pet. 51; Ex. 1009, col. 2, l. 56 – col. 3, l. 10, Figs. 1d, 1f.

Figure 1f of Pandit is reproduced below.

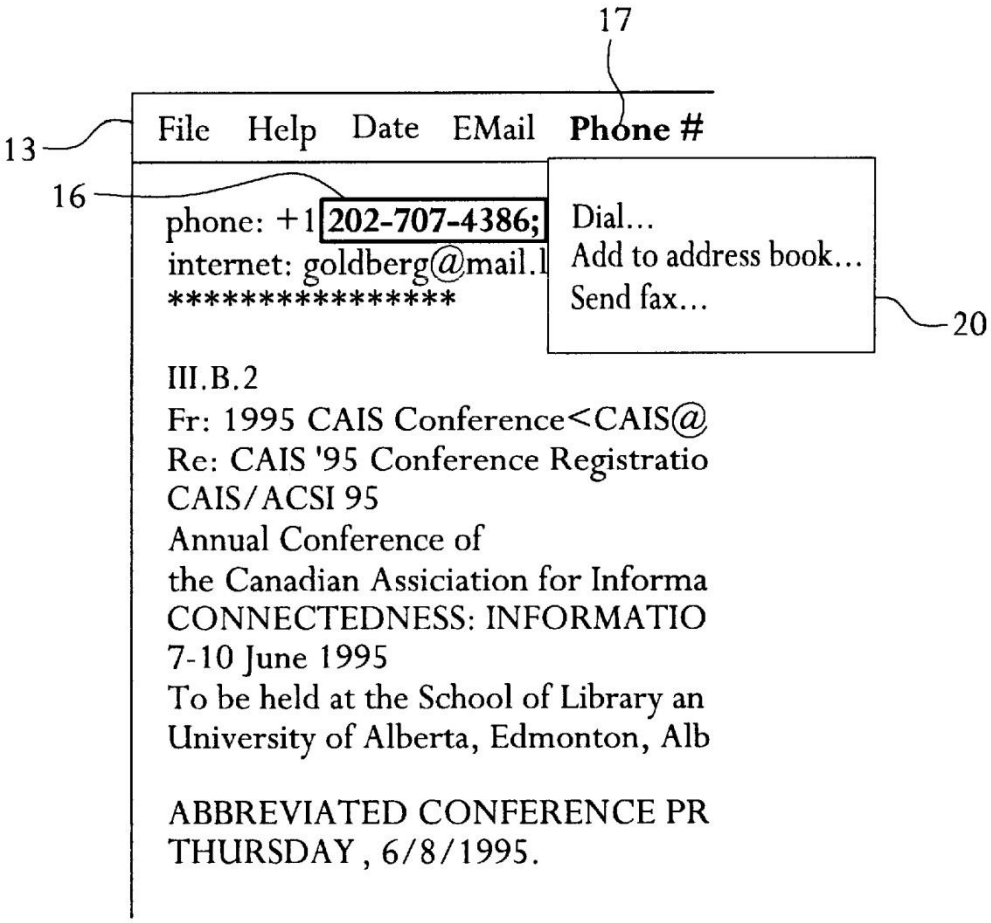

FIG. 1f

Figure 1f depicts a graphical representation of text on a video monitor. Ex. 1009, col. 1, ll. 59–60. The Figure shows that text (telephone number 16) has been selected by the user and highlighted. Pull down menu 17 ("Phone #") in menu bar 13 has been selected, yielding pulled-down menu 20. Links in pulled-down menu 20 allow the user to, for example, select the link "Add to address book. . ." in order to call a program to add the selected text (telephone number 16) to the address book. *Id.* at col. 2, l. 1 – col. 3, l. 10.

Petitioner applies the teachings of Pandit to the challenged claims. Pet. 48–55. In particular, Petitioner submits that Pandit discloses each limitation of illustrative claim 1 except for performing a search as specified in step (i) of the claim. Petitioner, however, submits further that in order to avoid multiple entries of the same address, it would have been obvious that the first step in adding to an address book is to search the address book to determine if an entry already exists with the entered information, and displaying any associated information that is located. *Id.* at 51. Petitioner refers to the Declaration of Dr. Menascé. *Id.* Dr. Menascé concurs:

> It would also have been obvious to a person of ordinary skill in the art at the relevant timeframe that the first step in adding to an address book is searching the address book to determine if an entry already exists with this information and displaying any associated information that is located. This would have been a matter of common sense to one of ordinary skill, in order to avoid multiple entries of the same address.

Ex. 1002 ¶ 99.

Pandit teaches further that, from pulled-down menu 20 (Ex. 1009, Fig. 1f), programs that can be called may include a writeable computer database of telephone and telefax numbers. *Id.* at col. 3, ll. 1–3. Dynamically linked

libraries may contain subroutines for implementing the invention with respect to telephone and telefax numbers. *Id*. at col. 4, ll. 20–31.

We find it reasonable to presume, as a matter of common sense and at the time of the invention, that the subroutine in Pandit would search for duplicate telephone numbers and, upon locating a duplicate entry, both the first information and associated (or second) information, such as the name and/or address associated with the telephone number, would be displayed to the user. A person having a bound paper address book would look first to determine if a potential new contact had been entered previously. A computerized search for duplicate entries would be a search "in order to find the second information, of a specific type or types," as claimed, in the same sense that the '843 patent's search is in order to find the second information. As shown, for example, in Figure 1 of the '843 patent, a name (first information) can be searched for in a database (12), and more than one possible contact or address (containing second information) may be found to match with the first information (18). Ex. 1001, Fig. 1. The first and the second information are displayed to the user for user action (20). *Id*. Searching a database for a telephone number in Pandit's system, and displaying results, would be no different in substance from searching a database for a name, and displaying results, in the disclosed example in the '843 patent. "What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 419 (2007).

Patent Owner's Response

Relying on the Declaration of Dr. John V. Levy (Ex. 2002), Patent Owner argues, with respect to Pandit, that a person of ordinary skill in the art would expect that a template would be displayed by which the user can enter the name of the party having the telephone number. PO Resp. 26. The search for duplicates would be conducted based on the name entered by the user rather than based on the telephone number. *Id.* at 27; Ex. 2002 ¶ 27.

Entry of a telephone number as depicted in Figure 1f of Pandit is, however, but one example of Pandit's teachings with respect to entry of data. *See* Pet. 50–51; Pet. Reply 14. Text including, for example, e-mail addresses, nouns, verbs, names, and street addresses can also be recognized. Ex. 1009, col. 2, ll. 24–31. Pandit at Figures 1c and 1d depicts recognition and entry of an e-mail address into an address book. Pandit teaches further that the entry may be made into a "general address book database." *Id.* at col. 2, ll. 57–61. Searching for duplicate names and displaying associated data also is within the scope of the claimed invention of the '843 patent, as exemplified in Figure 1 of the patent. If a possible duplicate in the database is found for the name, the found data is displayed to the user. Ex. 1001, col. 4, ll. 43–49, Fig. 1 (reference numerals 12, 18, 20).

Moreover, with respect to Pandit's Figure 1f example of entering a telephone number into an address book, we agree with Patent Owner that "'[a] telephone number stored in a database by itself is of little use.'" PO Resp. 25 (quoting Ex. 2002 ¶ 21). The address database must include information associated with the telephone number (e.g., a name) as opposed to consisting of a mere list of telephone numbers. Although a human being entering a contact into a paper address book would not be expected to search

for duplicate telephone number entries, it would have been obvious to the ordinary artisan to utilize a computerized search for duplicate telephone entries when entering a telephone number in an electronic address book database as taught by Pandit.

Patent Owner submits that products having Contacts databases that were introduced in 2013 and 2014 do not automatically search for duplicate entries when a new contact is entered. "[T]he contact application simply stores a new entry without checking for duplicates." PO Resp. 22. Patent Owner does not, however, provide a satisfactory explanation as to what relevance the allegation concerning more recent devices may have to what would have been obvious to one of ordinary skill in the art at the time of invention—on this record, November 10, 1998, the earliest-claimed priority date pursuant to 35 U.S.C. § 120. *See* Ex. 1001, col. 1, ll. 8–12. Further, Patent Owner does not allege that it *would have been non-obvious* in 2013 or 2014 to search for duplicate entries when entering a contact into a database.

The obviousness inquiry "not only permits, but *requires*, consideration of common knowledge and common sense." *DyStar Textilfarben GmbH & Co. v. C.H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1329 (Fed. Cir. 2009) (the obviousness analysis "may include recourse to logic, judgment, and common sense available to the person of ordinary skill that do not necessarily require explication in any reference or expert opinion"). Patent Owner argues, however, that "common sense" may only be applied when combining references that include all the required limitations, relying on *K/S HIMPP v. Hear-Wear Technologies, LLC*, 751 F.3d 1362, 1365 (Fed. Cir. 2014). PO Resp. 14–18.

In *Hear-Wear Technologies*, the United States Court of Appeals for the Federal Circuit determined that the Board did not err in requiring record evidence to support a third-party assertion that the structural features of "a plurality of prongs that provide a detachable mechanical and electrical connection" was a known prior art element. 751 F.3d at 1365. In this case, however, a claimed structural feature is not missing from the applied prior art. The conclusion of obviousness follows from a benefit that readily would have been apparent to one of skill in the art at the time of the invention. That benefit is provided by the mere retrieval and display of useful, pre-existing information to a user, using known methods.

"A person of ordinary skill is . . . a person of ordinary creativity, not an automaton." *KSR*, 550 U.S. at 421. Accordingly, the obviousness inquiry must take account of the "routine steps" that a person of ordinary skill in the art would employ. *Ball Aerosol & Specialty Container, Inc. v. Ltd. Brands, Inc.*, 555 F.3d 984, 993 (Fed. Cir. 2009). Patent Owner's expert admits that some database programs conduct a search for duplicates by default. Ex. 2002 ¶ 25; *see also* Pet. Reply 13. "[I]f a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *KSR*, 550 US at 417. We are not persuaded that retrieval and display of information was "uniquely challenging or difficult for one of ordinary skill in the art" (*Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418–19)).

Upon review of the Petition and supporting evidence, as well as the Patent Owner Response and supporting evidence, we conclude that

Petitioner has demonstrated, by a preponderance of the evidence, that claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 are unpatentable for obviousness over Pandit.

Patent Owner's Motion to Exclude Evidence

Patent Owner moves to exclude Exhibit 1013, which is the deposition transcript of Petitioner's expert, Dr. Daniel A. Menascé. Paper 24. Dr. Menascé was deposed by Patent Owner's counsel on August 7, 2014, for this proceeding and for proceedings IPR2014-00206 and IPR2014-00207. Ex. 1013, 1. Patent Owner submits that the transcript is irrelevant to this proceeding and that the information should have been submitted as a request by Petitioner for entry of supplemental information.

Although Petitioner does not appear to discuss or rely on any portion of the transcript in its Reply to Patent Owner's Response, Petitioner filed the Exhibit with its Reply. Petitioner argues that 37 C.F.R. § 42.53(f)(7) states that deposition testimony must be filed by its proponent as an exhibit. Paper 27, 3. Consistent with Petitioner's position, the rule recently has been clarified. *See* Amendments to the Rules of Practice for Trials Before the Patent Trial and Appeal Board, 80 Fed. Reg. 28,561, 28,563 (May 19, 2015) ("To clarify that either party is permitted to file testimony as an exhibit, the Office amends 37 CFR 42.53(f)(7) to delete the phrase 'by proponent' in the second sentence."). Because either party is permitted to file testimony as an exhibit, Petitioner's filing of the exhibit is proper. Because we do not consider or rely on any content of Exhibit 1013 in making our determinations in this Decision, Patent Owner's motion to exclude Exhibit 1013 is *dismissed* as moot.

III. CONCLUSION

Petitioner has demonstrated by a preponderance of the evidence that claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 of the '843 patent are unpatentable for obviousness over Pandit.

IV. ORDER

In consideration of the foregoing, it is

ORDERED that claims 1, 2, 8, 14–17, 20, 21, 23, 24, 30, 36–39, 42, and 43 of the '843 patent are *unpatentable*;

FURTHER ORDERED that Patent Owner's Motion to Exclude Evidence is *dismissed*; and

FURTHER ORDERED that, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2014-00208
Patent 7,917,843 B2

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Exhibit 6I

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Motorola Mobility LLC, Google Inc. and Apple Inc.,

Petitioners,

v.

Arendi S.A.R.L.,

Patent Owner.

Case No. IPR2014-00203

Patent No. 8,306,993

PATENT OWNER ARENDI S.A.R.L.'S PRELIMINARY RESPONSE

UNDER 35 U.S.C. § 313 and 37 C.F.R. § 42.107

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Statutes

EXHIBIT LIST

Arendi Exhibit Number	Description
2001	Third Supplement to Response H, filed November 3, 2011, for Serial No. 11/745,186, the application for the '993 Patent
2002	Miller and Bonura, "From documents to objects: An overview of LiveDoc", 30 SIGCHI Bulletin No. 2, 53-58.

I. INTRODUCTION

Patent Owner Arendi S.A.R.L. ("Arendi" or "Patent Owner") respectfully requests that the Board decline to initiate *inter partes* review of claims 1-24 of U.S. Patent No. 8,306,993 (the "'993 Patent") because Petitioners Apple Inc., Google Inc., and Motorola Mobility LLC ("Petitioners") have failed to show that they have a reasonable likelihood of prevailing with respect to any of the challenged claims. 35 U.S.C. § 314.

Petitioners have submitted proposed grounds for challenge based on anticipation or obviousness. However, for each proposed ground, at least one claim limitation is missing from the relied-upon reference or combination of references. Thus, Petitioners have failed to meet their initial burden to show that each element was known in the prior art.

II. OVERVIEW OF THE '993 PATENT

The '993 Patent is directed, among other things, to computer-implemented processes for automating a user's interaction between a first application, such as a word processing application or spreadsheet application, on the one hand, and a second application, such as contact management application having a database, on the other hand. In the '993 Patent, Exhibit 1001, Figs. 1 and 2 are flow charts showing for these interactions a number of scenarios, which are described from col. 4, line 55 to col. 6, line 12. Further details of the interactions are provided in

discussion thereafter of the other figures of the '993 Patent, and the discussion includes references back to relevant portions of the flow charts in Figs. 1 and 2. Fig. 1 is reproduced below.

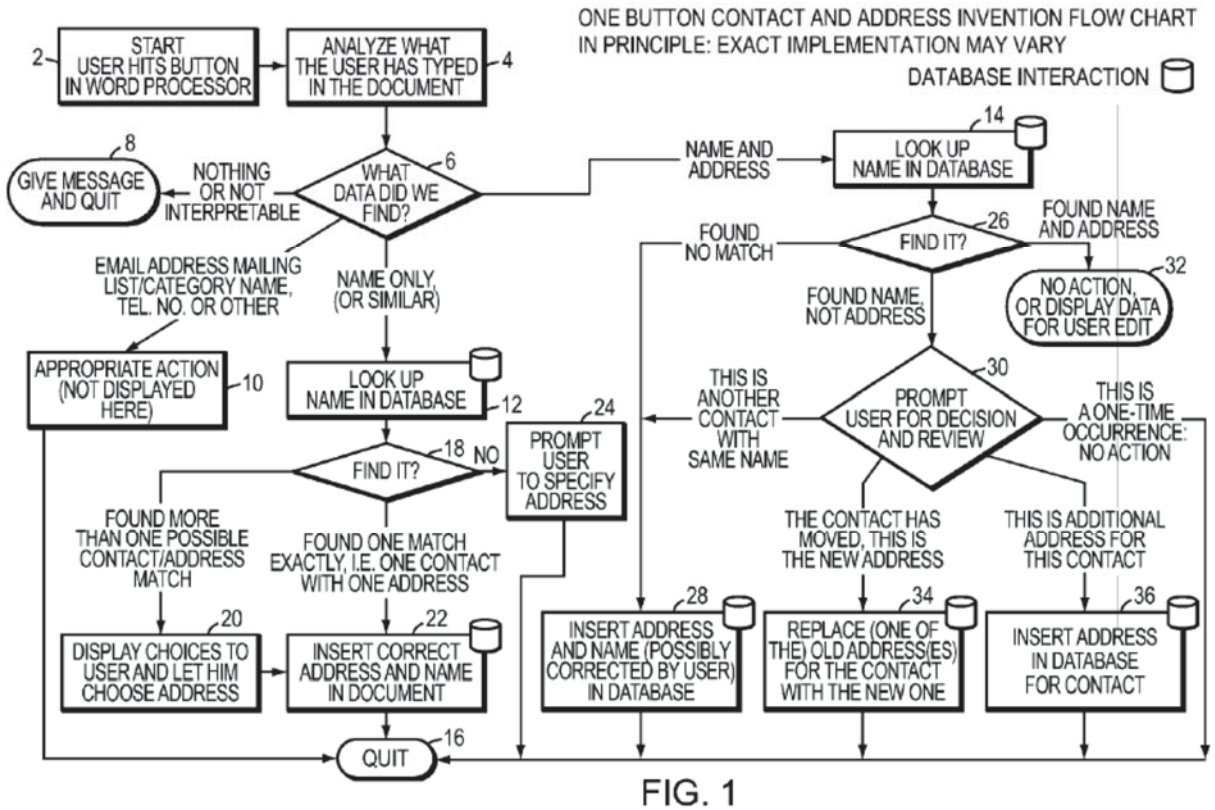

FIG. 1

In various scenarios, text in a document in the first application is analyzed (in step 2 of Fig. 1) to identify contact information. Exhibit 1001, col. 4, line 55 to col. 5, line 2. The analysis takes place without user designation of a specific part of the document to be subject to the analyzing. *Id*.

Once contact information has been identified, a number of different scenarios can follow, depending on the circumstances. In one scenario, if the identified contact information includes a name, a search is initiated in the database

associated with the second application for the name. *Id*., Fig. 1, steps 6, 12, and 14. If the contact information identified in the document included only a name, and if only a single entry is found in the database for the name and the entry includes a single address, then the address is inserted into the document. *Id*., Fig. 1, steps 6, 12, 18, and 22; Fig. 4; col. 6, lines 21-32. Fig. 4, which is reproduced below, shows the document displayed in Microsoft Word after the address has been inserted.

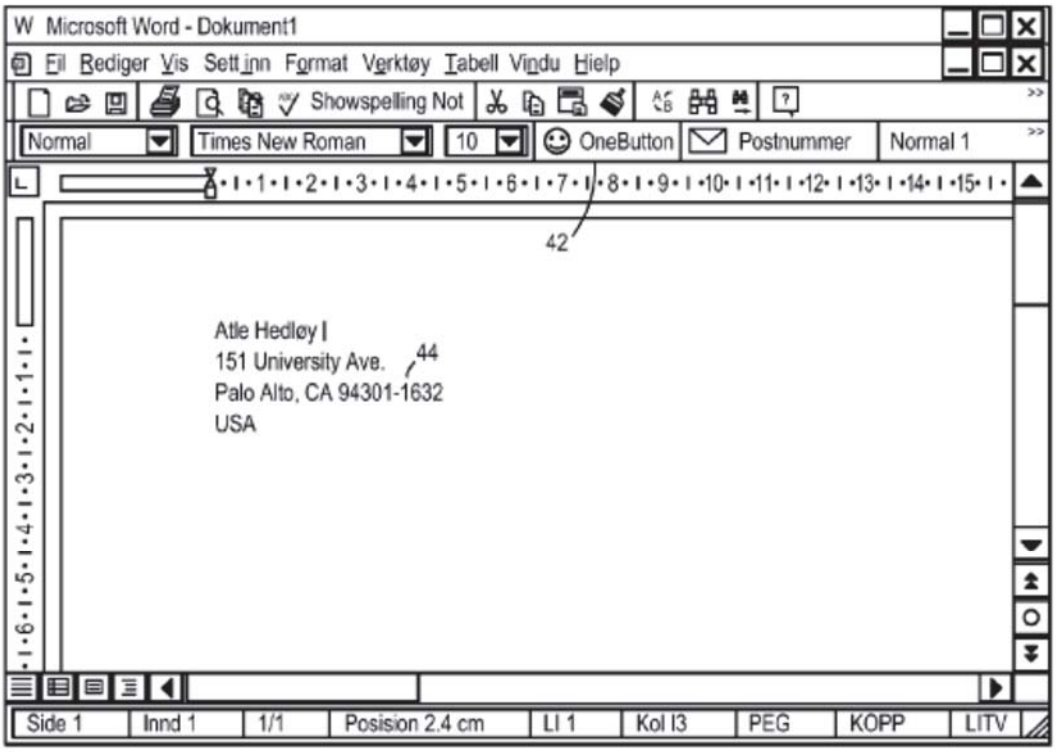

FIG. 4

Shown in Fig. 4 is the One Button 42, which, when pressed, launches the processes just recited, including analyzing the document to identify contact

information, the searching in the database, and inserting of the address. *Id*., Fig. 2, step 1; col. 4, lines 55-58; col. 6, lines 21-32.

On the other hand, if multiple addresses are found in searching the database for the identified name, these found addresses are displayed, and the user is presented with a choice of which of the addresses to insert. *Id*., Fig. 1, steps 18, 20, and 22; Fig. 10; col. 7, line 55 to col. 8, line 33.

In another scenario, when the user clicks on the "One Button" while viewing a document that includes a name and an address, the document is analyzed as before (per Fig. 1, step 4) to identify the name and the address. Next, the database is searched for the identified name (per Fig. 1, step 14). If the name happens to be in the contact database but the address in the contact database for that name differs from the address typed by the user into the document (per Fig. 1, step 26), then the user is prompted to make a choice (per Fig. 1, step 30). The user is presented with

a screen shown in Fig. 9, which is reproduced below.

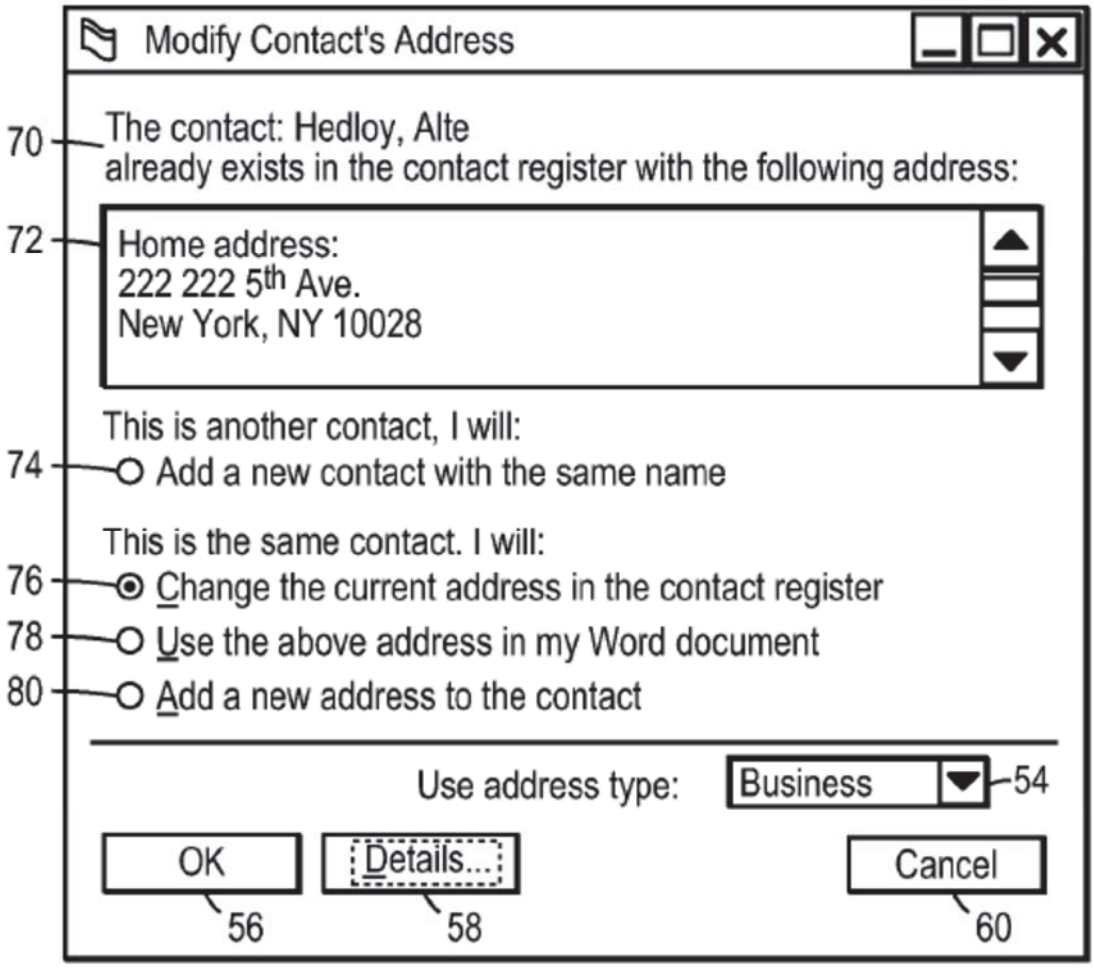

FIG. 9

Fig. 9 represents a screen presented to the user in which the user is given a series of choices that can be made in this specific context. *Id*., Col. 7, lines 27-51. The screen reproduces the name that is both in the document and in the contact database, and it also displays the address that is in the contact database for that name. Below this information, the screen offers a total of four choices in two categories. As shown in Fig. 9 and explained in the '993 Patent, the user is

enabled to select one of the four choices. *Id*. The first category is that "This is another contact", and the choice under this category is to "Add a new contact with the same name". The second category is that "This is the same contact", and the user is given three other choices for the contact: (a) "Change the current address in the contact register"; (b) "Use the above address [reproduced from the contact database] in my Word document"; and (c) "Add a new address to the contact".

These same four choices are also illustrated in connection with item 30 of Fig. 1 of the '993 Patent, which shows logical flow followed in described embodiments of the invention. Item 30 is labeled "PROMPT USER FOR DECISION AND REVIEW", and there are four outcomes shown from this item: (1) "THIS ANOTHER CONTACT WITH THE SAME NAME"; (2) "THE CONTACT HAS MOVED, THIS IS THE NEW ADDRESS"; (3) "THIS IS A ONE-TIME OCCURRENCE: NO ACTION"; and (4) "THIS IS ADDITIONAL ADDRESS FOR THIS CONTACT". These choices are described in the '993 Patent, col. 5, lines 26-37.

It can be seen that the first of the four choices is to add a new contact, and two of the remaining choices are specific ways of updating an existing contact. (Another choice offered is to do neither of these and simply use the address in the Word document as typed.) Consequently, the screen of Fig. 9 presents to the user

a choice, among other things, between competing alternatives of storing a new contact or updating an existing contact.

III. CLAIM CONSTRUCTION

In an *inter partes* review, the Patent Trial and Appeal Board gives patent claims their "broadest reasonable interpretation in light of the specification of the patent." 37 C.F.R. § 42.100(b); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*). The prosecution history is also relevant to identify the correct construction of claim terms. *Phillips v. AWH Corp.*, 415 F.3d at 1317. Extrinsic evidence may also be relevant to establish the meaning of terms, but such evidence is only relevant to the extent it is consistent with the specification and file history. *Id.*, 1319.

Patent Owner Arendi proposes construction of certain claim terms below pursuant to the broadest reasonable interpretation consistent with the specification standard. The proposed claim constructions are offered for the sole purpose of this proceeding and thus do not necessarily reflect appropriate claim constructions to be used in litigation and other proceedings wherein a different claim construction standard applies.

A. "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database" means presenting to the user a choice between competing alternatives of storing a new contact or updating an existing contact.

This phrase appears as one of three potential actions, in independent claims 1, 9, and 17, referenced in the limitation:

> after identifying the first contact information, performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing, wherein the set of potential actions includes:

In other words, these claims require (among other things), after textual information in the document has been analyzed to identify first contact information, "(iii) allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database".

A linguistic analysis of the phrase shows that the phrase requires allowing the user to make "a decision". The decision is "whether [1] to store at least part of the first contact information ... as a new contact or [2] to update an existing contact". The phrase therefore requires allowing the user to make a decision between competing alternatives of storing a new contact or updating an existing contact.

This limitation is supported in the '993 Patent by Fig. 9 and the discussion in the patent's description relating to Fig. 9. See '993 Patent, Exhibit 1001, Col. 7, lines 27-42, and the discussion of the '993 Patent in section II above. In particular, Fig. 9, shows a screen displayed to the user when the user clicks on the "One Button" after having typed into the document a name and an address, and the name happens to be in the contact database but the address in the contact database for that name differs from the address typed by the user into the document. Figure 9 is reproduced below again for convenience.

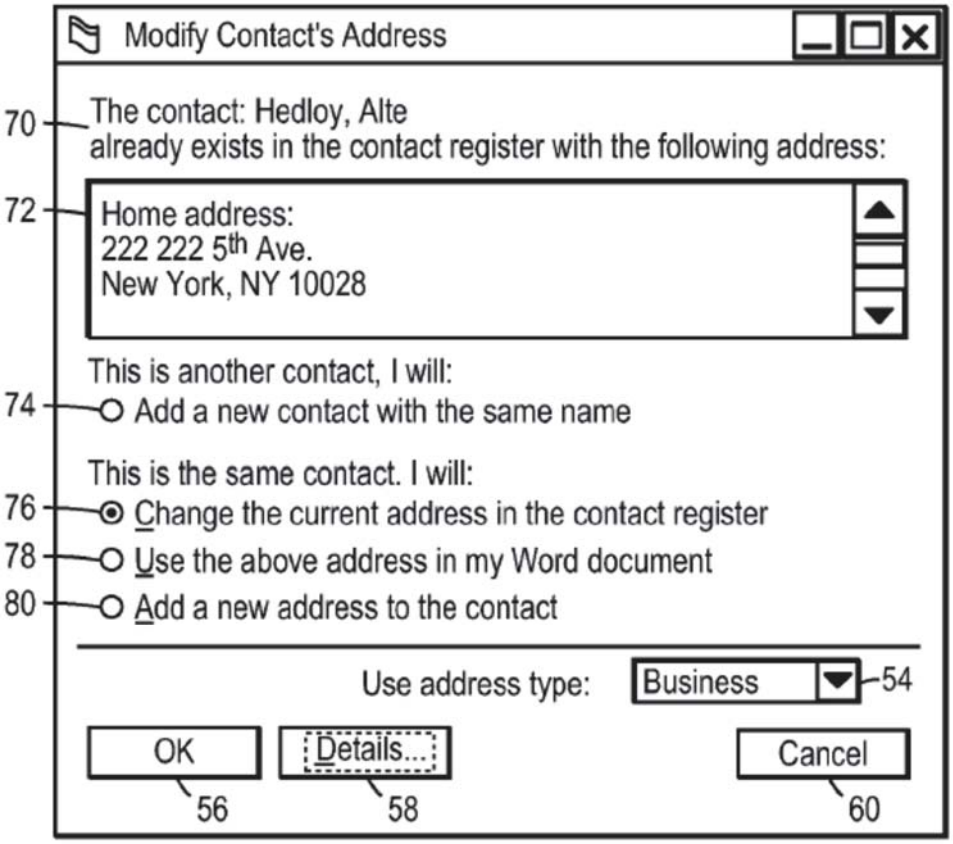

FIG. 9

As discussed in detail in section II, this screen gives the user a choice, among other things, between (1) adding a new contact or (2) updating an existing contact. Thus Fig. 9 is consistent with the linguistic analysis above that the phrase therefore requires allowing the user to make a decision between competing alternatives, storing a new contact or updating an existing contact. (See also the choices at item 30 of Fig. 1, discussed in section II, and described in the '993 Patent at col. 5, lines 26-37.) Specifically, since the '993 Patent is for a computer-implemented invention, the method, computer-readable medium, and apparatus of independent claims 1, 9, and 17 must have a computer process that includes presenting to the user a choice at least between competing alternatives of storing a new contact or updating an existing contact.

Moreover, when, in prosecution of the application for the '993 Patent, this phrase was inserted into the claim, Both Fig. 1 and Fig. 9, discussed above, were cited as support for the claim:

> Claims 119, 125, and 131 have been amended to require "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database." This amendment was previously offered in Response H, filed July 22, 2011. Support for this amendment can be found in Figure 1, numerals 28, 30, 34, and 36; Fig. 9; and page 9, lines 4-12 [corresponding to col. 5, lines 26-37 of the '993 Patent.]

Arendi Exhibit 2001, Third Supplement to Response H, filed November 3, 2011, for Serial No. 11/745,186, page 22.

The Petitioners argue that this phrase is ambiguous. "It could mean the user is allowed to make a decision between storing and updating, or that the user is allowed to make a "decision whether to store...or a decision whether to update." *Petition* at 10. However, the second construction offered by the Petitioners, "that the user is allowed to make a 'decision whether to store...or a decision whether to update'" is not supported the structure of the phrase, which is in the form "to make a decision whether to [X] or to [Y]". The word "decision" is in the singular and is followed by a single occurrence of the word "whether". The structure of the phrase makes clear that there is a single decision and it is between (at least) these two choices. By way of contrast, the phrase is *not* in the form "to make decision*s* *whether* to [X] or *whether* to [Y]", which would support the Petitioners' second construction—such a form puts "decision" in the plural and has two occurrences of the word "whether", one occurrence for each decision.

Besides ignoring the linguistic structure of the phrase, the Petitioners fail to take any notice of Fig. 9 and its accompanying text or of Fig. 1 at item 30 and its accompanying text, and Petitioners fail to take any notice of the procedural history, recited above, of the phrase. Given the rich context of the figures and description in the application, and the express reference to these figures and description in the

procedural history of the phrase, there is no reasonable basis for the Petitioner's second construction. There is no doubt that "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database" means presenting to the user a choice between competing alternatives of storing a new contact or updating an existing contact.

IV. OVERVIEW OF THE PRIOR ART

A. Overview of Drop Zones

Drop Zones, Exhibit 1006, is entitled "Drop Zones / An Extension of LiveDoc". Specifically, "Drop Zone provides users with an interface for managing LiveDoc objects in the context of a set of typical user tasks." Exhibit 1006, 30 SIGCHI Bulletin No. 2 at 60. Drop Zones is thus an implementation that uses the functionality of LiveDoc. (The authors of the Drop Zones article, Miller and Bonura, are the authors of the related article entitled "From documents to objects: An overview of LiveDoc" (hereinafter the "LiveDoc article", Patent Owner's Exhibit 2002), appearing in the same issue of SIGCHI Bulletin as their Drop Zone article, 30 SIGCHI Bulletin No. 2, 53-58**Error! Bookmark not defined.**: LiveDoc is discussed in section IV(B) below.)

Operation of the Drop Zone system uses Live Doc windows, as shown in Figures 1 and 2 of Drop Zones. The caption for Figure 1 states that "Drop zone is

shown in the window labeled 'Activities'. The window at the top called 'Test' is a LiveDoc window showing proper names, e-mail addresses phone number, URL, date and stock market ticker codes." Exhibit 1006, 30 SIGCHI Bulletin No. 2 at 60. Similarly in Figure 2 (reproduced below), which illustrates "A user interaction with Drop Zones", the same LiveDoc window is displayed. *Id*. To use Drop Zones, as discussed in connection with Figure 2, the user must first select a structure in a LiveDoc window. *Id*.

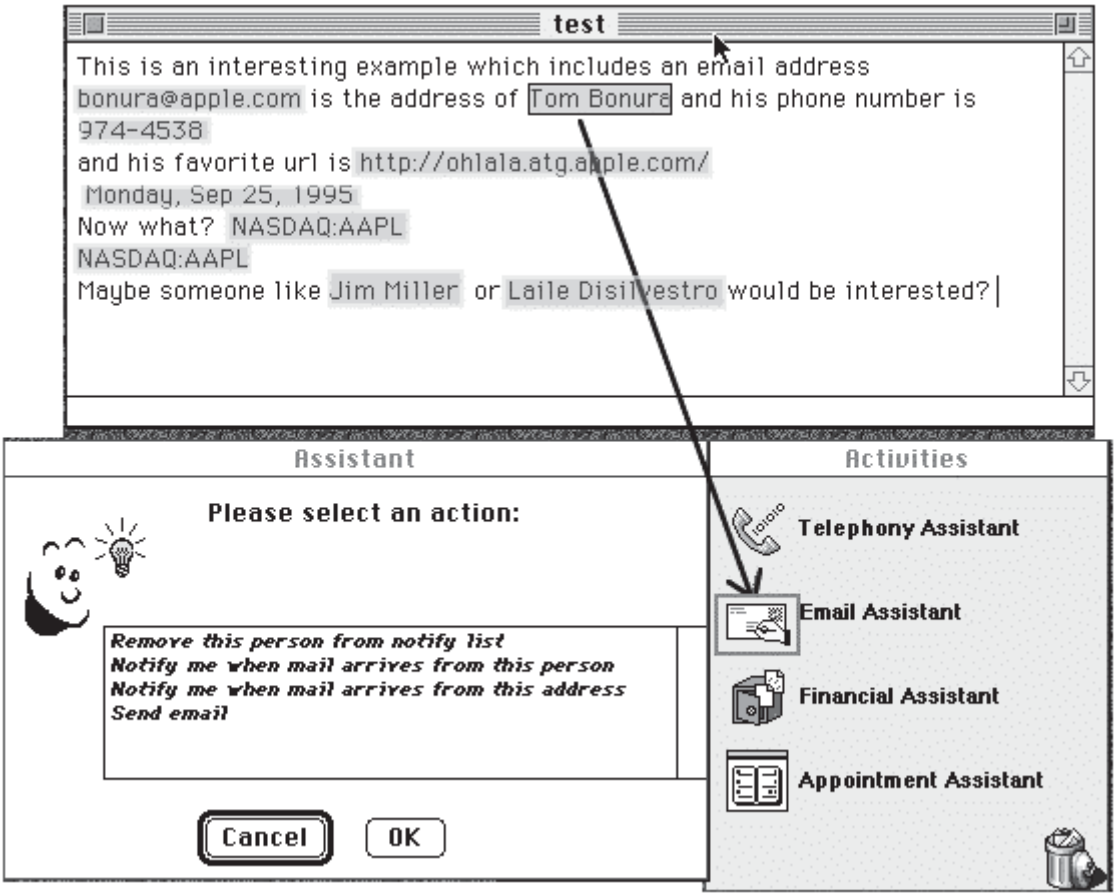

Figure 2: A user interaction with Drop Zones.

Specifically, to use the Drop Zone system, as described further below, the user must first enter "LiveDoc mode" by pressing and holding a function key in order to cause highlighting to be displayed over the document. Once "LiveDoc mode" has been entered, as shown in Fig. 2, the user uses the mouse to select an item of information that has been highlighted (here the name Tom Bonura) and (while still holding down the mouse button), then drags the selected item to the window labeled "Activities" over a desired category (here "Email Assistant") and then drops the selected name on the category (by releasing the mouse button). Dropping the item causes a menu of actions to appear in the Assistant window (shown to the left of the Activities window in Figure 2), and from that menu, the mouse is used to select a desired action. *Id.,* Exhibit 1006, 30 SIGCHI Bulletin No. 2 at 60-61.

Although the Drop Zones article does not explain how the LiveDoc window is invoked to show the information highlighted in it, the Drop Zones article points to the LiveDoc article. Citing the LiveDoc article (which is reference [6] therein), the Drop Zones article begins with a description of LiveDoc, explaining that LiveDoc reveals structural information in a document, such as a phone number or company names or a meeting, and then allows the user to invoke an action with respect to a recognized structure. Exhibit 1006, 30 SIGCHI Bulletin No. 2 at 59. The Drop Zones article explains that Drop Zones "is a framework centered on

representing the meaning of LiveDoc objects, composing those objects might into other higher-level objects, and enabling users to take action on those compositions." Exhibit 1006, 30 SIGCHI Bulletin No. 2 at 60.

As explained in Section IV(B) immediately below, because Drop Zones depends on the functionality of LiveDoc, when using Drop Zones, the structures identified by LiveDoc are not made visible to the user unless and until the user has entered an execute command by pressing and holding the function key. Only at that point can the Drop Zones interface be used to select an identified structure and to select an action for use with that structure.

B. Overview of LiveDoc

As mentioned in the Drop Zones article discussed above in section IV(A), to see highlighted structures in a LiveDoc window, the user needs to invoke "LiveDoc mode". The LiveDoc article explains that LiveDoc mode is invoked by pressing and holding the function key. Exhibit 2002, LiveDoc article, 30 SIGCHI Bulletin No. 2 at 56. By way of background, as shown by Figure 3 (reproduced below) in the LiveDoc article, the LiveDoc system operates outside of any application, such as a word processor. *Id*. at 55-56.

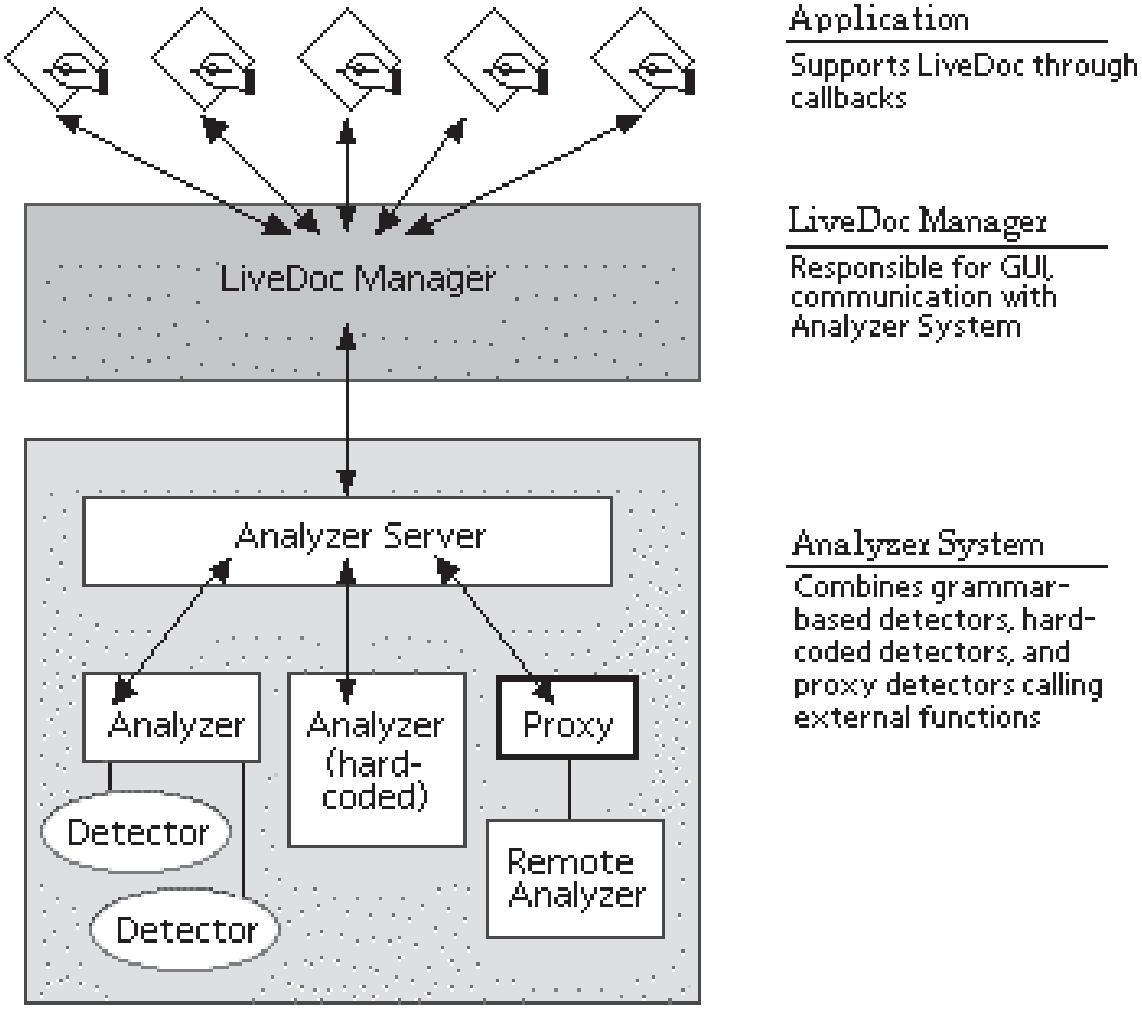

Figure 3: The high-level LiveDoc architecture.

As can be seen from the labels in the right-hand column in Fig. 3, the Applications (such as word processing) are shown separately from the LiveDoc Manager and from the Analyzer server. The article explains that the LiveDoc Manager "acts as an intermediary between the application making use of LiveDoc and the various internals of LiveDoc itself." *Id.*, Exhibit 2002, LiveDoc article, 30 SIGCHI Bulletin No. 2 at 55. Furthermore, "the Analyzer System is made up of a

set of detectors that analyze the content of the document passed to LiveDoc, a set of actions (typically, but not necessarily, implemented as AppleScripts) that carry out the various operations on the discovered structures, a table that specifies the mapping between detectors and actions, and an Analyzer Server that coordinates all these functions." *Id*. Since LiveDoc operates outside of the application, "LiveDoc must ask the application for the information about the structures it has found via a callback. Once this information is available, the highlights and their associated mouse-sensitive regions can be constructed." *Id*. Exhibit 2002, LiveDoc article, 30 SIGCHI Bulletin No. 2 at 56.

If one is viewing a document in a word processing program on a computer that is running LiveDoc, the structures identified by LiveDoc are not visible in the word processing program itself; instead one must first enter "LiveDoc mode" by pushing and holding the function key in order to see the structures: "The LiveDoc Manager also controls the events that occur when the user presses the function key to enter LiveDoc mode, and when the mouse button is pressed while over a LiveDoc item. The LiveDoc Manager updates the display to present the highlight information over the discovered structures when the function key is pressed, and to remove the highlights when the function key is released." *Id*.

C. Overview of Magnanelli

Magnanelli discloses a system "to reduce the work of an academic in finding and updating information about other researchers". P. 2, col. 1. The system includes a database that stores "person names and WWW addresses". P. 2, col. 2. The name identifies the research and the web address "is a general starting point for the agent to search for updates" to the information in the database. *Id.* "The database also stores general facts about persons such as title, address, photo and information about research activities including the titles of publications, URLs leading to abstracts or a publication file, project titles and URLs of pages containing further information on the project." *Id*.

The user of the Magnanelli system accesses the "database directly to retrieve and process information on academic contacts". *Id*. The system additionally provides an automated process, termed an "agent", that runs "to maintain the database and ensure its currency" . *Id*. The agent "runs in the background according to the periodicity specified by the user". *Id*.

While running in the background, the agent searches on the World Wide Web for information that may be used to update the database. P. 2, col. 2 to P. 3, col. 1. After searching the Web, the agent interacts with the database. Whenever the agent finds a relevant item of data, if the item has a confidence value over a user-specified threshold, then "the agent writes the fact in the database and records

this action in a log which the user may access to examine the agent's actions." *Id*. In other words, the agent operates in the background to update the database automatically whenever the item has a confidence value over the user-specified threshold. Only if the item has a confidence value below the user-specified threshold, "the agent will later consult the user who decides whether the fact will be stored or not." *Id.*

It can be seen that because the agent of the Magnanelli system runs in the background, there is no user command to cause the system to commence operation. In fact, the only user command that is even implied in the context of the Magnanelli system is when the item has a confidence value below the threshold and "the agent will later consult the user who decides whether the fact will be stored or not."

D. Overview of Luciw

Luciw describes logical processes, usable by a pen-based computer system that functions as a personal organizer, to provide "implicit or explicit assistance" for "user supportive information functions". Luciw, Exhibit 1003, col. 4, lines 14-18 (pen-based computer system); col. 2, lines 16-19 (implicit or explicit assistance).

The pen-based computer system has a database that can be queried. *Id*., col. 8, lines 31-34. Luciw describes "implicit" assistance, wherein a user has used a

smart field to enter a word used for look up in the database or has otherwise similarly triggered a database lookup, and "explicit" assistance, wherein the user explicitly invokes assistance from the device as by using pen 38 of Fig. 2. See *Id*., col. 8, lines 11-62.

The logical processes used by the Luciw device for providing implicit and explicit assistance are shown in Fig. 3 of Luciw. *Id*., col. 8, lines 2-6. A review of Fig. 3 shows that the database is queried in step 106 if it is determined in step 104 that there is an implicit assist. On the other hand, if in step 104 it is determined that there is not an implicit assist, and if further it is determined that there is an explicit assist, there is no database query, because the only database query indicated is in step 106, exclusively where there is an implicit assist.

As an example of implicit assist, Luciw provides Figs. 4b, 4c, 5, 6a and 6b, which describe use of a "smart field". *Id.*, col 10, line 23 *et seq*. (beginning discussion of smart fields in connection with Fig. 4b). According to Luciw, "[a] smart field is considered to be a predefined region on screen 52 of computer system 10 shown in FIG. 2, or a predefined region within a window which appears on screen 52". *Id*. col. 8, lines 16-19. Fig. 4b is reproduced below.

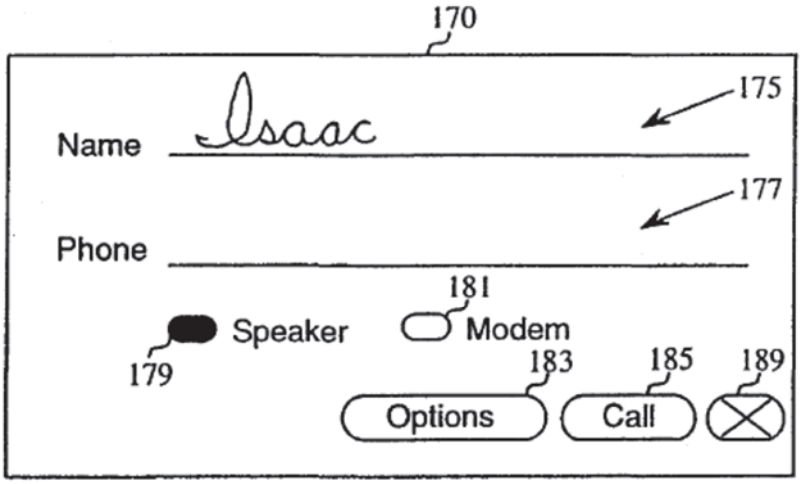

Figure 4b

According to Luciw, Fig. 4b "shows a phone slip window 170 with a smart name field 175 which has for example been evoked by either highlighting the verb 'call' or by simply writing the word on the display surface either before or after establishment of window 170." *Id*., col 10, lines 24-28. Operation of the phone slip window is explained in the lines thereafter in Luciw:

> Once the particular window 170 is presented to the user, the name ISAAC can be handwritten into the particular smart field 175. The assistance process recognizes the handwritten name "Isaac," and either continues operation as suggested at step 106 in FIG. 3 directly, or concurrently displays the recognized name in formal font form, as suggested in FIG. 4c, in the same position of the smart field, where formerly the handwritten name "Isaac" had been established. As will readily be recognized, window 170 in FIG. 4b may contain several smart fields, in this case for example definable for either the "name" field 175 or a "phone" field shown at step 177.

Id., col. 10, lines 27-39.

Because the user of the Luciw device uses the smart field to specify the field for which a database search is desired—a name in the name field 175 or a phone number in the phone field 177—the Luciw device uses the entered item to search for in the database for an item that has the same value for a corresponding attribute. *Id.*, col. 10, line 51 to col. 12, line 11.

E. Overview of Bates

Bates concerns "[a]pparatus, program products, and methods" that "implement various intelligent contact management operations to improve the productivity of users of electronic messaging systems and the like." Bates, Exhibit 1004, Abstract.

One of the features disclosed in Bates is intelligent name lookup, and a second feature is storing new contacts automatically. Bates explains these features: "A first intelligent management function is that of intelligent name lookup, where a favored user may be located from a contact database based upon a predetermined affinity criteria. A second intelligent contact management function that may be supported is that of the automated addition of new entries to a contact database based upon the number of contacts between users." *Id.*, col. 10, lines 22-29.

The intelligent name lookup procedure tracks past activity in order to establish these affinity criteria. Intelligent name lookup is implemented in a search routine, and affinity criteria influence the way results are displayed. *Id.*, col. 10, lines 42-51. In various embodiments, "affinity is determined based upon the number of contacts between the local user and the users found in the search. Contacts are typically monitored during certain operations performed in the electronic messaging system to determine the number of times certain activities occur with respect to a pair of users." *Id*., col. 11, lines 35-40.

For the purpose of these affinity criteria, the system of Bates uses an "update contact routine" after a user has accepted the displayed name, as discussed beginning at col. 12, line 41 and continuing to col. 13, line 13. Despite its name, the "update contact routine" does not update contacts in a local contact database. Rather, the update contact routine tracks "contacts between the local user and other users in the electronic messaging system so that the contact affinity therebetween may be determined." *Id*., col. 13, lines 15-18. At this point, at least optionally, an entry corresponding to the name is added to a "contact table" (which is an internal table used to count the number of interactions the user has had with a contact, see Bates Fig. 5 and col. 8, lines 7-10) if there is not such an entry already, and a count field for the entry is incremented by a value representative of the contact type.

When the count field has reached a threshold, the auto-add entry routine causes the name to be added automatically to the local database. *Id*., col. 13, line 21 to col. 14, line 17, and col. 15, line 1 *et seq*. ("Automated Addition of Entries to a Local Contact Database"). The name will be added if it is not present already. Col. 15, lines 30-34 ("If such an entry already exists, no further processing is required, and routine **152** terminates. However, if no such entry exists, control passes to block **184** to add an entry in the local contact database for the user by copying the corresponding entry from the master contact database"). Thus the Bates system adds new entries to the local contact database automatically, that is, without any input device or execute command.

F. Overview of Giordano

Giordano discloses a method and apparatus "for recognizing and accessing telephone numbers from a Web page." Giordano, Exhibit 1005, Abstract. Giordano discloses that the phone numbers recognized on the Web page "may be either automatically or manually stored in an address book for later use". *Id*., col. 2, lines 29-30, and col. 4, lines 57-67. However, Giordano fails to disclose, among other things, updating an existing contact in an address book.

V. SINCE THE PRIOR ART DOES NOT ANTICIPATE OR RENDER ANY CLAIM OBVIOUS, NO *INTER PARTES* REVIEW SHOULD BE INITIATED

A. Overview of Reasons for Denying Inter Parties Review

Petitioners have failed to show all any prior art alone or in combination to address all of the limitations of any of the independent claims. Each of the independent claims 1, 9, and 17 of the '993 Patent requires a computer-implemented method that is configured to perform each one of three potential actions involving a contact database. Each of the claims additionally requires performing at least one of these actions after identifying first contact information in a document, furthermore "providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing".

Drop Zones, relied upon by the Petitioners for this purpose, fails to meet the requirement "that a single execute command from the input device is sufficient to cause the performing". Drop Zones instead requires two execute commands, a first execute command (pressing and holding the function key) to enter LiveDoc mode to show highlighting of identified contact information and a second execute command (a series of mouse manipulations terminating in the user's selection of an action) to select an item of contact information and an action to be performed.

Each of the independent claims 1, 9, and 17 of the '993 Patent additionally requires "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database", Drop Zones in combination with Magnanelli, relied upon by the Petitioners for this limitation, similarly fails to meet this claim limitation, because these references fail to disclose or suggest presenting to the user a choice between competing alternatives of storing a new contact or updating an existing contact.

Luciw, in combination with Giordano and Bates, also urged to support this limitation, for similar reasons, fails to disclose or suggest this same limitation of "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database". In addition Luciw fails to meet the limitation of "analyzing in a computer process textual information in a document configured to be stored for later retrieval to identify a portion of the document as first contact information, without user designation of a specific part of the textual information to be subject to the analyzing", because in Luciw the user must tell the device explicitly what information and what kind of information should be the subject of a database search by writing the search term into a predetermined field, so as to make unnecessary any analysis as required by the claim. Finally, Luciw,

in combination with Giordano and Bates, fails to disclose or suggest the requirement "that a single execute command from the input device is sufficient to cause the performing".

B. Because an action can be triggered in the Drop Zones system only after entering two execute commands, Drop Zones fails to disclose "providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing", and therefore Ground 1 fails to establish a *prima facie* case for obviousness.

Independent claims 1, 9, and 17 include the limitation of "providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing". When the claims dependent on these independent claims are considered, then all of claims 1-24 include this limitation. The Drop Zones, Live Doc, and Magnanelli references relied upon by the Petitioners in Ground 1(see *Corrected Petition*, at 11) fail to disclose or suggest this claim limitation.

The "performing" in the claim limitation is from this context: "after identifying the first contact information, performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing." Each of the independent claims enumerates three potential actions, and requires that "the computer implemented method is configured to perform each one of action (i), action (ii), and action (iii)". The three actions are enumerated as follows:

(i) initiating an electronic search in the contact database for the first contact information while it is electronically displayed in order to find whether the first contact information is included in the contact database; and

when a contact in the contact database includes the first contact information, if second contact information in the contact database is associated with that contact, electronically displaying at least a portion of the second contact information, wherein the second contact information is at least one of a name, a title, an address, a telephone number, and an email address;

(ii) initiating electronic communication using the first contact information; and

(iii) allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database;

This claim limitation therefore requires an input device configured so that a single execute command from the input device is sufficient to cause the performing of at least one of these three listed potential actions, and the method is configured to perform each one of the actions.

Petitioner relies on Drop Zones, Exhibit 1006, as meeting this limitation. *Corrected Petition*, 30-31. Drop Zones, however, fails to meet the limitation of an input device configured so that a single execute command from the input device is

sufficient to cause the performing of at least one of these three listed potential actions. For the required input device the Petitioners cite "the use of the 'Activities' window comprising several 'Drop Zones' where a user can 'drop' the identified contact information to invoke the assistants' functionality via a single execute command." *Corrected Petition*, 30. In this context, an action is performed after a series of manipulations using a mouse to select, then drag, then drop the identified contact information on the desired Activities window, so as to cause a menu of actions to appear, and the mouse is further used to select the action from the menu. Exhibit 1006, 30 SIGCHI Bulletin No. 2, 60-61, including Fig. 2.

Assuming, as the Petitioners have asserted, that "the use of the 'Activities' window comprising several 'Drop Zones'" is the input device, then an execute command from that device is *necessary* to cause the performing, but it is not *sufficient* to cause to cause the performing, because an additional execute command is necessary to cause the performing.

We begin with the fact that Drop Zones, Exhibit 1006, is an "extension" of LiveDoc. (See Title of article: "Drop Zones / An Extension of LiveDoc" in Exhibit 1006.) Specifically, "[a] Drop Zone provides users with an interface for managing LiveDoc objects in the context of a set of typical user tasks." Exhibit 1006, 30 SIGCHI Bulletin No. 2 at 60. Drop Zones is therefore not a replacement of LiveDoc, but rather an implementation, built on top of LiveDoc, that requires

LiveDoc functionality. T hus in explaining Figure 1, the Drop Zone reference refers to LiveDoc functionalities: "The window named 'test' in Figure 1 belongs to a *LiveDoc-enabled* word processor, LiveSimpleText (see [6]), and shows a number of structures within the document in view having been recognized by the *analyzers*." *Id*. (emphasis added). A "LiveDoc-enabled" word processor manifestly requires the functionality of LiveDoc. Moreover, the Drop Zones article does not discuss "analyzers", because the analyzers are discussed in LiveDoc. The citation, in the quotation, to reference 6 is the related article by Miller and Bonura (the same authors as of Drop Zones) entitled "From documents to objects: An overview of LiveDoc", appearing in the same issue of SIGCHI Bulletin as their Drop Zone article, 30 SIGCHI Bulletin No. 2, 53-58.

Operation of the Drop Zone system explicitly uses Live Doc windows, as shown in Figure 1. The caption for Figure 1 states that "Drop zone is shown in the window labeled 'Activities'. The window at the top called 'Test' is a LiveDoc window showing proper names, e-mail addresses phone number, URL, date and stock market ticker codes." Exhibit 1006, 30 SIGCHI Bulletin No. 2 at 60. Similarly in Figure 2, which illustrates "A user interaction with Drop Zones", the same LiveDoc window is displayed. *Id*. To use Drop Zones, as discussed in connection with Figure 2, the user must first select a structure in a LiveDoc window. *Id*. and Drop Zones Figure 3.

In order to select a structure in a LiveDoc window, the user needs more than just the mouse, and must first and additionally press and hold the function key to enter "LiveDoc mode". *Id*., at 56. As discussed in further detail in section IV(B) above, and shown by Figure 3 in the LiveDoc article, the LiveDoc system operates outside of any application, such as a word processor. *Id*. at 55-56. If one is viewing a document in a word processing program on a computer that is running LiveDoc, the structures identified by LiveDoc are not visible in the word processing program itself; instead one must first enter "LiveDoc mode" by pushing and holding the function key in order to see the structures: "The LiveDoc Manager updates the display to present the highlight information over the discovered structures when the function key is pressed, and to remove the highlights when the function key is released." *Id*., at 56.

Because Drop Zones depends on the functionality of LiveDoc, the structures identified by LiveDoc are not made visible to the user unless and until the user has entered an execute command by pressing and holding the function key. Only at that point can the Drop Zone interface be used to select an identified structure and to select an action for use with that structure.

The claim limitation requires an input device configured so that a single execute command from the input device is *sufficient* to cause the performing of at least one of the three listed potential actions. The device identified by the

Petitioners—"the use of the 'Activities' window comprising several 'Drop Zones'"—is not *sufficient* to cause the performing because it is also necessary beforehand to enter another execute command by pressing and holding the function key in order to render the identified structures visible.

For at least these reasons, Ground 1 fails to make a *prima facie* case for obviousness of claims 1-24.

C. Because neither Drop Zones nor Magnanelli discloses "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database", Ground 1 for this additional reason fails to establish a *prima facie* case for obviousness.

As discussed in the immediately preceding section, independent claims 1, 9, 17 include the limitation "after identifying the first contact information, performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing." Each of the independent claims enumerates three potential actions, and requires that "the computer implemented method is configured to perform each one of action (i), action (ii), and action (iii)". One of those actions is:

> (iii) allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database;

The Petitioners have failed to identify anything in Drop Zones or Magnanelli that discloses or suggests this claim limitation. The Petitioners argue that Drop Zones "discloses allowing the user to **store** at least part of the first contact information in the contact database **as a new contact**" and that "Magnanelli discloses allowing a user to make a decision **whether to update an existing contact** in the contact database". *Corrected Petition*, 29 (emphasis in original).

However, even assuming that the points made by the Petitioners were correct, their argument fails to meet the claim limitation of "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database". As explained in section III(A), the user decision enabled by the claim limitation is not simply whether to update an existing contact (for which Magnanelli is cited) or whether to add a new contact (for which Drop Zones is cited). The user decision enabled by the claim limitation is whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database. Specifically, as discussed in section III(A), the claim limitation requires presenting to the user a choice between competing alternatives of storing a new contact or updating an existing contact.

Combining that which is attributed to Magnanelli with that which is attributed to Drop Zones does not establish the user decision required by the claim

limitation, because neither reference discloses or suggests that the user be given a choice between (1) storing at least part of the first contact information in the contact database as a new contact or (2) updating an existing contact in the contact database.

Because the Drop Zone and Magnanelli references fail to meet the claim limitation of "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database", for this additional reason, Ground 1 fails to make a *prima facie* case for obviousness of claims 1-24, which comprise independent claims 1, 9, 17 and the claims dependent on these independent claims.

D. Because Luciw's handling of a search input does not involve identifying the input as contact information, Luciw fails to disclose "analyzing in a computer process textual information in a document … to identify a portion of the document as first contact information, without user designation of a specific part of the textual information to be subject to the analyzing", and therefore Ground 3 fails to establish anticipation by Luciw.

Independent claims 1, 9, 17 include the limitation of "analyzing in a computer process textual information in a document configured to be stored for later retrieval to identify a portion of the document as first contact information, without user designation of a specific part of the textual information to be subject to the analyzing". In assertion of Ground 3, the Petitioners have failed to identify anything in Luciw that discloses or suggests this claim limitation.

The Petitioners argue (*Corrected Petition*, 39) that "[t]he method disclosed by Luciw includes the step of **analyzing textual information** in a document to identify a portion of the document as contact information. In Figures 6a-6c, the Luciw method recognizes entry of the term 'Isaac' as indicating a first name, which is then used to suggest last names for records of the contact database containing the first name 'Isaac.' *See also* Ex. 1003 at 11:60-12:6 (describing Figs. 6b and 6c). Ex. 1002 at ¶157."

Although the claim limitation requires "analyzing textual information in a document configured to be stored for later retrieval to identify a portion of the document as first contact information", the cited portions of the Luciw patent fail to disclose any such analyzing whatsoever. In fact, as we show in detail below, the cited portions of the Luciw patent show that the user must tell the computing device of Luciw that contact information—a name—is being entered. Moreover, the user tells the system exactly what part of the "document" is to be used by entering the text to be directly into the designated part of the screen; and thus no analysis to identify contact information is needed. Whatever is entered by the user into the specified field is used without any analysis. Moreover, since the user designates the contact information to be used by the Luciw device, even if the Luciw device were to analyze the "document" (which it does not), the Luciw

device fails to analyze the "document" without user designation of the text to be analyzed as required by the claim.

As discussed in further detail in section IV(C) above, the Luciw patent describes "implicit" assistance, wherein a user has used a smart field to enter a word used for look up in the database or has otherwise similarly triggered a database lookup, and "explicit" assistance, wherein the user explicitly invokes assistance from the device as by using pen 38 of Fig. 2. See Luciw, Exhibit 1003, col. 8, lines 11-62.

As to Fig. 6a, the Luciw patent states that "The phone slip window 170 in FIG. 6a is shown with a smart name field 175." *Id.*, col. 11, lines 46-47. As explained earlier in Luciw, In order to use a smart field, the user must select a name or phone field depending on whether the textual item that the user wants to be searched is a name or a phone number:

> Once the particular window 170 is presented to the user, the name ISAAC can be handwritten into the particular smart field 175. The assistance process recognizes the handwritten name "Isaac," and either continues operation as suggested at step 106 in FIG. 3 directly, or concurrently displays the recognized name in formal font form, as suggested in FIG. 4c, in the same position of the smart field, where formerly the handwritten name "Isaac" had been established. As will readily be recognized, window 170 in FIG. 4b may contain several

> smart fields, in this case for example definable for either the "name" field 175 or a "phone" field shown at step 177.

Id., col. 10, lines 28-39.

This passage makes clear that whereas the recognition achieved by the computing device of Luciw is of handwriting—namely translating a handwritten name into displayed text—nevertheless, in order to retrieve information from the database, the user is expected to enter a name into the name field 175 or a phone number into the phone field 177. Note that in Figs. 6a, 6b, and 6c the name field and the phone field are given the same item numbers, 175 and 177 respectively, as in Figs. 4b and 4c discussed above. Thus in using a smart field, a user is expected to tell the computing device what the contact information is, in what part of the "document" the contact information is located, and what type of contact information the user is entering—user designation is required, in contravention of the claim requirement that analyzing occurs "without user designation of a specific part of the textual information to be subject to the analyzing". In fact, no analysis to identify whether the typed text is "contact information" is performed: the system simply assumes that it is, *e.g.*, a name because the user told the system that it is a name by typing it into the name field. Moreover, it is a stretch of the imagination to characterize the forms displayed in Figs. 6a, 6b, and 6c as satisfying the claim requirement of a "document configured to be stored for later retrieval".

The Petitioners further argue that Luciw discloses that "[t]he analysis and identification of contact information can occur **without user designation of a specific part of the document."** *Corrected Petition* at 40 (emphasis in original), citing Exhibit 1003, col. 8, lines 31-43. Yet the cited passage says nothing about analysis and identification of contact information in a document; the entire passage reads as follows:

> However, implicit assist may be indicated not just by entry of an indication in a smart field, but by the happening of any of a number of predefined allowable events which lead to a query of the database at process step **106.** A user entry made into a smart field is not the only way computer system **10** is caused to undertake an implicit assist operation. Certain kinds of events on screen **52,** for example, such as the writing of a particular indication or word on screen **52** outside of a particular smart field may trigger an implicit assist. In general, implicit assist can be triggered by the happening of any of a number of predefined allowable events.

The passage says nothing about identifying contact information in a document. Nor does the passage even mention a document. The assumption appears to be that whatever "particular indication or word" is entered will be used by the device for "a query of the database at step **106**" of Fig. 3. Indeed, an inspection of Fig. 3, which "is a flow diagram of a process according to the invention for providing controlled computer-assisted user assistance", col. 2, lines

63-65, fails to uncover any step of analyzing text in a document to identify contact information. An inspection of Fig. 3 shows that the only instance wherein the database is queried is in step 106, and that step is preceded simply by a determination, in step 104, whether an "implicit assist" has been invoked, and the database query follows if the determination is that an "implicit assist" has been invoked. There is no analyzing step.

Petitioners make a similar argument, citing another passage of Luciw, that it discloses "the invocation of text analysis and explicit assistance without any user designation of a specific part to be analyzed." *Corrected Petition*, at 40, citing Exhibit 1003, col. 9, lines 30-35. The reference to "explicit assistance" by the Petitioners, when considered in relation to Fig. 3 means that the Petitioners are talking about operation of the Luciw device following step 110, which involves a determination whether an "explicit assist" has been invoked. We will show that there is no analyzing step associated with "explicit assistance".

In characterizing the steps after step 110 of Fig. 3, the Petitioners state: "While Luciw permits the user to select a portion for analysis when explicit assistance is desired [apparently referring to steps 130 and 132, wherein selected objects are entered into the Assistant], '[i]f no user selection has been made, objects entered since a delimiter are entered into the assistant in a step 133. Since no objects have specifically been selected, the objects to be entered into the

assistant are selected automatically by a delimiter process.'" *Corrected Petition* at 40, citing col. 9, lines 30-35.

The delimiter process is explained by Luciw in the following passage:

> An example of how the delimiter process can be accomplished, for example, involves the entry of only those objects on the screen **52** which are delimited in some fashion from the other objects which may have been entered on the screen. For example, if several paragraphs have been entered on the screen, only the last paragraph's objects will be considered for entry as objects into the assistant. Time may also be used as a delimiter. For example, if a considerable period of time separates a given object on the screen from another, only the most recent object will be entered into the assistant. The time threshold separating the particular objects may for example be a pre-set time-out.

Exhibit 1003, col. 9, lines 35-46. In other words, in the delimiter process the device simply selects as first information what was last entered by the user. In selecting as first information the information that was last entered by the user, the device provides a method for user designation of the first information. In contrast, the claim limitation requires "analyzing textual information in a document configured to be stored for later retrieval to identify a portion of the document as first contact information, without user designation of a specific part of the textual information to be subject to the analyzing". It is clear that none of the passages in Luciw identified by Petitioners disclose or suggest "analyzing textual information

… to identify a portion of the document as first contact information". It is similarly clear that the Luciw device requires user designation of contact information as the first information, and indeed in none of these passages is there a suggestion that there is even a document that may be subject to analyzing if analyzing were being performed.

Moreover, it should be noted that in Fig. 3, in the context of an "explicit assist" in step 110, none of the steps that follow step 110 include any query of the database at all. This means that in the context of an explicit assist there cannot follow the claimed potential action (i), because it requires a search of the contact database, and the claims require that the "method is configured to perform each one of action (i), action (ii), and action (iii)". Thus even if Luciw were to disclose analysis as required by the claim in connection with the explicit assist (which it does not), the first contact information found by this analysis would never be used in action (i), (ii), or (iii), as required by the claim, and thus Luciw still fails to disclose the necessary requirements of the claim. In any case, Luciw fails to disclose any analysis to determine if whatever the user entered is contact information as required by the claim, let alone what type of contact information it is.

In summary, Luciw fails to disclose any mechanism for "analyzing textual information … to identify a portion of the document as first contact information".

It is up to the user to alert the device as to what textual item should be made the subject of action, and Luciw provides smart fields and other mechanisms for this purpose. Moreover, Luciw fails to disclose action using textual information that is in a document.

In other words, contrary to the contention of the Petitioners, Figs. 6a, 6b, and 6c fail to disclose or suggest the claim limitation of "analyzing textual information in a document configured to be stored for later retrieval to identify a portion of the document as first contact information". These figures fail to disclose a document, and, far from showing analyzing textual information … to identify a portion of the document as first contact information", the figures show that the user must instead instruct the Luciw device precisely the nature of the contact information to be searched, namely whether a name or a phone number.

Because Luciw fails to disclose the claim limitation of "analyzing in a computer process textual information in a document configured to be stored for later retrieval to identify a portion of the document as first contact information, without user designation of a specific part of the textual information to be subject to the analyzing", Ground 3 fails to establish for anticipation of claims 1-24 by Luciw.

E. Because none of Luciw, Giordano, or Bates discloses or suggests "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database", Ground 4 fails to establish a *prima facie* case for obviousness and Ground 3 fails for this additional reason to establish anticipation by Luciw.

As pointed out above in connection with section V(C), independent claims 1, 9, 17 include the limitation "after identifying the first contact information, performing at least one action from a set of potential actions, using the first contact information previously identified as a result of the analyzing." Each of the independent claims enumerates three potential actions, and requires that "the computer implemented method is configured to perform each one of action (i), action (ii), and action (iii)". One of those actions is:

> (iii) allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database;

Ground 3fails to identify anything that discloses or suggests this claim limitation in Luciw, and Ground 4 fails to identify anything that discloses or suggests this claim limitation in any of Luciw, Giordano, or Bates. The Petitioners argue in Ground 3 that "Luciw teaches **updating a database with contact information**. Step 123 in Fig. 3 has an updating step. The related disclosure notes that 'upon accomplishment of the selected assistance action, the database information and any linked information are updated at step 123.'" *Corrected*

petition at 43, citing Exhibit 1003, col. 9, lines13-15. However, step 123 of Figure 3 in Luciw does not relate to updating a database with contact information as contended by Petitioners. Step 123 is depicted in Figure 8a. (Note the item number 123 in Figure 8a, which labels the entire flow chart.

Figure 8a in turn is explained in Luciw, Exhibit 1003, col. 12, lines 45-64. As explained by Luciw, "FIG. 8a illustrates details of the operation of step 123 of FIG. 3 dealing with the updating of information and linked information in smart fields." *Id*., lines 45-48. In other words, the smart fields are updated by data obtained from the data base and not vice versa: "The process starts at **200** and immediately checks the data base for any linked smart fields as indicated at **202**. If there are applicable smart fields which contain the desired phone number information, this data is obtained from the corresponding linked field types as suggested at **204**. Then, as suggested at **206**, the data obtained is entered into the applicable smart field of the window **170** under operation." *Id*., lines 51-58.

Moreover, even the erroneous interpretation of Luciw offered by Petitioners fails to meet the claim limitation, which, as discussed in section III(A) above, requires that the user be given a choice between competing alternatives of (1) storing at least part of the first contact information in the contact database as a new contact or (2) updating an existing contact in the contact database. The Petitioners' erroneous interpretation fails to identify such a choice and even fails to distinguish

between storing at least part of the first contact information as a new contact or updating an existing contact. Indeed, the Luciw patent fails to disclose updating contact information in the data base with user-entered information.

In Ground 4, Petitioners try to fill the gap left by Luciw (Exhibit 1003) by resorting to Giordano (Exhibit 1005) and Bates (Exhibit 1004). Petitioners cite Giordano for disclosing adding iconified telephone numbers (possibly with a name and address if present), found on a web page, to a user's address book. *Corrected Petition* at 52. However, Giordano fails to disclose, among other things, updating an existing contact in the user's address book.

Petitioners cite Bates for disclosing "storing at least part of the first contact information in the contact database as a new contact". *Corrected Petition* at 53. The process recounted in Bates for storing a new contact is automatic. As explained in the Abstract, "the automated addition of new entries to a contact database is supported by accumulating the number of contacts between a first user and a second user, with a new entry associated with the second user added to the contact database associated with the first user in response to the number of contacts between the first and second users exceeding a predetermined threshold." Bates, Exhibit 1004, Abstract. A user plays no role in deciding wither the new entry is added, and certainly is never given the choice about whether to update an existing contact or add a new one.

Petitioners wrongly confuse the automatic addition of a new entry to the contact database with intelligent name lookup. The Bates patent points out the distinction: "A first intelligent management function is that of intelligent name lookup, where a favored user may be located from a contact database based upon a predetermined affinity criteria. A second intelligent contact management function that may be supported is that of the automated addition of new entries to a contact database based upon the number of contacts between users." *Id.*, col. 10, lines 22-29.

This distinction is glossed over by the Petitioners in claiming a connection between the two: "In particular, a user inputs first contact information, i.e. a name, which is then used to conduct Bates' Intelligent Name Lookup. *See* Figs. 8 and 9; *see also* 10:52-59. Ex. 1002 at ¶¶186-188. Once a full name has been accepted by the user based on this partial input, the Bates method creates a record in the local database for this contact, as detailed in Fig. 12 and the accompanying text". *Corrected Petition* at 53.

However the preceding quoted sentence of the Petitioners is not accurate. Although there is indeed an intelligent name lookup, the next step is not creation of a record in the local database for this contact. The result of intelligent name lookup is discussed beginning in col. 12, line 41 and continuing to col. 13, line 13, where, it is revealed that after a user has accepted the displayed name, control is

passed to an "update contact routine 142". Despite its name, the "update contact routine 142" does not update contacts in the local contact database. On the contrary, the update contact routine 142 tracks "contacts between the local user and other users in the electronic messaging system so that the contact affinity therebetween may be determined." Exhibit 1004, col. 13, lines 15-18. At this point, at least optionally, an entry corresponding to the name is added to a "contact table" (which is an internal table used to count the number of interactions the user has had with a contact, see Bates Fig. 5 and col. 8, lines 7-10[1]) if there is not such an entry already, and a count field for the entry is incremented by a value representative of the contact type. Only when the count field has reached a threshold does the auto-add entry routine cause the name to be added automatically to the local database. *Id*., col. 13, line 21 to col. 14, line 17, and col. 15, line 1 *et seq*. ("Automated Addition of Entries to a Local Contact Database"). The name will be added if it is not present already. Col. 15, lines 30-34 ("If such an entry

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[1] Accordingly, the contact table also fails to satisfy the claim limitations that the "contact database can be separately accessed and edited by a user" and that the contact database has at "at least three fields within the contact database being specific to a particular type of contact information selected from the group consisting of name, title, address, telephone number, ands email address"

already exists, no further processing is required, and routine **152** terminates. However, if no such entry exists, control passes to block **184** to add an entry in the local contact database for the user by copying the corresponding entry from the master contact database"). This discussion shows that the Bates system adds new entries to the local contact database automatically.

The Petitioners erroneously assert that the Bates system has a method for updating existing contacts in the local contact database: "In much the same way, Bates discloses updating an existing contact in response to the partial name entry by the user." *Corrected petition* at 54. Aside from citing their own expert, the Petitioners rely on Bates, Exhibit 1004, col. 13, line 66 to col. 14, line 8, a passage we have just discussed in the preceding paragraph in connection with the "update contact routine 142", which, as we have said, tracks "contacts between the local user and other users in the electronic messaging system so that the contact affinity therebetween may be determined." As pointed out in the previous paragraph, the update contact routine 142 does not update a contact in the local contact database. Bates fails to disclose a mechanism for updating a contact in the local contact database.

The Petitioners argue that "[t]his alteration of the 'count' field in response to an interaction with an existing contact constitutes an 'update' of that existing contact within the meaning of the '993 patent claims because it is an item of

information in the database, related to a person listed in the database, that is altered in light of the contact information identified by the Bates process." *Corrected Petition* at 55. This argument is flawed, among other reasons, because the count field is not an item of information in the database, but rather, as discussed above, is in the "contact table", an internal table that is not part of the local contact database. (Moreover, the internal "contact table" cannot be separately accessed and edited by a user, nor does it contain "at least three fields" that are "specific to a particular type of contact information selected from the group consisting of name, title, address, telephone number, and email address" as required by the independent claims.)

Also importantly, the arguments advanced by Petitioners for obviousness of claims 1-24 based on Luciw, Giordano, and Bates fail to provide any disclosure or suggestion meeting the claim limitation of "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database". In Luciw, as previously discussed, there is no disclosure of updating the database with contact information at all. In Giordano, there is no disclosure of updating an existing contact in the user's address book (and no other contact database is mentioned). Similarly, in Bates, there is no disclosure of updating an existing contact in the contact database.

In sum, among other things, all of the references relied upon by the Petitioner fail to disclose or suggest updating an existing contact in the contact database. Given this deficiency, these references cannot possibly meet the claim limitation of "allowing the user to make a decision whether to store at least part of the first contact information in the contact database as a new contact or to update an existing contact in the contact database". Accordingly, Ground 4 fails to establish a *prima case* for obviousness based on Luciw, Giordano, and Bates.

F. Because none of Luciw, Giordano, and Bates discloses or suggests "providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing", for this additional reason Ground 4 fails to establish a *prima facie* case for obviousness and Ground 3 fails for this additional reason to establish anticipation by Luciw.

As discussed in section V(B), independent claims 1, 9, 17 include the limitation of "providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing". When the claims dependent on these independent claims are considered, then all of claims 1-24 include this limitation. The Luciw, Giordano, and Bates references relied upon by the Petitioners in Ground 4 fail to disclose or suggest this claim limitation.

The argument by Petitioners as to how Luciw meets this claim limitation is as follows: "With respect to the display and selection of second contact information as recited in elements 1f, 1g, and 1h above, the user may select the

appropriate full name from the pop-up menu depicted in Fig. 6b. With respect to the initiation of electronic communication recited in element 1i, the user need only activate the "call" button depicted in Fig. 8b. Ex. 1002 at ¶168." *Corrected Petition* at 44, referring to Ground 3, since, in Ground 4, "Luciw is applied as shown above in Ground 3" for all but "element (iii) of the independent claims". *Corrected Petition*, 46

A review of Fig. 6b of Luciw relied upon by the Petitioners:

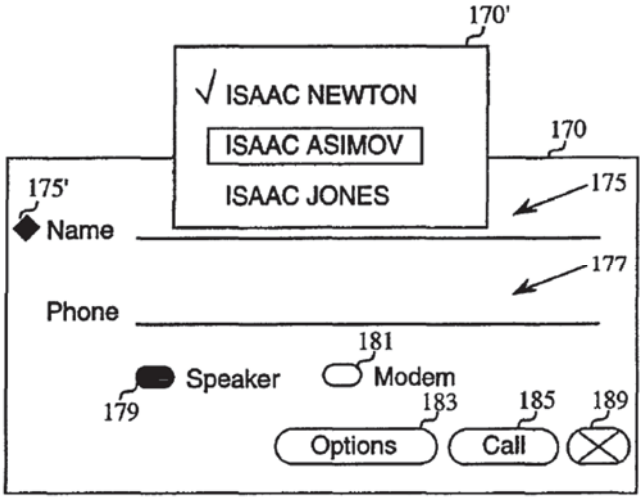

Figure 6b

shows that a search has already been performed (after entry of the name Isaac in Fig. 6a). But the claim limitation requires that "that a single execute command from the input device is sufficient to cause the performing" and the performing includes "(i) initiating an electronic search in the contact database for the first contact information while it is electronically displayed in order to find whether the first contact information is included in the contact database" and "when a contact

in the contact database includes the first contact information, if second contact information in the contact database is associated with that contact, electronically displaying at least a portion of the second contact information …."

Accordingly, as to leg (i) of the claim requirement, the display of names in Fig. 6b of Luciw comes too late to prove the Petitioners' point, since the single execute command must be sufficient to cause initiating the electronic search in the contact database for first information and displaying the results of the search, whereas in Fig. 6b the search has already been conducted and the results (the full names matching what the user typed) have been displayed.

As to leg (ii), the requirement is "(ii) initiating electronic communication using the first contact information", and Petitioners argue that [w]ith respect to the initiation of electronic communication recited in element 1i, the user need only activate the 'call' button depicted in Fig. 8b." *Corrected petition* at 44. However, leg (ii) requires initiating electronic communication using the *first* contact information, which in these figures is the name, Isaac Asimov; the telephone number is *second* information, which was already found in the database when looking up the names in Fig. 6b. The Petitioners have not cited an example that satisfies the requirements of leg (ii).

For at least these reasons, the Luciw patent, Exhibit 1003, fails to meet the claim limitation of "providing for the user an input device configured so that a

single execute command from the input device is sufficient to cause the performing".

Petitioners do not argue that Giordano or Bates have any disclosure that would meet this claim limitation.

Because Luciw, Giordano, and Bates fail to disclose or suggest "providing for the user an input device configured so that a single execute command from the input device is sufficient to cause the performing", for at least this additional reason Ground 4 has failed to establish a *prima facie* case for obviousness of claims 1-24 based on these references and Ground 3 fails to establish anticipation by Luciw.

VI. CONCLUSION

For the foregoing reasons, Petitioners have failed to establish a reasonable likelihood of prevailing as to any claim of the '993 Patent, and inter partes review of claims 1-24 of U.S. Patent No. 8,306,993 should be denied.

Dated: March 12, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

It is certified that on March 12, 2014, copies of the Preliminary Response of the Patent Owner under 35 U.S.C. § 313 and 37 C.F.R. § 42.107 have been served on Petitioners as provided in 37 C.F.R. § 42.6(e) via electronic mail transmission and by depositing a copy of the same via electronic mail transmission addressed to the persons at the following addresses:

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Exhibit 6J

IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

ARENDI S.A.R.L., Plaintiff, v. MICROSOFT CORPORATION, Defendant.	Case No. 09-119-LPS

PLAINTIFF'S SUPPLEMENTAL OPENING BRIEF IN SUPPORT OF ITS PROPOSED CLAIM CONSTRUCTIONS

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Dated: January 21, 2011

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— Emphasis added unless otherwise noted —

EXHIBIT LIST

The following exhibits cited herein refer to the exhibits to the Declaration Of Jon R. Carter In Support Of Plaintiff's Supplemental Proposed Claim Constructions, filed concurrently herewith.

Exhibit 1: Supplemental summary of disputed claim constructions[1]

Exhibit 2: Corresponding Structure for "means for an activation of a device selected from a group consisting of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice command device"

Exhibit 3: Corresponding Structure for "means for searching, using the second application program, for the second information associated with the first information"

Exhibit 4: Corresponding Structure for "means for retrieving the second information"

Exhibit 5: Corresponding Structure for "means for identifying without user intervention or designation the first information that can be utilized in a second application program, the first information selected from a group consisting of a name and an address"

Exhibit 6: Corresponding Structure for "if said second information exists, means for retrieving and displaying the second information"

Exhibit 7: Corresponding Structure for "means for using a first computer program to analyze the document, without direction from the operator, to identify the name"

Exhibit 8: Corresponding Structure for "means for using the identified name and a second computer program to search the database and to locate contact related information associated with the name"

Exhibit 9: Corresponding Structure for "means for inserting the contact related information into the document"

Exhibit 10: Excerpts from Microsoft Press Computer Dictionary (3d ed. 1997)

Exhibit 11: Excerpt from Webster's Encyclopedic Unabridged Dictionary of the English Language (1996)

[1] The parties' competing proposals for terms earlier identified for construction appear in Exhibit S to the Declaration Of Joseph A. Loy In Support Of Plaintiff's Answering Brief In Support Of Its Proposed Claim Constructions, filed August 25, 2009. (*See* D.I. 58-6.)

Plaintiff Arendi S.A.R.L. ("Arendi") respectfully submits this brief in support of its proposed constructions for the supplemental disputed claim terms of U.S. Patent No. 7,496,854 ("the '854 patent"), in accordance with the Court's October 21, 2010, Order To Reschedule Markman Hearing and Allow Further Claim Construction Briefing. (D.I. 282.)

NATURE AND STAGE OF THE PROCEEDINGS

Arendi filed this patent infringement action against Microsoft Corporation ("Microsoft") on February 24, 2009, for infringement of the '854 patent. Fact discovery closed on March 17, 2010, and expert discovery concluded on July 16, 2010. (D.I. 184.) Trial is scheduled to begin on October 31, 2011. (D.I. 277.) A claim construction hearing for both previously briefed and argued terms and supplemental terms is scheduled for February 25, 2011. (D.I. 282.)

SUMMARY OF ARGUMENT

Arendi's proposed claim constructions are based upon the intrinsic record of the '854 patent, including the claims, specification, prosecution history, and the ordinary and customary meaning of the terms to those skilled in the art, as evidenced by the intrinsic record and relevant extrinsic sources. Microsoft, in contrast, ignores these controlling sources and instead seeks to rewrite the claims through its proposed constructions to manufacture noninfringement and invalidity defenses. The parties' competing constructions are summarized in Exhibit 1. For the reasons set forth herein, as well as those set forth in its Opening Claim Construction Brief (D.I. 46), Arendi respectfully requests that the Court adopt its proposed constructions.

ARGUMENT

In accordance with the Court's October 21, 2010, Order (D.I. 282), the parties have identified various supplemental terms for construction. This brief first addresses dispute general terms in Section I and then the disputed means-plus-function elements in Section II. Arendi

incorporates by reference the discussions of applicable law and the background of the technology from its Opening Claim Construction Brief. (*See* D.I. 46 at 7–12.)

I. <u>Disputed Claim Terms</u>

A. "computer program"

The term "computer program" should be construed in accordance with its ordinary and customary meaning and the clear usage of the term within the intrinsic evidence as "a self-contained set of instructions, as opposed to a routine or library, intended to be executed on a computer so as to perform some task." In particular, the ordinary and customary meaning of "computer program" at the time of the invention was a set of instructions intended to be executed on a computer so as to perform some task, commonly understood to be self-contained, as opposed to a routine or a library:

> **computer program** \kəm-pyōō´tər prō`gram\ *n.* A set of instructions in some computer language intended to be executed on a computer so as to perform some task. The term usually implies a self-contained entity, as opposed to a routine or a library. *See also* computer language. *Compare* library (definition 1), routine.

(Ex. 10 at 111.) The specification's use of the term "computer program" is consistent with this ordinary and customary meaning. The specification, for example, explains that the claimed "computer programs" may be things such as word processing or spreadsheet programs:

> In an embodiment of the present invention, single button addressing is a achieved by providing an input device, such as a touch screen, keyboard, icon, menu, voice command device, etc. (hereinafter called "button"), in a computer program, such as a word processing program, spreadsheet program, etc. (hereinafter called "word processor"), for executing address handling therein.

(D.I. 47, Ex. D at col. 3, ll. 35–41.)

Indeed, the patent specification explains that the purpose of the invention is to access a second computer program, "external to the word processor," "while the user works simultaneously" in the first computer program—emphasizing that the "computer programs" of

the asserted claims are distinct and self-contained. (*See id.* at col. 1, ll. 35–36; col. 2, ll. 20–23.) As the "Background Information" section recounts, users of word processors and spreadsheets "may require retrieval of information, such as name and address information, etc. for insertion into a document." (*See id.* at col. 1, ll. 29–33.) In the prior art, this information typically would need to be manually retrieved by the user "from an information management source ***external*** to the word processor, such as a database program . . . ." (*See id.* at col. 1, ll. 34–36.) The invention of the '854 patent, however, allows for the retrieval from an information management source, such as a database program, of the desired "name and addresses and/or other . . . related information, while the user works simultaneously ***in another program, e.g., a word processor.***" (*See id.* at col. 2, ll. 20–23.) The patent discloses that the functionality to retrieve this information, without user intervention, is "provided in the computer program," such as the above-mentioned word processor, "and coupled to an information management source, such as a database program, contact management program, etc." (*See id.* at col. 2, ll. 6–13.)

The use of the term "computer program" in the claims of the '854 patent further supports the ordinary and customary meaning of the term. Claim 93, for example, refers to the two different computer programs described above—a "first computer program," which identifies text that can be used to search for related information, and a "second computer program," which uses that text to search a database and locate the related information:

> **93**. A method for assisting a computer operator to retrieve information from a database that is related to text in a document, the method comprising the steps of:
> (1) using a first computer program to analyze the document, without direction from the operator, to identify text in the document that can be used to search for related information,
> (2) using a second computer program and the text identified in step (1) to search the database and to locate related information, and
> (3) inserting the information located in step (2) into the document.

Indeed, the claim language expressly reflects retrieving information using a second computer program while working in a first computer program distinct from the second. (*See infra* Section I.D.) As neither the specification nor prosecution history suggests that the claim term "computer program" includes a "routine or library," or otherwise deviates from the ordinary and customary meaning of the term, Arendi's proposed construction of "computer program" as "a self-contained set of instructions, as opposed to a routine or library, intended to be executed on a computer so as to perform some task" should be adopted. *See Phillips*, 415 F.3d at 1316 ("The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction.").

B. "application program"

The term "application program" should be construed in accordance with its ordinary and customary meaning and the clear usage of the term within the intrinsic evidence as "a computer program designed to assist in the performance of a specific task, such as word processing, accounting, or inventory management." The following definition—from Microsoft's own dictionary—shows the ordinary meaning of "application program" at the time of the invention:

application \a`plə-kā´shən\ *n.* A program designed to assist in the performance of a specific task, such as word processing, accounting, or inventory management. *Compare* utility.

* * *

application program \a`plə-kā´shən prō`gram\ *n.* *See* application.

(Ex. 10 at 27–28.)

The patentee used the term "application program" in exactly this manner when describing the addition of new claims to define more fully the invention to the examiner:

> at page 3, lines 7 – 21 of the specification. Thus, "the first application program" of claim 1 corresponds to (but is not limited to) a program such as a word processor (see page 3, line 13). The "second application program" of claim 19 corresponds to (but is not limited to) a program such as a database program (see page 3, line 14). "[C]ommanding a function item"

(*See* D.I. 47, Ex. E at AHL0000370.) As the patentee noted, the use of "first application program" and "second application program" corresponds to computer programs such as word processors and database programs—consistent with the overall purpose of the invention discussed above. The patent provides further specific examples of word processors, such as Word and WordPerfect, and database programs, such as Outlook, each ordinarily and customarily understood to be an "application program"—a computer program that assists in the performance of a specific task, such as word processing, accounting, or inventory management. (*See* D.I. 47, Ex. D at col. 1, ll. 39–40; col. 8, ll. 31–33.) As nothing within the specification or prosecution history suggests that "application program" deviates from the ordinary and customary meaning of the term, Arendi's proposed construction of "application program" as "a computer program designed to assist in the performance of a specific task, such as word processing, accounting, or inventory management" should be adopted. *See Phillips*, 415 F.3d at 1312 ("[T]he words of a claim 'are generally given their ordinary and customary meaning.'") (citation omitted).

Microsoft, in an inappropriate attempt to manufacture invalidity arguments, proposes constructions for *both* "application" and "application program." (*See* Ex. 1 at 1.) But the term "application" does not appear in any claim of the '854 patent independently from "application program." *See, e.g., Am. Med. Sys., Inc.*, 666 F. Supp. 2d at 220 (declining to construe "the general term 'cladding'" given that "[t]he claims nowhere refer to 'cladding' independently; they refer only to 'glass cladding' and 'core cladding'"). Indeed, Microsoft's own dictionary provides

the same definition for both terms. (*See* Ex. 10 at 27–28.) Accordingly, no separate construction of "application" is necessary.

C. "information"

The term "information" should be construed in accordance with its ordinary and customary meaning and the intrinsic record as "the meaning of data as it is intended to be interpreted by people," which comports with the definition in Microsoft's own dictionary:

> **information** \in`fər-mā´shən\ *n.* The meaning of data as it is intended to be interpreted by people. Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what the data represents.

(Ex. 10 at 249.) Examples throughout the specification support this construction. For example, when the '854 patent specification refers to "name and addresses and/or other person or company related *information*," it describes that information in terms of its underlying data:

> . . . the person, company or address related *data*, in order to look up *data* corresponding to what the user types, or partly typed, e.g., name and/or address in the word processor, the correct *data* from the database, *data* related to the typed *data*, e.g., the name of the person, company, or the traditional or electronic address, or other person, or company, or address related data, and alternatively the persons, companies, or addresses, are displayed and possibly entered into the word processor, if such related *data* exists.

(D.I. 47, Ex. D at Abstract; *see also id.* at col. 2, ll. 20–22, 26–34.) When a person's name ("first information," which is data indicating the identity of a specific person, such as "Atle Hedløy" in Ex. D at Fig. 3) is found in a word processing document, and that name has exactly one address match, the patent specification describes retrieving the matching address information ("second information," which is data indicating the traditional physical or electronic address of that person, such as "151 University Ave., Palo Alto, CA 94301-1632 USA" in Ex. D at Fig. 4) and inserting the matching address information into the document. (*Id*. at Fig. 4; *see also id.* at Fig. 1 step 22; col. 5, l. 66–col. 6, l. 5.) This customary meaning of "information" as the meaning of

data as it is intended to be interpreted by people is also consistent with other examples of "information" mentioned in the patent claims and specification, including names, addresses, phone numbers, and e-mail addresses. (*See, e.g.*, *id.* at col. 3, ll. 58–61.)

D. "second computer program," "second application program," and "second information"

Various asserted claims of the '854 patent (e.g., claims 1 and 100) refer to both a "first" and "second computer program" as well as a "first" and "second application program" and/or "first" and "second information." "The use of the terms 'first' and 'second' is a common patent-law convention to distinguish between repeated instances of an element or limitation." *3M Innovative Props. Co.*, 350 F.3d at 1371. Absent explicit disclaimer, the numerical designations "first" and "second" should not be presumed to have narrower meaning. *See id.* Indeed, it is clear from the claims and specification that these terms refer to two distinct things. (*See supra* Section I.A; D.I. 47, Ex. D at col. 1, ll. 34–36; col. 2, ll. 20–23); *see Oately Co.*, 514 F.3d at 1277–78 ("the term 'first and second juxtaposed drain ports in said bottom wall' defines distinct openings . . ."). Accordingly, the term "second computer program" should be construed as "a computer program that is distinct from the first computer program"; the term "second application program" should be construed as "an application program that is distinct from the first application program," and the term "second information" should be construed as "information that is distinct from the first information."

E. "associated"

The term "associated" should be construed in accordance with its ordinary and customary meaning and the intrinsic record as "connected or brought into relation." (*See, e.g.*, Ex. 11 at 126 (defining "associate" as "to connect or bring into relation . . .").) Examples in the patent specification support this construction. For instance, the patent refers to the searching of a

database for contact information (e.g., physical and e-mail addresses, phone numbers) that is "related" to recognized text within a word processing document:

> . . . search a database or file . . . containing the person, company or address related data, in order to look up data corresponding to what the user types . . . data related to the typed data, e.g., the name of the person, company, or the traditional or electronic address, or other person, or company, or address related data. . . .

(D.I. 47, Ex. D at col. 2, ll. 24–31; *see also id.* at Abstract; col. 3, ll. 63–66; col. 5, l. 66–col. 6, l. 2.) When a person's name ("first information," such as "Atle Hedløy" in Fig. 3 of Ex. D) is found in a word processing document, the patent specification describes searching a database ("second application program") for address information that is connected or related to the typed name ("second information," such as "151 University Ave., Palo Alto, CA 94301-1632 USA" in Fig. 4 of Ex. D). (*See id*. at Fig. 1 steps 12, 14, and 18; col. 4, ll. 43–45, 57–58.) This ordinary and customary meaning of "associated" as "connected or brought into relation" is likewise consistent with the patentee's statement in the file history that "the claimed invention locates substantive information that is associated with information located in the document, e.g., an address that is associated with a name already entered into a document." (D.I. 47, Ex. E at AHL0000400.) Arendi's construction should therefore be adopted.

II. <u>Disputed Means-Plus-Function Claim Elements</u>

A. <u>Claims 14 and 51</u>

1. "means for an activation of a device selected from a group consisting of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice command device"

This means-plus-function element of both asserted dependent claims 14 and 51 should be construed in accordance with 35 U.S.C. § 112 ¶ 6, as follows:

> *Recited function:* "activation of a device selected from a group consisting of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice command device"
>
> *Corresponding structure:* A computer system programmed with an algorithm for activation of a device selected from a group consisting of a touch screen, a

keyboard button, a screen button, an icon, a menu, and a voice command device, as described, for example, at col. 2, ll. 35–39, 45–50; col. 3, ll. 4–19, 27–30; col. 4, ll. 8–11, 46–49, 64–65; col. 5, ll. 14–16, 44–51; col. 7, ll. 3–16, 20–24, 34–66; col. 8, ll. 5–7, 18–51; col. 9, ll. 3–52; and shown in Figs. 1 (e.g., steps 20 and 30), 2 (e.g., steps 20 and 30), 9, 10, 11, 12, 13, and 16, and equivalents thereof.

The '854 patent specification describes exemplary algorithms for implementing the claimed function. For example, algorithms for the activation of a device, such as a touch screen, keyboard button, a screen button, an icon, a menu, or a voice command device are illustrated in Figure 1 steps 20 and 30:

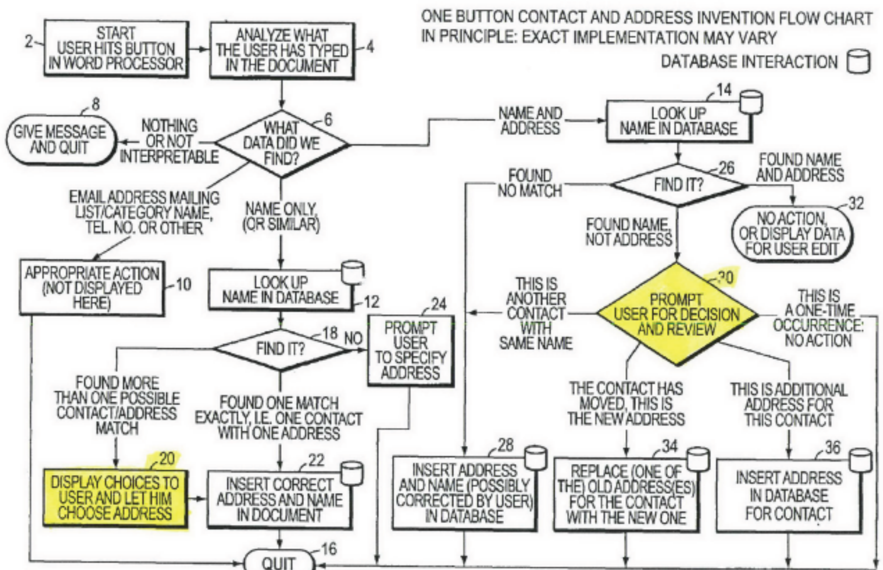

FIG. 1

(D.I. 47, Ex. D at Fig. 1; *see also id.* at Fig. 2, steps 20 and 30; col. 2, ll. 45–50.) As illustrated, when a person's name is found in a word processing document, and that name has more than one possible address match, the patent specification describes displaying choices to the user and permitting the user to choose the appropriate address for insertion. (*See, e.g.*, *id.* at Fig. 1 step 20; Fig. 2 step 20; col. 4, ll. 46–49; col. 5, ll. 14–16.) An exemplary display that allows the user to select between the alternative addresses is illustrated in Figure 10:

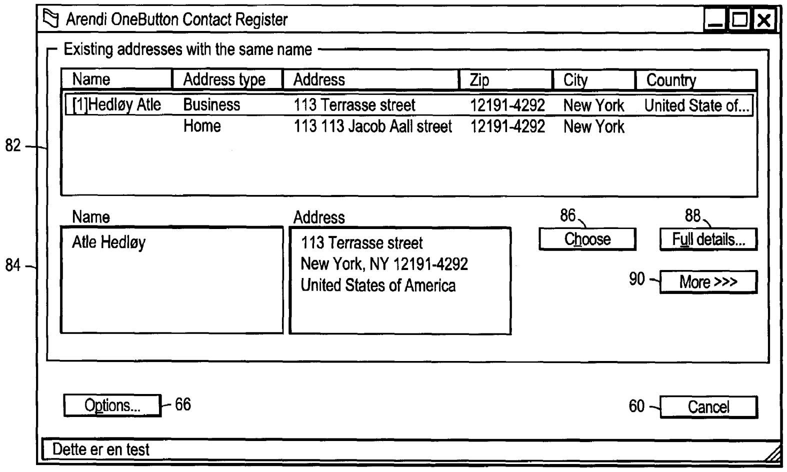

FIG. 10

(*Id.* at Fig. 10; *see also id.* at col. 3, ll. 7–9.) This exemplary display includes, for example, a screen button labeled "Choose" [86] that a user may activate to use the selected address and return to the document. (*See, e.g.*, *id.* at col. 7, ll. 37–53.) The patent specification provides further explanation of exemplary algorithms for "activation of a device selected from a group consisting of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice command device," as illustrated in Exhibit 2 and cited as part of the identified corresponding structure above.

The patent specification explains that these algorithms run on a computer system such as the one disclosed in Figure 16. (*See, e.g., id.* at Fig. 16; col. 2, ll. 35–39; col. 3, ll. 27–30; col. 9, ll. 3–52.) Accordingly, the corresponding structure disclosed in the specification for performing the claimed function is a computer system programmed with an algorithm for activation of a device selected from a group consisting of a touch screen, a keyboard button, a screen button, an icon, a menu, a voice command device, and equivalents thereof. *See* 35 U.S.C. § 112 ¶ 6; *WMS Gaming Inc.*, 184 F.3d at 1349. The cited portions of the specification to which Microsoft objects for this claim limitation (*see* Ex. 1 at 3) describe "a computer system programmed with an algorithm for activation of a device . . ." or specifically reference figures from the

specification that illustrate exemplary corresponding structure, including, for example, a touch screen; a screen button; an icon; and/or a menu. These portions should be included to fully describe the corresponding structure. *See Cardiac Pacemakers, Inc.*, 296 F.3d at 1119 (“[C]orresponding structure must include ***all structure*** that actually performs the recited function.”).

B. <u>Claims 15 and 52</u>

1. “means for searching, using the second application program, for the second information associated with the first information”

The second means-plus-function element of asserted dependent claims 15 and 52 should be construed in accordance with 35 U.S.C. § 112 ¶ 6, as follows:[2]

> *Recited function:* “searching, using the second application program, for the second information associated with the first information”[3]
>
> *Corresponding structure:* A computer system programmed with an algorithm for searching, using the second application program, for the second information associated with the first information, as described, for example, at Abstract; col. 2, ll. 14–39, 45–50; col. 3, ll. 27–30, 42–54; col. 4, ll. 12–18, 40–46, 57–58; col. 5, ll. 12–14, 23–25, 34–35; col. 5, l. 65–col. 6, l. 1; col. 6, ll. 4–5, 13–17, 36–39, 47–50, 58–59; col. 7, ll. 1–5, 20–23, 33–36; col. 8, ll. 5–7, 16–20, 48–51, 59–62, 64–67; col. 9, ll. 1–52; and shown in Figs. 1 (e.g., steps 12 and 14), 2 (e.g., steps 12, 14, and 29), and 16, and equivalents thereof.

The ’854 patent specification describes exemplary algorithms for searching, using the second application program, for second information associated with the first information, as illustrated below in Figure 1 steps 12 and 14:

---

2 This means-plus-function element is also a limitation of asserted claim 99.

3 Arendi’s proposed constructions for the terms “computer program,” “application program,” “information,” “second computer program,” “second application program,” “second information,” “database,” and/or “associated” are incorporated by reference into the recited functions for each means-plus-function claim element where applicable. (*See supra* Section I.)

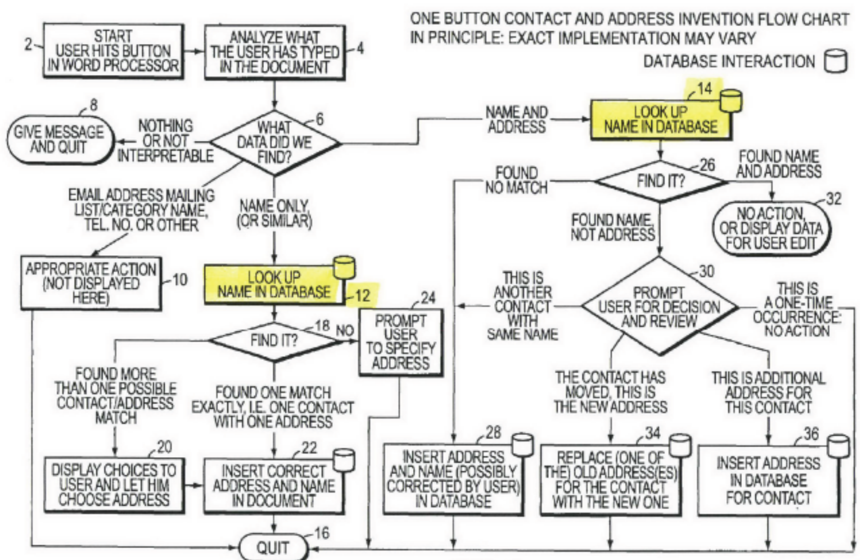

FIG. 1

(D.I. 47, Ex. D at Fig. 1; *see also id.* at Fig. 2 steps 12, 14, and 29; col. 2, ll. 45–50.) For example, when a person's name (a first information) is found in a word processing document, the computer system uses the database program to search for contact information (second information) associated with that name. (*See, e.g.*, *id.* at Fig. 1 steps 12, 14; col. 3, ll. 50–54; col. 4, ll. 40–46, 57–58; col. 5, ll. 12–14, 34–35.) The patent specification provides further explanation of exemplary algorithms for "searching, using the second application program, for the second information associated with the first information," as illustrated in Exhibit 3 and cited as part of the identified corresponding structure above.[4] The cited portions of the specification to which Microsoft objects for this claim limitation (*see* Ex. 1 at 4) describe an algorithm for recalling stored information (i.e., searching) or specifically reference figures from the specification that illustrate exemplary corresponding structure. These portions should be included to fully describe the corresponding structure. *See Cardiac Pacemakers*, 296 F.3d at

4 As reflected in Arendi's proposed construction, the corresponding structure disclosed in the specification is a computer system programmed with such an algorithm. (*See supra* at 10.)

1119 ("[C]orresponding structure must include ***all structure*** that actually performs the recited function.").

2. "means for retrieving the second information"

The second means-plus-function element of both asserted dependent claims 15 and 52 should be construed in accordance with 35 U.S.C. § 112 ¶ 6, as follows:

> *Recited function:* "retrieving the second information"
>
> *Corresponding structure:* A computer system programmed with an algorithm for retrieving the second information, as described, for example, at Abstract; col. 2, ll. 14–39, 45–50; col. 3, ll. 27–30, 63–67; col. 4, ll. 8–18, 40–43, 46–54, 62–65; col. 5, ll. 14–16, 19–22, 44–53; col. 5, l. 66–col. 6, l. 5; col. 7, ll. 3–6, 20–23, 34–37; col. 8, ll. 5–7, 18–21, 48–51; col. 8, l. 60–col. 9, l. 52; and shown in Figs. 1 (e.g., steps 10, 20, 22, 30, and 32), 2 (e.g., steps 10, 20, 22, 30, and 32), and 16, and equivalents thereof.

The '854 patent specification describes exemplary algorithms for retrieving second information, as illustrated below in Figure 1 steps 10, 20, 22, 30 and 32:

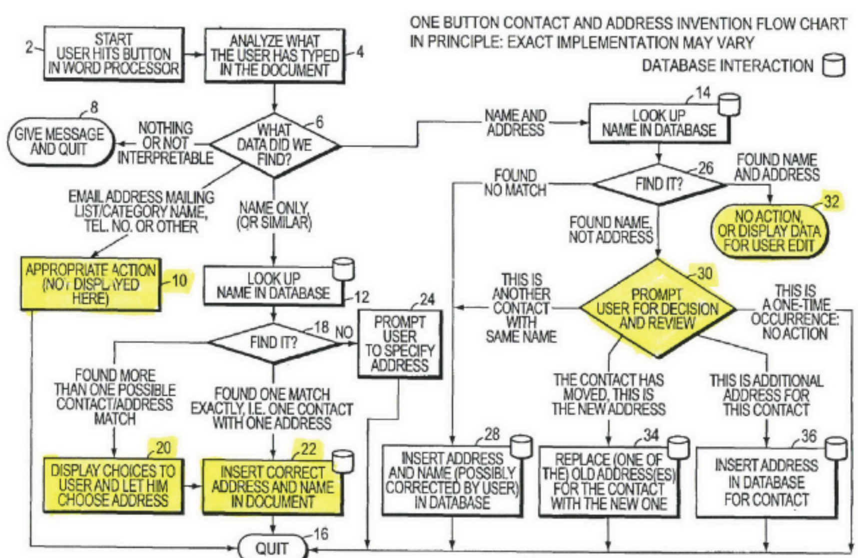

FIG. 1

(D.I. 47, Ex. D at Fig. 1; *see also id.* at Fig 2. steps 10, 20, 22, 30, and 32; col. 2, ll. 45–50; col. 4, ll. 40–43, 46–54, 62–65; col. 5, ll. 46–16, 44–53.) For example, when a person's name (a first information) is found in a word processing document, and that name has exactly one address match, the patent specification describes retrieving the matching address information (second

information) and inserting it into the document. (*See, e.g.*, *id.* at Fig. 1 step 22; col. 4, ll. 46–54; col. 5, l. 66–col. 6, l. 5.) The patent specification provides further explanation of exemplary algorithms for "retrieving the second information," as illustrated in Exhibit 4 and cited as part of the identified corresponding structure above.[5] The cited portions of the specification to which Microsoft objects for this claim limitation (*see* Ex. 1 at 5) describe an algorithm for retrieving information or reference figures from the specification that illustrate exemplary corresponding structure. These portions should be included to fully describe the corresponding structure. *See Cardiac Pacemakers*, 296 F.3d at 1119 ("[C]orresponding structure must include ***all structure*** that actually performs the recited function.").

C. <u>Claim 99</u>

1. "means for identifying without user intervention or designation the first information that can be utilized in a second application program, the first information selected from a group consisting of a name and an address"

This means-plus-function element of asserted claim 99 should be construed in accordance with 35 U.S.C. § 112 ¶ 6, as follows:

> *Recited function:* "identifying without user intervention or designation the first information that can be utilized in a second application program, the first information selected from a group consisting of a name and an address"
>
> *Corresponding structure:* A computer system programmed with an algorithm for identifying without user intervention or designation the first information that can be utilized in a second application program, the first information selected from a group consisting of a name and an address, as described, for example, at col. 2, ll. 35–39, 45–50; col. 3, ll. 27–30, 48–49; col. 4, ll. 25–39; col. 5, ll. 66–67; col. 6, ll. 4–5, 14–16, 36–39, 48–50, 58–59; col. 7, ll. 3–4, 20–23, 34–35; col. 8, ll. 5–7, 18–19, 48–51, 60–62, 64–67; col. 9, ll. 1–52; col. 10, ll. 23–27; and as shown in Figs. 1 (e.g., steps 4 and 6), 2 (e.g., steps 4 and 6), and 16, and equivalents thereof.

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[5] As reflected in Arendi's proposed construction, the corresponding structure disclosed in the specification is a computer system programmed with such an algorithm. (*See supra* at 10.)

The ’854 patent specification describes exemplary algorithms for implementing the claimed function. As discussed in Arendi’s Opening Brief, the specification describes exemplary algorithms for identifying without user intervention or designation the first information. (*See* D.I. 46 at 23–24.) Additionally, the specification discloses that the first information can be a name and address that can be used in a second application program (e.g., a database program). (*See*, *e.g.*, D.I. 47, Ex. D at Fig. 1 steps 4, 6; Fig. 2 steps 4, 6; col. 4, ll. 25–39; col. 10, ll. 23–27.) The specification provides further explanation of exemplary algorithms for “identifying without user intervention or designation the first information that can be utilized in a second application program, the first information selected from a group consisting of a name and an address,” as illustrated in Exhibit 5 and cited as part of the identified corresponding structure above.[6]

2. “if said second information exists, means for retrieving and displaying the second information”

This means-plus-function element of asserted claim 99 should be construed in accordance with 35 U.S.C. § 112 ¶ 6, as follows:

> *Recited function:* “if said second information exists, retrieving and displaying the second information”
>
> *Corresponding structure:* A computer system programmed with an algorithm for retrieving and displaying the second information, if it exists, as described, for example, at Abstract; col. 2, ll. 14–39, 45–50; col. 3, ll. 27–30, 63–67; col. 4, ll. 8–18, 40–43, 46–54, 62–65; col. 5, ll. 14–16, 19–22, 44–53; col. 5, l. 66–col. 6, l. 5; col. 7, ll. 3–6, 20–23, 34–37; col. 8, ll. 5–7, 18–21, 48–51; col. 8, l. 60–col. 9, l. 52; and shown in Figs. 1 (e.g., steps 20, 22, 30, and 32), 2 (e.g., 20, 22, 30, and 32), and 16, and equivalents thereof.

The ’854 patent specification describes exemplary algorithms for retrieving and displaying second information if said second information exists, as illustrated below in Figure 1:

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6 As reflected in Arendi’s proposed construction, the corresponding structure disclosed in the specification is a computer system programmed with such an algorithm. (*See supra* at 10.)

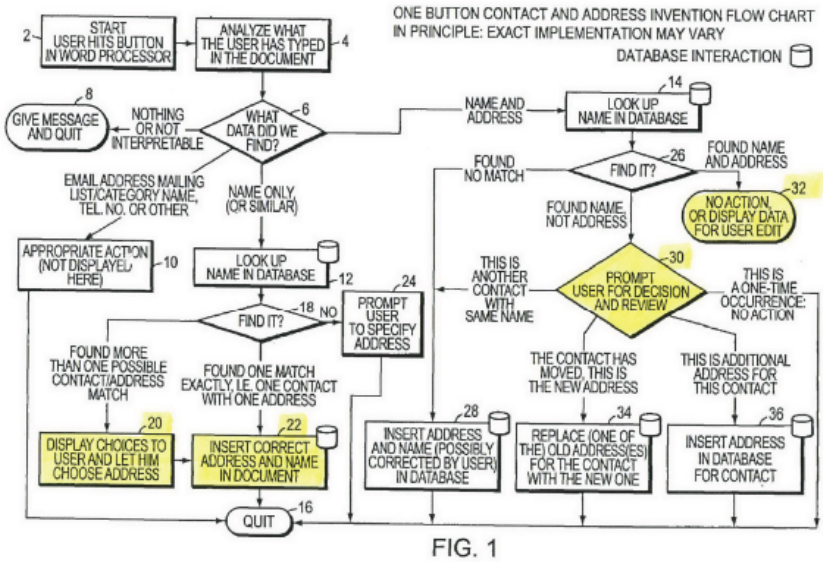

FIG. 1

(D.I. 47, Ex. D at Fig. 1; *see also id.* at Fig. 2 steps 20, 22, 30, and 32; col. 2, ll. 45–50; col. 4, ll. 46–54, 62–65; col. 5, ll. 14–16, 19–22, 44–53.) For example, as explained above, when a person's name (a first information) is found in a word processing document, and that name has exactly one address match, the patent specification describes retrieving the matching address information (second information) and inserting it into the document. (*See supra* Section II.B.2.) The patent specification provides further explanation of exemplary algorithms for "if said second information exists, retrieving and displaying the second information," as illustrated in Exhibit 6 and cited as part of the identified corresponding structure above.[7] The cited portions of the specification to which Microsoft objects for this claim limitation (*see* Ex. 1 at 7) describe an algorithm for retrieving information or specifically reference figures from the specification that illustrate exemplary corresponding structure. These portions should be included to fully describe the corresponding structure. *See Cardiac Pacemakers*, 296 F.3d at 1119 ("[C]orresponding structure must include ***all structure*** that actually performs the recited function.").

[7] As reflected in Arendi's proposed construction, the corresponding structure disclosed in the specification is a computer system programmed with such an algorithm. (*See supra* at 10.)

D. Claim 100

1. "means for using a first computer program to analyze the document, without direction from the operator, to identify the name"

The first means-plus-function element of asserted claim 100 should be construed in accordance with 35 U.S.C. § 112 ¶ 6, as follows:

> *Recited function:* "using a first computer program to analyze the document, without direction from the operator, to identify the name"
>
> *Corresponding structure:* A computer system programmed with an algorithm for using a first computer program to analyze the document, without direction from the operator, to identify the name, as described, for example, at col. 2, ll. 35–39, 45–50; col. 3, ll. 27–30, 48–49; col. 4, ll. 25–39; col. 5, ll. 66–67; col. 6, ll. 4–5, 14–16, 36–39, 48–50, 58–59; col. 7, ll. 3–4, 20–23, 34–35; col. 8, ll. 5–7, 18–19, 48–51, 60–62, 64–67; col. 9, ll. 1–52; col. 10, ll. 23–27; and as shown in Figs. 1 (e.g., steps 4 and 6), 2 (e.g., steps 4 and 6), and 16, and equivalents thereof.

The '854 patent specification describes exemplary algorithms for implementing the claimed function. As discussed in Arendi's Opening Brief, the specification describes exemplary algorithms for using a first computer program to analyze the document, without direction from the operator, to identify text in the document. (*See* D.I. 46 at 25–37.) The patent specification further discloses that the identified text can be a name. (*See*, *e.g.*, D.I. 47, Ex. D at Fig. 1 steps 4, 6; Fig. 2 steps 4, 6; col. 4, ll. 25–39; col. 10, ll. 23–27.) The patent specification provides further explanation of exemplary algorithms for "using a first computer program to analyze the document, without direction from the operator, to identify the name," as illustrated in Exhibit 7 and cited as part of the identified corresponding structure above.[8]

2. "means for using the identified name and a second computer program to search the database and to locate contact related information associated with the name"

The second means-plus-function element of asserted claim 100 should be construed in accordance with 35 U.S.C. § 112 ¶ 6, as follows:

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8 As reflected in Arendi's proposed construction, the corresponding structure disclosed in the specification is a computer system programmed with such an algorithm. (*See supra* at 10.)

Recited function: "using the identified name and a second computer program to search the database and to locate contact related information associated with the name"

Corresponding structure: A computer system programmed with an algorithm for using the identified name and a second computer program to search the database and to locate contact related information associated with the name, as described, for example, at Abstract; col. 2, ll. 14–39, 45–50; col. 3, ll. 27–30, 42–54; col. 4, ll. 12–18, 40–46, 57–58; col. 5, ll. 12–14, 23–25, 34–35; col. 5, l. 65–col. 6, l. 1; col. 6, ll. 4–5, 13–17, 36–39, 47–50, 58–59; col. 7, ll. 1–5, 20–23, 33–36; col. 8, ll. 5–7, 16–20, 48–51, 59–62, 64–67; col. 9, ll. 1–52; and shown in Figs. 1 (e.g., steps 12, 14, 18, and 26), 2 (e.g., steps 12, 14, 18, 26, 29, and 31), and 16, and equivalents thereof.

The '854 patent specification describes exemplary algorithms for using a database program (a second computer program) to search the database or file and to locate contact related information associated with a name, as illustrated below in Figure 1 steps 12, 14, 18, and 26:

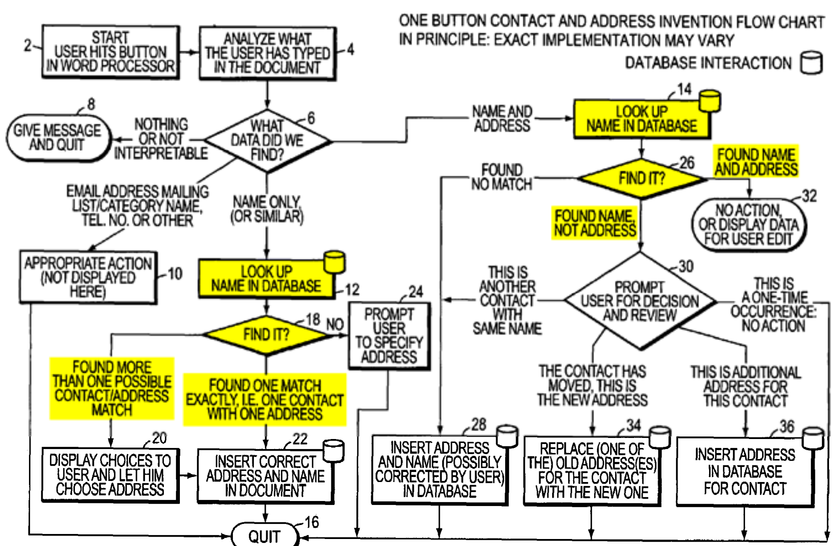

FIG. 1

(D.I. 47, Ex. D at Fig. 1; *see also id.* at Fig. 2 steps 12, 14, 18, and 26; col. 2, ll. 45–50; col. 4, ll. 40–46, 57–58; col. 5, ll. 12–14, 23–25, 34–35.) For example, the computer system uses the database program to look up address information associated with the name to determine whether there is one match exactly, i.e., one contact with one address, or more than one possible contact/address match. (*See id.* at Fig. 1 steps 12 and 18; *see also id.* at Fig. 1 steps 14 and 26; col. 4, ll. 40–46, 57–58; col. 5, ll. 12–14, 23–25, 34–35.) The patent specification provides

further explanation of exemplary algorithms for "using the identified name and a second computer program to search the database and to locate contact related information associated with the name," as illustrated in Exhibit 8 and cited as part of the identified corresponding structure above.[9] The cited portions of the specification to which Microsoft objects for this claim limitation (*see* Ex. 1 at 9) describe an algorithm for recalling stored information (i.e., searching) or reference figures from the specification that illustrate exemplary corresponding structure. These portions should be included to fully describe the corresponding structure. *See Cardiac Pacemakers*, 296 F.3d at 1119 ("[C]orresponding structure must include ***all structure*** that actually performs the recited function.").

3. "means for inserting the contact related information into the document"

The third means-plus-function element of asserted claim 100 should be construed in accordance with 35 U.S.C. § 112 ¶ 6, as follows:

> *Recited function:* "inserting the contact related information into the document"
>
> *Corresponding structure:* A computer system programmed with an algorithm for inserting the contact related information into the document, as described, for example, at Abstract; col. 2, ll. 23–39, 45–50, 55–57; col. 3, ll. 7–9, 24–30, 63–67; col. 4, ll. 8–11, 46–53; col. 5, ll. 14–22; col. 5, l. 65–col. 6, l. 5; col. 7, ll. 37–41, 48–49; col. 8, ll. 5–7, 60–67; col. 9, ll. 3–52; and shown in Figs. 1 (e.g., steps 20 and 22), 2 (e.g., steps 20, 21, and 22), 4 (e.g., label 44), 10 (e.g., labels 82 and 86), 15 (e.g., label 114), and 16, and equivalents thereof.[10]

The '854 patent specification describes exemplary algorithms for performing the claimed function. As set forth in Arendi's Opening Brief, the specification describes exemplary algorithms for inserting a second information into the document. (*See* D.I. 46 at 17–19, 29–31.) Additionally, the patent specification discloses that the second information can be contact related

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[9] As reflected in Arendi's proposed construction, the corresponding structure disclosed in the specification is a computer system programmed with such an algorithm. (*See supra* at 10.)

information. (*See, e.g.*, D.I. 47, Ex. D at Fig. 1 steps 20, 22; Fig. 2 steps 20-22; col. 4, ll. 46–53; col. 5, ll. 14–22.) The patent specification provides further explanation of exemplary algorithms for "inserting the contact related information into the document," as illustrated in Exhibit 9 and cited as part of the identified corresponding structure above.[11] The cited portions of the specification to which Microsoft objects for this claim limitation (*see* Ex. 1 at 10) reference figures that illustrate exemplary corresponding structure or the operation thereof, including, for example, Figure 4. These portions should be included to fully describe the corresponding structure. *See Cardiac Pacemakers*, 296 F.3d at 1119 ("[C]orresponding structure must include ***all structure*** that actually performs the recited function.").

CONCLUSION

For the foregoing reasons, Plaintiff Arendi S.A.R.L. respectfully requests that this Court construe, as a matter of law, the disputed terms of the patent-in-suit as set forth above.

Dated: January 21, 2011

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[11] As reflected in Arendi's proposed construction, the corresponding structure disclosed in the specification is a computer system programmed with such an algorithm. (*See supra* at 10.)

CERTIFICATE OF SERVICE

I, Michele Sherretta Budicak, Esquire, hereby certify that on January 21, 2011, I caused to be electronically filed a copy of the foregoing document with the Clerk of the Court using CM/ECF, which will send notification that such filing is available for viewing and downloading to the following counsel of record:

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I further certify that on January 21, 2011, I caused a copy of the foregoing document to be served by e-mail on the above-listed counsel and on the following non-registered participants:

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Exhibit 6L

Transaction History Date 2011-01-19
Date information retrieved from USPTO
Application Information Data...
system record...

Notice of Allowability	Application No. 12/182,048	Applicant(s) HEDLOY, ATLE	
	Examiner QUOC A. TRAN	Art Unit 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to *Applicant's supplemental responses filed 12/21/2010 and telephone interview on 01/07/2011*.

2. ☒ The allowed claim(s) is/are *1-2, 4, 3, 5-17, 21-22, 18-20, 23, 24, 26, 25, 27-44 (renumbering as 1-44 respectively)*.

3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All b) ☐ Some* c) ☐ None of the:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
      3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
   (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
   (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

   Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date See Continuation Sheet
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date *01/07/2011*.
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

/DOUG HUTTON/
Supervisory Patent Examiner, Art Unit 2176

Continuation Sheet (PTOL-37) **Application No. 12/182,048**

Continuation of Attachment(s) 3. Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date: 1/3/2011, 12/30/2010, 12/21/2010. 12/08/ 2010.

DETAILED ACTION

In response to Applicant's supplemental responses filed 12/21/2010 and telephone interview on 01/07/2011; the current patent application originally filed 07/29/2008; continuation of 09/189, 626 filed ***11/10/1998***, now US Patent 6,323,853.

The examiner's amendment was authorized by attorney of record Jacub Mitcha Attorney for Applicants.

- Claims 1-44, are pending.
- Claims 1, 13, 18, and 23-44 are currently amended.
- Claims 1, 18, 23 and 42 are independent claims
- Claims 2-12, 14-17 and 19-22 were original/previously presented.

In addition, the Examiner acknowledges the Terminal Disclaimer; which was filed on 12/08/2010 and APPROVED on 01/06/2011 [see eDan **DISQ dated 01/06/2011 for details].

EXAMINER'S AMENDMENT

The application has been amended as follows:

1. (Currently Amended) A computer-implemented method for finding data related to the contents of a document using a first computer program running on a computer, the method comprising:

displaying the document electronically using the first computer program;

while the document is being displayed, analyzing, in a computer process, first

information from the document to determine if the first information is at least one of a plurality of types of information that can be searched for in order to find second information related to the first information;

retrieving the first information;

providing an input device, configured by the first computer program, that allows a user to enter a user command to initiate an operation, the operation comprising (i) performing a search using at least part of the first information as a search term in order to find the second information, of a specific type or types, associated ~~in an information source~~ with the search term in an information source external to the document, wherein the specific type or types of second information is dependent at least in part on the type or types of the first information, and (ii) performing an action using at least part of the second information;

in consequence of receipt by the first computer program of the user command from the input device, causing a search for the search term in the information source, using a second computer program, in order to find second information related to the search term; and

if searching finds any second information related to the search term, performing the action using at least part of the second information, wherein the action is of a type depending at least in part on the type or types of the first information.

2. (Original) A method according to claim 1, wherein the first information comprises at least one of name-, person-, company- and address-related information.

3. (Previously Presented) A method according to claim 1, wherein performing the action includes performing the action in the first computer program.

4. (Previously Presented) A method according to claim 2, wherein performing the action includes performing the action in the first computer program.

5. (Previously Presented) A method according to claim 3, wherein performing the action includes causing addition of at least part of the second information to the first information in the document.

6. (Previously Presented) A method according to claim 3, wherein performing the action includes causing display of at least part of the second information.

7. (Previously Presented) A method according to claim 3, wherein performing the action includes causing display of at least part of the second information by the first computer program.

8. (Previously Presented) A method according to claim 1, further comprising, providing a prompt for updating the information source to include the first information.

9. (Previously Presented) A method according to claim 1, further comprising, if the

search is not successful, providing a prompt for updating the information source to include the first information.

10. (Previously Presented) A method according to claim 1, wherein receipt by the first computer program of the user command precedes analyzing the document.

11. (Original) A method according to claim 1, wherein analyzing the document is completed after the receipt of the user command is completed and before searching is initiated.

12. (Previously Presented) A method according to claim 1, wherein the input device is a graphical input device.

13. (Currently Amended) A method according to claim 1, wherein the user command is the only command from a user necessary ~~as a condition~~ to initiate performing the operation.

14. (Previously Presented) A method according to claim 1, wherein the input device is a menu and the entry of the user command includes a user's selection of the menu and click on a menu choice from the menu.

15. (Previously Presented) A method according to claim 1, further comprising, if

searching results in a plurality of distinct instances of second information, displaying such instances to enable user selection of one of them for use in performing the action.

16. (Previously Presented) A method according to claim 1, wherein the information source is associated with the second computer program and is available on the computer.

17. (Previously Presented) A method according to claim 1, wherein the information source is associated with the second computer program and is available through the computer.

18. (Currently Amended) A computer-implemented method for finding data related to the contents of a document using a first computer program running on a computer, the method comprising:

displaying the document electronically using the first computer program;

while the document is being displayed, analyzing, in a computer process on the computer, first information from the document to determine if the first information is at least one of a plurality of types of information that can be searched for in order to find second information related to the first information, and wherein the first information comprises at least one of name-, person-, company-, and address-related information;

providing an input device, configured by the first computer program, that allows a user to enter a user command to initiate an operation, the operation comprising (i)

performing a search using at least part of the first information as a search term in order to find the second information, of a specific type or types, associated with the search term in a user editable information source outside the document, wherein the specific type or types of second information is dependent at least in part on the type or types of the first information, and (ii) performing an action using at least part of the second information, wherein the input device includes a menu;

retrieving the first information;

in consequence of receipt by the first computer program of the user command, such user command including a user's selection of the menu and click on a menu choice from the menu, causing a search for the search term in the user editable information source, using a second computer program, in order to find second information related to the search term in the user editable information source ~~outside the document~~; and

if searching finds any second information related to the search term, performing the action using at least part of the second information, wherein the action is of a type depending at least in part on the type or types of the first information and performing the action includes at least causing display of at least part of the second information.

19. (Previously Presented) A method according to claim 18, further comprising, if searching results in a plurality of occurrences of second information, causing display of such instances to enable user selection of one of them for use in performing the action.

20. (Previously Presented) A method according to claim 18, wherein performing the action includes causing addition of at least part of the second information to the first information in the document.

21. (Previously Presented) A method according to claim 1, wherein performing the action includes causing insertion of at least part of the second information into the document.

22. (Previously Presented) A method according to claim 1, wherein performing the action includes causing insertion of at least part of the second information into the document by the first computer program.

23. (Currently Amended) At least one non-transitory computer readable medium encoded with instructions which, when loaded on a computer, establish processes for finding data related to the contents of a document using a first computer program running on a computer, the processes comprising:

displaying the document electronically using the first computer program;

while the document is being displayed, analyzing, in a computer process, first information from the document to determine if the first information is at least one of a plurality of types of information that can be searched for in order to find second information related to the first information;

retrieving the first information;

providing an input device, configured by the first computer program, that allows a user to enter a user command to initiate an operation, the operation comprising (i) performing a search using at least part of the first information as a search term in order to find the second information, of a specific type or types, associated ~~in an information source~~ with the search term in an information source external to the document, wherein the specific type or types of second information is dependent at least in part on the type or types of the first information, and (ii) performing an action using at least part of the second information;

in consequence of receipt by the first computer program of the user command from the input device, causing a search for the search term in the information source, using a second computer program, in order to find second information related to the search term; and

if searching finds any second information related to the search term, performing the action using at least part of the second information, wherein the action is of a type depending at least in part on the type or types of the first information.

24. (Currently Amended) At least one non-transitory computer readable medium according to claim 23, the instructions ~~further~~ establishing processes wherein the first information comprises at least one of name-, person-, company- and address-related information.

25. (Currently Amended) At least one non-transitory computer readable medium

according to claim 23, the instructions ~~further~~ establishing processes wherein performing the action includes performing the action in the first computer program.

26. (Currently Amended) At least one non-transitory computer readable medium according to claim 24, the instructions ~~further~~ establishing processes wherein performing the action includes performing the action in the first computer program.

27. (Currently Amended) At least one non-transitory computer readable medium according to claim 25, the instructions ~~further~~ establishing processes wherein performing the action includes causing addition of at least part of the second information to the first information in the document.

28. (Currently Amended) At least one non-transitory computer readable medium according to claim 25, the instructions ~~further~~ establishing processes wherein performing the action includes causing display of at least part of the second information.

29. (Currently Amended) At least one non-transitory computer readable medium according to claim 25, the instructions ~~further~~ establishing processes wherein performing the action includes causing display of at least part of the second information by the first computer program.

30. (Currently Amended) At least one non-transitory computer readable medium

according to claim 23, the instructions ~~further~~ establishing processes comprising:

providing a prompt for updating the information source to include the first information.

31. (Currently Amended) At least one non-transitory computer readable medium according to claim 23, the instructions ~~further~~ establishing processes comprising:

if the search is not successful, providing a prompt for updating the information source to include the first information.

32. (Currently Amended) At least one non-transitory computer readable medium according to claim 23, the instructions ~~further~~ establishing processes wherein receipt by the first computer program of the user command precedes analyzing the document.

33. (Currently Amended) At least one non-transitory computer readable medium according to claim 23, the instructions ~~further~~ establishing processes wherein analyzing the document is completed after the receipt of the user command is completed and before searching is initiated.

34. (Currently Amended) At least one non-transitory computer readable medium according to claim 23, the instructions ~~further~~ establishing processes wherein the input device is a graphical input device.

35. (Currently Amended) At least one non-transitory computer readable medium according to claim 23, the instructions ~~further~~ establishing processes wherein the user command is the only command from a user necessary ~~as a condition~~ to initiate performing the operation.

36. (Currently Amended) At least one non-transitory computer readable medium according to claim 23, the instructions ~~further~~ establishing processes wherein the input device is a menu and the entry of the user command includes a user's selection of the menu and click on a menu choice from the menu.

37. (Currently Amended) At least one non-transitory computer readable medium according to claim 23, the instructions ~~further~~ establishing processes comprising:

if searching results in a plurality of distinct instances of second information, displaying such instances to enable user selection of one of them for use in performing the action.

38. (Currently Amended) At least one non-transitory computer readable medium according to claim 23, the instructions ~~further~~ establishing processes wherein the information source is associated with the second computer program and is available on the computer.

39. (Currently Amended) At least one non-transitory computer readable medium

according to claim 23, the instructions ~~further~~ establishing processes wherein the information source is associated with the second computer program and is available through the computer.

40. (Currently Amended) At least one non-transitory computer readable medium according to claim 23, the instructions ~~further~~ establishing processes wherein performing the action includes causing insertion of at least part of the second information into the document.

41. (Currently Amended) At least one non-transitory computer readable medium according to claim 23, the instructions ~~further~~ establishing processes wherein performing the action includes causing insertion of at least part of the second information into the document by the first computer program.

42. (Currently Amended) At least one non-transitory computer readable medium encoded with instructions which, when loaded on a computer, establish processes for finding data related to the contents of a document using a first computer program running on a computer, the processes comprising:

displaying the document electronically using the first computer program;

while the document is being displayed, analyzing, in a computer process on the computer, first information from the document to determine if the first information is at least one of a plurality of types of information that can be searched for in order to find

second information related to the first information, and wherein the first information comprises at least one of name-, person-, company-, and address-related information;

providing an input device, configured by the first computer program, that allows a user to enter a user command to initiate an operation, the operation comprising (i) performing a search using at least part of the first information as a search term in order to find the second information, of a specific type or types, associated with the search term in a user editable information source outside the document, wherein the specific type or types of second information is dependent at least in part on the type or types of the first information, and (ii) performing an action using at least part of the second information, wherein the input device includes a menu;

retrieving the first information;

in consequence of receipt by the first computer program of the user command, such user command including a user's selection of the menu and click on a menu choice from the menu, causing a search for the search term in the user editable information source, using a second computer program, in order to find second information related to the search term in the user editable information source ~~outside the document~~; and

if searching finds any second information related to the search term, performing the action using at least part of the second information, wherein the action is of a type depending at least in part on the type or types of the first information and performing the action includes at least causing display of at least part of the second information.

43. (Currently Amended) At least one non-transitory computer readable medium according to claim 42, the instructions ~~further~~ establishing processes comprising:

if searching results in a plurality of occurrences of second information, causing display of such instances to enable user selection of one of them for use in performing the action.

44. (Currently Amended) At least one non-transitory computer readable medium according to claim 42, the instructions ~~further~~ establishing processes wherein performing the action includes causing addition of at least part of the second information to the first information in the document.

Allowable Subject Matter

❖ Claims 1-44 are allowed:

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The examiner can normally be reached on Mon through Fri 8AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on (571)272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Quoc A. Tran/
Examiner, Art Unit 2176

/DOUG HUTTON/
Supervisory Patent Examiner, Art Unit 2176

Exhibit 6K

IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

ARENDI S.A.R.L., Plaintiff, v. MICROSOFT CORPORATION, Defendant.	C.A. No. 09-119-LPS

PLAINTIFF'S SUPPLEMENTAL ANSWERING BRIEF IN SUPPORT OF ITS PROPOSED CLAIM CONSTRUCTIONS

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Dated: February 4, 2011

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TABLE OF AUTHORITIES

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Cases

— Emphasis Added Unless Otherwise Noted —

EXHIBIT LIST

Exhibits 12 through 22 refer to the exhibits to the Declaration Of Jon R. Carter In Support Of Plaintiff's Supplemental Answering Brief In Support Of Its Proposed Claim Constructions, filed concurrently herewith. Citations to docket entries refer to ECF pagination unless otherwise noted.

Exhibit 12: Excerpts from the Sept. 21, 2004 Trial Tr. in *Arendi USA*, *Inc*. *v*. *Microsoft Corp*., No. CA 02-343T (D.R.I.), taken from the prosecution history of the '854 patent.

Exhibit 13: Excerpts from the Sept. 23, 2004 Trial Tr. in *Arendi USA*, *Inc*. *v*. *Microsoft Corp*., No. CA 02-343T (D.R.I.), taken from the prosecution history of the '854 patent.

Exhibit 14: U.S. Patent No. 5,835,089

Exhibit 15: Excerpts from Microsoft's Suppl. Responses to Arendi's Interrogs., *Arendi USA, Inc. v. Microsoft Corp.*, No. CA 02-343T (D.R.I.), taken from the prosecution history of the '854 patent.

Exhibit 16: Excerpt from Dictionary of Computer and Internet Terms (5th ed. 1996)

Exhibit 17: Excerpt from Dictionary of Personal Computing and the Internet (1997)

Exhibit 18: Excerpt from Newton's Telecom Dictionary (14th ed. 1998)

Exhibit 19: Excerpt from The Computer Glossary (8th ed. 1998)

Exhibit 20: Excerpt from Michael Halvorson & Michael Young, Running Microsoft Office 97 (Microsoft Press 1997)

Exhibit 21: Excerpts from Webster's New World Dictionary of Computer Terms (6th ed. 1997)

Exhibit 22: Excerpts from the July 28, 2010, Dep. Tr. of Dr. Richard Taylor

Plaintiff Arendi S.A.R.L. ("Arendi") respectfully submits this answering brief in support of its proposed supplemental constructions for the disputed claim terms of U.S. Patent No. 7,496,854 ("the '854 patent").

INTRODUCTION

The '854 patent is directed to enabling a user in one application program, such as Microsoft Word, to access information in a second application program, such as a database program. (D.I. 47, Ex. D at col. 1, ll. 34–43; col. 2, ll. 14–34.) As explained in the "Background of the Invention" section of the patent, a user of a word processor or spreadsheet program may require retrieval of information from a different program, such as a database program:

> In recent years, with the advent of programs, such as word processors, spreadsheets, etc. (hereinafter called "word processors") users may require retrieval of information, such as name and address information, etc., for insertion into a document, such a letter, fax, etc., created with the word processor. Typically, the information is retrieved by the user from an information management source external to the word processor, such as a database program, contact management program, etc., or from the word processor itself, for insertion into the document. Examples of such word processors are WORD™, NOTEPAD™, EXCEL™, WORDPAD™, WORDPERFECT™, QUATROPRO™, AMIPRO™, etc., and examples of such information management sources are ACCESS™, OUTLOOK™, ORACLE™, DBASE™, RBASE™, CARDFILE™, etc.

(*Id.* at col. 1, ll. 29–43.) But the patent explains that "[t]his requires the user to learn how to use and have access to the database." (*Id.* at col. 1, ll. 45–46.) The patent overcomes this problem by providing a mechanism for a user to access information in one program while working ***simultaneously*** in ***another*** program:

> The above and other objects are achieved according to the present invention by providing a novel method, system and computer readable medium for providing a function item, such as a key, button, icon, or menu, tied to a user operation in a computer, whereby a single click on the function item in a window or program on a computer screen, or one single selection in a menu in a program, initiates retrieval of name and addresses and/or other person or company related information, while the user works simultaneously in another program, e.g., a word processor.

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(*Id.* at col. 2, ll. 14–23.) This novel mechanism for linking two separate application programs is central to every claim of the '854 patent, as illustrated by representative claim 1:

> 1. A method for information handling within a document created using a first application program comprising the steps of:
> entering a first information in the first application program;
> marking without user intervention the first information to alert the user that the first information can be utilized in a second application program; and
> responding to a user selection by inserting a second information into the document, the second information associated with the first information from a second application program.

(*Id.* at col. 10, ll. 41–51.)

A number of Microsoft's constructions—including those for "computer program," "application program," "application," "second computer program," and "second application program"—are designed to erase this fundamental aspect of the patented invention. Indeed, Microsoft attempts to manufacture invalidity defenses by arguing that ***features*** of an application program (such as the spell-checker feature of Microsoft Word) are themselves application programs, thus rewriting the claims to encompass the interaction between two parts of the ***same*** application program. But these constructions contradict the plain language of the claims, are inconsistent with the intrinsic record, and are contrary to the ordinary and customary meaning of the terms to those of skill in the art. And Microsoft's other constructions fare no better, as set forth below. Accordingly, Plaintiff respectfully requests that the Court reject Microsoft's attempts to rewrite the claims and adopt Plaintiff's proposed constructions.

ARGUMENT

I. "Computer Program"

Arendi's Construction	Microsoft's Construction
"a self-contained set of instructions, as opposed to a routine or a library, intended to be executed on a computer so as to perform some task"	"any interpreted or executable code mechanism, including but not limited to scripts, interpreters, dynamic link libraries, Java classes and complete executable programs, etc."

A. The Patentee Did Not Define "Computer Program."

Microsoft asserts that the patentee acted as his own lexicographer for the claim term "computer program." (D.I. 287 at 8.) But in support, Microsoft simply excerpts text it views as helpful without regard to the terms actually used by the patentee. Microsoft candidly admits that the language it uses for its construction comes "directly from the discussion in the specification of '***computer code devices***'" (*id.*)—not "computer program":

> The computer code devices of the present invention can be any interpreted or executable code mechanism, including but not limited to scripts, interpreters, dynamic link libraries, Java classes, and complete executable programs, etc.

(D.I. 47, Ex. D at col. 9, ll. 43–47.) This is clearly not a definition of the claim term "computer program." *See Laryngeal Mask Co. v. Ambu*, 618 F.3d 1367, 1372 (Fed. Cir. 2010) ("To be his own lexicographer, a patentee must use a 'special definition of the term [that] is ***clearly stated*** in the patent specification or file history.'" (citation omitted)). Because the text relied upon by Microsoft on its face does not purport to define the claim term "computer program," Microsoft's proposed construction must fail.

B. The Patentee Expressly Differentiated "Computer Programs" From "Computer Code Devices."

Microsoft attempts to justify its *non sequitur* of citing text related to a different term as a definition of "computer program" by declaring—without any support—that the terms "computer program product" and "computer code devices" are synonymous. (D.I. 287 at 8.) But the fact that the patentee chose to use different terms itself militates against Microsoft's attempt to rewrite the claims of the '854 patent to cover interactions between "first" and "second" "computer code devices" instead of "computer programs." *See CFMT, Inc. v. YieldUp Int'l Corp.*, 92 F. Supp. 2d 359, 372 (D. Del. 2000) (recognizing that when one term is used in the specification and a different term was used in the claim, the inventors were capable of referring

to the first term if that was what they had intended to convey), *rev'd on other grounds*, 349 F.3d 1333 (Fed. Cir. 2003); *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co.*, 224 F.3d 1308, 1317 (Fed. Cir. 2000) ("[W]e must presume that the use of . . . different terms in the claims connotes different meanings.").

Moreover, the relevant passage discussing "computer code devices" and "computer program products" makes clear that the patentee did ***not*** use them synonymously, but rather used the term "computer code devices" generically to refer to both (i) software for controlling the hardware of the computer and for enabling the computer to interact with a human user; and (ii) the "computer program product" of the invention:

> Stored on any one or on a combination of computer readable media, the present invention includes software for controlling both the hardware of the computer **200** and for enabling the computer **200** to interact with a human user. Such software may include, but is not limited to, device drivers, operating systems and user applications, such as development tools. Such computer readable media further includes the computer program product of the present invention for performing any of the processes according to the present invention, described above (see, e.g., FIGS. **1-15**). The computer code devices of the present invention can be any interpreted or executable code mechanism, including but not limited to scripts, interpreters, dynamic link libraries, Java classes, and complete executable programs, etc.

(D.I. 47, Ex. D at col. 9, ll. 33–47.) Nothing in the specification suggests that the claimed "computer program" refers to all software "computer code devices."

C. Arendi's Proposed Construction Reflects The Ordinary And Customary Meaning Of "Computer Program."

Arendi's construction also comports with the ordinary and customary meaning of "computer program" to those of skill in the art at the time of the invention, as set forth in Plaintiff's Opening Brief: "a self-contained set of instructions, as opposed to a routine or library, intended to be executed on a computer so as to perform some task." (D.I. 285 at 7–8.) Microsoft

argues that various other dictionary definitions support its construction.[1] (*See* D.I. 287 at 9.) But none of these definitions provides that a "computer program" includes "scripts, interpreters, dynamic link libraries, [or] Java classes," as Microsoft contends. And even if they did, such usage could not trump the usage of the term "computer program" within the specification. *See Free Motion Fitness, Inc. v. Cybex Int'l, Inc.*, 423 F.3d 1343, 1348–49 (Fed. Cir. 2005) ("[T]he rule that 'a court will give a claim term the full range of its ordinary meaning,' does not mean that the term will presumptively receive its broadest dictionary definition . . . . Rather, . . . the task is to scrutinize the intrinsic evidence in order to determine the most appropriate definition." (citations omitted)). In fact, the sole disclosure within the specification of a library or routine describes these entities to be "computer code devices," not "computer programs," as discussed above. (*See supra* section I.B.) The dictionary definitions thus support Arendi's—not Microsoft's—proposed construction.

D. Arendi's Proposed Construction Further Reflects The Prosecution History Regarding "Computer Program."

Finally, the intrinsic evidence before the examiner also makes clear that libraries and routines, such as DLLs, do not constitute computer programs. Indeed, one of ***Microsoft's own witnesses*** during the earlier Rhode Island trial testified that DLLs are "a set of subroutines," ***not*** computer programs. In that testimony—which the patentee submitted to the PTO during prosecution of the '854 patent (*see* D.I. 47, Ex. D at 4)[2]—David Block, the purported inventor of

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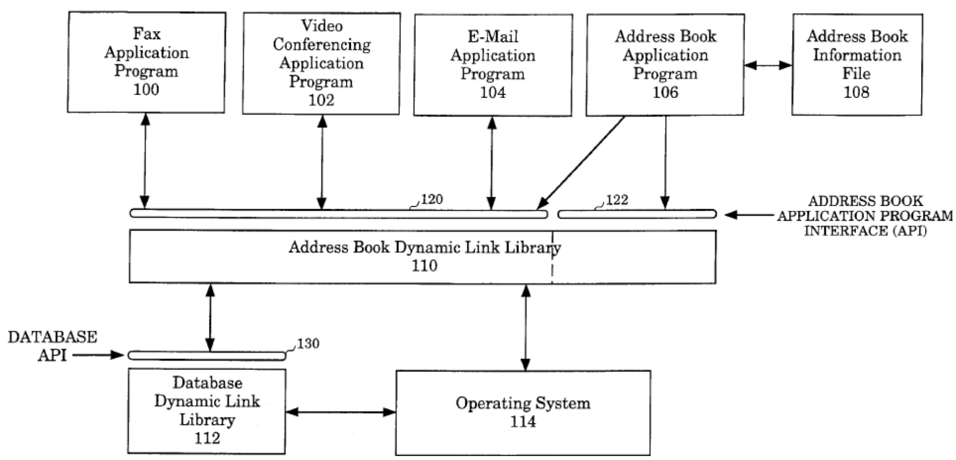
[1] Microsoft, in fact, inconsistently argues both that the patentee acted as his own lexicographer ***and*** that its construction reflects the ordinary meaning. *See Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008) ("A patentee may act as its own lexicographer and *assign to a term a unique definition that is* ***different*** *from its ordinary and customary meaning* . . . .").

[2] *See V-Formation, Inc. v. Benetton Group SpA*, 401 F.3d 1307, 1311 (Fed. Cir. 2005) ("This court has established that 'prior art cited in a patent or cited in the prosecution history of the patent constitutes intrinsic evidence.'" (citations omitted)).

alleged prior art asserted by Microsoft in both the previous and this litigation, was asked by the court whether a particular CD-ROM contained any programs:

> "***I don't believe it contains any programs***. It may contain what's commonly referred to as ***a dynamic link library or a DLL***, which perhaps [] some of the prior testimony [] mentioned, but it's something that you can call from another program or use from another program, ***a set of subroutines.***"

(Ex. 12 at AHL0112213–14.) This understanding of dynamic link libraries as a set of subroutines which ***support*** computer programs is confirmed elsewhere within the intrinsic evidence, including prior art submitted to the examiner, which clearly shows that dynamic link libraries are not themselves "programs," but rather are resources ***used by*** "programs":



(*See*, *e.g.*, Ex. 14 at Fig. 2; *see also* D.I. 47, Ex. D at 2.)

Microsoft improperly ignores these portions of the prosecution history and instead focuses on three preliminary rejections by the examiner over the prior art Tso reference (U.S. Patent No. 6,085,201), in which the examiner initially asserted that the Tso reference disclosed every claim limitation, including a "second application program."[3] (D.I. 287 at 10; D.I. 288,

[3] Despite Microsoft's assertions, however, the examiner never stated that a dynamic link library was a "computer program." Even if he had, the PTO does not interpret the claims during prosecution using the same legal standards that apply here after issuance. *In re Morris*, 127 F.3d 1048, 1053–54 (Fed. Cir. 1997) (recognizing that the PTO, which applies the "broadest

(Continued…)

Exs. 8–10.) The patentee, however, explicitly traversed the examiner's rejection based on the Tso reference on all three occasions and explained that "the system described by Tso is directed to ***a different subject*** than that claimed by the present invention." (D.I. 47, Ex. E at AHL0000400.) Indeed, the patentee cited Tso's disclosure that "the template engine 5 and user interface 2 may be ***fully integrated into an e-mail application***" (D.I. 288, Ex. 14 at col. 7, ll. 9–11) and explained that Tso differed from "the claimed invention['s] use[] [of] search information (i.e., the text to be processed) ***in a second application program*** to find second information associated with the search information . . . ." (D.I. 47, Ex. E at AHL0000401.) The examiner, moreover, ultimately allowed the claims describing "first" and "second" "application programs" and "computer programs" over Tso—as well as over ***the very spell checking prior art*** Microsoft now attempts to redraft the claims to cover. (*See, e.g.*, Ex. 15 at AHL0110024, AHL0110027 (disclosure of Microsoft contentions regarding Microsoft Office 97 "interactive spelling checker").) Accordingly, Microsoft's attempt to use preliminary rejections by the examiner to change the meaning of the term "computer program" evidenced by the specification, ordinary meaning of the term, and the rest of the prosecution history should be rejected. *See Phillips,* 415 F.3d at 1317 ("[B]ecause the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes.").

II. "Application Program" And "Application"

Term	Arendi's Construction	Microsoft's Construction
application program	"a computer program designed to assist in the performance of a specific task, such as word	"an individual computer program that implements part of an application"

reasonable interpretation" to the claim terms, does not "interpret claims in the same manner as courts are required to during infringement proceedings").

	processing, accounting, or inventory management."[4]	
application	No separate construction required.	"a computer program (or suite of programs) used for a specific user-oriented task, such as accounting purposes, medical, scientific analysis, or word processing"

A. Microsoft Attempts To Separately Construe Both "Application Program" And "Application" To Rewrite The Claims

Microsoft urges the Court to construe both "application program" and "application," even though the term "application" never appears by itself in the claims. (D.I. 287 at 12.) Even if it were appropriate to separately define "application"—which it is not[5]—it is clear, when Microsoft's two constructions are viewed together, that they are inconsistent with the intrinsic record and must therefore be rejected. For example, when the reference to "application" in Microsoft's proposed construction of "application program" is substituted with Microsoft's proposed construction of "application," Microsoft's construction of "application program" is:

> "an individual computer program that implements part of <u>a computer program (or suite of programs) used for a specific user-oriented task, such as accounting purposes, medical, scientific analysis, or word processing.</u>"

The resulting construction departs even from Microsoft's own cited extrinsic evidence for "application" and is not supported by the intrinsic evidence of the '854 patent.[6] Indeed,

[4] Arendi has no objection, to the extent the Court believes it is necessary, to Microsoft's proposal that "specific task" be further explained as "user-oriented task."

[5] *See Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001) ("The claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose."); *see also Am. Med. Sys., Inc. v. Biolitec, Inc.*, 666 F. Supp. 2d 216, 220 (D. Mass. 2009) (declining to construe "the general term 'cladding'" given that "[t]he claims nowhere refer to 'cladding' independently; they refer only to 'glass cladding' and 'core cladding'").

[6] Microsoft cites to the specification's ***caption*** for Example 7—"Spreadsheet Application"—to support its proposal to construe "application" apart from "application program." (D.I. 287 at 13–14.) The passage cited, however, simply describes an ***application of the invention*** to documents such as EXCEL spreadsheets. Nothing within the passage suggests that the patentee used the term "application" in the technical sense implied by Microsoft.

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Microsoft seeks to rely upon this construction to conclude that component parts of Microsoft Word, such as spell-checking functionality, are individual application programs simply because these components each implement "part of" a larger computer program used for word processing. (*See* D.I. 287 at 12–13.) The intrinsic evidence, however, describes a mechanism for the user to access information in one program while working ***simultaneously*** in ***another*** program—not for the exchange of information ***within*** the same "application program." (*See, e.g.*, D.I. 47, Ex. D at col. 2, ll. 14–23.)

The absurdity of Microsoft's construction is even more apparent when viewed in light of Microsoft's proposed "computer program" construction:

> "**any** individual **interpreted or executable code mechanism** . . . that implements part **of any interpreted or executable code mechanism** . . . (or suite of programs) used for a specific user-oriented task, such as accounting purposes, medical, scientific analysis or word processing."

With this proposed definition, Microsoft suggests that any "code mechanism" within an application program—even down to individual subroutines, functions, or lines of code—would constitute its own application program, so long as it implements part of a computer program that is used for the types of tasks identified in Microsoft's construction. This construction would eviscerate the entire stated purpose of the invention of the '854 patent and effectively merge the "first application program" and "second application program" limitations into a single "application program," which is improper. *See Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) ("[C]laims are interpreted with an eye toward giving effect to all terms in the claim." (citations omitted)). Moreover, such a construction finds no support whatsoever in the specification and must therefore be rejected. *Phillips*, 415 F.3d at 1316 ("The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." (citation omitted)).

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B. Arendi's Proposed Construction Reflects The Ordinary And Customary Meaning Of "Application Program."

The extrinsic evidence advanced by Microsoft confirms Arendi's proposed construction of "application program" and demonstrates how far Microsoft's proposed constructions stray from the ordinary meaning of the claim terms used by the patentee. *Id.* at 1312 ("[T]he words of a claim 'are generally given their ordinary and customary meaning.'" (citation omitted)). Microsoft attempts to defend its constructions of "application program" and "application," for example, by citing to a dictionary definition of "application" from Prentice Hall's Illustrated Dictionary of Computing. (D.I. 288, Ex. 6 at 29–30.) Microsoft's cited definition, however, provides that "application" could refer to "a computer program" ***or*** to a "suite of programs" and explains that while the "term 'application' refers to the entire set of programs that collectively implement a specific business process," "***application programs***" are "***[i]ndividual programs*** that implement part of this business process." (*Id.*) Nothing within this definition suggests that an "application program," such as Microsoft Word, could further contain other "application programs," as Microsoft now asserts through its constructions of "application program" and "application."

Moreover, numerous dictionaries define "application program" with reference to the ***same*** illustrative examples of application programs identified in the '854 patent specification.

- "Computer programs that perform useful work not related to the computer itself. Examples include ***word processors, spreadsheets,*** accounting systems, and engineering programs. Contrast UTILITIES; OPERATING SYSTEM." (Ex. 16 at 18.)

- "Program that makes the computer do useful work, ***such as word processing or a spreadsheet.*** The five most popular application programs are ***word processing, accounting, database management, spreadsheet analysis and desktop publishing***." (Ex. 17 at 10.)

- "A computer software program designed for a specific job, ***such as word processing, accounting, spreadsheet, etc.***" (Ex. 18 at 57.)

- "Any data entry, update, query or report program that processes data for the user. It includes the generic ***productivity software (spreadsheets, word processors, database programs, etc.)*** as well as custom and packaged programs for payroll, billing, inventory and other accounting purposes. Contrast with *system program*." (Ex. 19 at 13.)

There is no dispute that productivity software, including word processors such as Microsoft Word, were well known in the prior art to include features such as spell checking. But nothing within the extrinsic evidence identifies such features as separate application programs. Indeed, Microsoft's ***own*** documentation from the relevant time period shows that those having ordinary skill in the art understood Microsoft Word to be ***one*** of the ***five*** application programs included in the Microsoft Office suite, not an innumerable collection of "application programs":

> Microsoft Office 97, Professional Edition, is a state-of-the-art ***application suite*** containing ***five*** Windows 95 ***application programs*** and several powerful utilities that will make you more productive at home and in the office.

(Ex. 20 at MS0206309–10 (listing application programs as Word 97, Excel 97, PowerPoint 97, Access 97, and Outlook 97).)

Even Microsoft's expert has previously described the spell checking feature as "one of the tools in Word," rather than as a separate application program. (Ex. 13 at AHL0112513 ("Q. . . . In fact, . . . spellchecker is in Word, right? A. Yes, there's a lot of tools in word. . . . Spellchecker is one of the tools in Word."). Arendi's technical expert, Dr. Taylor, agrees and has repeatedly explained that Microsoft's attempts to identify Microsoft Word features as separate "application programs" are contrary to the intrinsic evidence and the understanding of one having ordinary skill in the art. (*See, e.g.*, Ex. 22 at 155:17–24 ("Q. So your opinion is you don't think that the spell checker is a second application program? A. . . . [T]he spell checker in [Office] '95 or '97 is a component, I think you mentioned it as a [DLL], . . . of the word

processing system. And there's no second application program . . . that you would then use in a manner consistent with [the] limitations.").)[7]

C. Arendi's Proposed Construction Further Reflects The Prosecution History Regarding "Application Program."

Furthermore, nothing within the intrinsic evidence justifies Microsoft's attempt to depart from the ordinary and customary meaning of the term "application program." Microsoft attempts to support its proposed constructions by again citing to examiner rejections based on the Tso reference that were *traversed* by the patentee, as discussed above. (D.I. 287 at 14; *see supra* page 7.) Microsoft further alleges that passages from Tso itself—although not cited by the examiner—demonstrate that features within a "first application program" should be understood as "second application programs." (D.I. 287 at 14.) The text cited by Microsoft, however, *differentiates* between "the user's e-mail ***application*** [that] provide[s] a user interface" and a "template ***engine***" which supports the operation of the Tso invention in the e-mail ***application****:*

> In order for a user to compose and/or reply to an e-mail message with the aid of the template ***engine*** 5 according to the present invention, the user's e-mail ***application*** must provide a user interface . . . .

(D.I. 287 at 14 (citing D.I. 288, Ex. 14 at col. 4, ll. 1–12).) Nothing in the Tso patent indicates that Tso considered the template engine to be its own application or application program. Indeed, Tso's use of different terms contradicts the suggestion that Tso considered an "engine" to be the same as an "application." *See, e.g.*, *CFMT, Inc.*, 92 F. Supp. 2d at 372.

Prior testimony from Microsoft's own witnesses, moreover, submitted by the patentee to the examiner, contradicts Microsoft's current attempt to describe the Word spell-checking

[7] Microsoft, to suggest otherwise, cites to a textbook co-authored by Dr. Taylor, regarding software architecture. (*See* D.I. 287 at 15.) The cited text, however, is irrelevant to Microsoft's claim that features of "application programs" constitute their own "application programs." (*See, e.g.*, D.I. 288, Ex. 15 at 12–13.) Nor does the cited text even discuss "application programs." (*Id.*)

feature as a "second application program" and supports Arendi's proposed constructions. As Dr. Croft himself testified, spell checking is "one of the tools in Word." (*See supra* pages 11–12.) Nothing within the intrinsic record, which discusses Microsoft Word, suggests such tools to be "application programs." Nor does anything within the prosecution history support Microsoft's invalidity-driven position that features such as spell checking constitute "second application programs." Indeed, the examiner had before him the very spell checking prior art now relied upon by Microsoft. (*See, e.g.*, Ex. 15 at AHL0110024, AHL0110027 (disclosure of Microsoft contentions regarding Microsoft Office 97 "interactive spelling checker").) But, as even the purported designer of the accused feature—Dr. Reynar—explained, "the [Word] spellchecker ***isn't about shuffling data from one app to another*** . . . ." (Ex. 12 at AHL0112173.) The patentee, in contrast, consistently described an invention that allows a user in one application program, such as Microsoft Word, to access information in a second application program, such as a database program. (*See, e.g.*, D.I. 47, Ex. D at col. 1, ll. 34–43; col. 2, ll. 14–34.)

III. "Information"

Arendi's Construction	Microsoft's Construction
"the meaning of data as it is intended to be interpreted by people"	"data"

While the terms "information" and "data" are interrelated, they are not synonymous. Information refers to "the meaning of data as it is intended to be interpreted by people," whereas data means "factual information (such as text, numbers, sounds, and images) in a form that can be processed by a computer." (Ex. 21 at 130.) There is no evidence in the intrinsic record that the patentee used these terms synonymously. Microsoft's proposed construction of "information," as simply "data," thus directly contradicts general principles of claim construction. Indeed, the '854 patent claims use ***both*** the terms "information" and "data" (the definition Microsoft proposes for information), including at times in a single claim. For

example, claim 19 refers to "***information***" and dependent claim 22 adds an additional limitation relating to "***data***." When an applicant uses different terms in a claim, as the patentee did here, there is an inference that the patentee intended his choice of different terms to reflect different meaning in the use of those terms. *See, e.g.*, *CAE Screenplates Inc.*, 224 F.3d at 1317 ("[W]e must presume the use of . . . different terms in the claims connotes different meanings."); *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1579 (Fed. Cir. 1996) (stating that if two terms described a single element, "one would expect the claim to consistently refer to this element [with one or the other of the two terms], but not both, especially within the same clause"). Microsoft's suggestion that the term "information" should be defined "in the context of 'second information'" as just "data" is thus an inappropriate attempt to strip the term "information" of its meaning to support Microsoft's already strained invalidity positions. *See, e.g.*, *Geomas (Int'l) Ltd. v. Idearc Media Services-West, Inc.*, No. 2:06-CV-475-CE, 2008 WL 4966933, at *9 (E.D. Tex. Nov. 20, 2008) ("The court . . . is not persuaded that the patentee intended to use the terms 'data' and 'information' interchangeably.")

Microsoft's proposed construction of the term "information" not only disregards the cannon of claim differentiation, but it completely ignores the context in which the term is used. As stated in the "Background Information" of the patent specification, for example, word processor "users may require retrieval of information, such as name and address information, etc., for insertion into a document, such as a letter, fax, etc., created with the word processor." (D.I. 47, Ex. D at col. 1, ll. 29–33.) While the claims are not limited to the ***type*** of information that might be covered by the invention (e.g., "name and addresses and/or other person or company related information"), to define information as nothing more than "data" would improperly transform anything that a computer could process—such as the binary code

"1010110" that represents the capital letter "V"—into information.[8]

Nor is Microsoft's suggestion correct that it is improper to consult a computer dictionary to confirm the meaning of information in the context of a software-related patent. Indeed, while trying to distance itself from the definition in its own dictionary, Microsoft proposes that the Court rely on a special "Computers" entry for "information" within an online general purpose dictionary. (D.I. 287 at 20.) But even that definition does not support Microsoft's position that information means data. Rather, definition (a) states that "information" is "important or useful facts obtained as output from a computer by means of processing input data . . . ." (D.I. 287 at 20.) Microsoft fails not only to explain how its overbroad definition of information is supported by the full definition it cites, but also why it would be preferable to use a general purpose dictionary's special computer definition instead of the definition from Microsoft's own computer dictionary, which, not surprisingly, defines "information" in a manner commensurate with the meaning and scope of the invention. (*See* D.I. 286, Ex. 10 at 249 (defining "information" as "[t]he meaning of data as it is intended to be interpreted by people").)

Microsoft finally accuses Arendi of injecting "subtlety and nuance" into its proposed construction of the term "information." (D.I. 287 at 19.) To illustrate this unavailing argument, Microsoft poses a series of "philosophical" questions. (D.I. 287 at 21.) But those questions do not reasonably follow from the definition of "information" as "the meaning of data as it is intended to be interpreted by people." The inventor's name "Atle Hedløy," for example,

[8] Microsoft appears to have appreciated this point when it argued for a proposed construction of "second information"—inexplicably absent from its supplemental brief—during the prior round of claim construction briefing. There, Microsoft argued that that "second information" should be construed to mean "*substantive information* that is associated with the first information located in the document." (D.I. 59 at 14.) Now, retreating from its prior position, Microsoft proposes to remove the distinction that it previously perceived in favor of a broader definition of information—as just "data"—to suit its invalidity arguments.

simultaneously may be ***data*** to a computer (represented by a series of zeros and ones or binary code) and ***information*** to a person. It does not matter which person reads the name—the meaning of the data is still the ’854 patent inventor’s name: Atle Hedløy. This concept—the difference between data and information in the context of the ’854 patent—is hardly a difficult one to comprehend. And nothing about it requires, as Microsoft suggests, “the jury to speculate on the possible intent of the user.” (D.I. 287 at 20.)

IV. “Second Computer Program,” “Second Application Program,” And “Second Information”

Term	Arendi’s Construction	Microsoft’s Construction
second computer program	“a computer program that is distinct from the first computer program”	“a computer program different from the first computer program in any way”
second application program	“an application program that is distinct from the first application program”	“an application program different from the first application program in any way”
second information	“information that is distinct from the first information”	“information different from the first information in any way”

Microsoft proposes constructions for “second computer program,” “second application program,” and “second information” that are unsupported and contrary to the disclosure of the ’854 patent. Microsoft argues that “first” and “second” simply refer to things that are “different . . . in any way.” (D.I. 287 at 18–19, 21.) But this interpretation is contrary to the ordinary usage of the terms “first” and “second” and the intrinsic record. Rather than cite the patent disclosure in support of its proposed constructions, Microsoft relies exclusively upon *3M Innovative Properties Co. v. Avery Dennison Corp.*, 350 F.3d 1365 (Fed. Cir. 2003). (*See* D.I. 287 at 18–19, 21.) But *3M* neither uses the phrase “different from the first . . . in any way” nor suggests such a meaning for “second.” On the contrary, when construing the terms “first pattern” and “second pattern,” the *3M* court concluded that the terms were equivalent to “pattern A” and “pattern B”—separate instances of “pattern.” *See* 350 F.3d at 1371. Indeed, consistent with the

definition proposed by Arendi, courts frequently construe "first" and "second" to mean instances of a claim element that are distinct. *See, e.g.*, *Becton, Dickinson and Co. v. Tyco Healthcare Group, LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) ("Where a claim lists elements separately, 'the clear implication of the claim language' is that those elements are 'distinct component[s]' of the patented invention.") (citations omitted); *Oatey Co. v. IPS Corp.*, 514 F.3d 1271, 1277–78 (Fed. Cir. 2008) (noting that "the term 'first and second juxtaposed drain ports in said bottom wall' defines ***distinct*** openings . . . "); *Regents of the Univ. of Minn. v. AGA Med. Corp.*, 660 F. Supp. 2d 1037, 1045 (D. Minn. 2009) (holding that the term "first and second occluding disks" meant "physically ***distinct and separate*** disks"); *see also Swapalease, Inc. v. Sublease Exchange.com, Inc.*, No. 07-cv-45, 2009 WL 204408, at *11 (S.D. Ohio, Jan. 27, 2009).

Microsoft's constructions are also unsupported by the patent disclosure. For example, Microsoft includes the phrase "in any way"—which serves no purpose other than to diminish the significance of the "differen[ce]" between "first" and "second" in its constructions—to include even the most trivial difference as enough to satisfy "first" and "second" "computer programs," "application programs," or "information." Microsoft yet again overreaches with this definition by attempting to cast the spell-checking component of Word as one "application program" and Word itself as another "application program," because while not distinct, they are "different … in any way." But the patent provides a way for a user to access information in one application program while working ***simultaneously*** in ***another*** application program:

> The above and other objects are achieved according to the present invention by providing a novel method, system and computer readable medium for providing a function item, such as a key, button, icon, or menu, tied to a user operation in a computer, whereby a single click on the function item in a window or program on a computer screen, or one single selection in a menu in a program, initiates retrieval of name and addresses and/or other person or company related information, while the user works simultaneously in another program, e.g., a word processor.

(D.I. 47, Ex. D at col. 2, ll. 14–23.) Similarly, the patent repeatedly identifies "second information" (e.g., an address) that is distinct from the "first information" (e.g., a name) entered by the user. (*See, e.g.*, *id.* at col. 2, ll. 27–31; col. 3, ll. 63–64; Figs. 3 and 4.)

V. "Associated"

Arendi's Construction	Microsoft's Construction
"connected or brought into relation"	"brought together or into relationship in any of various intangible ways"

Microsoft's proposed construction of "associated" must likewise be rejected. As an initial matter, unlike Arendi (*see* D.I. 285 at 12–13), Microsoft provides no analysis of or citation to the patent disclosure or the file history in support of its construction. Instead, Microsoft bases its construction exclusively upon one of many possible definitions in a general dictionary. (D.I. 287 at 17.) Microsoft fails to explain how or why it has chosen that particular definition and whether that definition is consistent with the usage of the term in the intrinsic record. But reliance on a general dictionary definition divorced from the intrinsic record is legally impermissible. *See Phillips*, 415 F.3d at 1321 (cautioning against "the adoption of a dictionary definition entirely divorced from the context of the written description"); *see also Free Motion Fitness*, 423 F.3d at 1348–49; *3M Innovative Props. Co.*, 350 F.3d at 1371 ("A term's ordinary meaning . . . must be considered in the context of all intrinsic evidence, namely the claims, the specification, and the prosecution history.").

Microsoft's proposed construction of "associated" is also unavailing because, by including the rhetorical phrase "in any of various intangible ways," Microsoft would impermissibly rewrite the claims to read out limitations. Explaining its proposed construction, Microsoft baldly asserts that "the association relationship can be *anything*, i.e., 'in any of various intangible ways.'" (D.I. 287 at 17 (emphasis in original).) Not only is it unclear what an "intangible" relationship is, the patent does not claim associations that can be just "anything."

On the contrary, the '854 patent claims a specific association: "second information" is connected or related to "first information" *from a second application program*. (*See, e.g.*, D.I. 47, Ex. D at claims 1 ("second information associated with the first information *from a second application program*") and 85 ("second information associated with all or part of the first information *from the second application program*").) Despite the inclusion of such a limitation in every asserted claim, Microsoft nevertheless seeks to construe the term "associated" in isolation so as to cover a seemingly infinite number of possible associations. *See, e.g.*, *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1330 (Fed. Cir. 2008) (finding a district court's construction of the term "information database" to be "unjustifiably broad" because the district court analyzed the term in isolation rather than in the context of the asserted patent). Because a relationship that "can be *anything*" is wholly inconsistent with the specific association between "first" and "second information" claimed by the '854 patent, Microsoft's proposed construction effectively rewrites the claims by deleting the limitation "from [a/the] second application program." *See Helmsderfer*, 527 F.3d at 1383 ("Courts cannot rewrite claim language."); *see also, e.g.*, *SynQor, Inc. v. Artesyn Techs.*, No. 2:07-CV-497, 2010 WL 2991037, at *28 (E.D. Tex. July 26, 2010) (rejecting a proposed claim construction that "would completely rewrite the claim language and delete important limitations"). Conversely, Arendi's proposed construction is entirely consistent with the claims as written because it does not require that they recognize any and every possible association between "first" and "second information." Microsoft's construction therefore should be rejected, and Arendi's should be adopted.

VI. The Means-Plus-Function Claim Elements Should Be Construed As Set Forth In Plaintiff's Supplemental Opening Brief.

Microsoft provides little by way of opposition argument to Arendi's proposed means-plus-function constructions. Aside from citing various legal principles that govern means-plus-

function constructions and incorporating its prior briefing by reference, Microsoft appears to set forth two additional arguments. First, Microsoft inaccurately states that "Arendi offers no construction of the functional language of the claims." (D.I. 287 at 24.) But Microsoft completely misrepresents the record before the Court, where Arendi irrefutably provides proposals for the functional language of each means-plus-function claim element. (*See, e.g.*, D.I. 46, 57, 285.) Unless Microsoft sets forth what it contends is specifically wrong with these constructions, Arendi is unable to provide rebuttal arguments. Second, Microsoft asserts that "Arendi often does not identify a corresponding structure." (D.I. 287 at 24.) But that too is conclusory and patently false. (*See, e.g.*, D.I. 46, 57, 285.) If Microsoft fails to explain what about the structure Arendi cites is wrong, then Arendi cannot offer rebuttal argument. As there is no real argument here to refute, Arendi relies on its earlier briefs in support of its proposed means-plus-function constructions.

CONCLUSION

For the reasons above and in Arendi's supplemental opening brief (D.I. 285), Plaintiff respectfully requests that this Court construe, as a matter of law, the disputed terms of the patent-in-suit as set forth above.

Dated: February 4, 2011

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