Exhibit 6AA

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Google Inc.

Petitioner,

v.

Arendi S.A.R.L.

Patent Owner

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Case No. IPR2014-00450

Patent No. 7,921,356

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PATENT OWNER ARENDI S.A.R.L.'S RESPONSE
UNDER 37 C.F.R. § 42.120

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Cases

Statutes

Rules

EXHIBIT LIST

Arendi Exhibit Number	Description
2001	Declaration of John V. Levy, Ph.D.

I.   INTRODUCTION

Patent Owner Arendi S.A.R.L. ("Arendi" or "Patent Owner") respectfully requests that the Board determine that Google Inc. ("Petitioner") has failed to establish by a preponderance of the evidence with respect to U.S. Patent No. 7,921,356 (the '356 Patent") that any of claims 1, 7, 10, 12, 16, and 20 are unpatentable under 35 U.S.C. §103(a) over the combination of Tso and Pandit.

The Petitioner fails to provide a credible rationale by which a combination of Tso and Pandit would lead to the invention as claimed. Specifically, the combination of the two references in one mode fails to disclose or suggest the limitation in the independent claims of "identifying at least part of the selected textual information to use as a search term." The combination of the two references in another mode fails to disclose or suggest the limitation in the independent claims of an "operation that includes both "searching and "and performing an action" "of a type depending at least in part on the type or types of contact information of the selected textual information."

Moreover, the independent claims require causing insertion of text into the document if "the search term is included in the information source" and "second information is found in association with the search term." In contrast to this requirement, Tso, the only reference disclosing insertion, requires the user to exercise discretion in determining whether to insert displayed text. Consequently,

Petitioner has failed to establish unpatentability of the independent claims on the basis of Pandit and Tso.

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

2

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.
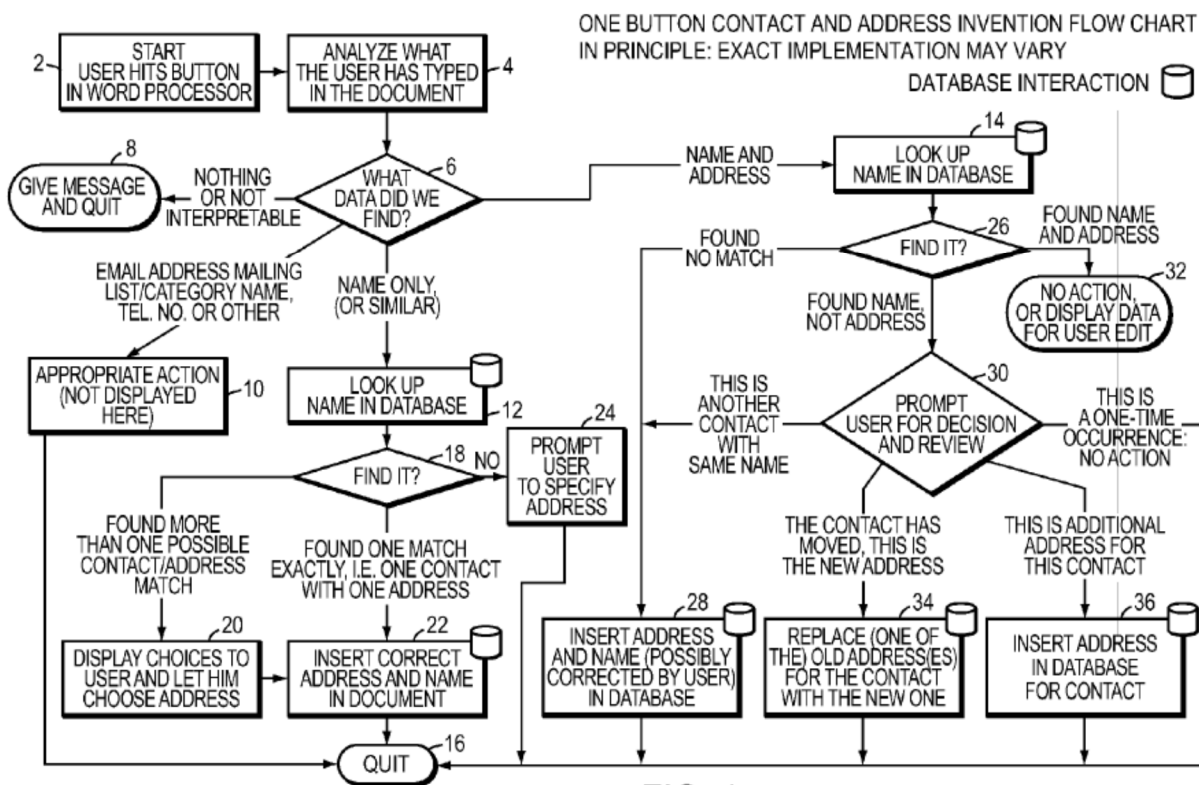
FIG. 1

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, and 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

4

the address has been inserted.
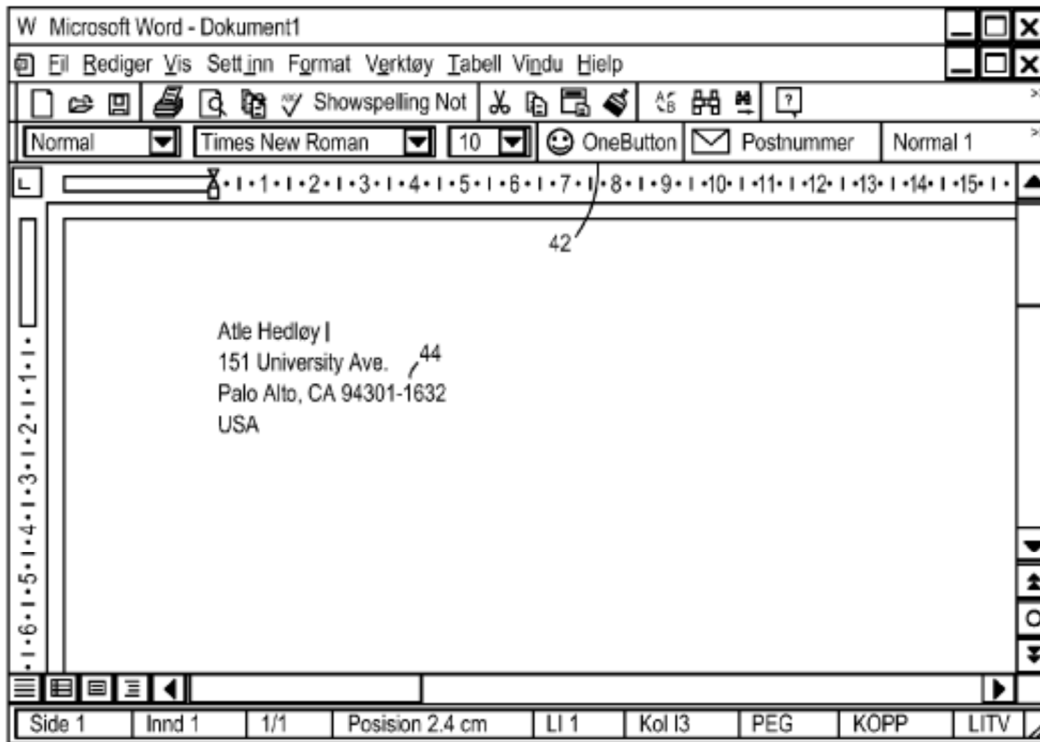
FIG. 4

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.

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.

| Modify Contact's Address | ▭☐✕ |

70 — The contact: Hedloy, Alte
already exists in the contact register with the following address:

72 — Home address:
222 222 5th Ave.
New York, NY 10028

This is another contact, I will:
74 — ○ Add a new contact with the same name

This is the same contact. I will:
76 — ◉ Change the current address in the contact register
78 — ○ Use the above address in my Word document
80 — ○ Add a new address to the contact

Use address type: Business   ▼ —54

| OK | Details... | | Cancel |
56 | 58 | | 60

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

7

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.

8

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. "type"

The term "type" is used consistently throughout the claims and consistently throughout the disclosure of the '356 Patent. The independent claims refer to a "type" of operation, a "type" of action, and a "type" of contact information. There are five examples of this usage in the independent claims, as follows:

a. "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"

b. "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"

c. "the operation comprising identifying at least part of the selected textual information to use as a search term in order to find *second information, of a specific type or types*"

d. "wherein the operation further comprises … causing an electronic search … and *performing an action having a type*,"

e. "wherein *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."

A "type" as understood by one of ordinary skill in the art and as used in the '356 Patent is a category. Declaration of Dr. Levy, Ex. 2001, paragraphs 29-34.

Thus, a "type" refers to a "category", and a "type" may include one or more instances of that category. *Id*., paragraphs 29-30. However, distinct instances of the same type are not distinct types, but precisely that—distinct instances—of the same type. *Id*.

When this terminology is considered in the context of "type of action", we have the claim limitation (d), defining the operation as comprising both "causing an electronic search … and performing an action having a type." "Claim limitation (e) requires that 'the *type of action* depends at least in part on whether the search term is included in the information source.' There are at least two possibilities created by this limitation (e): either the search term *is* included in the information source or the search term *is not* included in the information source. As a consequence of the claim structure, each of these possibilities must give rise to a different 'type of action'". *Id.*, paragraph 31.

"If the search term *is* included, then the balance of limitation (e) specifies that if also 'the information source includes the second information, the action comprises causing insertion of at least part of the second information into the document'". *Id*., paragraph 32.

"On the other hand, if the search term *is not* included, claim 2 requires that 'when the information source does not include the search term, the action

11

comprises causing indication to the user that the information source does not include the search term'". *Id*.

This analysis shows, and a person of ordinary skill in the art would understand, that, "claims 1 and 2 call out two distinct 'types' of action: (1) 'causing insertion of at least part of the second information into the document' and (2) 'causing indication to the user that the information source does not include the search term'. Moreover, claim 1, by itself requires that 'the *type of action* depends at least in part on whether the search term is included in the information source'". *Id*., paragraph 33.

Consideration of instance (e) shows that one particular type of action is "causing insertion of at least part of the second information into the document". The Petitioners equate this claim limitation with Tso's presentation of a template for insertion. Petition, p. 58.

The PTAB suggests in the Institution Decision at page 24 that proffering by the Tso system of different templates for insertion with different characteristics corresponds to the claim limitation "wherein the type of action depends at least in part on whether the search term is included in the information source". This construction is flawed, because the above analysis shows that insertion of a Tso template into the document qualifies as a single type of action regardless of the

information in the specific template being inserted in any given instance. Declaration of Dr. Levy, Ex. 2001, at paragraph 34.

Moreover, if one were to conclude that each instance wherein a distinct template is proffered for insertion by the Tso system constitutes a distinct type of action as suggested by the PTAB, the term "type" would add no meaning to the claim. As already stated, the independent claims contemplate that one action is "causing insertion of at least part of the second information into the document." Thus, using the PTAB's interpretation, each action of insertion of a different template having different characteristics would inherently imply a different type of action. Therefore, the word "action" and "type" would be redundant and the term "type" would have no meaning when referencing a "type of action". The foregoing discussion suggests that the terms "action" and "type" when used in the context of a type of action must have different meanings, and the term "type" should be construed to mean a "category" of an action, where each category is different and distinct and does not encompass different instances of the same action.

Furthermore, the PTAB's construction would seem to require inconsistent usages of the word "type" in the independent claims, which require, as a result of limitation (b) described above, that the operation is "of a type depending at least in part on the type or types of contact information of the selected textual information". We know from limitation (d) that the "operation further comprises

13

… causing an electronic search … and performing an action having a type".

Hence the requirement of limitation (b) that the type of *operation* depends at least in part on the type of contact information selected requires additionally that the type of *action* depends at least in part on the type of contact information selected. In the context of the disclosure of the '356 Patent, the contact information may be, e.g. name or a name with an address. See, for example, Ex. 1, col. 3, line 45 to col. 5, line 11. If two instances of a name would constitute two different types of contact information, as the PTAB interpretation of "type of action" would imply, then every instance of any name or name with address would constitute a different type of contact information. As a result, e.g. the claim limitation "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" would not add anything to the claim because each instance of contact information would be a different type of contact information, and the claim would mean exactly the same as if these words were not there, as the type would simply be the same as the text itself. This makes no sense, and is not consistent with the disclosure of the '356 Patent.

Moreover, the failure of the Tso system to disclose the claim limitation "wherein the type of action depends at least in part on whether the search term is included in the information source" is an independent reason why Petitioner has

14

failed to show that the independent claims of the '356 Patent are unpatentable on the basis of Pandit and Tso.

B. "wherein the type of action depends at least in part on whether the search term is included in the information source"

The claim limitation "wherein the type of action depends at least in part on whether the search term is included in the information source" requires two possibilities for the type of action. The possible types of action include: a first action type that occurs if the search term *is* included in the information source and a second action type that occurs if the search term *is not* included in the information source.

As discussed in further detail below in section V(C), the system of Tso necessarily gives the user discretion to accept a template offered by Tso's system, in which case the template is inserted into an e-mail message , or to reject the template offered by Tso's system, in which case the template is not inserted into the e-mail message. See Exhibit 1009 at col. 2 lines 33-41 and col. 5 lines 53-57, and Declaration of Dr. Levy, Ex. 2001, pars. 24-25. Consequently, the determination whether to insert the template in Tso is not conditioned on whether the search term is present in the information source, as required by the claims. See section V(C).

In the Institution decision, the PTAB stated at page 23 that the Petitioner's argument that Tso's system causes insertion only if search terms are found in the information source conveys that the system inserts second information if search terms are found, but otherwise refrains from inserting second information, which constitutes a different type of action. This reasoning is faulty, because, in contrast to the requirements of the claims, the Tso system always displays a template or templates for the user to elect to insert or not (Declaration of Dr. Levy, paragraphs 26-28) , and user discretion entirely determines whether an insertion occurs. Because the system of Tso requires the user to exercise discretion in determining whether insertion occurs, and the system always behaves the same way, whether or not key word(s) are found, the claim requirement that "the type of action depends at least in part on whether the search term is included in the information source" is not disclosed or suggested by Tso. Declaration of Dr. Levy, Ex. 2001, pars. 23, 27.

C. "operation"

The independent claims of the '356 patent all refer to the performance of an "operation". The claims require that the operation comprises:

> *causing an electronic search* in the information source, by an
>
> information management program external to the document editing

16

program, for the search term in order to find whether the search term

is included in the information source; *and performing an action*

having a type [emphasis added]

Thus, the operation includes both *searching* an information source and *performing*

a separate action.

Additionally, the independent claims require that the operation has a type,

the "type depending at least in part on the type or types of contact information of

the selected textual information". Therefore, the claim requires at least two

different types of operations wherein each operation is dependent on a different

type of contact information as identified in the selected textual information.

The Petitioner at page 56 of their Petition states that Pandit "teaches

recognizing particular types of contact information, and taking action based on the

type of information found." Although the Petitioner uses the term action, the

Patent Owner notes that this reference to Pandit is with respect to the term

"operation" and the "type of operation" being based on the "type of contact

information" of the selected textual information as required by the independent

claims. The Petitioner cites claims 1 and 7 of Pandit. Claim 1 of Pandit includes

the limitation of "recognizing the selected text as belonging to the predetermined

class if the format of the selected text matches the predetermined format; and (b)

performing an operation associated with the predetermined class using the

recognized text as a parameter….. Claim 7 of Pandit states that the "text is one of a date, name, telephone number, telefax number, e-mail address, and Uniform Resource Locator." Petition at 56-57 Ex. 1004 at claims 1 and 7.

Although Pandit identifies different types of contact information (claim 7, e.g. name, telephone number, telefax number, e-mail address) and performs an operation based upon the type of contact information (claim 1 i.e. performing an operation associated with the predetermined class). Pandit's operations are not the kind of operations as defined by the language of the independent claims where the operation requires the search of an information source for a search term and the performance of an action. Pandit fails to disclose searching. Therefore, Pandit does not associate a "type of operation" with "the type of contact information." Declaration of Dr. Levy, Ex. 2001, par. 42.

The term "operation" as it is used in the context of the independent claims, read as a whole, requires a search of an information source for a search term to determine if the search term is present in the information source followed by an additional action.

Although Tso can be read as disclosing an operation, the claim requires that the operation is of a "type depending at least in part on the type or types of contact information of the selected textual information". This further claim limitation has no counterpart in Tso, because Tso fails to disclose recognition of contact

18

information, let alone types of contact information. Although Petitioner has argued

that the combination of Tso with Pandit meets the terms of claim 1, there is no

specific discussion by Petitioner of how Tso and Pandit might be combined in

order to meet this claim limitation, among other claim limitations. We discuss

below in section V(B) the failure of Petitioner to show how the functionalities of

these references might be combined.

IV.   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," "E-mail," 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 operations

or executing one or more keyboard strokes. See Ex. 1004, col. 2, lines 41-46.

B. 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.

"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.* at col. 4 lines 31-35. The text is selected using an input device, such as a mouse, or positioning a cursor and pressing "enter." When the user selects the text, the template engine is invoked.
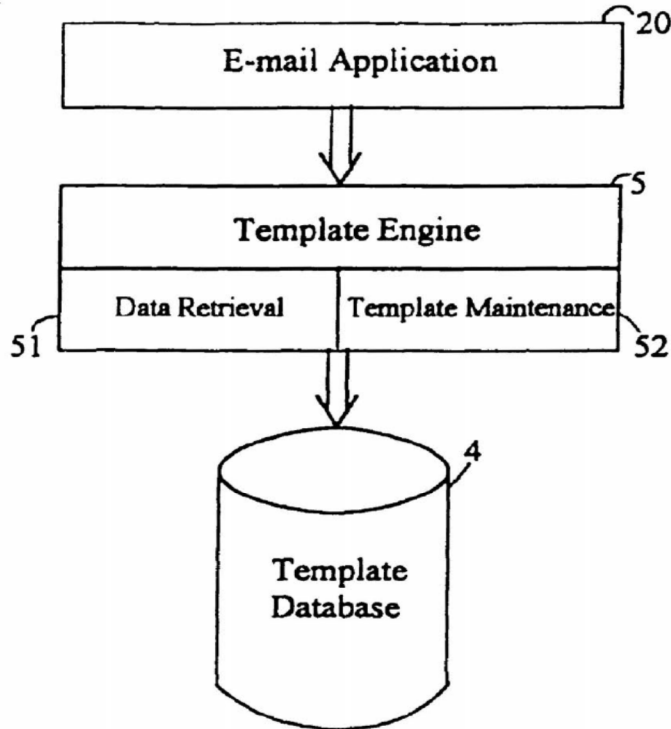
Figure 2

Tso requires user discretion to determine whether a proffered template

should be inserted into an e-mail, because the purpose of the system of Tso is to

assist a user in the construction of an e-mail message. Tso uses a best matching

algorithm to determine a possible context sensitive message. Tso cannot guarantee

that the best matching template will meet the needs of the user, since the user

ultimately determines what the user wishes to write:

The present invention provides a context-sensitive template

engine that helps users compose and/or reply to e-mail messages using

minimal keyboard access. Given an input text passage, such as a

portion of a partially-composed outgoing text message or a portion of

a received text message, the template engine can *suggest* one or more

predefined, context-appropriate sentences to include in the outgoing

text message based on the actual content of the input text passage.

Exhibit 1007, at col. 2 lines 59-67 (emphasis added).

Tso parses an input text string from an e-mail within an e-mail application

and identifies the 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

each word in the selected text string 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 possible 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.

The user can choose to insert the provided template or not to insert a template. Declaration of Dr. Levy, Ex. 2001, paragraph 23. In fact, Tso points out that the system might make more than one suggestion or that none of the suggestions may be appropriate. User discretion is required:

It is conceivable that more than one template will have a highest total weight value, in which case the user interface 2 could present multiple templates to the user. The user could then select which template is most appropriate for that user's purposes. It is also conceivable that the template or templates which the template engine 5 determines to be most appropriate may not meet the user's particular needs. In such a case, the user could request that the template engine 5 present additional templates from which the user may choose. These additional templates would typically be presented to the user in an order based on their respective total weight values.

Id., col. 5, lines 48-60. See Declaration of Dr. Levy, Ex. 2001, paragraphs

26-27.

V.   Because Pandit and Tso do not render claims 1, 12 and 20 obvious, the claims are patentable over Pandit and Tso

A.   Overview of reasons why the claims are patentable over Pandit and Tso

Petitioner has failed to show that any prior art alone or in combination

addresses all of the limitation of any of the independent claims.

The Petitioner fails to provide a credible rationale by which a combination

of Tso and Pandit would lead to the invention as claimed. The Petition lacks an

"articulated reasoning with some rational underpinning to support the legal

conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed, Cir. 2006).

Specifically, the combination of the two references in one mode fails to disclose or

suggest the limitation in the independent claims of "identifying at least part of the

selected textual information to use as a search term". The combination of the two

references in another mode fails to disclose or suggest the limitation in the

independent claims of an "operation" that includes both "searching" and "and

performing an action" "of a type depending at least in part on the type or types of

contact information of the selected textual information".

25

Moreover, the independent claims require causing insertion of text into the document if "the search term is included in the information source" and "second information is found in association with the search term". In contrast to this requirement, Tso, the only reference disclosing insertion, requires the user to exercise discretion in determining whether to insert displayed text. Consequently, Petitioner has failed to establish unpatentability of the independent claims on the basis of Pandit and Tso.

B. Because the Petitioner fails to provide a credible rationale by which a combination of Tso and Pandit would lead to the invention as claimed, the Petitioner has failed to establish unpatentability based on Pandit and Tso. Specifically, the combination of the two references in one mode fails to disclose or suggest "identifying at least part of the selected textual information to use as a search term" and in another mode fails to disclose or suggest an "operation" that includes both "searching" and "and performing an action" "of a type depending at least in part on the type or types of contact information of the selected textual information".

The Petitioner argues—without specifying any details as to the manner by which the specific functionalities of the two references can be combined—that the combination of Pandit and Tso would render obvious the subject matter defined the independent claims. We show that any possible combination of these two references by one of ordinary skill in the art fails to provide more functionality than in any one of the references taken alone, and that the combination therefore fails to render the subject matter obvious.

More specifically, the petition fails to provide any detail as to how the functionality of Pandit would be combined with the functionality of Tso other than to state that "[i]t would thus have been obvious to use Pandit's recognition of certain types of contact information in Tso's system. Specifically, it would have been obvious to use Tso's system to identify contact information in the document, and to insert related contact information." Petition, pages 50-51.

The law requires more. In *Unigene Laboratories, Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011), the Federal Circuit stated: "Obviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418, 127 S.Ct. 1727, 167 L.Ed.2d 705 (2007). Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention. *Id*. at 421, 127 S.Ct. 1727 (describing that a person of ordinary skill possesses 'ordinary creativity, [and is] not an automaton'); see also *Bayer Schering Pharm. AG v. Barr Labs., Inc.*, 575 F.3d 1341, 1350 (Fed.Cir.2009) (Newman, J., dissenting) ('The statutory criterion is whether the invention would have been obvious to persons of ordinary skill at the time of the invention, not whether it is

27

sufficiently simple to appear obvious to judges after the discovery is finally made....').""

The Petitioner makes virtually no effort to explain how one of ordinary skill in the art would go about combining the disparate claim elements from the references, or what modifications one of ordinary skill in the art would necessarily have made in order to combine the disparate elements. See Petition at pages 49-52. What is lacking is an "articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988 (Fed, Cir. 2006), cited with approval in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). The inadequacy of the obviousness analysis in the Petition and accompanying Declaration is readily apparent when the disparate elements of the references are scrutinized closely. The Petitioner is able to present a cursory rationale for combining Pandit with Tso; however, when a more complete analysis of how the references would actually be combined by one of ordinary skill in the art is presented as by Dr. Levy, a person of ordinary skill in the art is left to conclude that the combination of Tso with Pandit results in no more than the either Tso or Pandit by itself. Declaration of Dr. Levy, Ex. 2001, at paragraphs 39, 41.

Dr. Levy begins his analysis by looking at the technical teaching of the prior art reference of Pandit. In his declaration Dr. Levy states, "[w]hile Pandit discloses analysis, it is only in the sense of recognizing the type of information

28

input by the user. Pandit uses this type-recognition to select and display an appropriate action-menu for that type; subsequently, the user chooses an action from the menu and the action is taken. Thus, for example, when the user inputs a name, Pandit teaches recognizing that the input text is a name and displaying a list of actions (in a menu) that are relevant or appropriate for names, no matter what the specific name is." Declaration of Dr. Levy, Ex. 2001, at paragraph 36.

Dr. Levy then turns to the reference of Tso. He states that "Tso teaches finding a template most suited to the context of input text, using words extracted from the text input as search items against a list of keywords. Each keyword is associated with a template and has a weight. The intention of Tso is to find the most relevant template based on finding matches between the search items (words) and the keywords. Tso chooses a template based on summing the weights of matched keywords. Unlike Pandit, Tso does not classify the input text as to type. Tso only parses the input into discrete words before searching." Declaration of Dr. Levy, Ex. 2001, at paragraph 37.

Dr. Levy considers two possible modes of combining Pandit and Tso. With respect to the first mode of combination, using the system of Pandit with the teachings of Tso, Dr. Levy states that "[a] person of ordinary skill in the art attempting to combine Pandit with Tso could take the 'front-end' of Pandit and perform recognition on the input text in order to classify it by type. Such

classifications would be things like 'name' 'address' 'telephone number' 'e-mail

address' and so on. Having done the type classification using Pandit, the type

classifier name, such as 'name,' 'address,' and so on, could be used as a search

term in the manner described by Tso to match the input type with a template most

relevant to the input. Such a combination could, for example, recognize that an

input is a telephone number, and then select for display a template that is a list of

actions (such as in a menu) that are relevant or appropriate for telephone numbers,

no matter what the specific telephone number is.   This combination, however,

merely replicates the functions of Pandit. Since the output of Pandit is not a

specific telephone number or other specific information, the result of such a

combination does not add any functionality to Pandit alone. Furthermore, this

analysis does not address the fact that Pandit may classify different input words

into different types, and therefore when used as search terms, these Pandit types

would be different and conflicting." Declaration of Dr. Levy, Ex. 2001, at

paragraph 39.

Dr. Levy concludes that the combination does not result in the subject matter

of the independent claims and one of ordinary skill in the art would not be

motivated to combine Pandit with the teachings of Tso, since the combination

would not result in any additional functionality when compared to Pandit by itself.

Dr. Levy states: "[i]n particular, combining Pandit with Tso does not lead to a

database lookup of 'contact information' or any user-specific information, as in the

'356 Patent, because the templates of Tso are not a database of associations

between names and phone numbers, for example, as in the '356 Patent.

Specifically, the combination of Pandit with Tso, as described in this paragraph,

fails to disclose or suggest the claim requirement of 'identifying at least part of the

selected textual information to use as a search term,' because, as described above,

Pandit uses the type of the selected textual information as a search term (for a

menu of actions, in Pandit, or for a template, when combined with Tso as

described), not the textual information itself. Thus, one of ordinary skill in the art

would not be motivated to combine Pandit with Tso, nor would such a person be

capable of obtaining the functions of the '356 Patent by such a combination."

Declaration of Dr. Levy, Ex. 2001, at paragraph 40.

After establishing that the first mode of combining references does not result

in the subject matter of the independent claims, Dr. Levy turns to the second mode

of combination. In this second mode, the system of Tso is modified with the

teachings of Pandit. With respect to this combination, Dr. Levy states: "[i]n

contrast, if one of ordinary skill in the art were to start with the teachings of Tso

and add in the teachings of Pandit, the skilled artisan would still not end up with

the claimed subject matter of the '356 Patent. Beginning with the teachings of

Tso, a user could select text and that text could be divided into words to be used as

search terms. Those search terms could subsequently be used by the template

engine and the template database to select a template. The teachings of Pandit

could be employed to recognize the type of each of the search terms including the

case where the search term happens to be contact information. The template engine

of Tso, as implemented in accordance with this paragraph, could then perform

matching of the search terms with keywords associated with templates to identify a

template. However, Pandit can only identify the type of the search terms, and Tso

does not teach a way to use type information. Thus, this combination of Pandit

with Tso fails to add more functionality than present in Tso alone, and thus one of

ordinary skill in the art would not be motivated to combine Tso with Pandit.

"Declaration of Dr. Levy, Ex. 2001, at paragraph 41.

Dr. Levy concludes that the second mode of combination of Tso with Pandit

fails to account for each limitation of the independent claims. Dr. Levy states:

"Pandit teaches recognizing types of information, including contact information,

and uses the type to select (without searching) a set of actions associated with the

type. Tso teaches only using input terms (words) – not their types – to match

against keywords associated with templates." Declaration of Dr. Levy, Ex. 2001,

at paragraph 36. Thus, "a combination of Pandit with Tso fails to address the '356

Patent claim limitation wherein the 'operation,' which includes both 'searching'

and 'performing an action,' must be 'of a type depending at least in part on the

32

type or types of contact information of the selected textual information'."

Declaration of Dr. Levy, Ex. 2001, at paragraph 42.

In both modes of combination, according to Dr. Levy, the combination of the Pandit and Tso by one of ordinary skill in the art would not result in the subject matter of the independent claims. As a result, the Petitioner has not established a *prima facie* case of obviousness, since all of the claim limitations of the independent claims (1, 12, and 20) are not accounted for by either combination.

Therefore, one of ordinary skill in the art would not be motivated to combine Pandit with Tso; and even if one would be so inclined, the combination does not result in the subject matter of the independent claims.

Consequently, the Petitioner has failed to establish unpatentability of the independent claims 1, 12 and 20 and therefore the Petitioner has also failed to establish unpatentability of dependent claims 7, 10, and 16.

33

C. Because the independent claims require causing insertion of text into the document if "the search term is included in the information source" and "second information is found in association with the search term", whereas Tso, the only reference disclosing insertion, always displays a template to the user for insertion and furthermore requires the user to exercise discretion in determining whether to insert a displayed template, Petitioner has failed to establish unpatentability of the independent claims on the basis of Pandit and Tso.

The independent claims require "causing insertion of at least part of the second information" when certain conditions are satisfied. Specially, the claims require "causing insertion" if "the search term is included in the information source" and "second information is found in association with the search term",

Neither Tso nor Pandit teaches these limitations. Pandit lacks any disclosure whatsoever of insertion. As described in further detail below, in Tso, the program does not "cause" insertion upon occurrence of the conditions if "the search term is included in the information source" and "if the information source includes the second information". Instead, one or more templates are always displayed to the user for possible insertion, and insertion is always a matter left to the discretion of the user, and must always require user discretion for insertion, because Tso relies on a mechanism that differs from the conditional determinations required by the claims herein. Declaration of Dr. Levy, Ex. 2001, paragraphs 23 and 27-28.

Tso requires user discretion because the purpose of the system of Tso is to assist a user in the construction of an e-mail message. Tso uses a best matching

34

algorithm to determine a possible context sensitive message. Tso cannot guarantee

that the best matching template will meet the needs of the user, since the user

ultimately determines what the user wishes to write:

> The present invention provides a context-sensitive template
> engine that helps users compose and/or reply to e-mail messages using
> minimal keyboard access. Given an input text passage, such as a
> portion of a partially-composed outgoing text message or a portion of
> a received text message, the template engine can *suggest* one or more
> predefined, context-appropriate sentences to include in the outgoing
> text message based on the actual content of the input text passage.

Exhibit 1007, at col. 2 lines 59-67 (emphasis added).

To determine a possible context-sensitive e-mail message, Tso parses a text

string to identify search terms. Exhibit 1007 col. 4 line 31 – col. 5 line 6. The

search terms are then used to search for matching keywords in a template database.

Id. at col. 5 lines 7-15. Tso scores each template using a scoring mechanism based

upon keyword matches . *Id.* at col. 5 lines 18-41. Declaration of Dr. Levy, Ex.

2001, paragraphs 22-25.

Tso offers a user the selection of one or more templates for insertion within

an e-mail and presents at least the highest scoring template to the user for selection.

Ex. 1007 at col. 5 lines 42-60. "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)." *Id.*, col. 5, lines 42-44.

Even if there is no match between the keywords and the database, one or

more templates are displayed to the user for possible insertion. Declaration of Dr.

Levy, Ex 2001, paragraph 28. Thus, contrary to the requirements of the

independent claims herein, there is no difference in the actions of Tso between

situations wherein (1) the search term is included in the information source and

second information is found associated with the search term, and (2) the search

term is not included in the information source or second information is not found

associated with the search term.

The user can always choose to insert the provided template or not to insert a

template. Declaration of Dr. Levy, Ex. 2001, paragraph 23. In fact, Tso points out

that the system might make more than one suggestion or that none of the

suggestions may be appropriate. User discretion is required:

> It is conceivable that more than one template will have a
> highest total weight value, in which case the user interface 2 could
> present multiple templates to the user. The user could then select
> which template is most appropriate for that user's purposes. It is also
> conceivable that the template or templates which the template engine
> 5 determines to be most appropriate may not meet the user's particular

36

needs. In such a case, the user could request that the template engine

5 present additional templates from which the user may choose.

These additional templates would typically be presented to the user in

an order based on their respective total weight values.

Id., col. 5, lines 48-60. See Declaration of Dr. Levy, Ex. 2001, paragraphs

26-27.

Consequently Tso allows a user to reject a template ("second

information associated with the search term") if the search term is present in

the information source (i.e. keyword in the template database) and there is

associated second information (i.e. a template). Declaration of Dr. Levy, Ex.

2001, paragraphs 23-27.

Therefore, in Tso, the user must exercise discretion in each case whether to

insert a template and as to which template to insert. See Declaration of Dr. Levy,

Ex. 2001, paragraph 27. Tso is structured to determine a best matching template

based on the anticipated response of the user rather than determining if the search

term is included in the information source and second information is associated

with the search term in the information source as required by the independent

claims herein. In contrast, the independent claims require "causing insertion of at

least part of the second information into the document" under the conditions "if the

search term is so included, and if the information source includes the second

information". Tso on the other hand, cannot employ or even consider causing

insertion that is caused on the occurrence of specified conditions, because Tso

depends on finding a context sensitive best-matching template, which admittedly

may not meet the user's needs. Causing insertion upon the occurrence of specified

conditions would deprive the user of the discretion on which the Tso system

depends and is therefore incompatible with Tso's purpose. Declaration of Dr.

Levy, Ex. 2001, paragraph 27.

Therefore, even when Tso's purported "search term" is found in Tso's

purported "information source" and there is purported "second information" (a

template) associated with the "search term", insertion of the template associated

with the search term is not certain to occur because acceptance or rejection of the

template is necessarily based on user discretion. In other words, when the Tso

system presents a user with a template, and the template has a high score owing to

a number of selected words being associated with key words, the user may exercise

discretion and reject the template, since the user must determine whether the

presented template is suitable in each case. Declaration of Dr. Levy, Ex. 2001,

paragraph 27.

The Petitioner argues that Tso inserts a template only if a search term is

found in the template database (Petition at page 58). As support, the Petitioner

relies on Dr. Allison's interpretation of col. 5 lines 11-17 of Tso. Col. 5 lines 11-

17 states:

> 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
> template database 5. The template with the highest total
> weight value is then designated as the most appropriate
> template for the text string being processed.

Dr. Allison at paragraph 185 of his declaration concludes that this passage of

Tso means that "the predefined template, or the second information, is inserted

only if the information source includes the search term" (emphasis added). See

Declaration of Dr. Allison Exhibit 1002 at paragraph 185.

However, Dr. Allison's analysis of Tso fails to consider that the insertion of

a template results from the exercise of a user's discretion. In contrast, Dr. Levy

explains that col. 5 lines 11-17 does not indicate that a template is inserted only if

the search term is found. Rather, col. 5 lines 11-17 indicate that weighted value is

determined for each template and the template with the highest total score is

designated as the most appropriate template for presentation to the user and

exercise of the user's discretion. See Declaration of Dr. Levy, Ex. 2001,

paragraphs 23-27. As stated in Tso at col. 5 lines 49-57, the user can decide that

all of the provided templates are unsuitable and may request additional templates.

A template may be presented even though none of the keywords correspond to the

search term (i.e. a template with an associated zero score). A user may select this

template and insert the template into the document. Tso discloses that it is the user

who determines what is inserted and does not disclose any mechanism that causes

insertion of a template if a search term is found and there is an associated template

with the search term. Tso fails to cause the action of insertion on occurrence of a

set pattern of conditions. See Declaration of Dr. Levy, Ex. 2001, paragraph 27.

Contrary to Dr. Allison's conclusion that a template is inserted only if a

search term is found, Dr. Levy explains that Tso teaches that even when no search

term (key word) is found, the user is presented with one or more possible templates

to insert. Declaration of Dr. Levy, Ex. 2001, paragraph 28.

Because Tso always presents the user with templates for insertion, and

requires user discretion in the determination whether to insert a template and as to

what template, if any, should be inserted, Tso fails to disclose "causing insertion of

at least part of the second information into the document" under the conditions "if

the search term is so included, and if the information source includes the second

information". Consequently, the Petitioner has failed to establish unpatentability

of independent claims 1, 12, and 20 of the '356 Patent based on the combination of

Tso and Pandit and also dependent claims 7, 10 and 16.

VI. CONCLUSION

The Petitioner has failed to establish by a preponderance of the evidence with respect to U.S. Patent No. 7,921,356 that any of claims 1, 7, 10, 12, 16, and 20 are unpatentable under 35 U.S.C. §103(a) over the combination of Tso and Pandit.

Dated: November 4, 2014   Respectfully submitted,

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CERTIFICATE OF SERVICE

It is certified that on November 4, 2014, copies of the Response of the Patent

Owner under 37 C.F.R. § 42.120 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

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Exhibit 6BB

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 IPR2014-00450
Patent 7,921,356 B2

_____

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

POWELL, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

IPR2014-00450
Patent 7,921,356 B2

I. INTRODUCTION

Google Inc. ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–20 of U.S. Patent No. 7,921,356 B2 (Ex. 1001, "the '356 patent"). Paper 1 ("Pet."). On August 20, 2014, we instituted an *inter partes* review only as to claims 1, 7, 10, 12, 16, and 20. Paper 10 ("Dec. to Inst."). On November 4, 2014, Patent Owner, Arendi S.A.R.L., filed its Patent Owner Response. Paper 16 ("PO Resp."). On February 3, 2015, Petitioner filed a Reply. Paper 22 ("Pet. Reply").

An oral hearing was held on April 21, 2015. A transcript of the oral hearing is included in the record. Paper 27 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6(b). 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 preponderance of the evidence, that claims 1, 7, 10, 12, 16, and 20 of the '356 patent are unpatentable.

A. *Related Proceedings*

Petitioner indicates that the '356 patent has been asserted in the United States District Court for the District of Delaware in the following cases: *Arendi S.A.R.L. v. Google Inc.*, Case No. 1:13–cv–00919–LPS, filed on May 22, 2013; and Case No. 1:11–cv–00260–LPS, filed on March 29, 2011 and closed as of November 29, 2011. Pet. 1; *see* Paper 6, 2. Additionally, other patents related to the '356 patent have been the subject of petitions for *inter partes* review, including: Cases IPR2014-00203, IPR2014-00206, IPR2014-00207, IPR2014-00208, IPR2014-00214, and IPR2014-00452. Paper 6, 3–4.

IPR2014-00450
Patent 7,921,356 B2

B.   The '356 Patent (Ex. 1001)

The '356 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, [57]. If the database or file includes the corresponding information searched for, the information is displayed and possibly inserted into the word processor. *Id.* The '356 patent discusses an example of this function in connection with Figures 3 and 4. *Id.* at col. 5, l. 64–col. 6, l. 6. Figure 3 is reproduced below.
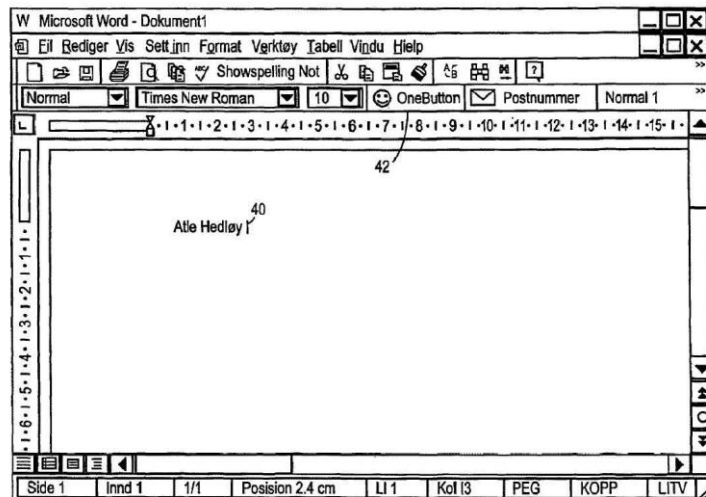
FIG. 3

Figure 3 shows a word processor document in which a user has typed name 40. *Id.* at col. 5, ll. 64–66. When the user hits button 42, the program according to the '356 patent retrieves name 40 from the document and then searches for name 40 in a database. *Id.* at col. 5, l. 66–col. 6, l. 2. 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. 6, ll. 1–4.

IPR2014-00450
Patent 7,921,356 B2
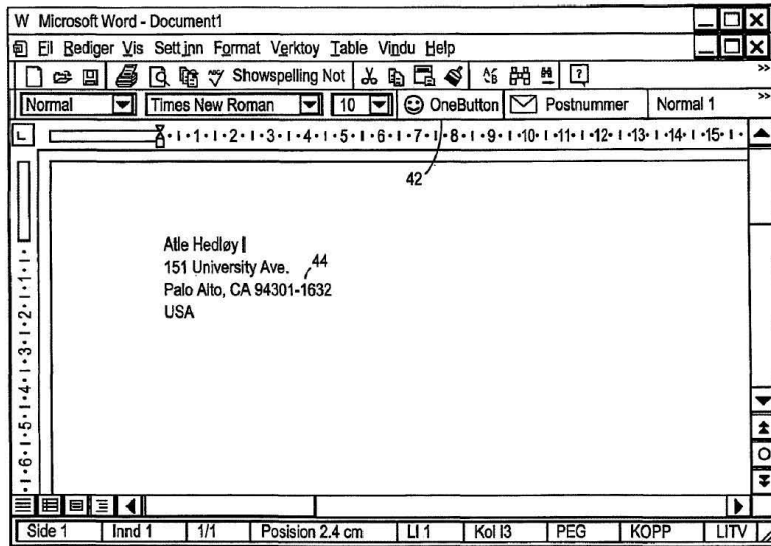
FIG. 4

Figure 4 shows the word processor document of Figure 3 with address 44 inserted. *See id.* The '356 patent discusses its process in greater detail in connection with Figure 1, reproduced below. *Id.* at col. 4, l. 28–col. 5, l. 59.

FIG. 1

4
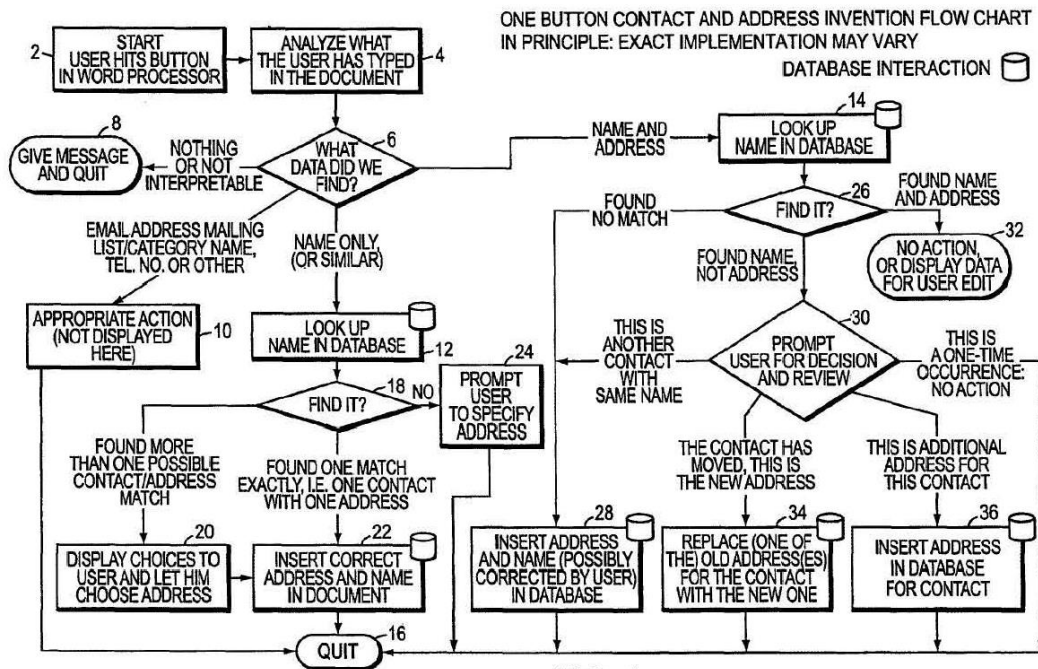
IPR2014-00450
Patent 7,921,356 B2

Figure 1 shows a flow chart illustrating a method for address handling. *Id.* at col. 2, ll. 48–50. At step 2, the user initiates the analyzing and searching process by commanding a button, such as button 42 shown in Figures 3 and 4. *See id.* at col. 4, ll. 29–31; col. 5, l. 66–col. 6, l. 1; col. 6, ll. 5–6. At step 4, "the program analyzes what the user has typed in the document." *Id.* at col. 4, ll. 29–31.

At step 6, the program determines what it found in the document. *Id.* at col. 4, ll. 31–32. 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. 32–35. 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. 43–46.

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. 46–49. 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. 54–57. 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. 49–54.

IPR2014-00450
Patent 7,921,356 B2

C.   *Illustrative Claim*

The pending ground of unpatentability involves claims 1, 7, 10, 12, 16, and 20 of the '356 patent. Claims 1, 12, and 20 are independent claims. Claim 1 is illustrative, and reads as follows:

1.   At least one non–transitory computer readable medium encoded with instructions which, when loaded on a computer, establish processes for contact information handling, implemented by a document editing program running in the computer, the processes comprising:

allowing a user to enter textual information into a document using the document editing program;

displaying the textual information in the document electronically using the document editing program;

allowing, in the document editing program, the user to select in the document at least a portion of the textual information while the textual information is displayed;

following user selection of textual information in the document analyzing, by the document editing program, the selected textual information 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;

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, the operation comprising identifying at least part of the selected textual information to use as a search term in order to find second information, of a specific type or types, associated with the search term in an information source external to the document;

after identifying at least part of the selected information to use as a search term, and in consequence of receipt by the

6

IPR2014-00450
Patent 7,921,356 B2

> document editing program of an execute command from the input device, performing the operation, wherein the operation further comprises:

> causing an electronic search in the information source, by an information management program external to the document editing program, for the search term in order to find whether the search term is included in the information source; and 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, 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.

Ex. 1001, col. 10, l. 42–col. 11, ll. 21.

D.   *The Prior Art*

The pending ground of unpatentability in this *inter partes* review is based on the following prior art:

U.S. Patent No. 5,859,636, issued Jan. 12, 1999 ("Pandit") (Ex. 1004).

U.S. Patent No. 6,085,201, issued July 4, 2000 ("Tso") (Ex. 1009).

E.   *Instituted Ground of Unpatentability*

We instituted an *inter partes* review involving the following ground of unpatentability:

References	Basis	Claims Challenged
Tso and Pandit	§ 103(a)	1, 7, 10, 12, 16, and 20

Petitioner supports its challenge with a Declaration executed by Dennis R. Allison, on February 14, 2014 ("Allison Declaration") (Ex. 1002).

7

IPR2014-00450
Patent 7,921,356 B2

Patent Owner relies on a Declaration executed by John V. Levy, Ph.D., on
November 4, 2014 ("Levy Declaration") (Ex. 2001).

II. ANALYSIS

A.   *Claim Interpretation*

"A claim in an unexpired patent shall be given its broadest reasonable
construction in light of the specification of the patent in which it appears."
37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, No. 2014-
1301, 2015 WL 4097949, *7–8 (Fed. Cir. July 8, 2015) (In considering the
broadest reasonable interpretation standard for *inter partes* review
proceedings, the United States Court of Appeals for the Federal Circuit
determined that "Congress implicitly approved the broadest reasonable
interpretation standard in enacting the AIA," and "the standard was properly
adopted by PTO regulation."), *reh'g en banc denied*, 2015 WL 4100060
(Fed. Cir. July 8, 2015). Under that standard, 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 Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir.
2010). Thus, we generally give claim terms their ordinary and customary
meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir.
2007) ("The ordinary and customary meaning is the meaning that the term
would have to a person of ordinary skill in the art in question.") (citations
and internal quotation marks omitted).

Petitioner and Patent Owner proffer constructions for a number of
terms. Pet. 8–11; PO Resp. 9–19; Pet. Reply 1–3. In this decision, we
construe only those claim terms in controversy, and we do so only to the

IPR2014-00450
Patent 7,921,356 B2

extent necessary to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

  1. "type" (Claims 1, 12, and 20)

  Patent Owner and Dr. Levy contend that the claim term "type" means "category." PO Resp. 9–11; Ex. 2001 ¶¶ 29–30. Additionally, Patent Owner and Dr. Levy make certain assertions about relationships between types of things. PO Resp. 11–15; Ex. 2001 ¶¶ 30–34. Petitioner does not proffer a construction of the term "type" itself, but disputes Patent Owner's assertions about relationships between types of things. Pet. Reply 1–3.

  a. Patent Owner's argument that "type" means "category"

  In support of their contention that "type" means "category," Patent Owner and Dr. Levy state that:

> The term "type" is used consistently throughout the claims and consistently throughout the disclosure of the '356 Patent. The independent claims refer to a "type" of operation, a "type" of action, and a "type" of contact information. There are five examples of this usage in the independent claims, as follows:
>
> a. "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"[;]
>
> b. "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"[;]
>
> c. "the operation comprising identifying at least part of the selected textual information to use as a search

9

IPR2014-00450
Patent 7,921,356 B2

> term in order to find *second information, of a specific type or types*"[;]
>
> d. "wherein the operation further comprises … causing an electronic search … and *performing an action having a type*[]"[; and]
>
> e. "wherein *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."

PO Resp. 9–10; Ex. 2001 ¶ 29. Based on this assertion, Patent Owner and

Dr. Levy conclude that "[t]hus, a 'type' refers to a 'category.'" PO

Resp. 10–11; Ex. 2001 ¶¶ 29–30.

We are not persuaded by these contentions of Patent Owner and Dr.

Levy. Under the broadest reasonable interpretation standard, "claims should

always be read in light of the specification and teachings in the underlying

patent." *Suitco Surface,* 603 F.3d. at 1260 (citation omitted) (emphasis

added); *see also In re NTP, Inc.*, 654 F.3d 1279, 1288 (Fed. Cir. 2011)

(claim construction "cannot be divorced from the specification and the

record evidence"). In this case, aside from certain examples in the claims,

Patent Owner and Dr. Levy do not cite any recitations of the term "type" in

the Specification of the '853 patent. In their assertion that the claims and

disclosure of the '356 patent use the term "type" consistently, Patent Owner

and Dr. Levy point to a number of recitations of the term "type" in the

claims, but they do not explain what is consistent about the claims' use of

the term with relevant disclosures in the Specification. *See* PO Resp. 10–11;

10

IPR2014-00450
Patent 7,921,356 B2

Ex. 2001 ¶¶ 29–30. The mere fact that the claims use the term repeatedly, by itself, does not provide a logical basis to conclude that the term means "category."

Patent Owner and Dr. Levy also assert that the language of claims 1 and 2 demonstrate that "causing insertion of at least part of the second information into the document" constitutes one type of action, and that "causing indication to the user that the information source does not include the search term" constitutes another type of action. PO Resp. 12; Ex. 2001 ¶ 33. We discern no reason to doubt that these constitute two types of actions. At the same time, however, we find this observation does not clarify the meaning of the term "type," itself. Indeed, we find that neither Patent Owner's and Dr. Levy's assertions about the language of the claims, nor the plain language of the claims, adds any clarity to the meaning of the term "type."

Aside from the claims, the '853 patent uses the word "type" as a noun or adjective in the following statements:[1]

    (1)   "Using address type." Ex. 1001, Fig. 6.

    (2)   "Use address type." *Id.* at Fig. 9.

    (3)   "Address type." *Id.* at Fig. 11.

    (4)   "Address type already in use." *Id.* at Fig. 13.

    (5)   "This screen includes . . . the address type selection 54, such as home, business, etc. . . ." *Id.* at col. 7, ll. 6–13.

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[1] Although not relevant to the present claim construction issue, we note that the '356 patent also extensively uses the verb "type," as in typing text.

11

IPR2014-00450
Patent 7,921,356 B2

(6)   "The updated screen includes . . . the fields for the address type selection 54, such as home, business, etc. . . ." *Id.* at col. 7, ll. 54–57.

(7)   "Although the present invention is defined in terms of word processing documents, such as WORD™ documents and EXCEL™ spreadsheets, the present invention is applicable to all *types* of word processing documents such as NOTE-PAD™, WORDPAD™, WORDPERFECT™, QUATROPROT™, AMIPRO™, etc., as will be readily apparent to those skilled in the art.

Although the present invention is defined in terms of information management or database programs, such as OUTLOOK™, etc., the present invention is applicable to all *types* of information management or database programs such as ACCESS™, ORACLE™, DBASE™, RBASE™, CARDFILE™, including "flat files," etc., as will be readily apparent to those skilled in the art.

Although the present invention is defined in terms of providing an input device, such as a button 42 in a word processor for address handling therein, the present invention may be practiced with all *types* of input devices, such as touch screen, keyboard button, icon, menu, voice command device, etc., as will be readily apparent to those skilled in the art." Ex. 1001, col. 9, l. 64–col. 10, l. 16 (emphases added).

Like the claims, these disclosures, which contain no discussion of what the term "type" means, do not clarify the meaning of the term itself. Neither the claims nor the other disclosures of the '853 patent suggest any meaning of the term "type" other than its ordinary and customary meaning. Indeed, the intrinsic evidence illustrates the flaw in Patent Owner's proposed construction. Here, "type" is used in its ordinary sense and "category" is merely another ordinary English word. Patent Owner points to nothing in

12

IPR2014-00450
Patent 7,921,356 B2

the intrinsic evidence that suggests any specific difference that using the word "category" over "type" would illuminate. In this case, without some specific difference in using one ordinary term over the other, Patent Owner's proposed one-for-one substitution of "category" for "type" in the claims creates opportunities for uncertainty rather than provides clarity.

Given the absence of an explicit definition in the Specification of the '853 patent, we look simply to the ordinary and customary meaning of "type." *See Translogic*, 504 F.3d at 1257. In a general purpose dictionary, we find that one ordinary meaning of the term "type" is "a kind, class, or category, the constituents of which share similar characteristics." COLLINS ENGLISH DICTIONARY (1998) (Ex. 3001). This meaning of the term "type" does not contradict any of the intrinsic evidence regarding the term "type." *See Starhome GmbH v. AT&T Mobility LLC*, 743 F.3d 849, 856 (Fed. Cir. 2014) ("[J]udges are free to rely on dictionaries at any time during the process of construing claims 'so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.'") (citations omitted). Accordingly, we conclude that the broadest reasonable interpretation of the term "type" is "a kind, class, or category, the constituents of which share similar characteristics."[2]

> b. *Patent Owner's arguments that types must be mutually exclusive*

In addition to arguing that "type" means "category," Patent Owner contends that different instances of a type of thing do not constitute different

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[2] We recognize that our construction of the term "type" includes "category," but we note that this construction is not limited to "category."

13

IPR2014-00450
Patent 7,921,356 B2

types of things, but instead merely constitute different instances of the same
type. PO Resp. 11 (citing Ex. 2001 ¶¶ 29–30). Patent Owner adds that if
each instance of something (e.g., each instance of a template or a name)
constituted a different "type" of thing, then the word "type" would be
redundant in the claim recitation "type of action." *Id.* at 13–14. Indeed,
Patent Owner argues, the claims require two types of actions, and different
instances of those types of actions are only different instances of the same
type of action, not different types. *Id.* at 11–14 (citing Ex. 2001 ¶¶ 29–34).

   Specifically, Patent Owner argues that "claims 1 and 2 call out two
distinct 'types' of action: (1) 'causing insertion of at least part of the second
information into the document'[;] and (2) 'causing indication to the user that
the information source does not include the search term.'" *Id.* at 12 (citing
Ex. 2001 ¶ 33). In support of this contention, Patent Owner asserts that the
claim 1 language "the type of action depends at least in part on whether the
search term is included in the information source" creates at least two
possibilities: (a) the search term is in the information source, or (b) the
search term is not in the information source. *Id.* at 11 (citing Ex. 2001 ¶ 31).
Patent Owner elaborates that, "[i]f the search term *is* included, then [claim 1]
specifies that if also 'the information source includes the second
information, the action comprises causing insertion of at least part of the
second information into the document.'" *Id.* (citing Ex. 2001 ¶ 32). Patent
Owner adds that, "[o]n the other hand, if the search term *is not* included,
claim 2 requires that 'when the information source does not include the
search term, the action comprises causing indication to the user that the

14

IPR2014-00450
Patent 7,921,356 B2

information source does not include the search term.'" *Id.* at 11–12 (citing Ex. 2001 ¶ 32).

Petitioner disagrees with Patent Owner's suggestion that the claim language requires mutually exclusive actions depending on whether the search term is in the information source. Pet. Reply 2–3. Petitioner argues that the claim language "wherein the type of action depends *at least in part* on whether the search term is included" (emphasis added) allows for factors other than the presence or absence of the search term to affect the type of the action. *Id.* at 2. Petitioner further argues that the claim language "the action *comprises* causing insertion of at least part of the second information into the document" (emphasis added) allows for aspects of the action other than the insertion to vary. *Id.* In connection with this, Petitioner asserts that "[o]ther exemplary 'actions' listed in the specification include displaying contact match choices in a menu for user decision (Ex. 1001, 4:49-52) and presenting data for the user to edit or update (*id.*, 4:62-67)." Pet. Reply 2–3.

Petitioner also argues that Dr. Levy admitted that the characteristics affecting the categories of various items overlap, such that they are not mutually exclusive. Pet. Reply 6 (citing Ex. 1017, 114, l. 21–117, l. 3). For example, Petitioner argues that Dr. Levy admitted that two pens could be both within the same category (e.g., "writing implements") and in different categories (e.g., "things that write with red ink"). *Id.* (citing Ex. 1017, 117, l. 4–118, l. 10; 118, l. 19–119, l. 9). Petitioner additionally asserts that Dr. Levy acknowledged the existence of an infinite number of ways to divide the world. *Id.* (citing Ex. 1017, 118, ll. 14–16).

IPR2014-00450
Patent 7,921,356 B2

We agree with Petitioner that neither the term "type," itself, nor other aspects of the claim language require dividing actions or other things into a set number of mutually exclusive categories. With respect to the recitation in claim 1 of "wherein the type of action depends at least in part on whether the search term is included in the information source," the language "at least in part" and "comprises" makes the plain meaning of the claim language broader than Patent Owner contends. Additionally, Petitioner's observation that the Specification discloses examples of more than two types of actions supports a conclusion that the plain meaning of the claims is consistent with the Specification. *See id.* at 2–3. Furthermore, Dr. Levy's admission that "there are literally an infinite number of ways to divide the world" vitiates Patent Owner's arguments that the term "type" requires separating things into a set number of mutually exclusive categories. Ex. 1017, 118, ll. 14–16. Thus, we decline to read this concept of mutually exclusive actions into our construction of "type" recited above.

2. *"wherein the type of action depends at least in part on whether the search term is included in the information source" (claims 1, 12, and 20)*

Patent Owner argues that this claim language "requires two possibilities for the type of action," including "a first action type that occurs if the search term *is* included in the information source and a second action type that occurs if the search term *is not* include in the information source." PO Resp. 15. In support of this contention, Patent Owner does not offer any additional arguments beyond those discussed in Section II.A.1.b above.

As also discussed above in Section II.A.1.b, Petitioner argues this claim language is broader than Patent Owner contends. Pet. Reply 1–3.

16

IPR2014-00450
Patent 7,921,356 B2

Petitioner notes that the claim language states that the type of action depends "at least in part" on the presence or absence of the search term, and that the action "comprises" causing insertion of second information. *Id.* at 2. Petitioner also cites the Specification of the '356 patent as disclosing examples of types of actions other than the two identified by Patent Owner. *Id.* at 2–3 (citing Ex. 1001, col. 4, ll. 49–52, 62–67). Petitioner contends that the claim language should be construed as requiring that "the character of the action changes based, at least in part, on whether the search term is included in the information source." *Id.* at 3.

For the reasons discussed above in Section II.A.1.b, we are persuaded by Petitioner that the proper construction of the claim language is broader than Patent Owner asserts. Additionally, we are persuaded that Petitioner's proposed construction is consistent with the Specification of the '356 patent and captures the plain meaning of the claim language. Petitioner's proffered construction captures the plain meaning of the nature of the conditional relationship in the claim—the presence or absence of the search term affects the type of action, but other things also may affect the type of the action. Additionally, Petitioner's contention that it is "the character of the action" that changes is consistent with our construction of "type" as meaning "a kind, class, or category, the constituents of which share similar characteristics." *See* Section II.A.1.a. Accordingly, we conclude that the broadest reasonable construction of the claim language "wherein the type of action depends at least in part on whether the search term is included in the information source" requires that "the character of the action changes based,

17

IPR2014-00450
Patent 7,921,356 B2

at least in part, on whether the search term is included in the information source."

> 3.   *"operation" (claims 1, 12, and 20)*

Patent Owner states that:

> The independent claims of the '356 patent all refer to the performance of an "operation". The claims require that the operation comprises:

> > *causing an electronic search* in the information source, by an information management program external to the document editing program, for the search term in order to find whether the search term is included in the information source; *and performing an action* having a type [emphasis added].

PO Resp. 16–17. Based on this, Patent Owner argues that "the operation includes both *searching* an information source and *performing a separate action*." *Id.* at 17. Patent Owner further notes that the independent claims each recite that the operation has a type, the "type depending at least in part on the type or types of contact information of the selected textual information." *Id.* Patent Owner adds that "the claim requires at least two different types of operations wherein each operation is dependent on a different type of contact information as identified in the selected textual information." *Id.*

In response, Petitioner agrees with Patent Owner that the "claims require searching an information source and performing an action based 'at least in part' on the results of that search." Pet. Reply 3. Petitioner argues, however, that Patent Owner's "apparent argument that both of these undisputed elements should be somehow integrated into the construction of 'operation' . . . confuses the issue." *Id.*

18

IPR2014-00450
Patent 7,921,356 B2

Patent Owner's arguments contain ambiguities that cause some confusion regarding whether Patent Owner is offering a construction of the term "operation," itself, or a construction of all of the other limitations tied to the term "operation." As Petitioner concedes, the limitations related to the operation having a type and including searching and performing an action are recited expressly in the independent claims as further limitations on the recited "operation." Given this, each independent claim as a whole does require these limitations. At the same time, to the extent Patent Owner suggests that the term "operation," itself, requires these other limitations, we disagree. It is well settled that a claim interpretation that renders a claim term or phrase superfluous is disfavored. *Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007). If the term "operation," itself, required that the operation have a type and include searching and performing an action, the claims' explicit recitation of these further limitations would be superfluous.

B.   *Obviousness of Claims 1, 7, 10, 12, 16, and 20 Based on Tso and Pandit*

Petitioner asserts that claims 1, 7, 10, 12, 16, and 20 are unpatentable under 35 U.S.C. § 103(a) over Tso and Pandit. Pet. 48–59; Pet. Reply 1–15. Petitioner explains how Tso and Pandit allegedly render obvious the claimed subject matter. Petitioner also relies on the Declaration of Mr. Allison. Ex. 1002. Patent Owner disagrees with Petitioner's assertions and relies on the Declaration of Dr. Levy. PO Resp. 1–41; Ex. 2001.

A claim is unpatentable under 35 U.S.C. § 103(a) "if the differences between the subject matter sought to be patented and the prior art are such

19

IPR2014-00450
Patent 7,921,356 B2

that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Prior art references must be "considered together with the knowledge of one of ordinary skill in the pertinent art." *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Regarding the level of ordinary skill in the art, Petitioner cites Mr. Allison's testimony. Pet. 11 (citing Ex. 1002 ¶¶ 21–60). Mr. Allison testifies that "a person of ordinary skill in the art pertaining to the '356 patent in the relevant timeframe would have at least a Bachelor's degree in Computer Science or Electrical Engineering or related discipline and about two years' experience designing applications that use databases." Ex. 1002 ¶ 21. Patent Owner does not specify a level of ordinary skill in the art in its Patent Owner Response, but Dr. Levy testifies that "a person of ordinary skill in the art pertaining to the '356 patent corresponds to one in 1998 who had at least a Bachelor's degree in Computer Science or Electrical Engineering or related discipline and approximately two years of experience designing user applications or software modules." Ex. 2001 ¶ 15. Mr. Allison's and Dr. Levy's testimony regarding the level of ordinary skill in the art differ only slightly. Our findings and conclusions apply under either Mr. Allison's or Dr. Levy's description of the level of ordinary skill in the art.

1. Tso

Tso discloses a context-sensitive template engine that automatically generates a text message, thereby helping a user generate the text message with minimal keyboard access. Ex. 1009, col. 1, ll. 56–63; col. 2, ll. 59–61.

IPR2014-00450
Patent 7,921,356 B2

The system allows users to generate a text message "from scratch" or,

alternatively, in response to a previously received message. *Id.* at col. 1,

ll. 58–60. Tso discloses:

> Given an input text passage, such as a portion of a
> partially-composed outgoing text message or a portion of
> a received text message, the template engine can suggest
> one or more predefined, context-appropriate sentences to
> include in the outgoing text message based on the actual
> content of the input text passage.

Id. at col. 2, ll. 61–67.

Tso shows how its template engine interacts with other parts of the

system architecture illustrated in Figure 1, reproduced below.
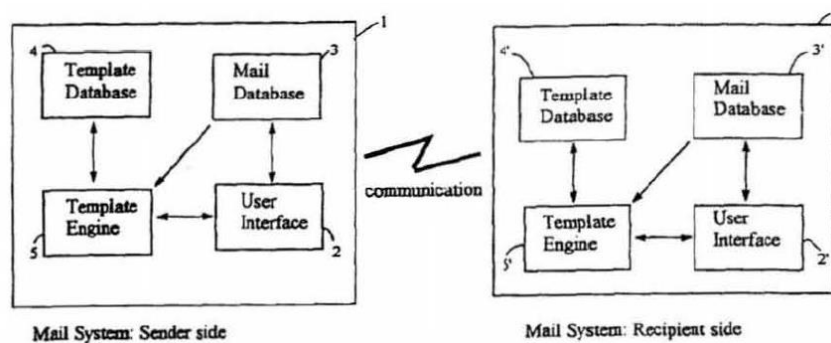
Figure 1

Figure 1 provides a block diagram illustrating relationships between

template engines 5, 5′ and other parts of a system, including user

interfaces 2, 2′, mail databases 3, 3′, and template databases 4, 4′. *See id.* at

col. 2, ll. 46–48; col. 3, ll. 45–49, 63–65. Template database 4 stores a set of

predefined templates. *Id.* at col. 5, ll. 7–9. Additionally, Tso discloses that

its system allows a user to create custom templates. *Id.* at col. 7, ll. 19–25;

21

IPR2014-00450
Patent 7,921,356 B2

col. 8, ll. 5–14. Tso discloses that "a 'template' is a text string consisting of

one or more 'phrases.'" *Id.* at col. 3, ll. 6–7.

Tso also discloses that "each template is associated with a set of

'keywords,'" and that the keywords each have a predetermined "weight."

Id. at col. 3, ll. 16–18. As an example, Tso discloses that one template may

be associated with the keywords and weights set forth in the table

reproduced below:

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

Id. at col. 5, ll. 23–34. The table lists five keywords and an associated

weight for each of the keywords.

Tso discloses that, "[w]hen 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.* at col. 4,

ll. 31–34. In response, user interface 2 "pass[es] the entire text message

being edited by the user and the current cursor position to" template engine 5

for processing. *Id.* at col. 4, ll. 42–46. Within this text, template engine 5

identifies words to use as search words. *Id.* at col. 4, l. 48–col. 5, l. 41.

Template engine 5 uses the search words to search template

database 4. *Id.* at col. 5, ll. 7–9. Template engine 5 does so by comparing

the keywords associated with each template to the search words. *Id.* at col.

5, ll. 9–11. In this process,

> [i]f a keyword is found in the array, the weight value
> associated with that keyword is added to a running total

22

IPR2014-00450
Patent 7,921,356 B2

> weight value for that template. In this fashion, the template engine 5 determines a total weight value for each template in the template database [4]. 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, ll. 11–18.

As an example, Tso explains how template engine 5 would compare the weighted keywords in the table reproduced above to the following text string: "When and where would you like to meet?" *Id.* at col 5, ll. 23–41. Tso explains that, because the keywords "where," "when," and "meet" match words in the text string, the template associated with the exemplary keywords would receive a weighted score of 145. *Id.* at col. 5, ll. 36–41.

Once template engine 5 "determines the most appropriate template, it passes that template to the user interface 2 for presentation to the user." *Id.* at col. 5, ll. 42–44. Tso further discloses that "[i]t is conceivable that more than one template will have a highest total weight value, in which case the user interface **2** could present multiple templates to the user" for the user to select the most appropriate one. *Id.* at col. 5, ll. 49–53. Tso additionally discloses that once template engine 5 finishes processing a section of text selected by the user,

> the additional text generated by the template engine 5 is passed to the e-mail application for insertion in the message being composed. The user interface 2 could be programmed to automatically insert the generated text at the end of the message text, or alternatively could prompt the user to place the cursor at a particular location where the text is to be inserted.

Id. at col. 6, l. 66–col. 7, l. 6.

23

IPR2014-00450
Patent 7,921,356 B2

2. Pandit (Ex. 1004)

Pandit's disclosure relates to recognizing text in a body of text as belonging to a class of text and executing an operation related to the recognized text. Ex. 1004, col. 1, ll. 51–53. Pandit discusses one example of such operations in connection with Figures 1c and 1d, reproduced below.
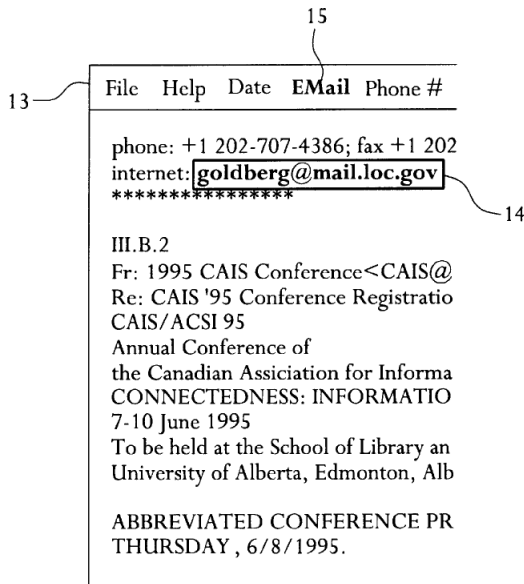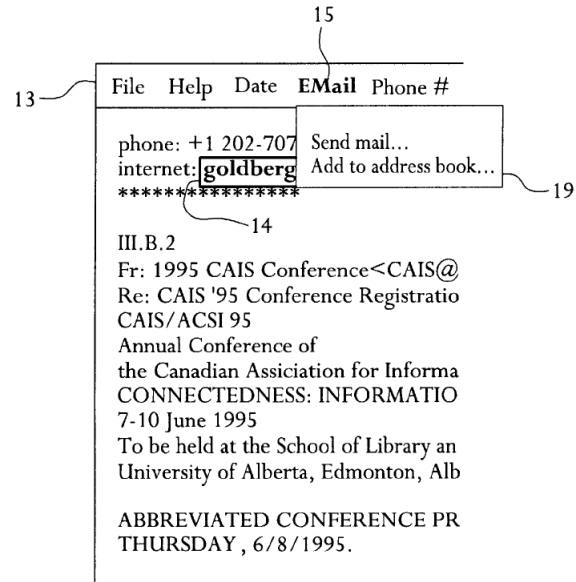
FIG. 1c   FIG. 1d

Figures 1c and 1d illustrate text on video monitors. *Id.* at col. 1, ll. 60–61. In Figure 1c, e-mail address 14 is accented. *Id.* at col. 2, l. 50. The accented text is recognized, and the name of a menu corresponding to the type of text recognized is highlighted in menu bar 13. *Id.* at col. 2, ll. 9–13; Figs. 1c, 2. Specifically, with e-mail address 14 accented and recognized, menu name EMail 15 is highlighted, indicating that menu is enabled. *See id.* at col. 2, ll. 51–53; Fig. 1c. As shown in Figure 1d, a user can call the enabled menu, resulting in pulled-down EMail menu 19, which includes programs related to e-mail. *See id.* at col. 2, ll. 16–19, 56–63; Figs. 1d, 2.

24

IPR2014-00450
Patent 7,921,356 B2

In connection with Figures 1e and 1f, Pandit discusses another example of recognizing a class of text and executing a related operation. *See id.* at col. 1, ll. 51–53; col. 2, l. 64–col. 3, l. 10. Figures 1e and 1f are reproduced below.
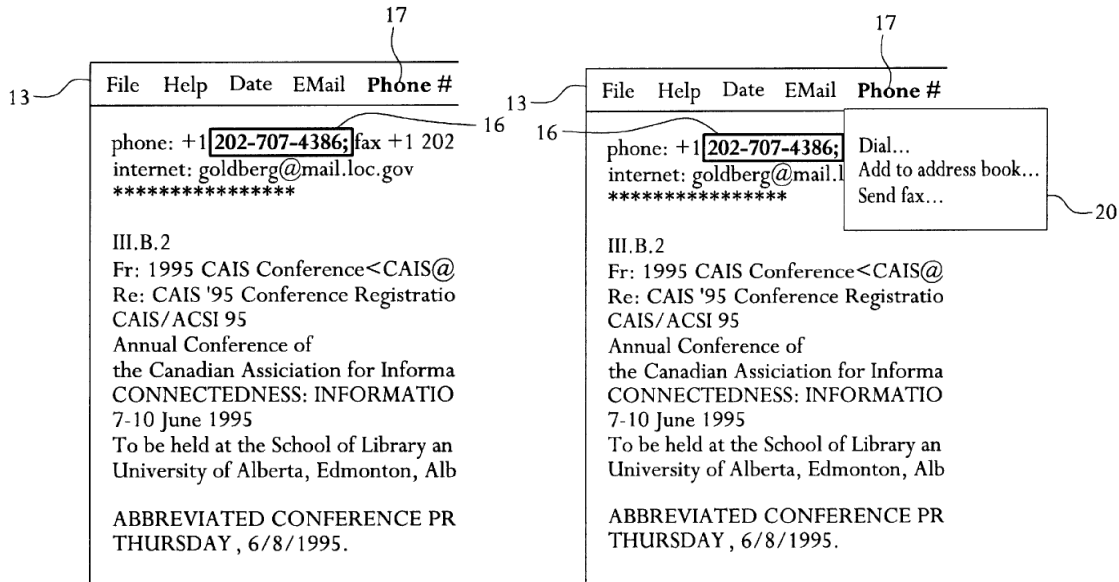
FIG. 1e   FIG. 1f

Figures 1e and 1f illustrate text on video monitors. *Id.* at col. 1, ll. 60–61. In Figure 1e, telephone number 16 is accented. *Id.* at col. 2, ll. 64–65. The accented text is recognized, and the name of a menu corresponding to the type of text recognized is highlighted in menu bar 13. *Id.* at col. 2, ll. 9–13; Figs. 1c, 2. Specifically, "[t]he pull down menu named Phone #17 is highlighted and preferably identifies the executable operations and/or programs which are relevant to telephone and telefax numbers." *Id.* at col. 2, l. 65–col. 3, l. 1.

IPR2014-00450
Patent 7,921,356 B2

3. Discussion

Petitioner contends that each limitation of claims 1, 7, 10, 12, 16, and 20 is taught by, or obvious in view of, Tso and Pandit. Pet. 48–59. Petitioner cites Tso as teaching most of the limitations of the claims. *See* Pet. 52–59. For example, Petitioner cites Tso as teaching that its system allows a user to enter text into a document. *Id.* at 53. Petitioner also cites Tso as teaching that its system allows a user to select at least a portion of the text. *Id.* at 53–54. Additionally, Petitioner cites Tso as teaching that its system analyzes the selected text, and that the system identifies at least part of the text to use as a search term in order to find second information associated with the search term in an information source external to the document. *Id.* at 54–56. Petitioner also cites Tso as teaching that its system

> perform[s] 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, 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.

Id. at 57–58.

Petitioner cites Pandit in connection with the claim language "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." *Id.* at 55–56. Petitioner asserts that Pandit teaches, among other things, analyzing selected textual information to determine if it is a particular type of contact information, and executing

26

IPR2014-00450
Patent 7,921,356 B2

actions based on the type of information identified. *Id.* at 56. Petitioner

cites the following portions of Pandit's claims 1 and 7:

> (3) recognizing the selected text as belonging to the predetermined class if the format of the selected text matches the predetermined format; and
>
> (b) performing an operation associated with the predetermined class using the recognized text as a parameter. . . .
>
> 7. The method of claim 1, wherein the text is one of a date, name, telephone number, telefax number, e-mail address, and Uniform Resource Locator.

Ex. 1004, col. 5, ll. 63–67, col. 6, ll. 30–32; Pet. 56–57.

Petitioner argues that it would have been obvious "to use Pandit's

recognition of certain types of contact information in Tso's system," and,

specifically, it would have been obvious "to use Tso's system to identify

contact information in the document, and to insert related contact

information." Pet. 50–51.

Petitioner argues that it would have been obvious for a number of

reasons to so combine the teachings of Tso and Pandit. *Id.* at 49–52.

Petitioner argues that "the [Tso and Pandit] systems are technically

compatible from the outset" because both Tso and Pandit teach analyzing

text selected by a user, performing an operation based on the content of the

selected text, and using "[dynamic link library] plugins to integrate with

common text processing programs, noting that the kind of text-processing

program is not of foremost importance." *Id.* at 49 (citing Ex. 1004, col. 2,

ll. 4–8; col. 3, ll. 37–39; col. 4, ll. 32–55; Ex. 1009, col. 3, ll. 20–25; col. 4,

ll. 32–47; Ex. 1002 ¶¶ 231–232). In this vein, Petitioner further argues that

IPR2014-00450
Patent 7,921,356 B2

Pandit teaches its system can be employed to generate an e-mail templating system like the one Tso discloses, and that Pandit teaches its system can be used with many text processing operations, including text processing operations of e-mail programs. *Id.* at 50 (citing Ex. 1004, col. 2, ll. 56–63; col. 3, ll. 27–33; Ex. 1002 ¶¶ 233–234).

Additionally, Petitioner cites a number of other teachings of Tso and Pandit as support for the argument that it would have been obvious to combine these references. For example, Petitioner further notes that Tso endeavors to reduce the number of keystrokes needed to compose an e-mail, that Tso already discloses templates related to location, and that Tso encourages the creation of new templates. *Id.* at 51 (citing Ex. 1009, col. 6, ll. 24–37, 60–61; col. 7, ll. 14–25; col. 8, ll. 5–14; Ex. 1002 ¶¶ 236–237). In light of this, Petitioner argues that modifying Tso's system to include templates with specific address information would have furthered Tso's object of reducing the number of keystrokes needed to compose an e-mail. *Id.*

Petitioner further argues that Pandit's teaching of processing contact information represented a known technique that could have been applied to Tso's system without any unpredictable results. *Id.* at 51–52 (citing *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 416–19 (2007); Ex. 1002 ¶ 238). Additionally, Petitioner argues that combining the teachings of the references would have been within the ordinary skill in the art, citing to the references' disclosure of using common technology, as well as Mr. Allison's supporting testimony. *Id.* at 52 (citing Ex. 1009, 3:23–25; Ex. 1002 ¶ 239).

28

IPR2014-00450
Patent 7,921,356 B2

We have reviewed the evidence and arguments presented in the Petition, Patent Owner's Response, and Petitioner's Reply. Based on that review, we determine that Petitioner has demonstrated, by a preponderance of the evidence, that all of the limitations of each of claims 1, 7, 10, 12, 16, and 20 are taught by, or rendered obvious in view of, Tso and Pandit, and that each of these claims, considered as a whole, would have been obvious over Tso and Pandit. Pet. 3–13, 48–59; PO Resp. 1–41; Pet. Reply 1–15.

The parties' disputes revolve around whether certain limitations of the claims are taught by, or obvious in view of, Tso and Pandit, and whether Petitioner has provided an articulated reason with some rational underpinning to support a conclusion that the claimed inventions would have been obvious in view of Tso and Pandit. Each of the claim limitations in dispute appears verbatim in each of independent claims 1, 12, and 20. Accordingly, our discussion of the disputed claim limitations applies equally to each of independent claims 1, 12, and 20, as well as dependent claims 7, 10, and 16.

a. *Whether Pandit discloses "an operation"*

With respect to "an operation" recited in the independent claims, Petitioner cites Pandit's disclosure of "recognizing the selected text as belonging to the predetermined class" and "performing an *operation* associated with the predetermined class using the recognized text as a parameter." Ex. 1004, col. 5, ll. 63–67 (emphasis added); Pet. 56–57. Patent Owner argues that Pandit does not teach "the kind of operations as defined by the language of the independent claims" because "Pandit fails to disclose searching." PO Resp. 18. Based on this, Patent Owner argues that

29

IPR2014-00450
Patent 7,921,356 B2

"Pandit does not associate a 'type of operation' with the 'type of contact information.'" *Id.*

Petitioner responds that Patent Owner admits Pandit identifies different types of contact information and uses that information to perform what Pandit describes as "operations." Pet. Reply 9. Petitioner further states that Patent Owner "argues that [Pandit's] operations are 'not the kind of operations' of the '356 Patent." *Id.* Petitioner argues that the Specification of the '356 patent contradicts this, citing disclosures in both Pandit and the '356 patent of updating contact information records. *Id.* (citing Ex. 1001, col. 6, ll. 7–38, col. 6, l. 60–col. 7, l. 23, Figs. 4–5; Ex. 1004, col. 2, l. 51– col. 3, l. 10). Additionally, Petitioner notes that it relies on Tso as teaching certain constituent parts of the claimed "operation," arguing that it would have been obvious to combine the teachings of the references. Pet. Reply 9– 10.

For the reasons explained above in Section II.A.3, the claim language "operation," itself, does not require an electronic search or performing an action having a type. Accordingly, Patent Owner's assertion that Pandit does not teach "wherein the operation further comprises: causing an electronic search . . . and performing an action having a type" does not persuade us that Pandit does not teach "an operation." *See* PO Resp. 18. To the contrary, Petitioner's reasoning and evidence, including Pandit's express disclosure of performing "an operation" and Petitioner's identification of similarities between Pandit's disclosure and that of the '356 patent, persuade us that Pandit discloses an "operation." Indeed, as Petitioner notes, Patent Owner concedes that "Pandit identifies different types of contact information

30

IPR2014-00450
Patent 7,921,356 B2

(claim 7, e.g. name, telephone number, telefax number, e-mail address) and performs an *operation* based upon the type of contact information (claim 1 i.e. performing an operation associated with the predetermined class)." PO Resp. 18 (emphasis added); Pet. Reply 9.

Furthermore, we are persuaded that Pandit teaches an operation "of a type depending at least in part on the type or types of contact information of the selected textual information," as recited in the independent claims. *See* Pet. 11–12, 48–52, 55–57; Pet. Reply 9–10. For example, we are persuaded that this is taught by the disclosure in Pandit's claims 1 and 7 that Petitioner cites. As noted above in Section II.A.1.a, we construe "type" as meaning "a kind, class, or category, the constituents of which share similar characteristics." Given this, we find Pandit teaches identifying the type of contact information by disclosing "recognizing the selected text as belonging to the predetermined *class*" "wherein the text is one of a date, name, telephone number, telefax number, e-mail address, and Uniform Resource Locator." Ex. 1004, col. 5, ll. 63–64, col. 6, ll. 30–32 (emphasis added). Furthermore, we find that Pandit's disclosure of "performing an operation associated with the predetermined *class* using the recognized text as a parameter" (Ex. 1004, col. 5, ll. 66–67 (emphasis added)) teaches "such operation being of a type depending at least in part on the type or types of contact information of the selected textual information," as recited in the independent claims.

Furthermore, we are persuaded that Pandit's statement that "the text is one of a date, name, telephone number, telefax number, e-mail address, and Uniform Resource Locator" identifies multiple classes (i.e., types) of

31

IPR2014-00450
Patent 7,921,356 B2

information that Pandit's system recognizes. *See, e.g.*, Pet. 48–49 ("Pandit describes a system for allowing a user to select text, analyzing the selected text to recognize a class of information such as an email address, a phone number or a street address."). Additionally, given that the cited disclosure teaches multiple types of contact information that the system may recognize, and that the recited "operation" is associated with the type of contact information recognized, we find that Pandit teaches multiple types of operations, which depend on the type of contact information identified.

Patent Owner's assertion that Pandit's operation does not include all of the other limitations tied to the operation recited in the independent claims is misplaced because Petitioner relies on Tso as teaching these other limitations. *See* Pet. 55–58.

b. *Whether Tso discloses an "operation"*

Patent Owner argues that Tso does not teach an operation of a "type depending at least in part on the type or types of contact information of the selected textual information," as recited in the independent claims. PO Resp. 18. We find this argument unpersuasive because we are persuaded that Pandit teaches an operation of a "type depending at least in part on the type or types of contact information of the selected textual information," and because Petitioner relies on Pandit in combination with Tso as rendering the claims obvious. *See* Pet. 48–59.

c. *Whether Petitioner provides an articulated reason with a rational underpinning to justify a conclusion of obviousness*

Patent Owner contends that "[t]he Petitioner fails to provide a credible rationale by which a combination of Tso and Pandit would lead to the

32

IPR2014-00450
Patent 7,921,356 B2

invention as claimed. The Petition lacks an 'articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" PO Resp. 25 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Patent Owner argues that Petitioner does not provide adequate detail about how the teachings of Tso and Pandit would be combined. *Id.* at 26–28. In concert with this, Patent Owner takes the initiative, alleging to "show that any possible combination of these two references by one of ordinary skill in the art fails to provide more functionality than in any one of the references taken alone, and that the combination therefore fails to render the subject matter obvious." *Id.* at 26. Patent Owner asserts that Dr. Levy performed an "analysis of how the references would actually be combined by one of ordinary skill in the art," in which "Dr. Levy considers two possible modes of combining Pandit and Tso." *Id.* at 28–33.

Patent Owner explains that Dr. Levy's "first mode" involves "using the system of Pandit with the teachings of Tso." *Id.* at 29. Regarding his first mode, Dr. Levy opines that "[a] person of ordinary skill in the art attempting to combine Pandit with Tso could take the 'front-end' of Pandit and perform recognition on the input text in order to classify it by type." Ex. 2001 ¶ 39. Dr. Levy elaborates that one could use the results in a search to pull up a template that is a list of options, but Pandit already does this, so this wouldn't add any additional functionality. *Id.* Dr. Levy also opines that, "[f]urthermore, this analysis does not address the fact that Pandit may classify different input words into different types, and therefore when used as search terms, these Pandit types would be different and conflicting." *Id.* Dr. Levy also asserts that his first mode of combining the references would

33

IPR2014-00450
Patent 7,921,356 B2

not produce the subject matter of the independent claims because Tso

allegedly does not disclose "a database of associations between names and

phone numbers," and Pandit allegedly "uses the *type* of selected textual

information as a search term . . . , not the textual information itself."

Ex. 2001 ¶ 40; PO Resp. 30–31.

      Patent Owner explains that in Dr. Levy's "second mode," "the system

of Tso is modified with the teachings of Pandit." PO Resp. 31. In this

mode, Patent Owner and Dr. Levy assert, one could begin with the teachings

of Tso and employ Pandit's teachings to recognize the type of each search

term. Ex. 2001 ¶ 41; PO Resp. 31–32. Asserting that "Pandit can only

identify the type of the search terms, and Tso does not teach a way to use

type information," Patent Owner and Dr. Levy conclude that the second

mode of combination "fails to add more functionality than present in Tso

alone." Ex. 2001 ¶ 41; PO Resp. 32. Patent Owner asserts that Dr. Levy's

second mode of combining the references does not meet the limitations of

the independent claims because Pandit does not teach searching and Tso

does not teach using the types of input words. PO Resp. 32–33 (citing Ex.

2001 ¶¶ 36, 42). Based on this, Patent Owner asserts that Dr. Levy's second

mode of combining the references "fails to address the '356 Patent claim

limitation wherein the 'operation,' which includes both 'searching' and

'performing an action,' must be 'of a type depending at least in part on the

type or types of contact information of the selected textual information.'"

PO Resp. 32–33 (citing Ex. 2001 ¶ 42). Based on their contentions that Dr.

Levy's first and second modes of combining the references would not

provide any additional functionality, Patent Owner and Dr. Levy contend

IPR2014-00450
Patent 7,921,356 B2

that a person of ordinary skill in the art would have no reason to combine

Tso and Pandit. PO Resp. 30–32; Ex. 2001 ¶¶ 40–41.

Petitioner responds that Tso and Pandit collectively disclose the

elements of the challenged claims, and that the Petition describes, in detail,

the compatibilities of these references and articulates how to combine them.

Pet. Reply 10–15 (citing Pet. 48–52; Ex. 1002 ¶¶ 235–238). Petitioner

elaborates that the Petition asserts that it would have been obvious to

combine Tso's e-mail template-generation system with Pandit's recognition

of the type of contact information to produce a system using related contact

information in the templates generated. *Id.* at 13–14 (citing Pet. 50–51;

Ex. 1002 ¶¶ 235–238). Petitioner reiterates its assertion that extensive

similarities between Tso and Pandit would have motivated a person of

ordinary skill in the art to combine the teachings of the references, arguing

that Patent Owner did not rebut this assertion. Pet. Reply 14–15 (citing

Pet. 18–25, 52–58; Ex. 1004, col. 5, ll. 18–23; Figs. 1c–1d; Ex. 1009, col. 7,

ll. 53–63; Ex. 1017, 51, l. 14–52, l. 17; *KSR*, 550 U.S. at 418). Petitioner

further notes that "[t]he Petition argued that the combination of the familiar

elements of Tso and Pandit yields nothing but predictable results," and that

"[n]either [Patent Owner]'s response nor Dr. Levy's testimony rebutted this

point." *Id.* at 15 (citing Pet. 51; Ex. 1002 ¶¶ 52–53, 238; Ex. 1017, 140,

ll. 9–17; *KSR*, 550 U.S. at 416–419).

Regarding Dr. Levy's discussion of two ways to combine the

teachings of the references, Petitioner asserts that Dr. Levy does not address

Petitioner's assertions directly, and that Dr. Levy's analysis is overly

simplistic. *Id.* at 10–12. Petitioner asserts that Dr. Levy's first mode of

IPR2014-00450
Patent 7,921,356 B2

combining the references—"using the 'front-end' of Pandit with some aspects of Tso"—does not address Petitioner's proposed combination of the references. *Id.* at 11. Regarding Dr. Levy's second mode of combining the references, Petitioner notes that Dr. Levy concludes the combination would not work because "Pandit can only identify the type of search terms, and Tso does not teach a way to use type information." *Id.* at 11 (citing PO Resp. 32). Petitioner argues that "this was not the combination offered in the Petition," but an "overly simplistic approach to combining prior art [that] amounts to little more than mechanically smashing the two system together, without making reasonable modifications to facilitate their integration." *Id.* Petitioner cites precedent of the Supreme Court and the United States Court of Appeals for the Federal Circuit as conflicting with Dr. Levy's analysis, stating that:

> "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR v. Teleflex*, 550 U.S. 398, 421 (2007). A factfinder "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at 418. Applying *KSR* to a situation similar to the present case, the Federal Circuit rejected an applicant's argument that his invention was nonobvious because a "literal, physical combination" of the prior art references would not achieve the patented benefits. *In re Gilbert Chevalier et al.*, 500 Fed. Appx. 932, 934 (Fed. Cir. 2013). Such an argument "misapprehends the nature of the obviousness inquiry," which "does not ask 'whether the references could be physically combined but whether the claimed inventions are rendered obvious by the teachings of the prior art as a whole.'" *Id.* (quoting *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (*en banc*)). *See also In re Keller,* 642 F.2d 413, 425 (CCPA 1981) ("The test for

36

IPR2014-00450
Patent 7,921,356 B2

> obviousness is not whether the features of a secondary
> reference may be bodily incorporated into the structure of
> the primary reference").

Id. at 11–12.

Additionally, Petitioner asserts that the '356 patent, itself, provides relatively little detail about how to use ordinary commodity information technology to manage contact information. *Id.* at 12 (citing Ex. 1017, 36, ll. 1–3; 37, ll. 16–18; 38, ll. 6–9; 38, l. 24–39, l. 9; 39, ll. 10–13; 40, ll. 7–14). Instead, Petitioner argues, the '356 patent relies on the skill of an ordinary artisan "to combine the disparate parts and implement the claimed text selection, analysis, searching insertion, and other actions." *Id.* at 12–13 (citing Ex. 1017, 49, ll. 5–12; 53, l. 3–54, l. 3; 59, ll. 12–20; 60, ll. 13–22; 62, ll. 3–11; 130, ll. 5–24). Petitioner asserts that this belies Patent Owner's argument that Petitioner has not provided adequate details about how to combine the references, arguing that "the Federal Circuit [has] held that when a patent applicant 'did not provide the type of detail in his specification that he now argues is necessary in prior art references,' this 'supports [a] finding that one skilled in the art would have known how to implement the features of the references.'" *Id.* (quoting *In re Epstein*, 32 F.3d 1559, 1568 (Fed. Cir. 1994)).

We are persuaded that Petitioner has provided an articulated reason with a rational underpinning to justify a conclusion of obviousness. Tso teaches an operation that includes searching and performing an action. *See* Pet. 49–52, 57–58; PO Resp. 18 (conceding "Tso can be read as disclosing an operation"). As discussed above in Section II.B.3.a, we are persuaded that Pandit discloses performing an operation, "such operation being of a

IPR2014-00450
Patent 7,921,356 B2

type depending at least in part on the type or types of contact information of the selected textual information," as recited in the independent claims. Petitioner's evidence and reasoning persuades us that it would have been obvious to combine these teachings of the references. *See* Pet. 48–52; Pet. Reply 10–15.

For example, Petitioner provides an articulated reason with a rational underpinning for its position by reasoning that modifying Tso to use Pandit's recognition of certain types of contact information and insert related contact information would have further advanced Tso's stated objective of reducing the keystrokes needed to compose an e-mail, particularly where Tso encourages creation of additional templates. *See* Pet. 51 (citing Ex. 1009, col. 6, ll. 24–37, 60–61; col. 7, ll. 14–25; col. 8, ll. 5–14; Ex. 1002 ¶¶ 236–37). Petitioner's identification of evidence in Pandit and Tso of technical similarity of their systems further supports Petitioner's contention that it would have been obvious to combine the teachings of the two references. *See id.* at 49 (citing Ex. 1004, col. 2, ll. 4–8; col. 3, ll. 37–39; col. 4, ll. 32–55; Ex. 1009, col. 3, ll. 20–25; col. 4, ll. 32–47; Ex. 1002 ¶¶ 231–32). For example, Petitioner's observation that Pandit expressly discloses using its system like that disclosed in Tso to create an email template system further supports Petitioner's assertion of obviousness. *See id.* at 50 (citing Ex. 1004, col. 2, ll. 56–63; Ex. 1002 ¶ 233). Petitioner's assertion of obviousness is further supported by Mr. Allison's testimony that Tso was a known system, Pandit discloses a known approach, and "Pandit could have been applied to the Tso system without unpredictable results." Ex. 1002 ¶ 238.

IPR2014-00450
Patent 7,921,356 B2

The arguments and evidence presented by Patent Owner do not rebut persuasively Petitioner's demonstration of obviousness. Patent Owner does not address persuasively Petitioner's assertion that it would have been obvious to combine the teachings of the references because using Pandit's recognition of contact information type in Tso's system to insert related contact information would advance Tso's stated desire to reduce key strokes. Nor does Patent Owner address persuasively the assertion of Petitioner and Mr. Allison that the combination would have involved nothing more than applying a known technique to Tso's system to achieve predictable results. Pet. 51; Pet. Reply 15; Ex. 1002 ¶ 238.

Additionally, we find unpersuasive Patent Owner's citation of Dr. Levy's two modes of combining Tso and Pandit. In particular, we are not persuaded by Patent Owner's assertion that Dr. Levy's reasoning demonstrates that "any possible combination of these two references by one of ordinary skill in the art" would not produce the claimed invention. *See* PO Resp. 26. As an initial matter, we are not persuaded that Dr. Levy's two modes of combining these references represent "any possible combination." In any event, Patent Owner focuses on Dr. Levy's testimony in this regard as though it was articulated and relied upon by Petitioner in its Petition. As we discussed previously, Petitioner provides an articulated reason with a rationale underpinning to justify a conclusion of obviousness. Dr. Levy's testimony regarding the two modes of combining the references does not negate or otherwise undermine the arguments or evidence presented and developed by Petitioner in its Petition.

39

IPR2014-00450
Patent 7,921,356 B2

Furthermore, we find unpersuasive Dr. Levy's assertion that the teachings of the references do not mesh because "Pandit can only identify the type of the search terms, and Tso does not teach a way to use type information." Ex. 2001 ¶ 41; PO Resp. 32. Dr. Levy's analysis distills down to an assertion that it would not have been obvious to combine the references, and that combining the references would not produce the limitations of the claims, because each reference lacks an express teaching of how to use the disclosure of the other reference. This does not negate or otherwise undermine Petitioner's sound reasoning and evidence supporting a conclusion that the claimed invention would have been obvious in view of Tso and Pandit. *See KSR*, 550 U.S. at 418 ("[T]he analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ."); *id.* at 421 ("A person of ordinary skill is also a person of ordinary creativity, not an automaton.").

> d. *"wherein the type of action depends at least in part on whether the search term is included in the information source"*

Petitioner cites Tso as teaching this limitation. Pet. 57–58; Pet. Reply 3–7. Petitioner argues that "Tso teaches that **if a template match is found**, the template can be **inserted** directly into the email document." Pet. 57–58. Petitioner also argues that the particular template used depends on whether the system finds search terms in the information source, and Petitioner cites Mr. Allison's testimony that "[t]he Tso patent discusses the that predefined template, or the second information, is inserted only if the information source includes the search term." *Id.* at 58 (citing Ex. 1002

40

IPR2014-00450
Patent 7,921,356 B2

¶ 185). Thus, Petitioner argues that Tso performs different types of actions, depending at least in part on the results of its search. *Id.* at 57–58; Pet. Reply 3–9.

Patent Owner asserts that Tso's system "always behaves the same way, whether or not key word(s) are found." PO Resp. 16 (citing Ex. 2001 ¶¶ 23, 27). Specifically, Patent Owner asserts that "the Tso system always displays a template or templates for the user to elect to insert or not." *Id.* (citing Ex. 2001 ¶¶ 26–28).

One issue raised by the parties' arguments is whether Tso's system provides a template only if a search term is found. Additionally, the parties dispute whether Tso's disclosure of providing different templates constitutes one and only one type of action, as Patent Owner asserts, or multiple types of actions. PO Resp. 12–13; Pet. Reply 5–7. We address these issues in turn.

> i. *Whether Tso teaches inserting a template only if its system finds a search term*

The parties dispute whether Tso's system provides a template only if its system finds at least one search term (keyword). Pet. 58 (citing Ex. 1002 ¶ 185); Pet. Reply 3–5; PO Resp. 16, 35, 39–40. As noted above, Petitioner cites Mr. Allison's testimony that "[t]he Tso patent discusses that the predefined template, or the second information, is inserted only if the information source includes the search term." Pet. 58 (citing Ex. 1002 ¶ 185). Mr. Allison explains that "[t]he system requires the search term, or keyword, to be found in the information source," quoting Tso's disclosure that:

41

IPR2014-00450
Patent 7,921,356 B2

> *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 template database 5.   The template
> with the highest total weight value is then designated as
> the most appropriate template for the text string being
> processed.

Ex. 1002 ¶ 185 (emphasis added); Ex. 1009, col. 5, ll. 11–17.

Patent Owner counters that, "[c]ontrary to Mr. Allison's conclusion
that a template is inserted only if a search term is found, Dr. Levy explains
that Tso teaches that even when no search term (key word) is found, the user
is presented with one or more possible templates to insert." PO Resp. 40
(citing Ex. 2001 ¶ 28). Citing the above passage of Tso, Dr. Levy testifies
that, "[i]n the comparison of the identified words from the input text string
to the keywords associated with a template, the system of Tso calculates a
score that determines a degree of match between the input text string and the
template." Ex. 2001 ¶ 25. Dr. Levy further testifies that "Tso presents the
template that has the associated highest score to the user of the system." *Id.*

Dr. Levy notes that "Tso does not give an example of presenting a
template whose associated search terms do not match any of the search text."
Id. ¶ 26. Dr. Levy asserts, however, that Tso "suggests what would happen
when none of the search terms match any of the templates" in the passage at
column 5, lines 53–60, reproduced below. *Id.*

> It is also conceivable that the template or templates
> which the template engine 5 determines to be most
> appropriate may not meet the user's particular needs. In
> such a case, the user could request that the template
> engine 5 present additional templates from which the

42

IPR2014-00450
Patent 7,921,356 B2

> user may choose.   These additional templates would
> typically be presented to the user in an order based on
> their respective total weight values.

Ex. 1009, col. 5, ll. 53–60. In the event that a user deems the templates

initially presented as unsuitable, Dr. Levy asserts that Tso's system presents

additional templates, and "[a] person of ordinary skill in the art would

understand that one or more of such additional templates may have a

weighted value of zero." *Id.* ¶ 27.

Dr. Levy further testifies that "it is possible for the terms in the search

text to be found in *none* of the template-associated keywords." *Id.* ¶ 28. Dr.

Levy asserts that

> From [column 5, lines 53–60] and the entire disclosure of
> Tso, a person of ordinary skill would conclude that in
> such case the system of Tso would nonetheless display at
> least one "default" template. This is also supported by
> one of the objectives of the Tso patent, which is to reduce
> the amount of typing required of a user.

Id.

In response, Petitioner asserts that Dr. Levy's testimony that Tso's

system would offer templates even when no search terms match is based on

speculation. Pet. Reply 4. Petitioner argues that Dr. Levy, in his deposition,

admitted Tso does not discuss "default" templates. *Id.* at 4–5 (citing

Ex. 1017, 133, l. 15–134, l. 2).

We find Mr. Allison's testimony persuasive. The portion of Tso cited

by Mr. Allison discloses that the system assigns points to a template if a

search match is found. Ex. 1009, col. 5, ll. 11–17; Ex. 1002 ¶ 185. Given

that templates with no search-term matches would appear to have no

discernible relationship to the user's task, it makes sense that the system

IPR2014-00450
Patent 7,921,356 B2

would not provide a template with no score. Accordingly, we are persuaded by Mr. Allison's testimony that "[t]he Tso patent discusses that the predefined template, or the second information, is inserted only if the information source includes the search term." Ex. 1002 ¶ 185.

By contrast, we find Dr. Levy's testimony unpersuasive. We are not persuaded that column 5, lines 53–60 of Tso suggests providing a default template when no search terms match. *See* Ex. 2001 ¶¶ 26–28. This portion of Tso says that, if a user finds unsuitable the templates suggested by the system, the user could request additional templates, which "would typically be presented to the user in an order based on their respective total weight values." Ex. 1009, col. 5, ll. 53–60. This disclosure of what the system does when the user does not like the templates retrieved based on search-term matches does not appear to have any bearing on what the system does if no search-term matches occur. We also find unpersuasive Dr. Levy's contention that "one of the objectives of the Tso patent, which is to reduce the amount of typing required of a user," demonstrates that Tso returns a default template when the system finds no search terms. Ex. 2001 ¶ 28. Dr. Levy does not explain how this stated objective of Tso supports his position, and it does not appear logical that presenting a default template that has no apparent relationship to the user's task (as reflected by a lack of any search-term matches) would help the user.

For the foregoing reasons, we are persuaded that Tso's system provides a template only if at least one of the search terms is found, and refrains from providing a template if no search term is found. In our view, providing a template constitutes the opposite of refraining from providing a

44

IPR2014-00450
Patent 7,921,356 B2

template. As such, providing a template and refraining from providing a template constitute different types of actions. Because we are persuaded that Tso's system either provides a template or refrains from inserting a template based on whether it finds a search term, we are persuaded that Tso teaches the claim limitation "wherein the type of action depends at least in part on whether the search term is included in the information source."

ii. Different templates

Patent Owner and Dr. Levy contend that "insertion of a Tso template into the document qualifies as a single type of action regardless of the information in the specific template being inserted in any given instance." PO Resp. 12–13; Ex. 2001 ¶ 34. As noted above, Patent Owner and Dr. Levy generally assert that inserting information constitutes a type of action, and that different instances of a type of action are only different instances, not different types. PO Resp. 11–12; Ex. 2001 ¶¶ 30–33.

Petitioner counters that "Tso's disclosure of returning different templates constitutes performing different types of actions." Pet. Reply 7. Additionally, Petitioner argues that Patent Owner does not dispute that Tso discloses insertion of a template based on its search results. *Id.* (citing Pet. 57–58; Ex. 1009, col. 5, ll. 11–17, col. 6, l. 66–col. 7, l. 6).

Petitioner further argues that, "[Patent Owner] misconstrues its own construction" of "type" because, "[e]ven assuming that 'type' means 'category,' this does not imply that different templates are all of the same type." Pet. Reply 6. Petitioner argues that Dr. Levy demonstrated this in his deposition testimony. *Id.* at 6–7 (citing Ex. 1017, 114, l. 21–118, l. 10; 118, ll. 14–16; 118, l. 19–119, l. 9). For example, Petitioner argues that Dr. Levy

45

IPR2014-00450
Patent 7,921,356 B2

conceded that two things, such as two pens of different colors, may both belong to one category but still be divided among other categories. *Id.* at 6 (citing Ex. 1017, 117, l. 4–118, l. 10; 118, l. 19–119, l. 9). Petitioner further cites Dr. Levy's testimony that "there are literally an infinite number of ways to divide the world." Ex. 1017, 118, ll. 14–16; Pet. Reply 6.

As discussed above in Section II.A.1.b, this testimony vitiates Patent Owner's contention that the term "type" requires separating things into a set number of mutually exclusive categories. Accordingly, we disagree with Patent Owner's contention that Tso's teaching of providing and inserting different templates constitutes one and only one type of action. Given the ordinary meaning of "type" as dividing things based on different characteristics (*see* Section II.A.1.a), we are persuaded that Tso's disclosure of producing and inserting different templates with different characteristics teaches different types of actions. Accordingly, Petitioner's assertion that the particular template used by Tso depends on whether the search term is found in the information source constitutes another reason that we are persuaded Tso teaches the claim limitation "wherein the type of action depends at least in part on whether the search term is included in the information source," as recited in the independent claims. *See, e.g.*, Pet. 58; Pet. Reply 5–7.

> e. *"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."*

Petitioner relies on Tso as teaching this limitation. Pet. 57–58; Pet. Reply 8–9. Petitioner cites Tso's disclosure that

46

IPR2014-00450
Patent 7,921,356 B2

> [T]he additional text generated by the template engine 5 is passed to the e-mail application for **insertion in the message being composed**. The user interface 2 could be programmed to **automatically insert the generated text** at the end of the message text, or alternatively could prompt the user to place the cursor at a particular location where the text is to be inserted.

Pet. 58 (citing Ex. 1002 ¶ 184); Ex. 1009, col. 6, l. 66–col. 7, l. 6.

Patent Owner contends that Tso does not cause insertion if the search term is present and the information source includes the second information. PO Resp. 34–40 (citing Ex. 2001 ¶¶ 22–28). Patent Owner argues that, instead, Tso always provides one or more templates for possible insertion, always requiring user discretion for insertion. *Id.* at 34 (citing Ex. 2001 ¶¶ 23, 27–28). In connection with this, Patent Owner discusses Tso's disclosure of providing a user with a choice as to which template to insert. *Id.* at 34–38 (citing Ex. 1009, col. 2, ll. 59–67, col. 4, l. 31–col. 5, l. 6, col. 5, ll. 7–15, 18–60; Ex. 2001 ¶¶ 22–28). Patent Owner argues that, "[c]onsequently[,] Tso allows a user to reject a template ('second information associated with the search term') if the search term is present in the information source (i.e. keyword in the template database) and there is associated second information (i.e. a template)." *Id.* at 37 (citing Ex. 2001 ¶¶ 22–28). Patent Owner further argues that, contrary to Petitioner's argument, Tso's system always provides a template that the user can elect to insert. *Id.* at 38–40 (citing Pet. 58; Ex. 1002 ¶ 185; Ex. 1009, col. 5, ll. 11–17, 49–57; Ex. 2001 ¶¶ 23–28).

Petitioner responds that Tso does not always return a template and does not necessarily require user discretion for insertion. Pet. Reply 3–5, 8–

47

IPR2014-00450
Patent 7,921,356 B2

9. Petitioner asserts that Patent Owner's argument that Tso always provides a template rests on speculative testimony of Dr. Levy. *Id.* at 4. Petitioner asserts that Tso does not require user discretion because Tso "specifically states that '[t]he user interface 2 could be programmed to ***automatically insert the generated text at the end of the message text***.'" *Id.* at 8 (quoting Ex. 1009, col. 7, ll. 3–4). Petitioner argues that Tso provides the option, not a requirement, for a user to exercise discretion in the insertion of a template. *Id.* (citing Ex. 1009, col. 5, ll. 48–60). Additionally, Petitioner contends that Patent Owner's discussion of the option to decline insertion of a template "is a red herring" because "the relevant inquiry is whether Tso discloses the insertion of a template as a result of matching the search term." *Id.* (citing PO Resp. 37). Petitioner contends that Tso discloses inserting a template as a result of matching the search term, and that this is not negated by Tso also disclosing another option. *Id.* (citing Pet. 57–58).

Petitioner further argues that "the '356 patent claims do not *exclude* embodiments having user discretion — they use the 'comprising' transition, and do not include any negative limitations around the 'inserting' limitation." *Id.* Petitioner further notes that the '356 patent discloses embodiments that include user discretion prior to insertion. *Id.* at 8–9 (citing Ex. 1001, Fig. 1, col. 7, l. 25–col. 8, l. 5). Petitioner, therefore, argues that "the claims permit extra steps, such as the inclusion of user discretion, as long as the 'second information' is eventually inserted." *Id.* at 9 (citing *Vitronics v. Conceptronic*, 90 F.3d 1576, 1583 (Fed. Cir. 1996)).

At the oral hearing, Patent Owner further addressed Tso's disclosure at column 7, lines 3–6, that "[t]he user interface 2 could be programmed to

48

IPR2014-00450
Patent 7,921,356 B2

automatically insert the generated text at the end of the message text, or alternatively could prompt the user to place the cursor at a particular location where the text is to be inserted." Tr. 34, l. 21–35, l. 7. Patent Owner asserted that "the automatically has to do with where you are going to place – where you are going to insert the template, not are you going to accept this choice of a template." *Id*. at 35, ll. 5–7.

We first note that the disputed claim language includes the permissive language "if," which indicates the claim language that follows is optional and, therefore, is not required. *See In re Johnston*, 435 F.3d 1381, 1384 (Fed. Cir. 2006) ("[O]ptional elements do not narrow the claim because they can always be omitted."). For at least this reason, we are persuaded that the disputed claim language does not patentably distinguish over the cited references.

Additionally, even if the disputed claim language did positively limit the claim, we are persuaded that Tso teaches "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." We are persuaded that Tso's disclosure that "[t]he user interface 2 could be programmed to automatically insert the generated text at the end of the message text, or alternatively could prompt the user to place the cursor at a particular location where the text is to be inserted" teaches a mode that automatically inserts a template without requiring the user to exercise discretion to determine whether to insert the text. *See* Ex. 1009, col. 7, ll. 3–6; Pet. 57–58; Pet. Reply 3–5, 8–9; Ex. 1002 ¶ 184. The fact

49

IPR2014-00450
Patent 7,921,356 B2

that this disclosure specifies where the system automatically inserts the text
does not negate the disclosure that it automatically inserts the text.

Additionally, we are not persuaded that Tso's discussions of allowing
user discretion apply to the disclosed automatic insertion mode of operation.
See PO Resp. 34–38. Furthermore, in view of Petitioner's accurate
observation that the '356 patent discloses user discretion in the process of
inserting text, we are persuaded that, even if Tso did require user discretion,
Tso's system meets the claim limitation because it ultimately inserts the text.
See Pet. Reply 8–9.

Regarding Patent Owner's argument that Tso always provides a
template, we are unpersuaded by this argument for the reasons explained
above in Section II.B.3.d.i. Furthermore, even if Tso's system did always
provide a template, this does not negate that its disclosure of automatically
inserting a template meets the claim limitation "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."

> f. *Summary*

In summary, we determine that Petitioner has demonstrated, by a
preponderance of the evidence, that claims 1, 7, 10, 12, 16, and 20 are
unpatentable because they would have been obvious over Tso and Pandit.

III. CONCLUSION

Petitioner has shown, by a preponderance of the evidence, that claims
1, 7, 10, 12, 16, and 20 of the '356 patent would have been obvious over Tso
and Pandit.

IPR2014-00450
Patent 7,921,356 B2

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1, 7, 10, 12, 16, and 20 are determined to be *unpatentable*; 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.

IPR2014-00450
Patent 7,921,356 B2

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Exhibit 6CC

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Hedloy	Attorney Docket:	3324/106
Appl. No:	12/841,302	Art Unit:	2176
Filed :	7/22/10	Examiner:	Tran
Invention:	METHOD, SYSTEM AND COMPUTER READABLE MEDIUM FOR ADDRESSING HANDLING FROM A COMPUTER PROGRAM		

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

RESPONSE A

Dear Sir:

In response to the Office Action dated November 24, 2010, the Applicant submits

the following amendment and remarks.

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims which begin on page 7

of this paper.

Remarks begin on page 14 of this paper.

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

AMENDMENTS TO THE SPECIFICATION

The amendments to the specification indicated below are solely to correct obvious typographical errors.

Please replace the paragraph beginning on page 3, line 7 of the originally filed application with the following amended paragraph:

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, [[w]] while the user works simultaneously in another program, e.g., a word processor. The click on the function item initiates a program connected to the button to search a database or file available on or through the computer, containing 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.

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

Please replace the paragraph beginning on page 7, line 8 of the originally filed application with the following amended paragraph:

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 analyzes what the user has typed in the document at step 4. [[AT]] 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 un-interpretable 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.

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

Please replace the paragraph beginning on page 7, line 19 of the originally filed

application with the following amended paragraph:

If the program find an e-mail address mailing list/category name telephone number or other information, at step 10 an appropriate action is performed by the program and then the program execution quits at step 16. If the program only finds a name or initials, or the like, the program looks up the name in the database at step 12 and at step 18 the program determines what was found. If the program finds more than one possible contact/address match, at step 20 the program displays menu choices to the user to let him choose an appropriate answer. Then at step 22 the program inserts a correct address and name in the document and then at step 16 the program quits execution. If the program finds one match exactly, i.e., one contact with one address, the program inserts the correct address and name in the document at step 22 then quits and then quits execution at step 16. If the program does not find a name in the database, at step 24 the program prompts the user to specify an address and then quits execution at step 16. If the program at step 6 finds a name and an address, at step 14 the name is looked up in the database. Then, at step 26, if no match is found, at step 28 the program inserts an address and a name which are possibly corrected by the user into the database and then quits execution at step 16. If at step 26, the name and address is found, at step 32 the program either takes no action or displays t̶ h̶e̶ the data for the user to edit. If at step 26, the name is found but not the address, the program prompts the user for a decision at step 30. If the user decides that this is another contact with a same name, the program goes to step 28. If the user decides that this is a one time occurrence, no action is taken and the program quits at step 16. If the user decides that the contact has, for example, moved and that this is a new address, at step 34 one of the old addresses for the contact is replaced with the new one and the program w̶i̶t̶h̶ ̶t̶h̶e̶ ̶n̶e̶w̶ ̶o̶n̶e̶ ̶a̶n̶d̶ ̶t̶h̶e̶ ̶p̶r̶o̶g̶r̶a̶m̶ quits at step 16. If the user decides that this is an additional address for the contact, at step 36 the additional address is inserted into the database for that contact and execution quits at step 16.

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

Please replace the paragraph beginning on page 11, line 21 of the originally filed application with the following amended paragraph:

FIG. 3 illustrates a starting point in word processor document, such as WORD document, wherein the user has typed a name of a contact 40. The user commands 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 of the contact 40 and generates a screen as shown in, for example, FIG. 8. This screen includes a message 68 informing the user that the contact does not exist in the database and to specify an address, and "OK" buttons 56. At this point when the user commands the OK button 56, the user returns to the document so that [[he]] the contact's address can be included as in Example 2 above.

Please replace the paragraph beginning on page 13, line 21 of the originally filed application with the following amended paragraph:

At this point the user may command the Choose button 86 to use the selected address and return to the document, or the user may command the More >>> button 90 to view how the program interpreted what [[he]] the user typed in the word processor, and possibly change this data, wherein the program generates an updated screen as shown in, for example, FIG. 11. ~~The updated screen includes the data 62 which displays the name for example, FIG. 11.~~ The updated screen includes the data 62 which displays the name typed in the word processor as interpreted by the program, address fields, and the fields for the address type selection 54, such as home, business, etc., which may be changed by the user before the program stores it in the database, the Add and Choose button 64, a "<<<Less" button 90 corresponding to the More>>> button 90 for returning to the screen of FIG. 10, and an "Add this address to the selected contact above" button 92. The user might then command the Add this address to the selected contact above button 92 and the result in the word processor is illustrated in FIG. 4. The user can also cancel the operations by commanding the Cancel button 60, or command the add choose button 64 to add this name and address as a new contact and address, or open the database before

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

storing data into the database by commanding a "Full details" button 88 as will be later

described.

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

AMENDMENTS TO THE CLAIMS

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

Listing of Claims:

1. (Currently Amended) At least one non-transitory computer readable medium encoded with instructions which, when loaded on a computer, establish processes for contact information handling, implemented by a document editing program running in the computer, the processes comprising:

allowing a user to enter textual information into a document using the document editing program;

displaying the textual information in the document electronically using the document editing program;

allowing, in the document editing program, a user to select in the document at least a portion of the textual information while the textual information is displayed;

following user selection of textual information in the document, analyzing, by the document editing program, the selected textual information 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;

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, the operation comprising identifying at least part of the selected textual information to use as a search term in order to find 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;

after identifying at least part of the selected information to use as a search term, and in consequence of receipt by the document editing program of an execute command from the input device, performing the operation, wherein the operation further comprises:

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

causing an electronic search in the information source, by an information

management program external to the document editing program, for the search

term in order to find whether the search term is included in the information

source; and 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, 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.

2. (Original) At least one non-transitory computer readable medium according to claim 1,
wherein the instructions further establish processes wherein:

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.

3. (Original) At least one non-transitory computer readable medium according to claim 1,
wherein the instructions further establish processes wherein:

when (i) the information source includes the search term, (ii) the selected textual

information includes a name, (iii) the information source further includes the second

information, and (iv) the second information includes an address, the action further

comprises causing insertion of at least part of the address into the document.

4. (Original) At least one non-transitory computer readable medium according to claim 3,
wherein the instructions further establish processes wherein, when the second

information includes a plurality of addresses, the operation further comprises allowing

the user to choose one of the plurality of addresses to use for insertion into the document.

5. (Original) At least one non-transitory computer readable medium according to claim 1,
wherein the instructions further establish processes wherein, when the selected textual

information includes information that is not in the information source, the operation

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

further comprises:

allowing the user to cause storage of at least some of the selected textual

information in the information source.

6. (Original) At least one non-transitory computer readable medium according to claim 5,
wherein the instructions further establish processes wherein, when the selected textual
information includes a name and an address and the information source does not include
the name, allowing the user to cause storage comprises allowing the user to cause storage
of at least part of the selected information in the information source as a new contact.

7. (Original) At least one non-transitory computer readable medium according to claim 1,
wherein the instructions further establish processes wherein the information source is
available over a network.

8. (Original) At least one non-transitory computer readable medium according to claim 1,
wherein the instructions further establish processes wherein the information source
includes an e-mail address and the operation includes causing an e-mail to be sent to the
e-mail address.

9. (Original) At least one non-transitory computer readable medium according to claim 1,
wherein the instructions further establish processes wherein, when the type or types of
contact information includes a name, the operation includes causing display by the
information management program of at least part of a contact information record in the
information source corresponding to the name.

10. (Original) At least one non-transitory computer readable medium according to claim
1, wherein the instructions further establish processes wherein the document editing
program is a spreadsheet program.

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

11. (Original) At least one non-transitory computer readable medium according to claim 1, wherein the instructions further establish processes wherein the type of operation includes updating the document with information from the information source.

12. (Currently Amended) A method, for contact information handling, implemented by running a document editing program in a computer, the method comprising:

allowing a user to enter textual information into a document using the document editing program;

displaying the textual information in the document electronically using the document editing program;

allowing, in the document editing program, a user to select in the document at least a portion of the textual information while the textual information is displayed;

following user selection of textual information in the document, analyzing, by the document editing program, the selected textual information 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;

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, the operation comprising identifying at least part of the selected textual information to use as a search term in order to find second information, of a specific type or types, associated ~~in an information source~~ with the search term <u>in an information source external to the document</u>;

after identifying at least part of the selected information to use as a search term, and in consequence of receipt by the document editing program of an execute command from the input device, performing the operation, wherein the operation further comprises:

causing an electronic search in the information source, by an information management program external to the document editing program, for the search term in order to find whether the search term is included in the information source; and performing an action having a type,

wherein the type of action depends at least in part on whether the search

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

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.

13. (Original) A method according to claim 12, wherein:

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; and

when (i) the information source does include the search term, (ii) the selected textual information includes a name, (iii) the information source further includes the second information, and (iv) the second information includes an address, the action further comprises causing insertion of at least part of the address into the document.

14. (Original) A method according to claim 12, wherein, when the second information includes a plurality of addresses, the operation further comprises allowing the user to choose one of the plurality of addresses to use insertion into the document.

15. (Original) A method according to claim 12, wherein, when the selected textual information includes information that is not in the information source, and the operation further comprises:

allowing the user to cause storage of at least some of the selected textual information in the information source;

wherein, when the selected textual information includes a name and an address and the information source does not include the name, allowing the user to cause storage comprises allowing the user to cause storage of at least part of the selected information in the information source as a new contact.

16. (Original) A method according to claim 12, wherein the information source is available over a network.

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

17. (Original) A method according to claim 12, wherein the information source includes an e-mail address and the operation includes causing an e-mail to be sent to the e-mail address.

18. (Original) A method according to claim 12, wherein, when the type or types of contact information includes a name, the operation includes causing display by the information management program of at least part of a contact information record in the information source corresponding to the name.

19. (Original) A method according to claim 12, wherein the type of operation includes updating the document with information from the information source.

20. (Currently Amended) An apparatus for contact information handling, comprising:
a processor; and
a memory storing instructions executable by the processor to perform processes that include:
allowing a user to enter textual information into a document using a document editing program;
displaying the textual information in the document electronically using the document editing program;
allowing, in the document editing program, a user to select in the document at least a portion of the textual information while the textual information is displayed;
following user selection of textual information in the document, analyzing, by the document editing program, the selected textual information 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;
providing an input device configured by the 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, the operation comprising identifying at least part of the selected textual information

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

to use as a search term in order to find second information, of a specific type or types, associated ~~in an information source~~ with the search term <u>in an information source external to the document</u>;

after identifying at least part of the selected information to use as a search term, and in consequence of receipt by the document editing program of an execute command from the input device, performing the operation, wherein the operation further comprises:

causing an electronic search in the information source, by an information management program external to the document editing program, for the search term in order to find whether the search term is included in the information source; and 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, 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.

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

REMARKS

The Applicant thanks Examiner Tran for his analysis of the pending claims and

for his time during the examiner interview on December 13, 2010, in which the Miller

reference was discussed with Bruce Sunstein and Jakub Michna, attorneys for the

Applicant. The remarks below expand on the points discussed in the interview and, with

the amendments made in the response, the claims now require expressly that the

information source is external to the document, a concept that was previously implicit.

Specifically, the original claims required "causing an electronic search in the information

source, *by an information management program external to the document editing*

program." Accordingly, the current amendment merely makes express an implicit

requirement in the original claims.

Claims 1-20 are currently pending in the application. Claims 1, 12, and 20 have

been amended. For the reasons set forth below, the rejection is traversed, and

reconsideration and allowance of the claims are respectfully requested.

Objections

The Applicant files with this response a corrected and supplemental information

disclosure statement (IDS), relisting the references that the Examiner did not consider in

the previous IDS of July 22, 2010 and also providing additional **bolded** information in

Section 3.

Claims

Independent claim 1 (a media claim), independent claim 12 (a corresponding

method claim), and independent claim 20 (a corresponding apparatus claim) are directed

to contact information handling implemented by a document editing program running in a

computer. The claims require "allowing … a user to select in [a] document at least a

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

portion of the textual information while the textual information is displayed." The

selected textual information is analyzed "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."

The claims further require providing an input device … to allow the user to

initiate an operation. The operation comprises:

1. "identifying at least part of the selected textual information to use as a search term
   in order to find second information, of a specific type or types, associated with the
   search term in an information source external to the document"

2. "causing an electronic search in the information source … for the search term in
   order to find whether the search term is included in the information source" and

3. "performing an action having a type," which, under appropriate conditions,
   includes:

4. "causing insertion of at least part of the second information into the document."

Distinction of the Claimed Subject Matter from the Art of Record

Claims 1, 3-4, 7-14, and 16-20 are rejected as anticipated by the Miller reference

(U.S. 5,946, 647). Claims 2, 5-6, and 15 are rejected as obvious in view of the Miller

reference and the Person reference ("Special Edition Using Microsoft Word 97"). These

references, however, do not meet the limitations of the claims for at least the reasons

provided below.

The Miller reference discloses a method for detecting data in a document and

performing a particular action on the detected data. Miller, Abstract. For example, if a

telephone number is recognized within the document, then a "mouse-down" operation is

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

placed over the telephone number (Fig. 6, 7; 5:38-50). When a user clicks on the mouse-down operation, a pop-up menu appears that enables the user to either dial the number or put the electronic number in a telephone book (Fig. 7; 5:38-50).

The Miller reference fails to disclose item 2 above, "causing an electronic search in the information source [which is required to be external to the document, as per item 1 above] … for the search term in order to find whether the search term is included in the information source," as required by the claims. The claims further require that the search is performed "in order to find second information, of a specific type or types, associated in [the] information source with the search term." In Miller, no search is performed at all in an information source external to the document. The office action argues that Miller's abstract discloses the search required by the claims. The abstract, however, does not disclose or suggest a search for a search term in order to find second information. To the contrary, Miller's abstract discloses an analyzer server that receives data and parses the data to detect structures within the data. No search in an information source external to the document is performed, as required by the claims.

Furthermore, since Miller does not perform a search in an information source external to the document, it also fails to disclose item 3, "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 the claims.

Also, since there is no search for second information in an information source external to the document, the Miller reference fails to disclose item 4 above, "causing insertion of at least part of the *second information* into the document", as required by the claims. Insertion of information into a document is not disclosed by the Miller reference,

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

let alone insertion of at least part of the *second information* into the document, as required by the claims. For at least these reasons, all of the present claims distinguish the Miller reference.

The Person reference does not make up for the deficiencies of the Miller reference. The Person reference describes a functionality in Microsoft Word 97 known as Mail Merge. Mail Merge allows a user to create multiple letters "by merging together a list of names and addresses with letters, envelopes, or address labels." Person, page 485. The method starts when the user selects a main document and inserts merge fields into the document for specifying the placement of merged information. The merge fields also specify a particular data field that is to replace them: "First_Name", "Last_Name", and "Company_Name." *See* Person, Fig. 17.30; Person, page 485. Next, the user selects a list of contacts that includes data fields for name and address information. Person, page 488. When the user selects the "merge" button, the name and address information from the list of contacts is retrieved and inserted into the main document according to the merge fields. Person, page 492, 507.

Person fails to disclose or suggest a search for a search term in order to find second information in an information source, as required by item 2 above, because the information to be inserted by mail merger is never searched for in the information source. Rather, the records specified by the user (*i.e.*, *every* contact from the contact list) are retrieved and used for insertion into the main document. Furthermore, since the Person reference does not disclose performing a search for a search term, it also does not disclose item 3 above, "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."

Application Serial No. 12/841,302
Attorney Docket No. 3324/106

For these reasons, among others, independent claims 1, 12, and 20 are patentable

over the Miller and the Person references (alone or in combination). The dependent

claims are also allowable 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, 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.

Date: December 14, 2010   Respectfully submitted,

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03324/00106 1373510.1

Page 18 of 18

Exhibit 6DD

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.*

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

I. BACKGROUND

Apple Inc., Google Inc., and Motorola Mobility LLC (collectively
"Petitioner") requests *inter partes* review of claims 1-44 of U.S. Patent No.

IPR2014-00208
Patent 7,917,843 B2

7,917,843 B2 ("the '843 patent") (Ex. 1001) under 35 U.S.C. §§ 311-319.
Paper 1 ("Pet."). Arendi S.A.R.L. ("Patent Owner") submitted a preliminary
response under 37 C.F.R. § 42.107(b) on March 12, 2014. Paper 6 ("Prelim.
Resp."). We have jurisdiction under 35 U.S.C. § 314.

For the reasons that follow, we institute an *inter partes* review of
claims 1, 2, 8, 14-17, 20, 21, 23, 24, 30, 36-39, 42, and 43 of the '843 patent.
We do not institute review of challenged claims 3-7, 9-13, 18, 19, 22, 25-29,
31-35, 40, 41, and 44.

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.

2

IPR2014-00208
Patent 7,917,843 B2
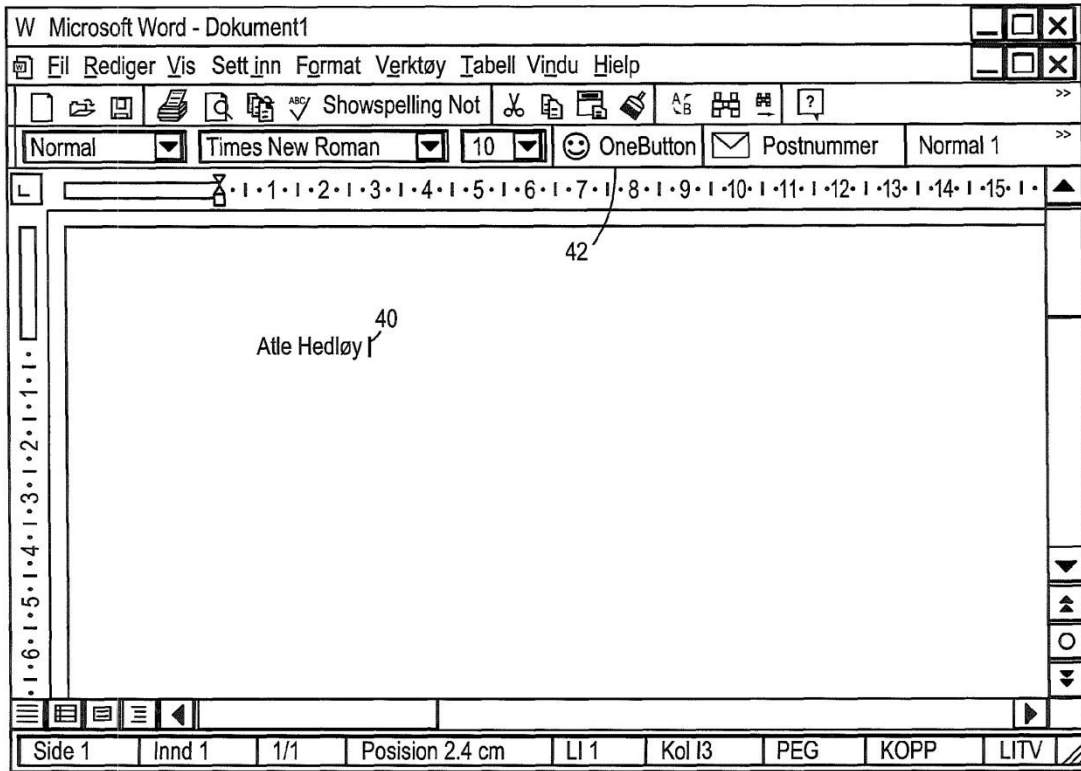
FIG. 3

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.

3

IPR2014-00208
Patent 7,917,843 B2

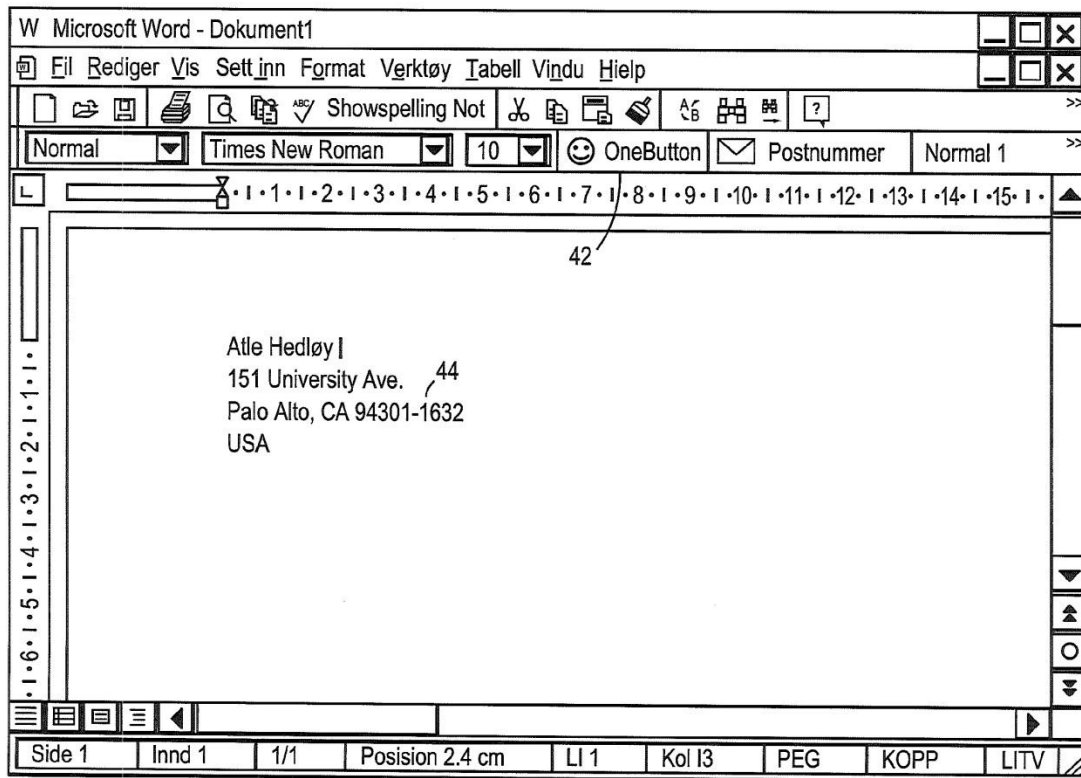FIG. 4

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.

4

IPR2014-00208
Patent 7,917,843 B2

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.

5

IPR2014-00208
Patent 7,917,843 B2

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.); and *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., et al.*, No. 1:12-cv-01600 (D. Del.); A*rendi 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, et al.*, No. 1:12-2cv-01599 (D. Del.); *Arendi S.A.R.L. v. Blackberry Limited, et al.*, No. 1:12-cv-01597 (D. Del.); *Arendi S.A.R.L. v. LG Electronics Inc., et al.*, No. 1:12-cv-015959 (D. Del.); and *Arendi S.A.R.L. v. Samsung Electronics Co. Ltd., et al.*, No. 1:12--cv01598 (D. Del.). According to Patent Owner, patents related to the '843 patent are involved in the following *inter partes* reviews: IPR2014-00206, IPR2014-00207, IPR2014-00203, and IPR2014-00214.

Prior Art

Miller	US 5,946,647	Aug. 31, 1999	Ex. 1007
Luciw	US 5,644,735	Jul. 1, 1997	Ex. 1008
Pandit	US 5,859,636	Jan. 12, 1999	Ex. 1009

Miller et al., From Documents to Objects, An Overview of LiveDoc, 30(2) SIGCHI (April 1998) (Ex. 1010) ("LiveDoc").

Bonura et al., Drop Zones, An Extension to LiveDoc, 30(2) SIGCHI (April 1998) (Ex. 1010) ("Drop Zones").

IPR2014-00208
Patent 7,917,843 B2

Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability under

35 U.S.C. § 103(a) (Pet. 8):

Reference(s)	Claims
LiveDoc and Drop Zones	1-44
Miller	1-44
Luciw	1-7, 10-29, and 32-44
Pandit	1, 2, 8, 14-17, 20, 21, 23, 24, 30, 36-39, 42, and 43

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). The

Office must apply the broadest reasonable meaning to the claim language,

taking into account any definitions presented in the specification. *Id.* (citing

In re Bass, 314 F.3d 575, 577 (Fed. Cir. 2002)). There is a "heavy

presumption" that a claim term carries its ordinary and customary meaning.

CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed. Cir. 2002).

The "ordinary and customary meaning" is that which the term would have to

IPR2014-00208
Patent 7,917,843 B2

a person of ordinary skill in the art in question. *In re Translogic Tech., Inc.,*
504 F.3d 1249, 1257 (Fed. Cir. 2007).

> *Providing An Input Device, Configured by*
> *the First Computer Program*

Each of the independent claims (1, 20, 23, and 42) contains the phrase
"providing an input device, configured by the first computer program." The
'843 patent indicates that an "input device" can be a touch screen button, a
keyboard button, an icon, a menu choice, or a voice command device,
suitable for calling an external program from a word processor. *See* Ex.
1001, col. 3, ll. 35-54. Petitioner submits that the '843 patent specification
"gives no guidance" regarding how the input device is "configured by" the
first computer program. Pet. 7. Indeed, it appears that no form of the word
"configure" is used in the patent's description of the input device as it relates
to a computer program. On the evidence before us, it appears that the phrase
in question was added to the claims during prosecution, with no discussion
as to how the input device may be "configured by" the first computer
program, nor any indication as to how the phrase might be deemed to
distinguish over the prior art. *See* Ex. 1003 at 9-19.

Patent Owner provides a general dictionary definition to indicate that
"configure" means "to design, arrange, set up, or shape with a view to
specific applications or uses." Prelim. Resp. 7 citing Ex. 2001 at 1. Based
on this definition, Patent Owner submits that "providing 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." Prelim. Resp. 7.
Patent Owner also contends that the claims require "providing" the input

IPR2014-00208
Patent 7,917,843 B2

device, in addition to the device being "configured by" the computer program (*id.* at 7-8), but does not offer any interpretation for what "providing" of the input device might require.

Although claims 23 and 42 are drawn to "[a]t least one non-transitory computer readable medium," the "providing" of an input device is in the form of a method step in all the independent claims. The phrase in question does not specify that the first computer program "provides" an input device. We interpret "providing" an input device merely as requiring the presence of the device; that is, the input device is a structure that exists in steps that "allow[] a user to enter a user command to initiate an operation," as claimed.

For purposes of this decision, we adopt Patent Owner's construction that "an input device, configured by the first computer program" means that the input device is set up by the first computer program for use. We agree with Petitioner (Pet. 7) to the extent that the "input device" is an interface to receive a user command, such as a user-selectable area or icon on a computer screen.

Proposed Grounds of Unpatentability

LiveDoc and Drop Zones

Petitioner submits that LiveDoc and Drop Zones teach a computer-implemented method for finding data related to the contents of a document that includes displaying the document electronically using a first computer program. Pet. 12 (claim chart). The document shown in Figure 2 of Drop Zones (Ex. 1006 at 7)[1] is displayed by using a text entry application

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[1] Although the Petition cites to page numbers in the LiveDoc and Drop Zones references, we cite to corresponding pages in Exhibit 1006.

9

IPR2014-00208
Patent 7,917,843 B2

program, *LiveSimpleText*, which the Petition maps to the claimed "first computer program." Pet. 12. For the limitation of "providing an input device, configured by the first computer program," Petitioner acknowledges that the "input device" in the reference (the highlighted area shown in Figure 2 of LiveDoc) is not configured by the text entry application program. The reference, instead, teaches that LiveDoc "knows" where the structures appear in the text passed to it, but LiveDoc "has no idea" where in the window those characters physically appear. That information is 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" to the application. Pet. 13-14; Ex. 1006 at 8. To make up for the admitted deficiency of the references, Petitioner alleges 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." Pet. 14. Petitioner refers, for support, to the Declaration of Dr. Daniel A. Menascé.

Dr. Menascé testifies that the "approach" that is not described in LiveDoc would be "equivalent" and "would yield the same predictable result" to that described by the reference, apparently because it "would have been a predictable modification of LiveDoc that was well within ordinary skill, in order to perform a known function of standard word processing programs." Ex. 1002 ¶ 61. Neither Petitioner nor Declarant, however, points to anything in the record to demonstrate existence of the asserted "known function of standard word processing programs" at the time of invention of the claimed subject matter of the '843 patent. Expert testimony

10

IPR2014-00208
Patent 7,917,843 B2

that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight. 37 C.F.R. § 42.65(a).

We are persuaded by Patent Owner that Petitioner's allegation that it would have been obvious to change the functionality of LiveDoc and the associated text entry application program in a way that is consistent with the claimed invention is, in effect, mere hindsight-driven argument. Prelim. Resp. 27 n.1.

> Although the obviousness analysis should "take account of the inferences and creative steps that a person of ordinary skill in the art would employ," the Supreme Court emphasized that this evidentiary flexibility does not relax the requirement that, "[t]o facilitate review, this analysis should be made explicit." *Id.* [*KSR Int'l Co. v. Teleflex, Inc.,* 550 U.S. 398, 418 (2007)], 127 S.Ct. 1727 (citing [*In re*] *Kahn*, 441 F.3d [977,] 988 [(Fed. Cir. 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.")).

Perfect Web Tech., Inc. v. InfoUSA, Inc., 587 F.3d 1324, 1330 (Fed. Cir. 2009). In short, Petitioner's allegations fail to "specify where each element of the claim is found . . . ." 37 C.F.R. § 42.104(b)(4).

Each of the independent claims (1, 20, 23, and 42) contains substantially similar limitations that are material to the deficiency with respect to what the "first computer program" requires. In view of the foregoing, we conclude that Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to any of claims 1-44 in a § 103(a) challenge over LiveDoc and Drop Zones.

IPR2014-00208
Patent 7,917,843 B2

Miller

Petitioner submits that the "first computer program" of claim 1 is taught by Miller's word processor (application 167) that is depicted in Figure 1 of the reference. Pet. 25-26. The "detect structures" button 520 (Miller Fig. 5) is an input device that allows the user to enter a command for initiating program 165. *Id.* at 26.

Figure 5 of Miller shows window 510 that presents an exemplary document. The window includes button 520 for initiating program 165. Ex. 1007, col. 5, ll. 19-24. Application (word processor) 167 presents data on the output device to a user. *Id.* at col. 3, ll. 34-67. Although window 510 includes button 520 for initiating program 165, Petitioner does not allege that button 510 is provided by the word processor. Petitioner submits, instead, that a modification must be made to the "first computer program" in Miller to include the "input device." "It would have been obvious for the word processor program 167 to provide an interface, such as button 520, to receive a user command." Pet. 26. Petitioner cites to, as support, the declaration of Dr. Menascé.

Dr. Menascé testifies that it was well known to configure word processing programs to add graphical user interface (GUI) elements, such as additional menu options or buttons, to provide desired functionality. Ex. 1002 ¶ 71. Dr. Menascé refers to a paper and a book, each co-authored by Declarant, which are asserted to discuss tools relating to "Visual Basic code" for customized GUI elements. *Id.* Declarant does not, however, provide a copy of relevant sections of the paper and book as exhibits, nor indicate or explain how the disclosures (not provided) might have led one of ordinary

12

IPR2014-00208
Patent 7,917,843 B2

skill in the art to modify Miller consistent with the requirements of claim 1, to support the allegation of what "would have been obvious." We find Petitioner's evidentiary basis for the allegation to be lacking.

Each of the other independent claims (20, 23, and 42) contains substantially similar limitations that are material to the deficiency with respect to what the "first computer program" requires. In view of the foregoing, we conclude that Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to any of claims 1-44 in a § 103(a) challenge over Miller.

Luciw

Claim 1 of the '843 patent recites "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." For this limitation, Petitioner points to description in Luciw of entering information into a smart field. Pet. 37. Petitioner also refers to an "implicit assist" as taught by Luciw. *Id.* at 38.

Luciw describes entering information into a smart field (e.g., Fig. 4b; "Name" field 175 in window 170). Ex. 1008, col. 8, ll. 15-18. The reference also describes an "implicit assist" action that may be triggered by writing in the notepad outside of a smart field. *Id.* at col. 8, ll. 30-41.

As Patent Owner argues, however, by the act of using a smart field, the user informs the computing device what type of information the user is entering. No analysis to identify the type of information is performed or

13

IPR2014-00208
Patent 7,917,843 B2

needed. Prelim. Resp. 50. For example, as shown in Luciw's Figure 4b, information may be entered into "Name" field 175 or "Phone" field 177, thus identifying the type of information.

Further, as noted by Patent Owner (Prelim. Resp. 51-53), Petitioner has not shown that analyzing entered text is part of Luciw's "implicit assist" operation. Petitioner submits that "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)." Pet. 38 (referring to Ex. 1008, col. 10, ll. 15-20 and col. 8, ll. 7-13; Figs. 3 and 4a). However, determining if implicit assist is possible, and "the kind" of implicit assist indicated, has not been shown to be an analysis of the information to determine if it is a type of information that can be searched for in order to find second information related to the first information, in accordance with the requirements of the claim. As Patent Owner points out, Luciw does not teach analyzing the information to determine information type in the implicit assist operation. As shown in Luciw's Figure 3, "Implicit Assist" (step 104) if enacted, results in "Query Database" (step 106), with no intervening step of determining the type of information. Ex. 1008, Fig. 3.

Each of the other independent claims (20, 23, and 42) contains substantially similar limitations that are material to the deficiency with respect to what the "analyzing" requires. In view of the foregoing, we conclude that Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to any of claims 1-7, 10-29, and 32-44 in a § 103(a) challenge over Luciw.

14

IPR2014-00208
Patent 7,917,843 B2

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]." Prelim. Resp. 53. 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 does not seem to allege that the disclosed dictionary search relates to the first and second types of information dependency in the claim. Petitioner submits, however, 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 and 1f.

Figure 1f of Pandit is reproduced below.

15

IPR2014-00208
Patent 7,917,843 B2
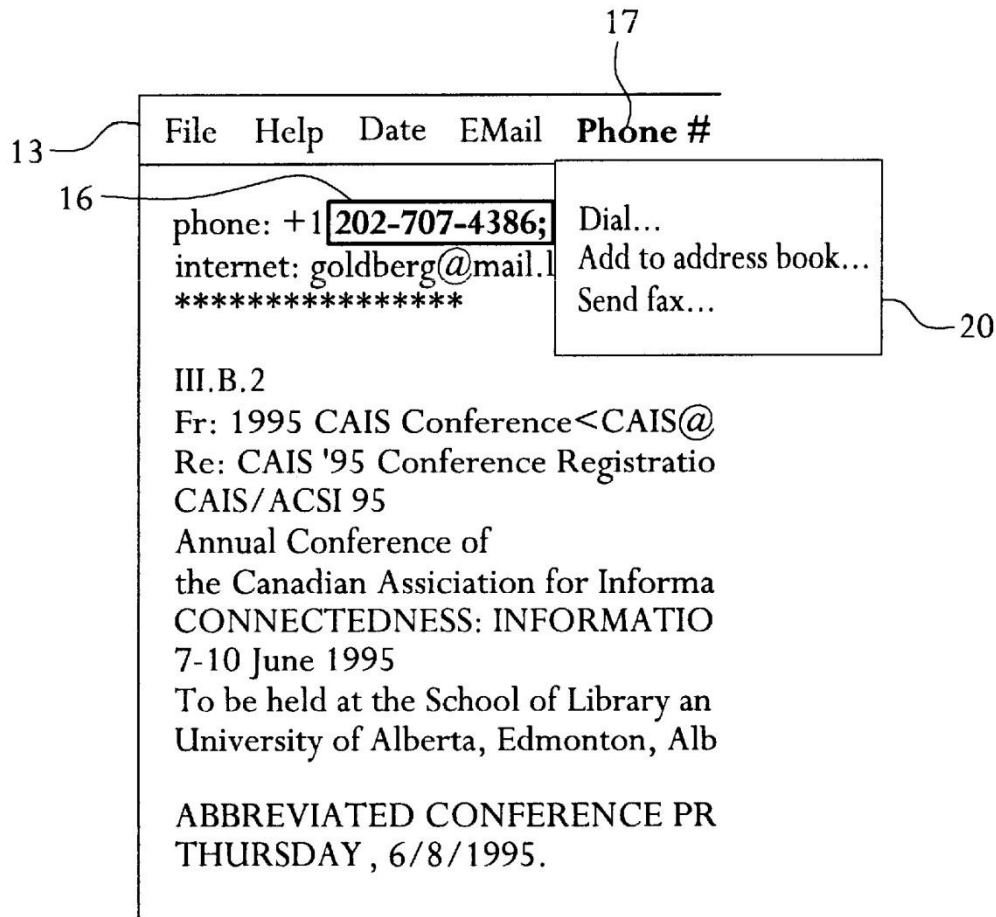
FIG. 1f

Figure 1f is said to show 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

16

IPR2014-00208
Patent 7,917,843 B2

selected text (telephone number 16) to the address book. *Id*. at col. 2, l. 1 –
col. 3, l. 10.

In order to avoid multiple entries of the same address, Petitioner
submits that 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. Pet. 51. Petitioner refers to the declaration of
Dr. Menascé. *Id*. Dr. Menascé concurs. Ex. 1002 ¶ 99.

Patent Owner argues that Petitioner's proposed search would fail to
meet the requirements of the claim. The search for pre-existing entries
would be a search for a duplicate telephone number. According to Patent
Owner, 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. Prelim. Resp. 58-59.

We find Patent Owner's argument to be unpersuasive. Pandit teaches
that, from pulled down-menu 20 (Fig. 1f), programs that can be called may
include a writeable computer database of telephone and telefax numbers.
Ex. 1009, 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. It would be reasonable to presume,
as a matter of common sense, that the subroutine 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

17

IPR2014-00208
Patent 7,917,843 B2

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). The first and the second information
are displayed to the user for user action (20). 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).

We have reviewed Petitioner's evidence regarding the dependent
claims as well and, based on this record, are persuaded that Petitioner has
shown a reasonable likelihood that it would prevail in the § 103(a) challenge
of claims 1, 2, 8, 14-17, 20, 21, 23, 24, 30, 36-39, 42, and 43 of the '843
patent over Pandit.

III. CONCLUSION

The Petition demonstrates a reasonable likelihood of prevailing on the
obviousness ground of unpatentability based on Pandit.

The Board has not made a final determination on the patentability of
any challenged claim.

IPR2014-00208
Patent 7,917,843 B2

IV. ORDER

In consideration of the foregoing, it is

ORDERED that an *inter partes* review is instituted as to '843 patent claims 1, 2, 8, 14-17, 20, 21, 23, 24, 30, 36-39, 42, and 43 on the obviousness ground based on Pandit;

FURTHER ORDERED that the Petition is denied as to all other grounds set forth in the Petition;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '843 patent is instituted with trial 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 given of the institution of the trial; and

FURTHER ORDERED that the trial is limited to the grounds identified immediately above and no other ground is authorized for the '843 patent claims.

IPR2014-00208
Patent 7,917,843 B2

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Exhibit 6EE

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE
_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

GOOGLE INC.
Petitioner
v.

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

U.S. Patent No. 7,921,356

_____

**PETITION FOR *INTER PARTES* REVIEW
UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.100 *ET. SEQ.***

TABLE OF CONTENTS

EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Pat. No. 7,921,356
1002	Declaration of Dennis Allison
1003	Curriculum Vitae of Dennis Allison
1004	U.S. Pat. No. 5,859,636 ("Pandit")
1005	U.S. Patent No. 5,644,735 ("Luciw")
1006	Bonura and Miller, "Drop Zones An Extension to LiveDocs", SIGCHI Bulletin Volume 30, Number 2 April 1998.
1007	U.S. Patent No. 6,377,965 ("Hachamovitch")
1008	U.S. Pat. No. 5,923,848 ("Goodhand")
1009	U.S. Patent No. 6,085,201 to Tso ("Tso")
1010	Magnanelli, et al., "ACADEMIA: An Agent-Maintained Database based on Information Extraction from Web Documents", 14th European Meeting on Cybernetics and Systems Research on April 15, 1998.
1011	U.S. Pat. No. 5,754,306 ("Taylor")
1012	U.S. Pat. No. 5,790,532 ("Sharma")
1013	Comparison of claim language
1014	U.S. App. Ser. No. 09/189,626, Response of Dec. 18, 2000
1015	U.S. App. Ser. No. 09/189,626, Notice of Allowance of Jan. 4, 2001

NOTICE OF LEAD AND BACKUP COUNSEL

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NOTICE OF EACH REAL-PARTY-IN-INTEREST

The real-party-in-interest for this Petition is Google Inc.

NOTICE OF RELATED MATTERS

U.S. Patent no. 7,921,356 ("the '356 patent") at issue has been asserted in the

U.S. District Court for the District of Delaware in the following cases: 1:13-cv-

00919-LPS filed on May. 22, 2013 (currently pending) and 1:11-cv-00260-LPS

filed on March 29, 2011 (closed as of Nov. 29, 2011).

NOTICE OF SERVICE INFORMATION

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GROUNDS FOR STANDING

Petitioner hereby **certifies** that the patent for which review is sought is available

for *inter partes* review and that the Petitioner is not barred or estopped from

1

requesting an *inter partes* review challenging the patent claims on the grounds identified in the petition.

STATEMENT OF PRECISE RELIEF REQUESTED

The Petitioner respectfully requests that claims 1-20 of U.S. Patent No. 7,921,356 ("the '356 patent") (Ex. 1001) be canceled based on the following grounds of unpatentability, explained in detail in the next section:

Ground 1. Claims 1, 3-4, 9, 12, 14, 18 and 20 are invalid under 35 U.S.C. § 103 over Pandit in view of Luciw.

Ground 2. Claims 2, 5, 8, 11, 13 and 17 would have been obvious as in Ground 1, in further view of Goodhand.

Ground 3. Claims 7, 10, 11, 16 and 19 are invalid under 35 U.S.C. § 103 as described in Ground 1, in further view of Hachamovitch.

Ground 4. Claims 5, 6 and 15 are invalid under 35 U.S.C. § 103 over the references of Ground 1 in further view of Bonura.

Ground 5. Claims 1, 7, 10, 12, 16 and 20 are invalid under 35 U.S.C. § 103 over Tso in view of Pandit.

THRESHOLD REQUIREMENT FOR *INTER PARTES* REVIEW

This petition presents "a reasonable likelihood that the Petitioner would prevail with respect to at least one of the claims challenged in the petition." 35 USC § 314(a), as shown in the Grounds explained below.

I.   INTRODUCTION

A. Declaration of Dennis Allison

The declaration of Dennis Allison is attached as Exhibit 1002.

B. Technical Background

1.   Overview of the '356 patent

The disclosure of the '356 patent relates to the computerized handling of contact information. Contact information is information related to a person—e.g. a name, telephone number, postal address, email address, etc. Ex. 1002 at ¶43.

The '356 patent "handles" such contact information with a system that facilitates interaction between programs that use text documents (like word processors) and databases of contact information. Ex. 1002 at ¶¶43. Such databases can be called "contact databases" or "address books." Ex. 1002 at ¶43. These databases can contain information relating to people, such as their names, telephone numbers, email addresses, postal addresses, and notes. Ex. 1002 at ¶43-44.

The interaction between programs like word processors and contact databases can be illustrated with reference to Figures 3 and 4 of the '356 patent (Ex. 1001). These figures depict screens that a person might see when using a word processing program. Ex. 1002 at ¶43-44. The relevant portions of the figures are shown here:

3
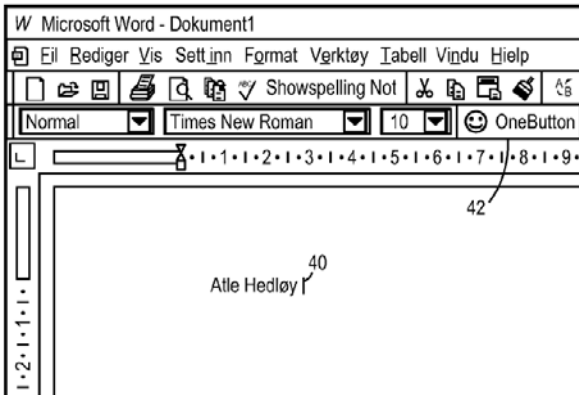
Fig. 3
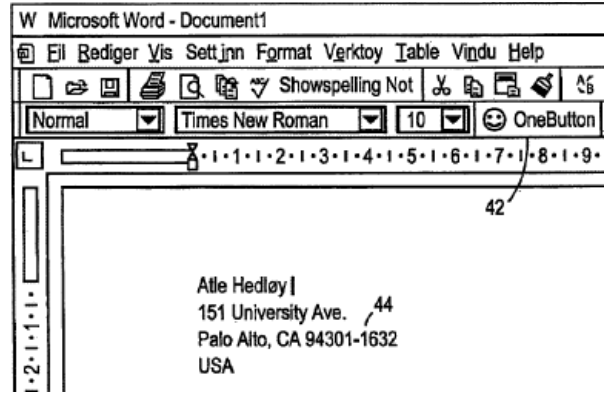
Fig. 4

Figure 3 on the left shows a word processor window, in which a user has entered a name. The user selects the name (presumably using a standard mouse action to select command in the word processor). The selected name is processed by the '356 patent system after the user clicks the "OneButton" 42 in the upper right part of the window. Clicking the "OneButton" causes the system to "retrieve[] the name[] from the document" and "search[] a database for the name…." Ex. 1001 at 6:1-2. Assuming that the search finds an address associated with the name, the system then inserts the address into the word processing document, as depicted in Fig. 4 on the right. Ex. 1002 at ¶44.

The independent claims of the '356 patent include a similar process. Among other things, the independent claims recite that **(a)** the user must enter text into a document editing program to be displayed, and **(b)** select certain text. After **(c)** sending an execute command (e.g. pressing a key or clicking a button), the document editing program **(d)** analyzes the text for contact information. Any

4

contact information so located is used to **(e)** search a database to find second

contact information, which is then **(f)** inserted into the document.

There is a family of related patents of which the '356 patent is a part. The '356

patent is somewhat different from other patents in this family, however, because its

independent claims require step (b) above. The relevant limitation reads in full:

"allowing, in the document editing program, <u>the user to select in the document at</u>

<u>least a portion of the textual information while the textual information is</u>

<u>displayed.</u>" Ex. 1001 at cl. 1. (emphasis added). This selected textual information

is then analyzed to determine whether it "is regarded by the document editing

program as contact information." *Id.* Applied to the example shown in Fig. 3,

above, this would mean allowing the user to select the text "Alte Hedloy." This

selection would identify the text "Alte Hedloy" to the system as the information to

analyze. Ex. 1002 at ¶45-47.

During the prosecution an application leading to a related patent (U.S. Pat. No.

6,323,853), however, the applicant distinguished claims over the prior art Pandit

and Tso references (applied below). These references were distinguishable,

according to the applicant, precisely because the references required the user to

select the text on which to operate. In his response received Dec. 18, 2000, the

applicant in fact stated:

"**<u>Tso teach[es] a user selecting a text string to be processed by</u>**

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**…." Ex. 1014 at 2-3 (emphasis added); Ex. 1002 at ¶46.

The Examiner ultimately allowed the claims over Tso, stating

"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 671, whereas **the present invention 'does not require the user to select the text string** to be processed since it functions automatically …." Ex. 1015 at 2 (emphasis added).

In the application leading to the '356 patent at issue here, however, the applicant reversed course, and expressly claimed allowing the user to select the text on which the system operates. Ex. 1002 at ¶46-47.

Not only is the '356 patent directed to an embodiment that was previously disclaimed, the '356 patent relates mainly to the end-result of contact information handling, that is, what the user of the computer system experiences as he or she uses the system. Exactly how these end-results are achieved is described only at the highest level. *See* Ex. 1002 at ¶50. For example, the '356 patent provides no source code or pseudo code. High-level flowcharts for some embodiments are included, Ex. 1001 at Figs. 1-2, but each of these is limited to a general description

6

of the desired functionality, with no implementation detail. Ex. 1002 at ¶¶50-51.

In fact, the '356 patent relies on existing word processors and existing databases to implement its contact management method, assuming that the person of ordinary skill can fill in the detail. The methods of the '356 patent are implemented on standard, well-known operating systems and ordinary commodity computer hardware, all of which were readily available well before the filing of the application leading to the '356 patent. Ex. 1002 at ¶¶51-60.

II.   STATE OF THE ART AT THE CLAIMED PRIORITY DATE

In the years leading up to earliest possible priority date (Sept. 3, 1998), numerous systems existed that used personal computers to manage personal contact information. These systems integrated sophisticated contact database technology available at the time (Ex. 1002 at ¶¶21-42) with applications like word processors as well as applications that performed communications (such as email applications). Ex. 1002 at ¶28-42.

For example, systems had been developed for analyzing text in a document to detect contact information, and assisting the user in taking appropriate actions based on the information discovered. U.S. Pat. No. 5,859,636 to **Pandit** (Ex. 1004) disclosed a system that allowed a user to select information in a document. Ex. 1002 at ¶28-29. The Pandit system would then analyze the selected information and allow the user to take a number of appropriate actions. As Pandit

7

states in the Abstract:

> "Text of a predetermined class is recognized in a body of text. After
> recognition, operations relevant to the recognized text may be
> performed." Ex. 1004 at Abstract; Ex. 1002 at ¶28.

An example of this is shown in Fig. 1d of Pandit (Ex. 1004) (relevant portion at

right). Figure 1d shows that a user

has selected an email address. The

system recognizes that the selected

text is an email address, and

suggests two appropriate actions
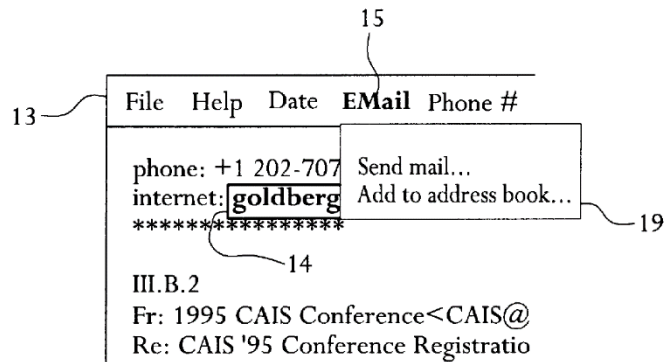
("Send mail" and "Add to address book") for the user to choose from. Ex. 1002 at

¶¶29, 73. Another example is found in U.S. Patent No. 5,644,735 to **Luciw** (Ex.

1005), which describes a system for detecting

structures in text and using a database to offer the

user options for handling the data so identified.

Figures 6a and 6b, which illustrate entering a name

and having the system provide a full name, are

shown at right. Ex. 1002 at ¶30, 97-98.
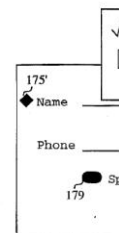
III.   CONSTRUCTION OF THE CLAIMS

8

A claim in *inter partes* review is given the "broadest reasonable construction in light of the specification." 37 C.F.R. § 42.100(b). As stated by the Federal Circuit in the case *In re ICON Health and Fitness, Inc.*:

> "[T]he PTO must give claims their broadest reasonable construction consistent with the specification. Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation."

496 F.3d 1374, 1379 (Fed. Cir. 2007). In particular, claims in *inter partes* review should not be limited by party *argument* (whether in this or a prior proceeding). To the extent that the Patent Owner desires a claim term to be interpreted more narrowly than its broadest reasonable interpretation in light of the specification, the Patent Owner must show that the *specification* provides an express definition for the relevant portions of the claims, or amend the claims. *SAP v. Versata*, CBM2012-00001, Pat. App. LEXIS 3788, *8 (PTAB June 11, 2013). As found by the *en banc* Federal Circuit:

> "If, in reexamination, an examiner determines that particular claims are invalid and need amendment to be allowable, one would expect an examiner to require amendment rather than accept argument alone."

Marine Polymer Tech., Inc. v. HemCon, Inc., 672 F.3d 1350, 1364 (Fed. Cir. 2012)(*en banc*). For the purposes of this proceeding, claim terms are presumed to take on their broadest reasonable ordinary meaning. This meaning is explained in

9

certain instances in the following subsections. The Petitioners note that the

standard of claim construction used in district courts differs from the standard

applied before the USPTO. Any claim constructions in this Petition are directed to

the USPTO standard, and are not necessarily the constructions that the Petitioners

believe would be adopted in court. The Petitioners do not acquiesce or admit to

the constructions reflected herein for any purpose outside of this proceeding.

A. Claims 1, 12 and 12 — "Input Device"

Claims 1, 12 and 20 recite an "input device." The specification notes that an

input device can be either hardware or a GUI element on a screen. Ex. 1001 at

2:11-13; Ex. 1002 at ¶67.

B. Claims 1, 9, 12, 18 and 20 — "Contact Information"

The specification includes in the concept of "contact information" names and

addresses, but also "other information, such as telephone numbers, fax numbers, e-

mail addresses, etc.," as well as "mailing lists." Ex. 1001 at 4:15-17. Therefore,

the broadest reasonable interpretation of the term "contact information" is

"information related to a person (including a legal person)." Ex. 1002 at ¶68.

C. Claims 11 and 19 — "Updating the document"

Dependent claims 11 and 19 recite "updating the document with information

from the information source." The disclosure of the '356 patent does not discuss

"updating" the document. The broadest reasonable interpretation should include,

however, replacing information in a document. Ex. 1002 at ¶69.

IV.   CLAIM-BY-CLAIM EXPLANATION OF GROUNDS FOR UNPATENTABILITY.

Ground 1.   Claims 1, 3-4, 9, 12, 14, 18 and 20 are invalid under 35 U.S.C. § 103 over Pandit in view of Luciw.

Claims 1, 3-4, 9, 12, 14, 18 and 20 are invalid under 35 U.S.C. § 103 over U.S. Patent No. 5,859,636 to Pandit ("Pandit") (Ex. 1004) in view of U.S. Patent No. 5,644,735 to Luciw ("Luciw") (Ex. 1005).

Pandit issued on January 12, 1999. The application leading to the Pandit patent was filed on Dec. 27, 1995. Pandit therefore qualifies as prior art under 35 U.S.C. § 102(e). Ex. 1002 at ¶70. Luciw is a U.S. patent that issued on July 1, 1997, and is thus prior art under 35 U.S.C. § 102(b). Ex. 1002 at ¶96. The level of ordinary skill in the art is provided in the Allison declaration. Ex. 1002 at ¶¶21-60. The Background and claim construction sections are incorporated in this Ground.

Pandit teaches a system that recognizes user-selected text and performs operations related to the selected text. Ex. 1004 at Abstract; Ex. 1002 at ¶71. The system recognizes accented (selected) text strings – i.e., text strings that have been "shad[ed], underlin[ed] or point[ed] to and click[ed] on . . . ." Ex. 1004 at 2:4-12. After recognizing the selected text strings, Pandit performs operations that depend on the type of information in the text, specifically including handling of contact information. Ex. 1004 at 2:51-3:10. These operations are initiated by clicking or

11

keystroke command. Ex. 1004 at 2:33-46; Ex. 1002 at ¶71.

For example, in Figures 1c and 1d (relevant portions shown below), when an e-mail address is selected and recognized, the system allows the user to add it to the address book. Ex. 1004 at 2:51-3:10. Other operations that Pandit can initiate in response to the recognized selected text include "such programs as . . . general address book database . . . EMail sending or address storage." Ex. 1004 at 2:56-63. Ex. 1002 at ¶¶71-73.
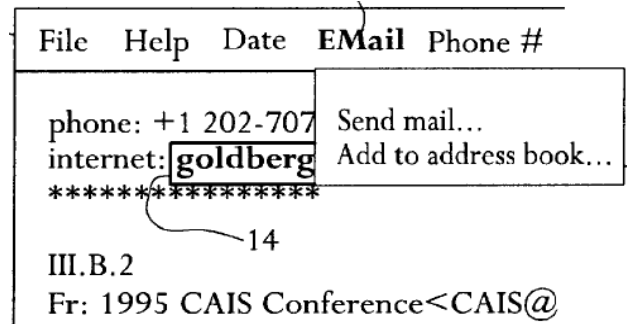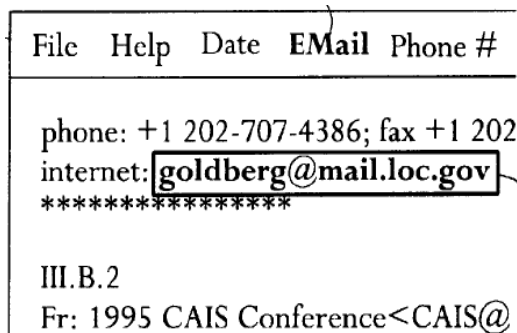
In addition to e-mail addresses, Pandit also teaches the recognition of names, street addresses, and phone numbers. Ex. 1004 at 2:31, 2:51-3:10; cl. 6-7; Ex. 1002 at ¶74. Pandit further teaches the implementation of the system by other applications via pluggable DLLs and Microsoft Component Object Model Servers. Ex. 1004 at Abstract; 3:37-39; 4:32-55. Applications such as a document editing program can, therefore, implement Pandit. Ex. 1004 at Fig. 3; Ex. 1002 at ¶75.

Pandit thus teaches analyzing a document to recognize certain types of contact information, and then allowing the user to take some action specific to that contact information. Pandit is described overall as a flexible and modular system. **Luciw**,

12

in turn, teaches using contact information found in a document to search a

database. The database search results in second contact information, which is then

displayed and inserted into the document.

Specifically, Luciw starts by analyzing user-entered text. Ex. 1005 9:22-27;

8:9-43. After text is entered, the system searches an information source (database)

to determine whether the text is recognized and whether assistance can be

provided. Ex. 1005 at 8:10-3, 10:49-60, 11:30-7. If the entered text matches an

entry in the database, the system inserts into and updates the document with data

(second information) from the database. Ex. 1005 at 12:41-60. Ex. 1002 at ¶97.

A specific focus of Luciw, for example in Figs. 4-6 and 8b, is the handling of

contact information. This includes providing a list of stored last names if a first name is entered, and providing a phone number (and optionally, calling that number) when a specific contact is identified. Figures 6a and 6b of Luciw, shown below, depict a specific example "assistance" by proposing last names of

Figure 6a

Figure 6b

persons that the user could be referring to when typing a first name (Ex. 1002 at

¶98):

13
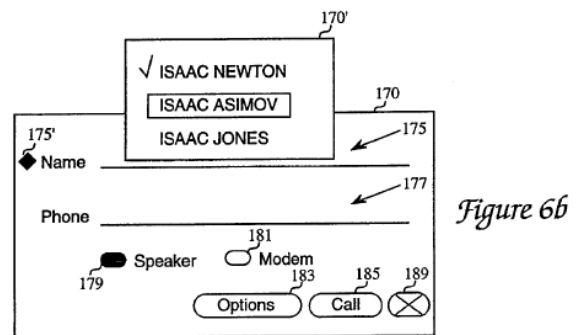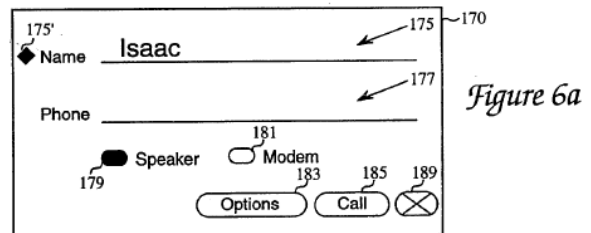
1.   Reasons for combining Pandit with Luciw

It would have been obvious to combine Pandit with Luciw. Ex. 1002 at ¶¶190-204. As noted above, Pandit discloses a system for analyzing user-selected information, including contact information, in free-form text areas such as word processing documents, and taking actions based on that information. The basic structure of the Pandit invention is the recognizing of certain selected text by "class," i.e., by analyzing the substance of the text and ascertaining what it means, and providing an input for further action. Pandit states (Ex. 1002 at ¶192):

> "The invention selectively recognizes text and performs relevant operations based on the recognition.… [F]or example, a date 11 in text appearing on a video monitor is accented… for example by shading, underlining or pointing to and clicking on the text. The invention recognizes the accented text…, and provides a menu bar 13 in which the name of menu 12 corresponding to the class of text accented is highlighted or shown in bold type, thereby showing that the menu is enabled (step 23)." Ex. 1004 at 2:3-13 (referring to Figs. 1a and 2). Ex. 1002 at ¶191.

Pandit specifically discloses *recognizing, and acting upon*, contact information, such as email addresses and phone numbers. Ex. 1004 at 2:51-3:10 and Figs. 1a-1f; Ex. 1002 at ¶192.   The actions offered for information recognized in the text, depend in turn on the content and nature of that text. For example, if an email address is recognized, "a user may click on the highlighted menu name Email… to

14

pull-down the menu." Ex. 1004 at 2:52-53. Furthermore, the menu can include

"such programs as a writable Email or general address book **database** and an

EMail template and transmitting program, preferably automatically addressed with

the accented address recognized in the text, etc." Ex. 1004 at 2:53-62 (emphasis

added); Ex. 1002 at ¶193. Pandit also makes other references to databases,

indicating that using the recognized text to interact with a database is within the

scope of its disclosure. Ex. 1004 at 2:40-41, 2:56-64, and 3:1-2; Ex. 1002 at ¶194.

Along with databases, Pandit discloses integrating with other programs as a

means to provide functionality using the recognized text – for example, a

scheduling program in response to dates (Ex. 1004 at 2:41), an email transmission

program in response to email addresses (Ex. 1004 at 2:58), or a phone dialer in

response to telephone or fax numbers (Ex. 1004 at 3:3-4). 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.

15

Like Pandit, Luciw discloses a system for providing computer-user assistance with tasks such as managing contact information, including in free-form text areas such as notes. Ex. 1002 at ¶198. Luciw focuses on providing a computer-based implicit or explicit "assistance" to a computer user based on what the user is doing with the computer, as for example indicated by the content of text he or she is entering. Ex. 1005 at 16:1-19; Ex. 1002 at ¶198-199.

Part of the Luciw solution is its database, known as a "frame" system. Ex. 1005 at 10:49-11:39. In this system, a "type frame" is provided to define a type of data record, such as a "<PERSON>," and individual instances of the "PERSON" data types are stored in their own respective frames. Ex. 1005 at 10:49-55. This is shown in the relevant portion of Fig. 5, below. Ex. 1002 at ¶200.

As the "<PERSON>" frame name indicates, Luciw specifically discloses storing contact information, such as the person's name,

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                                                        182c
                                                         )
                                            ┌──────────────────────────────────┐
                                            │ <PERSON-3> <ISAAC-3>             │
                                  182b      ├──────────────────────────────────┤
                                   )        │ NAME: ISAAC JONES               │
                              ┌──────────────────────────────────┐            │
                              │ <PERSON-2> <ISAAC-2>            │            │
                    182a      ├──────────────────────────────────┤            │
                     )        │ NAME: ISAAC ASIMOV             │            │
                ┌──────────────────────────────────┐         │            │
                │ <PERSON-1> <ISAAC-1>            │         │            │
                ├──────────────────────────────────┤         │            │
                │ NAME: ISAAC NEWTON             │         │            │
                │ BIRTHDAY: NULL                 │         │            │
                │ TELEPHONE: 408-555-1212        │         │────────────┘
                │ FAX: NULL                      │         │
                │ ADDRESS: 123 MAIN STREET,      │         │
                │                                │─────────┘
                │ HEIGHT: NULL                   │
                │ WEIGHT: NULL                   │
                └──────────────────────────────────┘
```
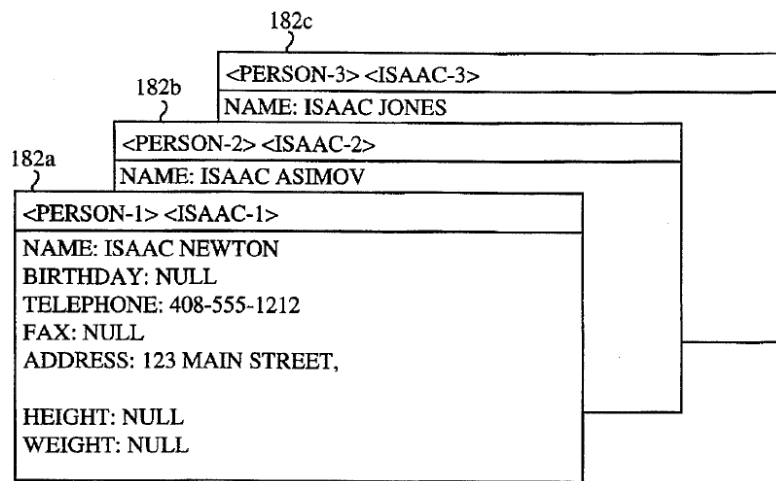
telephone number, fax number, and address. Ex 1005 at Fig. 5. Accordingly, one specific type of computerized "assistance" option offered by Luciw is to retrieve more detailed contact information in response to a user's entry of partial contact

16

information. Ex. 1005 at Figs. 6a-6c. In the Fig. 6 example, Luciw discloses

recognizing a partial name, such as a first name (11:43-44), and using that partial

name to query the contact information database (11:61-64). The retrieved

information is then provided to the user who can select a portion for insertion into

the document (12:3-6). Likewise, Luciw discloses obtaining a telephone number

associated in the database with a selected person (12:43-52). Ex. 1002 at ¶199-202.

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. Ex. 1002 at ¶203. Thus,

adding Luciw's contact information search and retrieval option to the text

recognition and task delegation system of Pandit represents an extension of Pandit

in the manner in which Pandit was intended to be extended (by adding another

sensible option associated with text recognized as having meaning, whether

selected or typed into a "smart" field). Ex. 1002 at ¶203. For example, Pandit

discloses that its system is flexible and modular (Ex. 1004 at 3:37-39 and 4:32-52),

and "will benefit any application which displays text to a user, regardless of the

origin of the text." Ex. 1004 at 1:42-43; *See also* Ex. 1004 at Abstract, 3:37-49,

4:32-55, Fig. 3, 5:17-21; Ex. 1002 at ¶204.

Furthermore, Pandit was a known system, and Luciw's approach to contact

information database search, and use of the search results, represented a known

17

technique that could have been applied to Pandit's system, without any unpredictable results. Ex. 1002 at ¶205. At the level of the claims of the '356 patent, the relevant field is predictable. Ex. 1002 at ¶205. None of the '356 patent, Pandit nor Luciw report any unpredictable results. *KSR Int'l Co. v. Teleflex, Inc.,* 550 U.S. 398, 416-19 (2007); Ex. 1002 at ¶205.

The combination would have been well within the ordinary skill in the art in the relevant timeframe. Ex. 1002 at ¶206. In particular, the state of the art was far more advanced than the disclosure of the '356 patent would indicate. Ex. 1002 at ¶206. The '356 patent, in fact, relies on prior art for enabling its techniques, thereby assuming that a person of ordinary skill could have written the requisite code to implement its system. Ex. 1002, ¶¶21-60, 207; *In re Epstein*, 32 F.3d 1559, 1568 (Fed. Cir. 1994) (lack of enabling disclosure supports prior art knowledge of a technique).

Pandit and Luciw are analogous art, because both are in the same field and both would have been reasonably pertinent to the problems faced by Mr. Hedloy. Ex. 1002 at ¶208; *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1237 (Fed. Cir. 2010) ("The Supreme Court's decision in KSR… directs us to construe the scope of analogous art broadly…."). An element-by-element mapping of the claims noted above is provided in the following claim charts:

356 Claim	Prior Art Disclosure
1[a]. At least one	Pandit discloses a non-transitory **computer readable**

18

non-transitory computer readable medium encoded with instructions which, when loaded on a computer, establish processes for contact information handling, implemented by a document editing program running in the computer, the processes comprising:	**medium** encoded with instructions. For example, Pandit states:

medium encoded with instructions. For example, Pandit states:

> "The present invention also can be embodied in the form of computer program code embodied in tangible media, such as floppy diskettes, CD-ROMS, hard drives, or any other computer-readable storage medium . . . ." Ex. 1004 at 5:25-35; Ex. 1002 at ¶76.

Pandit discloses this medium having instructions which establish processes for **contact information handling**. For example, Pandit teaches processes that handle (operate on) email addresses:

> "The invention selectively recognizes text and performs relevant operations based on the recognition . . . ." Ex. 1004 at 2:3-4; Ex. 1002 at ¶77.

> "[A]n e-mail address 14 is accented . . . An embodiment of pulled-down EMail menu 19 is shown in FIG. 1d. Included in pulled-down Email menu 19 are such programs as a writable Email or **general address book database** and an EMail template and transmitting program, preferably automatically addressed with the **accented address recognized in the text**, etc. Any other program related to EMail sending or **address storage** may be included as within the scope of this invention." Ex. 1004 at 2:51-63 (emphasis added); Ex. 1002 at ¶77.

Pandit also handles other contact information such as "names" and "street addresses," Ex. 1004 at 2:31, 2:51-3:10, cls. 6-7; Ex. 1002 at ¶78.

Pandit further discloses instructions **implemented by a document editing program**. For example Figures 1a-f illustrate the Pandit invention being implemented by a document editing program. Ex. 1002 at ¶79. Furthermore, Pandit states its system "will benefit any application which displays text to a user, regardless of the origin of the text." Ex. 1004 at 1:42-43; *See also* Ex. 1004 at Abstract, 3:37-49, 4:32-55, Fig. 3, 5:17-21. Ex. 1002 at ¶79.

Luciw likewise discloses a computer readable medium encoded with instructions which establish processes for

19

	contact information handling, implemented by a document editing program. Ex. 1005 at 4:18-26 (computer readable medium), 11:60-67 (contact information handling), 7:47-58, 6:6:21-31, and 1:54-65 ("notepad" or document editing program). Ex. 1002 at ¶¶99-102.
[1b.] allowing a user to enter textual information into a document using the document editing program;	Pandit discloses **entering** (creating) **textual information** into a document using the document editing program. Ex. 1002 at ¶80. For example: "Any text appearing on a video monitor can be operated on by the invention, whether the text is . . . **created** by a word processing or database program, etc." Ex. 1004 at 5:17-21 (emphasis added). Ex. 1002 at ¶80. *See also* Ex. 1004 at Figs. 1a-1f (depicting text that has been entered in exemplary embodiments). Ex. 1002 at ¶¶79-80. Luciw likewise discloses entering textual information into a document using the document editing program. Ex. 1005 at Fig. 2. Luciw further states: "Additional text, graphical, and other data can then be entered into this second note area 54b. For example, the text object T comprising 'ISAAC' has been entered into second note area 54b." Ex. 1005 at 6:27-31; Ex. 1002 at ¶102.
[1c.] displaying the textual information in the document electronically using the document editing program;	Pandit discloses **displaying the textual information** in the document electronically using the document editing program. For example, Figures 1a-1f show the display of textual information in a document. Ex. 1002 at ¶81. Pandit further states that: "Any text **appearing** on a video monitor can be operated on by the invention, whether the text is . . . created by a word processing or database program, etc." Ex. 1004 5:17-21 (emphasis added); Ex. 1002 at ¶81. Luciw also discloses displaying the textual information in the document electronically using the document editing program. For example, Figure 2 illustrates the display of text on the document editing program. Ex. 1002 at ¶¶103-104.

	Additionally, Luciw states: "Additional text, graphical, and other data can then be entered into this second note area 54b. For example, the text object T comprising 'ISAAC' has been entered into second note area 54b." Ex. 1005 at 6:28-31, Fig. 2; Ex. 1002 at ¶103.
[1d.] allowing, in the document editing program, the user to select in the document at least a portion of the textual information while the textual information is displayed;	Pandit discloses the **selection** (for example by shading, underlining or pointing to and clicking) **in the document** at least a portion of the textual information while the textual information is displayed. Ex. 1002 at ¶82. For example: "Referring to FIG. 1a and FIG. 2, for example, a date 11 in text appearing on a video monitor is accented (step 21 of FIG. 2) for example by **shading, underlining or pointing to and clicking on the text**. The invention recognizes the accented text (step 22), and provides a menu bar 13 in which the name of menu 12 corresponding to the class of text accented is highlighted or shown in bold type, thereby showing that the menu is enabled (step 23)." Ex. 1004 at 2:4-12. (emphasis added.); Ex. 1002 at ¶82. Luciw likewise discloses the selection in the document at least a portion of the textual information: "If an explicit assist has been indicated at step 110, then a step 130 determines, if a particular selection as to the explicit assistance has been made. Selection is typically made by clicking on a particular word with pen 38, for example, and thereby highlighting the item selected." Ex. 1005 at 9:22-27; Ex. 1002 at ¶105.
[1e.] following user selection of textual information in the document, analyzing, by the document editing program, the selected textual information to determine if the	Pandit discloses **analyzing** the selected textual information to determine if the selected text is **contact information** and what **type of contact information** the text is: "As shown in FIGS. 1c-1f, the invention is not limited to the **recognition** of dates in text and preferred embodiments of the invention can recognize e-mail addresses and telephone numbers. In fact, there is no limit on the **type of text which can be recognized** by the invention and additional embodiments can

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;	recognize **such classes of text as Uniform Resource Locators, nouns, verbs, names, street addresses, etc.**" Ex. 1004 at 2:24-32 (emph. add.); claims 6-7; Ex. 1002 at ¶85. Luciw also discloses determining if the selected text is contact information. "The recognition process is started at step 240 in FIG. 11a . . . the process aims to determine whether the object(s) match at least one of the templates of object combinations set forth in FIG. 11c." Ex. 1005 at 13:54-61; Ex. 1002 at ¶106. Pandit discloses **analyzing by the document editing program**. Figures 1a-f illustrate analysis by the document editing program. Ex. 1002 at ¶83. As noted above, Pandit states that any application that processes text can use the invention. Furthermore, Pandit states that its document processing can be implemented by dynamic link libraries (DLLs) and Microsoft COM objects that can be plugged into any application. Ex. 1004 at 3:36-49; 4:32-52; Ex. 1002 at ¶83-84. As Pandit explains: "Conventionally, a software program must be entirely recompiled for its functionality to be increased or its operations changed in any manner. **The present invention, however, is highly modular and allows libraries to be added at will and additional features to be added to libraries without recompiling**. For example, by implementing libraries as 'MICROSOFT' Component Object Model Servers or by using equivalent standards known to those skilled in the art…." Ex. 1004 at 4:32-52 (emphasis added); *see also* Ex. 1004 at 3:36-49; Ex. 1002 at ¶83-84.
[1f.] providing an input device configured by the document editing program to allow the user to initiate an operation, such	Pandit teaches an **input device** (clicking or keyboard key strokes) configured to allow the user to initiate an operation. For example: "The pull-down menus provided by the invention identify the operations and/or programs which relate to the class of text accented, highlighted or otherwise indicated . . . . A user is able to run one or more of the programs relevant to dates which are identified in the

operation being of a type depending at least in part on the type or types of contact information of the selected textual information, the operation comprising identifying at least part of the selected textual information to use as a search term in order to find second information, of a specific type or types, associated with the search term in an information source external to the document;	pulled-down menu in a known manner, such as by **clicking** on the name of the program as it appears in the pulled-down menu (step 25) or through the execution of **one or more keyboard key strokes**." Ex. 1004 at 2:33-46 (emphasis added); Ex. 1002 at ¶86. Pandit further discloses that the operation is **dependent at least in part on the type or types of contact information** of the selected text. Pandit summarizes a portion the method in claims 1 and 7 as: "(3) recognizing the selected text as belonging to the predetermined class if the format of the selected text matches the predetermined format; and (b) **performing an operation associated with the predetermined class using the recognized text as a parameter**. . . . 7. The method of claim 1, wherein the text is one of a date, name, telephone number, telefax number, e-mail address, and Uniform Resource Locator." Ex. 1004, cls. 1 and 7 (emph. add.); Ex. 1002 at ¶87. For example, when the contact information is an EMail-type, operations related to an email are initiated. When the contact information is a telephone-number-type, operations related to a phone number are initiated: "An embodiment of pulled-down EMail menu 19 is shown in FIG. 1d. Included in pulled-down Email menu 19 are such programs as a writable Email or general address book database and an EMail template and transmitting program, preferably automatically addressed with the accented address recognized in the text, etc. Any other program related to EMail sending or address storage may be included as within the scope of this invention. Referring now to FIG. 1e, a telephone number 16 is accented. The pull down menu named Phone #17 is highlighted and preferably identifies the executable operations and/or programs which are relevant to telephone and telefax numbers." Ex. 1004 at 2:56-67; Ex. 1002 at ¶88. Luciw likewise provides an input device that allows the

23

user to **initiate an operation**:

> "An example of an indication of user desire to have explicit assistance undertaken is the act of using pen 38 in FIG. 2 to tap or click on the assist icon or button…." Ex. 1005 at 8:51-53; Ex. 1002 at ¶107.

> "[I]mplicit 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." Ex. 1005 at 8:30-41; Ex. 1002 at ¶107.

Luciw discloses an operation of a type **depending on the type or types of contact information of the selected text**. Luciw describes this as forming a "hypothesis" of the action desired by the user:

> "[A]n attempt is made at step 135 to recognize the possible intent expressed by the objects entered into the assistance process . . . . If a possible intent is recognized at step 135, the intent is hypothesized at step 137. Next, step 139 checks whether there is a hypothesis available. If no hypothesis is found, process step 141 permits the user to supply a proposed action. If no hypothesis is found and no user action is proposed, process control returns to point A. However, with the availability of a user supplied action or if a hypothesis is available, preparations for execution of actions consistent with the action requested or hypothesized are undertaken at step 143." Ex. 1005 at 9:45-63; Ex. 1002 at ¶108.

Luciw further discloses **using at least part of the selected textual information to use as a search term**. For example:

> "If a user does enter information into a 'smart field,'

24

	the computer database will be queried at step 106 to determine whether assistance is possible given the user input." Ex. 1005 at 8:10-13; Ex. 1002 at ¶109. Luciw describes the database query as follows: "Details of one way to carry out the database query process indicated in FIG. 3 at step 106 can be understood in connection with FIG. 5. In particular, FIG. 5 illustrates a frame 180 which is a special case of a frame, referred to commonly as a 'type' frame, as the frame refers to a particular type, i.e., the type <PERSON>. Particular instances of the type <PERSON>; are shown as frames. Frame 180 has a number of slots for various attributes of being a person, such as NAME, BIRTHDAY, TELEPHONE, FAX, etc. Frame 180 also includes a list of all frames which are an instance of the type frame <PERSON>, namely <PERSON-1>, <PERSON-2>, and <PERSON-3>." Ex. 1005 at 10:49-60, Fig. 3; Ex. 1002 at ¶110. "Frames used in the present invention have a number of slots which may contain data, daemons, or other frames. Slots are accessed by making assertions to the knowledge base. For example, if it was desired to retrieve all of the frames that were colored red, a typical frame accessor language query would be in the form of: (QUERY (MEMBER-VALUE COLOR ?xRED)" Ex. 1005 at 11:30-37; Ex. 1002 at ¶110.
[1g.] after identifying at least part of the selected information to use as a search term, and in consequence of receipt by the document editing program of an execute	Pandit discloses that it can interface with systems (such as address books) external to the document application. Ex. 1002 at ¶89. For example, after recognition of text in a document, Pandit's system can call upon external programs to operate on the selected contact information: "An embodiment of pulled-down EMail menu 19 is shown in FIG. 1d. **Included in pulled-down Email menu 19 are such programs** as a writable Email or general address book database and an EMail template and transmitting program, preferably automatically addressed with the accented address recognized in the text, etc. **Any other program related to EMail**

25

command from the input device, performing the operation, wherein the operation further comprises: causing an electronic search in the information source, by an information management program external to the document editing program, for the search term in order to find whether the search term is included in the information source; and	**sending or address storage may be included** as within the scope of this invention." Ex. 1004 at 2:56-64 (emph. add.); Ex. 1002 at ¶89. Luciw also discloses causing an **electronic search in the information source**, as described under limitation [1f.], above. The search query shown in [1f.] above **will find whether the search term is included in the information source**. Ex. 1002 at ¶110. The **search** can be triggered by an execute command that causes an "implicit assist" (**execute command from the input device**). Ex. 1005 at 8:30-41; Ex. 1002 at ¶107. The information source is **external** to the document editing program. For example, Luciw claim 1 states: "1. A computer system having assistance capabilities, comprising: (a) computation means for performing assistance functions, (b) memory means for maintaining a data base of assistance-pertinent events, said memory means **being coupled to** said computation means…." Ex.1005, cl. 1, emphasis added; Ex. 1002 at ¶111.
[1h.] 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, and if the search term is so included, and if the information source includes the second	Luciw causes **insertion of at least part of the second information into the document if it is included in the database**: "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. In the earlier example of FIG. 6c in which it was decided that Isaac Asimov was the desired ISAAC, the phone information in window 170 had not yet been entered. This information may be available and can be accessed according to the process of FIG. 8a. 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

26

information, the action comprises causing insertion of at least part of the second information into the document.	obtained from the corresponding linked field types as suggested at 203. Then, as suggested at 206, **the data obtained is entered into the applicable smart field of the window 170 under operation**." Ex. 1005 at 12:41-60 (emph. add.); Ex. 1002 at ¶112-113.
	
	    Here, the second information is the phone number or last name matched to 'Isaac'. Ex. 1002 at ¶¶112-114. It is found in a "linked" smart field or "linked field", which is part of the frame database. Ex. 1002 at ¶115.
	
	    As noted by Luciw, the content of the linked field inserted into a document can also be "persons, telephone numbers, dates, document names, account numbers, addresses, and access codes." Ex. 1005 at cls. 9, 16 and 20; Ex. 1002 at ¶113.

3. At least one non-transitory computer readable medium according to claim 1, wherein the instructions establish processes wherein: when (i) the information source includes the search term, (ii) the selected textual information includes a name, (iii) the information source further includes the second information, and (iv) the second information includes an	Luciw discloses **inserting at least part of the second information into the document**. For example, the patent states:
	
	    "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 203. Then, as suggested at 206, the data obtained is entered into the applicable smart field." Ex. 1005 at 12:47-54; Ex. 1002 at ¶114.
	
	  Here Luciw is referring to "smart fields" as database entries. Ex. 1002, Luciw further teaches that smart fields can contain names (Figs. 6a-c) and addresses:
	
	    "8. A computer system as recited in claim 1 wherein the smart field is responsive to information selected from the group consisting of persons, telephone numbers, dates, document names, account numbers, **addresses**, and access codes." Ex. 1005 at Claim 8 (emphasis added). *See also* Ex. 1005 at Claim 1, 10, 16, and 20; Ex. 1002 at ¶115.
	
	  Luciw also discloses that linked fields (second

27

address, the action further comprises causing **insertion of at least part of the address into the document.**	information, or fields in the database associated with the first information) can contain addresses: "9. A computer system as recited in claim 8 wherein the database is comprised of templates, each template comprised of linked fields, each linked field being selected from the group consisting of persons, telephone numbers, dates, document names, account numbers, **addresses**, and access codes." Ex. 1005 at Claim 9 (emphasis added). *See also* Ex. 1005 at Claim 1, 10, 16, and 20; Ex. 1002 at ¶115.
4. At least one non-transitory computer readable medium according to claim 3, wherein the instructions establish processes wherein, when the second information includes a plurality of addresses, the operation further comprises allowing the user to choose one of the plurality of addresses to use for	Luciw discloses that when the second information includes a plurality of possibilities, the operation further comprises **allowing the user to choose one of the plurality of possibilities to use for insertion**. For example, Figure 6b illustrates that when the second information includes a plurality of last names, an overlay window 170 is displayed to allow the user to choose one of the plurality of names to insert. Luciw states that: "Responsive to the recognition of the name ISAAC, the assistance process has produced a list of alternatives by earlier query of the database per step 106 in FIG. 3. In particular, **three ISAAC are presented for selection of one of them**, the presentation being made in an overlay window 170, positioned partially over the underlying window 170. The user-selected 'ISAAC ASIMOV' is shown having been marked for selection by a rectangle indicating a highlighting operation. FIG. 6c illustrates the completion of the selection process". Ex. 1005 at 11:61-12:6 (emph. add.); Ex. 1002 at ¶116. Luciw further states that: "In the earlier example of FIG. 6c in which it was decided that Isaac Asimov was the desired ISAAC, the phone information in window 170 had not yet been entered. This information may be available and can be accessed according to the process of FIG. 8a. 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

28

insertion into the document.	from the corresponding linked field types as suggested at 203. **Then, as suggested at 206, the data obtained is entered into the applicable smart field**" Ex. 1005 at 12:43-54 (emph. add.); Ex. 1002 at ¶116.
	
	    In the claims, Luciw also discloses that linked fields and smart fields can contain addresses:
	
	    "8. A computer system as recited in claim 1 wherein the **smart field** is responsive to information selected from the group consisting of **persons, telephone numbers, dates, document names, account numbers, addresses, and access codes**." Ex. 1005 at Claim 8 (emph. add.). *See also* Ex. 1005 at Claim 1, 10, 16, and 20.
	
	    "9. A computer system as recited in claim 8 wherein the database is comprised of templates, each template comprised of **linked fields**, each linked field being selected from the group consisting of **persons, telephone numbers, dates, document names, account numbers, addresses, and access codes**." Ex. 1005 at Claim 9 (emph. add.). *See also* Ex. 1005 at Claim 1, 10, 16, and 20; Ex. 1002 at ¶¶115-116.

9. At least one non-transitory computer readable medium according to claim 1, wherein the instructions establish processes wherein, when the type or types of contact information includes a name, the operation includes causing display by the information	Luciw discloses that when **the type of contact information includes a name**, the operation **causes display** of at least part of a contact information record in the information source corresponding to the name, which in this case is a last name or phone number. For example: "Responsive to the **recognition of the name ISAAC**, the **assistance process** has produced a list of alternatives by earlier query of the database per step 106 in FIG. 3. In particular, **three ISAAC are presented for selection of one of them, the presentation being made in an overlay window 170**, positioned partially over the underlying window 170. The user-selected "ISAAC ASIMOV" is shown having been marked for selection by a rectangle indicating a highlighting operation. FIG. 6c illustrates the completion of the selection process, **with the full name in formal font of ISAAC ASIMOV being presented in the name field 175 of window 170**."

management program of at least part of a contact information record in the information source corresponding to the name.	Ex. 1005 at 11:60-12:6 (emph. add.); Ex. 1002 at ¶118. Luciw further discloses that the display is **by the** assistance process (**information management program**): "A method or process 100 for providing implicit or explicit **assistance** in the provision of computer implemented services in accordance with the present invention is shown in FIG. 3. The **process** begins at step 102 on power-up of the computer system 10 and runs **concurrently with other system functions**." Ex. 1005 at 8:1-6; Ex. 1002 at ¶119.

12[a]. A method, for contact information handling, implemented by running a document editing program in a computer, the method comprising:	Pandit discloses a method for **contact information handling**. For example: "The invention selectively recognizes text and performs relevant operations based on the recognition . . . ." Ex. 1004 at 2:3-4. "[A]n e-mail address 14 is accented . . . An embodiment of pulled-down EMail menu 19 is shown in FIG. 1d. Included in pulled-down Email menu 19 are such programs as a writable Email or general address book database and an EMail template and transmitting program, preferably automatically addressed with the accented address recognized in the text, etc. Any other program related to EMail sending or address storage may be included as within the scope of this invention." Ex. 1004 at 2:51-63; Ex. 1002 at ¶92. Pandit further discloses the method **implemented by running a document editing program**. For example: "Any text appearing on a video monitor can be operated on by the invention, whether the text is within an EMail message, World-Wide Web site, created by a word processing or database program, etc." Ex. 1004 at 5:17-21; Ex. 1002 at ¶93. Luciw likewise discloses a method, for contact information handling, implemented by running a document editing program. Ex. 1005 at 11:60-67 (contact information handling); Ex. 1005 at 7:47-58, 6:21-31, 1:54-65 ("notepad" or document editing

program). See also Ex. 1002 at ¶¶120-122.	

As shown immediately above, both Pandit and Luciw disclose portions of the preamble for Claim 12; it would have been obvious to one of skill in the art in the relevant timeframe to combine Pandit and Luciw to obtain the entire preamble of Claim 12, as described *supra* immediately above the Claim 1 chart. *See also* Ex. 1002 at ¶63 and ¶¶190-208. After the preamble, the elements of Claim 12 are substantially identical to those of Claim 1; Allison Decl., Ex. 1002 at ¶61-64. *See also* Ex. 1013 (comparing the claim language of Claims 1, 12, and 20). Therefore Claim 12 is obvious as set forth in the chart for Claim 1, *supra*.

14. A method according to claim 12, wherein, when the second information includes a plurality of addresses, the operation further comprises allowing the user to choose one of the plurality of addresses to use for insertion into the document.	See reasoning for claims 4 and 12. Ex. 1002 at ¶61.

18. A method according to claim 12, wherein, when the type or types of contact information includes a name, the operation includes causing display by the information management program of at least part of a contact information record in the information source corresponding to the name.	See reasoning for claims 9 and 12. Ex. 1002 at ¶61.

20[a]. An apparatus for contact information handling, comprising: a processor; and a memory storing instructions	Pandit discloses an apparatus for contact information handling, comprising a processor and a memory storing instructions executable by the processor. For example: "The present invention can be embodied in the form of computer-implemented processes and apparatuses for practicing those processes. The present invention also can be embodied in the form of **computer program code embodied in tangible media**… wherein, when the computer program code is loaded into and executed by a computer, the computer becomes an apparatus for

executable by the processor to perform processes that include:	practicing the invention. The present invention can also be embodied in the form of computer program code… wherein, when the computer program code is loaded into and executed by a computer, the computer becomes an apparatus for practicing the invention." Ex. 1004 at 5:25-43 (emph. add.); Ex. 1002 at ¶95. Luciw likewise discloses an apparatus for contact information handling, comprising a processor and a memory storing instructions executable by the processor. Ex. 1005 at 4:13-26; Ex. 1002 at ¶123.

As shown immediately above, both Pandit and Luciw disclose portions of the

preamble for Claim 20; it would have been obvious to one of skill in the art in the

relevant timeframe to combine Pandit and Luciw to obtain the entire preamble of

Claim 20, as described *supra* immediately above the Claim 1 chart. Ex. 1002 at

¶63, ¶¶190-208. After the preamble, the elements of Claim 20 are substantially

identical to those of Claim 1; Allison Decl., Ex. 1002 at ¶61-64. *See also* Ex. 1013

(comparing the claim language of Claims 1, 12, and 20). Therefore Claim 20 is

obvious as set forth in the chart for Claim 1, *supra*.

Ground 2.   Claims 2, 5, 8, 13 and 17 would have been obvious as in Ground 1, in further view of Goodhand.

Claims 2, 5, 8, 13 and 17 would have been obvious for the reasons given in

Ground 1, in further view of U.S. Pat. No. 5,923,848 ("Goodhand") (Ex. 1008).

Goodhand was filed on May 31, 1996 and issued on July 13, 1999, and is thus

prior art under 35 U.S.C. § 102(e).

As discussed above, Pandit discloses a system allowing a user to select text,

32

analyzing the text to recognize contact information, and allowing the user to perform a variety of further actions on the contact information. Also as discussed above, Luciw discloses having a user enter or select contact information, searching a database for related information, and then inserting the related information into a document or carrying out another action.

Goodhand teaches a similar system in the context of email addressing for email messages. Specifically, Goodhand teaches a "system and method for resolving names in an electronic messaging environment." Ex. 1008 at Title; Ex. 1002 at ¶125. Goodhand discloses a system that matches the text ("display name") entered by the user to an entry in an information source (address book). Ex. 1008 at 16:40-53; Ex. 1002 at ¶¶126, 129, 132-133. This relieves a user of having to memorize exact email addresses. The matching/searching process is referred to as "resolving." Ex. 1008 at 16:51-53; Ex. 1002 at ¶127. Resolving can be initiated in several ways; for example, text is resolved when the user clicks the send button or if the user selects a "check

FIG.6a

FIG.6b

FIG.6c

SCREEN DISPLAYS - ORIGINAL NAME RESOLUTION

33
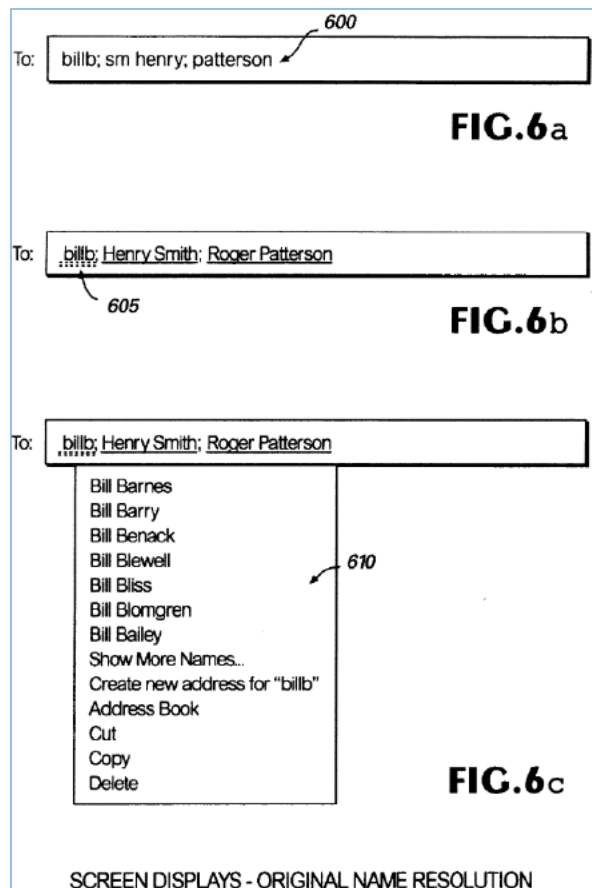
names" command. Ex. 1008 at 20:18-21; Ex. 1002 at ¶¶130-131.

After resolving, if a display name has a match in the information source (address book), the display name from the information source is inserted and displayed. Ex. 1008 at 17:37-41, Fig. 6a-b; Ex. 1002 at ¶¶134-135. However, if no unique match for the display name is found, an indication is made to the user by a squiggly line under the display name. Ex. 1008 at 17:41-52. When no unique match is found, the system further allows the user to add the display text into the address book as a new entry. Ex. 1008 at 18:2-7; Ex. 1002 at ¶¶136-137.

Figures 6a-6c of Goodhand (at right) show the process of address resolution. A user enters one or more names (here "billb," "sm henry" and "Patterson") in the "To:" field. When the user exits the field (or alternatively, clicks a specific button), the system recognizes "billb," "sm henry" and "Patterson" as unresolved addresses, and searches for them in an address book. Ex. 1008 at 17:22-30. The system tries to match each of "billb," "sm henry" and "Patterson" with specific address book entries. Ex. 1008 at 17:34-37; Ex. 1002 at ¶¶128-132.

If the search for any text string results in one unambiguous hit in the address book, the full name of the person located by the search will be inserted in the "To:" line (here: "sm henry" is replaced with "Henry Smith" and "Patterson" is replaced with "Roger Patterson" in Fig. 6b). Ex. 1008 at 17:37-40. If the search result is ambiguous (as was the case for "billb"), the user is given several options to resolve

34

the ambiguity and the option to add to address book. Ex. 1008 17:53-62, 18:2-7;

Ex. 1002 at ¶134-140.

1. Reasons for combining Pandit and Luciw with Goodhand

It would have been obvious to combine Goodhand with the references of

Ground 1. The reasons for combining Pandit with Luciw explained in Ground 1

are applicable here, particularly with reference to Pandit's express disclosure that it

is designed to be modular and extensible, and is appropriate for use with other text

processing functions and in conjunction with any text processing application. Ex.

1002 at ¶¶209-211. Pandit further expressly discloses that it is usable with email.

Ex. 1004 at 2:53-63; Ex. 1002 at ¶112. Goodhand is also directed to an electronic

mail system (Ex. 1008, Abstract; Ex. 1002 at ¶¶211-212), and teaches that "[t]he

present invention satisfies the above described needs by providing an **improved**

system and method for composing, processing, and organizing electronic mail

message items." Ex. 1008 at 4:45-53 (emphasis added); Ex. 1002 at ¶212. Pandit

suggests using the Microsoft COM system for application extension (Ex. 1004 at

4:32-52) and Goodhand expressly recommends the use of the Microsoft Outlook

program. Ex. 1008 at 8:37-45. Goodhand is also assigned to Microsoft

Corporation, the maker of Microsoft Outlook and the COM system. *Ex parte*

Mettke, Appeal 2008-0610, 2008 Pat. App. LEXIS 6761, *43-*44 (BPAI Sept. 30,

2008); Ex. 1002 at ¶214.

The combined system is also based on known systems and components that could have been combined by a person of skill in the art without unpredictable results. Ex. 1002 at ¶214; *KSR,* 550 U.S. 398, 416-19 (2007). The discussion of predictability under Ground 1 is applicable. Ex. 1002 at ¶205. Goodhand is analogous art because it is in the same field and would have been reasonably pertinent to the problems faced by Mr. Hedloy. Ex. 1002 at ¶215. The elements of the above-mentioned claims are mapped to the disclosure of the references in the claim charts below.

2. At least one non-transitory computer readable medium according to claim 1, wherein the instructions establish processes wherein: 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.	Goodhand discloses that 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**. For example, when Goodhand is unable to find a unique match in the information source (address book), then a squiggly line is used to indicate so to the user: "The squiggly line beneath the display name 'billb' indicates that the e-mail system was unable to find a unique match for that display name." Ex. 1008 at 17:49-52, Fig. 6a-b; Ex. 1002 at ¶141.

5. At least one non-transitory computer readable medium according to claim 1, wherein the instructions	Pandit suggests that when the selected text is not in the information source, the user is allowed to cause storage of at least some of the selected text. Ex. 1002 at ¶90. For example Figure 1d illustrates allowing the user to cause storage of the selected text. Pandit further discloses: "[A]n e-mail address 14 is accented . . . An embodiment of pulled-down EMail menu 19 is shown in FIG. 1d. Included in pulled-down Email menu 19 are such

| establish processes wherein, when the selected textual information includes information that is not in the information source, the operation further comprises: allowing the user to cause storage of at least some of the selected textual information in the information source. | programs as a writable Email or general address book database and an EMail template and transmitting program, preferably automatically addressed with the accented address recognized in the text, etc. Any other program related to EMail sending or **address storage** may be included as within the scope of this invention." Ex. 1004 at 2:51-63; Ex. 1002 at ¶90.

 Goodhand likewise discloses that **when the selected text is not in the information source, the user is allowed to cause storage** of at least some of the selected text. Ex. 1002 at ¶142. For example, Figure 6c illustrates that when no unique match is found for the entered text, the user is allowed to cause storage in the information source (create an new entry in address book):

 "The squiggly line beneath the display name 'billb' indicates that the e-mail system was unable to find a unique match for that display name." Ex. 1008 at 17:49-52.

 "The 'create new address for billb' option in the context menu 610 allows the user to create an entry in his or her personal address book. Those skilled in the art will appreciate that this is typically used to store addresses of e-mail recipients who are not registered users on the local e-mail system." Ex. 1008 at 18:2-7; Ex. 1002 at ¶142-143. |
| 8. At least one non-transitory computer readable medium according to claim 1, wherein the instructions establish processes wherein the information source includes an e-mail address and the operation includes causing an e-mail to be sent to the e-mail address. | Goodhand discloses that **the information source includes an e-mail address, causing an e-mail to be sent to the e-mail address**. For example, Goodhand teaches that the search for information in an information source (resolve) is initiated by the user's command to send an e-mail:

 "Those skilled in the art will appreciate that in the preferred application program, addresses are also resolved **when the user sends the message** or if the user selects the 'check names' command." Ex. 1008 at 20:19-21 (emph. add.); Ex. 1002 at ¶144. |

37

11. At least one non-transitory computer readable medium according to claim 1, wherein the instructions establish processes wherein the type of operation includes updating the document with information from the information source.	Goodhand discloses **updating the document with information from the information source**. For example, as illustrated in Figures 6a and 6b, after the user enters text, the system replaces the entered text with the information from the information system. Ex. 1002 at ¶145. Goodhand further states: "FIG. 6b illustrates the results of the effort to resolve the names. **If a display name is unambiguous and matches only one registered user, the name of that user is inserted in the address field**. If the display name is ambiguous, the e-mail program indicates that the display name needs to be manually resolved by displaying the display name and a predetermined indicia, such as a squiggly line 605 beneath the display name. FIG. 6b indicates that the display names 'sm henry' and 'patterson' were unambiguously matched to 'Henry Smith' and 'Roger Patterson,' respectively. Names that are unambiguously matched appear with a regular underline beneath the display name." Ex. 1008 at 37-52 (emph. add.); Ex. 1002 at ¶145.

13. A method according to claim 12, wherein: 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; and when (i) the information source does include the search term, (ii) the selected textual information includes a name, (iii) the information source further includes the second information, and (iv) the second information includes an address, the action further comprises causing insertion of at least part of the address into the document.	Goodhand discloses that when the information source does not include the search term, the action comprises **causing indication** to the user. See reasoning for claim 2. Luciw discloses the **insertion of at least part of the address** into the document. See reasoning for claim 3. Ex. 1002 at ¶61.

17. A method according to claim 12, wherein the information source includes an e-mail address and the operation includes causing an e-mail to be sent to the e-mail address.	See reasoning for claims 8 and 12. Ex. 1002 at ¶61.

38

Ground 3.   Claims 7, 10, 11, 16 and 19 are invalid under 35 U.S.C. § 103 as described in Ground 1 in further view of Hachamovitch.

Claims 7, 10, 11, 16 and 19 are invalid under 35 U.S.C. § 103 over Pandit and

Luciw in further view of U.S. Patent No. 6,377,965 ("Hachamovitch") (Ex. 1007).

Hachamovitch was filed on Nov. 7, 1997 and issued on Apr. 23, 2002, and is thus

prior art under 35 U.S.C. § 102(e). The Background and claim construction

sections are incorporated in this Ground.

Hachamovitch discloses an "automatic word completion system for partially

entered data." Ex. 1007 at Title. The system recognizes text that has been entered

by the user. Ex. 1007 at 4:55-60. The system matches the entered text with entries

in an information source database (suggestion list). Ex. 1007 at 11:40-50. If a

match is found, the data from the database is used to update and insert into the

document. Ex. 1007 at 11:40-50; Ex. 1002 at ¶147.

An example is illustrated in Figs. 2A-3 (below).
The user first partially enters text 204 into a
document editing program. The system takes the
partially entered text 204 and compares it with
column 302 in Figure 3 for a match. Ex. 1007 at
11:36-50, Fig. 2A-3. If the partially entered text
matches the "Name" in column 302, then the

39

"Completion" data in column 304 associated with the "Name" 302 is displayed 208. Ex. 1007 at 11:36-50, Fig. 2A-3. The user can accept the displayed suggestion and insert the suggested text into the word editing document. Ex. 1007 at 11:36-50, Fig. 2A-3; Ex. 1002 at ¶148.

For example, as illustrated in Figure 3, when the user's partial text entry matches "Microsoft Corporation" in the "Name" 302 column, the program would automatically complete the text with Microsoft Corporation's address from the "Completion" 304 column. Ex. 1002 at ¶149.

1. Reasons for combining Hachamovitch with Luciw and Pandit

It would have been obvious to combine Hachamovitch with Pandit and Luciw. Like Pandit and Luciw, Hachamovitch teaches a system to assist the user with text processing. Hachamovitch states that it is desirable to assist the user of text documents in reducing the amount of time spent entering text:

> "For many users, the most time consuming computer activity is the entry of large amounts of text into various data files, such as Word processing files and e-mail files. Regard less of the input method used, the speed at which the text can be entered into the computer is a major factor governing the user's efficiency. The designers of text-intensive application programs have therefore developed text-input aids to assist users in entering text into the computer." Hachamovitch, Ex. 1007, at 1:26-32; Ex. 1002 at ¶¶216-217.

Hachamovitch's system allows a user to reduce keyboarding requirements by automatically predicting and inserting certain text. (Hachamovitch, Ex. 1007, Abstract). Like Pandit (Ex. 1004, 5:17-21), Hachamovitch teaches that it is useful with a wide variety of text processing applications:

> "It will be appreciated that the principles of the invention are not limited **word processing and e-mail** application programs, but **could equivalently be applied to any computer-implemented system that involves a substantial amount of text entry**. For example, it is anticipated that the invention may be deployed in connection with future versions of Microsoft's **personal calendar applications programs, spread sheet programs, database programs, and so forth**." Ex. 1007 at 9:52-61 (emphasis added); Ex. 1002 at ¶218.

Hachamovitch teaches that its system is an improvement to dictionary systems such as spell-checkers. Ex. 1007 at 3:18-4:37. Pandit expressly states that its own system can be used with dictionary systems kinds of systems, which it calls "conventional." Ex. 1004 at 3:24-33 1:38-42. Ex. 1002 at ¶219. Like Pandit and Luciw, Hachamovitch teaches replacement functions for email addresses (Ex. 1007 at 7:42-47), as well as for addresses and names. Ex. 1007 at 10:64-11:3 and Fig. 3; Ex. 1002 at ¶220. Further like Pandit (Ex. 1004 at 3:37-39 and 4:32-52), Hachamovitch teaches that its system can be used with Microsoft applications (Ex. 1007 at 9:44-65). In fact, Hachamovitch is assigned to Microsoft. Ex. 1002 ¶¶219-221.

41

The combined system is also based on known systems and components that could have been combined by a person of skill in the art without unpredictable results. Ex. 1002 at ¶222; *KSR*, 550 U.S. 398, 416-19 (2007). The discussion of predictability under Ground 1 is applicable. Ex. 1002 at ¶205. Hachamovitch is analogous art, because it is in the same field and would have been reasonably pertinent to the problem faced by Mr. Hedloy. Ex. 1002 at 223. The claims noted above are taught by Hachamovitch as shown in the following claim charts and discussion.

7. At least one non-transitory computer readable medium according to claim 1, wherein the instructions establish processes wherein the information source is available over a network.	Hachamovitch discloses the information source is available over a network. For example: "The invention may also be practiced in distributed computing environments where tasks are performed by remote processing devices that are linked through a communications network." Ex. 1007 at 8:35-40; Ex. 1002 at ¶150.

10. At least one non-transitory computer readable medium according to claim 1, wherein the instructions establish processes wherein the document editing program is a spreadsheet program.	Hachamovitch discloses the document editing program is a spreadsheet program: "It will be appreciated that the principles of the invention are not limited word processing and e-mail application programs, but could equivalently be applied to any computer-implemented system that involves a substantial amount of text entry. For example, it is anticipated that the invention may be deployed in connection with future versions of Microsoft's personal calendar applications programs, **spread sheet programs**, database programs, and so forth." Ex. 1007 at 9:52-60 (emph. add.); Ex. 1002 at ¶151.

42

| 11. At least one non-transitory computer readable medium according to claim 1, wherein the instructions establish processes wherein the type of operation includes updating the document with information from the information source. | Hachamovitch discloses updating the document with information from the information source. For example, in Fig. 4A-C, when the user inputs text "Sym," the text is updated with "Save the Whales Symposium:"

"The series FIGS. 4A-C shows an example illustrating a procedure for including a user-defined name-completion pair in a word completion suggestion list. In this example, the data entry 'Symposium' is entered as the name entry and the data entry 'Save the Whales Symposium' is entered as the completion entry of a name-completion pair. Creating this name-completion pair allows the user the type 'Symposium' as a short-hand data entry that triggers the display 'Save the Whales Symposium' as a completion suggestion. This example illustrates how the Auto-Complete utility 100 may be used as a user-defined keyboard accelerator." Ex. 1007 at 12:26-36; Ex. 1002 at ¶152. |

| 16. A method according to claim 12, wherein the information source is available over a network. | See reasoning for claims 7 and 12. Ex. 1002 at ¶61. |

| 19. A method according to claim 12, wherein the type of operation includes updating the document with information from the information source. | See reasoning for claims 11 and 12. Ex. 1002 at ¶61. |

Ground 4.   Claims 5, 6 and 15 are invalid under 35 U.S.C. § 103 over the references of Ground 1 in further view of Bonura.

Claims 5, 6 and 15 are invalid under 35 U.S.C. § 103 over Pandit and Luciw in

further view of Thomas Bonura and James R. Miller, "Drop Zones: An Extension

to LiveDoc," *SigCHI Bulletin*, vol. 30 no. 2, April 1998 ("Bonura") (Ex. 1006).

The Background and claim construction sections are incorporated in this Ground.

Bonura is an article published in the bulletin for the Association for Computing

Machinery's "Special Interest Group on Computer-Human Interaction"" also known as the *SigCHI Bulletin*, in April 1998. Bonura therefore qualifies as prior art under 35 U.S.C. § 102(a). Ex. 1002 at ¶¶153-155.

Like Pandit and Luciw, Bonura teaches a computer system for analyzing text in a document, and then allowing the user to take actions based on identified text. The process of identifying specific text in a document is based on the Macintosh LiveDoc system. Ex. 1002 at ¶156. As Bonura explains:

> **"LiveDoc** [6] is an extension to the Macintosh user experience that **allows documents to reveal structured information in such a way that it can be readily identified and used** to achieve specific actions. Various kinds of recognizers, including context free grammars, are used to describe the structures to be found; these structures can be made up of either a single lexical term (either a variable structure like a phone number, or a collection of static strings, like company names) or multiple terms (for instance, a meeting can be defined as a combination of date, time, and venue structures). **Small pieces of code can then be associated with each structure to instruct applications to carry out specific user actions on the discovered structures**- **perhaps to tell a telephony application to 'Dial this phone number.'** These actions can then be offered to users by **visually highlighting the discovered structures** and **attaching pop-up menus** to the highlights." Ex. 1006, p. 59, left column (emphasis added); Ex. 1002 at ¶156.

Bonura discloses that the information identified in a document can be a name,

44

telephone number (*see* quote above), an email address (Ex. 1006 at Fig 1 and caption, Fig. 3), etc. Ex. 1002 at ¶157.

Bonura describes extending the LiveDoc system with "Drop Zones." Ex. 1006, p. 60, left column. Drop Zones allows a user to make context-based decisions on the identified information. For example, Bonura discloses that Drop Zones can interact with an address book (contact database). The address book can be searched by Drop Zones to convert an identified phone number into an email address in the address book. The email address, for example, can then be used to send an email. Ex. 1002 at ¶¶158-159. This is shown in Fig. 2 of Bonura, reproduced here with red annotations:

In Fig. 2 (below), the name "Tom Bonura" (red box at top) has been identified by the system using text analysis. A user takes advantage of this analysis by initiating an email to Tom Bonura (red box at bottom: "Send email"). Behind the scenes, the Drop Zones system queries the address book, using the identified name, to come up with an email address stored in the address book. Ex. 1002 at ¶¶160-162.
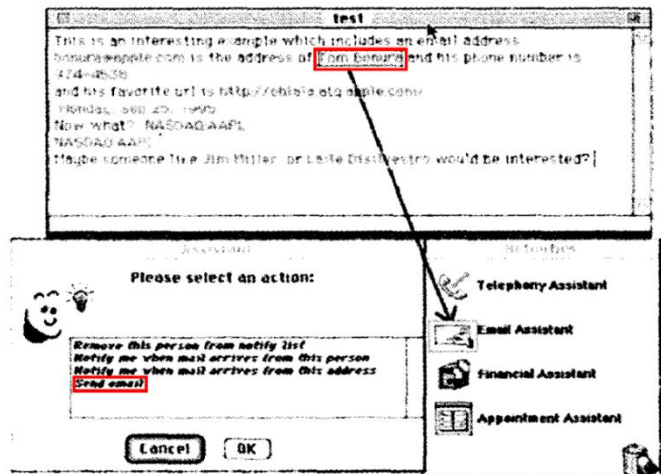
Bonura discloses that virtually any action could be attached to the identified

text. Ex. 1002 at ¶161. For example, Bonura states that:

> "[T]hinking about [a name and phone number] from the perspective of
> an address book **easily leads to the interpretation, 'Add this person
> to my address book**.'" Ex. 1006, p. 60 (left column) (emphasis
> added); Ex. 1002 at ¶161.

Bonura teaches certain natural actions to take. For example, when contact

information has been found, Bonura notes that "thinking about this information

from the perspective of an address book easily leads to the interpretation, 'Add this

person to my address book.'" Ex. 1006 at 60; Ex. 1002 at ¶161.

1.   Reasons for combining Pandit, Luciw and Bonura

Claim 5 is dependent on claim 12, adding the limitation of: "allowing the user

to cause storage of at least some of the selected textual information in the

information source." **Claim 6** is dependent on claim 5, and further specifies

"wherein, when the selected textual information includes a name and an address

and the information source does not include the name, allowing the user to cause

storage comprises allowing the user to cause storage of at least part of the selected

information in the information source as a new contact." **Claim 15** is dependent on

claim 12, and combines the limitations of claims 5 and 6. Ex. 1002 at ¶61.

Bonura in combination with Pandit and Luciw renders claims 5, 6 and 15

obvious. Ex. 1002 at ¶¶163, 224-229. Luciw and Pandit do not expressly disclose

allowing a user, having identified a name and address <u>together</u> in a document, to

add a portion of the name and/or address to the address book (or other "information source"). However, claims 6 and 15 are essentially directed to the *content* of the information. Ex. 1002 at ¶¶224-225. From a content perspective, it was common sense that names and addresses were (and are) naturally used together (for example, in the U.S. Postal System). Ex. 1002 at ¶226. And each of Pandit, Luciw and Bonura handles multiple types of contact information, and places no restrictions on the content of the contact information. Pandit states, for example, that "there is no limit on the type of text which can be recognized by the invention and additional embodiments can recognize such classes of text as Uniform Resource Locators, nouns, verbs, **names, street addresses**, etc." Ex. 1004 at 2:27-32 (emphasis added). *See also* Ex. 1005 at cl. 9 ("**persons**, telephone numbers, dates, document names, account numbers, addresses, and access type; codes." (emphasis added)) and Bonura, Ex. 1006 at p. 60 (discussing "address books" and "proper names, e-mail addresses phone number, URL, date and stock market ticker codes"). Ex. 1002 at ¶227.

Moreover, Bonura expressly suggests that when contact information is identified, "[t]hinking about [it] from the perspective of an address book **easily** leads to the interpretation, '**Add this person to my address book**.'" Ex. 1006, p. 60 (left column) (emphasis added); Ex. 1002 at ¶228. The same interpretation would be present with any contact information identified in a document. This is an

express teaching that the addition of identified contact information to the information source was obvious in the relevant timeframe. Ex. 1002 at ¶228.

It would further have been obvious to modify Luciw and Pandit to add part of an identified name and address to an information source containing contact information (e.g. Luciw's frame database) because this would have been the combination of known techniques for their known functions, without unpredictable results. *KSR,* 550 U.S. 398, 416-19 (2007); Ex. 1002 at ¶229.

Bonura is analogous art, because it is in the same field of endeavor as the '356 patent and would have been reasonably pertinent to the problems faced by Mr. Hedloy. Ex. 1002 at ¶230; *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1237 (Fed. Cir. 2010).

Ground 5. Claims 1, 7, 10, 12, 16 and 20 are invalid under 35 U.S.C. § 103 over Tso in view of Pandit.

Claims 1, 7, 10, 12, 16 and 20 are invalid under 35 U.S.C. § 103 over U.S. Patent No. 6,085,201 to Tso ("Tso")(Ex. 1009) in view of Pandit.

Tso issued on July 4, 2000. The application leading to the Tso patent was filed on June 28, 1996, and Tso is thus prior art under 35 U.S.C. § 102(e). The Background and claim construction sections are incorporated in this Ground.

Pandit describes a system for allowing a user to select text, analyzing the selected text to recognize a class of information such as an email address, a phone number or a street address. These classes of text can then be used to perform

48

operations. Pandit is described in detail under Ground 1.

Tso is a system for helping users write email messages. Ex. 1009 at Abstract. Tso's system allows a user to select text in an email document. After clicking or hitting "enter," the system parses the selected text to identify search terms, which are used to search a database. Ex. 1009 at 4:43-60; Ex. 1002 at ¶165. The database matches the search terms to email templates that differ depending on the content of the search terms. Ex. 1009 at 5:1-8 and 8:9-12; Ex. 1002 at ¶165. The email templates are text that can be inserted into the email document. Ex. 1009 at 6:66-7:6; Ex. 1002 at ¶165. Tso allows the user to add arbitrary templates to the system. Ex. 1009 at 7:14-25 and 8:5-14; Ex. 1002 at ¶166.

1. Reasons for combining Tso with Pandit

Tso and Pandit are fundamentally similar systems. Ex. 1002 at ¶231-232. Both patents teach systems that analyze text selected by a user. Ex. 1002 at ¶232. Both patents teach analyzing the selected text and doing something based on the content of the text selected. Ex. 1009 at 4:32-47. Ex. 1004 at 2:4-8. Ex. 1002 at ¶232. Both patents use DLL plugins to integrate with common text processing programs, noting that the kind of text-processing program is not of foremost importance. Ex. 1009 at 3:20-25; Ex. 1004 at 3:37-39 and 4:32-55; Ex. 1002 at ¶232. This means that the two systems are technically compatible from the outset. Ex. 1002 at ¶232.

Tso is a system for providing a context-aware email template for specific text

selected by a user. Ex. 1009, Abstract. Ex. 1002 at ¶233. Pandit is also based on

text selected by a user, but contemplates taking a broader array of actions than Tso.

Ex. 1004 at Abstract; cls. 1 and 6; 2:2-24. Ex. 1002 at ¶233. Pandit expressly

suggests, however, that its system can be used to create an email templating system

(like the one discussed in Tso):

> "Included in pulled-down Email menu 19 are such programs as a
> Writable Email or general address book database and **an EMail**
> **template and transmitting program**, **preferably automatically**
> **addressed** with the accented address recognized in the text, etc. Any
> other program related to EMail sending or address storage may be
> included as within the scope of this invention." Ex. 1004 at 2:56-63,
> (emphasis added). Ex. 1002 at ¶233.

Pandit also notes that its system can be used with many kinds of text processing

operations, including those operating in email programs:

> "The invention preferably includes as default operations such
> programs as spell-checkers, grammar-checkers, a thesaurus, a
> dictionary, execution of an EMail program to transmit the text,
> programs to store the text and any other programs relating to Words in
> general." Ex. 1004 at 3:27-33. Ex. 1002 at ¶234.

It would thus have been obvious to use Pandit's recognition of certain types of

contact information in Tso's system. Specifically, it would have been obvious to

use Tso's system to identify contact information in the document, and to insert

50

related contact information. Ex. 1002 at ¶235. Tso's system seeks to reduce the number keystrokes a user must enter to compose an email. Ex. 1009 at 6:25-37. Ex. 1002 at ¶236. Tso already suggests using selected text to locate templates having specific location information, such as "in the cafeteria" (Ex. 1009 at 6:24) or "the thirdfloor conference room" (*Id.*, 6:60-61). Ex. 1002 at ¶236. From there, it would not have been a great leap to selecting first contact information, and then inserting second contact information. This is, in fact, suggested by Pandit and Tso. Pandit discusses templates addressed to specific users (Ex. 1004 at 2:56-64) and Tso teaches "repetitively generat[ing] correspondence on the same subject." Ex. 1009 at 7:53-63; Ex. 1002 at ¶236. By providing templates with specific address information included, the purpose of Tso to reduce the number of keystrokes required to compose an email is served. Ex. 1009 at 6:25-37; Ex. 1002 at ¶237. Tso encourages the creation of new templates having arbitrary text content. Ex. 1009 at 7:14-25 and 8:5-14; Ex. 1002 at ¶237.

Furthermore, Tso was a known system, and Pandit's approach to identifying contact information and allowing the user to carry out operations thereon represented a known technique that could have been applied to Tso's system, without any unpredictable results. Ex. 1002 at ¶238. At the level of the claims of the '356 patent, the relevant field is predictable. *Id.* None of the '356 patent, Pandit nor Tso report any unpredictable results. *KSR Int'l Co. v. Teleflex, Inc.,* 550

U.S. 398, 416-19 (2007); Ex. 1002 at ¶238.

The combination would have been well within the ordinary skill in the art in the relevant timeframe. Ex. 1002 at ¶239. Both Tso and Pandit implement their systems in software DLLs that can be added. Tso notes that "[t]his type of software implementation is well known in the art of data processing, and thus is not described in detail herein." Ex. 1009 at 3:23-25. Ex. 1002 at ¶239. In particular, the state of the art was far more advanced than the disclosure of the '356 patent would indicate. Ex. 1002 at ¶239. The '356 patent, in fact, relies on prior art for enabling its techniques, thereby assuming that a person of ordinary skill could have written the requisite code to implement its system. *Id.*; *In re Epstein*, 32 F.3d 1559, 1568 (Fed. Cir. 1994) (lack of enabling disclosure supports prior art knowledge of a technique); Ex. 1002 at ¶239.

Tso and Pandit are analogous art, because both are in the same field and both would have been reasonably pertinent to the problems faced by Mr. Hedloy. Ex. 1002 at ¶240. *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1237 (Fed. Cir. 2010).

An element-by-element mapping of the claims noted above is provided in the following claim charts:

356 Claim	Tso Disclosure
1[a]. At least one non-transitory computer readable medium encoded with	Tso discloses software system for information handling in an email system (**document editing program**). Tso states that its email system provides all the standard email functions (Ex. 1009, 3:29-36), including text processing (Ex. 1009 at claim 6). Ex. 1002 at ¶170. Likewise, Pandit discloses that

instructions which, when loaded on a computer, establish processes for contact information handling, implemented by a document editing program running in the computer, the processes comprising:	its system "will benefit any application which displays text to a user, regardless of the origin of the text." Ex. 1004, 1:42-43. Ex. 1002 at ¶79. Tso's system is software running on a computer, and would have used a **computer readable medium**. Ex. 1002 at ¶¶168-169. Tso suggests a ROM, flash memory or diskette. Ex. 1009 at 7:64-8:4. Software causes a computer to implement a process. Pandit's software also runs on a computer readable medium. Ex. 1004 at 5:25-44; Ex. 1002 at ¶76.
[1b.] allowing a user to enter textual information into a document using the document editing program;	Tso teaches that the user can **enter text into an email editor**, e.g., to "compose an email." Ex. 1009 at 4:32-33; claim 6; 3:29-36; 6:25-27. *See also* Ex. 1004 at 1:42-43; Ex. 1002 at ¶¶170-172.
[1c.] displaying the textual information in the document electronically using the document editing program;	Tso teaches that the email program has all the standard features of an email program, which would **display text** as it is being composed. Ex. 1009, 3:29-36; Ex. 1004, 1:42-43; Ex. 1002 at ¶173. Furthermore, as discussed below, Tso allows a user to select a particular text string from an email document for further processing. Ex. 1009 at 4:32-47. The user has to be able to see the text to select it. Ex. 1002 at ¶174.
[1d.] allowing, in the document editing program, the user to select in the document at least a portion of the textual	Tso teaches allowing the user to **select in the document textual information** (while it is displayed): "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**. The particular method by which such a selection is made

information while the textual information is displayed;	will vary according to the user input device available to the user." Ex. 1009 at 4:32-47 (emphasis added); Ex. 1002 at ¶175. Pandit also describes that the user selects a portion of displayed text in a document: "Referring to FIG. 1a and FIG. 2, for example, a date 11 in text appearing on a video monitor is accented (step 21 of FIG. 2) for example by shading, underlining or pointing to and clicking on the text." Ex. 1004 at 2:4-8; Ex. 1002 at ¶82.
[1e.] following user selection of textual information in the document, analyzing, by the document editing program, the selected textual information 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;	Tso describes a process of **analyzing the selected text** to **identify keywords**. Tso states: "[O]nce the user makes a selection the user interface 2 of the e-mail application 20 will invoke the template engine 5 (step 230), passing the entire text message being edited by the user and the current cursor position to the template engine 5. Upon being invoked, the **template engine 5 analyzes the information passed by the e-mail application 20** to determine the portion of the text message for which a template is to be provided (step 231). According to one embodiment, the template engine 5 initially views the entire text message passed by the e-mail application 20 as a single data string. Then, using standard string processing techniques, the template engine 5 starts at the current cursor position and searches backwards in the text string until it finds a sentence-ending punctuation mark (i.e., period, question mark, exclamation point). The template engine 5 then designates the first word immediately following the punctuation mark as the beginning of the text string to be processed." Ex. 1009 at 4:43-60 (emphasis added); Ex. 1002 at ¶176. Tso teaches that one alternative architecture is to have the "template engine" be part of the email application (such that the analysis is done "**by the document editing program**"). Ex. 1002 at ¶177. Tso states: "[T]he template engine 5 and user interface 2 may be fully integrated into an e-mail application, providing a

	seamless set of text generating functions in a manner that is transparent to the end user." Ex. 1009 at 7:9-13. Ex. 1002 at ¶177.
	Pandit discloses having the application **analyze the selected text** to determine whether it is a **particular kind of contact information**. For example, Pandit states:
	"As shown in FIGS. 1c—1f, the invention is not limited to the recognition of dates in text and preferred embodiments of the invention can recognize e-mail addresses and telephone numbers. In fact, there is no limit on the type of text Which can be recognized by the invention and additional embodiments can recognize such classes of text as Uniform Resource Locators, nouns, verbs, names, street addresses, etc." Ex. 1004 at 2:24-32; Ex. 1002 at ¶85; *see also* cl. 6-7.
[1f.] 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, the operation comprising identifying at least part of the selected textual	Tso teaches providing an **input device** that triggers the analysis of the pre-selected text (configured :
	"[T]he user selects a text string to be processed, for example, by clicking-on it. **The particular method by which such a selection is made will vary according to the user input device** available to the user. For example, where the user has access to a laptop or other personal computer, the selection could be accomplished using a **mouse**. On the other hand, with a device having limited user interface capabilities, such as a Smartphone, the selection could be accomplished by appropriately positioning a cursor using a touch keypad and pressing an **'ENTER' key**." Ex. 1009 at 4:32-43 (emph. add.); Ex. 1002 at ¶178.
	The **input device** initiating the operation is **configured by the document editing program**. As explained in Tso:
	"In either case, **once the user makes a selection the user interface 2 of the e-mail application 20 will invoke the template engine 5** (step 230), passing the entire text message being edited by the user and the current cursor position to the template engine 5." Ex. 1009 at 4: 43-47 (emphasis added); Ex. 1002 at ¶178.

information to use as a search term in order to find second information, of a specific type or types, associated with the search term in an information source external to the document;	When the command is given, Tso teaches **analyzing the selected text to provide keywords**, as discussed above under element [1e.]. Ex. 1002 at ¶176. Tso's analysis results in a set of keywords (**part of the selected textual information**) that is used as a **search term** to find predefined templates (**second information).** Tso states: "Once the text string to be processed is identified, the template engine 5 decomposes the text string into <u>search words</u> 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 <u>uses the extracted words to search the set of predefined templates stored in the template database 4</u> (step 232)." Ex. 1009 at 5:1-8 (emphasis added); Ex. 1002 at ¶179. The template (**second information) is associated with the first information** (search terms) by the term's occurrence in the template and a weighting score. Ex. 1009 at 5:7-17; Ex. 1002 at ¶180. The template database (**information source**) is **external to the email document**, and can be external to the entire email application. Ex. 1009 at 3:49-54; Fig. 1.; Ex. 1002 at ¶181. Tso teaches, for example, that the template database can be located across a network. Ex. 1009 at 8:9-12; Ex. 1002 at ¶182. Pandit further teaches **recognizing particular types of contact information**, and taking actions **based on the type of information found**. Pandit summarizes a portion the method in claims 1 and 7 as: "(3) recognizing the selected text as belonging to the predetermined class if the format of the selected text matches the predetermined format; and (b) performing an operation associated with the predetermined class using the recognized text as a parameter. . . . 7. The method of claim 1, wherein the text is one of a date, name, telephone number, telefax number, e-mail

	address, and Uniform Resource Locator." Ex. 1004 at cls. 1 and 7; Ex. 1002 at ¶87.
[1g.] after identifying at least part of the selected information to use as a search term, and in consequence of receipt by the document editing program of an execute command from the input device, performing the operation, wherein the operation further comprises: causing an electronic search in the information source, by an information management program external to the document editing program, for the search term in order to find whether the search term is included in the information source; and	As described above under element [1f.], Tso's template engine uses search terms to search a template database to retrieve second information. Ex. 1002 at ¶179. This happens as a consequence of the **document editing program receiving an execute command** (from its own user interface). Ex. 1009 at 4: 43-47; Ex. 1002 at ¶178.

The search is conducted by the template database, which can be **external to the email program**. Tso states:

"The template database 4 may be viewed as a sub-module of the template engine 5, or as a **separate data structure with which the template engine 5 interacts**." Ex. 1009 at 3:50-54 (emphasis added); Ex. 1002 at ¶181-182.

The Tso search examines **whether keywords** extracted from selected text strings **are stored in the template database** (see element [1f]). Tso states:

"Ideally, the template engine 5 employs a 'blind' text string match when comparing the extracted words to the stored keywords. The template engine 5 is therefore completely language independent, again providing maximum flexibility to system users and application programmers." Ex. 1009 at 5:18-22; Ex. 1002 at ¶183. |
| [1h.] performing | Tso teaches that **if a template match is found**, the |

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, 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.	template can be **inserted** directly into the email document. Tso states: "[T]he additional text generated by the template engine 5 is passed to the e-mail application for **insertion in the message being composed**. The user interface 2 could be programmed to **automatically insert the generated text** at the end of the message text, or alternatively could prompt the user to place the cursor at a particular location where the text is to be inserted." Ex. 1009 at 6:66-7:6 (emph. add.); Ex. 1002 at ¶184. Tso teaches that the particular template used is dependent on whether search terms are found in the information source. As Tso explains: **"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 template database 5. The template with the highest total weight value is then designated as the most appropriate template for the text string being processed." Ex. 1009 at 5:11-17 (emphasis added); Ex. 1002 at ¶185.

7. At least one non-transitory computer readable medium according to claim 1, wherein the instructions establish processes wherein the information source is available over a network.	Tso teaches that its template database can be located over a network. Ex. 1009 at 8:9-12; Ex. 1002 at ¶186.

10. At least one non-transitory computer readable medium according to claim 1, wherein the	Tso teaches that its system can be applied to any application that processes text: "Likewise, the template engine of the present invention is not limited to use only in electronic messaging applications. The present invention may be readily applied to any type of text processing application, including standard word processing applications." Ex. 1009 at 7:53-57; Ex. 1002 at ¶187-189.

instructions establish processes wherein the document editing program is a spreadsheet program.	Likewise, Pandit teaches that:
	"[t]he present invention will benefit any application which displays text to a user, regardless of the origin of the text." Ex. 1004 at 1:42-43; Ex. 1002 at ¶91.
	As admitted in the '356 patent, spreadsheets such Microsoft Excel process text. Ex. 1001, 1:40-45; Ex. 1002 at ¶188.
	Both Tso and Pandit teach implementing their systems as DLLs. Ex. 1004 3:37-39; Ex. 1009 at 3:20-28; Ex. 1002 at ¶91,84, 189. Pandit teaches that:
	"Conventionally, a software program must be entirely recompiled for its functionality to be increased or its operations changed in any manner. The present invention, however, is highly modular and allows libraries to be added at will and additional features to be added to libraries without recompiling." Ex. 1004 at 4:32-37; Ex. 1002 at ¶84.

Claims 12 and 20 are identical to claim 1, except that they are directed to a method (claim 12) and apparatus (claim 20) instead of a computer-readable medium (claim 1). Similarly, claim 16 has the same content as claim 7, except that it depends from claim 12. Ex. 1002 at ¶¶61-64. Claims 12, 16 and 20 are thus obvious for the same reasons as claim 1, because the computer-readable medium of claim 1 causes the method of claims 12 and 16 to be carried out in the apparatus of claim 20. Ex. 1002 at ¶¶61-64; *see also* Ex. 1013.

CONCLUSION

For the foregoing reasons, the Petitioners respectfully request that Trial be instituted and that claims 1-20 be canceled.

Respectfully submitted,

Dated: Feb. 20, 2014   By: /Matthew A. Smith/
                                                         Matthew A. Smith
                                                         Registration No. 49,003
                                                         Counsel for Petitioner
                                                         Google Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Petition for Inter

Partes Review, together with all exhibits and documents, was served on February

20, 2014 by electronic mail (**by prior agreement with the Patent Owner**) to the

attorneys of record at

SUNSTEIN KANN MURPHY & TIMBERS LLP
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by transmitting the documents to the attorneys' email addresses at:

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By: /Matthew A. Smith/
Matthew A. Smith
Registration No. 49,003
Counsel for Petitioner

Exhibit 6FF

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: May 7, 2007   Examiner: Pham, Khanh B.
For: Method, System and Computer Readable Medium for Addressing Handling from an Operating System

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

REQUEST FOR CONTINUED EXAMINATION (RCE)
(37 C.F.R. § 1.114)

1.   Applicant hereby requests continued examination, in accordance with 37 C.F.R. § 1.114, for the above identified application.

TIME REQUEST IS BEING MADE

2.   This request is being submitted:

    i.   Prior to abandonment of the application
    ii.
ENCLOSURES

3.   Enclosed herewith is:

    An amendment

FEE FOR REQUEST (37 C.F.R. § 1.17(e)).

4.   This application is on behalf of small entity (and status is still as small entity).

    Continued Prosecution Request Fee: 465.00

FEE FOR CLAIMS

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

	(Col.1) CLAIMS REMAINING AFTER AMENDMENT	(Col. 2) HIGHEST NO. PREVIOUSLY PAID FOR	(Col. 3) PRESENT EXTRA		RATE		ADDIT. FEE SMALL ENTITY
TOTAL	30	– 70	= 0	x $	30.00	= $	0.00
INDEP.	7	– 9	= 0	x $	125.00	= $	0.00
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				+ $	225.00	= $	0.00
					TOTAL ADDIT. FEE	$	0.00

No additional fee for claims is required.

EXTENSION OF TIME

6. The proceedings herein are for a patent application, and the provisions of 37 C.F.R. § 1.136(a) apply.

    Applicant petitions for an extension of time, the fees for which are set out in 37 C.F.R. § 1.17(a)(1)-(4), for two months:

    <div align="center">Fee: $280.00</div>

    If an additional extension of time is required, please consider this a petition therefor.

    An extension for one month(s) has already been secured, and the fee paid therefor of $65.00 is deducted from the total fee due for the total months of extension now requested.

    <div align="center">Extension fee due with this request: $215.00</div>

TOTAL FEE(S) DUE

7. The total fee(s) due is/are:

Continued Prosecution Fee (Section 1.17(e))	$465.00
Fee(s) for additional claims (Section 1.16(b)-(d))	$0.00
Extension of time fee (Section 1.17(a)(1)-(4))	$215.00
Total Fee(s) Due:	$680.00

PAYMENT OF FEE(S) DUE

8.   Please pay the fee(s) for this continued examination application as follows:

Charge Account 19-4972 the sum of $680.00.

Please charge any required additional fee(s) for § 1.17(e), § 1.16(b)-(d) and/or § 1.17(a)(1)-(4) to Account 19-4972.

INVENTORSHIP

9.   This application as amended names as inventors the same inventors as previously designated for the claims.

Date: November 3, 2011   /Bruce D. Sunstein, #27,234/

_____
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Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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		

Third Supplement to Response H

Dear Sir/Madam:

In response to the Final Office Action dated June 3, 2011, the Applicant submits the following amendment and remarks.

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.

1

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions and listings of claims in the application, changes are marked with respect to Response G, filed April 22, 2011, which sets forth the last entered amendment.

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;

analyzing in a computer process textual information in a document ~~electronically displayed~~ configured to be stored for later retrieval to identify a portion of ~~that information~~ the document 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:

2

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

(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; and

(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;

wherein the computer implemented method is configured to perform both each one of action (i), and action (ii), and action (iii) 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)

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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;

analyzing in a computer process textual information in a document electronically

displayed configured to be stored for later retrieval to identify a portion of that information

the document 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:

<p style="text-align:center">5</p>

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

(i) initiating an electronic search 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; and

(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;

wherein the computer implemented method is configured to perform both

each one of action (i), and action (ii), and action (iii) 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

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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.

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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;

analyzing in a computer process textual information in a document

electronically displayed configured to be stored for later retrieval to identify a

portion of that information the document 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:

8

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

(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; and

(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;

wherein the computer implemented method is configured to perform both

each one of action (i), and action (ii), and action (iii) 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).

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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.

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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.

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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

13

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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.

14

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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.

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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

17

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.

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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.

19

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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)

1

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

REMARKS

1. Amendments and Support

Claims 119, 121-125, 127-131, and 133-151 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 152-154 are cancelled and claims 119, 125, and 131 are amended. Claims 155-157, sought to be entered in the Supplement to Response H, filed August 16, 2011, were not entered and are not sought to be entered herein. No new matter has been added to the claims with these amendments.

Claims 119, 125, and 131 have been amended to require that the analyzing process (appearing, for example, in the second limitation of the claims 119 and 125) is of "textual information in a document ~~electronically displayed~~ configured to be stored for later retrieval". This limitation is similar to the limitation that would have been added by the second supplement to Response H filed September 9, 2011. The term "document" is well understood in the application and 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 further distinguish the Goodwin reference, the amendment herein requires "a document configured to be stored 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^{TM} 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^{TM} document is configured to be stored for later retrieval. Also, Figs 3, 4, and 5, illustrating an embodiment of the invention, show a document in Microsoft Word^{TM} with its well-known user interface including icons for saving the

21

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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.

Claims 119, 125, and 131 have been amended by clarifying that "initiating an

electronic search in the contact database for the first contact information" occurs "while it

is electronically displayed" whereas formerly the "displayed" requirement occurred in the

limitation directed to the analyzing process. Support for this amendment occurs variously

in the application, including, for example, Figs. 3 and 4, and the discussion of these

figures from page 10, line 22 through page 11, line 3, where it can be seen that the name

(constituting the first contact information in the claim) is displayed while the program

searches the database for that name in order to obtain the second contact information

(which is shown inserted in Fig. 4). To similar effect, for example, see Figs. 14 and 15,

and discussion on page 16, lines 1-11, where there is also referenced the logical flow

diagrams of Figs. 1 and 2.

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.

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

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

to a contact database that can also be separately accessed and edited by a user." The

claims further require "analyzing in a computer process textual information in a

document configured to be stored for later retrieval to identify a portion of the 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." It is required that the method is configured to perform each one of action (i),

action (ii), and action (iii) using the first contact information previously identified as a

result of the analyzing, although this claim limitation does not require performing more

than one of them.

The first potential action includes "(i) initiating an electronic search in a contact

database for the first contact information while it is 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." The second potential action includes "(ii)

initiating electronic communication using the first contact information." The third

potential action includes "(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 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."

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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 fail to meet the limitations of independent claims 119, 125, and 131.

I.   **The Cited References Fail to Disclose or Suggest the Claim Requirement 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.**

The claims 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". The cited references lack any disclosure of a feature 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.

Goodwin utterly lacks any disclosure of such a feature. The Goodwin reference is directed to a user-initiated process for searching in an address book. In Goodwin, the user enters a contact information as a search string into a search screen and the search string is used to search an address book. We begin with the problem that Goodwin's user-entered search string fails to correspond to first contact information that results from analyzing displayed information in the claim. Even if such a requirement were satisfied, however, (which it is not) Goodwin teaches only about searching, and not about using the string from the search field to allow the user to make a decision whether to store at least a part thereof as a new contact or to update an existing contact.

24

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

Although the Miller reference describes an action by which a telephone number can be added to an electronic telephone book (Figs. 4 and 7) or an e-mail can be added to an e-mail address book (Fig. 4) or an address can be added to an address book (Fig. 4), the electronic telephone book, the e-mail address book, and the address book are distinct entities, whereas the claims require an integrated contact database. In particular, pursuant to the claims, 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 e-mail address."

Furthermore, although Miller describes an action by which a telephone number can be added to an electronic telephone book or an e-mail can be added to an e-mail address book or an address can be added to an address book, there is no disclosure or suggestion in Miller of a feature allowing the user to *update* an *existing contact* in the contact database, as required by the claims. For at least these reasons, the claims are patentable over the combination.

II. **The rejection fails to address the claim limitation of searching in a contact database for first contact information identified by analyzing the document.**

The independent claims 119, 125, and 131, as amended herein, require "(i) initiating an electronic search in the contact database for the first contact information while it is displayed in order to find whether the first contact information is included in the contact database". Miller lacks a contact database as defined by the claims herein, and

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

Miller fails to disclose or suggest searching in a contact database for first contact information.

Goodwin therefore is the only one of the two references cited in the rejection to be concerned with searching at all, and Goodwin fails to disclose or suggest the claim requirement of analyzing a document to identify first contact information. Goodwin furthermore fails to disclose or suggest "analyzing …to identify a portion of the document" because the user types the search criteria into the search box, so there is no need for the Goodwin system to identify a portion of the document. In addition, and as recognized by Examiner Pham in in his Office Action dated 06/03/2011 on page 4, Goodwin fails to disclose or suggest that such analysis is done "without user designation of a specific part of the textual information to be subject to the analyzing" because again, in Goodwin the user designates the textual information to be searched by typing it into the search box. Because Goodwin fails to disclose or suggest these claim limitations, it most assuredly fails to disclose or suggest searching in a contact database for the first contact information thus identified.

Consequently, for these reasons among others, the rejection fails to meet the claim requirement of "(i) initiating an electronic search in the contact database for the first contact information while it is displayed in order to find whether the first contact information is included in the contact database".

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

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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. 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. In an attempt to get around this feature of

Goodwin, 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 to initiate a search query. Indeed,

the Goodwin reference explicitly states its objectives:

> It is therefore an objective of the present invention to provide a
> user an efficient search method whereby he does not have to remember the
> exact information that he wants to search.
> It is therefore yet another objective of the present invention to
> enable a user to input different parts of data that he remembers with
> respect to a person, company, telephone etc. and be able to retrieve an
> entry that provides him with all the entered data that relates to that entry.
> It is yet another objective of the present invention to provide a
> search, in the case of a name search, which is not dependent on whether
> the first name or surname of a person to be searched is input, or whether
> some of the letters have been capitalized.

Goodwin, col. 3, lines 1-15.

These objectives pervasively underlie the Goodwin disclosure. The user must

enter data to trigger searching based on user-specified criteria. For example.:

> 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

27

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

> 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). 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" 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 objectives and

technology. It is impossible to have the user 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

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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, let alone a search for contact

information identified from the document. 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.

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

IV. 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 (*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. 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

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

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 is identified – using criteria set by the system with no user say at all. 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.

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.

Application Serial No. 11/745,186
Attorney Docket No. 3324/103

The examiner is invited to call the undersigned if anything remains to be done to

achieve allowance of the application.

Respectfully submitted,

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03324/00103 1539203.1

32

Exhibit 6GG

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

Samsung Electronics Co., Ltd.,

Petitioner,

v.

Arendi S.A.R.L.,

Patent Owner.

_____

Case No. IPR2014-00214

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	Arendi Exhibit 2001, Third Supplement to Response H, filed November 3, 2011, for Serial No. 11/745,186, the application for the '993 Patent

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 Petitioner Samsung

("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

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, Petitioner has failed to meet its 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.
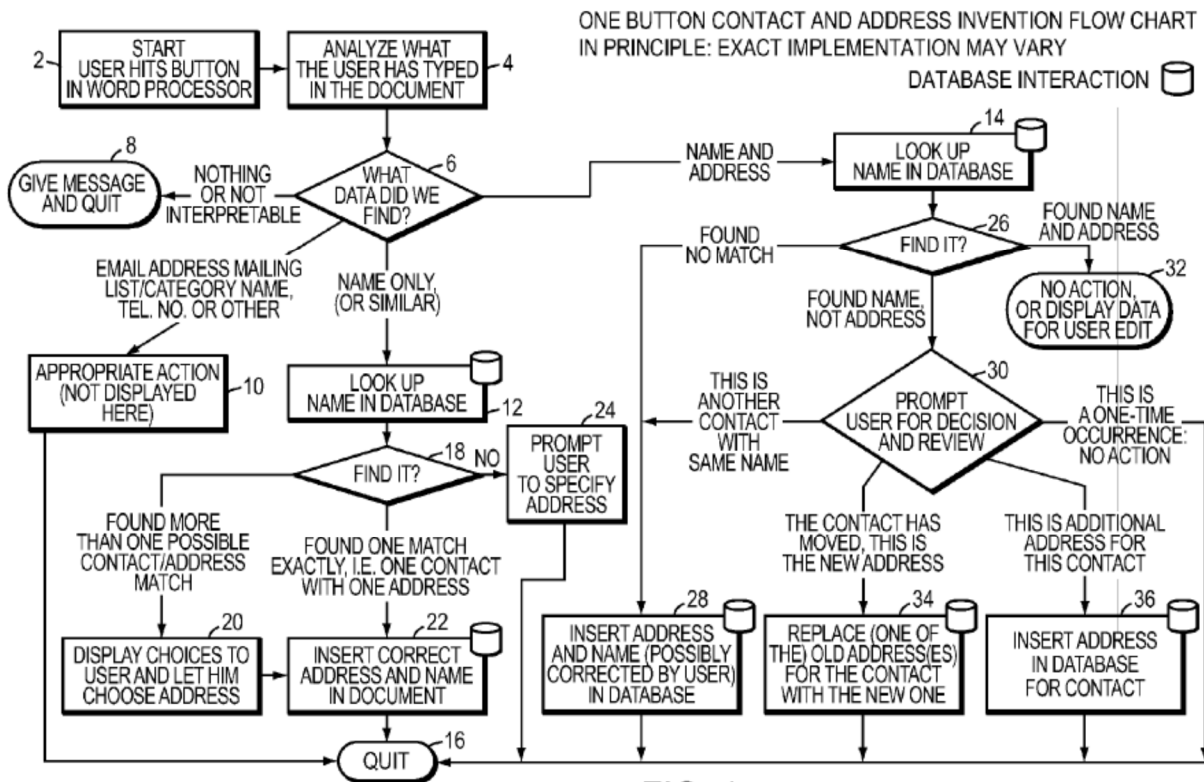
FIG. 1

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

2

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.
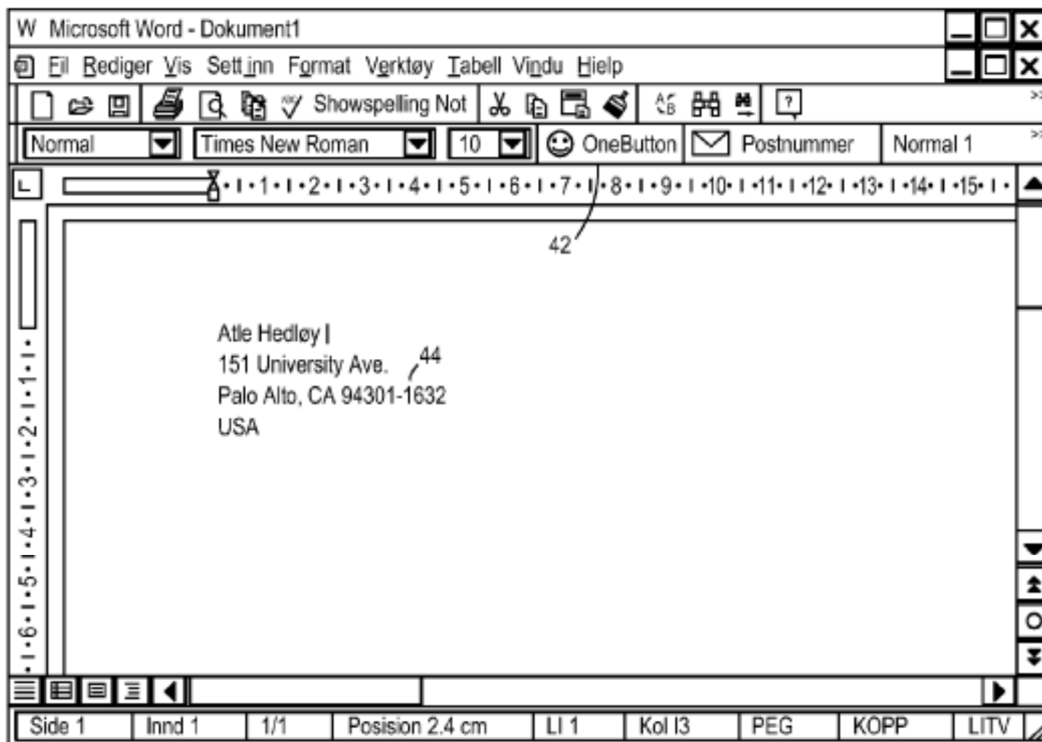
FIG. 4

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.

3

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.

4

Modify Contact's Address

70 — The contact: Hedloy, Alte already exists in the contact register with the following address:

72 —
Home address:
222 222 5th Ave.
New York, NY 10028

This is another contact, I will:
74 — ○ Add a new contact with the same name

This is the same contact. I will:
76 — ◉ Change the current address in the contact register
78 — ○ Use the above address in my Word document
80 — ○ Add a new address to the contact

Use address type: Business ▼ —54

OK   Details...   Cancel
56   58   60

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

5

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:

7

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.
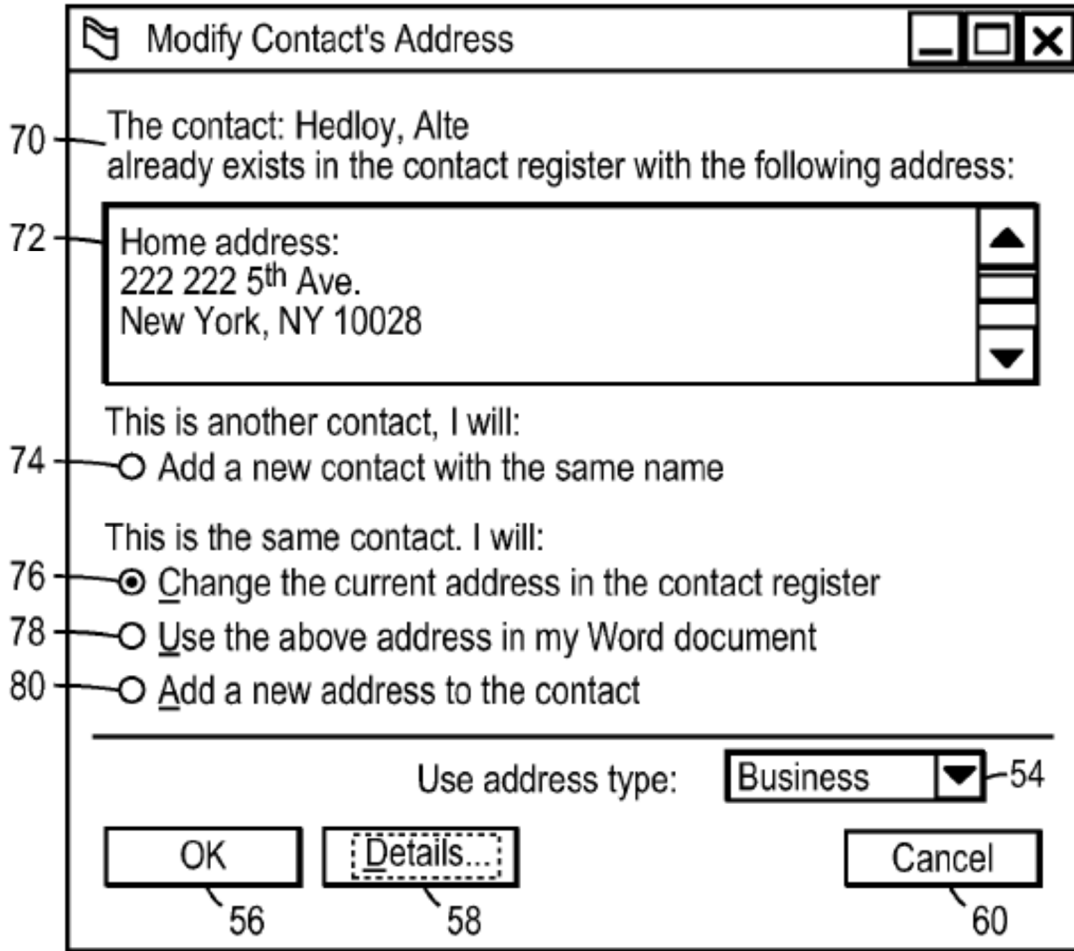
FIG. 9

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

9

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.

For these reasons, "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

10

a choice between competing alternatives of storing a new contact or updating an

existing contact.

IV.   OVERVIEW OF THE PRIOR ART

A. Overview Drop Zones

Drop Zones, Exhibit 1003, 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 1003, 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", Exhibit 1005),

appearing in the same issue of SIGCHI Bulletin as their Drop Zone article, 30

SIGCHI Bulletin No. 2, 53-58; 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 1003, 30 SIGCHI Bulletin No. 2 at

60. These identified "structures" are shown in the LiveDoc window as

highlighted. *Id.* Similarly in Figure 2 (reproduced below), which illustrates "A

11

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 select a

structure in a LiveDoc window. *Id*.
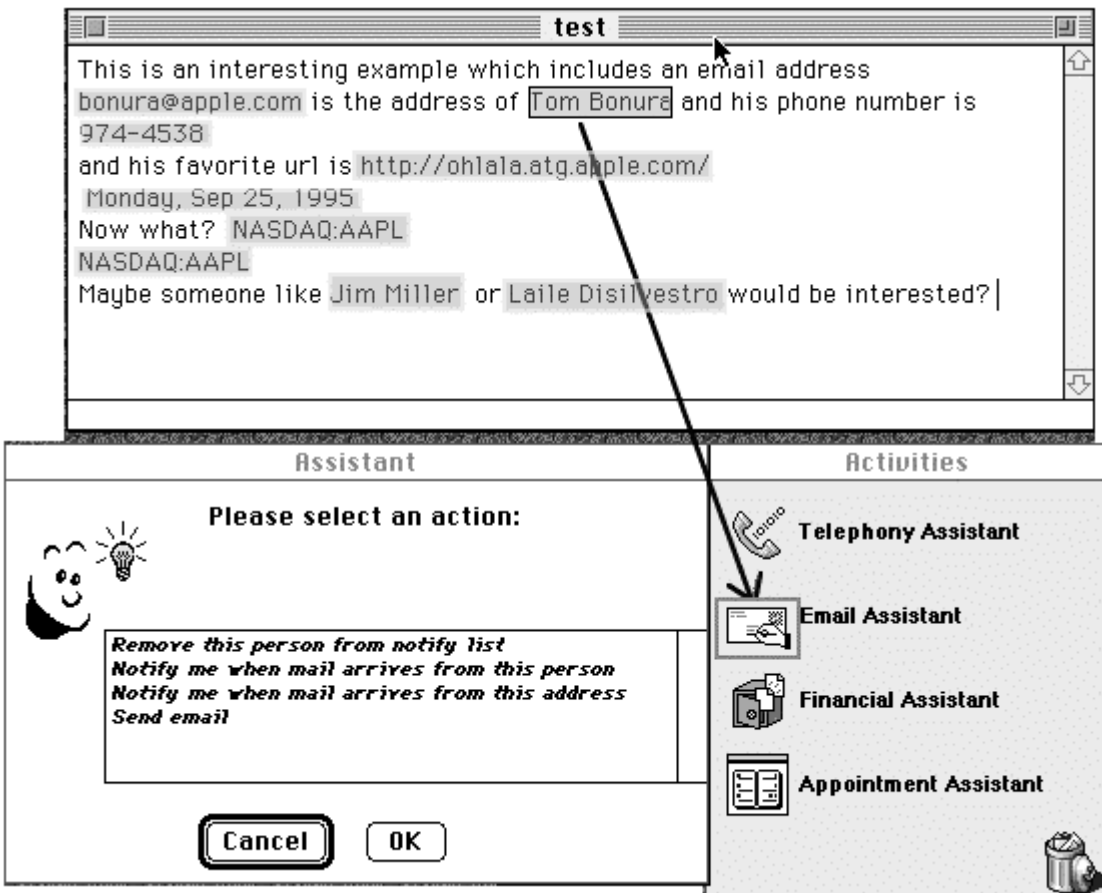
Figure 2: A user interaction with Drop Zones.

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 1003, 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 1003, 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 1003, 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 1003, 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. Exhibit 1005, LiveDoc article, 30 SIGCHI

Bulletin No. 2 at 55-56.
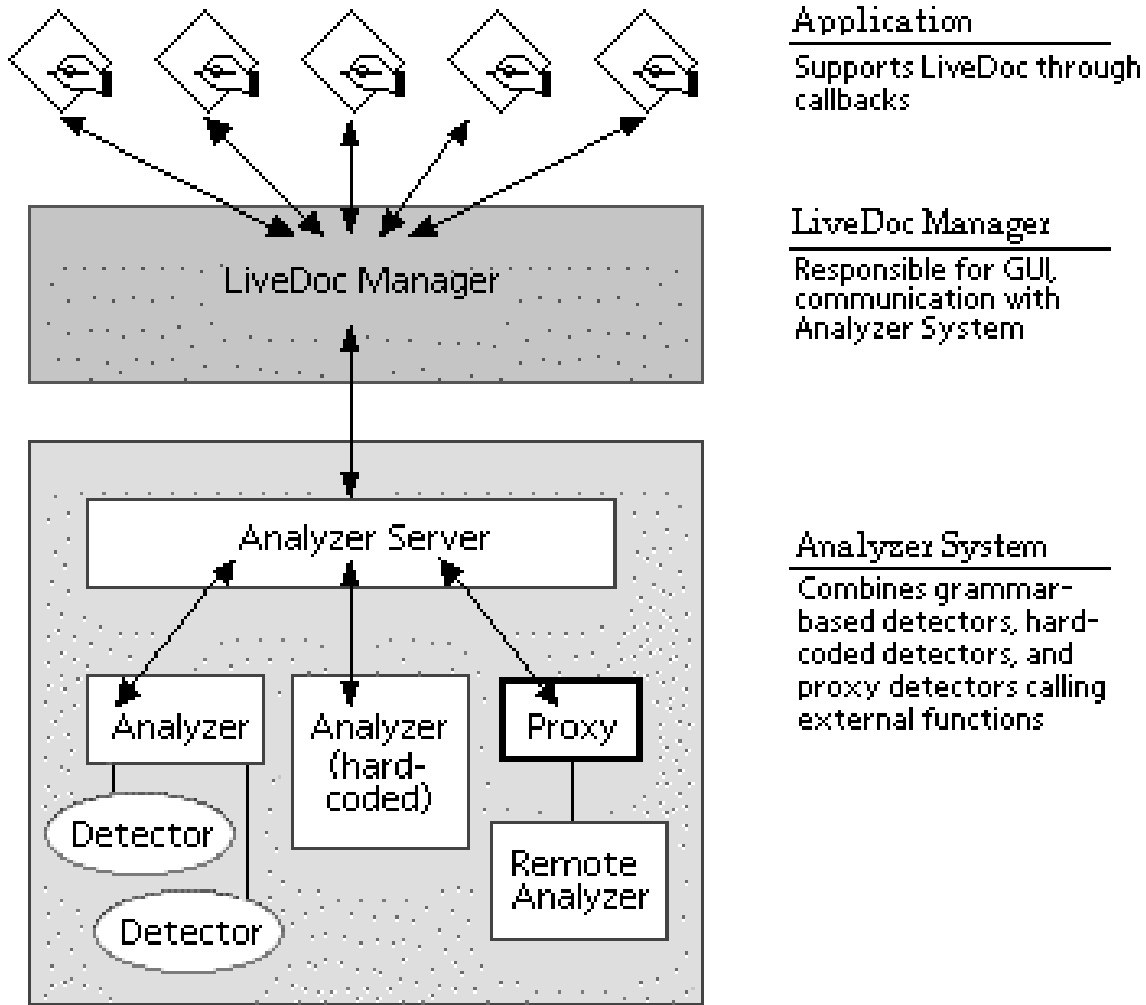
Figure 3: The high-level LiveDoc architecture.

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 1005, 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

15

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 1005, 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 Pensoft

The Pensoft reference is a user manual for software, for personal information management, called "Perspective": "Perspective can help you manage

16

your schedule, tasks, contacts, notes, and other important information. This

chapter explains how to use the Handbook, the basic reference source for using

Perspective." Pensoft, 1.

The Perspective software described in the Pensoft reference is designed for

computers that run the PenPoint operating system. *Id*. (According to Diana

Cohen, whose declaration is an exhibit of the Petitioner, "Perspective was meant to

be used with pen-based computers that run PenPoint, an operating system created

specifically by GO Corporation for pen-based computers such as ones based on

AT&T's Hobbit microprocessor. One such computer was later marketed by AT&T

under the name of the EO Personal Communicator." Cohen Declaration, Exhibit

1013, at 1.)

The Perspective software described in the Pensoft reference causes storage

of contact information for individuals and companies so that the information can

be seen as an Address Book. Pensoft, 9. Similarly the Perspective software causes

storage of calendar information that can be seen as a Day Planner and as a Month

Planner. Pensoft, 15-16. The Perspective software also supports To Do List and

Notes views. Pensoft, 6, 14.

The term "document" has a unique meaning in the Pensoft reference, and

that term is used to describe the template by which information is entered into the

17

Perspective system and by which it can be viewed; moreover, information about

any "item" in the Perspective system can also be viewed using a "profile":

> Each item has a profile. Profiles are forms which display all the
> details for an item. You can open the profile for any item displayed in
> any Perspective document.

Every item entered into a Perspective document is stored in a

ProfileBook. Each document is connected to a specific ProfileBook

which serves as a central storage place for your information. This

allows several documents to display the same items. For example, the

Day Planner and the Month Planner can both show your

appointments. The Address Book and the Company List both show

companies.

> Because documents share a single ProfileBook, details changed
> in one document are changed in all documents, so your information is

18

always consistent. For example, rescheduling an appointment in the
Day Planner reschedules it in the Month Planner. Updating a
company's address updates it in all Perspective documents.

Most people use a single ProfileBook, which contains all of
their personal information. You may create additional ProfileBooks,
each of which is a separate storage place for information. Pensoft
recommends that you keep all of your information in one ProfileBook.

Pensoft, 9-10.

This passage confirms the point made at the beginning of this discussion of

the Pensoft reference, that the Perspective software described in Pensoft is personal

information management software that provides a database for that purpose. As a

result, it is a property of the Perspective software that when a detail, stored in the

database, that appears in one form is changed, then the detail is changed when

viewed using any other form as well: "Because documents share a single

ProfileBook, details changed in one document are changed in all documents, so

your information is always consistent." *Id*.

This passage points out another characteristic of the Perspective software,

namely, that the term "document" used in the Pensoft reference has a particular

meaning. Specifically the term "document", as used in the Pensoft reference, is

described on page 8:

Within Perspective[,] information is displayed in documents. A
document is like a predesigned piece of paper with areas to hold a

particular kind of information. Each document gives you a different view of your information.

Documents are collected in a notebook. Perspective comes in its own notebook, the Perspective Notebook, with documents which have been set up for you. For more information on notebooks, see Using PenPoint.

The Perspective Notebook contains six standard documents:

• Day Planner,

• Month Planner,

• Address Book,

• To Do List,

• Topic Index, and

• Note Index

You can also choose documents from the Additional Documents section of the Perspective Notebook. You can use any of the documents as they are, change them, create additional documents, or remove unneeded documents. For more information on the documents provided in the Perspective Notebook, see Chapter 2, "Your Perspective Notebook" on page 13.

Pensoft, 8.

The passages on pages 8 and on 9-10 quoted above show that the Perspective software has six standard "documents", including Day Planner, Month Planner, Address Book, To Do List, Topic Index, and Note Index. Information stored by Perspective is displayed in "documents". A document "is like a predesigned piece of paper with areas to hold a particular kind of information."

20

Each document provides "a different view of your information". Moreover, changing a detail in one of the documents causes a similar change in all of the other documents.

Because (i) the Perspective software causes "your information" to be stored and retrieved, (ii) Perspective's "documents" provide different views of such information, and (iii) Perspective's "document is like a predesigned piece of paper with areas to hold a particular kind of information", the Perspective software implements storage of personal information in a database, and each "document" is a template that provides a defined view of selected fields of the database. The content of a field of the database will change in a first "document" (*i.e.*, view) whenever the content is modified in any other "document" (*i.e.*, view). Consequently, the word "document" has a meaning different from a conventional document in which textual information can be stored for later retrieval. In Perspective, the textual information is not in the "document" but rather in fields of the database. A "document" of the Perspective software provides a view into the database, and any information placed into the "document" by a user is stored in the database and is subject to change whenever it is changed even via another "document". With the Perspective software, one cannot therefore save textual information in a "document" and expect that on retrieval of the same "document",

21

the same information will appear, because that information may have been changed via another "document".

When contact information is entered into the Perspective system, the user is required to tell the system precisely what type of information is being entered, in that there are specific fields by which name, business phone, address, must be entered: "When you enter information in different columns along the row, you are entering details for the item. For example, when you write in the Address Book, you enter each detail about the person, such as name, address, city, state, and business phone number in a different column." Pensoft, 27.

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

Petitioner has failed to show that any prior art alone or in combination addresses 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 (and the ability to perform all three of them) 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 Petitioner 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". Pensoft, relied up by Petitioner for this limitation, fails to meet the claim limitation, because it fails to disclose or suggest presenting to the user a choice between competing alternatives of storing a new contact or updating an existing contact.

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, 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 Pensoft references relied upon by the Petitioner in Ground 1 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

24

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 1003, as meeting this limitation.

Corrected Petition, 34. Drop Zones, however, fails to meet this limitation, which,

as we have stated, 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. For the required input device, the Petitioner

relies on the E-mail Assistant in Drop Zones, whereby a user can drag and drop the

identified contact information to invoke the functionality:

25

Drop Zones discloses that, after the user drops a recognized name on the E-mail Assistant, the user is presented with a number of actions, such as "send email", from which the user may choose. *See* Drop Zone[s], p. 61, col. 1, ¶1 and Fig. 2. As shown in Fig. 2 of Drop Zones, an "OK" button is provided, which under the BRI as explained in the specification of the '993 patent is an "input device." After the user clicks the "OK" button (single execute command from the input device), Drop Zones carries out the selected functionality such as, e.g., sending of the email message, without any further action involving the user. Drop Zones, Fig. 2 and p. 61, col. 1, ¶1. Similarly, dropping recognized name or button on the E-mail assistant initiates search in an address book application. Drop Zones, p. 61. Such an address book application is Pensoft, which allows the user to store and update contact information. Pensoft, p. 17.

Corrected Petition, 30.

Assuming, as the Petitioner has asserted, that the "OK" button in the Assistant window, displayed following the user's dropping a recognized name in E-mail Assistant, is the input device, then although an execute command from that device is *necessary* to cause the performing, 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 1003, is an "extension of LiveDoc". (See Title of article: "Drop Zones / An Extension of LiveDoc" in

26

Exhibit 1003.) Specifically, "[a] Drop Zone provides users with an interface for

managing LiveDoc objects in the context of a set of typical user tasks." Exhibit

1003, 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. Thus in explaining Figure 1, the Drop Zones 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 an article by Miller and

Bonura (the same authors as of Drop Zones) entitled "From documents to objects:

An overview of LiveDoc", appearing immediately before the Drop Zones article in

the same issue of SIGCHI Bulletin as their Drop Zones article, 30 SIGCHI Bulletin

No. 2, 53-58.

Operation of the Drop Zones system explicitly uses LiveDoc 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

27

stock market ticker codes." Exhibit 1003, 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 select one or more structures 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". LiveDoc article, Exhibit 1005, 30 SIGCHI Bulletin No. 2

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. LiveDoc article, 30 SIGCHI Bulletin No. 2 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." LiveDoc article, Exhibit 1005, 30 SIGCHI Bulletin No.

2 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 Petitioner—the E-mail Assistant in 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 these reasons, Ground 1 fails to make a *prima facie* case for obviousness of claims 1-24.

C. Because none of LiveDoc, Drop Zones or Pensoft 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 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, and 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 1 fails to identify anything in LiveDoc, Drop Zones or Pensoft that

discloses or suggests this claim limitation. The Petitioner relies on Pensoft for this

limitation. The Pensoft reference is a user manual for software, used for personal

information management, called "Perspective": "Perspective can help you manage

your schedule, tasks, contacts, notes, and other important information. This

chapter explains how to use the Handbook, the basic reference source for using

Perspective." Pensoft, 1.

Petitioner argues that "Pensoft discloses that the user of an information

handling system may be given the option, when the user invokes a name, to (i)

update information associated with that name if information associated with the

name is already present in the database, or (ii) enter in contact information for that

name as a new contact if the name is not present in the database." *Corrected

Petition*, 48. To support this assertion, the Petitioner selects four passages from

30

Pensoft at pages 38, 9, 178, and 17 respectively. *Id.* We discuss each passage in turn.

On page 38, the passage quoted from Pensoft reads as follows: "If you have not previously entered a Dan, the Associate asks if you want to create a new profile for Dan." The context of this passage is that the user has entered "Meet Dan". The Pensoft reference explains that "When the **Associate** is **On**, you can determine whether or not you want the Associate to ask for help resolving linking questions. For example, if you have two or more people named Dan in Perspective, and write *Meet Dan* with **Let the Associate ask for Help** turned **On**, the Associate asks you which Dan you are meeting. If you have not previously entered a Dan, the Associate asks if you want to create a new profile for Dan. If **Let the Associate ask for Help** is turned **Off**, no Link is created in either case." Pensoft, 38 (emphasis in original).

Presumably, in the context of the claim limitation at issue, "Dan" constitutes "first contact information" in a "document". The claim limitation 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" (emphasis added). In this claim limitation, the "first contact information" results from the limitation, previously recited in the independent claims 1, 9, and 17, of "analyzing in a computer process

31

textual information in a document configured to be stored for later retrieval *to identify a portion of the document as first contact information*" (emphasis added). The Petitioner's argument therefore requires that "Dan" corresponds to "first contact information" that has been identified by analyzing "textual information in a document configured to be stored for later retrieval".

The limitation at hand requires, with respect to the identified first contact information, "allowing the user to make a decision". The decision that is enabled is "whether [i] to store at least part of the first contact information in the contact database as a new contact or [ii] to update an existing contact in the contact database". In the quoted passage from Pensoft, "If you have not previously entered a Dan, the Associate asks if you want to create a new profile for Dan." *Id*. In the words of the claim limitation, with this capability the user can "store at least part of the first contact information in the contact database as a new contact." (Yet the Pensoft document does not tell us *how* the user is given this option. Pensoft, therefore does not tell us, for example, whether "a single execute command from the input device is sufficient to cause the performing"—indeed it fails to disclose an input device for this action at all—or whether the user must re-type the name of the contact into the address book, etc.)

But the claim limitation requires more. The claim limitation requires "allowing the user to make a decision" and the decision is "whether [1] to store at

32

least part of the first contact information in the contact database as a new contact or

[2] to update an existing contact in the contact database". The passage on page 38

of Pensoft fails to meet the claim limitation, among other reasons, because Pensoft

fails to disclose or suggest a mechanism for allowing the user make a decision

between [1] and [2].

The next passage quoted by Petitioner is from page 9 of Pensoft: "Each item

has a *profile*. Profiles are forms which display all the details for an item."

(Original emphasis here restored.) Again, the Petitioner fail to address the

requirements of the claim: the quoted passage, "Each item has a profile. Profiles

are forms which display all the details for an item." Pensoft, p. 9, says nothing

about allowing a user to make a decision as required by the claim. In fact, Pensoft

page 9 does not mention anything about changing the database at all, nor does it

mention any "first information", let alone "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".

After Petitioner quotes from page 9 of Pensoft, the Petitioner then quotes

from page 178: "You can add an instance detail in a profile you open in any

Perspective document." *Corrected Petition*, 41. The Petitioner also refers to the

figure on page 178 of Pensoft, pointing out that it is "instance detail for 'Dan

Costa' profile in 'Address Book.'" *Id*. It is important to note, that in adding

"instance detail", the user must enter contact information according to the type of

contact information is being entered. The referenced figure is reproduced below:
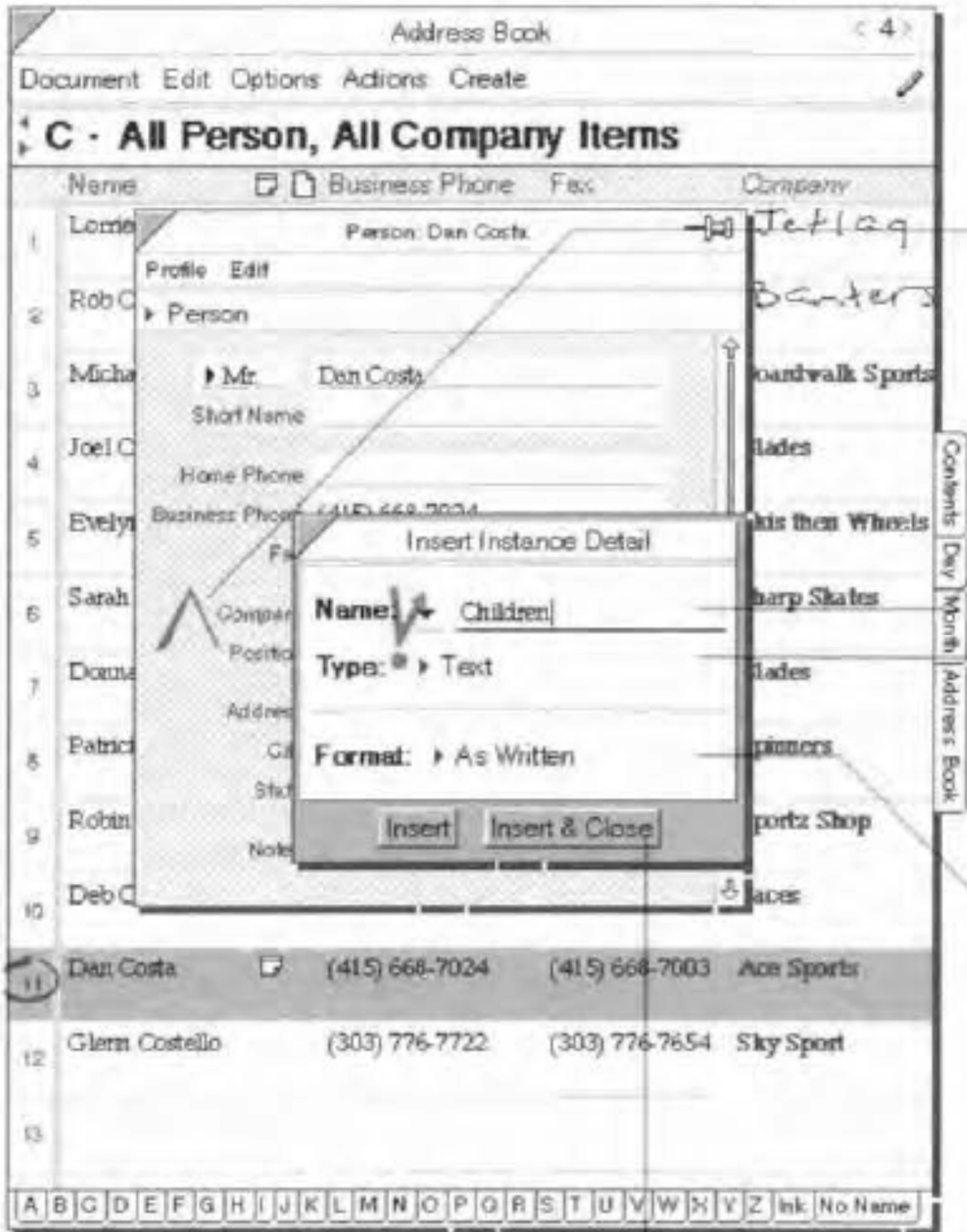
In the figure, it can be seen that, of the entries in the Address Book shown in the bottom window (in the next to last line), entry number 11 for Dan Costa has been highlighted. In the window above the Address Book appears a window for "Person: Don Costa". In the next line of the same window appears "Profile Edit" and below that "Person". This window is therefore being used to edit data for Dan Costa, and it can be seen that the window specifies separately fields for "Short name", "Home Phone", and "Business Phone", with other fields partly obscured for such things as "Address". In other words, for a user to change or add detail for a person in the Address Book, it is necessary to make the change or add the detail separately in each field to be changed or added. In the top window, entitled "Insert Instance Detail", the user is prompted to designate the Name of the detail, the Type, and the Format. See, also Chapter 3, page 27 (emphasis added), for entering contact data for a new person, "When you enter information in different columns along the row, you are entering details for the item. For example, when you write in the Address Book, you enter each detail about the person, such as name, address, city, state, and business phone number *in a different column*."

Thus, also here, on page 178 of Pensoft, the Petitioner fails utterly to link the Pensoft functionality to the requirements of the claim: all the Petitioner has shown is that in Pensoft the user can update the contents of the database. There is no mention of anything like the claim's "first information", this passage does not

35

mention anything about entering a new contact in the database, let alone "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".

On page 17 of Pensoft appears the final quotation by Petitioner in seeking to show that Pensoft meets 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" . The quotation is as follows:

> "Use the Address Book to:
> • write and track names, phone numbers and addresses for everyone in one place,
> • update information when it changes."

Corrected Petition, 41. The quoted passage shows unsurprisingly that the Perspective database can be used to keep contact information on a current basis. However, again, the Petitioner fails to show anything in Pensoft that meets 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." Nowhere in the quoted passage or page from Pensoft does Pensoft teach to update the database with any "first information" at all; nowhere else on the page or in the section or elsewhere in

36

the Pensoft reference is disclosed that the user is allowed to make a decision as required by this claim limitation.

There is an additional reason why Pensoft fails to disclose this claim limitation. The context of the claim limitation follows a recited process of analyzing a document (which is "configured to be stored for later retrieval") to identify "first contact information". In this context, some, but not all, of the identified first contact information may match contact information that is in the database. It is at this point that the claim 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".

By way of contrast, in Pensoft, it will be recalled that the Perspective software prompts the user to enter Dan into the database when, after "Meet Dan" is entered *as an appointment*, and the software determines that there is no entry for Dan in the Address Book. So in the claim limitation "allowing the user to make a decision whether to store *at least part of the first contact information …*", Pensoft has nothing corresponding to the first contact information because there is nothing in Pensoft corresponding to 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*", In fact, Pensoft has already been invoked by Petitioner as corresponding to the limitation of

37

"providing access to a contact database that can also be separately accessed and edited by a user …." *Corrected Petition*, at 30. Because Pensoft discloses nothing other than such a database and its user interface (see Pensoft, 9-10), it cannot be argued to cover processes occurring outside of the database and its user interface, such as "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*" and "allowing the user to make a decision whether to store *at least part of the first contact information …*",

In other words, Pensoft has been invoked inconsistently by Petitioner, and even while being invoked inconsistently, still fails to disclose or suggest the 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".

Finally, in attempting to demonstrate that the referenced prior art teaches this limitation, the Petitioner points to Drop Zones:

> Drop Zones discloses that it can derive e-mail addresses based on a person's name or his/her phone number. This would require a search through the contact database, and a determination of whether the information sought is present in the database. See Drop Zones, p. 61, col. 1, ¶ 1; col. 2, ¶ 1

38

Corrected Petition, 33. However, as in the case with the Petitioner's references to Pensoft, Drop Zones does nothing like what is required by this claim limitation. These sections of Drop Zones (or any other part of the Drop Zones reference) fail to teach "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": Nowhere in these paragraphs is contemplated storing any "first information" at all, nor allowing the user to make a decision as required by the claim.

In summary, then, the Petitioner has failed to demonstrate that LiveDoc, Drop Zones, and Pensoft teach the 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," and thus, for at least this additional reason, Ground 1 fails to establish a *prima facie* case for obviousness.

VI.   CONCLUSION

For the foregoing reasons, Petitioner 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.

Date: March 11, 2014   Respectfully submitted,

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40

CERTIFICATE OF SERVICE

It is certified that on March 11, 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

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Exhibit 6HH

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		

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

Response D

Dear Sir/Madam:

In response to the Office Action dated September 29, 2009, the Applicant submits the following amendment and remarks.

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

Remarks begin on page 14 of this paper.

1

AMENDMENTS TO THE CLAIMS:

Claims 1-106. (Cancelled)

107. (New) A computer implemented method for information handling, comprising:

      displaying information electronically, using a computer program;

      electronically analyzing the information to identify a portion of that information as contact information and to determine what type of contact information the portion is, without user designation of a specific part of the electronically displayed information to be subject to the analyzing;

      electronically searching in an information source for the contact information in order to find whether the contact information is included in the information source; and

      when the information source includes the contact information, if second information in the information source is associated with the contact information, causing electronic display of at least a portion of the second information.

108. (New) A method according to claim 107, further comprising:

      during the displaying, receiving an execute command from an input device that initiates at least one process of this method.

109. (New) A method according to claim 107, further comprising:

      in a computer process, performing an action depending on the type of contact information the portion is.

2

110. (New) A method according to claim 110, wherein the portion is a name and the action includes insertion of an address into the displayed information.

111. (New) 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 electronically, using a computer program;

      electronically analyzing the information to identify a portion of that information as contact information and to determine what type of contact information the portion is, without user designation of a specific part of the electronically displayed information to be subject to the analyzing;

      electronically searching in an information source for the contact information in order to find whether the contact information is included in the information source; and

      when the information source includes the contact information, if second information in the information source is associated with the contact information, causing electronic display of at least a portion of the second information.

112. (New) At least one non-transitory computer readable medium according to claim 111, wherein the instructions establish processes further comprising:

      during the displaying, receiving an execute command from an input device that initiates at least one process for which instructions are stored in the computer readable medium.

113. (New) At least one non-transitory computer readable medium according to claim 111, wherein the instructions establish processes further comprising:

in a computer process, performing an action depending on the type of contact information the portion is.

114. (New) At least one non-transitory computer readable medium according to claim 113, wherein the portion is a name and the action includes insertion of an address into the displayed information.

115. (New). An apparatus for information handling, comprising:

a processor; and

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

displaying information electronically, using a computer program;

electronically analyzing the information to identify a portion of that information as contact information and to determine what type of contact information the portion is, without user designation of a specific part of the electronically displayed information to be subject to the analyzing;

electronically searching in an information source for the contact information in order to find whether the contact information is included in the information source; and

when the information source includes the contact information, if second

information in the information source is associated with the contact information,

causing electronic display of at least a portion of the second information.

116. (New) An apparatus according to claim 115, wherein the memory further stores

instructions executable by the processor to perform processes that include:

during the displaying, receiving an execute command from an input device that

initiates at least one process for which instructions are stored in the memory.

117. (New) An apparatus according to claim 115, wherein the memory further stores

instructions executable by the processor to perform processes that include:

in a computer process, performing an action depending on the type of contact

information the portion is.

118. (New) An apparatus according to claim 117, wherein the portion is a name and the

action includes insertion of an address into the displayed information.

5

119. (New) A computer implemented method for information handling, comprising:

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

electronically searching in an information source for the contact information in order to find whether the contact information is included in that information source; and

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

120. (New) A method according to claim 119, further comprising:

receiving an execute command from an input device that initiates at least one process of this method.

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

6

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

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

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

125. (New) 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:

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

   electronically searching in an information source for the contact information in order to find whether the contact information is included in that information source; and

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

126. (New) At least one non-transitory computer readable medium according to claim 125, wherein the instructions establish processes further comprising:

receiving an execute command from an input device that initiates at least one process for which instructions are stored in the computer readable medium.

127. (New) 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 running a program, the client selected from a group consisting of a computer, a cell phone, a palm top device, and a personal organizer.

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

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

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

131. (New). An apparatus for information handling, comprising:

a processor; and

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

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

electronically searching in an information source for the contact information in order to find whether the contact information is included in that information source; and

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

132. (New) An apparatus according to claim 131, wherein the memory further stores instructions executable by the processor to perform processes that include:

receiving an execute command from an input device that initiates at least one process for which instructions are stored in the computer readable medium.

9

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

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

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

137. (New) 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 the user to use the input device to command the system 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;

10

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; and

if 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;

if the contact information is identified as including a name with an address, i) electronically prompting the user with an option to save electronically in the information source at least some of the contract information, and 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 and address as a new contact or to update one of the at least one contact.

138. (New) 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 the user to use the input device to command the system 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;

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; and

if 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;

if the contact information is identified as including a name with an address, i) electronically prompting the user with an option to save electronically in the information

source at least some of the contract information, and 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 and address as a new contact or to update one of the at least one contact.

REMARKS

The Applicant thanks Examiner Pham for his analysis of the pending claims and for his time during the examiner interview. Original claims 1-106 have been cancelled, and new claims 107-138 have been introduced to simplify and streamline prosecution. No new matter has been added.

Interview Summary

The telephonic interview was held on March 25, 2010 between Examiners Pham and Applicant's representatives, Bruce Sunstein and Jakub Michna. During the interview, Examiner Pham and Applicant's representatives discussed claim language and the prior art. The new claims presented herewith are similar to the claims discussed during the interview.

Claim 107 (drawn to a method) includes new limitations, including the requirement of analyzing information to identify a portion as contact information and to determine what type of contact information the portion is. The "identifying" and "determining" is not required to be done in two separate processes (*e.g.*, it can be done in a single computer process, as disclosed in the application at page 8, lines 3-12). The analyzing of claim 107 simply requires two characteristics—identifying a portion as contact information and determining what type of contact information the portion is.

Claims 111 (drawn to a computer readable medium) and 115 (drawn to an apparatus) have limitations that are generally similar to those of new claim 107.

Claim 119 requires "analyzing in a computer process information electronically displayed to identify a portion of that information as contact information." The contact information is "at least one of a name, a title, an address, a telephone number, and an

14

email address." Unlike claim 107, which generally requires identifying contact information, claim 119 requires at least one of the listed types of contact information—a name, a title, an address, a telephone number, and an email address. Support for these types of contact information can be found in, among other places, original claims 4, 33, and 34 and at page 8, lines 13-15 of the application, which explains that the program may identify a telephone number.

Claim 119 also requires, once the contact information is identified, electronically searching for the contact information in an information source. If second information in the information source is associated with that contact information, at least a portion of the second information is displayed. In this case, again, claim 119 requires a more specific limitation. While claim 107 causes display of *second information* associated with contact information, claim 119 requires display of "at least one of a name, a title, an address, a telephone number, and an email address." Support for these limitations can be found in, among other places, original claims 4, 33, and 34, and at page 6, line 23 – page 7, line 2 of the application, which explains that the program may search for stored information—a name—associated with part of a name.

Claims 125 (drawn to a computer readable medium) and 131 (drawn to an apparatus) have limitations that are generally similar to those of new claim 119.

Claim 137 requires "analyzing the information in a computer process to identify a portion of that information as contact information." This claim is also more specific regarding contact information. It requires that the contact information includes "at least one of a name without an address and a name with an address." Although claim 137 does not include the "without user designation" limitation, the claim does require other more

specific limitations (*e.g.*, providing an input device). Claim 138 (drawn to a computer readable medium) has limitations that are generally similar to those of new claim 137.

The Applicant addresses the 35 U.S.C. §112 and §102 rejections below. There were no claim rejections under 35 U.S.C. § 103.

I.   The Claims Presented Herein Satisfy Requirements of Written Description and Enablement.

Claims 29-41, 44-52, 54, 56, and 58-106 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description and enablement requirements. Each of those claims is now canceled without prejudice, thereby rendering this rejection moot. Independent claims 107, 111, 115, 119, 125, and 131 include the recitation "without user designation of a specific part of the electronically displayed information to be subject to the analyzing." This limitation (as well as the original limitation, now cancelled) has support in, among other places, Example 1 of the application. *Application, page 10, line 22 – Page 11, line 5*. In Example 1 (and other examples), the user does not designate a specific part of the electronically displayed information to be subject to the analyzing. Instead, a computer process "analyses what the user has typed in the document" to determine the contact. The application describes various ways in which the computer process analyzes the document to determine the contact (*e.g.*, by looking for designators such as "Mr." or "Mrs."). *See application, page 8, lines 3 to 12*.

The office action alleges that the "without user designation" limitation (of the cancelled claims) does not have support because "every embodiment in the specification requires user action/designation to initiate the analyzing process." *See page 3 of the office action*. Nonetheless, user initiation of the analyzing process is different from user

designation of information.

Applicant notes that the phrase "without user designation of a specific part of the electronically displayed information to be subject to the analyzing" is not a disavowal of *any* user action at all, *i.e.*, not a disavowal of, for example, the need for the user to start the computer, initialize the application program, open or load the document, perform an action to initiate the analysis, such as clicking a button, opening and/or selecting a menu choice, etc., or select among various actions to be thereafter performed once the system or method has *first* identified the "contact information."

A key point is that the identification of the "information to be subject to the analyzing" is done by the computer process "without user designation" of the specific part to be analysed.   Thus, as to claims 107-136 the computer performs the analysis to identify the contact information without the user *first* having to "help" the program specify the "contact information." Thus, to the extent that Applicant is disclaiming any "user intervention" in the process, it is disclaiming only the user specifically aiding the computer process in the identification of the "contact information" at the outset, not disclaiming any user operations *after* contact information has been *first* identified, nor user operations *before* the computer processes except user operations that perform all or part of an analysis to identify the "contact information".

II.   The Anticipation Rejections Fail Because Each Cited Prior Art Reference Fails to Meet All of the Claims Limitations.

The office action rejects the broadest independent claims as anticipated by each one of the Ho, Hachamovitch, Miller, Land, and Miller references. As shown below, these cited references, alone and in combination, fail to account for all of the limitations of the claims.

a. **The Ho Reference Identifies Concept Matching Words and Fails to Disclose or Suggest:**
   i. **Searching to Find Whether Contact Information is Included in the Information Source,**
   ii. **Analyzing Information to Identify A Portion of the Information as Contact Information, and**
   iii. **Analyzing Information to Determine What Type of Contact Information the Portion Is.**

There are at least three important respects in which the Ho reference fails to meet the requirements of claims presented herein. First, claims 107, 111, 115, 119, 125, and 131 require electronically analyzing information to identify a portion of that information as contact information. Once the contact information is identified, these claims require the contact information to be used in a search "in order *to find whether the contact information is included in an information source.*" The Ho reference does not disclose, suggest, or teach searching for contact information in order to find whether the contact information is included in an information source. To the contrary, the system taught by Ho knows that an input word is included in an information source and has an associated graphic as soon as the input word is matched to a concept matching word.

The Ho reference is directed to adding conceptually relevant graphics to a presentation document. *Ho, Abstract.* Once the user initiates the process, the Ho reference teaches determining whether input words are among a list of "concept matching words." *Id.* If a word is in the list, then Ho's system retrieves an instance of graphics that is associated with the input word and its concept matching word. *Id.* Ho's system associates concept matching words with concepts and their associated graphics using the concept table depicted below.

	concept matching word	concept lemma	representative concept synonym	concept table
651	652	653		60
601	shock	shock	surprise	
602	shocked	shock	surprise	
603	shocking	shock	surprise	
604	shocks	shock	surprise	
605	surprise	surprise	surprise	

Each concept matching word is mapped to a concept lemma, and a representative concept synonym that has at least one associated graphic in a graphics library. As a consequence, in Ho, there is *always* a graphic associated with a concept matching word. Furthermore, if an input word is found in the concept matching word list, then it must exist in the concept table and have an associated graphic in the graphics library (and, thus, there is no need to determine if it is included in an information source or if there are any associated graphics). Indeed, the Ho reference explains clearly that the system matches input words to concepts and graphics by comparing them to a list of concept matching words:

> The method and system further utilizes a list of words, each representing a concept. The method and system first determines whether the input word is among the list of words that each represent a concept.

Id. Thus, the Ho reference does not disclose searching for "concept matching words" in order to find whether they are included in an information source because Ho's "concept matching words" are preset in the context table and have an associated graphic in the graphic library. Furthermore, the list of concept matching word is the only criterion for determining whether an input word matches a concept matching word.

Moreover, specific dependent claims herein distinguish further over Ho. For example, claims 124, 130, and 136 specify that the contact information is a telephone number and the second information is a name. Nothing in Ho teaches such a set of limitations. In contrast to the claims, Ho does not look for a telephone number. Instead,

19

Ho looks for input words that are among a list of "concept matching words." The concept matching words have nothing to do with telephone numbers. Furthermore, Ho knows there is a corresponding graphic associated with each "concept matching word" and merely needs to retrieve the graphic(s) associated with the concept matching word. Thus, there is no need in Ho to first determine "whether" the input word is included in an information source because if the input word is in the list, then it *must* be included in the concept table and it *must* have an associated graphic in the graphics library.[1]

Second, and still further, unlike Ho, independent claims 107, 111, 115, 119, 125, 131, 137, and 138 require electronically analyzing information "to identify a portion of information as contact information." As noted above, Ho looks only for the presence of any concept matching words related to the content of a graphics library -- not "contact information." Independent claims 119, 125, and 131 are even more specific and require that the contact information is "at least one of a name, a title, an address, a telephone number, and an email address," while claim 137 and 138 requires that the contact information is "at least one of a name without an address and a name with an address." In contrast, Ho "blindly" determines whether any input words appear in list of concept matching words. The determination is "blind" because Ho's approach provides no insight into the nature of the input word. Even if contact information happened to be an input word, Ho does not disclose or suggest a mechanism for identifying it as such.

Thirdly, claims 107, 111, and 115 further require analyzing the information "to determine what type of contact information the portion is." Ho does not disclose, teach,

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[1] Indeed, Ho does not even describe or contemplate an embodiment where a matched input word is not found in the concept table or does not have an associated graphic— there is no need because this situation does not happen, as described above.

or suggest determining the "type" of concept matching word. As explained above, in Ho's system, information either appears in the list of concept matching words or it does not. No further analysis or determination is taught. Accordingly, for at least these reasons, Ho fails to anticipate or suggest the claims.

b. The Hachamovitch and Miller References Are Auto-Completion Systems and Fail to Disclose or Suggest Features Required by the Claims.

The Hachamovitch and Miller references are directed to auto-completion systems. *Hachamovitch, Abstract; Miller, Abstract.* As the user types a data entry into a document, the systems search for possible entry completions corresponding to the partial data entry. *Id.* The systems then provide the user with possible entry completions for the partial data entry. *Id.* The user can select one of the possible entry completions and the systems will automatically complete his data entry. *Id.*

i. The Hachamovitch and Miller References Fail to Disclose or Suggest Electronically Analyzing Information to Identify a Portion of that Information as Contact Information.

Neither the Hachamovitch nor the Miller references discloses the process of analyzing displayed information to identify the data entry (or portions thereof) as *contact information*, as required by claims 107, 111, 115, 119, 125, 131, 137, and 138. Indeed, in these prior art references, as the user types, the typed entries are "blindly" used in a search for possible completions. The use of the typed entries is "blind" because it provides no insight into the nature of the entries. Even if contact information happened to be formed by the typed entries, the prior art does not disclose or suggest a mechanism for identifying it as such. Similarly, none of the other more specific requirements of claims 119, 125, and 131 ("wherein the contact information is at least one of a name, a title, an address, a telephone number, and an email address") and 137 and 138 ("contact

21

information including at least one of a name without an address and a name with an

address") are met by Hachamovitch or Miller.

ii. The Hachamovitch and Miller References Fail to Disclose or Suggest Electronically Analyzing Information to Determine What Type of Contact information the Portion [of information] is.

Claims 107, 111, and 115 further require analyzing information "to determine

what type of contact information the portion is." Similarly, as explained above, neither

the Hachamovitch nor the Miller references discloses identifying a portion of information

as contact information, let alone determining *what type* of contact information the portion

is, as required by claims 107, 111, and 115.

iii. The Hachamovitch and Miller References Fail to Disclose or Suggest Receiving an Execute Command From an Input device That Initiates One Process of the Method

Dependent claims 108, 112, 116, 120, 126, and 132 require receiving an execute

command from an input device. The execute demand initiates at least one of the

processes recited in their respective independent claims. Claims 108, 112, and 116

further require that the execute command is received "during the displaying" of

information. Thus, according to the claims, the execute command does not initiate the

process of displaying information, but instead initiates at least one of the processes of

analyzing information, searching for contact information, or causing display of second

information. The Hachamovitch and Miller references do not meet this limitation

because they fail to receive an execute command that initiates one of these processes.

As explained above, Hachamovitch searches for possible entry completions as the

user types the data entry. *Col. 10, lines 27-37.* Nonetheless, entry of textual information

into a document is not an execute command, as required by the claims.

Miller operates somewhat differently from Hachamovitch. Miller searches and displays possible entry completions when the user pauses typing for a pre-determined duration. *Col. 12, lines 10-16.* A pause is also not an execute command. To the contrary, a pause is the *absence* of an execute command.

In both the Hachamovitch and Miller references, the execute command is received when the user selects one of the possible entry completions:

> Suggested word completions, which may change as the user types a partial data entry, are displayed in a non-disruptive manner and *selected using traditional acceptance keystrokes, such as the "tab" key or the "enter" key.*

Hachamovitch, Abstract (emphasis added).

> The user may accept a completion suggestion from the list by *touching a stylus to the display screen over the position of the desired completion suggestion*, or by using traditional selection and acceptance keystrokes, *such as the "arrow" keys to select a completion suggestion and the "enter"* key to accept the selected completion suggestion.

Miller, Abstract (emphasis added). However, this execute command does not meet the limitations of the claims because it is received after the possible completions are displayed. Therefore, the execute command does not initialize the other processes of Miller, which happen *before* the possible completions are displayed (*e.g.,* analyzing partial entries, searching for possible completions, or display of possible completions).

For at least the above reasons, the Hachamovitch and Miller references fails to anticipate or suggest the claims.

c. The Land Reference Obtains Images Based on User Designated Text and Fails to Disclose or Suggest Features Required by the Claims.

The Land reference discloses "using indicated text to automatically query a search engine for a database and return images that are relevant to the indicated text." *Land, Abstract.* In Land, a user highlights a word to trigger a search following graphical

selection of an "Imagizer." *Land, col. 4, line 6 – col. 5, line 12*. Land also discloses

another embodiment in which a search is based on where the user places the cursor. In

either embodiment of Land, a search requires user designation of the search criteria.

> i. **The Land Reference Fails to Disclose or Suggest Electronically Analyzing Information Without User Designation of a Specific Part of the Electronically Displayed Information To Be Subject to the Analyzing**

As set out above, in each embodiment of Land, a user designates information to

be searched. Accordingly, Land does not disclose or suggest electronically analyzing

information without user designation of a specific part of the information to be analyzed,

as required by each of claims 107, 111, 115, 119, 125, or 131.

> ii. **The Land Reference Fails to Disclose or Suggest Electronically Analyzing Information to Identify a Portion of that Information As Contact Information.**

Additionally, the Land reference does not meet the requirements of claim 107,

111, 115, 119, 125, 131, 137, or 138 because it does not disclose identifying the data

entry (or portions thereof) as contact information, as required by those claims. Similarly,

none of the other more specific requirements of claims 119, 125, and 131 ("wherein the

contact information is at least one of a name, a title, an address, a telephone number, and

an email address") and 137 and 138 ("contact information including at least one of a

name without an address and a name with an address") are met by Land.

> iii. **The Land Reference Fails to Disclose or Suggest Electronically Analyzing Information to Determine What Type of Contact information the Portion [of information] is.**

Claims 107, 111, and 115 further require analyzing information "to determine

what type of contact information the portion is." Similarly, as explained above, the Land

reference does not even disclose identifying a portion of information as contact

information, let alone determining *what type* of contact information the portion is, as required by claims 107, 111, and 115.

For at least the above reasons, Land fails to anticipate or suggest the claims.

d. The Reiter Reference Applies Printing to a Parcel or Letter and Fails to Disclose or Suggest Features Required by the Claims.

The Reiter reference is directed to a computer system that applies commercial advertisements to letters and parcels based on address information. *Reiter, Abstract.* Reiter uses an optical character reader to read address information that is located on a letter or parcel. The address information is then used to search a database for commercial advertisements. If there is a match between the address and a commercial advertisement (*e.g.*, based on demographic information), the commercial advertisement is applied to the letter or parcel (*e.g.*, by printing). *Reiter, col. 6, lines 28-33.*

i. The Reiter Reference Fails to Disclose or Suggest Displaying Information Electronically Using a Computer Program.

Reiter's system does not meet the limitations of the independent claims because the information to be analyzed is not *electronically displayed*. In Reiter's system, the address information appears on letters or parcels. At no point in the Reiter process are these letters or parcels electronically displayed, as required by claims 119, 125, or 131, much less "using a computer program" as is, for example, additionally recited in independent claims 107, 111, 115, 137, and 138.

ii. The Reiter Reference Fails to Disclose or Suggest Causing Electronic Display of at Least a Portion of the Second Information.

As noted above, in Reiter, if there is a match between the address and a commercial advertisement (*e.g.*, based on demographic information), the commercial advertisement is physically applied to the letter or parcel (*e.g.*, by printing). Thus, the

commercial advertisements are not caused to be electronically displayed as is required in

independent claims 107, 111, or 115 ("causing *electronic display* of at least a portion of

the second information") and independent claims 119, 125, or 131 ("*electronically*

displaying at least a portion of the second information").

iii. The Reiter Reference Fails to Disclose or Suggest Receiving an Execute Command From an Input device That Initiates One Process of the Method.

As explained above with respect to the Miller and Hachamovitch references,

dependent claims 108, 112, 116, 120, 126, and 132 require "receiving an execute

command from an input device that initiates at least one process" recited in their

respective independent claims. In other words, the claims require that the execute

command initiate at least one of the processes of analyzing information, searching for

contact information, or displaying (or causing display) of second information. In Reiter,

none of the disclosed processes of (1) analyzing the physical packages, (2) searching for

commercial advertisements, or (3) applying advertisements to packages is "initiated"

based on an "execute command" from an "input device." Therefore, Reiter does not meet

the limitations of dependent claims 108, 112, 116, 120, 126, and 132.

For at least the above reasons, Reiter also fails to anticipate or suggest the claims.

In summary, each of independent claims 107, 111, 115, 119, 125, 131, 137, and

138 are allowable over the prior art for at least the reasons stated above. The dependent

claims are also allowable at least for similar reasons and the additional reasons expressly

stated.

Applicant believes that all of the rejections have been addressed and a notice of allowance is requested. A three month extension of time is required. Applicants respectfully petition for such an extension. Authorization is hereby given to charge the extension fee to deposit account number 19-4972. If additional fees are required, please charge deposit account number 19-4972. To further expedite prosecution, the Examiner may call Jakub Michna at 617-443-9292 if he has any further questions.

Respectfully submitted,

/Jakub M. Michna, #61,033/

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27

Exhibit 6II

UNITED STATES PATENT AND TRADEMARK OFFICE
_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD
_____

GOOGLE INC., MOTOROLA MOBILITY LLC, and
SAMSUNG ELECTRONICS CO., LTD.,
Petitioners,

v.

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

_____

Case IPR2014-00452[1]
Patent 6,323,853 B1

_____

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

POWELL, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

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[1] Case IPR2014-01518 has been joined with this proceeding.

IPR2014-00452
Patent 6,323,853 B1

I. INTRODUCTION

Petitioners Google Inc. ("Google") and Motorola Mobility LLC ("Motorola") filed a Petition requesting *inter partes* review of claims 1–79 of U.S. Patent No. 6,323,853 B1 ("the '853 patent"). IPR2014-00452, Paper 1 ("Pet."). On August 20, 2014, we instituted an *inter partes* review of claims 1–79 based on certain grounds presented in the Petition. IPR2014-00452, Paper 10 ("Dec. to Inst."). On November 3, 2014, Patent Owner, Arendi S.A.R.L., filed its Patent Owner Response. IPR2014-00452, Paper 17 ("PO Resp."). On February 3, 2015, Google and Motorola filed a Reply. IPR2014-00452, Paper 23 ("Pet. Reply").

Samsung Electronics Co., Ltd. ("Samsung") filed a second Petition for *inter partes* review of claims 1–79 of the '853 patent. IPR2014-01518, Paper 1. The second Petition challenged claims 1–79 on the same grounds as those for which we instituted trial in IPR2014-00452. Concurrent with the second Petition, Samsung filed a motion to join IPR2014-01518 with IPR2014-00452. IPR2014-01518, Paper 3. On March 18, 2015, we instituted an *inter partes* review with respect to all challenges raised in the second Petition, joined IPR2014-01518 with IPR2014-00452, and terminated IPR2014-01518. IPR2014-01518, Paper 10; IPR2014-00452, Paper 26.[2]

An oral hearing was held on April 21, 2015. A transcript of the oral hearing is included in the record. Paper 30 ("Tr.").

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[2] From this point forward, all references to "Petitioners" refer to Google, Motorola, and Samsung. Additionally, from this point forward, all references to papers and exhibits refer to the documents filed in IPR2014-00452.

2

IPR2014-00452
Patent 6,323,853 B1

We have jurisdiction under 35 U.S.C. § 6(b). 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 Petitioners have shown, by a

preponderance of the evidence, that claims 1–79 of the '853 patent are

unpatentable.

A.   *Related Proceedings*

The '853 patent has been asserted in several district court cases in the

U.S. District Court for the District of Delaware, including *Arendi S.A.R.L. v.*

Motorola Mobility LLC, Case No. 1-12-cv-01601; *Arendi S.A.R.L. v. Google*

Inc., Case No. 1-13-cv-00919; and *Arendi S.A.R.L. v. Samsung Electronics*

Co. Ltd., Case No. 1-12-cv-01598. Pet. 1; *see* Paper 6, 2–3. Additionally,

other patents related to the '853 patent have been the subject of petitions for

inter partes review in other cases, including IPR2014-00203, IPR2014-

00206, IPR2014-00207, IPR2014-00208, IPR2014-00214, and IPR2014-

00450. Paper 6, 3.

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 text 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.

3

IPR2014-00452
Patent 6,323,853 B1

Figure 3 is reproduced below.
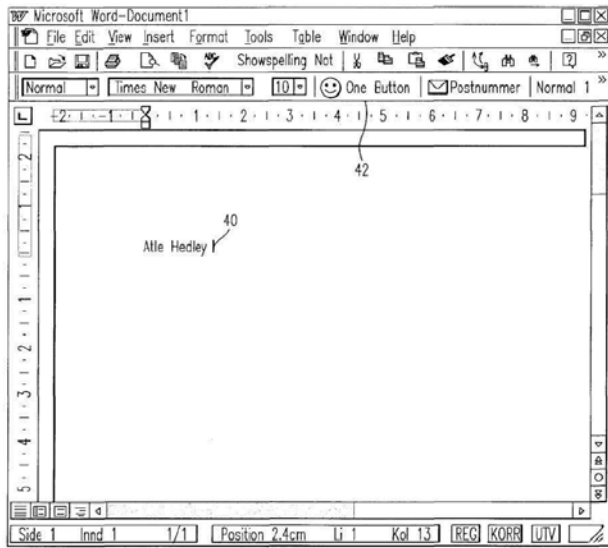
FIG. 3

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

4
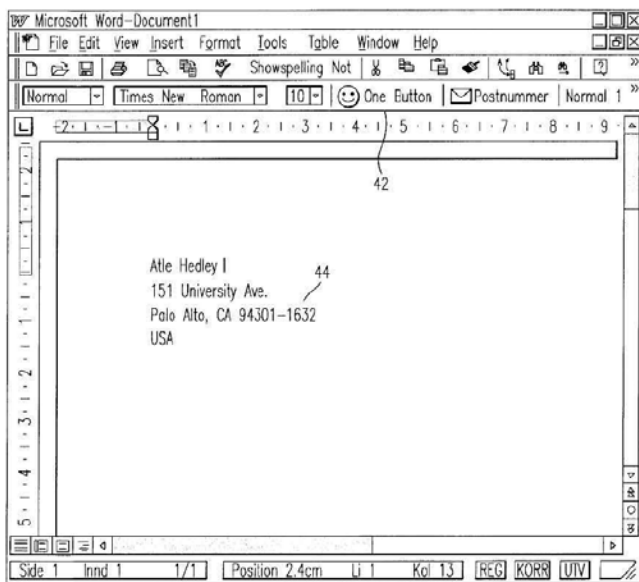
IPR2014-00452
Patent 6,323,853 B1

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
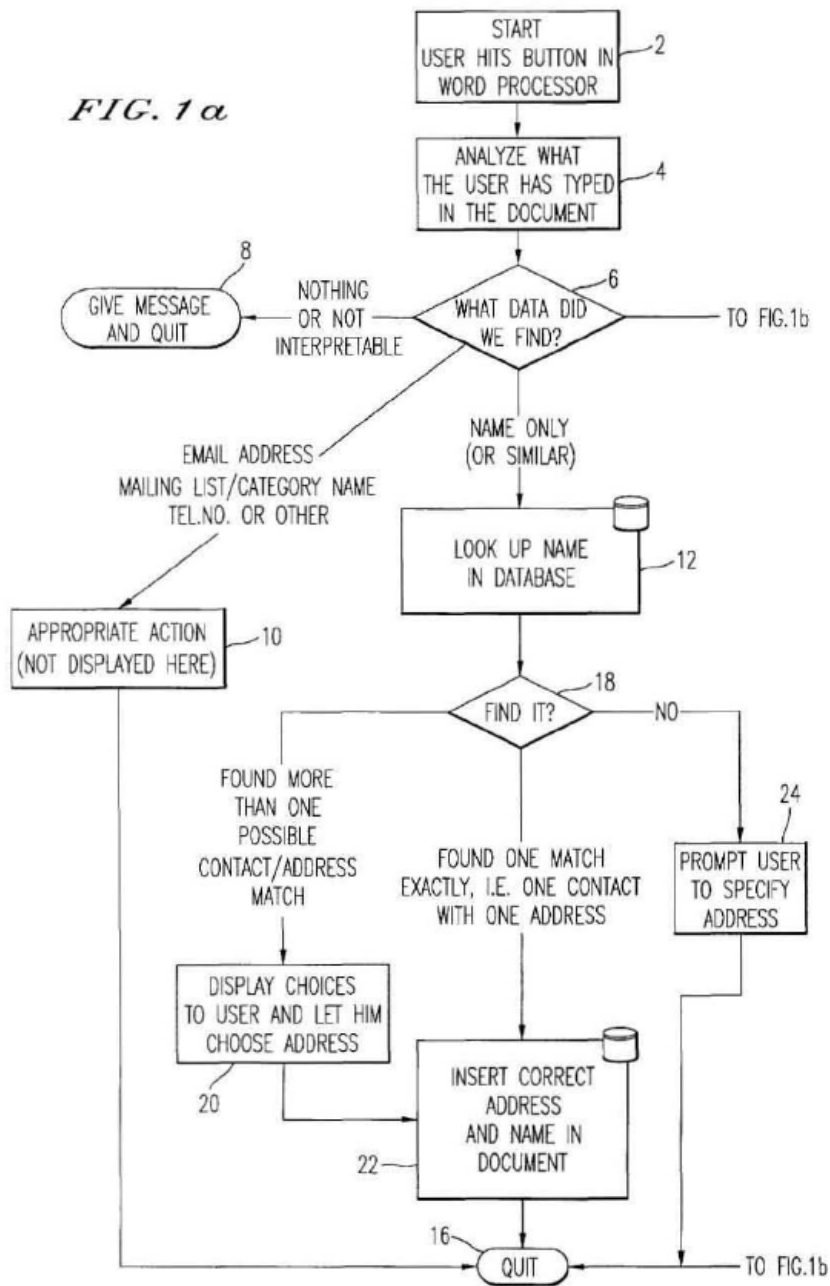
Figure 1a shows a flow chart illustrating a method according to the '853 patent. *Id.* at col. 2, ll. 38–40. At step 2, the user initiates the

IPR2014-00452
Patent 6,323,853 B1

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,

6

IPR2014-00452
Patent 6,323,853 B1

> 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

7

IPR2014-00452
Patent 6,323,853 B1

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

Ex. 1001, col. 10, ll. 28–52.

D.   *The Prior Art*

The pending grounds of unpatentability in this *inter partes* review are

based on the following prior art:

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

Gordon Padwick et al.,[3] USING MICROSOFT OUTLOOK 97 (Que®
Corporation[4] 1997[5]) ("Padwick") (Ex. 1004).

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[3] 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.

[4] 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.

[5] 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, as Patent Owner does not
dispute, whether the evidence regarding the Library of Congress control
number establishes a publication date earlier than the 1997 copyright date
explicitly listed in Padwick.

8

IPR2014-00452
Patent 6,323,853 B1

E.   *Instituted Grounds of Unpatentability*

        We instituted an *inter partes* review involving the following grounds

of unpatentability:

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

Petitioners support their challenges with a Declaration executed by

Dennis R. Allison, on February 20, 2014 ("Allison Declaration") (Ex. 1002).

Patent Owner relies on a Declaration executed by John V. Levy, Ph.D., on

October 21, 2014 ("Levy Declaration") (Ex. 2008).

II. ANALYSIS

A. *Claim Interpretation*

        "A claim in an unexpired patent shall be given its broadest reasonable

construction in light of the specification of the patent in which it appears."

37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, No. 2014-

1301, 2015 WL 4097949, *7–*8 (Fed. Cir. July 8, 2015) (In considering the

broadest reasonable interpretation standard for *inter partes* review

proceedings, the United States Court of Appeals for the Federal Circuit

determined that "Congress implicitly approved the broadest reasonable

interpretation standard in enacting the AIA," and "the standard was properly

adopted by PTO regulation."),[6] *reh'g en banc denied*, _F.3d_, 2015 WL

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[6] Patent Owner objects in its Response to our application of the broadest
reasonable construction standard in *inter partes* review proceedings. PO

IPR2014-00452
Patent 6,323,853 B1

4100060 (Fed. Cir. July 8, 2015). Under that standard, 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 Suitco Surface, Inc.*, 603 F.3d 1255, 1260

(Fed. Cir. 2010). Thus, we generally give claim terms their ordinary and

customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257

(Fed. Cir. 2007) ("The ordinary and customary meaning is the meaning that

the term would have to a person of ordinary skill in the art in question.")

(citation and internal quotation marks omitted).

 Petitioners and Patent Owner proffer constructions for a number of

terms. Pet. 11–14; PO Resp. 9–19, 36–45; Pet. Reply 7–14. In this

decision, we construe only those claim terms in controversy, and we do so

only to the extent necessary to resolve the controversy. *See Vivid Techs.,*

Inc. v. Am. Sci. & Eng'g, Inc., 200 F.3d 795, 803 (Fed. Cir. 1999).

> 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" (claim 1)*

 Patent Owner argues that this claim language requires a number of

things. Patent Owner argues that in claim 1 the recited "analyzing" is a

separate process from and a pre-condition to the "searching" process

subsequently recited in the claim language—namely, "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." PO Resp. 12–13. Patent Owner also contends that claim 1

"require[s] distinguishing the presence of first information, from other text

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Resp. 45–53. *Cuozzo*, which was decided after Patent Owner filed its
Response, resolves this argument by affirming our use of the broadest
reasonable construction standard in *inter partes* review proceedings
involving unexpired patents.

IPR2014-00452
Patent 6,323,853 B1

in the document, and this process is triggered by a single entry of the execute command." *Id*. at 11. Patent Owner further argues that, "[b]ecause the broadest reasonable 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." *Id.* at 35.

Petitioners contest Patent Owner's claim construction arguments. Petitioners argue that the disputed claim language does not require distinguishing contact information from other text in the document.[7] Pet. Reply 7–9. Additionally, Petitioners argue that Patent Owner misconstrues the claim language related to the recited "single entry of the execute command." *Id.* at 10–12. Furthermore, Petitioners dispute Patent Owner's claim construction arguments based on the prosecution history of the '853 patent. *Id.* at 12–14.

> a. *Patent Owner's argument that the recited "analyzing" is separate from and a precondition to the "searching" recited in claim 1*

Patent Owner argues that claim 1 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

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[7] Some statements in Patent Owner's Response tend to imply that Patent Owner believes claim 1 requires distinguishing "contact information" from other information. *See, e.g.*, PO Resp. 6 ("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."). At the oral hearing, Patent Owner confirmed that its argument in this regard is that the claims require distinguishing "first information" from other information, not that the claims require distinguishing "contact information" from other information. Tr. 37, l. 6–38, l. 1.

11

IPR2014-00452
Patent 6,323,853 B1

'searching, using the record retrieval program, the information source for second information associated with the first information.'" PO Resp. 12–13. Patent Owner further argues that:

> 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).

Id. at 13.

Consistent with Patent Owner's arguments, our Institution Decision expressed agreement with Patent Owner regarding this aspect of the meaning of claim 1, stating that:

> 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).

Dec. to Inst. 13. The record developed at trial provides no reason to modify this interpretation.

> b. *Patent Owner's argument that the claim language requires distinguishing first information from other text in the document*

In support of its assertion that claim 1 requires distinguishing first information from other text in the document, Patent Owner argues the following: 1) the "analyzing" step determines *if* the document contains the "first information"; and 2) the claims do not preclude the document from having other text from which the first information would have to be

IPR2014-00452
Patent 6,323,853 B1

distinguished. PO Resp. 13–14. Patent Owner also argues that this interpretation is "consistent with the logical flow shown in Fig. 1 and as the logical flow is described in the '853 Patent." *Id*. at 14; *see id.*at 14–16.

Petitioners disagree. Pet. Reply 7–8. Petitioners argue that, "[b]ecause the word 'first' does not limit the word 'information' by type, the 'analyzing' step—which [Patent Owner] drafted—requires only a determination that some piece of information is present in the document." *Id*. at 8. Petitioners argue that the Specification of the '853 patent contradicts Patent Owner's argument that the claim requires distinguishing the first information from other information. *Id*. Specifically, Petitioners note that Figures 3 and 14 and the corresponding disclosure in the '853 patent provide examples where the only information in a document is one instance of first information, specifically the name "Atle Hedley." *Id*.

We disagree with Patent Owner's argument that the claims require distinguishing first information from other text in the document. We first consider the plain language of the claim, which says nothing about any other text in the document, much less distinguishing the "first information" from any other text in the document. Turning to the other disclosures in the '853 patent, the example discussed in connection with Figure 3 discloses analyzing a document that does not contain any text other than the "first information," which, in that instance, is the name "Atle Hedley." *See* Ex. 1001, col. 5, ll. 60–67; Fig. 3. This example contradicts Patent Owner's argument that the disclosures in the Specification indicate the claims require distinguishing first information from other text in the document.

13

IPR2014-00452
Patent 6,323,853 B1

> ### c. *Patent Owner's argument that the analyzing process is triggered by a single entry of the execute command*

Because the claim language specifies that the "analyzing" process occurs "upon a single entry of the execute command," Patent Owner argues that claim 1 "rule[s] 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." PO Resp. 17 (citing Ex. 2008 ¶ 25). Citing a dictionary, Patent Owner argues that "[t]he word 'upon' means 'on', and is 'used to say that someone or something is very close or has arrived.'" *Id.* (citing FREE MERRIAM-WEBSTER DICTIONARY, accessed on October 6, 2014 at http://www.merriam-webster.com/dictionary/upon). Patent Owner then argues that "[i]n 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." *Id.* (citing Ex. 2008 ¶ 24). Emphasizing that the claim recites "upon a *single* entry" and arguing that "the execute command triggers the 'analyzing of the document to determine if the first information is contained therein,'" Patent Owner argues that the claims preclude any action other than the single entry of the execute command as a condition to execution of the "analyzing" process. *Id.* at 17–18 (citing Ex. 2008 ¶ 25).

Petitioners counter that the word "single" in the disputed claim language modifies "entry," arguing that "[t]he claim thus excludes the 'analyzing' happening only after two (or more) entries of the execute command." Pet. Reply 11. Noting that claim 1 uses the "comprising" transitional term, Petitioners argue that the claim does not restrict actions prior to entry of the execute command. *Id.* Petitioners further argue that "Dr. Levy has admitted [that]. . . even in the '853 patent there are a large number of user actions that must occur prior to the 'execute command' if

IPR2014-00452
Patent 6,323,853 B1

one wants to trigger the 'analyzing' step." *Id.* at 11–12 (citing Ex. 1016, 75,
l. 21–79, l. 18).

At the oral hearing, Patent Owner sought to rebut Petitioners'
assertions and clarify its initial argument. Patent Owner asserted that
Petitioners' assertion that "single" only excludes multiple entries of the
execute command "challenges the imagination." Tr. 30, ll. 3–10. Patent
Owner further asserted that Petitioners' argument is illogical in the context
of other claim language. *Id.* at 30, ll. 3–23. Patent Owner referred to the
recitation in claim 1 of "an execute command which initiates a record
retrieval." *Id.* at 30, ll. 12–17. Given this claim language, Patent Owner
argued that "[t]herefore, by definition, the first execute command has
already initiated the record retrieval because that's what the claim says it
does." *Id.* at 30, ll. 18–20. Based on this assertion, Patent Owner suggested
that the claim term "single" would be redundant if it only excluded multiple
entries of the execute command. *Id.* at 30, ll. 20–23.

In response, Petitioners asserted that Patent Owner's argument does
not make sense in the context of "a specification that expressly includes user
selection in a family of patents that otherwise expressly claims user
selection." *Id.* at 46, ll. 18–23.

We agree with Patent Owner insofar as the disputed claim language
requires that the recited "analyzing" ensues when "a single entry of the
execute command" occurs. This follows from the plain meaning of the
claim language, and no evidence to the contrary has been cited.

We do not agree, however, with Patent Owner's argument that claim 1
"rule[s] 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." PO Resp. 17

15

IPR2014-00452
Patent 6,323,853 B1

(citing Ex. 2008 ¶ 25). According to the plain meaning of "upon a single

entry of the execute command . . . analyzing the document," the word

"single" does modify entry, thereby excluding multiple entries of the execute

command. Additionally, claim 1's use of the transitional term "comprising"

indicates that the method may include other actions prior to the recited

"single entry of the execute command." Furthermore, contrary to Patent

Owner's assertion, the claim language "an execute command which initiates

a record retrieval from an information source," by itself, does not convey

clearly that the record retrieval necessarily occurs because of one entry of

the execute command. Moreover, the portion of Dr. Levy's deposition

testimony cited by Petitioners persuades us that the system disclosed by the

'853 patent would require user actions prior to entering the execute

command to trigger the analyzing process. *See* Ex. 1016, 75, l. 21–79, l. 18;

Pet. Reply 11–12. Additionally, as noted by Petitioners, Patent Owner's

argument is contradicted by the Specification's disclosure that:

> 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.

Ex. 1001, col. 10, ll. 5–10; Tr. 46, ll. 18–23.

d. Patent Owner's prosecution history argument

Patent Owner argues that "[t]he public record of the [United States

Patent and Trademark Office ("PTO")] . . . 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' . . . rule out user selection of the first information." PO Resp. 39.

16

IPR2014-00452
Patent 6,323,853 B1

Patent Owner contends that "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." *Id.* at 44. Patent Owner notes that the U.S. District Court for the District of Rhode Island, in *Arendi U.S.A., Inc. v. Microsoft Corp.*, Case No. 02-343-T, found a clear disavowal of claim scope consistent with the claim construction arguments advanced by Patent Owner in this case. *Id.* at 39–40. In concert with this, Patent Owner argues that the Federal Circuit summarily affirmed the District Court in *Arendi U.S.A., Inc. v. Microsoft Corp.*, 168 F. App'x 939 (Fed. Cir. 2005). *Id.* at 40. Patent Owner argues that, in an *inter partes* proceeding at the PTO, it is proper to consider prosecution history when construing a claim. *Id.* at 43 (citing *Tempo Lighting, Inc. v. Tivoli, LLC,* 742 F.3d 973 (Fed. Cir. 2014)).

In response, Petitioners argue that we should not consider prosecution history when construing claims in an *inter partes* review. Pet. Reply 12–13 (citing *Marine Polymer Tech., Inc. v. HemCon, Inc.*, 672 F.3d 1350, 1364 (Fed. Cir. 2012) (en banc); *Tempo Lighting*, 742 F.3d at 978). Petitioners also dispute Patent Owner's assertion that the PTO requested amendment of the claims. *Id*. at 13–14.

Since Patent Owner filed its Response and Petitioners filed their Reply, the Federal Circuit has admonished that "[t]he PTO should also consult the patent's prosecution history in proceedings in which the patent has been brought back to the agency for a second review." *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1298 (Fed. Cir. 2015). Accordingly, we consider the cited portions of the prosecution history and the parties' arguments about them.

17

IPR2014-00452
Patent 6,323,853 B1

Patent Owner cites a number of documents from the prosecution history of U.S. Patent Application No. 09/189,626 ("the '626 application"), which issued as the '853 patent. Patent Owner cites an Office Action (Ex. 2001) in which the pending claims of the '626 application were rejected based on U.S. Patent No. 6,085,201 to Tso (Ex. 2003, "Tso"). PO Resp. 36. Patent Owner also cites a subsequent Interview Summary (Ex. 2002), Amendment (Ex. 2004), and Notice of Allowance (Ex. 2005). *Id.* at 37–39. We have considered all of these documents, as well as Patent Owner's arguments regarding them.

We find that the cited prosecution history does not demonstrate a clear disavowal of text selection. The Remarks section of the Amendment addresses a number of different subjects. *See* Ex. 2004, 2–4. The first four paragraphs of the Remarks section present background information, including a request for reconsideration, a summary of the status of the claims, a summary of the Office Action, and a summary of an interview between the applicant and examiner ("the examiner interview"). *Id.* at 2–3. The paragraph summarizing the examiner interview bridges pages 2 and 3. *Id.* This paragraph describes an exploratory discussion between the applicant and the examiner about distinguishing Tso, a discussion in which "[n]o agreement was reached." *Id.* at 3. In the following paragraph, the Amendment addresses the scope of the claims, explaining that:

> *Claim 8 has been amended to clarify that according to Applicants' invention*, upon a single entry of an execute command by means of an input device, a document is analyzed to determine if first information is contained therein, and if the first information is contained in the document, an information source is searched for second information associated with the first information using a record retrieval program.

18

IPR2014-00452
Patent 6,323,853 B1

Id. (emphasis added). We find that this latter paragraph contains the only clear statement from the applicant regarding the scope of the claims, and, in our view, it says nothing about whether the claims preclude or encompass text selection. *See id.*

Additionally, we find unpersuasive Patent Owner's citation of the examiner's statements in the Notice of Allowance. *See* PO Resp. 38–39. "[I]t is the applicant, not the examiner, who must give up or disclaim subject matter that would otherwise fall within the scope of the claims." *Sorensen v. Int'l Trade Comm'n*, 427 F.3d 1375, 1379 (Fed. Cir. 2005) (citations omitted).

Furthermore, we find unpersuasive Patent Owner's observation that the Federal Circuit affirmed the decision of the District of Rhode Island. Although we recognize that the Federal Circuit's decision summarily affirmed the decision of the District Court of Rhode Island, the Federal Circuit's decision does not provide guidance as to whether there had been a clear disavowal of subject matter during the prosecution of the '626 application. *See Arendi*, 168 F. App'x 939; *see also* Fed. Cir. R. 36 (noting five possible circumstances for summary affirmance).

Because we find that the prosecution history does not contain a clear disavowal of text selection by a user, we do not adopt Patent Owner's suggestion that we construe the claims as precluding text selection by a user. *See Seachange Int'l., Inc. v. C-COR, Inc.* 413 F.3d 1361, 1373 (Fed. Cir. 2005) ("A disclaimer must be clear and unambiguous."). As the Federal Circuit notes, the prosecution history "often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Phillips v. AWH Corp.*, 415 F.3d 1302,1317 (Fed. Cir. 2005) (en banc)

IPR2014-00452
Patent 6,323,853 B1

(citations omitted). As noted above, the Specification of the '853 patent states that "the user may select the information in the document to be searched by the program in the database." Ex. 1001, col. 10, ll. 5–10.

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

Petitioners assert that claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 are unpatentable under 35 U.S.C. § 103(a) over Goodhand. Pet. 14–37; Pet. Reply 1–15. Petitioners explain how Goodhand teaches or renders obvious each of the limitations of the challenged claims. Petitioners also rely on the Declaration of Mr. Allison. Ex. 1002. Patent Owner disagrees with Petitioners' assertions and relies on the Declaration of Dr. Levy. *See* PO Resp. 1–54; Ex. 2008.

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.

20

IPR2014-00452
Patent 6,323,853 B1

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 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.
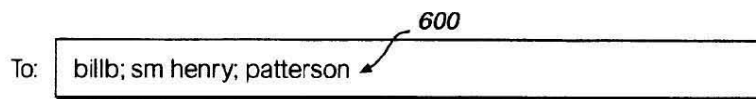
FIG.6a

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 text into address field 600. *Id.* at col. 17, ll. 15–17. Goodhand discloses that, "[a]s soon as the user moves the cursor to another field on the e-mail form, the e-mail program module begins to resolve the recipient names in the background." *Id.* at col. 17, ll. 21–23. Goodhand also discloses that "[t]hose skilled in the art will appreciate that in the preferred application program, addresses are also resolved when the user sends the message or if the user selects the 'check names' command." *Id.* at col. 20, ll. 18–21. In the example shown in Figure 6a, 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.

IPR2014-00452
Patent 6,323,853 B1

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

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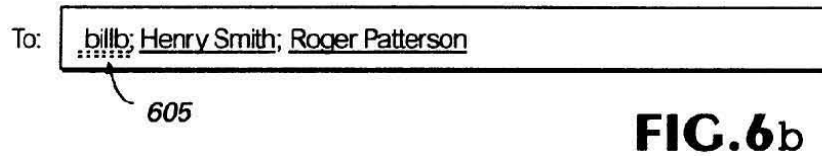
Figure 6b "illustrates the results of the effort to resolve the names." *Id.* at col. 17, ll. 38–39. If searching the address book identifies an unambiguous match for the display name of an intended recipient, the system inserts the full name of the intended recipient with a regular underline beneath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

Figure 6b further illustrates that squiggly line 605 appears underneath the display name "billb." *Id.* at col. 17, ll. 49–52; *see id.* at col. 19, ll. 52–53. This indicates that the system could not find a unique match for that display name. *Id.* 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 1 recitations of "record retrieval program" and "initiates a record retrieval from an information source using the record retrieval program" are disclosed

IPR2014-00452
Patent 6,323,853 B1

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. *Id.* at 17–20. Petitioners also contend that the claim 1 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.

We have reviewed the evidence and arguments presented in the Petition, Patent Owner's Response, and Petitioners' Reply. Based on that review, we determine that Petitioners have demonstrated, by a preponderance of the evidence, that all of the limitations of each of claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 are taught by or rendered obvious in view of Goodhand, and that each of these claims, considered as a whole, would have been obvious over Goodhand. Pet. 3–37; PO Resp. 1–53; Pet. Reply 1–15.

The parties' dispute revolves around claim 1's recitation 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." Petitioners point to Goodhand's disclosures related to address resolution associated with its address field 600 as teaching or rendering obvious this disputed claim language. Pet. 14–16, 20–21, 23–25; Pet. Reply 1–15. Patent Owner disagrees with Petitioner's contentions. PO Resp. 1–54.

IPR2014-00452
Patent 6,323,853 B1

> a.   *"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"*

Regarding the "execute command" recited in claim 1, Petitioners assert that Goodhand discloses three alternative execute commands that one can use to initiate address resolution. Pet. 23 (citing Ex. 1002 ¶ 119). As teaching one execute command, Petitioners note that Goodhand discloses a user can trigger address resolution by using a mouse or keyboard to move a cursor to a different field. *Id.* (citing Ex. 1003, col. 10, ll. 45–49, col. 17, ll. 21–29; Ex. 1002 ¶ 119). Regarding their assertion of two alternate execute commands, Petitioners explain that "Goodhand also discloses that the **execute command** could be a 'send mail' or 'check names' command." *Id.* at 23–24 (citing Ex. 1003, col. 20, ll. 18–21, col. 16, ll. 54–56; Ex. 1002 ¶¶ 119–120). In support of this assertion, Petitioners cite, *inter alia,* Goodhand's disclosure that "[t]hose skilled in the art will appreciate that in the preferred application program, addresses are also resolved when the user sends the message or if the user selects the 'check names' command." *Id.* (quoting Ex. 1003, col. 20, ll. 18–21).

Regarding the claim language, "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 first assert that Goodhand discloses a single entry of the execute command in the form of: "(1) moving the cursor to another field, (2) sending the email, or (3) clicking a 'check names' button." Pet. 24 (citing Ex. 1003, col. 17, ll. 21–29, col. 20, ll. 18–21, col. 16, ll. 54–56; Ex. 1002 ¶ 121). Petitioners elaborate that "Goodhand discloses that after the user enters the execute command, the computer **analyzes the document** to find display names or

IPR2014-00452
Patent 6,323,853 B1

addresses **(first information)** (Ex. 1002 at ¶122), and determine[s] whether they need to be resolved." *Id.* (citing Ex. 1002 ¶ 122).

Petitioners assert that Goodhand's system does this in two ways. *Id.* First, Petitioners argue that Goodhand's system determines whether address field 600 contains more than one name. *Id.* (citing Ex. 1002 ¶ 122, Fig. 6a). Second, Petitioners contend that, Goodhand's system analyzes and identifies the display names, and it uses the display names later as search terms. *Id.* (citing Ex. 1002 ¶ 122). Petitioners argue that, "[i]n order to identify the names, the system must **determine that they are there**." *Id.* (citing Ex. 1002 ¶ 122). Petitioners elaborate that, "[i]n other words, the system has analyzed the user-entered text string to find smaller strings that can be used as a search term in a database search." *Id.* (citing Ex. 1002 ¶¶ 101, 122).

Patent Owner contends that Goodhand's system does not need to analyze the document to determine if first information is contained therein. PO Resp. 26. In support of this contention, Patent Owner argues that the Goodhand system already knows that text in address field 600 is contact information, so "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.'" *Id.* Patent Owner further argues that Goodhand's system does the same thing with all text entered into address field 600, "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.'" *Id.*

We are persuaded by Petitioners that a person of ordinary skill in the art would have understood from Goodhand that its system performs analysis to determine if address field 600 contains any information, and its system is

IPR2014-00452
Patent 6,323,853 B1

capable of breaking down the information contained in address field 600 to isolate display names, which constitute first information. Mr. Allison provides credible, persuasive testimony supporting Petitioners' arguments. *See, e.g.*, Ex. 1002 ¶¶ 101–103, 122. Mr. Allison correctly asserts that Goodhand's system resolves individual display names and can search for each display name individually. *Id.* at ¶ 103 (citing Ex. 1003, col. 19, ll. 40–42); *see also* Ex. 1003, col. 17, ll. 33–36 ("Thus, in this example, the e-mail program will attempt to match 'billb,' 'sm henry," and 'patterson' with specific address book entries belonging to registered users."). Given this and Goodhand's disclosure that a user may enter multiple display names and other information (e.g., punctuation) (*see e.g.*, Ex. 1003, col. 17, ll. 12–20; Fig. 6a), we find credible and persuasive Mr. Allison's testimony that Goodhand's system "must first check to determine whether there is any text at all in the relevant address field," and "must then separate and identify display names that it will use in follow-on searches" (Ex. 1002 ¶ 122; *see* Ex. 1016, 109, l. 22–110, l. 9).

Because we are persuaded that Goodhand's system must determine if any information is present, and the system is capable of separating display names from other information, we are not persuaded that Goodhand's system already knows address field 600 contains contact information and only contact information. As discussed in greater detail below in Section II.B.2.b.i, semicolons represent one example of text from which Goodhand's system must separate the display names that it uses to resolve e-mail addresses.

Additionally, we are persuaded that the aspects of Goodhand's processing cited by Petitioners constitute essentially the same textual

26

IPR2014-00452
Patent 6,323,853 B1

analysis disclosed by the '853 patent. Regarding determining whether the document contains any text, Petitioners cite Figure 1 of the '853 patent as showing at steps 6 and 8 that, if the system finds in the document "nothing or not interpretable," it provides an error message. Pet. Reply 5. In concert with this, Petitioners cite Dr. Levy's testimony that the same thing would occur if a person clicks send without entering text in the address field in Microsoft Outlook 2010, which Dr. Levy equates with the disclosed system of Goodhand (Ex. 2008 ¶ 28). Pet. Reply 5. Regarding Goodhand identifying display names entered in address field 600, Petitioners argue that this analysis is essentially the same as the analysis shown in Figure 1 of the '853 patent between step 6 and step 12, where the system determines that it found a name or something similar. *See* Tr. 13, ll. 15–18, 10, l. 14–11, l. 2. We find these arguments persuasive.

Patent Owner counters that the '853 patent does not disclose that its system may find nothing in the document. Tr. 24, l. 21–25, l. 20. In support of this argument, Patent Owner cites the statement at column 4, lines 29–30 of the '853 patent that "[t]he program analyzes what the user has typed in the document at step 4." *Id.* at 24, l. 22–25, l. 2. Patent Owner argues that, because the '853 patent discloses that step 4 involves analyzing "what the user has typed," "it is clear" that the language "found nothing" in Figure 1a does not mean that the document contained no text. *Id.* at 25, ll. 18–20.

Contrary to Patent Owner's assertions, the '853 patent unequivocally says that, "[a]t 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 un-interpretable the program goes to step 8 and outputs an appropriate message to the user." Ex. 1001, col. 4, ll. 25–29 (emphasis added). Given this

27

IPR2014-00452
Patent 6,323,853 B1

statement, we read the disclosures regarding steps 4 and 6 as teaching that these steps determine what the user has typed in the document, which, in some instances, may be "nothing." Accordingly, contrary to Patent Owner's assertions, we read the '853 patent as disclosing that its system may analyze an empty document to determine if it contains information.

Patent Owner also asserts that in Goodhand "there is no determination *if* first information is present," arguing that "the Goodhand process starts only after the user has placed something in [address field 600]." PO Resp. 32. Dr. Levy likewise distinguishes Goodhand from the '853 patent on the basis that, "[i]n Goodhand, . . . a user enters address information into an Address (or "To:") field before the 'resolving' process begins." Ex. 2008 ¶ 126. Patent Owner and Dr. Levy base these assertions on Goodhand's disclosure of beginning the address-resolution process in response to a user moving the cursor out of the address field. PO Resp. 32 (citing Ex. 1003, col. 19, ll. 24–31); Ex. 2008 ¶ 126.

We find these assertions of Patent Owner and Dr. Levy unpersuasive. We first note that we do not agree with the assertion that a user moving the cursor out of address field 600 necessarily occurs only after the user has entered text in address field 600.

Additionally, Patent Owner's and Dr. Levy's assertions overlook Petitioners' correct assertion that Goodhand's system also starts its address-resolution process in response to triggers other than a user moving the cursor out of address field 600. Pet. 16, 23–24. Specifically, Goodhand discloses that its system starts the address-resolution process "when the user sends the message or if the user selects the 'check names' command." Ex. 1003, col. 20, ll. 18–21; *see* Pet. 23–24. Patent Owner and Dr. Levy provide no

IPR2014-00452
Patent 6,323,853 B1

credible reason to believe that address field 600 necessarily contains display names when these other triggers occur. Indeed, as Petitioners note, in his deposition testimony, Dr. Levy testified that if a user clicks send without entering any text in the address field, he "would expect an error message that says there's no valid addressees," noting that he did not "think it would be meaningful to search for null text" and that, "[i]f it was going to do a search process, it certainly doesn't do it based on a null input field." Ex. 1016, 109, l. 22–110, l. 9.

In view of the foregoing, we are persuaded that, by determining if address field 600 contains any information and, if so, identifying any display names contained therein, Goodhand's system "analyz[es] the document to determine if the first information is contained therein."

Furthermore, even if Goodhand did not teach this limitation, we are persuaded by Petitioners' argument that it would have been obvious to a person of ordinary skill in the art in view of Goodhand's disclosure. Pet. 21. As Petitioners reason, analyzing the document to determine if address field 600 contains any text and, if so, identifying any display names therein, would have been obvious "because performing that analysis would allow the system to use the identified display names in the searches expressly taught by Goodhand." Pet. 21; *see* Ex. 1002 ¶ 122.

> b.   *Patent Owner's argument that Goodhand's system does not distinguish between first information and other text in the document*

Patent Owner also argues that Goodhand's system does not distinguish between first information and other text in the document. PO Resp. 22–25. We find this argument unpersuasive. Patent Owner's argument that "the Goodhand system cannot distinguish between contact

29

IPR2014-00452
Patent 6,323,853 B1

information and other text" (*id.* at 22) is unpersuasive because Patent Owner

concedes that the claims do not require distinguishing contact information

from other text (Tr. 37, l. 6–38, l. 1). Furthermore, we find unpersuasive

Patent Owner's argument that Goodhand's system does not distinguish

between first information and other text in the document because, as

explained in Section II.A.1.b above, we are not persuaded that claim 1

requires distinguishing first information from other text in the document.

Furthermore, even if claim 1 did require distinguishing first

information from other text in the document, Petitioners persuade us that

Goodhand's system is capable of performing this function. In addition to

display names, Goodhand shows address field 600 containing other text,

specifically semicolons and spaces. Ex. 1003, Fig. 6a, col. 17, ll. 12–20; *see*

Pet. Reply 3. Goodhand also discloses that a user may enter "an Internet e-

mail address in the form of xxxxx@yyyyy.zzz." Ex. 1003, col. 20, ll. 12–

13; Pet. Reply 6. For at least the reasons discussed below, Petitioners

persuade us that Goodhand teaches distinguishing between these different

portions of text that may be entered in address field 600. Pet. Reply 6–7

(citing Ex. 1003, Figs. 6a–6c, col. 17, ll. 12–17). Moreover, as also

discussed below, we are persuaded that, even if Goodhand's system did not

distinguish between display names, semicolons, and fully formatted e-mail

addresses, it would have been obvious in view of Goodhand to do so. *See,*

e.g., Pet. 21; *see* Ex. 1002 ¶ 122.

> i.   *Distinguishing display names from semicolons and*
>   *spaces*

We are persuaded that Goodhand's system distinguishes display

names from the semicolons and spaces between the display names. Mr.

Allison testifies that a person of ordinary skill in the art would have

IPR2014-00452
Patent 6,323,853 B1

understood Goodhand as communicating that its system uses text processing of address field 600 to separate display names. Ex. 1002 ¶ 122. As Mr. Allison notes, Goodhand's system attempts to resolve individual display names and may search each display name individually. Ex. 1002 ¶ 103 (citing Ex. 1003, col. 19, ll. 24–55, col. 17, ll. 34–37; Figs. 6a–6c). For instance, as Petitioners note, Goodhand indicates that its system identifies the individual display names "billb," "sm henry," and "Patterson" shown in Figure 6a, disclosing that the "e-mail program will attempt to match 'billb,' 'sm henry,' and 'patterson' with specific address book entries belonging to registered users." Ex. 1003, col. 17, ll. 33–36; Pet. Reply 3.

Mr. Allison further testifies that it would have been apparent to a person of ordinary skill in the art that separating the individual display names in address field 600 "could have been done by taking advantage of the semicolon delimiter." Ex. 1002 ¶ 122. Consistent with this, Petitioners cite Goodhand's disclosure that a semicolon serves as a delimiter between display names. *See* Ex. 1003, col. 17, ll. 19–20; Pet. 4. We are persuaded that, in order to resolve individual display names, Goodhand's system analyzes the text in address field 600 to distinguish the individual display names from the semicolons and spaces between the display names. *See, e.g.*, Ex. 1002 ¶¶ 103, 122.

At the oral hearing, Patent Owner argued that the semicolons and spaces are part of "first information," as recited in claim 1. Tr. 43, ll. 17–23. Regarding this argument, we note claim 1 recites that the method includes "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." Ex. 1001, col. 10, ll. 40–44. Patent

IPR2014-00452
Patent 6,323,853 B1

Owner does not identify any reason to believe that Goodhand's system searches, using a record retrieval program, an information source for second information associated with the semicolons and spaces entered in address field 600. Nor does Patent Owner identify any disclosure of the '853 patent that persuades us the semicolons and spaces in Goodhand's address field constitute "first information" according to claim 1. Accordingly, we do not find Patent Owner's argument in this regard persuasive.

Patent Owner also cites an experiment that Dr. Levy performed with Microsoft Outlook 2010 as evidence that Goodhand does not distinguish first information from other information. PO Resp. 23–25 (citing Ex. 2008 ¶¶ 28–29). Dr. Levy asserts that the operation of Microsoft Outlook 2010 is representative of how Goodhand's system would operate. Ex. 2008 ¶ 28. We agree with Petitioners that the experiment does not support Patent Owner's contention that the system does not analyze text in the address field to distinguish between display names and other information. Pet. Reply 1–5.

In his experiment, Dr. Levy typed into the address field of Outlook's email template the following "shopping list": "cheesecake; apple sauce; baloney." Ex. 2008 ¶ 28. Dr. Levy testified that, "[w]hen 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).'" *Id.*

Regarding this experiment, Petitioners argue that:

> If [Patent Owner] were correct that no "analysis" is being performed, then Outlook would have displayed the message "Microsoft Outlook does not recognize 'cheesecake; apple sauce; baloney'". Instead, Outlook correctly identified the substring "cheesecake" as "first

32

IPR2014-00452
Patent 6,323,853 B1

> information", *discarding* the trailing semicolon and
> space, as well as the remainder of the string.

Pet. Reply 3 (citing Ex. 2008 ¶ 28). Petitioners also note that, in his

deposition testimony, Dr. Levy explained that Outlook knew what to search

"[b]ecause in Outlook a semicolon is a known delimiter between addresses

in that field." Ex. 1016, 108, ll. 11–15. For at least these reasons, we agree

with Petitioners that Dr. Levy's experiment does not provide persuasive

support for Patent Owner's position.

Additionally, Petitioners persuade us that analyzing text to distinguish

display names from semicolons and spaces constitutes essentially the same

textual analysis disclosed in the '853 patent. Petitioners cite column 4, lines

29–37 of the '853 patent as providing examples of how a program may

analyze text. Pet. Reply 4. Petitioners assert that "[t]he very first example

uses 'paragraph/line separations/**formatting**, etc.'" *Id.* (quoting Ex. 1001,

col. 4, ll. 31–32) (emphasis added by Petitioners). Petitioners also note that,

when discussing the same disclosure in related U.S. Patent No. 7,921,356,

Dr. Levy testified that the disclosed approaches for analyzing text were not

exhaustive, but that analysis of text could be performed by looking at

punctuation. *Id.* (citing Ex. 1016, 96, l. 19–97, l. 7). This evidence

persuades us that Goodhand's use of semicolons to identify individual

display names constitutes essentially the same textual analysis disclosed in

the '853 patent.

> ii.   *Distinguishing fully formatted e-mail addresses*

Additionally, we are persuaded that Goodhand's system distinguishes

between fully formatted Internet e-mail addresses and other display names.

In support of their assertion that Goodhand treats fully formatted email

IPR2014-00452
Patent 6,323,853 B1

addresses differently than other information entered in address field 600,

Petitioners cite Goodhand's disclosure that:

> When a user enters an Internet e-mail address in the form of xxxxx@yyyyy.zzz, the user need not create a new name in his or her directory before the name can be resolved. The preferred e-mail system simply identifies such an address as an Internet address and resolves it without further user intervention.

Ex. 1003, col. 20, ll. 12–15. Additionally, Petitioners cite the following

portion of Dr. Levy's deposition. Pet. Reply 5–6.

> **Q   And what happens in Outlook when you enter a**
> **proper e-mail address?**
>
> A   Pretty much nothing until you send it. It
> would point -- it sends.
>
> **Q   If you type in the "To" box a proper e-mail**
> **address, will it search the contact information**
> **database before sending it?**
>
> A   That's a good question. *I actually haven't*
> *considered that.* I think it's likely that Outlook
> checks its local database of contacts to see if it
> knows this user, but it's not necessary.

Ex. 1016, 109, ll. 4–14 (emphasis added). Petitioners contrast this testimony

with Dr. Levy's prior declaration testimony reproduced below. Pet. Reply 6.

> [T]he 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".

Ex. 2008 ¶ 27. In view of this evidence, we are persuaded that Goodhand's

system distinguishes fully formatted e-mail addresses from other display

IPR2014-00452
Patent 6,323,853 B1

names and other text, contrary to the assertions of Patent Owner and Dr. Levy that Goodhand's system treats all information in address field 600 the same.

Additionally, we are persuaded that this aspect of Goodhand's processing constitutes essentially the same textual analysis disclosed in the '853 patent. Petitioners note that, in Figure 1a of the '853 patent, the process proceeds to box 10 when the system determines that the document contains an e-mail address. Tr. 13, ll. 6–15, 19–21. Petitioners assert that this disclosure in the '853 patent of distinguishing an e-mail address from a name is like Goodhand's disclosure of distinguishing a fully formatted email address from display names. *Id.* at 22–24. We find this comparison persuasive.

Patent Owner argues that Goodhand does not treat fully formatted e-mails differently than other display names. Tr. 42, ll. 13–24. Asserting that "resolves is a term of art," Patent Owner argues that the portion of Goodhand discussing the treatment of fully formatted e-mail addresses "tells us . . . that e-mails, like anything else that is entered in the 'to' field, are subject to the resolve process. So e-mails are not, contrary to what Petitioner[s] say[], they are not a different case." *Id.* at 42, ll. 19–23. Dr. Levy's deposition testimony regarding the treatment of fully formatted e-mails conflicts with Patent Owner's argument. *Compare* Tr. 42, ll. 13–14 *with* Ex. 1016, 108, l. 21–109, l. 14. We are persuaded that Goodhand distinguishes between fully formatted e-mail addresses and other display names appearing in address field 600.

35

IPR2014-00452
Patent 6,323,853 B1

> c.   *Patent Owner's argument that Goodhand requires*
> *selection*

As noted above, Patent Owner argues that certain language in the claims and the prosecution history of the '853 patent support a claim construction precluding user selection of text prior to the "single entry of the execute command," as recited in claim 1. PO Resp. 16–19. In combination with this, Patent Owner asserts that Goodhand's disclosure of a user entering text in address field 600 constitutes user selection of text. *Id.* at 1, 19, 21, 24–25 (citing Ex. 2008 ¶ 29). We find this argument unpersuasive because, as explained above in Sections II.A.1.c and II.A.1.d, we find Patent Owner's claim construction arguments unpersuasive.

In any event, even if we agreed with Patent Owner's claim construction and we were to assume that the claimed "single entry of the execute command" precludes user selection of text, we are persuaded that Goodhand does not require user selection of text prior to executing this command. In support of their contention that Goodhand's disclosed process involves analysis to determine if first information is present, as opposed to user text selection, Petitioners compare Goodhand's disclosure to the '853 patent's discussion of exemplary analysis techniques. Pet. Reply 4, 10. For example, as discussed above in Section II.B.2.b.i, Petitioners equate Goodhand's use of semicolons to the '853 patent's disclosed analysis technique of using "paragraph/line separations/formatting, etc.," and Petitioners cite to Dr. Levy's deposition testimony that looking at punctuation constitutes a form of analysis. *Id.* at 4 (citing Ex. 1016, 96, l. 19–97, l. 7). Petitioners also point to the '853 patent's disclosure of using the term "Mr." to analyze text. *Id.* at 10 (citing Ex. 1001, col. 4, l. 34). Petitioners then argue that placement of text in address field 600 does not

36

IPR2014-00452
Patent 6,323,853 B1

constitute selection any more than placing text after the word "Mr." *Id.*

These comparisons of Goodhand's disclosure to that of the '853 patent

provide persuasive support for Petitioners' contentions that Goodhand's

processing involves essentially the same textual analysis as disclosed in the

'853 patent, and not user text selection, as argued by Patent Owner.

Patent Owner quotes Dr. Levy's testimony for the proposition that

Goodhand's disclosure of entering text in address field 600 constitutes text

selection. PO Resp. 24–25 (quoting Ex. 2008 ¶ 29). Dr. Levy asserts that

Goodhand's system does not need to perform analysis to determine if first

information is present in address field 600 because "user entry of text into

the address field constitutes characterization of the text as name or alias

information." Ex. 2008 ¶ 29. Dr. Levy elaborates that "the Goodhand

system is not structured to distinguish between contact information and other

textual content." *Id.* In concert with these assertions, Dr. Levy further

asserts that entering text into address field 600 constitutes "selecting" the

text because "[b]y 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." *Id.*

For a number of reasons, we find Patent Owner's and Dr. Levy's

assertions less persuasive than Petitioners'. For example, whereas

Petitioners cite examples of textual "analysis" in the '853 patent to support

their contention that Goodhand discloses textual analysis instead of

selection, Patent Owner and Dr. Levy do not cite any specific examples of

"selection" in the '853 patent to support their contention that Goodhand

discloses selection instead of textual analysis. Patent Owner and Dr. Levy

37

IPR2014-00452
Patent 6,323,853 B1

do not discuss the '853 patent's disclosure regarding text selection, which states that "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.)." Ex. 1001, col. 10, l. 8. The disclosed examples of "selecting" text—highlighting, selecting, italicizing, underlining—differ from typing new text in address field 600, and neither Patent Owner nor Dr. Levy addresses the disparity.

Additionally, in asserting that Goodhand's disclosed process involves user text selection, Patent Owner and Dr. Levy do not discuss the "selection" disclosed by Tso that was allegedly distinguished during prosecution. The disclosure in Tso states:

> 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*. The particular method by which such a selection is made will vary according to the user input device available to the user. For example, where the user has access to a laptop or other personal computer, *the selection could be accomplished using a mouse*. On the other hand, with a device having limited user interface capabilities, such as a Smartphone, *the selection could be accomplished by appropriately positioning a cursor using a touch keypad and pressing an "ENTER" key*.

Ex. 2003, col. 4, ll. 31–42 (emphases added). Here again, these examples differ from typing new text in address field 600, and neither Patent Owner nor Dr. Levy addresses the disparity.

Furthermore, Dr. Levy confuses the issue in his testimony that, by typing text in address field 600, the user "designated" the text, "just as if the user had selected" it. *See* Ex. 2008 ¶ 29. This assertion suggests that Goodhand's disclosure constitutes "selection" because it is like selection.

38

IPR2014-00452
Patent 6,323,853 B1

The assertion that an act is *like* selection does not persuade us that it actually *is* selection.

Additionally, Dr. Levy's assertion that Goodhand requires text selection, which appears in paragraph 29 of his Declaration, rests on the results of his experiment with Microsoft Outlook 2010. *See* Ex. 2008 ¶¶ 28–29. Dr. Levy asserts that, "[s]ince 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." Ex. 2008 ¶ 28. Dr. Levy does not cite adequate evidence to persuade us that operation of Microsoft Outlook 2010 is representative of the full scope of how Goodhand's system operates. Given this, and given that Dr. Levy's assertion that Goodhand requires user text selection rests on his experiment with Microsoft Outlook 2010, we find Dr. Levy's testimony unpersuasive.

Furthermore, as discussed above, Petitioners persuade us that Goodhand teaches or renders obvious performing analysis to determine if address field 600 contains any information and, if so, determining if address field 600 contains display names, as opposed to, e.g., semicolons and fully formatted e-mail addresses. This vitiates one of the principal bases of Dr. Levy's conclusion that Goodhand's process involves text selection—that "no analysis is required to 'determine if 'first information' is present.'" Ex. 2008 ¶ 29. Indeed, Patent Owner argues that if a user has selected information, no analysis is needed to determine if the document contains information. PO Resp. 18. By this reasoning, if a system analyzes a document to determine if it contains information, then the user must not have selected information. In light of Patent Owner's reasoning, we are

39

IPR2014-00452
Patent 6,323,853 B1

persuaded that Goodhand does not require text selection prior to the "single entry of the execute command."

Moreover, even if we assume that entering text in address field 600 did constitute selection of that text, we are not persuaded that Goodhand requires selection of text as a pre-condition to analyzing the document to determine if first information is contained therein. As explained above in Section II.B.2.a, we are persuaded that Goodhand teaches or renders obvious responding to movement of the cursor from address field 600, entry of a check names command, or entry of a send command by analyzing the document to determine if any text is contained in address field 600. As also explained in Section II.B.2.a, we are further persuaded that Goodhand does not require a user to enter text into address field 600 before moving the cursor from address field 600, entering a check names command, or entering a send command.

d. Summary

In summary, we determine that Petitioners have demonstrated, by a preponderance of the evidence, that claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 are unpatentable because they would have been obvious 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

Petitioners assert that claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Goodhand and Padwick. Pet. 37–44. Petitioners provide reasons explaining why it would have been obvious to combine the teachings of Goodhand and Padwick, and Petitioners explain how the combination of Goodhand and Padwick allegedly teaches the subject matter

40

IPR2014-00452
Patent 6,323,853 B1

of each of the challenged claims. *Id.* In doing so, Petitioners rely on the Declaration of Mr. Allison. Ex. 1002. With each of the challenged claims depending directly or indirectly from independent claim 1, Petitioners cite their challenge of independent claim 1 based on obviousness over Goodhand to address the limitations of claim 1. *See* Pet. 38 ("Goodhand is applied as in Ground 1, above."). Aside from the above-discussed arguments disputing Petitioners' treatment of the limitations of independent claim 1, Patent Owner does not address separately Petitioners' challenge of claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 as unpatentable under 35 U.S.C. § 103(a) over Goodhand and Padwick. We have reviewed the evidence and arguments presented, and we find Petitioners' assertions persuasive. We adopt Petitioners' proposed facts as our findings of fact with respect to the teachings of the prior art. We determine that Petitioners have demonstrated, by a preponderance of the evidence, that claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 are unpatentable because they would have been obvious over Goodhand and Padwick.

III. CONCLUSION

Petitioners have shown, by a preponderance of the evidence, that claims 1–9, 11, 13–29, 38–45, 57–64, 66, 68–75, 77, and 79 of the '853 patent would have been obvious over Goodhand.

Petitioners also have shown, by a preponderance of the evidence, that claims 6, 10, 12, 21, 27, 30–37, 42, 46–56, 61, 65, 67, 72, 76, and 78 would have been obvious over Goodhand and Padwick.

IPR2014-00452
Patent 6,323,853 B1

IV. ORDER

In consideration of the foregoing, it is

ORDERED that claims 1–79 of the '853 patent are determined to be *unpatentable*; 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.

IPR2014-00452
Patent 6,323,853 B1

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bsunstein@sunsteinlaw.com

Exhibit 6JJ

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application of:)
    Atle Hedloy)
)
)
Serial No.: 09/923,134)   Examiner: Crescelle dela Torre
)
Filed: August 6, 2001)
)   Art Unit: 2174
For: METHOD, SYSTEM AND)
    COMPUTER READABLE ME-)
    DIUM FOR ADDRESSING)
    HANDLING FROM A COM-)
    PUTER PROGRAM)

Cesari and McKenna, LLP
88 Black Falcon Avenue
Boston, MA 02210
April 15, 2003

RECEIVED

"Express Mail" Mailing-Label Number: EL714808145US

APR 1 8 2003

Honorable Assistant Commissioner for Patents
Washington, D.C. 20231

Technology Center 2400

Sir:

AMENDMENT

This Amendment is filed in response to the Office Action mailed October 15, 2002.

All objections and rejections are respectfully traversed.

<u>In the claims</u>:

2. (Twice Amended)   The method of claim 1, wherein the user selection further comprises activating 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 or other standard user interface device.

1

1   8. (Amended) Computer data signals embodied in a carrier wave, the computer data signals

2   carrying information for practicing the method of claim 1.

REMARKS

This Amendment is filed in response to the Office Action mailed October 15, 2002.

All rejections and objections are respectfully traversed.

At paragraph 1 of the Office Action, the Examiner helpfully reminded the Applicant

that a claim for foreign priority has not yet been made in this application. Applicant respect-

fully requests priority to September 3, 1998 based upon the papers filed in the parent appli-

cation, United States Application No. 09/189,626 now United States Patent No. 6,323,853.

The Examiner rejected claims 1-18 under 35 U.S.C. §112, first paragraph because the

Examiner felt that it was not clear where the step of "automatically marking the first infor-

mation to alert the user that the first information can be utilized in a second application pro-

gram" is described in the specification. Applicant respectfully traverses this rejection. The

specification states, at page 7, line 16 to page 8, line 3:

> In Figure 1, after the user has inserted the address in the word processor, the
> user commands the button at step 2 and the program analyzes 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 un-interpretable the program goes to step 8 and outputs an
> appropriate message to the user and then quits at step 16. The program ana-
> lyzes what the user has typed in the document at step 4, for example, by ana-
> lyzing (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 data-
> base of common male/female names, etc.

Thus, the specification contains the requisite support for these claim elements.

The Examiner rejected claim 8 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claim 8 has been amended to better point out that it is claiming computer data signals embodied in a carrier wave and not electromagnetic signals per se.

At paragraph 10 of the Office Action, the Examiner rejected claims 1-18 under 35 U.S.C. §103(a) as being obvious in light of Tso (United States Patent Number 6,085,201) in view of Pandit (United States Patent Number 5,859,636). Applicant respectfully traverses this rejection. Pandit does teach marked information, including marked information with highlighted text in column 2, lines 5-6. However, Pandit accents or highlights the text by "shading, underlining or pointing to and clicking on the text." Column 2, lines 7-8. As noted above, the applicants claimed invention automatically marks the text without user intervention. The highlighting of text as disclosed by Pandit requires the user to manually highlight or select the text. Thus, Pandit does not teach the claimed elements.

Applicant requests that the Examiner contact the undersigned by telephone in order to advance the prosecution of this application.

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

Duane H. Dreger
Reg. No. 48,836
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88 Black Falcon Avenue
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 (617) 951-2500

MARK-UP PAGES FOR THE APRIL 15, 2003, AMENDMENT TO
U.S. PATENT APPLICATION SER. NO. 09/923,134 .

The replacement for claim 2 resulted from the following changes:

1   2. (Twice Amended)   The method of claim 1, wherein the user selection further comprises

2   [an activation] <u>activating</u> a device selected from a group consisting of a touch screen, a key-

3   board button, a screen button, an icon, a menu, a voice command device or other standard

4   user interface device.

The replacement for claim 8 resulted from the following changes:

1   8. (Amended)   [Electromagnetic signals propagating over a computer network, the electro-

2   magnetic] <u>Computer data signals embodied in a carrier wave, the computer data</u> signals car-

3   rying information for practicing the method of claim 1.
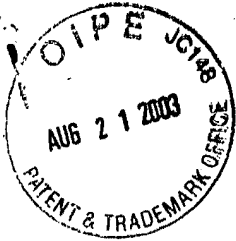
4

Exhibit 6KK

PATENTS
103176-0001C1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application of:)
    Atle Hedloy)
)
Serial No.: 09/923,134)
)
Filed: August 6, 2001)
)
For: METHOD, SYSTEM AND)
    COMPUTER READABLE ME-)
    DIUM FOR ADDRESSING)
    HANDLING FROM A COM-)
    PUTER PROGRAM

Examiner: Luu, Sy D   **RECEIVED**

Art Unit: 2174   AUG 2 6 2003

Technology Center 2100

Cesari and McKenna, LLP
88 Black Falcon Avenue
Boston, MA 02210
August 21, 2003

"Express Mail" Mailing-Label Number: EV336752739US

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

Sir:

REQUEST FOR CONTINUED EXAMINATION UNDER 35 C.F.R. §1.114

This is a Request for Continued Examination under 35 C.F.R. §1.114. In response to the Office action dated June 27, 2003, please enter the following amendments:

1

IN THE CLAIMS:

1. (Currently Amended): 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;

~~automatically~~ marking <u>without user intervention</u> 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.

2. (Previously Presented): The method of claim 1, wherein the user selection further comprises an activation 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 or other standard user interface device.

3. (Original): The method of claim 1, wherein the step of inserting the second information into the document further comprises the steps of:

initializing the second application program;

searching, using the second application program, for the second information associated with the first information; and

retrieving the second information.

4. (Original) The method of claim 3, wherein when the second application program includes second information associated with the first information, performing the further step of displaying the second information.

2

5. (Original): The method of claim 4, further comprising the step of:

    completing at least one of the first and second information in the document.

6. (Original): The method of claim 1, wherein the first information comprises a name.

7. (Original): A computer readable medium, including program instructions, for performing the method of claim 1.

8. (Previously Presented): Electromagnetic signals propagating over a computer network, the electromagnetic signals carrying information for practicing the method of claim 1.

9. (Previously Presented): A computer readable medium, including program instructions, for performing the method of claim 2.

10. (Previously Presented): A computer readable medium, including program instructions, for performing the method of claim 3.

11. (Previously Presented): A computer readable medium, including program instructions, for performing the method of claim 4.

12. (Previously Presented): A computer readable medium, including program instructions, for performing the method of claim 5.

13. (Previously Presented): A computer readable medium, including program instructions, for performing the method of claim 6.

14. (Currently Amended): A method for information handling within a document created by a first application program comprising the steps of:

    entering a first information in the first application program;

3

automatically 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 performing an operation related to a second information, the second information associated with the first information from the second application program.

15. (Previously Presented): The method of claim 14, wherein the first information is a name, and the operation performed is selected from a group consisting of an electronic mail, a telex, a facsimile or a letter addressed to the name indicated by the first information.

16. (Previously Presented): The method of claim 14, wherein the operation performed is entering additional data into a database.

17. (Previously Presented): The method of claim 16, wherein the additional data is entered by a user.

18. (Previously Presented): The method of claim 16, wherein the additional data is located within the document.

REMARKS
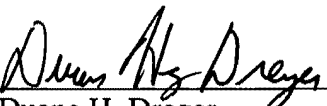
This Request For Continued Examination Under 35 C.F.R. §1.114 is filed along with this Amendment in response to the Final Office Action dated June 27, 2003.

The Examiner rejected claims 1-18 under 35 U.S.C. §103(a) as being unpatentable over Tso (U.S. Patent No. 6,085,201) in view of Pandit (U.S. Patent No. 5,859,636). The Examiner disagreed with Applicant's argument that the claimed invention marked the text without user intervention, whereas Pandit's marking of the text requires the user to manually highlight or select the text. By this Amendment, Applicant has amended claims 1 and 14 to better claim the invention by adding the phrase "without user intervention" to the claim language per the Examiner's suggestion.

Applicant believes that all claims are now in a condition for allowance and respectfully requests the issuance of a Notice of Allowance

Please charge any additional fee occasioned by this paper to our Deposit Account No. 03-1237.

Respectfully submitted,

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(617) 951-2500

5

Exhibit 6LL

PATENTS
103176-0001C1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application of:)
    Atle Hedloy   )
)

Serial No.: 09/923,134   )   Examiner: Lau, Sy D
)

Filed: August 6, 2001   )
)   Art Unit: 2174

For: METHOD, SYSTEM AND   )
    COMPUTER READABLE ME-   )
    DIUM FOR ADDRESSING   )
    HANDLING FROM A COM-   )
    PUTER PROGRAM

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April 18, 2007

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Sir:

AMENDMENT

In response to the Office action dated October 18, 2006, please enter the following amendments:

1

IN THE CLAIMS:

1   1. (CANCELLED)

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1   3. (CANCELLED):

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PATENTS
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1   33. (CANCELLED)

1   34. (CANCELLED)

1   35. (PREVIOUSLY PRESENTED): A method for information handling within a document

2   created using a first application program comprising the steps of:

3   entering a first information in the first application program;

4   marking without user intervention the first information to alert the user that the first

5   information can be utilized in a second application program; and

6   responding to a user selection by inserting a second information into the document,

7   the second information associated with the first information from a second application pro-

8   gram.

1   36. (PREVIOUSLY PRESENTED): The method of claim 35 wherein the user selection fur-

2   ther comprises an activation of a device selected from a group consisting of a touch screen, a

3   keyboard button, a screen button, an icon, a menu, and a voice command device.

1   37. (PREVIOUSLY PRESENTED): The method of claim 35, wherein the step of inserting

2   the second information into the document further comprises the steps of:

3   initializing the second application program;

4   searching, using the second application program, for the second information associ-

5   ated with the first information; and

6   retrieving the second information.

1   38. (PREVIOUSLY PRESENTED): The method of claim 37, wherein when the second ap-

2   plication program includes second information associated with the first information, per-

3   forming the further step of displaying the second information.

1   39. (PREVIOUSLY PRESENTED): The method of claim 38, further comprising the step of

2   completing at least one of the first and second information in the document.

1   40. (PREVIOUSLY PRESENTED): The method of claim 35, wherein the first information

2   comprises a name.

1   41. (PREVIOUSLY PRESENTED): A computer readable medium, including program in-

2   structions related to information handling within a document created using a first application

3   program and for performing the steps of:

4   entering a first information in the first application program;

5   marking without user intervention the first information to alert the user that the first

6   information can be utilized in a second application program; and

7   responding to a user selection by inserting a second information into the document,

8   the second information associated with the first information from a second application pro-

9   gram.

1   42. (PREVIOUSLY PRESENTED): The computer readable medium of claim 41, wherein

2   the user selection further comprises an activation of a device selected from a group consist-

3   ing of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice com-

4   mand device.

6

1   43. (PREVIOUSLY PRESENTED): The computer readable medium of claim 41, wherein

2   the step of inserting the second information into the document further comprises the steps of:

3   initializing the second application program;

4   searching, using the second application program, for the second information associ-

5   ated with the first information; and

6   retrieving the second information.

1   44. (PREVIOUSLY PRESENTED): The computer readable medium of claim 43, wherein

2   when the second application program includes second information associated with the first

3   information, performing the further step of displaying the second information.

1   45. (PREVIOUSLY PRESENTED): The computer readable medium of claim 44, further

2   comprising the step of completing at least one of the first and second information in the

3   document.

1   46. (PREVIOUSLY PRESENTED): The computer readable medium of claim 41, wherein

2   the first information comprises a name.

1   47. (PREVIOUSLY PRESENTED): A computer system related to information handling

2   within a document created using a first application program, comprising:

3   means for entering a first information in the first application program;

4   means for marking without user intervention the first information to alert the user

5   that the first information can be utilized in a second application program; and

6   means for responding to a user selection by inserting a second information into the

7   document, the second information associated with the first information from a second appli-

8   cation program.

1   48. (PREVIOUSLY PRESENTED): The computer system of claim 47, wherein the means

2   for the user selection further comprises:

3   means for an activation of a device selected from a group consisting of a touch

4   screen, a keyboard button, a screen button, an icon, a menu, and a voice command device.

1   49. (PREVIOUSLY PRESENTED): The computer system of claim 47, wherein the means

2   for inserting the second information into the document further comprises:

3   means for initializing the second application program;

4   means for searching, using the second application program, for the second informa-

5   tion associated with the first information; and

6   means for retrieving the second information.

1   50. (PREVIOUSLY PRESENTED): The computer system of claim 49, wherein when the

2   second application program includes second information associated with the first informa-

3   tion, and comprising means for performing the further step of displaying the second informa-

4   tion.

1   51. (PREVIOUSLY PRESENTED): The computer system of claim 50, further comprising

2   means for completing at least one of the first and second information in the document.

1   52. (PREVIOUSLY PRESENTED): The computer system of claim 47, wherein the first in-

2   formation comprises a name.

1   53. (PREVIOUSLY PRESENTED): A method for information handling within a document

2   created by a first application program comprising the steps of:

3   entering a first information in the first application program;

4   marking without user intervention the first information to alert the user that the first

5   information can be utilized in a second application program; and

6   responding to a user selection by performing an operation related to a second infor-

7   mation, the second information associated with the first information from the second applica-

8   tion program.

1   54. (PREVIOUSLY PRESENTED): The method of claim 53 wherein the operation com-

2   prises displaying the second information.

1   55. (PREVIOUSLY PRESENTED): The method of claim 53, wherein the first information is

2   a name, and the operation performed is selected from a group consisting of an electronic

3   mail, a telex, a facsimile or a letter addressed to the name indicated by the first information.

1   56. (PREVIOUSLY PRESENTED): The method of claim 53, wherein the operation per-

2   formed is entering additional data into a database.

1   57. (PREVIOUSLY PRESENTED): The method of claim 56, wherein the additional data is

2   entered by a user.

1   58. (PREVIOUSLY PRESENTED): The method of claim 56, wherein the additional data is

2   located within the document.

1   59. (PREVIOUSLY PRESENTED): A computer readable medium, including program in-

2   structions related to information handling within a document created by a first application

3   program and for performing the steps of:

4   entering a first information in the first application program;

5   marking without user intervention the first information to alert the user that the first

6   information can be utilized in a second application program; and

7   responding to a user selection by performing an operation related to a second infor-

8   mation, the second information associated with the first information from the second applica-

9   tion program.

1   60. (PREVIOUSLY PRESENTED): The computer readable medium of claim 59 wherein

2   the operation comprises displaying the second information.

1   61. (PREVIOUSLY PRESENTED): The computer readable medium of claim 59, wherein

2   the first information is a name, and the operation performed is selected from a group consist-

3   ing of an electronic mail, a telex, a facsimile or a letter addressed to the name indicated by

4   the first information.

1   62. (PREVIOUSLY PRESENTED): The computer readable medium of claim 59, wherein

2   the operation performed is entering additional data into a database.

1   63. (PREVIOUSLY PRESENTED): The computer readable medium of claim 62, wherein

2   the additional data is entered by a user.

1   64. (PREVIOUSLY PRESENTED): The computer readable medium of claim 62, wherein

2   the additional data is located within the document.

1   65. (PREVIOUSLY PRESENTED): A computer system related to information handling

2   within a document created by a first application program, comprising:

3   means for entering a first information in the first application program;

4   means for marking without user intervention the first information to alert the user that

5   the first information can be utilized in a second application program; and

10

6   means for responding to a user selection by performing an operation related to a sec-

7   ond information, the second information associated with the first information from the sec-

8   ond application program.

1   66. (PREVIOUSLY PRESENTED): The computer system of claim 65 wherein the operation

2   comprises displaying the second information.

1   67. (PREVIOUSLY PRESENTED): The computer system of claim 65, wherein the first in-

2   formation is a name, and the operation performed is selected from a group consisting of an

3   electronic mail, a telex, a facsimile or a letter addressed to the name indicated by the first in-

4   formation.

1   68. (PREVIOUSLY PRESENTED): The computer system of claim 65, wherein the operation

2   performed is entering additional data into a database.

1   69. (PREVIOUSLY PRESENTED): The computer system of claim 68, wherein the addi-

2   tional data is entered by a user.

1   70. (CURRENTLY AMENDED): A method for information handling within a document

2   operated on by a first application program, the document containing first information <u>that can</u>

3   <u>be utilized in a second application program</u> ~~entered by a user~~, the method comprising the

4   steps of:

5   identifying without user intervention <u>or designation </u>the first information ~~that can be~~

6   ~~utilized in a second application program~~; and

7   responding to a user selection by inserting a second information into the document,

8   the second information associated with the first information from a second application pro-

9   gram.

10 ~~responding to a user selection by inserting into the document a second information re-~~

11 ~~trieved from a second application program through use of said first information.~~

1 71. (PREVIOUSLY PRESENTED): The method of claim 70, wherein the user selection fur-

2 ther comprises an activation of a device selected from a group consisting of a touch screen, a

3 keyboard button, a screen button, an icon, a menu, and a voice command device.

1 72. (PREVIOUSLY PRESENTED): The method of claim 70, wherein the step of inserting

2 the second information into the document further comprises the steps of:

3   initializing the second application program;

4   searching, using the second application program, for the second information associ-

5   ated with the first information; and

6   retrieving the second information.

1 73. (CURRENTLY AMENDED): The method of claim 72 wherein the step of inserting the

2 second information <u>into</u> ~~in to~~ the document further comprises adding the second information

3 to the first information in the document.

1 74. (CURRENTLY AMENDED): The method of claim <u>72</u>~~73~~, wherein when the second ap-

2 plication program includes second information associated with the first information, perform-

3 ing the further step of displaying the second information.

1 75. (CURRENTLY AMENDED): The method of claim <u>72</u> ~~73~~, further comprising the step of

2 completing at least one of the <u>first</u> ~~search~~ and second information in the document.

1 76. (CURRENTLY AMENDED): The method of claim 70, wherein the <u>first</u> ~~search~~ informa-

2 tion comprises a name.

12

1   77. (CURRENTLY AMENDED): A computer readable medium, including program instruc-

2   tions related to information handling within a document operated on by a first application

3   program, the document containing first information <u>that can be utilized in a second applica-</u>

4   <u>tion program</u> ~~entered by a user~~, and for performing the steps of:

5   identifying without user intervention <u>or designation</u> the first information ~~that can be~~

6   ~~utilized in a second application program~~; and

7   responding to a user selection by inserting a second information into the document,

8   the second information associated with the first information from a second application pro-

9   gram.

10   ~~responding to a user selection by inserting into the document a second information re-~~

11 ~~trieved from a second application program through use of said first information.~~

1   78. (PREVIOUSLY PRESENTED): The computer readable medium of claim 77, wherein

2   the user selection further comprises an activation of a device selected from a group consisting

3   of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice command

4   device.

1   79. (PREVIOUSLY PRESENTED): The computer readable medium of claim 77, wherein

2   the step of inserting the second information into the document further comprises the steps of:

3   initializing the second application program;

4   searching, using the second application program, for the second information associ-

5   ated with the first information; and

6   retrieving the second information.

1   80. (CURRENTLY AMENDED): The method of claim 79 wherein the step of inserting the

2   second information <u>into</u> ~~in to~~ the document further comprises adding the second information

3   to the first information in the document.

1   81. (PREVIOUSLY PRESENTED): The computer readable medium of claim 80, wherein

2   when the second application program includes second information associated with the first

3   information, performing the further step of displaying the second information.

1   82. (PREVIOUSLY PRESENTED): The computer readable medium of claim 80, further

2   comprising the step of completing at least one of the search and second information in the

3   document.

1   83. (PREVIOUSLY PRESENTED): The computer readable medium of claim 77, wherein

2   the search information comprises a name.

1   84. (CURRENTLY AMENDED): A computer system related to information handling within

2   a document operated on by a first application program, the document containing first infor-

3   mation that can be utilized in a second application program ~~entered by a user~~, comprising:

4   means for identifying without user intervention or designation the first information

5   ~~that can be utilized in a second application program~~; and

6   means for responding to a user selection by inserting a second information into the

7   document, the second information associated with the first information from a second appli-

8   cation program.

9   ~~means for responding to a user selection by inserting into the document a second in-~~

10   ~~formation retrieved from a second application program through use of said first information.~~

1   85. (PREVIOUSLY PRESENTED): The computer system of claim 84, wherein the means

2   for user selection further comprises means for an activation of a device selected from a group

3   consisting of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice

4   command device.

1   86. (PREVIOUSLY PRESENTED): The computer system of claim 84, wherein the means

2   for inserting the second information into the document further comprises:

3   means for initializing the second application program;

4   means for searching, using the second application program, for the second informa-

5   tion associated with the first information; and

6   means for retrieving the second information.

1   87. (CURRENTLY AMENDED): The computer system of claim 84 wherein the means for

2   inserting the second information into ~~in to~~ the document further comprises means for adding

3   the second information to the first information in the document.

1   88. (PREVIOUSLY PRESENTED): The computer system of claim 84, wherein when the

2   second application program includes second information associated with the first informa-

3   tion, and comprising means for performing the further step of displaying the second informa-

4   tion.

1   89. (PREVIOUSLY PRESENTED): The computer system of claim 88, further comprising

2   means for completing at least one of the search and second information in the document.

1   90. (PREVIOUSLY PRESENTED): The computer system of claim 84, wherein the search

2   information comprises a name.

1   91. (CURRENTLY AMENDED): A method for information handling within a document op-

2   erated on by a first application program, the document containing first information that can

3   be utilized in a second application program ~~entered by a user,~~ the method comprising the

4   steps of:

5   identifying without user intervention or designation the first ~~information that can be~~

6   ~~utilized in a second application program~~; and

7   responding to a user selection by performing an operation related to a second in-

8 formation, the second information associated with the first information from the second ap-

9 plication program.

1 92. (PREVIOUSLY PRESENTED): The method of claim 91 wherein the operation com-

2 prises displaying the second information.

1 93. (PREVIOUSLY PRESENTED): The method of claim 91, wherein the search information

2 is a name, and the operation performed is selected from a group consisting of generating an

3 electronic mail, a telex, a facsimile or a letter addressed to the name indicated by the search

4 information.

1 94. (PREVIOUSLY PRESENTED): The method of claim 91, wherein the operation per-

2 formed is entering additional data into a database

1 95. (PREVIOUSLY PRESENTED): The method of claim 94, wherein the additional data is

2 entered by a user.

1 96. (PREVIOUSLY PRESENTED): The method of claim 94, wherein the additional data is

2 located within the document.

1 97. (CURRENTLY AMENDED): A computer readable medium, including program instruc-

2 tions related to information handling within a document operated on by a first application

3 program, the document containing first information <u>that can be utilized in a second applica-</u>

4 <u>tion program</u> entered by a user, and for performing the steps of:

5   identifying without user intervention <u>or designation</u> the first information <s>that can be</s>

6 <s>utilized in a second application program</s>; and

7   responding to a user selection by performing an operation related to a second infor-

8   mation, the second information associated with the first information from the second applica-

9   tion program.

1   98. (PREVIOUSLY PRESENTED): The computer readable medium of claim 97 wherein

2   the operation comprises displaying the second information.

1   99. (PREVIOUSLY PRESENTED): The computer readable media of claim 97, wherein the

2   first information is a name, and the operation performed is selected from a group consisting

3   of generating an electronic mail, a telex, a facsimile or a letter addressed to the name indi-

4   cated by the first information.

1   100. (PREVIOUSLY PRESENTED): The computer readable media of claim 97, wherein the

2   operation performed is entering additional data into a database

1   101. (PREVIOUSLY PRESENTED): The computer readable media of claim 100, wherein

2   the additional data is entered by a user.

1   102. (PREVIOUSLY PRESENTED): The computer readable media of claim 100, wherein

2   the additional data is located within the document.

1   103. (CURRENTLY AMENDED): A computer system related to information handling

2   within a document operated on by a first application program, the document containing first

3   information that can be utilized in a second application program entered by a user, compris-

4   ing:

5   means for identifying without user intervention or designation the first information

6   that can be utilized in a second application program; and

17

7   means for responding to a user selection by performing an operation related to a sec-

8   ond information, the second information associated with the first information from the sec-

9   ond application program.

1   104. (PREVIOUSLY PRESENTED): The computer system of claim 103 wherein the opera-

2   tion comprises displaying the second information.

1   105. (PREVIOUSLY PRESENTED): The computer system of claim 103, wherein the first

2   information is a name, and the operation performed is selected from a group consisting of

3   generating an electronic mail, a telex, a facsimile or a letter addressed to the name indicated

4   by the first information.

1   106. (PREVIOUSLY PRESENTED): The computer system of claim 103, wherein the opera-

2   tion performed is entering additional data into a database

1   107. (PREVIOUSLY PRESENTED): The computer system of claim 106, wherein the addi-

2   tional data is entered by a user.

1   108. (PREVIOUSLY PRESENTED): The computer system of claim 106, wherein the addi-

2   tional data is located within the document.

1   109. (NEW) The method of claim 91 wherein the user selection comprises an activation of a

2   menu.

1   110. (NEW) The method of claim 91 wherein at least part of the identifying occurs after the

2   user selection.

1   111. (NEW) The method of claim 91 wherein the identifying occurs after the user selection.

18

1   112. (NEW): The method of claim 109, wherein the step of performing the operation further

2   comprises the steps of:

3   initializing the second application program;

4   searching, using the second application program, for the second information associ-

5   ated with the first information; and

6   retrieving the second information.

1   113. (NEW): The method of claim 112, wherein when the second information associated

2   with first information exists, performing the further step of displaying the second informa-

3   tion.

1

2   114. (NEW): The method of claim 113, wherein the first information comprises a name.

1

2   115. (NEW): The method of claim 114, wherein the activation of the menu comprises

3   selection the menu indicator for the menu

4   opening the menu

5   selecting a choice in the menu; and

6   activating the selected choice in the menu

7

1   116. (NEW): The method of claim 115, wherein selection of the menu indicator comprises

2   moving a mouse pointer to the menu indicator.

1   117. (NEW): The method of claim 116, wherein the opening of a menu comprises clicking

2   on the menu indicator with a mouse button.

1   118. (NEW) The method of claim 91, wherein the second information is associated with only

2   part of the identified first information.

19

1   119. (NEW): A method for information handling within a document operated on by a first

2   application program, the document containing first information entered by a user, the method

3   comprising the steps of:

4   identifying without user intervention or designation the first information that can be

5   utilized in a second application program, the first information selected from a Group consist-

6   ing of a name and an address; and

7   responding to a user selection by performing an operation related to a second in-

8   formation, the second information associated with all or part of the first information from the

9   second application program, wherein the step of responding to the user selection further com-

10   prises the steps of:

11   initializing the second application program;

12   searching, using the second application program, for the second information associ-

13   ated with the first information; and

14   if said second information exists, retrieving and displaying the second information;

15   wherein said user selection comprises:

16   selecting a menu indicator for the menu;

17   opening the menu;

18   selecting a choice in the menu; and

19   activating the selected choice in the menu;

20   wherein selecting the menu indicator comprises moving the mouse pointer to the

21   menu indicator;

22   wherein opening the menu comprises clicking on the menu indicator with a mouse

23   button; and

24   wherein the second information is associated with at least part of the identified first

25   information.

1   120. (NEW)   A method for assisting a computer operator to retrieve contact related infor-

2   mation from a database when a document includes a name, the method comprising of the

3   steps of:

4

5   (1)   using a first computer program to analyze the document, without direction

6   from the operator, to identify the name,

7

8   (2)   using the identified name and a second computer program to search the

9   database and to locate related information associated with the name, and

10

11   (3)   inserting the contact related information into the document,

12

13   wherein steps (1) - (3) require only a single execute command.

1   121. (NEW) The method of claim 120 wherein the contact information comprises an ad-

2   dress.

1   122. (NEW) The method of claim 120 wherein the contact information comprises a tele-

2   phone number.

1   123. (NEW) The method of claim 120 wherein the name comprises a business name.

1   124. (NEW) The method of claim 120 wherein the name comprises a personal name.

1   125. (NEW) The method according to claim 120 wherein the execute command is a selec-

2   tion from a menu.

1   126. (NEW) The method according to claim 125 wherein the operator enters the execute

2   command before step (2).

21

1   127. (NEW)   A method for assisting a computer operator to retrieve information from a da-

2   tabase that is related to text in a document, the method comprising the steps of:

3

4   (1)   using a first computer program to analyze the document, without direction

5   from the operator, to identify text in the document that can be used to search

6   for related information,

7

8   (2)   using a second computer program and the text identified in step (1)

9   to search the database and to locate related information, and

10

11   (3)   inserting the information located in step (2) into the document.

1   128. (NEW)   The method according to claim 127 wherein at least steps (2) - (3) take place

2   following entry a single execute command.

1   129. (NEW)   The method according to claim 128 wherein the execute command is a selec-

2   tion from a menu.

1   130. (NEW)   A computer readable medium for information handling within a document op-

2   erated on by a first application program, the document containing first information entered by

3   a user, the computer readable medium including program instructions for performing the

4   steps of:

5   identifying without user intervention or designation the first information that can be

6   utilized in a second application program, the first information selected from a group consist-

7   ing of a name and an address; and

8   responding to a user selection by performing an operation related to a second in-

9   formation, the second information associated with all or part of the first information from the

10   second application program, wherein the step of responding to the user selection further com-

11   prises the steps of:

22

12   initializing the second application program;

13   searching, using the second application program, for the second information associ-

14   ated with the first information; and

15   if said second information exists, retrieving and displaying the second information;

16   wherein said user selection comprises:

17   selecting a menu indicator for the menu;

18   opening the menu;

19   selecting a choice in the menu; and

20   activating the selected choice in the menu;

21   wherein selection the menu indicator comprises moving the mouse pointer to the

22   menu indicator;

23   wherein the opening of a menu comprises clicking on the menu indicator with a

24   mouse button; and

25   wherein the second information is associated with at least part of the identified first

26   information.

1   131. (NEW) A computer readable medium for assisting a computer operator to retrieve con-

2   tact related information from a database when a document includes a name, the computer

3   readable medium including program instructions for performing the steps of:

4

5   (1)   using a first computer program to analyze the document, without direction

6   from the operator, to identify the name,

7

8   (2)   using the identified name and a second computer program to search the

9   database and to locate related information associated with the name, and

10

11   (3)   inserting the contact related information into the document,

12

13   wherein steps (1) - (3) require only a single execute command.

1   132. (NEW) A computer readable medium for assisting a computer operator to retrieve in-

2   formation from a database that is related to text in a document, the computer readable me-

3   dium including program instructions for performing the steps of:

4

5   (1)   using a first computer program to analyze the document, without direction

6   from the operator, to identify text in the document that can be used to search

7   for related information,

8

9   (2)   using a second computer program and the text identified in step (1)

10   to search the database and to locate related information, and

11

12   (3)   inserting the information located in step (2) into the document.

1   133. (NEW) A system for information handling within a document operated on by a first

2   application program, the system comprising:

3   means for identifying without user intervention or designation the first information

4   that can be utilized in a second application program, the first information selected from a

5   group consisting of a name and an address; and

6   means for responding to a user selection by performing an operation related to a

7   second information, the second information associated with all or part of the first information

8   from the second application program, wherein the means for responding to the user selection

9   further comprises:

10   means for initializing the second application program;

11   means for searching, using the second application program, for the second informa-

12   tion associated with the first information; and

13   if said second information exists, means for retrieving and displaying the second in-

14   formation;

24

15   wherein said user selection comprises:

16   selecting a menu indicator for the menu;

17   opening the menu;

18   selecting a choice in the menu; and

19   activating the selected choice in the menu;

20   wherein selection the menu indicator comprises moving the mouse pointer to the

21 menu indicator;

22   wherein the opening of a menu comprises clicking on the menu indicator with a

23 mouse button; and

24   wherein the second information is associated with at least part of the identified first

25   information.

1   134. (NEW) A system for assisting a computer operator to retrieve contact related informa-

2   tion from a database when a document includes a name, the system comprising:

3

4   (1)   means for using a first computer program to analyze the document, without

5   direction from the operator, to identify the name,

6

7   (2)   means for using the identified name and a second computer program to search

8   the database and to locate related information associated with the name, and

9

10   (3)   means for inserting the contact related information into the document,

11

12 wherein (1) - (3) require only a single execute command.

1   135. (NEW) A system for assisting a computer operator to retrieve information from a data-

2   base that is related to text in a document, the system comprising:

3

4   (1)   means for using a first computer program to analyze the document, without

5   direction from the operator, to identify text in the document that can be used

6   to search for related information,

7

8   (2)   means for using a second computer program and the text identified in (1)

9   to search the database and to locate related information, and

10

11   (3)   means for inserting the information located in (2) into the document.

REMARKS

This Amendment is in response to the Office Action mailed October 18, 2006. All objections and rejections are respectfully traversed.

Claims 35-135 are currently pending.

Claims 73, 80 and 87 have been amended to correct typographical errors. Claims 70, 74-77, 84, 91, 97 and 103 have been amended to better claim the invention.

Claims 109-135 have been added to better claim the invention.

At paragraph 9 of the Office Action, the Examiner allowed claims 35-69.

At paragraphs 4 and 5 of the Office Action, the Examiner noted several typographic errors. Applicant thanks that Examiner for pointing out the typographical errors. Appropriate correction has been made via this Amendment.

Applicant thanks the Examiner for the in person interview held on January 18, 2007 with the undersigned attorney and Mr. Atle Hedloy. At the interview, claims 35 and 70 were discussed in light of the Tso reference and specification. By way of this amendment, Applicant believes that the issues raised during the interview have been resolved.

At paragraph 7 of the Office Action, the Examiner rejected claims 70-75, 77-82, 84-89, 91-92, 94-98, 100-104 and 106-108 under 35 U.S.C. §102(b) as being anticipated by Tso (U.S. Patent No. 6,085,201). Applicant respectfully traverses this rejection.

Illustrative claim 70 as amended includes the element of "identifying without user intervention *or designation* the first information." This is in distinction to the Tso reference where the user must designate text before the analysis of the text. For example in Tso, column 4, lines 32-45, states that a user designates a "text string to be processed, for example, by clicking on it." Alternately, the designation "could be accomplished by appropriately positioning a cursor using a touch keypad and pressing an 'ENTER' key." Thus, Tso requires that the user designate the first information prior to initiation of the analysis. However, Applicant's claimed invention identifies the first information without such user designation.

At paragraph 8 of the Office Action, the Examiner rejected claims 76, 83, 90, 93, 99 and 105 under 35 U.S.C. §103(a) as being unpatentable over Tso in view of Pandit (U.S. Patent No. 5,859,636). Applicant respectfully traverses this rejection. Applicant believes that these claims are allowable at least because they depend from allowable base claims.

In a litigation involving U.S. Patent No. 6,323,853, which issued from U.S. Patent Application Serial No. 09/189,626 (a parent of the pending application), the court construed the claims as requiring 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." The court reached this construction because it concluded that "text selection was clearly disavowed by Arendi during prosecution of the patent." In support of this conclusion, the court cited the examiner's rejections based on *Pandit* and

Tso, Arendi's claim amendments and explanations as to how those amendments distinguished these references, and the examiner's statements of his reasons for allowance.

The court's construction was unfortunately overbroad and, we believe, based on too broad a reading of the prosecution history. We wish to avoid such a misinterpretation here. In particular, we distinguish the present invention from Tso, as well as Tso in view of Pandit, by pointing out that in the present invention, the existence of the "first information", on the basis of which a second information may be retrieved, is marked and/or identified without the user first having to identify the first information. In the words of the claims, the marking (identification) of the first information is done without user intervention, i.e., without the user first having to specify the "first information".

Furthermore, Applicant notes that the phrase "without user intervention or designation" is not a disavowal of *any* user action at all, i.e. not a disavowal of, for example, the need for the user to start the computer, initialize the application program, open or load the document, or perform an action to initiate the identification, such as clicking a button, opening and/or selecting a menu choice, etc. or select among various actions to be thereafter performed once the system or method has marked(identified) the "first information". The key point is that the marking(identification) of "first information" in a document is done by the program or system that implements the method of the invention without the user *first* having to specify the "first information". Thus, to the extent that applicant is disclaiming any "user intervention" in the process, it is disclaiming only the user's spe-

29

cifically marking(identifying) the "first information" at the outset, not disclaiming any user operations on that information *after* it has been marked(identified).

The Examiner has asked applicant to explain the support in the specification for the term "marking" as used in claim 35 and claims dependent thereon. Applicant has previously identified support for the term "marking" in the Amendment filed on April 15, 2003 in response to the Office Action dated October 15, 2002. In the broadest sense, to "mark" is to pick out or designate something or someone as special in some way. Thus, the verb to mark, as defined by the American Heritage Dictionary (accessed via www.dictionary.com on February 26, 2007), means, inter alia:

a.   To single out or indicate by or as if by a mark: *marked the spot where the treasure was buried; a career marked for glory.*

b.   To distinguish or characterize: *the exuberance that marks her writings; marked the occasion with celebrations.*

c.   To make conspicuous: *a concert marking the composer's 60th birthday.*

d.   To give attention to; notice: *Mark her expression of discontent. Mark my words: they are asking for trouble.*

e.   To take note of in writing; write down: *marked the appointment on my calendar.*

In the present case, the program marks the "first information" in any of a variety of ways. Thus, it automatically (i.e., without user intervention) identifies (i.e., singles out) certain text found in a document (e.g., a name) that may serve as the "first information" for searching in a database to find corresponding ("second") information. See p. 2, paragraph 35 of the application:

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.

Further, it may display the text (the "first information") to the user: see, for instance, Example 4, page 4, paragraph 53 in which the system, in response to having identified the name and address of a contact in a document, searches a database and displays any already-existing name and address for the contact:

The user commands the button 42, for example, marked "OneButton," and the program according to the present invention retrieves the existing contact 44 from the document, searches a database for the same name of the existing contact 44 and generates a screen as shown in, for example, Fig. 9. This screen includes a message 70 informing the user that the contact already exists in the database with an existing address, a message 72 including the existing address, add new contact with same name selection 74, change existing address selection 76, use existing address in document selection 78, add the new address contact selection 80, the address type selection 54, such as home, business, etc., and the "OK," "Details," and "Cancel" buttons 56, 58 and 60 respectively.

The user may then use the retrieved data or add to it or take other action. See also figures 6, 9, 10, 11 and 12, and examples 2, 5, 6 (paragraphs 45-48, 55-58, and 59-62 respectively).

Furthermore, in paragraph 35 of the published application, "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 un-interpretable the program goes to step 8 and outputs an

31

appropriate message to the user and then quits at step 16." Thus, also if no first informa-

tion is found, the claimed invention alerts the user.

Applicant believes that all claims are in condition for allowance and respectfully

requests the issuance of a Notice of Allowance.

Please charge any additional fee occasioned by this paper to our Deposit Account

No. 03-1237.

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Respectfully submitted,

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Exhibit 6MM

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PATENTS
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re The Application of: Atle Hedloy	
Serial No.: 09/923,134	Examiner: Sy D. Luu
Filed: August 6, 2001	Art Unit: 2174
For: METHOD, SYSTEM AND COMPUTER READABLE MEDIUM FOR ADDRESSING HANDLING FROM A COMPUTER PROGRAM	Confirmation No.: 9141

Cesari and McKenna, LLP
88 Black Falcon Avenue
Boston, MA 02210
January 24, 2008

CERTIFICATE OF EFS WEB TRANSMISSION

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   /Elaine Cruz/
Elaine Cruz

AMENDMENT

In response to the Office Action dated November 9, 2007, please enter the following amendments:

IN THE CLAIMS:

1   1. (CANCELLED)

1   2. (CANCELLED)

1   3. (CANCELLED)

1   4. (CANCELLED)

1   5. (CANCELLED)

1   6. (CANCELLED)

1   7. (CANCELLED)

1   8. (CANCELLED)

1   9. (CANCELLED)

1   10. (CANCELLED)

1   11. (CANCELLED)

1   12. (CANCELLED)

1   13. (CANCELLED)

1   14. (CANCELLED)

1   15. (CANCELLED)

1   16. (CANCELLED)

1   17. (CANCELLED)

1   18. (CANCELLED)

1   19. (CANCELLED)

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1   27. (CANCELLED)

1   28. (CANCELLED)

1   29. (CANCELLED)

1   30. (CANCELLED)

1   31. (CANCELLED)

1   32. (CANCELLED)

1   33. (CANCELLED)

1   34. (CANCELLED)

1   35. (PREVIOUSLY PRESENTED): A method for information handling within a document

2   created using a first application program comprising the steps of:

3   entering a first information in the first application program;

4   marking without user intervention the first information to alert the user that the first

5   information can be utilized in a second application program; and

6   responding to a user selection by inserting a second information into the document,

7   the second information associated with the first information from a second application

8   program.

1   36. (PREVIOUSLY PRESENTED): The method of claim 35 wherein the user selection

2   further comprises an activation of a device selected from a group consisting of a touch

3   screen, a keyboard button, a screen button, an icon, a menu, and a voice command device.

1   37. (PREVIOUSLY PRESENTED): The method of claim 35, wherein the step of inserting

2   the second information into the document further comprises the steps of:

3   initializing the second application program;

4   searching, using the second application program, for the second information

5   associated with the first information; and

6   retrieving the second information.

1   38. (PREVIOUSLY PRESENTED): The method of claim 37, wherein when the second

2   application program includes second information associated with the first information,

3   performing the further step of displaying the second information.

1   39. (PREVIOUSLY PRESENTED): The method of claim 38, further comprising the step of

2   completing at least one of the first and second information in the document.

1   40. (PREVIOUSLY PRESENTED): The method of claim 35, wherein the first information

2   comprises a name.

1   41. (PREVIOUSLY PRESENTED): A computer readable medium, including program

2   instructions related to information handling within a document created using a first

3   application program and for performing the steps of:

4   entering a first information in the first application program;

5   marking without user intervention the first information to alert the user that the first

6   information can be utilized in a second application program; and

7   responding to a user selection by inserting a second information into the document,

8   the second information associated with the first information from a second application

9   program.

1   42. (PREVIOUSLY PRESENTED): The computer readable medium of claim 41, wherein

2   the user selection further comprises an activation of a device selected from a group

3   consisting of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice

4   command device.

1   43. (PREVIOUSLY PRESENTED): The computer readable medium of claim 41, wherein

2   the step of inserting the second information into the document further comprises the steps of:

3   initializing the second application program;

4   searching, using the second application program, for the second information

5   associated with the first information; and

6   retrieving the second information.

1   44. (PREVIOUSLY PRESENTED): The computer readable medium of claim 43, wherein

2   when the second application program includes second information associated with the first

3   information, performing the further step of displaying the second information.

1   45. (PREVIOUSLY PRESENTED): The computer readable medium of claim 44, further

2   comprising the step of completing at least one of the first and second information in the

3   document.

1   46. (PREVIOUSLY PRESENTED): The computer readable medium of claim 41, wherein

2   the first information comprises a name.

1   47. (PREVIOUSLY PRESENTED): A computer system related to information handling

2   within a document created using a first application program, comprising:

3   means for entering a first information in the first application program;

4   means for marking without user intervention the first information to alert the user

5   that the first information can be utilized in a second application program; and

6   means for responding to a user selection by inserting a second information into the

7   document, the second information associated with the first information from a second

8   application program.

1   48. (PREVIOUSLY PRESENTED): The computer system of claim 47, wherein the means

2   for the user selection further comprises:

3   means for an activation of a device selected from a group consisting of a touch

4   screen, a keyboard button, a screen button, an icon, a menu, and a voice command device.

1   49. (PREVIOUSLY PRESENTED): The computer system of claim 47, wherein the means

2   for inserting the second information into the document further comprises:

3   means for initializing the second application program;

4   means for searching, using the second application program, for the second

5   information associated with the first information; and

6   means for retrieving the second information.

1   50. (PREVIOUSLY PRESENTED): The computer system of claim 49, wherein when the

2   second application program includes second information associated with the first

3   information, and comprising means for performing the further step of displaying the second

4   information.

1   51. (PREVIOUSLY PRESENTED): The computer system of claim 50, further comprising

2   means for completing at least one of the first and second information in the document.

1   52. (PREVIOUSLY PRESENTED): The computer system of claim 47, wherein the first

2   information comprises a name.

1   53. (PREVIOUSLY PRESENTED): A method for information handling within a document

2   created by a first application program comprising the steps of:

3   entering a first information in the first application program;

4   marking without user intervention the first information to alert the user that the first

5   information can be utilized in a second application program; and

6   responding to a user selection by performing an operation related to a second

7   information, the second information associated with the first information from the second

8   application program.

1   54. (PREVIOUSLY PRESENTED): The method of claim 53 wherein the operation

2   comprises displaying the second information.

1   55. (PREVIOUSLY PRESENTED): The method of claim 53, wherein the first information is

2   a name, and the operation performed is selected from a group consisting of an electronic

3   mail, a telex, a facsimile or a letter addressed to the name indicated by the first information.

1   56. (PREVIOUSLY PRESENTED): The method of claim 53, wherein the operation

2   performed is entering additional data into a database.

1   57. (PREVIOUSLY PRESENTED): The method of claim 56, wherein the additional data is

2   entered by a user.

1   58. (PREVIOUSLY PRESENTED): The method of claim 56, wherein the additional data is

2   located within the document.

1   59. (PREVIOUSLY PRESENTED): A computer readable medium, including program

2   instructions related to information handling within a document created by a first application

3   program and for performing the steps of:

4   entering a first information in the first application program;

5   marking without user intervention the first information to alert the user that the first

6   information can be utilized in a second application program; and

7   responding to a user selection by performing an operation related to a second

8   information, the second information associated with the first information from the second

9   application program.

1   60. (PREVIOUSLY PRESENTED): The computer readable medium of claim 59 wherein

2   the operation comprises displaying the second information.

1   61. (PREVIOUSLY PRESENTED): The computer readable medium of claim 59, wherein

2   the first information is a name, and the operation performed is selected from a group

3   consisting of an electronic mail, a telex, a facsimile or a letter addressed to the name

4   indicated by the first information.

1   62. (PREVIOUSLY PRESENTED): The computer readable medium of claim 59, wherein

2   the operation performed is entering additional data into a database.

1   63. (PREVIOUSLY PRESENTED): The computer readable medium of claim 62, wherein

2   the additional data is entered by a user.

1   64. (PREVIOUSLY PRESENTED): The computer readable medium of claim 62, wherein

2   the additional data is located within the document.

1   65. (PREVIOUSLY PRESENTED): A computer system related to information handling

2   within a document created by a first application program, comprising:

3   means for entering a first information in the first application program;

4   means for marking without user intervention the first information to alert the user that

5   the first information can be utilized in a second application program; and

6   means for responding to a user selection by performing an operation related to a

7   second information, the second information associated with the first information from the

8   second application program.

1   66. (PREVIOUSLY PRESENTED): The computer system of claim 65 wherein the operation

2   comprises displaying the second information.

10

1   67. (PREVIOUSLY PRESENTED): The computer system of claim 65, wherein the first

2   information is a name, and the operation performed is selected from a group consisting of an

3   electronic mail, a telex, a facsimile or a letter addressed to the name indicated by the first

4   information.

1   68. (PREVIOUSLY PRESENTED): The computer system of claim 65, wherein the operation

2   performed is entering additional data into a database.

1   69. (PREVIOUSLY PRESENTED): The computer system of claim 68, wherein the

2   additional data is entered by a user.

1   70. (PREVIOUSLY PRESENTED): A method for information handling within a document

2   operated on by a first application program, the document containing first information that can

3   be utilized in a second application program, the method comprising the steps of:

4   identifying without user intervention or designation the first information; and

5   responding to a user selection by inserting a second information into the document,

6   the second information associated with the first information from a second application

7   program.

1   71. (PREVIOUSLY PRESENTED): The method of claim 70, wherein the user selection

2   further comprises an activation of a device selected from a group consisting of a touch

3   screen, a keyboard button, a screen button, an icon, a menu, and a voice command device.

1   72. (PREVIOUSLY PRESENTED): The method of claim 70, wherein the step of inserting

2   the second information into the document further comprises the steps of:

3   initializing the second application program;

4   searching, using the second application program, for the second information

5   associated with the first information; and

11

6   retrieving the second information.

1   73. (PREVIOUSLY PRESENTED): The method of claim 72 wherein the step of inserting

2   the second information into the document further comprises adding the second information to

3   the first information in the document.

1   74. (PREVIOUSLY PRESENTED): The method of claim 72, wherein when the second

2   application program includes second information associated with the first information,

3   performing the further step of displaying the second information.

1   75. (PREVIOUSLY PRESENTED): The method of claim 72, further comprising the step of

2   completing at least one of the first and second information in the document.

1   76. (PREVIOUSLY PRESENTED): The method of claim 70, wherein the first information

2   comprises a name.

1   77. (PREVIOUSLY PRESENTED): A computer readable medium, including program

2   instructions related to information handling within a document operated on by a first

3   application program, the document containing first information that can be utilized in a

4   second application program, and for performing the steps of:

5   identifying without user intervention or designation the first information; and

6   responding to a user selection by inserting a second information into the document,

7   the second information associated with the first information from a second application

8   program.

1   78. (PREVIOUSLY PRESENTED): The computer readable medium of claim 77, wherein

2   the user selection further comprises an activation of a device selected from a group consisting

3   of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice command

4   device.

1   79. (PREVIOUSLY PRESENTED): The computer readable medium of claim 77, wherein

2   the step of inserting the second information into the document further comprises the steps of:

3   initializing the second application program;

4   searching, using the second application program, for the second information

5   associated with the first information; and

6   retrieving the second information.

1   80. (PREVIOUSLY PRESENTED): The method of claim 79 wherein the step of inserting

2   the second information into the document further comprises adding the second information to

3   the first information in the document.

1   81. (PREVIOUSLY PRESENTED): The computer readable medium of claim 80, wherein

2   when the second application program includes second information associated with the first

3   information, performing the further step of displaying the second information.

1   82. (PREVIOUSLY PRESENTED): The computer readable medium of claim 80, further

2   comprising the step of completing at least one of the search and second information in the

3   document.

1   83. (PREVIOUSLY PRESENTED): The computer readable medium of claim 77, wherein

2   the search information comprises a name.

1   84. (PREVIOUSLY PRESENTED): A computer system related to information handling

2   within a document operated on by a first application program, the document containing first

3   information that can be utilized in a second application program, comprising:

4   means for identifying without user intervention or designation the first information;

5   and

6   means for responding to a user selection by inserting a second information into the

7   document, the second information associated with the first information from a second

8   application program.

9   85. (PREVIOUSLY PRESENTED): The computer system of claim 84, wherein the means

10   for user selection further comprises means for an activation of a device selected from a group

11   consisting of a touch screen, a keyboard button, a screen button, an icon, a menu, and a voice

12   command device.

1   86. (PREVIOUSLY PRESENTED): The computer system of claim 84, wherein the means

2   for inserting the second information into the document further comprises:

3   means for initializing the second application program;

4   means for searching, using the second application program, for the second

5   information associated with the first information; and

6   means for retrieving the second information.

1   87. (PREVIOUSLY PRESENTED): The computer system of claim 84 wherein the means for

2   inserting the second information into the document further comprises means for adding the

3   second information to the first information in the document.

1   88. (PREVIOUSLY PRESENTED): The computer system of claim 84, wherein when the

2   second application program includes second information associated with the first

3   information, and comprising means for performing the further step of displaying the second

4   information.

1   89. (PREVIOUSLY PRESENTED): The computer system of claim 88, further comprising

2   means for completing at least one of the search and second information in the document.

1   90. (PREVIOUSLY PRESENTED): The computer system of claim 84, wherein the search

2   information comprises a name.

1   91. (CURRENTLY AMENDED): A method for information handling within a document

2   operated on by a first application program, the document containing first information that can

3   be utilized in a second application program the method comprising the steps of:

4   identifying without user intervention or designation the first information; and

5   responding to a user selection by performing an operation related to a second

6   information, the second information associated with the first information from the second

7   application program.

1   92. (PREVIOUSLY PRESENTED): The method of claim 91 wherein the operation

2   comprises displaying the second information.

1   93. (PREVIOUSLY PRESENTED): The method of claim 91, wherein the search information

2   is a name, and the operation performed is selected from a group consisting of generating an

3   electronic mail, a telex, a facsimile or a letter addressed to the name indicated by the search

4   information.

1   94. (PREVIOUSLY PRESENTED): The method of claim 91, wherein the operation

2   performed is entering additional data into a database

1   95. (PREVIOUSLY PRESENTED): The method of claim 94, wherein the additional data is

2   entered by a user.

1   96. (PREVIOUSLY PRESENTED): The method of claim 94, wherein the additional data is

2   located within the document.

1   97. (PREVIOUSLY PRESENTED): A computer readable medium, including program

2   instructions related to information handling within a document operated on by a first

3   application program, the document containing first information that can be utilized in a

4   second application program, and for performing the steps of:

5   identifying without user intervention or designation the first information; and

6   responding to a user selection by performing an operation related to a second

7   information, the second information associated with the first information from the second

8   application program.

1   98. (PREVIOUSLY PRESENTED): The computer readable medium of claim 97 wherein

2   the operation comprises displaying the second information.

1   99. (PREVIOUSLY PRESENTED): The computer readable media of claim 97, wherein the

2   first information is a name, and the operation performed is selected from a group consisting

3   of generating an electronic mail, a telex, a facsimile or a letter addressed to the name

4   indicated by the first information.

1   100. (PREVIOUSLY PRESENTED): The computer readable media of claim 97, wherein the

2   operation performed is entering additional data into a database

1   101. (PREVIOUSLY PRESENTED): The computer readable media of claim 100, wherein

2   the additional data is entered by a user.

1   102. (PREVIOUSLY PRESENTED): The computer readable media of claim 100, wherein

2   the additional data is located within the document.

1   103. (PREVIOUSLY PRESENTED): A computer system related to information handling

2   within a document operated on by a first application program, the document containing first

3   information that can be utilized in a second application program, comprising:

4   means for identifying without user intervention or designation the first information;

5   and

6   means for responding to a user selection by performing an operation related to a

7   second information, the second information associated with the first information from the

8   second application program.

1   104. (PREVIOUSLY PRESENTED): The computer system of claim 103 wherein the

2   operation comprises displaying the second information.

1   105. (PREVIOUSLY PRESENTED): The computer system of claim 103, wherein the first

2   information is a name, and the operation performed is selected from a group consisting of

3   generating an electronic mail, a telex, a facsimile or a letter addressed to the name indicated

4   by the first information.

1   106. (PREVIOUSLY PRESENTED): The computer system of claim 103, wherein the

2   operation performed is entering additional data into a database

1   107. (PREVIOUSLY PRESENTED): The computer system of claim 106, wherein the

2   additional data is entered by a user.

1   108. (PREVIOUSLY PRESENTED): The computer system of claim 106, wherein the

2   additional data is located within the document.

1   109. (PREVIOUSLY PRESENTED) The method of claim 91 wherein the user selection

2   comprises an activation of a menu.

1   110. (PREVIOUSLY PRESENTED) The method of claim 91 wherein at least part of the

2   identifying occurs after the user selection.

1   111. (PREVIOUSLY PRESENTED) The method of claim 91 wherein the identifying

2   occurs after the user selection.

1   112. (PREVIOUSLY PRESENTED): The method of claim 109, wherein the step of

2   performing the operation further comprises the steps of:

3   initializing the second application program;

4   searching, using the second application program, for the second information

5   associated with the first information; and

6   retrieving the second information.

1   113. (PREVIOUSLY PRESENTED): The method of claim 112, wherein when the second

2   information associated with first information exists, performing the further step of displaying

3   the second information.

1

2   114. (PREVIOUSLY PRESENTED): The method of claim 113, wherein the first information

3   comprises a name.

1

2   115. (CURRENTLY AMENDED): The method of claim 114, wherein the activation of the

3   menu comprises

4   ~~selection~~ selecting the menu indicator for the menu

5   opening the menu

6   selecting a choice in the menu; and

7   activating the selected choice in the menu

8

1 116. (PREVIOUSLY PRESENTED): The method of claim 115, wherein selection of the

2 menu indicator comprises moving a mouse pointer to the menu indicator.

1 117. (PREVIOUSLY PRESENTED): The method of claim 116, wherein the opening of a

2 menu comprises clicking on the menu indicator with a mouse button.

1 118. (PREVIOUSLY PRESENTED) The method of claim 91, wherein the second

2 information is associated with only part of the identified first information.

1 119. (PREVIOUSLY PRESENTED): A method for information handling within a document

2 operated on by a first application program, the document containing first information entered

3 by a user, the method comprising the steps of:

4   identifying without user intervention or designation the first information that can be

5 utilized in a second application program, the first information selected from a Group

6 consisting of a name and an address; and

7   responding to a user selection by performing an operation related to a second

8 information, the second information associated with all or part of the first information from

9 the second application program, wherein the step of responding to the user selection further

10 comprises the steps of:

11   initializing the second application program;

12   searching, using the second application program, for the second information

13   associated with the first information; and

14   if said second information exists, retrieving and displaying the second information;

15   wherein said user selection comprises:

16   selecting a menu indicator for the menu;

17   opening the menu;

18   selecting a choice in the menu; and

19   activating the selected choice in the menu;

20   wherein selecting the menu indicator comprises moving the mouse pointer to the

21 menu indicator;

22   wherein opening the menu comprises clicking on the menu indicator with a mouse

23 button; and

24   wherein the second information is associated with at least part of the identified first

25   information.

1   120. (PREVIOUSLY PRESENTED)   A method for assisting a computer operator to

2   retrieve contact related information from a database when a document includes a name, the

3   method comprising of the steps of:

4

5   (1)   using a first computer program to analyze the document, without direction

6   from the operator, to identify the name,

7

8   (2)   using the identified name and a second computer program to search the

9   database and to locate related information associated with the name, and

10

11   (3)   inserting the contact related information into the document,

12

13 wherein steps (1) - (3) require only a single execute command.

1   121. (PREVIOUSLY PRESENTED) The method of claim 120 wherein the contact

2   information comprises an address.

1   122. (PREVIOUSLY PRESENTED) The method of claim 120 wherein the contact

2   information comprises a telephone number.

1   123. (PREVIOUSLY PRESENTED) The method of claim 120 wherein the name comprises

2   a business name.

1   124. (PREVIOUSLY PRESENTED) The method of claim 120 wherein the name comprises

2   a personal name.

1   125. (PREVIOUSLY PRESENTED) The method according to claim 120 wherein the

2   execute command is a selection from a menu.

1   126. (PREVIOUSLY PRESENTED) The method according to claim 125 wherein the

2   operator enters the execute command before step (2).

1   127. (PREVIOUSLY PRESENTED)   A method for assisting a computer operator to

2   retrieve information from a database that is related to text in a document, the method

3   comprising the steps of:

4

5   (1)   using a first computer program to analyze the document, without direction

6   from the operator, to identify text in the document that can be used to search

7   for related information,

8

9   (2)   using a second computer program and the text identified in step (1)

10   to search the database and to locate related information, and

11

12   (3)   inserting the information located in step (2) into the document.

1   128. (PREVIOUSLY PRESENTED) The method according to claim 127 wherein at least

2   steps (2) - (3) take place following entry a single execute command.

1   129. (PREVIOUSLY PRESENTED) The method according to claim 128 wherein the

2   execute command is a selection from a menu.

1   130. (PREVIOUSLY PRESENTED) A computer readable medium for information

2   handling within a document operated on by a first application program, the document

3   containing first information entered by a user, the computer readable medium including

4   program instructions for performing the steps of:

5   identifying without user intervention or designation the first information that can be

6   utilized in a second application program, the first information selected from a group

7   consisting of a name and an address; and

8   responding to a user selection by performing an operation related to a second

9   information, the second information associated with all or part of the first information from

10   the second application program, wherein the step of responding to the user selection further

11   comprises the steps of:

12   initializing the second application program;

13   searching, using the second application program, for the second information

14   associated with the first information; and

15   if said second information exists, retrieving and displaying the second information;

16   wherein said user selection comprises:

17   selecting a menu indicator for the menu;

18   opening the menu;

19   selecting a choice in the menu; and

20   activating the selected choice in the menu;

21   wherein selection the menu indicator comprises moving the mouse pointer to the

22   menu indicator;

23   wherein the opening of a menu comprises clicking on the menu indicator with a

24   mouse button; and

25   wherein the second information is associated with at least part of the identified first

26   information.

1   131. (PREVIOUSLY PRESENTED) A computer readable medium for assisting a computer

2   operator to retrieve contact related information from a database when a document includes a

3   name, the computer readable medium including program instructions for performing the

4   steps of:

5

6   (1)   using a first computer program to analyze the document, without direction

7   from the operator, to identify the name,

8

9   (2)   using the identified name and a second computer program to search the

10   database and to locate related information associated with the name, and

11

12   (3)   inserting the contact related information into the document,

13

14   wherein steps (1) - (3) require only a single execute command.

1   132. (PREVIOUSLY PRESENTED) A computer readable medium for assisting a computer

2   operator to retrieve information from a database that is related to text in a document, the

3   computer readable medium including program instructions for performing the steps of:

4

5   (1)   using a first computer program to analyze the document, without direction

6   from the operator, to identify text in the document that can be used to search

7   for related information,

8

9   (2)   using a second computer program and the text identified in step (1)

10   to search the database and to locate related information, and

11

12   (3)   inserting the information located in step (2) into the document.

1   133. (PREVIOUSLY PRESENTED) A system for information handling within a document

2   operated on by a first application program, the system comprising:

3   means for identifying without user intervention or designation the first information

4   that can be utilized in a second application program, the first information selected from a

5   group consisting of a name and an address; and

6   means for responding to a user selection by performing an operation related to a

7   second information, the second information associated with all or part of the first information

8   from the second application program, wherein the means for responding to the user selection

9   further comprises:

10   means for initializing the second application program;

11   means for searching, using the second application program, for the second

12   information associated with the first information; and

13   if said second information exists, means for retrieving and displaying the second

14   information;

15   wherein said user selection comprises:

16   selecting a menu indicator for the menu;

17   opening the menu;

18   selecting a choice in the menu; and

19   activating the selected choice in the menu;

20   wherein selection the menu indicator comprises moving the mouse pointer to the

21   menu indicator;

22   wherein the opening of a menu comprises clicking on the menu indicator with a

23   mouse button; and

24   wherein the second information is associated with at least part of the identified first

25   information.

1   134. (PREVIOUSLY PRESENTED) A system for assisting a computer operator to retrieve

2   contact related information from a database when a document includes a name, the system

3   comprising:

4

5   (1) means for using a first computer program to analyze the document, without

6 direction from the operator, to identify the name,

7

8   (2) means for using the identified name and a second computer program to search

9 the database and to locate related information associated with the name, and

10

11   (3) means for inserting the contact related information into the document,

12

13 wherein (1) - (3) require only a single execute command.

1 135. (PREVIOUSLY PRESENTED) A system for assisting a computer operator to

2 retrieve information from a database that is related to text in a document, the system

3 comprising:

4

5   (1) means for using a first computer program to analyze the document,

6   without direction from the operator, to identify text in the document that

7   can be used to search for related information,

8

9   (2) means for using a second computer program and the text identified in (1)

10   to search the database and to locate related information, and

11

12   (3) means for inserting the information located in (2) into the document.

REMARKS

This Amendment is filed in response to the Non-Final Office Action dated November 9, 2007. All rejections and objections are respectfully traversed.

Claims 35-135 are currently pending.

Claims 91 and 115 have been amended to correct typographical errors.

Claim Objections

On page 2 of the Office Action, the Examiner objected to claims 91 and 115 due to informalities. By way of this Amendment, Applicant has corrected these informalities. Applicant thanks the Examiner for pointing out these informalities.

Rejections Under 35 U.S.C. §103

At paragraph 4 of the Office Action, the Examiner rejected claims 35-135 under 35 U.S.C. §103(a) as being unpatentable over AddressMate for Windows Version 2.0 ("AddressMate") software product box in view of U.S. Patent No. 5,859,636 ("Pandit"). Applicant respectfully traverses this rejection.

User Manual For AddressMate and AddressMate Plus

Applicant notes that User Manual For AddressMate and AddressMate Plus ("User Manual") describes the operation of the AddressMate software product in more detail than the AddressMate software product box. During the trial of *Arendi v. Microsoft*, which involved U.S. Patent No. 6,323,853, (the parent of the present application), David

Block, the creator of the AddressMate software product, testified that the User Manual

pertains to AddressMate 2.0. In particular Mr. Block testified as follows:

```
        A. YES.  WE HAD TWO PRODUCTS ON THE MARKET AT THE
           SAME TIME.  WE HAD ADDRESSMATE VERSION 2.1
           SOMETHING-OR-OTHER, AND WE HAD ANOTHER PIECE
           OF SOFTWARE THAT WE SOLD AT ADDRESSMATE PLUS,
           WHICH WAS ACTUALLY THE SAME EXACT CODE BASE
           EXCEPT WE CHANGED THE DLL IN THE 2.0 VERSION
           OF THE DLL THAT SAID IF YOU WANT TO DO ADDRESS
           CORRECTION -- I'M SORRY.
                IN THE ADDRESSMATE 2.0, THERE WAS A DLL
           THAT SAID IF YOU WANT TO DO ADDRESS
           CORRECTION, YOU COULD UPGRADE TO ADDRESSMATE
           PLUS.  ADDRESSMATE PLUS ALWAYS CAME WITH THE
           CD.
```

(Trial Transcript of September 21, 2004 on page 95)

The trial transcript has been cited to, and considered by, the Examiner in an

Information Disclosure Statement filed on January 3, 2005 and initialed by the Examiner

on October 23, 2007. Furthermore, a copy of the User Manual has previously been cited

to, and considered by, the Examiner in an Information Disclosure Statement filed on

February 10, 2004 and initialed by the Examiner on May 14, 2004.

Mr. Block makes clear that he is the creator of the program, and the responsible

for its marketing, see page 77 of the trial transcript of Sept 21, 2004.

```
Q.   NOW, YOU MENTIONED THE ADDRESSMATE SOFTWARE

     COMPANY.  WHAT WAS YOUR POSITION THERE?

 A.  AS I SAID, I STARTED THE COMPANY, I WAS THE

     PRESIDENT, I WAS ALSO THE DEVELOPER, THE DESIGNER, THE

     PROGRAMMER, THE CHIEF MARKETING PERSON, THE SHIPPING
```

CLERK AND EVERYTHING IN BETWEEN.

Also, Mr. Block testified on page 111 that:

Q.   AND WHAT IS THAT MANUAL?

A.   IT IS THE USER MANUAL THAT WAS SHIPPED WITH BOTH

      ADDRESSMATE AND ADDRESSMATE PLUS, SO THE USER WOULD

      KNOW WHAT THEY COULD DO WITH THE PRODUCT AND HOW IT

      WORKED.

Q.   AND HOW DO YOU KNOW THAT?

A.   I WROTE THE ORIGINAL VERSION.

The User Manual came in the box with AddressMate and AddressMate Plus (AddressMate Plus was also called AddressMate 3.0). AddressMate Plus, with its box and the manual was part of what was called Exhibit X-15 at the trial.

On this, Mr. Block stated in the same trial transcript on page 111:

Q.   … ON WHAT'S
      BEEN MARKED AS EXHIBIT X-15, YOU NOTED THAT THERE IS A
      USER MANUAL; IS THAT RIGHT?
A.   THAT'S CORRECT.
Q.   AND WHAT IS THAT MANUAL?
A.   IT IS THE USER MANUAL THAT WAS SHIPPED WITH BOTH
      ADDRESSMATE AND ADDRESSMATE PLUS, SO THE USER WOULD
      KNOW WHAT THEY COULD DO WITH THE PRODUCT AND HOW IT
      WORKED.

And further, Mr. Block further stated on page 127:

Q.   I WOULD LIKE TO SHOW YOU WHAT'S BEEN MARKED AS
      EXHIBIT X-15, AND THAT'S THE SOFTWARE BOX.
      MR. BLOCK, DO YOU RECOGNIZE WHAT'S BEEN HANDED

```
        TO YOU, WHICH HAS BEEN MARKED AS EXHIBIT X-15?
A.      I DO.
Q.      AND WHAT IS IT?
A.      THIS IS A COPY OF THE BOX WITH -- APPARENT CONTENTS
        IN IT OF ADDRESSMATE PLUS, WHICH WAS ALSO KNOWN AS
        ADDRESSMATE VERSION 3.0
```

As noted above, that the only difference between AddressMate 2.0 (to which the box pertains) and AddressMate 2.1 and AddressMate 3.0 was related to address correction. Moreover, the quote above makes clear that AddressMate 3.0 is simply another name for AddressMate Plus. Therefore the User Manual for AddressMate and AddressMate Plus describes the functionally of the software in all respects with respect to address correction, which was handled in AddressMate Plus. This means that the User Manual describes all functionality of AddressMate 2.0 plus the added functionality that appeared in AddressMate Plus.

Argument in Response to Rejection

The User Manual provides a more accurate instruction as to the actual operation of the AddressMate software product.

Illustrative claim 35 includes the element of:

marking without user intervention the first information to alert the user that the first information can be utilized in a second application program

Illustrative claim 70 includes the elements of:

identifying without user intervention or designation the first information; 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.

As described in the User Manual on page 6-44, to retrieve an address, the user must:

"1. Type part of the address you want to retrieve… 2. Using the mouse, drag through the address information you typed to select it. (If no text is selected, the text to the left of the cursor will be used for the search.)…3. Choose the *Amate/Retreive* command."

Thus, the AddressMate program requires that the user select the text to be searched, either by highlighting the text (i.e., dragging through the address using the mouse) or by placing the cursor to the right of the desired text. In this way, the AddressMate program is similar to the Tso reference which the Examiner has indicated the claims are allowable over.   For example in Tso, column 4, lines 32-45, states that a user designates a "text string to be processed, for example, by clicking on it." Alternately, the designation "could be accomplished by appropriately positioning a cursor using a touch keypad and pressing an 'ENTER' key." Thus, similar to the Pandit and Tso references, a user must manually intervene in the AddressMate program to designate the desired first information.

The Examiner indicates that by combining the AddressMate and Pandit references, the claimed invention is rendered obvious under 35 U.S.C. §103. Applicant respectfully traverses this rejection. In Pandit, the user must specifically highlight or select the text (first information) before it is "recognized as belonging to a predetermined class and performing an operation relevant to the recognized text" See, col. 1, lines 51-53. Pandit reference uses the words accent, highlight or indicate to describe the user intervention required. See, e.g., Fig. 2, step 21. For example, in col. 2, lines 8-9, Pandit states that "[t]he invention recognizes the accented text." Additionally, in col. 2, lines 32-35, Pandit further states that "[t]he pull-down menus provided by the invention identify the operations and/or programs which relate to the class of text accented, highlighted or otherwise indicated." Thus, Pandit teaches a system where the user must select text prior to the system processing the "a selected text", e.g. col. 5, line 56).

Neither the AddressMate program nor Pandit teach the element of "marking without user intervention " or "identifying without user intervention or designation the first information" either alone or in combination. The combination of AddressMate and Pandit is similar to the combination of Tso and Pandit previously argued in this application.

Furthermore, the description of the AddressMate program contained within the AddressMate reference is a marketing reference that does not sufficiently enable one skilled in the art to implement the invention.

Similar claim elements appear in the other independent claims of this application. These claims should be allowable for the same reason as stated above in reference to claims 35 and 70.

All dependent claims are believed to be allowable at least because they depend from an allowable base claim.

Conclusion

All claims are believed to be in condition for allowance.

<div align="right">PATENTS
103176–0001C1</div>

Please charge any additional fee occasioned by this paper to our Deposit Account

No. 03-1237.

Respectfully submitted,

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Exhibit 6NN

Patent No. 7,496,854
Petition For *Inter Partes* Review

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

Patent No. 7,496,854
Issue Date: February 24, 2009
Title: METHOD, SYSTEM AND COMPUTER READABLE MEDIUM FOR
ADDRESSING HANDLING FROM A COMPUTER PROGRAM
_____

Inter Partes Review No. _____

_____

PETITION FOR *INTER PARTES* REVIEW

UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.100 *et seq.*

TABLE OF CONTENTS

Page

TABLE OF CONTENTS
(continued)

Page

Exhibit List for *Inter Partes* Review of U.S. Patent No. 7,496,854

Exhibit Description	Exhibit #
U.S. Patent No. 7,496,854 to Hedloy	*1001*
Declaration of Dr. Daniel A. Menascé	*1002*
Amendment dated January 24, 2008	*1003*
Amendment dated April 18, 2007	*1004*
SIGCHI Bulletin (April 1998) at 51-63	*1005*
U.S. Patent No. 6,085,206 to Domini et al.	*1006*
U.S. Patent No. 5,946,647 to Miller et al.	*1007*
U.S. Patent No. 5,644,735 to Luciw et al.	*1008*
U.S. Patent No. 5,963,964 to Nielsen	*1009*
SIGCHI Bulletin (April 1998) at 51-63 (web version)	*1010*

Petitioners Apple Inc., Google Inc., and Motorola Mobility LLC (collectively, "Petitioners") respectfully petition for *inter partes* review of claims 19-35, 57-85, 96, and 99 of U.S. Patent No. 7,496,854 ("the '854 patent" (Ex. 1001)) in accordance with 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 *et seq*.

I.   NOTICES AND STATEMENTS

Pursuant to 37 C.F.R. § 42.8(b)(1), Apple Inc. ("Apple") is the real party-in-interest for Petitioner Apple. Google Inc. ("Google") is the real party-in-interest for Petitioner Google. Motorola Mobility LLC ("Motorola Mobility") is the real party-in-interest for Petitioner Motorola Mobility.

Pursuant to 37 C.F.R. § 42.8(b)(2), Petitioners identify the following related matters. On November 29, 2012, the Patent Owner filed suit against Apple and Motorola Mobility, among others, in the U.S. District Court for the District of Delaware alleging infringement of several patents, including the '854 patent. *See 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*, Case No. 1:12-cv-01601-LPS (D. Del.). The Complaint was served on Motorola Mobility on November 30, 2012 and on Apple on December 3, 2012. Thus, this Petition has been filed within one year of Apple and Google (which owns Motorola Mobility) being served a complaint alleging infringement of the '854 patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b).

Pursuant to 37 C.F.R. § 42.8(b)(3), Apple identifies the following counsel

(and a power of attorney accompanies this Petition).

Lead Counsel for Petitioner Apple	Backup Counsel for Petitioner Apple
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Google and Motorola Mobility identify the following counsel (and a power

of attorney accompanies this Petition).

Lead Counsel for Petitioners Google and Motorola Mobility	Backup Counsel for Petitioners Google and Motorola Mobility
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Pursuant to 37 C.F.R. § 42.8(b)(4), service information for lead and back-up

counsel is provided above.

Pursuant to 37 C.F.R. § 42.104(a), Petitioners certify that the '854 patent is

available for *inter partes* review and that Petitioners are not barred or estopped

from requesting an *inter partes* review challenging the patent claims on the grounds identified in this Petition.

II.   INTRODUCTION

The '854 patent is directed to a method, system, and computer readable medium for name and address handling from a computer program. For example, a user can type a name and address in a document being created with a word processing program. Through the use of a button, the document is searched and the name and address are detected. The detected information is then used with respect to a second application program, such as a database. For example, the user can add the name and address to an address book as a new entry, or edit or add additional address information associated with the name if the name is already in the address book. If the user types only a name into the document and the database has the name and a corresponding address, the user can insert the address for the name into the document being created by the word processing program.

The claims of the '854 patent may be divided into two groups: (1) claims directed to performing an operation, such as updating a database with an address; and (2) claims directed to inserting information into the document, such as an address. This Petition addresses the first set of claims (*i.e.*, claims 19-35, 57-85, 96, and 99). A related petition, filed concurrently, addresses the second set of

claims (*i.e.*, claims 1-18, 36-56, 86-95, 97, 98, 100, and 101). Two other petitions,

also filed concurrently, address related U.S. Patent Nos. 7,917,843 and 8,306,993.

Petitioners present herein references (including several originating from

Apple) that anticipate or render obvious the challenged claims of this Petition. The

references make clear that the purported invention of the challenged claims was

well known before the '854 patent. Section III of this Petition summarizes the '854

patent and relevant aspects of its prosecution history. Sections V-IX set forth the

detailed grounds for invalidity of the challenged claims.   This showing is

accompanied by the Declaration of Dr. Daniel A. Menascé ("Menascé Decl.," Ex.

1002.) Accordingly, Petitioners respectfully request a Decision to institute *inter*

partes review.

III.   SUMMARY OF THE '854 PATENT

A.   Background Of The '854 Patent

The '854 patent is directed to name and address handling within a document

created by a computer program, such as a word processing program. (1:19-27.)

One aspect relates to inserting information from a database into a document. This

is described in connection with the left side of the flow charts of Figs. 1 and 2 and

Examples 1, 5 and 7. Another aspect relates to adding data from a document into a

database. This is described in connection with the right side of Figs. 1 and 2 and

Examples 2-4 and 6. Dr. Menascé's Declaration (Ex. 1002) includes highlighted

copies of Fig. 1 corresponding to various examples.

Example 2 relates to adding a new contact to a database. Fig. 5 (below)

illustrates a document into which a name and address 46 have been entered. (6:10-

13.) The user presses a "OneButton" button 42. (6:13-17; Fig. 1 at 2.) A program

then analyzes what the user has typed into the document to detect certain types of

information. (4:25-39; Fig. 1 at 4.)   There is no disclosure as to how this analysis

is accomplished.
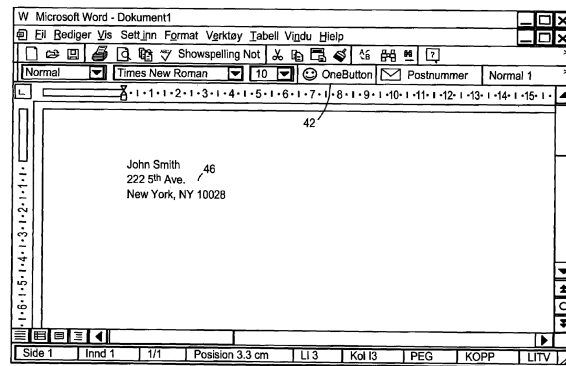
FIG. 5

Upon detection, the name and address are searched in a database. (6:13-17; Fig. 1

at 14.) If the name and address in the document are not found, the user is

prompted to, for example, enter the name and address into a database as shown in

Fig. 6 and set forth in exemplary claims 22 and 24. (6:17-23.) The user can also

edit the name and address, *e.g.*, as discussed in connection with Fig. 7 and

exemplary claim 23. (6:28-35.)

B.   Prosecution History Of The '854 Patent

Throughout the prosecution of the '854 patent, Applicant argued that the distinguishable feature over the applied art was marking information or identifying information, such as a name and address in a document, "without user intervention." For example, in an Amendment dated January 24, 2008, at 31 (Ex. 1003), Applicant asserted:

> Thus, Pandit teaches a system where the user must select text prior to the system processing the "a selected text", e.g. col. 5, line 56). Neither the AddressMate program nor Pandit teach the element of "marking without user intervention" or "identifying without user intervention or designation the first information" either alone or in combination.

As set forth below, such marking or identifying information without user intervention was well-known in the art.

IV.   CLAIM CONSTRUCTION

Petitioners provide constructions of several terms and the means-plus-function limitations. *See* 37 C.F.R. § 42.104(b)(3). Petitioners note that a claim is given the "broadest reasonable construction in light of the specification" in *inter partes* review. *See* 37 C.F.R. § 42.100(b). Furthermore, a number of claims contain means-plus-function limitations under 35 U.S.C. § 112, ¶ 6 (pre-AIA).

A.   "Marking … The First Information To Alert The User"

The recitation "marking … the first information to alert the user" appears in

numerous independent claims. (*See* Claims 19, 25, 31.) However, neither the term

"marking" nor the full recitation appears in the specification. The '854 patent is a

continuation of application No. 09/189,626 filed on November 10, 1998, and the

"marking" recitation was not added until the application that matured into the '854

patent was filed years later in August 6, 2001. Therefore, the specification gives

no guidance as to the meaning of this recitation. Accordingly, the plain meaning

of the recitation is that the first information is detected without user intervention

and has some form of marking or highlighting applied to it to draw the user's

attention to it. (Menascé Decl. ¶¶ 49-50.)

During prosecution, Applicant attempted to provide an expansive reading of

"marking" in order to demonstrate support for the recitation, and asserted that the

program "marks the 'first information' in any of a variety of ways" and "may

display the text (the 'first information') to the user." (Amendment dated April 18,

2007 (Ex. 1004), at 30-31.) The portions of the specification identified relate to

generating another screen, *e.g.*, Fig. 9, and not to any direct marking of the first

information itself (which is already displayed in the document) to provide the

recited alerting function. Therefore, because the only possible disclosure of

marking to alert in the specification is provision of a separate dialog box, for this

7

proceeding the marking to alert recitation should be construed to encompass both direct marking (*e.g.,* highlighting or a pop-up at the information being marked) and display of the information in a separate dialog box.

B.   "Performing An Operation Related To Second Information"

The term "performing an operation related to second information" appears in numerous claims. (*See* Claims 19, 25, 31, 57, 73, 79, 85, 96, 99.) The broadest reasonable construction of this term encompasses operations relating to either already-existing information or the entry of new information, whether it is second information itself or other information related to second information. Such scope is consistent with other claims and the various examples contained in the specification. For example, dependent claim 22 recites the operation as entering additional data into a database. In dependent claim 23, this additional data is entered by a user, which, for example could be done by the user adding second information – that is not currently in the database – into the database as described in connection with Fig. 7 and 6:28-33 and numerous other examples. In contrast, in dependent claim 24, the additional data is located within the document. This can correspond, for example, to Fig. 6, where the data from the document already exists and is directly added to the database. Therefore, the operation in claim 19 should be construed to encompass both preexisting data and newly entered data added to the database.

C.   Means-Plus-Function Limitations

For means-plus-function limitations, 37 C.F.R. § 42.104(b)(3) requires the petition to identify the structure corresponding to each claimed function. However, a structure that is not actually disclosed in the specification cannot be corresponding structure. *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 948, 952 (Fed. Cir. 2007).

In IPR2013-00152, the Patent Trial and Appeal Board denied institution of an *inter partes* review because, among other reasons, the means-plus-function limitations were not amenable to construction. Specifically, the Board analyzed the specification and concluded that there was no corresponding structure disclosed in the specification to perform the recited function of various limitations. (Decision (Paper 8 dated August 19, 2013), at 12, 13, 20.) It is submitted that the same situation exists with respect to the claims in this Petition having means-plus-function limitations, *i.e.*, claims 31-35, 79-84, and 99, which are only a subset of the total claims at issue in this Petition.

1.   Independent Claim 31

Claim 31 includes three limitations, which are all means-plus-function limitations, with the recited functions underlined below.

Limitation/Recited Function	Corresponding Structure
means for <u>entering a first information in</u>	Keyboard along with its device driver at

the first application program	Fig. 16 and 9:37-39. (Menascé Decl. ¶¶ 54-57.)
means for <u>marking without user intervention the first information to alert the user that the first information can be utilized in a second application program</u>	None. Boxes 4, 6 and 4:25-39 simply show desired results, with no algorithm disclosing what is done. (Menascé Decl. ¶¶ 58-62.)
means for <u>responding to a user selection by performing an operation related to a second information, the second information associated with the first information from the second application program</u>	Figs. 1 and 2 (boxes/steps 20, 22, 27, 28, 30, 33, 34, 36) and accompanying discussion in the specification; Examples 4-6 discussed in the specification. (Menascé Decl. ¶¶ 63-71.) Box 22, however, simply shows desired results, with no algorithm disclosing what is done.

2.   Independent Claim 79

Independent claim 79 includes two means-plus-function limitations, with the recited functions underlined below.

Limitation/Recited Function	Corresponding Structure
means for <u>identifying without user intervention or designation the first</u>	None. Boxes 4, 6 and 4:25-39 simply show desired results, with no algorithm

information	disclosing what is done. (Menascé Decl. ¶¶ 72-76.)
means for responding to a user selection by performing an operation related to a second information, the second information associated with the first information from the second application	Figs. 1 and 2 (boxes/steps 20, 22, 27, 28, 30, 33, 34, 36) and accompanying discussion in the specification; Examples 4-6 discussed in the specification. (Menascé Decl. ¶¶ 77-84.) Box 22, however, simply shows desired results, with no algorithm disclosing what is done.

3.   Independent Claim 99

Independent claim 99 includes five means-plus-function limitations, with the recited functions underlined below.

Limitation/Recited Function	Corresponding Structure
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	None. Boxes 4, 6 and 4:25-39 simply show desired results, with no algorithm disclosing what is done to identify a name or address. (Menascé Decl. ¶¶ 85-89.)

11

means for <u>responding to a user selection by performing an operation related to a second information, the second information associated with all or part of the first information from the second application program</u>	Figs. 1 and 2 (boxes/steps 20, 22, 27, 28, 30, 33, 34, 36) and accompanying discussion in the specification; Examples 4-6 discussed in the specification. (Menascé Decl. ¶¶ 90-94.) Box 22, however, simply shows desired results, with no algorithm disclosing what is done.
means for <u>initializing the second application program</u>	None. (Menascé Decl. ¶ 95-99.)
means for <u>searching, using the second application program, for the second information associated with the first information</u>	Figs. 1 and 2 (step 12 or 14) described in column 4, lines 43-46 and 57-58 and Fig. 2 (steps 12 or 14) described in column 5, lines 12-16 and 23-26; Examples 1, 2, 4, 5, and 6 discussed in the specification. (Menascé Decl. ¶¶ 100-104.)
means for <u>retrieving and displaying the second information</u>	Figs. 1 (steps 18 and 20) 2 (steps 26 and 30 or steps 26 and 27 or steps 29, 31, and 30) described on 4:43-49, 5: 23-53;

	Examples 1 and 5 discussed in the specification. (Menascé Decl. ¶¶ 105-109.)

D.   Remaining Claim Terms

Petitioners submit that the remaining claim terms should be accorded their ordinary and customary meaning as understood by one of ordinary skill in the art.

V.   IDENTIFICATION OF CHALLENGE

Pursuant to 37 C.F.R. § 42.104(b), Petitioners respectfully request the cancellation of claims 19-35, 57-85, 96, and 99 of the '854 patent based on the following references.

Reference	Designated Name/Exhibit No.
SIGCHI Bulletin (April 1998) at 51-63	LiveDoc/Drop Zones (Ex. 1005)
U.S. Patent No. 6,085,206 to Domini et al.	Domini (Ex. 1006)
U.S. Patent No. 5,946,647 to Miller et al.	Miller (Ex. 1007)
U.S. Patent No. 5,644,735 to Luciw et al.	Luciw (Ex. 1008)
U.S. Patent No. 5,963,964 to Nielsen	Nielsen (Ex. 1009)

The statutory grounds for the challenge of each claim are set forth below. All the statutory citations are pre-AIA.

Ground	35 USC	Claims	References

13

1	102(a)	19-22, 24-28, 30-34, 57-60, 62-69, 72-76, 78-82, 84, 85, 96, and 99	LiveDoc/Drop Zones
2	103(a)	23, 29, 35, 61, 64-71, 77, and 83	LiveDoc/Drop Zones
3	103(a)	22-24, 28-30, 34, 35, 60-62, 76-78, and 82-84	LiveDoc/Drop Zones and Nielsen
4	102(e)	19, 20, 22-26, 28-32, 34, 35, 57, 58, 60-74, 76-80, 82-85, 96, and 99	Domini
5	102(e)	19, 21-25, 27-31, 33-35, 57, 59-63, 72, 73, 75-79, and 81-84	Miller
6	103(a)	20, 26, 32, 58, 64-69, 74, 80, 85, 96, and 99	Miller
7	102(e)	19-35, 57-71, 73-85, 96, and 99	Luciw

Below is a discussion of why the challenged claims of the '854 patent are unpatentable under the statutory grounds raised, including claim charts specifying where each element of a challenged claim is met by the prior art. 37 C.F.R. § 42.104(b)(4). The showing in these sections establishes a reasonable likelihood of prevailing as to each ground of invalidity with respect to the challenged claims as to that ground. This showing is accompanied by the Declaration of Dr. Daniel A. Menascé (Ex. 1002), as noted above.

14

VI. GROUNDS BASED ON LIVEDOC/DROP ZONES

A.   Background Of LiveDoc/Drop Zones

The April 1998 issue of SIGCHI Bulletin was dedicated to Apple's Advanced Technology Group. The Bulletin included an introduction section and two articles, by James Miller and Thomas Bonura, describing an Apple technology that allowed documents to reveal structures for identification and action. The articles are entitled "From Documents to Object: An Overview of LiveDoc" and "Drop Zones: An Extension of LiveDoc" and are sequential in the SIGCHI Bulletin from pages 53-63 (collectively, "LiveDoc/Drop Zones"). LiveDoc/Drop Zones thus qualifies as prior art under § 102(a) based on the earliest alleged U.S. filing date of the '854 patent.

LiveDoc/Drop Zones discloses creating a document and entering information into the document using a text entry application program, such as shown in Fig. 2 of LiveDoc below.[1] (LiveDoc, 53-55.)

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[1] Fig. 2 is from a website posting (Ex. 1010) of LiveDoc and is identical in content to the LiveDoc publication accompanying this Petition.

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.

Without user intervention, LiveDoc's "structure detection" process runs in the background and highlights information in the document that can be used to perform a related action. (LiveDoc at 54-55.) Selecting a highlighted structure displays a menu of actions that can be performed. (*Id.*) For example, in Fig. 2 above, the user can view the webpage of the URL identified in the document in Netscape Navigator. (LiveDoc at 54, 57-58.) Drop Zones is an interface to LiveDoc that allows, for example, e-mail actions or adding to an address book based on an identified name in a document. (Drop Zones at 60-61.)

16

B.   Ground 1: Anticipation Based On LiveDoc/Drop Zones

1.   Method Claims

Method claims 19-22, 24, 57-60, 62-69, 72 and 85 are anticipated by

LiveDoc/Drop Zones as set forth below.

Claim	LiveDoc/Drop Zones
[19a] 19. A method for information handling within a document created by a first application program comprising the steps of:	LiveDoc discloses a document created using a first application program (*e.g.*, a document as shown in Fig. 2 created using a text entry application program). *See also* LiveDoc at 53 ("There is a real opportunity to advance the computing field here, by bringing these two worlds together: by enabling an ordinary document, built with any application, to automatically offer users access to some of the meaningful bits of its content, and by helping users carry out appropriate actions on these objects."); at 55 ("[W]e decided to modify a simply text editor application, SimpleText, to be a LiveDoc client."). Drop Zones uses the same program. *See*, *e.g.*, at 60 (referring to a "LiveDoc enabled word processor, *LiveSimpleText*").
[19b] entering a first information in the first application program;	A document including first information, such as a name, an e-mail address or a URL, is entered in the first application program such as a word processor. *See, e.g.*, document of Fig. 2 of LiveDoc (e-mail addresses and URL); document of Fig. 2 in Drop Zones (name). Word processor is *LiveSimpleText.*
[19c] marking without user intervention the first information to alert the user that the first information can be utilized in a second application program; and	In LiveDoc/Drop Zones, the first information is marked without user intervention to alert the user that the first information can be utilized in a second application program *Marking and alerting – See, e.g.*, LiveDoc at 55 ("In LiveDoc, the structure detection process is run in the background on the visible document's text, whenever that document is presented or updated. The results of LiveDoc's analysis are then presented by visually highlighting the discovered structures with a patch of color around the structure … Pointing at a highlight and pressing the mouse button then displays the menu of actions that can be applied to the structure, as shown in Fig 2."); at 55 ("Experientially,

17

	the design of LiveDoc draws on the Web in obvious ways: certain meaningful parts of a document are highlighted, and clicking on them causes certain actions to occur."); Fig. 2 of LiveDoc (e-mail addresses and URL detected and highlighted); Drop Zones at 60 ("Consider Figure 2, in which the user has selected the structure Tom Bonura, which LiveDoc has identified with its personalName recognizer.") *Second application program* – Numerous applications, *e.g.*, browser, e-mail or address book are disclosed in LiveDoc and Drop Zones. *See, e.g.*, LiveDoc at 54 ("This first version of structure detection has been applied to the domain of Internet information management; finding structures like e-mail addresses, URLs, host names, and newsgroup names in user documents and automating actions on these structures, like creating a new e-mail message addressed to a discovered e-mail address or opening a web browser on a discovered URL."); at 57-58 ("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."); Fig. 2 of LiveDoc. A URL can be utilized to retrieve a webpage and can be placed in a bookmark database via the web browser. *See also* Drop Zones at 60 ("Add this person to my address book."); at 61 ("Such a mapping…enables the E-mail assistant to look inside an address book application for a person with the stated phone number.")
[19d] responding to a user selection by performing an operation related to a second information,	LiveDoc/Drop Zones responds to a user selection by performing an operation related to a second information (*e.g.*, sending an e-mail, bookmarking the URL or displaying the webpage pointed to by a URL, or entering a person's information in an address book). *User selection – See, e.g.*, LiveDoc at 56 ("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. If one of these items is selected, the action corresponding to the selection is run, producing the desired action.").

	Second information – When the user clicks on a URL, second information is the webpage pointed to by the URL. When the user selects the option to bookmark the URL (*see* Fig. 2 of LiveDoc ("Bookmark in Netscape Navigator")), the second information is a name associated with the URL. For a detected name of a person in Drop Zone, the second information is other address book information corresponding to the detected name, such as telephone number and e-mail address of the person. *Operation related to second information* – *See, e.g.*, LiveDoc at 57 ("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."); Fig. 2 of LiveDoc ("Bookmark in Netscape Navigator"). Drop Zones at 60 ("Add this person to my address book.")
[19e] the second information associated with the first information from the second application program.	*See* claim 19d.

20. The method of claim 19 wherein the operation comprises displaying the second information.	LiveDoc discloses displaying the second information (*e.g.*, displaying the website pointed to by a URL). *See, e.g.*, LiveDoc at 57 ("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."); at 54 ("This first version of structure detection has been applied to the domain of Internet information management; finding structures like e-mail addresses, URLs, host names, and newsgroup names in user documents and automating actions on these structures, like creating a new e-mail message addressed to a discovered e-mail address or opening a web browser on a discovered URL."). In Drop Zones, an e-mail based on a detected name

19

	would display the e-mail address.

21. The method of claim 19, wherein the first information is a name, and the operation performed is selected from a group consisting of an electronic mail, a telex, a facsimile or a letter addressed to the name indicated by the first information.	Drop Zones allows for entering a name and adding the name to an address book or providing e-mail actions with respect to the name. *See, e.g.*, Drop Zones at 60 ("Add this person to my address book"); at 61 ("… What is interesting in this example is that the e-mail actions are available, even though the object being offered to the assistant is a personalName ...") ("Such a mapping ... enables the E-mail Assistant to look inside an address book application for a person with the stated phone number.").

22. The method of claim 19, wherein the operation performed is entering additional data into a database.	LiveDoc discloses adding a bookmark in a web browser. Fig. 2 ("Bookmark in Netscape Navigator"). The bookmark list is a database containing URLs and corresponding names. When a bookmark is added URL and name data is entered into the database. Drop Zones discloses adding a person's information to an address book database. *See*, *e.g.*, at 60 ("Add this person to my address book.")

24. The method of claim 22, wherein the additional data is located within the document.	The URL located in the document in LiveDoc is additional data that is entered into the bookmark database. In Drop Zones, the name for the address book is located in the document.

[57a] 57. A method for information handling within a document operated on by a first application program, the document containing first information that can be utilized in a second application program the method comprising the steps of:	LiveDoc discloses a method for information handling within a document operated on by a first application program. *See* claim 19a. The document contains first information that can be utilized in a second application program. *See* claim 19b-c.
[57b] identifying without user intervention or designation the first information; and	LiveDoc identifies the first information without user intervention or designation. *See, e.g.*, LiveDoc at 55 ("In LiveDoc, the structure detection process is run in the

	background on the visible document's text, whenever that document is presented or updated."); at 55 ("LiveDoc's use of background processing and automatic highlighting of discovered structures offers other advantages. Structures relevant to the user are automatically presented to the user while a document is in LiveDoc mode; interesting structures need not be searched for and highlighted manually."). Drop Zones at 60 ("Consider Figure 2, in which the user has selected the structure Tom Bonura, which LiveDoc has identified with its personalName recognizer.") *See also* claim 19c.
[57c] responding to a user selection by performing an operation related to a second information,	*See* claim 19d.
[57d] the second information associated with the first information from the second application program.	*See* claim 19e.

58. The method of claim 57 wherein the operation comprises displaying the second information.	*See* claim 20.

59. The method of claim 57, wherein the first information is a name, and the operation performed is selected from a group consisting of generating an electronic mail, a telex, a facsimile or a letter addressed to the name indicated by the first information.	*See* claim 21.

60. The method of claim 57, wherein the operation performed is entering additional data into a database.	*See* claim 22.

62. The method of claim 60, wherein the additional data is located within the document.	*See* claim 24.

63. The method of claim 57 wherein the user selection comprises an activation of a menu.	LiveDoc discloses user selection via activation of a menu. *See, e.g.*, Fig. 2; LiveDoc at 55 ("Pointing at a highlight and pressing the mouse button then displays the menu of actions that can be applied to the structure, as shown in Fig 2."); at 55 ("[C]licking on the host name part of a URL can present a menu of actions relevant to host names, while clicking outside the host name region presents actions relevant to URLs."). Fig. 1 of Drop Zones shows "Activities" menu.

[64a] 64. The method of claim 63, wherein the step of performing the operation further comprises the steps of:	*See* claim 63.
[64b] initializing the second application program;	The second application program must necessarily be initialized in order to run.
[64c] searching, using the second application program, for the second information associated with the first information; and	LiveDoc discloses detecting the formula (first information) for an organic molecule in a document and displaying a rendering of the molecule (second information) in the document. *See, e.g.*, LiveDoc at 58 ("Imagine a detector that finds the formula of an organic molecule in a document, and an action that presents a three-dimensional rendering of that molecule within the context of the document itself …"). In order to present the rendering, it is necessary to search a database to locate the rendering associated with the formula. Drop Zones discloses e-mail actions when the first information is a name. *See, e.g.*, Drop Zones, 60-61 ("What is interesting in this example is that the e-mail actions are available, even though the object being offered to the assistant is a personalName."); *Id.* ("Such a mapping ... enables the E-mail Assistant to look inside an address book application for a person with the stated phone number."). The address book

	application therefore searches for the e-mail address associated with the name.
[64d] retrieving the second information.	The molecule rendering must be retrieved to be displayed, and the e-mail address must be retrieved to send an e-mail. *See* claim 64c.

65. The method of claim 64, wherein when the second information associated with first information exists, performing the further step of displaying the second information.	*See* claim 20.

66. The method of claim 65, wherein the first information comprises a name.	*See* claim 21.

[67a] 67. The method of claim 66, wherein the activation of the menu comprises	*See* claim 63.
[67b] selecting the menu indicator for the menu	LiveDoc discloses selecting the menu indicator for the menu (*i.e.*, a highlight). *See, e.g.*, LiveDoc at 55 ("Pointing at a highlight and pressing the mouse button then displays the menu of actions that can be applied to the structure, as shown in Fig 2."); Fig. 2 of LiveDoc.
[67c] opening the menu	Selecting the menu indicator opens the menu. *See* claim 67b.
[67d] selecting a choice in the menu; and	LiveDoc discloses selecting a choice in the menu. *See, e.g.*, LiveDoc at 56 ("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. If one of these items is selected, the action corresponding to the selection is run, producing the desired action."); Figs. 1 and 2 of Drop Zones shows selecting a choice from an "Activities" menu.
[67e] activating the selected choice in the menu.	LiveDoc and Drop Zones disclose activating the selected choice in the menu. *See, e.g.*, Figs. 2 of LiveDoc and Drop Zones. *See also* claim 67d.

23

68. The method of claim 67, wherein selection of the menu indicator comprises moving a mouse pointer to the menu indicator.	In LiveDoc, selection of the menu indicator comprises moving a mouse pointer to the menu indicator. *See, e.g.*, LiveDoc at 55 ("Pointing at a highlight and pressing the mouse button then displays the menu of actions that can be applied to the structure, as shown in Fig 2."); at 56 ("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."). In Drop Zones at 61, "Activities" object is clicked on.

69. The method of claim 68, wherein the opening of a menu comprises clicking on the menu indicator with a mouse button.	In LiveDoc, opening of a menu comprises clicking on the menu indicator with a mouse button. *See* claim 68.

72. The method of claim 57, wherein the second information is associated with only part of the identified first information.	In LiveDoc, operations can be performed based on nested structures identified, in which case the second information is associated with only part of the identified first information. *See, e.g.*, LiveDoc at 54 ("It is not uncommon for useful structures to be nested within other useful structures. The URL 'http://www.apple. com/defaut.html' contains within it the host name 'www.apple.com'; a similar situation holds for the host name embedded in an e-mail address."); at 55 ("Similarly, nested structures can be handled by nesting the mouse-sensitive regions around the structure: clicking on the host name part of a URL can present a menu of actions relevant to host names, while clicking outside the host name region presents actions relevant to URLs. This is shown in Figure 2: the host name of the e-mail address and URL ('sci.org') is shown with a darker highlight than those of the e-mail address and URL themselves.").

[85a] 85. A method for information handling within a document operated on by a first application program, the document containing first information entered by a user, the method	LiveDoc/Drop Zones discloses a method for information handling within a document operated on by a

comprising the steps of:	first application program. *See* claim 19a. The document contains first information entered by a user. *See* claim 19b.
[85b] identifying without user intervention or designation the first information that can be utilized in a second application program,	*See* claims 19c and 57b.
[85c] the first information selected from a group consisting of a name and an address; and	*See* claim 21.
[85d] responding to a user selection by performing an operation related to a second information,	*See* claims 19d and 57c.
[85e] the second information associated with all or part of the first information from the second application program,	*See* claims 19e, 57d, and 72.
[85f] wherein the step of responding to the user selection further comprises the steps of: initializing the second application program;	*See* claim 64b.
[85g] searching, using the second application program, for the second information associated with the first information; and	*See* claim 64c.
[85h] if said second information exists, retrieving and displaying the second information;	*See* claim 64d.
[85i] wherein said user selection comprises: selecting a menu indicator for the menu;	*See* claims 63 and 67b.
[85j] opening the menu;	*See* claim 67c.
[85k] selecting a choice in the menu; and	*See* claim 67d.
[85l] activating the selected choice in the menu;	*See* claim 67e.
[85m] wherein selecting the menu indicator comprises moving the mouse pointer to the menu indicator;	*See* claim 68.
[85n] wherein opening the menu comprises clicking on the menu indicator with a mouse button; and	*See* claim 69.
[85o] wherein the second information is associated with at least part of the identified first information.	*See* claims 19e, 57d, 72, and 85e.

2.   Computer Readable Medium And System Claims

Computer readable medium claims 25-28, 30, 73-76, 78, and 96 are anticipated by LiveDoc/Drop Zones. These claims correspond to method claims 19-22, 24, 57-60, 62, and 85. LiveDoc/Drop Zones discloses the steps in the body of the computer readable medium claims (as set forth above with respect to the corresponding method claims) and further discloses a computer readable medium including program instructions (*see, e.g.*, LiveDoc at 57 (referring to processors); Fig. 2 (illustrating a screen from an Apple computer)).

System claims 31-34, 79-82, 84, and 99, which include means-plus-function limitations, are also anticipated by LiveDoc/Drop Zones. These claims correspond to method claims 19-22, 57-60, 62, and 85. LiveDoc/Drop Zones discloses the functions of the means-plus-function limitations (as set forth above with respect to the corresponding method claims). LiveDoc/Drop Zones discloses a processor (*see, e.g.*, LiveDoc at 57) programmed to perform these functions, and the programmed processor is the same or equivalent structure as that disclosed in the '854 patent (if any structure is disclosed at all).

C.   Ground 2: Obviousness In View Of LiveDoc/Drop Zones

Claims 23, 29, 35, 61, 64-71, 77, and 83 are obvious in view of LiveDoc/Drop Zones. (Menascé Decl. ¶ 117.) Exemplary claims 23 and 61 depend from claims 22 and 60, which recite entering additional data into a

database. Claims 23 and 61 further recite "wherein the additional data is entered by a user." As discussed in Ground 1, claims 22 and 60 are anticipated by LiveDoc. LiveDoc discloses adding a bookmark ("additional data") in a web browser based on a URL in a document. (*See, e.g.*, Fig. 2 of LiveDoc.) It was well known that the names of bookmarks can be edited based on a user's personal preference for the names of bookmarks. (Menascé Decl. ¶ 117.) Thus it would have been obvious to one of ordinary skill in the art to have edited the bookmark based on the URL in the document, based on his or her personal preference for the name of the bookmark. It would also have been obvious to one of ordinary skill in the art that the user would enter additional information into an address book when a detected name is added to the address book as disclosed in Drop Zones. (*Id.*)

Computer readable medium claims 29 and 77 are obvious in view of LiveDoc/Drop Zones. (Menascé Decl. ¶ 117.) These claims correspond to method claims 23 and 61. LiveDoc/Drop Zones discloses or renders obvious the steps in the body of the computer readable medium claims (as set forth above with respect to the corresponding method claims) and further discloses a computer readable medium including program instructions (*see, e.g.*, LiveDoc at 57; Fig. 2).

System claims 35 and 83, which include means-plus-function limitations, are also obvious in view of LiveDoc/Drop Zones. (Menascé Decl. ¶ 117.) These claims correspond to method claims 23 and 61. LiveDoc/Drop Zones discloses the

27

functions of the means-plus-function limitations (as set forth above with respect to the corresponding method claims). LiveDoc/Drop Zones discloses a processor (*see, e.g.*, LiveDoc at 57) programmed to perform these functions, and the programmed processor is the same or equivalent structure as that disclosed in the '854 patent (if any structure is disclosed at all).

Claim 64 and its dependent claims 65-69 recite initializing the second application program and searching using the second application program for the second information. These steps would have been obvious in view of LiveDoc and Drop Zones. (Menascé Decl. ¶ 118.) For example, Drop Zones at 60-61 discloses detecting a name that is then utilized by an e-mail application to obtain an e-mail address. As a matter of common sense, it would have been obvious for the e-mail application to be initialized in order to run and to search the address book for the e-mail address. (*Id* .)

Claims 70 and 71 are directed to the identifying (or at least part of the identifying) occurring after the user selection. These claims are obvious in view of LiveDoc/Drop Zones. (Menascé Decl. ¶ 119.) In LiveDoc, the detection process runs in the background, but structures are not highlighted until a function key is held down. It would have been obvious that the detection process could also be run in response to holding the function key. (*See, e.g.*, LiveDoc at 55 ("Holding down a function key places the document in 'LiveDoc Mode' and presents the

28

highlighted structures."); Menascé Decl. ¶ 119.) Although such implementation

would be slower than running the process in the background and thus not as

desirable, it would still have been obvious from a technical perspective, as the

authors were aware of such implementation but chose to implement the more

desirable one.   (*See, e.g.*, LiveDoc at 56 ("LiveDoc works quietly in the

background and displays the results of its analysis on demand, rather than

performing the analysis on demand.")) (Menascé Decl. ¶ 119.)

D.   Ground 3: Obviousness In View Of LiveDoc/Drop Zones And Nielsen

Claims 22-24, 28-30, 34, 35, 60-62, 76-78, and 82-84 are additionally

obvious in view of LiveDoc/Drop Zones and Nielsen. Nielsen was filed on April

5, 1996 and thus qualifies as prior art under § 102(e) based on the earliest alleged

U.S. filing date of the '854 patent. Nielsen discloses creating bookmarks in

Netscape Navigator that include URLs and a corresponding user-entered name for

the bookmark. (Fig. 12 at 1210; 2:9-31.)

Claims 22, 28, 34, 60, 76, and 82 and their dependent claims all recite that

the operation being performed is entering additional data into a database. As

discussed above in Ground 1, LiveDoc discloses adding a bookmark in a web

browser. The bookmark list is a database containing URLs and corresponding

names, which was well-known according to Nielsen. Thus, creating a bookmark,

as disclosed in LiveDoc, enters the bookmark data into the database. This would

have simply been a combination of prior art elements according to known methods to yield predictable results. (Menascé Decl. ¶ 121.)

Moreover, as to claims 23, 29, 35, 61, 77 and 83, Nielsen explicitly discloses that the name of the bookmark added to the database can be changed. (Fig. 12; 2:27-29 ("Edit control button 1204 allows a user to add a new header name to a name field 1210.").)

VII.   GROUND BASED ON DOMINI

A.   Background Of Domini

Domini was filed on June 20, 1996 and thus qualifies as prior art under § 102(e) based on the earliest alleged U.S. filing date of the '854 patent. Domini discloses identifying and correcting spelling errors in a document created by a word processing program. (Abstract; 4:65-5:11.) The user selects the "spelling and grammar" command to initialize the spell check program.   (16:13-16.) Without user intervention, the spell check program identifies misspelled words and presents them in red, bold typeface. (17:27-33; 4:12-16.) The spell check program also displays a list of suggested corrections, as shown in Fig. 3 below. (1:42-44; 12:1-5.) When the user selects the "Change" button 340, the suggested correction selected by the user is inserted into the document. (12:61-64.)

30
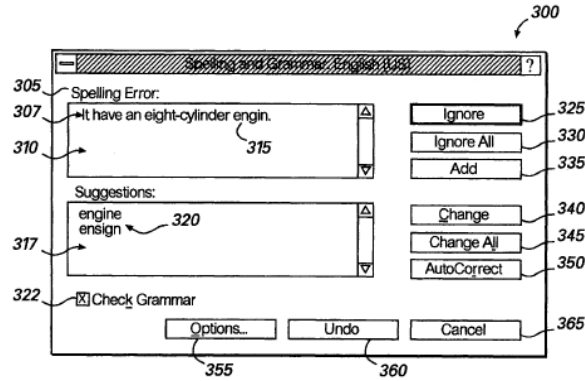
FIG.3

B.   Ground 4: Anticipation Based On Domini

1.   Method Claims

Method claims 19, 20, 22-24, 57, 58, 60-72, and 85 are anticipated by

Domini as set forth below.

Claim	Domini
[19a] 19. A method for information handling within a document created by a first application program comprising the steps of:	Domini discloses a method for identifying and correcting spelling errors within a document created by a word processor program (first application program). *See, e.g.*, Abstract ("In an electronic word processing system environment, a system and method for verifying the accuracy of the grammatical composition of a sentence and the spelling of words within the sentence in an electronic document.").
[19b] entering a first information in the first application program;	A user enters words and sentences (first information) into the word processing program (first application program). *See, e.g.*, 5:1-7 ("The preferred embodiment of the present invention is represented by 'WORD', version 8.0, which is a word processing application program … Briefly described, the preferred program allows users to create and edit electronic documents by entering characters, symbols, graphical objects, and commands.").
[19c] marking without user	Without user intervention (*see*, *e.g.*, 3:31-41), the spell check program identifies a potentially misspelled word and marks it

31

intervention the first information to alert the user that the first information can be utilized in a second application program; and	by presenting the word in red, bold typeface to alert the user the word can be utilized in the database, *i.e.*, dictionary of the spell check program. *Marking to alert* – 4:12-16 ("It is determined whether any of the words in the sentence are misspelled and an indication, such as presenting the misspelled word in red, bold typeface, is provided for any misspelled words."); Fig. 3; 11:55-60 (blinking cursor). *Second application program* – Fig. 1 identifies word processing program 37A and spell checker program 37B, which includes one or dictionaries, as different application programs. *See e.g.*, Fig. 1; 7:41-51 ("The application programs 37 may include a number of different programs such as a word processing program 37a, a spell checker program 37b, and a grammar checker program 37c."); 16:66-17:57 (standard and custom dictionaries); 7:41-51; 1:56-61.
[19d] responding to a user selection by performing an operation related to a second information,	The user can select a suggested correction, which is then inserted into the document (an operation related to second information). *Second information* – Second information is a list of suggested corrections for an identified misspelled word. 1:42-44 ("In addition, many spell checker program modules provide other features, such as lists of suggestions to replace the misspelled word …"). *Operation related to second information* – Figs. 3, 5, and 7; 12:1-5 ("Still referring to FIG. 3, the combined spelling and grammar dialog box 300 includes a suggestion list box 317. The suggestion list box 317 includes a plurality of suggestions 320 to replace the possible spelling error in the sentence 307."); 12:61-64 ("If the user selects the Change button 340, the misspelled word 315 will be replaced with the word that has been selected by the user from the suggestions 320 in the suggestion list box 317.").
[19e] the second information associated with	Each suggested correction (second information) for a misspelled word is associated with the misspelled word (first information).

the first information from the second application program.	

20. The method of claim 19 wherein the operation comprises displaying the second information.	The spell check program displays the list of suggested corrections (second information). *See, e.g.*, 18:7-9 ("The suggestions are the information that is displayed in the suggestions list box 317 as shown in FIG. 3."). *See also* claim 19d.

22. The method of claim 19, wherein the operation performed is entering additional data into a database.	The spell check program allows the user to add a misspelled word identified in the document (and for which a suggested correction is provided) to the dictionary (database). 12:50-58 ("If the user selects the Add button 335 for a spelling error, then the misspelled word is added to the custom dictionary."); Fig. 3.

23. The method of claim 22, wherein the additional data is entered by a user.	The word identified and added to the dictionary in claim 22 is entered by the user into the document. *See* claims 19b and 22.

24. The method of claim 22, wherein the additional data is located within the document.	The word identified and added to the dictionary is located within the document. *See* claims 19b and 22.

[57a] 57. A method for information handling within a document operated on by a first application program, the document containing first information that can be utilized in a second application program the method comprising the steps of:	Domini discloses information handling within a document operated on by a first application program. *See* claim 19a. The document contains first information that can be utilized in a second application program. *See* claims 19b-c.
[57b] identifying without user intervention or designation the first information; and	Without user intervention, the spell check program detects words and identifies a potentially misspelled word in the document (first information). *See, e.g.*, 17:27-33 ("As is well-known in the art, a

	spell checker program module checks the spelling of a word by comparing the word to the list of words in the standard dictionary and custom dictionaries. If the word does not correspond to one of the words in the standard dictionary or custom dictionaries, then the spell checker program module flags the word as a word that is possibly misspelled."); Figs. 3, 5 and 7. *See also* claim 19c.
[57c] responding to a user selection by performing an operation related to a second information,	*See* claim 19d.
[57d] the second information associated with the first information from the second application program.	*See* claim 19e.

58. The method of claim 57 wherein the operation comprises displaying the second information.	*See* claim 20.

60. The method of claim 57, wherein the operation performed is entering additional data into a database.	*See* claim 22.

61. The method of claim 60, wherein the additional data is entered by a user.	*See* claim 23.

62. The method of claim 60, wherein the additional data is located within the document.	*See* claim 24.

63. The method of claim 57 wherein the user selection comprises an activation of a menu.	Domini discloses user selection via activation of a menu. 10:65-11:9 ("The 'Spelling and Grammar' command can be executed by selecting a command from a menu or toolbar displayed on the monitor 31."); 15:36-42.

[64a] 64. The method of claim 63, wherein the step of performing the operation further comprises the steps of:	*See* claim 63.
[64b] initializing the second application program;	The spell check program having one or more dictionaries is called and initiated. *See, e.g.*, 16:56-57 ("Referring to FIG. 7, the spell checker program module is called at step 705 and a spell checking session is initiated.").
[64c] searching, using the second application program, for the second information associated with the first information; and	The spell check program having one or more dictionaries (second application program) provides suggested corrections for a misspelled word (first information). The spell check program searches the dictionary database for the suggested corrections. *See, e.g.*, 16:66-17:57 (standard and custom dictionaries); 18:4-9 ("[T]he preferred application program consults another part of the SRB [Spell Return Buffer] to locate a string buffer containing suggestions from the spell checker program module at step 735. The suggestions are the information that is displayed in the suggestion list box 317 as shown in Fig. 3.").
[64d] retrieving the second information.	The suggested corrections are retrieved from the spell check program and displayed for the user. *See* claim 64c.

65. The method of claim 64, wherein when the second information associated with first information exists, performing the further step of displaying the second information.	*See* claim 20.

66. The method of claim 65, wherein the first information comprises a name.	The misspelled word can be a name. 11:36-40 ("[T]hose skilled in the art will understand that some words, such as proper names, may not be recognized by the spell checker program module and may be flagged as spelling errors even though they are correctly spelled.").

[67a] 67. The method of claim 66, wherein the activation of	*See* claim 63.

35

the menu comprises	
[67b] selecting the menu indicator for the menu	Domini discloses selecting the menu indicator for the menu. *See, e.g.*, 15:36-42 ("[T]he 'Spelling and Grammar' command can be executed by selecting a command from a menu or toolbar of the user interface displayed on the monitor 31. Typically, the user can position a cursor over the desired command button or menu item and select the down position of the mouse button, i.e., by clicking the mouse."); 10:65-11:9.
[67c] opening the menu	Selecting a menu indicator will open the menu. *See* claim 67b.
[67d] selecting a choice in the menu; and	The spelling and grammar command is selected. *See* claim 67b.
[67e] activating the selected choice in the menu.	Selecting spelling and grammar causes it to be activated. *See* claim 67b.

68. The method of claim 67, wherein selection of the menu indicator comprises moving a mouse pointer to the menu indicator.	The user makes a menu selection by moving a mouse pointer to the menu indicator and clicking with a mouse button. *See, e.g.*, 15:39-42 ("Typically, the user can position a cursor over the desired command button or menu item and select the down position of the mouse button, i.e., by clicking the mouse.").

69. The method of claim 68, wherein the opening of a menu comprises clicking on the menu indicator with a mouse button.	*See* claim 68.

70. The method of claim 57 wherein at least part of the identifying occurs after the user selection.	The identification of misspelled words occurs after the user selects the "spelling and grammar" command. *See, e.g.*, 10:14-21 ("In the preferred program, the user selects the command 'Spelling and Grammar' via a menu, toolbar or keyboard. The first sentence in the document is located and, in response, each word in the first sentence is spell checked by the spell checker program module."); 15:31-33 ("The method 500 begins at start step 505 and proceeds to step 510 when the user selects the 'Spelling and Grammar' command."); Fig. 5.

71. The method of claim 57 wherein the identifying occurs	*See* claim 70.

36

after the user selection.	

72. The method of claim 57, wherein the second information is associated with only part of the identified first information.	The spell check program identifies an entire sentence (as shown in Fig. 3 at 307), as well as misspelled words within the sentence. A sentence is also first information. For each misspelled word, the list of suggested corrections is associated with only part of the identified sentence. *See, e.g.*, 4:12-16 ("A sentence is parsed from the document. It is determined whether any of the words in the sentence are misspelled and an indication, such as presenting the misspelled word in red, bold typeface, is provided for any misspelled words.").

[85a] 85. A method for information handling within a document operated on by a first application program, the document containing first information entered by a user, the method comprising the steps of:	Domini discloses a method for information handling within a document operated on by a first application program. *See* claim 19a. The document contains first information entered by a user. *See* claim 19b.
[85b] identifying without user intervention or designation the first information that can be utilized in a second application program,	*See* claims 19c and 57b.
[85c] the first information selected from a group consisting of a name and an address; and	*See* claim 66.
[85d] responding to a user selection by performing an operation related to a second information,	*See* claims 19d and 57c.
[85e] the second information associated with all or part of the first information from the second application program,	*See* claims 19e, 57d, and 72.
[85f] wherein the step of responding to the user selection further comprises the steps of: initializing the second application program;	*See* claim 64b.
[85g] searching, using the second application program, for the second information associated with the first information; and	*See* claim 64c.

37

[85h] if said second information exists, retrieving and displaying the second information;	*See* claim 64d.
[85i] wherein said user selection comprises: selecting a menu indicator for the menu;	*See* claims 63 and 67b.
[85j] opening the menu;	*See* claim 67c.
[85k] selecting a choice in the menu; and	*See* claim 67d.
[85l] activating the selected choice in the menu;	*See* claim 67e.
[85m] wherein selecting the menu indicator comprises moving the mouse pointer to the menu indicator;	*See* claim 68.
[85n] wherein opening the menu comprises clicking on the menu indicator with a mouse button; and	*See* claim 69.
[85o] wherein the second information is associated with at least part of the identified first information.	*See* claims 19e, 57d, 72, and 85e.

2.   Computer Readable Medium And System Claims

Computer readable medium claims 25, 26, 28-30, 73, 74, 76-78, and 96 are

anticipated by Domini. These claims correspond to method claims 19, 20, 22-24,

57, 58, 60-62, and 85. Domini discloses the steps in the body of the computer

readable medium claims (as set forth above with respect to the corresponding

method claims) and further discloses a computer readable medium including

program instructions (*see, e.g.*, Fig. 1 at 15).

System claims 31, 32, 34, 35, 79, 80, 82-84, and 99, which include means-

plus-function limitations, are also anticipated by Domini. These claims correspond

to method claims 19, 20, 22, 23, 57, 58, 60-62, and 85. Domini discloses the

functions of the means-plus-function limitations (as set forth above with respect to

the corresponding method claims). Domini discloses a processor (*see, e.g.*, Fig. 1

at 14) programmed to perform these functions, and the programmed processor is the same or equivalent structure as that disclosed in the '854 patent (if any structure is disclosed at all).

VIII. GROUNDS BASED ON MILLER

A. Background Of Miller

Miller was filed on February 1, 1996 and thus qualifies as prior art under § 102(e) based on the earliest alleged U.S. filing date of the '854 patent. Miller is assigned to Apple. Miller discloses inputting information in a document of an application program, such as shown in Fig. 5 below. (5:19-21; 3:36-38.)
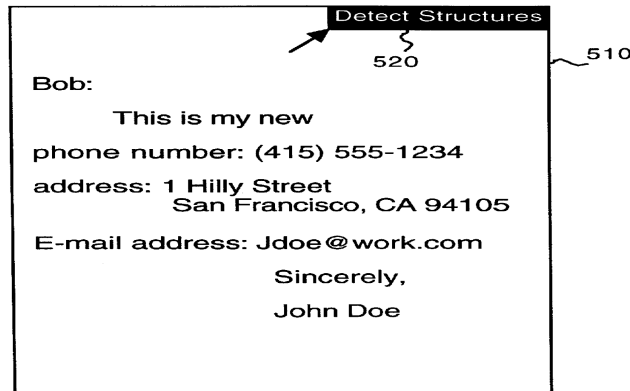
FIG. 5

A user then presses a "Detect Structures" button 520. (5:22-24.) Without user intervention, Miller identifies the structures in the document such as the address. (Fig. 6; 5:25-37.) The user can put the identified address in an address book as shown in Fig. 4 at 410 (second block), along with additional information associated with the address, such as a name.

39

B.   Ground 5: Anticipation Based On Miller

1.   Method Claims

Method claims 19, 21-24, 57, 59-63, and 72 are anticipated by Miller as set

forth below.

Claim	Miller
[19a] 19. A method for information handling within a document created by a first application program comprising the steps of:	Miller discloses performing actions based on information identified (information handling) within a document created by a first application program, such as a word-processor or e-mail program. *See, e.g.*, 1:8-11. *First application program* – First application program is a word processor or e-mail program. *See, e.g.*, Fig. 1, 167; 3:36-38 ("Application 167 is a program, such as a word-processor or e-mail program, that presents data on output device 105 to a user."); 2:42-46. The program 167 creates a document. *See, e.g.*, Fig. 5, 210; 5:19-22 ("FIG. 5 shows a window 510 presenting an exemplary document 210 having data containing recognizable structures, including a phone number, post-office address, e-mail address, and name.").
[19b] entering a first information in the first application program;	Fig. 5 shows a document containing information entered by a user. *See also* 3:36-38; 5:19-22; 5:64-66. The document contains various items of first information, such as phone number, address, and e-mail address.
[19c] marking without user intervention the first information to alert the user that the first information can be utilized in a second application program; and	*Marking and alerting* – Structures in the document such as phone numbers and addresses (the first information) are detected by program 165 and highlighted without user intervention. *See, e.g.*, 2:21-25 ("The present invention … includes a program to identify structures in a document …"); 3:61-64 ("Analyzer server 220 … uses patterns to parse document 210 for recognizable structures."); 4:5-10 (Application program interface 230 "highlights the detected structures."); 3:52-4:15. Highlighted structures are illustrated in Fig. 6. *See also* 3:8-10 ("FIG. 6 illustrates a window with the identified structures

	in the example document of FIG. 5 highlighted based on the analyzer server of FIG. 4."); 5:35-37 ("User interface 240 then highlights the identified structures in document 210 …"). *Second application program* – Second application program is a database program such as an address book or telephone book. Fig. 4 illustrates various actions that can be taken with respect to a highlighted structure, including putting it in an address book or writing a letter. *See also* 5:5-17.
[19d] responding to a user selection by performing an operation related to a second information,	*Second information* – If the detected structure is, for example, a post-office address, the second information is other address information in the address book, such as a name, that is related to the post-office address. *Operation related to a second information* – Entering the detected post-office address information into the address book as shown in Fig. 4 is one operation related to the other address information in the address book, such as a name, and entering additional information in the address book is another operation related to the other address information in the address book, such as a name. *See, e.g.*, Fig. 7; 5:38-50 ("Action processor 250 locates and opens the electronic telephone book, places the telephone number in the appropriate field and allows the user to input any additional information."). Both actions respond to a user selection. Although reference is to a telephone book, the discussion applies equally to an address book. *See also* 2:30-42 ("Upon detection of a structure, the analyzer server links actions to the detected structure …"); 4:52-57 ("Upon selection of a candidate action, user interface 240 transmits the selected structure and the selected action to action processor 250. Action processor 250 retrieves the sequence of operations that constitute the selected action, and performs the sequence using the selected structure as the object of the selected action.").
[19e] the second information associated with the first	The name (second information) is associated with the highlighted address information (first information) in the address book.

information from the second application program.	

21. The method of claim 19, wherein the first information is a name, and the operation performed is selected from a group consisting of an electronic mail, a telex, a facsimile or a letter addressed to the name indicated by the first information.	Fig. 4 of Miller discloses identifying a name (first information) and drafting a letter addressed to the name identified. *See, e.g.*, Fig. 4; 5:19-22 ("FIG. 5 shows a window 510 presenting an exemplary document 210 having data containing recognizable structures, including a phone number, post-office address, e-mail address, and name."); 2:36-41 ("An action may further include … actions such as returning phone calls, drafting letters, sending facsimile copies and e-mail, and the like.").

22. The method of claim 19, wherein the operation performed is entering additional data into a database.	Miller allows the user to add information identified in the document, such as a phone or address, to an address book or phone book. It also allows the user to enter additional information to be added. *See* claim 19d; Fig. 7; 5:38-50 ("Action processor 250 locates and opens the electronic telephone book, places the telephone number in the appropriate field and allows the user to input any additional information.").

23. The method of claim 22, wherein the additional data is entered by a user.	*See* claim 22.

24. The method of claim 22, wherein the additional data is located within the document.	*See* claim 22.

[57a] 57. A method for information handling within a document operated on by a first application program, the document containing first information that can be utilized in a second application program the method comprising the steps of:	Miller discloses a method for information handling within a document operated on by a first application program. *See* claim 19a.

The document contains first information that can be utilized in a second application |

	program. *See* claims 19b-c.
[57b] identifying without user intervention or designation the first information; and	Miller identifies structures such as phone numbers and addresses (first information) without user intervention or designation. *See, e.g.*, Fig. 5; 3:61-64 ("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."); 5:19-22 ("FIG. 5 shows a window 510 presenting an exemplary document 210 having data containing recognizable structures, including a phone number, post-office address, e-mail address, and name."). *See also* claim 19c.
[57c] responding to a user selection by performing an operation related to a second information,	*See* claim 19d.
[57d] the second information associated with the first information from the second application program.	*See* claim 19e.

59. The method of claim 57, wherein the first information is a name, and the operation performed is selected from a group consisting of generating an electronic mail, a telex, a facsimile or a letter addressed to the name indicated by the first information.	*See* claim 21.

60. The method of claim 57, wherein the operation performed is entering additional data into a database.	*See* claim 22.

61. The method of claim 60, wherein the additional data is entered by a user.	*See* claim 23.

62. The method of claim 60, wherein the additional data is located within the document.	*See* claim 24.

63. The method of	Miller discloses user selection via activation of a menu. *See,*

43

claim 57 wherein the user selection comprises an activation of a menu.	*e.g.*, Fig. 7; 4:28-31 ("Upon selection of this structure, user interface 240 presents and enables selection of the linked candidate actions using any selection mechanism, such as a conventional pull-down or pop-up menu."); 6:17-25.

72. The method of claim 57, wherein the second information is associated with only part of the identified first information.	Actions can be taken on sub-structures identified, in which case the second information is associated with only part of the identified first information. *See, e.g.*, 4:17-22 ("It will be appreciated that detected structures can be hierarchical, i.e. that a sub-structure can itself be selected and have actions associated with it. For example, a user may be able to select the year portion of an identified date, and select actions specific to the year rather than to the entire date.").

2.   Computer Readable Medium And System Claims

Computer readable medium claims 25, 27-30, 73, and 75-78 are anticipated by Miller. These claims correspond to method claims 19, 21-24, 57, and 59-62. Miller discloses the steps in the body of the computer readable medium claims (as set forth above with respect to the corresponding method claims) and further discloses a computer readable medium including program instructions (*see, e.g.*, Fig. 1 at 170).

System claims 31, 33-35, 79, and 81-84, which include means-plus-function limitations, are also anticipated by Miller. These claims correspond to method claims 19, 21-23, 57, and 59-62. Miller discloses the functions of the means-plus-function limitations (as set forth above with respect to the corresponding method claims). Miller discloses a processor (*see, e.g.*, Fig. 1 at 120) programmed to

perform these functions, and the programmed processor is the same or equivalent structure as that disclosed in the '854 patent (if any structure is disclosed at all).

C.   Ground 6: Obviousness In View Of Miller

Claims 20, 26, 32, 58, 64-69, 74, 80, 85, 96, and 99 are obvious in view of Miller as set forth below. (Menascé Decl. ¶ 130.) With respect to claims 20 and 58, it would have been obvious to a person of ordinary skill in the art that, in drafting a letter, the name and address would be displayed. (*Id.* ¶ 130.) With respect to claims 64(c) (and its dependent claims 65-69) and 85(g), it would have been obvious to a person of skill in the art that drafting the letter would include searching in the address book for an address associated with the identified name (or vice-versa) and inserting it into the letter. (*Id.* ¶ 130.) These would have been simply matters of common sense. *See, e.g., Randall Mfg. v. Rea*, __ F. 3d. __ (Fed. Cir. 2013) (requiring consideration of common sense in an obviousness inquiry). (Menascé Decl. ¶ 131.)

Claim	Miller
20. The method of claim 19 wherein the operation comprises displaying the second information.	Fig. 4 of Miller discloses identifying a name and drafting a letter to the contact with that name, as well as identifying an address and drafting a letter to the contact with that address. *See also* 5:19-22 ("FIG. 5 shows a window 510 presenting an exemplary document 210 having data containing recognizable structures, including a phone number, post-office address, e-mail address, and name."); 2:36-41 ("An action may further include … actions such as returning phone calls, drafting letters, sending facsimile copies and e-mail, and

	the like.").

58. The method of claim 57 wherein the operation comprises displaying the second information.	*See* claim 20.

[64a] 64. The method of claim 63, wherein the step of performing the operation further comprises the steps of:	*See* claim 63.
[64b] initializing the second application program;	The operation performed includes opening another application (*i.e.*, initializing the second application program.). *See, e.g.*, 2:34-36 ("An action may specify opening another application, loading the identified structure into an appropriate field, and closing the application.").
[64c] searching, using the second application program, for the second information associated with the first information; and	Fig. 4 of Miller discloses identifying a name and drafting a letter to the contact with that name, as well as identifying an address and drafting a letter to the contact with that address. *See* Fig. 4. *See also* claim 20.
[64d] retrieving the second information.	The address or name is retrieved and inserted into the letter. *See* claim 64c.

65. The method of claim 64, wherein when the second information associated with first information exists, performing the further step of displaying the second information.	*See* claim 20.

66. The method of claim 65, wherein the first information comprises a name.	*See* claim 21.

[67a] 67. The method of claim 66, wherein the activation of	*See* claim 63.

46

the menu comprises	
[67b] selecting the menu indicator for the menu	A user opens the menu by selecting a highlighted detected structure (*i.e.*, the menu indicator). *See, e.g.*, 4:23-31 ("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. Upon selection of this structure, user interface 240 presents and enables selection of the linked candidate actions using any selection mechanism, such as a conventional pull-down or pop-up menu."); 5:38-40 ("As shown in FIG. 7, upon recognition of a mouse-down operation over a structure, user interface 240 presents a pop-up menu 710."); Fig. 7.
[67c] opening the menu	*See* claim 67b.
[67d] selecting a choice in the menu; and	Selection of an item in a menu inherently includes selecting and activating the selected choice in the menu. *See* claim 67b.
[67e] activating the selected choice in the menu.	*See* claim 67d.

68. The method of claim 67, wherein selection of the menu indicator comprises moving a mouse pointer to the menu indicator.	A user opens the menu by clicking with a mouse on a highlighted detected structure (*i.e.*, the menu indicator), which inherently includes moving the mouse pointer to the menu indicator. *See* claim 67b.

69. The method of claim 68, wherein the opening of a menu comprises clicking on the menu indicator with a mouse button.	*See* claim 68.

[85a] 85. A method for information handling within a document operated on by a first application program, the document containing first information entered by a user, the method comprising the steps of:	Miller discloses a method for information handling within a document operated on by a first application program. *See* claim 19a.

	The document contains first information entered by a user. *See* claim 19b.
[85b] identifying without user intervention or designation the first information that can be utilized in a second application program,	*See* claims 19c and 57b.
[85c] the first information selected from a group consisting of a name and an address; and	*See* claim 21.
[85d] responding to a user selection by performing an operation related to a second information,	*See* claims 19d and 57c.
[85e] the second information associated with all or part of the first information from the second application program,	*See* claims 19e, 57d, and 72.
[85f] wherein the step of responding to the user selection further comprises the steps of: initializing the second application program;	*See* claim 64b.
[85g] searching, using the second application program, for the second information associated with the first information; and	*See* claim 64c.
[85h] if said second information exists, retrieving and displaying the second information;	*See* claim 64d.
[85i] wherein said user selection comprises: selecting a menu indicator for the menu;	*See* claims 63 and 67b.
[85j] opening the menu;	*See* claim 67c.
[85k] selecting a choice in the menu; and	*See* claim 67d.
[85l] activating the selected choice in the menu;	*See* claim 67e.
[85m] wherein selecting the menu indicator comprises moving the mouse pointer to the menu indicator;	*See* claim 68.
[85n] wherein opening the menu comprises clicking on the menu indicator with a mouse button; and	*See* claim 69.
[85o] wherein the second information is associated with at least part of the identified first information.	*See* claims 19e, 57d, 72, and 85e.

Computer readable medium claims 26, 74, and 96 are obvious in view of Miller. (Menascé Decl. ¶ 130.) These claims correspond to method claims 20, 58, and 85. Miller discloses or renders obvious the steps in the body of the computer readable medium claims (as set forth above with respect to the corresponding method claims) and further discloses a computer readable medium including program instructions (*see, e.g.*, Fig. 1 at 170). (*Id.*)

System claims 32, 80, and 99, which include means-plus-function limitations, are also obvious in view of Miller. (*Id.*) These claims correspond to method claims 20, 58, and 85. Miller discloses the functions of the means-plus-function limitations (as set forth above with respect to the corresponding method claims). Miller discloses a processor (*see, e.g.*, Fig. 1 at 120) programmed to perform these functions, and the programmed processor is the same or equivalent structure as that disclosed in the '854 patent (if any structure is disclosed at all).

IX.   GROUND BASED ON LUCIW

A.   Background Of Luciw

Luciw was filed on April 19, 1995 and thus qualifies as prior art under § 102(e) based on the earliest alleged U.S. filing date of the '854 patent. Luciw relates to Apple's pen-based, handheld Newton device developed in the 1990s. It discloses providing user assistance based on information entered into a document, such as a note area created by a notepad application. (2:19-22; 6:24-59.) When

the user handwrites certain information, such as a name, it is automatically recognized and converted to formal font, as shown by "Isaac" in Fig. 2 below. (3:8-10; 10:10-21; 11:43-45.)
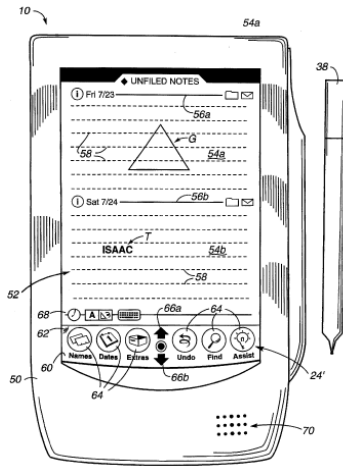
Figure 2

Luciw then presents for user selection a list of persons with the name identified; when the user makes a selection, information associated with the person, such as the person's full name, is inserted into the document. (11:60-12:6.)

B.   Ground 7: Anticipation Based On Luciw

1.   Method Claims

Method claims 19-24, 57-71, and 85 are anticipated by Luciw as set forth below.

Claim	Luciw
[19a] 19. A method for information handling within a document created by a first	Luciw discloses providing user assistance based on information the user enters into a document created by a first application program. *See, e.g.*, 2:19-22. Note areas 54a and 54b are documents created by the notepad application (first application program). *See, e.g.*, 6:24-31

50

application program comprising the steps of:	("Additional note areas, such as a note area 54b, can be formed by the user by drawing a substantially horizontal line across the screen 52 with the stylus 38."); 6:49-59 ("The screen illustrated in FIG. 2 is referred to as the 'notepad', and is preferably an application program running under the operating system of the pen based computer system 10."); Fig. 2.
[19b] entering a first information in the first application program;	The user enters first information, such as a name, in the notepad application. *See, e.g.*, 6:28-31 ("Additional text, graphical, and other data can then be entered into this second note area 54b. For example, the text object T comprising 'ISAAC' has been entered into second note area 54b."); Figs. 2 and 4b.
[19c] marking without user intervention the first information to alert the user that the first information can be utilized in a second application program; and	Luciw discusses entering information into a smart field whether in window 170 as in Fig. 4b or in the notepad application. *See, e.g.*, 8:15-18. Further, an implicit assist can also be indicated by writing in the notepad outside of a smart field. *See, e.g.*, 8:30-41 ("However, implicit assist may be indicated not just by entry of an indication in a smart field … [T]he writing of a particular indication or word on screen 52 outside of a particular smart field may trigger an implicit assist."). As discussed above, once a user enters a first name, the system without user intervention recognizes the name and displays it as a formal font (*i.e.*, marks first information) to alert the user the name can be used for an implicit assist action—for example, to locate additional information in a database (*i.e.*, can be utilized in a second application program). *See, e.g.*, Fig. 2 (showing Isaac in formal font); Figs 4b-4c, 6b, and 10a-10b; 10:6-20; 16:25-50; 17:1-10. Also, Luciw discloses presenting three "Isaacs" for selection by the user. 11:60-12:6; Fig. 6b.
[19d] responding to a user selection by performing an operation related to a second information,	The system in Luciw presents for user selection a list of people with the first name identified. The system then inserts the full name (second information) of the person selected (*i.e.*, performing an operation related to a second information). *See, e.g.*, Figs. 6a-6c; 11:60-12:6 ("Responsive to the recognition of the name ISAAC, the assistance process has produced a list of alternatives by earlier query of the database

	per step 106 in FIG. 3. … The user-selected 'ISAAC ASIMOV' is shown having been marked for selection by a rectangle indicating a highlighting operation. FIG. 6c illustrates the completion of the selection process, with the full name in formal font of ISAAC ASIMOV being presented in the name field 175 of window 170.").
[19e] the second information associated with the first information from the second application program.	The second information (*e.g.*, a person's full name) is associated with the first information (*e.g.*, a person's first name). *See* claim 19d.

20. The method of claim 19 wherein the operation comprises displaying the second information.	Luciw discloses displaying the second information (*e.g.*, inserting the full name). *See* claim 19d.

21. The method of claim 19, wherein the first information is a name, and the operation performed is selected from a group consisting of an electronic mail, a telex, a facsimile or a letter addressed to the name indicated by the first information.	First information in Luciw can be a name (*see* claim 19c) and the operation performed can include faxing and mailing (a letter) addressed to the name indicated. *See, e.g.*, 13:66-14:4 ("FIG. 11c illustrates selected example functions such as scheduling, finding, filing, formatting, mailing, faxing, printing, and calling, just to cite a few of the possibilities.").

22. The method of claim 19, wherein the operation performed is entering additional data into a database.	In claim 19d, the user selects a person from suggestions provided. However, the system in Luciw can automatically make a selection for the user by selecting the last used selection, most frequently used, etc. To do so, it maintains a database of persons and usage information, then updates the database upon user selection. *See, e.g.*, Figs. 5, 7a-7c (and corresponding discussions), 9:6-1512:7-40, 17:7-9 ("A computer system as recited in claim 5 further including means for updating the database to contain information regarding the selected alternative."). Thus, additional data is entered into a database each time a user makes a selection. Further, when a user

	enters a person for the first time, the person must necessarily be added to the database.

23. The method of claim 22, wherein the additional data is entered by a user.	The person added to the database is entered by the user into the document. *See* claim 22.

24. The method of claim 22, wherein the additional data is located within the document.	*See* claims 22 and 23.

[57a] 57. A method for information handling within a document operated on by a first application program, the document containing first information that can be utilized in a second application program the method comprising the steps of:	Luciw discloses information handling within a document operated on by a first application program. *See* claim 19a. The document contains first information that can be utilized in a second application program. *See* claims 19b-c.
[57b] identifying without user intervention or designation the first information; and	Luciw identifies information that can be used for an implicit assist without user intervention. *See* claim 19c.
[57c] responding to a user selection by performing an operation related to a second information,	*See* claim 19d.
[57d] the second information associated with the first information from the second application program.	*See* claim 19e.

58. The method of claim 57 wherein the operation comprises displaying the second information.	*See* claim 20.

59. The method of claim 57, wherein the first information is a name, and the operation performed is selected from a group consisting of generating an electronic mail, a telex, a facsimile or a letter addressed to the name indicated by the first information.	*See* claim 21.

60. The method of claim 57, wherein the operation performed is entering additional data into a database.	*See* claim 22.

61. The method of claim 60, wherein the additional data is entered by a user.	*See* claim 23.

62. The method of claim 60, wherein the additional data is located within the document.	*See* claim 24.

63. The method of claim 57 wherein the user selection comprises an activation of a menu.	Luciw discloses user selection via activation of a menu. *See, e.g.*, 3:14-20 ("FIGS. 6a-6c show respective assist windows in successive stages of an assist process, including first a window containing a first informational level directed at the name ISAAC alone, a second window with a pop-up menu offering a user choice among several known ISAACs, and a third window showing the selection of a particular ISAAC, that is ISAAC ASIMOV, having been accomplished.").

[64a] 64. The method of claim 63, wherein the step of performing the operation further comprises the steps of:	*See* claim 63.
[64b] initializing the second application program;	The system in Luciw uses a second application program, which must necessarily be initialized in order to function. *See* claim 19c.
[64c] searching, using the second application program, for the second information associated with the first information; and	The system in Luciw searches, using a database (the second application program), for other information, *e.g.*, last name, (second information) associated with a first name (first information). *See, e.g.* 10:49-11:39; 11:60-12:6 ("Responsive to the recognition of the name ISAAC, the assistance process has produced a list of alternatives by earlier query of the database per step 106 in FIG. 3."); 12:41-54 ("In the earlier example of FIG. 6c in which it was decided that Isaac Asimov was the desired ISAAC, the phone information in window 170 had not yet been entered. This information may be available and can be accessed according to the process of FIG. 8a. *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,

54

	this data is obtained from the corresponding linked field types as suggested at 203. Then, as suggested at 206, the data obtained is entered into the applicable smart field of the window 170 under operation.") (emphasis added); Figs. 3 and 5.
[64d] retrieving the second information.	The second information is retrieved and displayed. *See* claim 64c.

65. The method of claim 64, wherein when the second information associated with first information exists, performing the further step of displaying the second information.	*See* claim 20.

66. The method of claim 65, wherein the first information comprises a name.	*See* claim 21.

[67a] 67. The method of claim 66, wherein the activation of the menu comprises	*See* claim 63.
[67b] selecting the menu indicator for the menu	Luciw discloses selecting the menu indicator, which opens the menu. *See, e.g.*, 11:50-59 ("Further options can be displayed in a pull-down menu button entitled 'options' at step 183 which can be presented as a help menu. … Significantly, to the left of the name field is a diamond icon 175' which can be invoked to produce a pull-down menu of selection items (not shown) which permit the user to initiate further assistance operations."); 11:50-59; 14:59-67; Figs. 6a-6c, 8b, 12c.
[67c] opening the menu	Luciw discloses opening the menu. *See* claim 67b.
[67d] selecting a choice in the menu; and	Luciw discloses selecting a choice in the menu. *See* claims 63 and 67b-c.
[67e] activating the selected choice in the menu.	Luciw discloses activating the selected choice in the menu. *See* claims 63 and 67b-c.

68. The method of claim 67, wherein selection of the menu	In Luciw, selection of the menu indicator comprises moving a mouse pointer to the menu indicator. *See, e.g.*, 4:14-16 ("The present invention is well suited for pointer based computer systems such as the pen-based, pen-aware and mouse

indicator comprises moving a mouse pointer to the menu indicator.	controlled systems that are currently popular."); 5:44-51 ("While the method of the present invention is described in the context of a pen-based system, other pointing devices such as a computer mouse, a track ball, or a tablet can be used to manipulate a pointer on a screen of a general purpose computer.").

69. The method of claim 68, wherein the opening of a menu comprises clicking on the menu indicator with a mouse button.	In Luciw, opening a menu comprises clicking on the menu indicator with a mouse button. *See* claims 67b and 68.

70. The method of claim 57 wherein at least part of the identifying occurs after the user selection.	Luciw also discloses an "explicit assist" function, where identification of the assist information occurs after the user selects the explicit assist command. *See, e.g.*, 9:16-10:5 ("If an explicit assist has been indicated at step 110, then a step 130 determines, if a particular selection as to the explicit assistance has been made. … If 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.").

71. The method of claim 57 wherein the identifying occurs after the user selection.	*See* claim 70.

[85a] 85. A method for information handling within a document operated on by a first application program, the document containing first information entered by a user, the method comprising the steps of:	Luciw discloses information handling within a document operated on by a first application program. *See* claim 19a. The document contains first information entered by a user. *See* claim 19b.
[85b] identifying without user intervention or designation the first information that can be utilized in a second application program,	*See* claims 19c and 57b.
[85c] the first information selected from a group	*See* claim 21.

consisting of a name and an address; and	
[85d] responding to a user selection by performing an operation related to a second information,	*See* claims 19d and 57c.
[85e] the second information associated with all or part of the first information from the second application program,	*See* claims 19e, 57d, and 72.
[85f] wherein the step of responding to the user selection further comprises the steps of: initializing the second application program;	*See* claim 64b.
[85g] searching, using the second application program, for the second information associated with the first information; and	*See* claim 64c.
[85h] if said second information exists, retrieving and displaying the second information;	*See* claim 64d.
[85i] wherein said user selection comprises: selecting a menu indicator for the menu;	*See* claims 63 and 67b.
[85j] opening the menu;	*See* claim 67c.
[85k] selecting a choice in the menu; and	*See* claim 67d.
[85l] activating the selected choice in the menu;	*See* claim 67e.
[85m] wherein selecting the menu indicator comprises moving the mouse pointer to the menu indicator;	*See* claim 68.
[85n] wherein opening the menu comprises clicking on the menu indicator with a mouse button; and	*See* claim 69.
[85o] wherein the second information is associated with at least part of the identified first information.	*See* claims 19e, 57d, 72, and 85e.

2.   Computer Readable Medium And System Claims

Computer readable medium claims 25-30, 73-78, and 96 are anticipated by

Luciw. These claims correspond to method claims 19-24, 57-62, and 85. Luciw

discloses the steps in the body of the computer readable medium claims (as set

forth above with respect to the corresponding method claims) and further discloses

a computer readable medium including program instructions (*see, e.g.*, Fig. 1 at 22).

System claims 31-35, 79-84, and 99, which include means-plus-function limitations, are also anticipated by Luciw. These claims correspond to method claims 19-23, 57-62, and 85. Luciw discloses the functions of the means-plus-function limitations (as set forth above with respect to the corresponding method claims). Luciw discloses a processor (*see, e.g.*, Fig. 1 at 12) programmed to perform these functions, and the programmed processor is same or equivalent structure as that disclosed in the '854 patent (if any structure is disclosed at all).

X.   CONCLUSION

For the reasons detailed above, there is a reasonable likelihood that Petitioner will prevail as to each of claims 19-35, 57-85, 96, and 99 of the '854 patent. Accordingly, *inter partes* review of claims 19-35, 57-85, 96, and 99 of the '854 patent is respectfully requested.

The USPTO is authorized to charge any required fees, including the fee as set forth in 37 C.F.R. § 42.15(a) and any excess claim fees, to Deposit Account No. **03-1952** referencing Docket No. **106842805100**.

Dated: December 2, 2013   Respectfully submitted,

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Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached Petition for *Inter Partes* Review and supporting materials were served as of the below date by FedEx, which is a means at least as fast and reliable as U.S. Express Mail, on the Patent Owner at the correspondence address indicated for U.S. Patent No. 7,496,854 (*i.e.*, Sunstein Kann Murphy & Timbers LLP, 125 Summer Street, Boston, MA 02110-1618).

Dated: December 2, 2013   /Mehran Arjomand/
                                  Mehran Arjomand
                                  MORRISON & FOERSTER LLP
                                  707 Wilshire Blvd, Suite 6000
                                  Los Angeles, CA 90017-3543

Exhibit 6OO

Patent No. 7,496,854
Petition For *Inter Partes* Review

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

Patent No. 7,496,854
Issue Date: February 24, 2009
Title: METHOD, SYSTEM AND COMPUTER READABLE MEDIUM FOR
ADDRESSING HANDLING FROM A COMPUTER PROGRAM
_____

Inter Partes Review No. _____
_____

PETITION FOR *INTER PARTES* REVIEW

UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. § 42.100 *et seq.*

TABLE OF CONTENTS

Page

TABLE OF CONTENTS
(continued)

Page

ii

Exhibit List for *Inter Partes* Review of U.S. Patent No. 7,496,854

Exhibit Description	Exhibit #
U.S. Patent No. 7,496,854 to Hedloy	*1001*
Declaration of Dr. Daniel A. Menascé	*1002*
Amendment dated January 24, 2008	*1003*
Amendment dated April 18, 2007	*1004*
SIGCHI Bulletin (April 1998) at 51-63	*1005*
U.S. Patent No. 5,577,239 to Moore et al.	*1006*
U.S. Patent No. 6,085,206 to Domini et al.	*1007*
U.S. Patent No. 6,377,965 to Hachamovitch et al.	*1008*
U.S. Patent No. 5,644,735 to Luciw et al.	*1009*
SIGCHI Bulletin (April 1998) at 53-63 (web version)	*1010*

Petitioners Apple Inc., Google Inc., and Motorola Mobility LLC (collectively, "Petitioners") respectfully petition for *inter partes* review of claims 1-18, 36-56, 86-95, 97, 98, 100, and 101 of U.S. Patent No. 7,496,854 ("the '854 patent" (Ex. 1001)) in accordance with 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42.100 *et seq.*

I.   NOTICES AND STATEMENTS

Pursuant to 37 C.F.R. § 42.8(b)(1), Apple Inc. ("Apple") is the real party-in-interest for Petitioner Apple. Google Inc. ("Google") is the real party-in-interest for Petitioner Google. Motorola Mobility LLC ("Motorola Mobility") is the real party-in-interest for Petitioner Motorola Mobility.

Pursuant to 37 C.F.R. § 42.8(b)(2), Petitioners identify the following related matters. On November 29, 2012, the Patent Owner filed suit against Apple and Motorola Mobility, among others, in the U.S. District Court for the District of Delaware alleging infringement of several patents, including the '854 patent. *See 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*, Case No. 1:12-cv-01601-LPS (D. Del.). The Complaint was served on Motorola Mobility on November 30, 2012 and on Apple on December 3, 2012. Thus, this Petition has been filed within one year of Apple and Google (which owns Motorola Mobility) being served a complaint alleging infringement of the '854 patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b).

Pursuant to 37 C.F.R. § 42.8(b)(3), Apple identifies the following counsel

(and a power of attorney accompanies this Petition).

Lead Counsel for Petitioner Apple	Backup Counsel for Petitioner Apple
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Google and Motorola Mobility identify the following counsel (and a power

of attorney accompanies this Petition).

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Pursuant to 37 C.F.R. § 42.8(b)(4), service information for lead and back-up

counsel is provided above.

Pursuant to 37 C.F.R. § 42.104(a), Petitioners certify that the '854 patent is

available for *inter partes* review and that Petitioners are not barred or estopped

from requesting an *inter partes* review challenging the patent claims on the grounds identified in this Petition.

II.   INTRODUCTION

The '854 patent is directed to a method, system, and computer readable medium for name and address handling from a computer program. For example, a user can type a name and address in a document being created with a word processing program. Through the use of a button, the document is searched and the name and address are detected. The detected information is then used with respect to a second application program, such as a database. For example, the user can add the name and address to an address book as a new entry, or edit or add additional address information associated with the name if the name is already in the address book. If the user types only a name into the document and the database has the name and a corresponding address, the user can insert the address for the name into the document being created by the word processing program.

The claims of the '854 patent may be divided into two groups: (1) claims directed to performing an operation, such as updating a database with an address; and (2) claims directed to inserting information into the document, such as an address. This Petition addresses the second set of claims (*i.e.*, claims 1-18, 36-56, 86-95, 97, 98, 100, and 101). A related petition, filed concurrently, addresses the

first set of claims (*i.e.*, claims 19-35, 57-85, 96, and 99). Two other petitions, also filed concurrently, address related U.S. Patents Nos. 7,917,843 and 8,306,993.

Petitioners present herein references (including several originating from Apple) that anticipate or render obvious the challenged claims of this Petition. The references make clear that the purported invention of the challenged claims was well known before the '854 patent. Section III of this Petition summarizes the '854 patent and relevant aspects of its prosecution history. Sections V-IX set forth the detailed grounds for invalidity of the challenged claims. This showing is accompanied by the Declaration of Dr. Daniel A. Menascé ("Menascé Decl.," Ex. 1002.) Accordingly, Petitioners respectfully request a Decision to institute *inter partes* review.

III.   SUMMARY OF THE '854 PATENT

A.   Background Of The '854 Patent

The '854 patent is directed to name and address handling within a document created by a computer program, such as a word processing program. (1:19-27.) One aspect relates to inserting information from a database into a document. This is described in connection with the left side of the flow charts of Figs. 1 and 2 and Examples 1, 5 and 7. Another aspect relates to adding data from a document into a database. This is described in connection with the right side of Figs. 1 and 2 and

Examples 2-4 and 6. Dr. Menascé's Declaration (Ex. 1002) includes highlighted

copies of Fig. 1 corresponding to various examples.

Example 1 relates to inserting an address into the document. Fig. 3 (below)

illustrates a document into which a name 40 has been entered. (5:63-65.) The user

presses a "OneButton" button 42. (6:13-17; Fig. 1 at 2.) A program then analyzes

what the user has typed into the document to detect certain types of information.

(4:25-39; Fig. 1 at 4.)   There is no disclosure as to how this analysis is

accomplished.
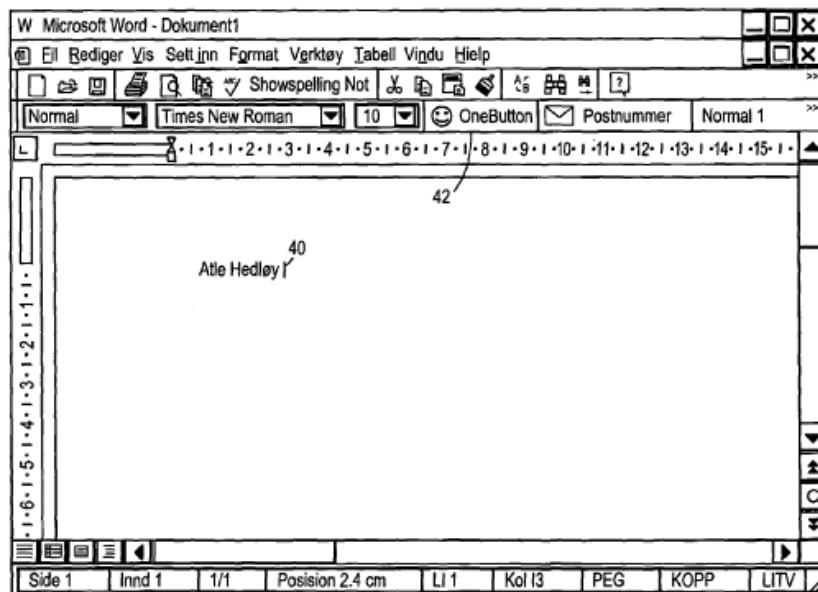
FIG. 3

Upon detection, the name is searched in a database. (5:65-6:3; Fig. 1 at 12.) If the

search returns one matching contact with only one address, the address is inserted

into the document, as shown in Fig. 4. (5:65-6:3; Fig. 1 at 22.) If multiple

matching contacts are found, the user is prompted to select an address for insertion into the document. (7:33-49; Fig. 10; Fig. 1 at 20 and 22.)

B.   Prosecution History Of The '854 Patent

Throughout the prosecution of the '854 patent, Applicant argued that the distinguishable feature over the applied art was marking information or identifying information, such as a name and address in a document, "without user intervention." For example, in an Amendment dated January 24, 2008, at 31 (Ex. 1003), Applicant asserted:

> Thus, Pandit teaches a system where the user must select text prior to the system processing the "a selected text", e.g. col. 5, line 56). Neither the AddressMate program nor Pandit teach the element of "marking without user intervention" or "identifying without user intervention or designation the first information" either alone or in combination.

As set forth below, such marking or identifying information without user intervention was well-known in the art.

IV.   CLAIM CONSTRUCTION

Petitioners provide constructions of a term and the means-plus-function limitations. *See* 37 C.F.R. § 42.104(b)(3). Petitioners note that a claim is given the "broadest reasonable construction in light of the specification" in *inter partes* review. *See* 37 C.F.R. § 42.100(b). Furthermore, a number of claims contain means-plus-function limitations under 35 U.S.C. § 112, ¶ 6 (pre-AIA).

A.   "Marking … The First Information To Alert The User"

The recitation "marking … the first information to alert the user" appears in

numerous independent claims. (*See* Claims 1, 7, 13.) However, neither the term

"marking" nor the full recitation appears in the specification. The '854 patent is a

continuation of application No. 09/189,626 filed on November 10, 1998, and the

"marking" recitation was not added until the application that matured into the '854

patent was filed years later in August 6, 2001. Therefore, the specification gives

no guidance as to the meaning of this recitation. Accordingly, the plain meaning

of the recitation is that the first information is detected without user intervention

and has some form of marking or highlighting applied to it to draw the user's

attention to it. (Menascé Decl. ¶ 49.)

During prosecution, Applicant attempted to provide an expansive reading of

"marking" in order to demonstrate support for the recitation, and asserted that the

program "marks the 'first information' in any of a variety of ways" and "may

display the text (the 'first information') to the user." (Amendment dated April 18,

2007 (Ex. 1004), at 30-31.) The portions of the specification identified relate to

generating another screen, *e.g.*, Fig. 9, and not to any direct marking of the first

information itself (which is already displayed in the document) to provide the

recited alerting function.   Therefore, because the only possible disclosure of

marking to alert in the specification is provision of a separate dialog box, for this

7

proceeding the marking to alert recitation should be construed to encompass both direct marking (*e.g.,* highlighting or a pop-up at the information being marked) and display of the information in a separate dialog box.

B.   Means-Plus-Function Limitations

For means-plus-function limitations, 37 C.F.R. § 42.104(b)(3) requires the petition to identify the structure corresponding to each claimed function. However, a structure that is not actually disclosed in the specification *cannot* be corresponding structure. *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946, 948, 952 (Fed. Cir. 2007).

In IPR2013-00152, the Patent Trial and Appeal Board denied institution of an *inter partes* review because, among other reasons, the means-plus-function limitations were not amenable to construction. Specifically, the Board analyzed the specification and concluded that there was no corresponding structure disclosed in the specification to perform the recited function of various limitations. (Decision (Paper 8 dated August 19, 2013), at 12, 13, 20.) It is submitted that the same situation exists with respect to the claims in this Petition having means-plus-function limitations, *i.e.*, claims 13-18, 50-56, 100, and 101, which are only a subset of the total claims at issue in this Petition.

1.   Independent Claim 13 And Dependent Claims 14-17

Claim 13 includes three limitations, which are all means-plus-function

elements, with the recited functions underlined below.

Limitation/Recited Function	Corresponding Structure
means for <u>entering a first information in the first application program</u>	Keyboard along with its device driver at Fig. 16 and 9:37-39. (Menascé Decl. ¶¶ 51-54.)
means for <u>marking without user intervention the first information to alert the user that the first information can be utilized in a second application program</u>	None. Boxes 4, 6 and 4:25-39 simply show desired results, with no algorithm disclosing what is done. (Menascé Decl. ¶¶ 55-59.)
means for <u>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</u>	No structure disclosed in the specification that corresponds to the claimed function. (Menascé Decl. ¶¶ 60-65.)

Dependent claim 14 includes an additional means plus function limitation,

with the recited functions underlined below.

Limitation/Recited Function	Corresponding Structure

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 [The recited function is "activating a device …"]	No structure disclosed in the specification that corresponds to the claimed function. (Menascé Decl. ¶¶ 66-70.)

Dependent claim 15 includes three additional means plus function limitations, with the recited functions underlined below.

Limitation/Recited Function	**Corresponding Structure**
means for <u>initializing the second application program</u>	None. (Menascé Decl. ¶¶ 71-75.)
means for <u>searching, using the second application program, for the second information associated with the first information</u>	Figs. 1 and 2 (steps 12 or 14) described on 4:43-46 and 5:12-16; Examples 1, 2, 4, 5, and 6 discussed in the specification. (Menascé Decl. ¶¶ 76-80.)
means for <u>retrieving the second information</u>.	Figs. 1 (steps 18 and 20) 2 (steps 26 and 30 or steps 26 and 27 or steps 29, 31, and 30) described on 4: 43-49, 5: 23-53;

	Examples 1 and 5 discussed in the specification. (Menascé Decl. ¶¶ 81-85.)

Dependent claim 16 includes an additional means plus function limitation, with the recited functions underlined below.

Limitation/Recited Function	Corresponding Structure
means for performing the further step of displaying the second information	Figs. 1 and 2 (step 20) described on 4:46-49 and 5:12-16; Example 5 discussed in the specification. (Menascé Decl. ¶¶ 86-88.)

Dependent claim 17 includes an additional means plus function limitation, with the recited functions underlined below.

Limitation/Recited Function	Corresponding Structure
means for completing at least one of the first and second information in the document	No structure disclosed in the specification that corresponds to the claimed function. (Menascé Decl. ¶¶ 89-92.)

11

2.   Independent Claim 50 And Dependent Claims 51-55

Claim 50 includes two means-plus-function limitations, with the recited

functions underlined below.

Limitation/Recited Function	Corresponding Structure
means for <u>identifying without user intervention or designation the first information</u>	None. Boxes 4, 6 and 4:25-39 simply show desired results, with no algorithm disclosing what is done. (Menascé Decl. ¶¶ 93-97.)
means for <u>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</u>	No structure disclosed in the specification that corresponds to the claimed function. (Menascé Decl. ¶ 98.)

The analysis for claim 51 is the same as dependent claim 14. The analysis

for claim 52 is the same as dependent claim 15.

Claim 53 includes an additional means-plus-function limitation, with the

recited functions underlined below.

Limitation/Recited Function	Corresponding Structure
means for <u>adding the second</u>	No structure disclosed in the

<u>information to the first information in</u> <u>the document</u>	specification that corresponds to the claimed function. (Menascé Decl. ¶¶ 103-108.)

The analysis for claim 54 is the same as dependent claim 16. (Menascé

Decl. ¶ 110.)   The analysis for claim 55 is the same as dependent claim 17.

(Menascé Decl. ¶ 112.)

3.   Independent Claim 100

Independent claim 100 includes three means-plus-function limitations, with

the recited functions underlined below.

Limitation/Recited Function	Corresponding Structure
(1) means for <u>using a first computer</u> <u>program to analyze the document,</u> <u>without direction from the operator, to</u> <u>identify the name</u>	No structure disclosed in the specification that corresponds to the claimed function. (Menascé Decl. ¶¶ 113-117.)
(2) means for <u>using the identified name</u> <u>and a second computer program to</u> <u>search the database and to locate contact</u> <u>related information associated with the</u> <u>name</u>	Figs. 1 and 2 (step 12) described on 4:43-46 and 5:12-16; Examples 1 and 5 discussed in the specification. (Menascé Decl. ¶¶ 118-122.)

| (3) means for <u>inserting the contact related information into the document</u> | No structure disclosed in the specification that corresponds to the claimed function. (Menascé Decl. ¶¶ 123-128.) |

4.   Independent Claim 101

Independent claim 101 includes five means-plus-function limitations, with the recited functions underlined below.

Limitation/Recited Function	Corresponding Structure
(1) means for <u>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</u>	No structure disclosed in the specification that corresponds to the claimed function. (Menascé Decl. ¶¶ 129-133.)
(2) means for <u>using a second computer program and the text identified in (1) to search the database and to locate related information</u>	Figs. 1 and 2 (step 12) described on 4:43-46 and 5:12-16; Examples 1 and 5 discussed in the specification. (Menascé Decl. ¶¶ 134-138.)

(3) means for <u>inserting the information located in (2) into the document</u>	No structure disclosed in the specification that corresponds to the claimed function. (Menascé Decl. ¶¶ 139-144.)

C.   Remaining Claim Terms

Petitioners submit that the remaining claim terms should be accorded their ordinary and customary meaning as understood by one of ordinary skill in the art.

V.   IDENTIFICATION OF CHALLENGE

Pursuant to 37 C.F.R. § 42.104(b), Petitioners respectfully request the cancellation of claims 1-18, 36-56, 86-95, 97, 98, 100, and 101 of the '854 patent based on the following references.

Reference	Designated Name/Exhibit No.
SIGCHI Bulletin (April 1998) at 51-63	LiveDoc/Drop Zones (Ex. 1005)
U.S. Patent No. 5,577,239 to Moore et al.	Moore (Ex. 1006)
U.S. Patent No. 6,085,206 to Domini et al.	Domini (Ex. 1007)
U.S. Patent No. 6,377,965 to Hachamovitch et al.	Hachamovitch (Ex. 1008)
U.S. Patent No. 5,644,735 to Luciw et al.	Luciw (Ex. 1009)

The statutory grounds for the challenge of each claim are set forth below. All the statutory citations are pre-AIA.

Ground	35 USC	Claims	References
1	102(a)	1-18, 36-56, 93-95, 98, and 101	LiveDoc/Drop Zones
2	103(a)	1-18, 36-56, 93-95, 98, and 101	LiveDoc/Drop Zones
3	103(a)	1-18, 36-56, 93-95, 98, and 101	LiveDoc/Drop Zones and Moore
4	102(e)	1-18, 36-38, 40-45, 49-52, 54-56, 93, 98, and 101	Domini
5	102(e)	1-18, 36-56, 86, 87, 89, 93, 97, 98, 100, and 101	Hachamovitch
6	103(a)	3-5, 9-11, 15-17, 38-41, 45-48, 53, 88, 90, and 91	Hachamovitch
7	102(e)	1-18, 36-56, 86-88, 90, 92-94, 97, 98, 100, and 101	Luciw
8	103(a)	3-5, 9-11, 15-17, 38-41, 45-48, 53, 87, 89, 91, and 95	Luciw

Below is a discussion of why the challenged claims of the '854 patent are unpatentable under the statutory grounds raised, including claim charts specifying where each element of a challenged claim is met by the prior art. 37 C.F.R. § 42.104(b)(4). The showing in these sections establishes a reasonable likelihood of prevailing as to each ground of invalidity with respect to the challenged claims

16

as to that ground. This showing is accompanied by the Declaration of Dr. Daniel A. Menascé (Ex. 1002), as noted above.

VI.   GROUNDS BASED ON LIVEDOC/DROP ZONES

A.   Background Of LiveDoc/Drop Zones

The April 1998 issue of SIGCHI Bulletin was dedicated to Apple's Advanced Technology Group. The Bulletin included an introduction section and two articles, by James Miller and Thomas Bonura, describing an Apple technology that allowed documents to reveal structures for identification and action. The articles are entitled "From Documents to Object: An Overview of LiveDoc" and "Drop Zones: An Extension of LiveDoc" and are sequential in the SIGCHI Bulletin from pages 53-63 (collectively, "LiveDoc/Drop Zones"). LiveDoc/Drop Zones thus qualifies as prior art under § 102(a) based on the earliest alleged U.S. filing date of the '854 patent.

LiveDoc/Drop Zones discloses creating a document and entering information into the document using a text entry application program, such as shown in Fig. 2 of LiveDoc below.[1] (LiveDoc at 53-55.)

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[1] Fig. 2 is from a website posting (Ex. 1010) of LiveDoc and is identical in content to the LiveDoc publication accompanying this Petition.

17

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.

Without user intervention, LiveDoc's "structure detection" process runs in the background and highlights information in the document that can be used to perform a related action. (LiveDoc at 54-55.) Selecting a highlighted structure displays a menu of actions that can be performed. (*Id.*) As just one example, LiveDoc can identify a molecular formula in a document and provide an action that presents a three-dimensional rendering of the molecule in the document itself. (LiveDoc at 57-58.) This would be achieved through searching a database containing the three-dimensional rendering based on the molecular formula identified in the document.

18

B.   Ground 1: Anticipation By LiveDoc/Drop Zones

1.   Method Claims

Method claims 1-6, 36-42, and 93-95 are anticipated by LiveDoc/Drop

Zones as set forth below.

Claim	LiveDoc/Drop Zones
[1a] 1. A method for information handling within a document created using a first application program comprising the steps of:	LiveDoc discloses a document created using a first application program (*e.g.*, a document as shown in Fig. 2 created using a text entry application program). *See also* LiveDoc at 53 ("There is a real opportunity to advance the computing field here, by bringing these two worlds together: by enabling an ordinary document, built with any application, to automatically offer users access to some of the meaningful bits of its content, and by helping users carry out appropriate actions on these objects."); at 55 ("[W]e decided to modify a simply text editor application, SimpleText, to be a LiveDoc client."). Drop Zones uses the same program. *See*, *e.g.*, at 60 (referring to a "LiveDoc enabled word processor, *LiveSimpleText*").
[1b] entering a first information in the first application program;	A document including first information, such as a molecular formula, is entered in the first application program such as a word processor. LiveDoc at 58 ("Imagine a detector that finds the formula of an organic molecule *in a document*, and an action that presents a three-dimensional rendering of that molecule within the context of the document itself, rather than in a separate application.") (emphasis added). *See also* Fig. 2 of LiveDoc and Fig. 2 in Drop Zones. Word processor is *LiveSimpleText.*
[1c] marking without user intervention the first information to alert the user that the first information can	In LiveDoc, the first information, such as a molecular formula, is marked without user intervention to alert the user that the first information can be utilized in a second

19

be utilized in a second application program; and	application program, such as a database application to retrieve a rendering of the molecule. *Marking and alerting* – LiveDoc at 58 ("Imagine a detector that finds the formula of an organic molecule in a document, and an action that presents a three-dimensional rendering of that molecule within the context of the document itself, rather than in a separate application."); *see also* LiveDoc at 55 ("In LiveDoc, the structure detection process is run in the background on the visible document's text, whenever that document is presented or updated. The results of LiveDoc's analysis are then presented by visually highlighting the discovered structures with a patch of color around the structure. … Pointing at a highlight and pressing the mouse button then displays the menu of actions that can be applied to the structure, as shown in Fig 2."); at 55 ("Experientially, the design of LiveDoc draws on the Web in obvious ways: certain meaningful parts of a document are highlighted, and clicking on them causes certain actions to occur."). *Second application program* – LiveDoc discloses obtaining a rendering of a molecule for a formula identified in a document. *See, e.g.*, LiveDoc at 58 ("Imagine a detector that finds the formula of an organic molecule in a document, and an action that presents a three-dimensional rendering of that molecule within the context of the document itself, rather than in a separate application."). LiveDoc's discussion of a rendering of the molecule discloses a database program application containing the rendering. This database program application is a second application.
[1d] responding to a user selection by inserting a second	The rendering of the molecule associated with the identified molecular formula is "presented within

information into the document,	the context of the document" (*i.e.*, inserted into the document) based on user "action." *See, e.g.*, LiveDoc at 58 ("Imagine a detector that finds the formula of an organic molecule in a document, and *an action that presents a three-dimensional rendering of that molecule within the context of the document itself*, rather than in a separate application.") (emphasis added).
[1e] the second information associated with the first information from a second application program.	The rendering of the molecule (second information) is associated with the identified molecular formula (first information). *See* claim 1d.

2. The method of claim 1 wherein the user selection further comprises 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.	LiveDoc discloses user selection via activation of a menu. *See, e.g.*, LiveDoc at 55 ("Pointing at a highlight and pressing the mouse button then displays the menu of actions that can be applied to the structure, as shown in Fig 2."); at 58 ("Imagine a detector that finds the formula of an organic molecule in a document, and *an action* that presents a three-dimensional rendering of that molecule within the context of the document itself, rather than in a separate application.") (emphasis added).

[3a] 3. The method of claim 1, wherein the step of inserting the second information into the document further comprises the steps of:	*See* claim 1.
[3b] initializing the second application program;	The second application program must necessarily be initialized in order to function.
[3c] searching, using the second application program, for the second information associated with the first information; and	Searching must necessarily be done in the database application program containing the rendering linked to the molecular formula identified in the document. *See* claims 1c-d.
[3d] retrieving the second information.	The rendering is retrieved as a result of the search. *See* claims 1c-d.

4. The method of claim 3, wherein when the second application program includes second information associated with the first information, performing the further step of displaying the second information.	The first application program displays the rendering for the user. *See also* claims 1b and 1d.

5. The method of claim 4, further comprising the step of completing at least one of the first and second information in the document.	The second information is completed by inserting a rendering of the molecule into the document corresponding to the entered molecular formula. *See* claim 1d.

6. The method of claim 1, wherein the first information comprises a name.	A molecular formula is a type of name for a molecule as it identifies the molecule.

[36a] 36. A method for information handling within a document operated on by a first application program, the document containing first information that can be utilized in a second application program, the method comprising the steps of:	LiveDoc discloses a method for information handling within a document operated on by a first application program. *See* claim 1a. The document contains first information that can be utilized in a second application program. *See* claims 1b-c.
[36b] identifying without user intervention or designation the first information; and	LiveDoc identifies the first information without user intervention or designation. *See, e.g.*, LiveDoc at 55 ("In LiveDoc, the structure detection process is run in the background on the visible document's text, whenever that document is presented or updated.") and ("LiveDoc's use of background processing and automatic highlighting of discovered structures offers other advantages. Structures relevant to the user are

22

	automatically presented to the user while a document is in LiveDoc mode; interesting structures need not be searched for and highlighted manually."). *See also* claim 1c.
[36c] responding to a user selection by inserting a second information into the document,	*See* claim 1d.
[36d] the second information associated with the first information from a second application program.	*See* claim 1e.

37. The method of claim 36, wherein the user selection further comprises 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.	*See* claim 2.

[38a] 38. The method of claim 36, wherein the step of inserting the second information into the document further comprises the steps of:	*See* claim 3a.
[38b] initializing the second application program;	*See* claim 3b.
[38c] searching, using the second application program, for the second information associated with the first information; and	*See* claim 3c.
[38d] retrieving the second information.	*See* claim 3d.

39. The method of claim 38	The rendering of the molecule corresponding to

wherein the step of inserting the second information into the document further comprises adding the second information to the first information in the document.	the formula is added to the document. *See, e.g.*, LiveDoc at 58 ("Imagine a detector that finds the formula of an organic molecule in a document, and an action that presents a three-dimensional rendering of that molecule within the context of the document itself, rather than in a separate application.").

40. The method of claim 38, wherein when the second application program includes second information associated with the first information, performing the further step of displaying the second information.	*See* claim 4.

41. The method of claim 38, further comprising the step of completing at least one of the first and second information in the document.	*See* claim 5.

42. The method of claim 36, wherein the first information comprises a name.	*See* claim 6.

[93a] 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:	LiveDoc discloses a method for assisting a user to retrieve information that is related to text in a document; for example, retrieving a rendering of a molecule associated with a molecular formula identified in a document. *See* claim 1.
[93b] (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	LiveDoc (first computer program) analyzes the document, without direction from the operator, to identify text that can be used to search for related information, such as a molecular formula. *See* claims 1c and 36b.

related information,	
[93c] (2) using a second computer program and the text identified in step (1) to search the database and to locate related information, and	Using a second computer program and the formula identified in the document, LiveDoc retrieves a rendering for the molecule. *See* claims 1c, 1d and 3c.
[93d] (3) inserting the information located in step (2) into the document.	The rendering of the molecule is inserted into the document. *See* claims 1d and 36c.

94. The method according to claim 93 wherein at least steps (2)-(3) take place following entry a single execute command.	LiveDoc searches for and inserts the rendering of the molecule following the user's selection of the action from a menu (*i.e.*, a single execute command). *See* claims 1d and 2.

95. The method according to claim 94 wherein the execute command is a selection from a menu.	*See* claim 2.

2.   Computer Readable Medium And System Claims

Computer readable medium claims 7-12, 43-49, and 98 are anticipated by LiveDoc/Drop Zones. These claims correspond to method claims 1-6, 36-42, and 93. LiveDoc/Drop Zones discloses the steps in the body of the computer readable medium claims (as set forth above with respect to the corresponding method claims) and further discloses a computer readable medium including program instructions (*see*, *e.g.*, LiveDoc at 57 (referring to processors); Fig. 2 (illustrating a screen from an Apple computer)).

System claims 13-18, 50-56, and 101, which include means-plus-function limitations, are also anticipated by LiveDoc/Drop Zones. These claims correspond

to method claims 1-6, 36-42, and 93. LiveDoc/Drop Zones discloses the functions

of the means-plus-function limitations (as set forth above with respect to the

corresponding method claims). LiveDoc/Drop Zones discloses a processor (*see*,

e.g., LiveDoc at 57) programmed to perform these functions, and the programmed

processor is the same or equivalent structure as that disclosed in the '854 patent (if

any structure is disclosed at all).

C.   Ground 2: Obviousness based on LiveDoc/Drop Zones

Claims 1-18, 36-56, 93-95, 98, and 101 are additionally obvious in view of

LiveDoc/Drop Zones. (Menascé Decl. ¶ 151.) As noted above, LiveDoc discloses

inserting second information, such as a molecule rendering, into the document

itself. Drop Zones discloses that a name in a document can be detected and, based

upon the detected name, a person's information may be added to an address book.

See, e.g., Drop Zones at 60 ("Add this person to my address book."). In view of

LiveDoc's disclosure that information related to detected information can be added

into the document, it would have been obvious to one of ordinary skill in the art

that information already contained in an address book, such as an address

corresponding to a detected name, could be added to the document. (*Id*. ¶ 151.)

Such would simply be another obvious operation of entering related information

into the document, as names and addresses are commonly entered together in

documents such as letters. (*Id*.)

Furthermore, claims 3, 9, 15, 38, 45 and 53 and any respective dependent claims recite initializing the second application program and searching using the second application program for the second information. These steps would have been obvious in view of LiveDoc and Drop Zones. (Menascé Decl. ¶ 152.) As a matter of common sense, it would have been obvious for the address book application, for example, to be initialized in order to run and search for the name, so as to allow a user to enter a person's information as to the detected name. (*Id.*)

D. Ground 3: Obviousness In View Of LiveDoc/Drop Zones And Moore

Claims 1-18, 36-56, 93-95, 98, and 101 are additionally obvious in view of LiveDoc/Drop Zones and Moore. Moore issued on November 19, 1996 and thus qualifies as prior art under § 102(b) based on the earliest alleged U.S. filing date of the '854 patent. As discussed in Ground 1, LiveDoc can identify a molecular formula in a document and provide an action that presents a rendering of the molecule in the document itself. (LiveDoc at 57-58.) LiveDoc's discussion of a rendering of the molecule discloses searching a database containing the rendering based on the molecular formula identified in the document.

Furthermore, it was known to have chemical databases searchable by chemical name or molecular formula. (Menascé Decl. ¶ 154.) For example, Moore discloses an exemplary chemical structure storage, searching, and retrieval system and that can be "adapted to numerous types of technology." (Title;

27

Abstract; 2:16-30.) The system employs a relational database application that can search a database based upon chemical name or molecular formula and display a corresponding image. (Moore at 2:43-54; Fig. 10.) Thus, it would have been obvious to employ Moore's database application (as the second application program or computer program in independent claims 1, 7, 13, 36, 43, 50, 93, 98 and 101) to implement LiveDoc's action of inserting a rendering of a molecule in the document. Moore's application would be able to obtain the rendering from its database based on the identified chemical name or molecular formula. This would be a simple combination of prior art elements according to known methods to yield predictable results. (Menascé Decl. ¶ 154.) It should be emphasized that LiveDoc's disclosure is not in any way limited to inserting chemical content from a chemical database in a document. This is just one example provided by LiveDoc.

VII.   GROUND BASED ON DOMINI

A.   Background Of Domini

Domini was filed on June 20, 1996 and thus qualifies as prior art under § 102(e) based on the earliest alleged U.S. filing date of the '854 patent. Domini discloses identifying and correcting spelling errors in a document created by a word processing program. (Abstract; 4:65-5:11.) The user selects the "spelling and grammar" command to initialize the spell check program. (16:13-16.) Without user intervention, the spell check program identifies misspelled words and

28

presents them in red, bold typeface. (17:27-33; 4:12-16.) The spell check program

also displays a list of suggested corrections, as shown in Fig. 3 below. (1:42-44;

12:1-5.) When the user selects the "Change" button 340, the suggested correction

selected by the user is inserted into the document. (12:61-64.)

FIG.3

B.   Ground 4: Anticipation Based On Domini

1.   Method Claims

Method claims 1-6, 36-38, 40-42, and 93 are anticipated by Domini as set

forth below.

Claim	Domini
[1a] 1. A method for information handling within a document created using a first application program comprising the steps of:	Domini discloses a method for identifying and correcting spelling errors within a document created by a word processor program (first application program). *See, e.g.*, Abstract ("In an electronic word processing system environment, a system and method for verifying the accuracy of the grammatical composition of a sentence and the spelling of words within the sentence in an

29

	electronic document.").
[1b] entering a first information in the first application program;	A user enters words and sentences (first information) into the word processor (first application program). *See, e.g.*, 5:1-7 ("The preferred embodiment of the present invention is represented by 'WORD', version 8.0, which is a word processing application program … Briefly described, the preferred program allows users to create and edit electronic documents by entering characters, symbols, graphical objects, and commands.").
[1c] marking without user intervention the first information to alert the user that the first information can be utilized in a second application program; and	Without user intervention (*see*, *e.g.*, 3:31-41), the spell check program identifies a potentially misspelled word and marks it by presenting the word in red, bold typeface to alert the user the word can be utilized in the database, *i.e.*, dictionary, of the spell check program.

Marking to alert – 4:12-16 ("It is determined whether any of the words in the sentence are misspelled and an indication, such as presenting the misspelled word in red, bold typeface, is provided for any misspelled words."); Fig. 3; 11:55-60 (blinking cursor).

Second application program – Fig. 1 identifies word processing program 37A and spell checker program 37B, which includes one or dictionaries, as different application programs. *See e.g.*, Fig. 1; 7:41-51 ("The application programs 37 may include a number of different programs such as a word processing program 37a, a spell checker program 37b, and a grammar checker program 37c."); 16:66-17:57 (standard and custom dictionaries); 7:41-51; 1:56-61. |
| [1d] responding to a user selection by inserting a second information into the document, | The user can select a suggested correction, which is then inserted into the document.

Second information – Second information is a list of suggested corrections for an identified |

30

	misspelled word. 12:1-5 ("Still referring to FIG. 3, the combined spelling and grammar dialog box 300 includes a suggestion list box 317. The suggestion list box 317 includes a plurality of suggestions 320 to replace the possible spelling error in the sentence 307."). *Inserting second information* – Figs. 3, 5, and 7; 12:61-64 ("If the user selects the Change button 340, the misspelled word 315 will be replaced with the word that has been selected by the user from the suggestions 320 in the suggestion list box 317.").
[1e] the second information associated with the first information from a second application program.	Each suggested correction (second information) for a misspelled word is associated with the misspelled word (first information).

2. The method of claim 1 wherein the user selection further comprises 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.	The user selects the "Change" button. *See, e.g.*, Fig. 3; 12:61-64 ("If the user selects the Change button 340, the misspelled word 315 will be replaced with the word that has been selected by the user from the suggestions 320 in the suggestion list box 317."); 18:21-24.

[3a] 3. The method of claim 1, wherein the step of inserting the second information into the document further comprises the steps of:	*See* claim 1.
[3b] initializing the second application program;	The spell check program having one or more dictionaries is called and initiated. *See, e.g.*, 16:56-57 ("Referring to FIG. 7, the spell checker program module is called at step 705 and a spell checking session is initiated.").
[3c] searching, using the	The spell check program having one or more

second application program, for the second information associated with the first information; and	dictionaries (second application program) provides suggested corrections for a misspelled word (first information). The spell check program searches the dictionary database for the suggested corrections. *See, e.g.*, 16:66-17:57 (standard and custom dictionaries); 18:4-9 ("[T]he preferred application program consults another part of the SRB [Spell Return Buffer] to locate a string buffer containing suggestions from the spell checker program module at step 735. The suggestions are the information that is displayed in the suggestion list box 317 as shown in Fig. 3.").
[3d] retrieving the second information.	The suggested corrections are retrieved from the spell check program and displayed for the user. *See* claim 3c.

4. The method of claim 3, wherein when the second application program includes second information associated with the first information, performing the further step of displaying the second information.	The spell check program searches the dictionary database for the suggested corrections (second information) associated with the misspelled word (first information) and displays the suggestions for the user. *See, e.g.*, 18:7-9 ("The suggestions are the information that is displayed in the suggestions list box 317 as shown in FIG. 3."). *See also* claims 1d and 3c.

5. The method of claim 4, further comprising the step of completing at least one of the first and second information in the document.	When a user selects the "Change" button, the misspelled word is replaced by a suggested correction (*i.e.*, the misspelled word is completed accurately). *See* claim 1d.

6. The method of claim 1, wherein the first information comprises a name.	The misspelled word can be a name. 11:36-40 ("[T]hose skilled in the art will understand that some words, such as proper names, may not be recognized by the spell checker program module and may be flagged as spelling errors even though they are correctly spelled.").

[36a] 36. A method for information handling within a document operated on by a first application program, the document containing first information that can be utilized in a second application program, the method comprising the steps of:	Domini discloses information handling within a document operated on by a first application program. *See* claim 1a. The document contains first information that can be utilized in a second application program. *See* claims 1b-c.
[36b] identifying without user intervention or designation the first information; and	Without user intervention, the spell check program detects words and identifies a potentially misspelled word in the document (first information). *See, e.g.*, 17:27-33 ("As is well-known in the art, a spell checker program module checks the spelling of a word by comparing the word to the list of words in the standard dictionary and custom dictionaries. If the word does not correspond to one of the words in the standard dictionary or custom dictionaries, then the spell checker program module flags the word as a word that is possibly misspelled."); Figs. 3, 5 and 7. *See also* claim 1c.
[36c] responding to a user selection by inserting a second information into the document,	*See* claim 1d.
[36d] the second information associated with the first information from a second application program.	*See* claim 1e.

37. The method of claim 36, wherein the user selection further comprises an activation of a device selected from a group consisting of a touch screen, a keyboard button, a screen button, an icon, a	*See* claim 2.

menu, and a voice command device.	

[38a] 38. The method of claim 36, wherein the step of inserting the second information into the document further comprises the steps of:	*See* claim 3a.
[38b] initializing the second application program;	*See* claim 3b.
[38c] searching, using the second application program, for the second information associated with the first information; and	*See* claim 3c.
[38d] retrieving the second information.	*See* claim 3d.

40. The method of claim 38, wherein when the second application program includes second information associated with the first information, performing the further step of displaying the second information.	*See* claim 4.

41. The method of claim 38, further comprising the step of completing at least one of the first and second information in the document.	*See* claim 5.

42. The method of claim 36, wherein the first information comprises a name.	*See* claim 6.

[93a] 93. A method for assisting a computer operator	Domini discloses a method for assisting a user to retrieve suggested corrections from a database for

to retrieve information from a database that is related to text in a document, the method comprising the steps of:	misspelled words in a document. *See* claim 1.
[93b] (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,	The spell check program includes a first computer program to analyze the document, without direction from the operator, to locate potentially misspelled words. *See* claims 1c and 36b.
[93c] (2) using a second computer program and the text identified in step (1) to search the database and to locate related information, and	Using the misspelled word identified, the spell check program searches a dictionary (*i.e.*, database) to search for suggested corrections. *See* claims 1d and 3c.
[93d] (3) inserting the information located in step (2) into the document.	When the user selects the "Change" button the selected suggested correction is inserted into the document. *See* claim 1d.

2.   Computer Readable Medium And System Claims

Computer readable medium claims 7-12, 43-45, 49, and 98 are anticipated by Domini. These claims correspond to method claims 1-6, 36-38, 42, and 93. Domini discloses the steps in the body of the computer readable medium claims (as set forth above with respect to the corresponding method claims) and further discloses a computer readable medium including program instructions (*see*, *e.g.*, Fig. 1 at 15).

System claims 13-18, 50-52, 54-56, and 101, which include means-plus-function limitations, are also anticipated by Domini. These claims correspond to method claims 1-6, 36-38, 40-42, and 93. Domini discloses the functions of the

35

means-plus-function limitations (as set forth above with respect to the corresponding method claims). Domini discloses a processor (*see*, *e.g.*, Fig. 1 at 14) programmed to perform these functions, and the programmed processor is the same or equivalent structure as that disclosed in the '854 patent (if any structure is disclosed at all).

VIII. GROUNDS BASED ON HACHAMOVITCH

A.   Background Of Hachamovitch

Hachamovitch was filed on November 7, 1997 and thus qualifies as prior art under § 102(e) based on the earliest alleged U.S. filing date of the '854 patent. Hachamovitch discloses an auto-complete program that identifies a user's text entry and suggests a completion entry. (4:10-20.) When the user enters text into a document, such as a word processing document, the system identifies the partial entry and displays an associated auto-complete suggestion name directly above the partial entry, as shown in Fig. 2B below. (*See also* Figs. 2A-2C; 10:31-37.)

FIG. 2B
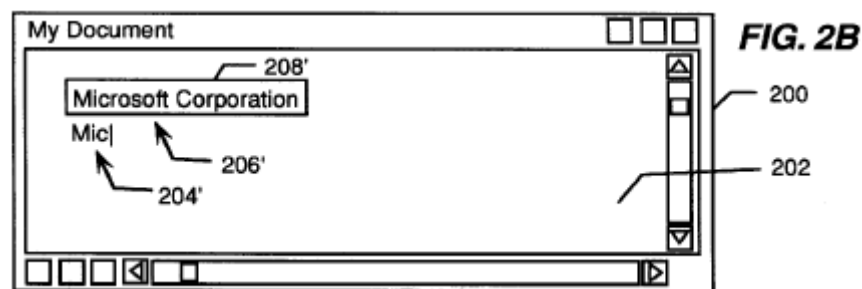
The user can select the suggestion and insert it into the document by pressing a suggestion acceptance key, such as the "tab" key. (7:4-5; 5:7-10.) The suggestion

entry name can be related to additional contact information, such as an address,

associated with a name entered into the document. For example, the name

"Microsoft Corporation" can have completion information associated with it that

includes both the name and address of Microsoft Corporation, as shown in Fig. 3.

(7:18-61.) An address book may be used as a suggestion list.

B.   Ground 5: Anticipation Based On Hachamovitch

1.   Method Claims

Method claims 1-6, 36-42, 86, 87, 89, and 93 are anticipated by

Hachamovitch as set forth below.

Claim	Hachamovitch
[1a] 1. A method for information handling within a document created using a first application program comprising the steps of:	Hachamovitch discloses a system that provides auto-complete suggestions for partial entry in a document created using a first application program, such as a word processor. *See, e.g.*, 4:10-13 ("The present invention is a word completion system that can automatically predict unrestricted word completions for data entries in an unstructured portion of a data file, such as the body of a word processing document or email message.").
[1b] entering a first information in the first application program;	The user enters text, such as a name, into the word processing document. *See, e.g.*, Figs. 2A-2C; 10:21-24 ("The graphical user interface 200 includes an unstructured area 202 into which the user may enter free text using the keyboard 40 or another suitable text entry device.").
[1c] marking without user intervention the first information to alert the user that the first information can be utilized in a second	Without user intervention, text entered by the user is identified as a partial data entry, and a completion suggestion is displayed directly above the partial data entry (*i.e.*, marked) to alert the user that the auto-complete program can retrieve

37

application program; and	and insert associated text.
	Marking and alerting – See, e.g., Figs. 2A-2C; 10:31-37 ("The host application program causes the partial data entry to be displayed in the usual manner, and the Auto-Complete utility 100 causes a completion suggestion 206 to be displayed in association with the partial data entry in a non-disruptive word completion field, such as a pop-up word completion frame 208 that appears directly above the partial data entry.").
	Second application program – The auto-complete program is a stand-alone application that searches using a suggestion list database, such as an e-mail address book (second application program), for suggested corrections. *See, e.g.*, 7:65-8:5 ("[T]he word completion system may be deployed within an operating system or as a stand-alone utility that may operate on an application-independent basis."); 7:18-61 (" … For example, an e-mail address book may be used as the suggestion list when a user is typing within a structured address frame of an e-mail user interface. …"); 4:60-5:6; 11:30-65.
[1d] responding to a user selection by inserting a second information into the document,	When a completion suggestion is displayed, if the user presses an acceptance key, such as the "tab" key, the suggestion entry (second information) is inserted into the document. *See, e.g.*, 7:4-5; 5:7-10 ("The word completion utility may then receive a command indicating acceptance of the completion entry. In response, the word completion utility replaces the partial data entry with the completion entry in the data file.").
	For example, in Fig. 2B the user enters "Mic"; acceptance of the completion suggestion causes the full name and address of Microsoft Corporation, as seen in Fig. 3, to be inserted into the document. *See, e.g.*, 11:36-50.

[1e] the second information associated with the first information from a second application program.	The completion information such as the address (second information) is associated with the name information (first information) used to locate and retrieve the suggestion entry from the database. *See* claim 1d.

2. The method of claim 1 wherein the user selection further comprises 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.	The user selects the suggestion entry by hitting a data acceptance keyboard button, such as the "tab" key. *See, e.g.*, 11:48-50 ("The user may then accept the completion suggestion by entering a familiar data acceptance keystroke, such as the 'tab' key or the 'enter' key.").

[3a] 3. The method of claim 1, wherein the step of inserting the second information into the document further comprises the steps of:	*See* claim 1.
[3b] initializing the second application program;	The auto-complete program must necessarily be initialized in order to run.
[3c] searching, using the second application program, for the second information associated with the first information; and	The auto-complete program searches using a suggestion list database (second application program) for completion suggestions associated with a name entry. *See, e.g.*, 10:38-42 ("As discussed in more detail with reference to FIG. 3 below, the word completion suggestion 206 is identified by comparing the partial data entry 204 to the name entries in a suggestion list that includes a group of name-completion pairs."); 7:18-61 (" … For example, an e-mail address book may be used as the suggestion list when a user is typing within a structured address frame of an e-mail user interface. …"); 4:60-5:6; 11:30-65.
[3d] retrieving the second information.	The suggestion must be retrieved to be displayed for the user and inserted into the document. *See* claims 1d and 3c.

39

4. The method of claim 3, wherein when the second application program includes second information associated with the first information, performing the further step of displaying the second information.	The auto-complete program searches the suggestion list database for suggested completions (second information) associated with the partial data entry (first information) and displays the suggestions for the user. *See* claims 1c-1d and 3d.

5. The method of claim 4, further comprising the step of completing at least one of the first and second information in the document.	When the user accepts a suggested entry, the name data entry (first information) is completed with the suggested entry (second information). *See* claim 1d.

6. The method of claim 1, wherein the first information comprises a name.	The partial data entry (first information) can be a name. For example, the company name "Microsoft Corporation" in Figs. 2B and 3. *See also* claim 1d.

[36a] 36. A method for information handling within a document operated on by a first application program, the document containing first information that can be utilized in a second application program, the method comprising the steps of:	Hachamovitch discloses information handling within a document operated on by a first application program. *See* claim 1a. The document contains first information that can be utilized in a second application program. *See* claims 1b-c.
[36b] identifying without user intervention or designation the first information; and	*See* claim 1c.
[36c] responding to a user selection by inserting a second information into the document,	*See* claim 1d.
[36d] the second information	*See* claim 1e.

40

associated with the first information from a second application program.	

37. The method of claim 36, wherein the user selection further comprises 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.	*See* claim 2.

[38a] 38. The method of claim 36, wherein the step of inserting the second information into the document further comprises the steps of:	*See* claim 3a.
[38b] initializing the second application program;	*See* claim 3b.
[38c] searching, using the second application program, for the second information associated with the first information; and	*See* claim 3c.
[38d] retrieving the second information.	*See* claim 3d.

39. The method of claim 38 wherein the step of inserting the second information into the document further comprises adding the second information to the first information in the document.	When the user accepts a completion suggestion, the completion information of an address (second information) can complete a name entry (first information)—that is, adding the suggestion entry to the name entry. *See* claim 1d.

40. The method of claim 38, wherein when the second	*See* claim 4.

41

application program includes second information associated with the first information, performing the further step of displaying the second information.	

41. The method of claim 38, further comprising the step of completing at least one of the first and second information in the document.	*See* claim 5.

42. The method of claim 36, wherein the first information comprises a name.	*See* claim 6.

[86a] 86. A method for assisting a computer operator to retrieve contact related information from a database when a document includes a name, the method comprising of the steps of:	Hachamovitch discloses a system that provides auto-complete suggestions for an entry in a document. For example, if a user enters a name, the system searches a database for competition suggestions, which can include contact related information. This is shown, for example, in Fig. 3, where the name "Microsoft Corporation" results in a suggested completion of the address for Microsoft Corporation. *See also* claims 1d and 3c.
[86b] (1) using a first computer program to analyze the document, without direction from the operator, to identify the name,	The auto-complete program includes a first computer program that, without direction from the operator, analyzes the document to identify a partial entry, such as a name. *See* claim 1c.
[86c] (2) using the identified name and a second computer program to search the database and to locate contact related information associated with the name, and	Using the partial entry identified (*e.g.*, a name), the auto-complete program searches using a suggestion list database (second computer program) to locate suggested completions, including contact related information, associated with the partial entry. *See* claims 1d and 3c.
[86d] (3) inserting the contact	If the user accepts the suggested completion by

related information into the document,	hitting an acceptance key, the suggested entry is inserted into the document. *See* claim 1d.
[86e] wherein steps (1)-(3) require only a single execute command.	Analysis of the document and searching the database are done automatically as the user enters information into the document, thus steps (1)-(3) require only execution of the suggestion acceptance command. *See* claims 86b-86d.

87. The method of claim 86 wherein the contact related information comprises an address.	In Fig. 3 the contact related information is the address for Microsoft Corporation.

89. The method of claim 86 wherein the name comprises a business name.	In Figs. 2B and 3 the name is a business name (Microsoft Corporation).

[93a] 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:	*See* claim 86a.
[93b] (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,	*See* claim 86b.
[93c] (2) using a second computer program and the text identified in step (1) to search the database and to locate related information, and	*See* claim 86c.
[93d] (3) inserting the information located in step (2) into the document.	*See* claim 86d.

43

2.   Computer Readable Medium And System Claims

Computer readable medium claims 7-12, 43-49, 97 and 98 are anticipated by Hachamovitch. These claims correspond to method claims 1-6, 36-42, 86, and 93. Hachamovitch discloses the steps in the body of the computer readable medium claims (as set forth above with respect to the corresponding method claims) and further discloses a computer readable medium including program instructions (*see*, *e.g.*, 4:53-55).

System claims 13-18, 50-56, 100, and 101, which include means-plus-function limitations, are also anticipated by Hachamovitch. These claims correspond to method claims 1-6, 36-42, 86, and 93. Hachamovitch discloses the functions of the means-plus-function limitations (as set forth above with respect to the corresponding method claims). Hachamovitch discloses a processor (*see*, *e.g.*, Fig. 1 at 21) programmed to perform these functions, and the programmed processor is same or equivalent structure as that disclosed in the '854 patent (if any structure is disclosed at all).

C.   Ground 6: Obviousness In View Of Hachamovitch

Claims 3, 9, 15, 38, 45 and 53 and any respective dependent claims recite initializing the second application program and searching using the second application program for the second information. These steps would have been obvious in view of Hachamovitch. (Menascé Decl. ¶ 161.) As a matter of

44

common sense, it would have been obvious for the auto-complete program to be initialized in order to run and search for completed suggestions. (*Id*. ¶ 162.)

Claims 88, 90, and 91 would have also been obvious in view of Hachamovitch. (Menascé Decl. ¶¶ 163-165.) Claim 88 depends from claim 86 and recites that the contact related information inserted into the document is a telephone number. As discussed in Ground 5, Hachamovitch discloses auto-completion by inserting an address. (Fig. 3.) Because both addresses and phone numbers are common contact information, it would have been obvious to one of ordinary skill in the art to insert a telephone number. (*Id*. ¶ 163.) Similarly, claim 90 recites that the name identified in the document is a personal name. Hachamovitch discloses identifying a business name, as shown in Figs. 2B and 3. One of ordinary skill in the art would have immediately understood that there is no meaningful difference between a business name and a personal name, and thus it would have been obvious to identify a personal name. (*Id*. ¶ 164.)

Claim 91 recites that "the execute command is a selection from a menu." The suggestion acceptance command in Hachamovitch is executed by pressing a keyboard button (11:48-50), but selection from a menu was well known, and thus it would have been obvious to a person of ordinary skill in the art to select the suggestion acceptance command from a menu. (Menascé Decl. ¶ 165.) This would have been a simple substitution of one known element (selecting via a

45

button) with another known element (selecting via a menu) to obtain predictable

results. (*Id.*)

IX. GROUNDS BASED ON LUCIW

A. Background Of Luciw

Luciw was filed on April 19, 1995 and thus qualifies as prior art under

§ 102(e) based on the earliest alleged U.S. filing date of the '854 patent. Luciw

relates to Apple's pen-based, handheld Newton device developed in the 1990s. It

discloses providing user assistance based on information entered into a document,

such as a note area created by a notepad application. (2:19-22; 6:24-59.) When

the user handwrites certain information, such as a name, it is automatically

recognized and converted to formal font, as shown by "Isaac" in Fig. 2 below.

(3:8-10; 10:10-21; 11:43-45.)

Figure 2

46

Luciw then presents for user selection a list of persons with the name identified; when the user makes a selection, information associated with the person, such as the person's full name, is inserted into the document. (11:60-12:6.)

B.   Ground 7: Anticipation Based On Luciw

1.   Method Claims

Method claims 1-6, 36-42, 86-88, 90, and 92-94 are anticipated by Luciw as set forth below.

Claim	Luciw
[1a] 1. A method for information handling within a document created using a first application program comprising the steps of:	Luciw discloses providing user assistance based on information the user enters into a document created by a first application program. *See, e.g.*, 2:19-22. Note areas 54a and 54b are documents created by the notepad application (first application program). *See, e.g.*, 6:24-31 ("Additional note areas, such as a note area 54b, can be formed by the user by drawing a substantially horizontal line across the screen 52 with the stylus 38."); 6:49-59 ("The screen illustrated in FIG. 2 is referred to as the 'notepad', and is preferably an application program running under the operating system of the pen based computer system 10."); Fig. 2.
[1b] entering a first information in the first application program;	The user enters first information, such as a name, in the notepad application. *See, e.g.*, 6:28-31 ("Additional text, graphical, and other data can then be entered into this second note area 54b. For example, the text object T comprising 'ISAAC' has been entered into second note area 54b."); Figs. 2 and 4b.
[1c] marking without user intervention the first information to alert the user	Luciw discusses entering information into a smart field whether in window 170 as in Fig. 4b or in the notepad application. *See, e.g.*, 8:15-18.

47

that the first information can be utilized in a second application program; and	Further, an implicit assist can also be indicated by writing in the notepad outside of a smart field. *See, e.g.*, 8:30-41 ("However, implicit assist may be indicated not just by entry of an indication in a smart field … [T]he writing of a particular indication or word on screen 52 outside of a particular smart field may trigger an implicit assist.").
	As discussed above, once a user enters a first name, the system without user intervention recognizes the name and displays it as a formal font (*i.e.*, marks first information) to alert the user the name can be used for an implicit assist action—for example, to locate additional information in a database (*i.e.*, can be utilized in a second application program). *See, e.g.*, Fig. 2 (showing Isaac in formal font); Figs. 4b-4c, 6b, and 10a-10b; 10:6-20; 16:25-50; 17:1-10. Also, Luciw discloses presenting three "Isaacs" for selection by the user. 11:60-12:6 ("Responsive to the recognition of the name ISAAC, the assistance process has produced a list of alternatives by earlier query of the database per step 106 in FIG. 3."); Fig. 6b.
[1d] responding to a user selection by inserting a second information into the document,	The system in Luciw presents for user selection a list of people with the first name identified. The system then inserts the full name (second information) of the person selected. *See, e.g.*, Figs. 6a-6c; 11:60-12:6 ("Responsive to the recognition of the name ISAAC, the assistance process has produced a list of alternatives by earlier query of the database per step 106 in FIG. 3. … The user-selected 'ISAAC ASIMOV' is shown having been marked for selection by a rectangle indicating a highlighting operation. FIG. 6c illustrates the completion of the selection process, with the full name in formal font of ISAAC ASIMOV being presented in the name field 175 of window 170.").

[1e] the second information associated with the first information from a second application program.	The second information (*e.g.*, a person's full name) is associated with the first information (*e.g.*, a person's first name). *See* claim 1d.

2. The method of claim 1 wherein the user selection further comprises 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.	Luciw discloses user selection via activation of a menu. *See, e.g.*, 3:14-20 ("FIGS. 6a-6c show respective assist windows in successive stages of an assist process, including first a window containing a first informational level directed at the name ISAAC alone, a second window with a pop-up menu offering a user choice among several known ISAACs, and a third window showing the selection of a particular ISAAC, that is ISAAC ASIMOV, having been accomplished.").

[3a] 3. The method of claim 1, wherein the step of inserting the second information into the document further comprises the steps of:	*See* claim 1.
[3b] initializing the second application program;	The system in Luciw uses a second application program, which must necessarily be initialized in order to function. *See* claim 1c.
[3c] searching, using the second application program, for the second information associated with the first information; and	The system in Luciw searches, using a database (the second application program), for other information (second information) associated with a first name (first information). *See, e.g.* 10:49-11:39; 11:60-12:6 ("Responsive to the recognition of the name ISAAC, the assistance process has produced a list of alternatives by earlier query of the database per step 106 in FIG. 3."); 12:41-54 ("In the earlier example of FIG. 6c in which it was decided that Isaac Asimov was the desired ISAAC, the phone information in window 170 had not yet been entered. This information may be available and can be accessed according to the process of FIG. 8a. *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 203. Then, as suggested at 206, the data obtained is entered into the applicable smart field of the window 170 under operation.") (emphasis added); Figs. 3 and 5.
[3d] retrieving the second information.	The second information is retrieved and displayed. *See* claim 3c.

4. The method of claim 3, wherein when the second application program includes second information associated with the first information, performing the further step of displaying the second information.	Luciw searches a database (second application) for and displays the second information (*e.g.*, inserting the full name). *See* claim 1d.

5. The method of claim 4, further comprising the step of completing at least one of the first and second information in the document.	The first and second information is completed by inserting the full name associated with the first name identified. *See* claim 1d.

6. The method of claim 1, wherein the first information comprises a name.	First information comprises a name. *See* claim 1b-d.

| [36a] 36. A method for information handling within a document operated on by a first application program, the document containing first information that can be utilized in a second application program, the | Luciw discloses a method for information handling within a document operated on by a first application program. *See* claim 1a.

The document contains first information that can be utilized in a second application program. *See* claims 1b-c. |
|---|---|

method comprising the steps of:	
[36b] identifying without user intervention or designation the first information; and	Luciw identifies information that can be used for an implicit assist without user intervention. *See* claim 1c.
[36c] responding to a user selection by inserting a second information into the document,	*See* claim 1d.
[36d] the second information associated with the first information from a second application program.	*See* claim 1e.

37. The method of claim 36, wherein the user selection further comprises 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.	*See* claim 2.

[38a] 38. The method of claim 36, wherein the step of inserting the second information into the document further comprises the steps of:	*See* claim 3a.
[38b] initializing the second application program;	*See* claim 3b.
[38c] searching, using the second application program, for the second information associated with the first information; and	*See* claim 3c.
[38d] retrieving the second information.	*See* claim 3d.

51

39. The method of claim 38 wherein the step of inserting the second information into the document further comprises adding the second information to the first information in the document.	The full name of the identified person (second information) is added to the identified first name (first information). *See* claim 1d.

40. The method of claim 38, wherein when the second application program includes second information associated with the first information, performing the further step of displaying the second information.	*See* claim 4.

41. The method of claim 38, further comprising the step of completing at least one of the first and second information in the document.	*See* claim 5.

42. The method of claim 36, wherein the first information comprises a name.	*See* claim 6.

[86a] 86. A method for assisting a computer operator to retrieve contact related information from a database when a document includes a name, the method comprising of the steps of:	Luciw discloses a method for assisting a user to retrieve contact information from a database related to a name included in a document. *See* claim 1.
[86b] (1) using a first computer program to analyze the document, without direction from the operator, to identify the name,	A user assist program (first computer program) analyzes the document without direction from the user to identify information that can be used for an assist, including a name. *See* claim 1c.

[86c] (2) using the identified name and a second computer program to search the database and to locate contact related information associated with the name, and	The identified name is used to search a database (second application program) to locate contact related information associated with the name, such as a phone number. *See* claim 3c.
[86d] (3) inserting the contact related information into the document,	The phone number is inserted into the document. *See* claims 1d and 3c.
[86e] wherein steps (1)-(3) require only a single execute command.	Upon selection of the "explicit assist" command, the system automatically identifies the user assist information, such a first name. *See, e.g.*, 9:16-10:5 ("If an explicit assist has been indicated at step 110, then a step 130 determines, if a particular selection as to the explicit assistance has been made. … Since no objects have specifically been selected, the objects to be entered into the assistant are selected automatically by a delimiter process."). The system then automatically selects the person to search for contact information. *See, e.g.*, Figs. 7a-7c, 12:7-40. The database is then searched for related contact information to insert into the document. *See* claims 1d and 3c. Thus, the system identifies the name, searches the database, and inserts the contact information upon execution of only the explicit assist command.

87. The method of claim 86 wherein the contact related information comprises an address.	Each person entry in the database contains various contact related information, including an address. *See, e.g.*, Fig. 5; 3:11-13 ("FIG. 5 shows an example of a generic <PERSON> type frame along with a particular set of specific frames of the <PERSON> type."); 10:49-11:39.

88. The method of claim 86 wherein the contact related information comprises a	The contact related information can be a phone number. *See, e.g.*, Fig. 5. *See also* claims 86c and 87.

53

telephone number.	

90. The method of claim 86 wherein the name comprises a personal name.	The name comprises a personal name. *See* claim 1c.

92. The method according to claim 91 wherein the operator enters the execute command before step (2).	The user enters the explicit assist command prior to identification of the name and searching the database. *See* claim 86e.

[93a] 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:	*See* claim 86a.
[93b] (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,	*See* claim 86b.
[93c] (2) using a second computer program and the text identified in step (1) to search the database and to locate related information, and	*See* claim 86c.
[93d] (3) inserting the information located in step (2) into the document.	*See* claim 86d.

94. The method according to claim 93 wherein at least steps (2)-(3) take place following entry a single execute command.	*See* claim 86e.

54

2.   Computer Readable Medium And System Claims

Computer readable medium claims 7-12, 43-49, 97, and 98 are anticipated by Luciw. These claims correspond to method claims 1-6, 36-42, 86, and 93. Luciw discloses the steps in the body of the computer readable medium claims (as set forth above with respect to the corresponding method claims) and further discloses a computer readable medium including program instructions (*see*, *e.g.*, Fig. 1 at 22).

System claims 13-18, 50-56, 100, and 101, which include means-plus-function limitations, are also anticipated by Luciw. These claims correspond to method claims 1-6, 36-42, 86, and 93. Luciw discloses the functions of the means-plus-function limitations (as set forth above with respect to the corresponding method claims). Luciw discloses a processor (*see*, *e.g.*, Fig. 1 at 12) programmed to perform these functions, and the programmed processor is same or equivalent structure as that disclosed in the '854 patent (if any structure is disclosed at all).

C.   Ground 8: Obviousness In View Of Luciw

Furthermore, claims 3, 9, 15, 38, 45 and 53 and any respective dependent claims recite initializing the second application program and searching using the second application program for the second information. These steps would have been obvious in view of Luciw. (Menascé Decl. ¶ 174.) As a matter of common

sense, it would have been obvious for the database to be initialized in order to run and search for the name, so as to provide the user with assistance. (*Id.* ¶ 175.)

Claims 87, 89, 91, and 95 would have been obvious in view of Luciw. (Menascé Decl. ¶ 176.) Claim 87 depends from claim 86 and requires the contact related information comprise an address. As discussed in Ground 7, Luciw discloses inserting contact related information such as a full name. It would have been obvious to insert an address given that Fig. 5 of Luciw discloses storing address information for contacts. This would be a simple substitution of address for name based on known methods to yield a predictable result. (*Id.*)

Claim 89 depends from claim 86 and recites that the name identified in the document is a business name. As discussed in Ground 7, Luciw discloses identifying a personal name. (Figs. 4b-4c; 11:43-45.) One of ordinary skill in the art would have immediately understood that there is no meaningful difference between a personal name and a business name, and thus it would have been obvious to identify a business name. (Menascé Decl. ¶ 177.) Claims 91 and 95 both recite that "the execute command is a selection from a menu." The "explicit assist" command in Luciw is executed by selection of an on-screen button. (Fig. 2 at 24; 8:51-53.) Because other commands in Luciw are selected from a menu (3:14-20), it would have been obvious to a person of ordinary skill in the art to select the "explicit assist" command from a menu. (Menascé Decl. ¶ 178.) This

would have been a simple substitution of one known element (selecting via a button) with another known element (selecting via a menu) to obtain predictable results. (*Id*.)

X.   CONCLUSION

For the reasons detailed above, there is a reasonable likelihood that Petitioner will prevail as to each of claims 1-18, 36-56, 86-95, 97, 98, 100, and 101 of the '854 patent. Accordingly, *inter partes* review of claims 1-18, 36-56, 86-95, 97, 98, 100, and 101 of the '854 patent is respectfully requested.

The USPTO is authorized to charge any required fees, including the fee as set forth in 37 C.F.R. § 42.15(a) and any excess claim fees, to Deposit Account No. **03-1952** referencing Docket No. **106842805100**.

Dated: December 2, 2013   Respectfully submitted,

By /David L. Fehrman/
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Certificate of Service (37 C.F.R. § 42.6(e)(4))

I hereby certify that the attached Petition for *Inter Partes* Review and supporting materials were served as of the below date by FedEx, which is a means at least as fast and reliable as U.S. Express Mail, on the Patent Owner at the correspondence address indicated for U.S. Patent No. 7,496,854 (*i.e.*, Sunstein Kann Murphy & Timbers LLP, 125 Summer Street, Boston, MA 02110-1618).

Dated: December 2, 2013   /Mehran Arjomand/
                                     Mehran Arjomand
                                     MORRISON & FOERSTER LLP
                                     707 Wilshire Blvd, Suite 6000
                                     Los Angeles, CA 90017-3543

Exhibit 6PP

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,134	08/06/2001	Atle Hedloy	103176-0001C1	9141

24267   7590   01/23/2007
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER
LUU, SY D

ART UNIT	PAPER NUMBER
2174	

MAIL DATE	DELIVERY MODE
01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

PTOL-90A (Rev. 10/06)

Interview Summary	Application No.	Applicant(s)
	09/923,134	HEDLOY, ATLE
	Examiner	Art Unit	
	Sy D. Luu	2174	

All participants (applicant, applicant's representative, PTO personnel):

(1) *Sy D. Luu (Examiner)*.   (3)*Atle Hedloy (Inventor)*.

(2) *Duane Dreger (Attorney)*.   (4)_____.

Date of Interview: *18 January 2007*.

Type: a)☐ Telephonic   b)☐ Video Conference
        c)☒ Personal [copy given to: 1)☐ applicant   2)☐ applicant's representative]

Exhibit shown or demonstration conducted: d)☐ Yes   e)☒ No.
    If Yes, brief description: _____.

Claim(s) discussed: _____.
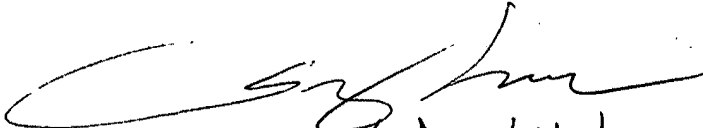
Identification of prior art discussed: *Tso (US 6,085,201)*.

Agreement with respect to the claims f)☐ was reached.   g)☒ was not reached.   h)☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: *Discussed claims 70 and 35 in light of the Tso reference and the specification. It is agreed that the claim language of the steps of: (a) identifying the first information would require amendments to clarify the invention and to distinguish the features of the invention over the applied prior art; and (b) marking the first information to alert the user would need to be clarified in light of possible 112 issues* .

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

SY D. LUU
PRIMARY EXAMINER

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.
_____
Examiner's signature, if required

U.S. Patent and Trademark Office
PTOL-413 (Rev. 04-03)   Interview Summary   Paper No. 20070118

Exhibit 6QQ

UNITED STATES PATENT AND TRADEMARK OFFICE

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NOTICE OF ALLOWANCE AND FEE(S) DUE

24267   7590   07/02/2008

CESARI AND MCKENNA, LLP
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BOSTON, MA 02210

EXAMINER
LUU, SY D

ART UNIT	PAPER NUMBER
2174	

DATE MAILED: 07/02/2008

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,134	08/06/2001	Atle Hedloy	103176-0001C1	9141

TITLE OF INVENTION: METHOD, SYSTEM AND COMPUTER READABLE MEDIUM FOR ADDRESSING HANDLING FROM A COMPUTER PROGRAM

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	$1440	$300	$0	$1740	10/02/2008

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE 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.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PTOL-85 (Rev. 08/07) Approved for use through 08/31/2010.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: <u>Mail</u>   Mail Stop ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
or <u>Fax</u>   **(571)-273-2885**

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)	Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

24267   7590   07/02/2008

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

Certificate of Mailing or Transmission
I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

_____ (Depositor's name)

_____ (Signature)

_____ (Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,134	08/06/2001	Atle Hedloy	103176-0001C1	9141

TITLE OF INVENTION: METHOD, SYSTEM AND COMPUTER READABLE MEDIUM FOR ADDRESSING HANDLING FROM A COMPUTER PROGRAM

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	$1440	$300	$0	$1740	10/02/2008

EXAMINER	ART UNIT	CLASS-SUBCLASS
LUU, SY D	2174	715-780000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

❑ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

❑ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list

(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,

(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 _____

2 _____

3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE   (B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent) :   ❑ Individual   ❑ Corporation or other private group entity   ❑ Government

4a. The following fee(s) are submitted:
❑ Issue Fee
❑ Publication Fee (No small entity discount permitted)
❑ Advance Order - # of Copies _____

4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)
❑ A check is enclosed.
❑ Payment by credit card. Form PTO-2038 is attached.
❑ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)
❑ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.   ❑ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

Authorized Signature _____   Date _____

Typed or printed name _____   Registration No. _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,134	08/06/2001	Atle Hedloy	103176-0001C1	9141

24267   7590   07/02/2008
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON, MA 02210

EXAMINER
LUU, SY D

ART UNIT	PAPER NUMBER
2174	

DATE MAILED: 07/02/2008

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 32 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 32 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101   or (571)-272-4200.

PTOL-85 (Rev. 08/07) Approved for use through 08/31/2010.

Supplemental ***Notice of Allowability***	Application No. 09/923,134	Applicant(s) HEDLOY, ATLE	
	Examiner Sy D. Luu	Art Unit 2174	

-- 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 *the communications filed 1/24/2008*.

2. ☒ The allowed claim(s) is/are *35-132*.

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 _____
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 _____ .
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

/SY D. LUU/
Primary Examiner, Art Unit 2174

Application/Control Number: 09/923,134   Page 2
Art Unit: 2174

Statement of Reasons for Allowance

1.   Claims 35-135 are allowed.

2.   The following is an examiner's statement of reasons for allowance.

The present invention is directed to a method for name and address handling within a document..

Claims 35, 41, 47, 70, 77, 84, 120, 127, 131-132, and 134-135 recite, or similarly recite, the steps of: entering a first information in the first application program; marking or identifying 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.

Claims 53, 59, and 65 recite, or similarly recite, 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 performing an operation related to a second information, the second information associated with the first information from the second application program.

Claims 91, 97, 103 recite, or similarly recite, the steps of:: identifying without user intervention or designation the first information and responding to a user selection by performing an operation related to a second information, the second information associated with the first information from the second application program.

Application/Control Number: 09/923,134   Page 3
Art Unit: 2174

Claims 119 and 130 recite, or similarly recite, the steps of:: initializing the second application program; searching, using the second application program, for the second information associated with the first information; and if said second information exists, retrieving and displaying the second information; wherein said user selection comprises: selecting a menu indicator for the menu; opening the menu; selecting a choice in the menu; and activating the selected choice in the menu; wherein selection the menu indicator comprises moving the mouse pointer to the menu indicator; wherein the opening of a menu comprises clicking on the menu indicator with a mouse button; and wherein the second information is associated with at least part of the identified first information.

The closest prior art, Tso (US 6,085,201) and Pandit (US 5,859,636), show a substantially similar method for marking and inserting information. However, Tso and Pandit, singularly or in combination still fail to anticipate or render the above cited limitations obvious.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Application/Control Number: 09/923,134   Page 4
Art Unit: 2174

Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sy Luu whose telephone number is **(571) 272-4064**. The examiner can normally be reached on Monday - Friday from 7:300 am to 4:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on (571) 272-3923.

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). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sy D. Luu/
Primary Patent Examiner
Art Unit 2174

SDL: 7/2/08

Exhibit 6RR

Trials@uspto.gov   Paper No. 31
571-272-7822   Entered: March 3, 2015

RECORD OF ORAL HEARING

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

- - - - - - -

Cases IPR2014-00206 and IPR2014-00207

Patent 7,496,854

Technology Center 2100

Oral Hearing Held on Wednesday, February 4, 2015

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
TREVOR M. JEFFERSON, *Administrative Patent Judges.*

The above-entitled matter came on for hearing on Wednesday, February 4,
2015, at 1:00 p.m., in Hearing Room A, taken at the U.S. Patent and
Trademark Office, 600 Dulany Street, Alexandria, Virginia.

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

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Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

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

2   (1:00 p.m.)

3   JUDGE MEDLEY: Please be seated. Good

4   afternoon. This is the hearing for IPR's 2014-00206 and 207,

5   between Petitioner Apple, Google, and Motorola Mobility, and

6   Patent Owner Arendi S.A.R.L. involving U.S. Patent Number

7   7,496,854.

8   Per the January 12 order from the Board, each

9   party will have 60 minutes total time to present argument for

10   both cases.

11   Petitioner, you will proceed first to present your

12   case with respect to the challenged claims and grounds for

13   which the Board instituted trial for both cases.

14   Thereafter, Patent Owner, you will respond to

15   Petitioner's presentation for both cases. And then, Petitioner,

16   you may reserve rebuttal time to respond to Patent Owner's

17   presentation with respect to the two cases.

18   And at this time we would like the parties to

19   please introduce counsel and also identify who will be

20   presenting today, beginning with Petitioner.

21   MR. FEHRMAN: Good afternoon, Your Honor.

22   My name is David Fehrman, Morrison & Foerster, on behalf of

23   Apple.

24   And with me is Mehran Arjomand and Alex Yap of

25   Morrison & Foerster, and Wendy Anna Herby, in-house

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Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   counsel at Apple; and Matthew Smith from Turner Boyd for

2   Google and Motorola. And I will be presenting the argument

3   with some possible additional argument from Mr. Yap.

4   JUDGE MEDLEY: Thank you. For Patent Owner?

5   MR. ASHER: Robert Asher from Sunstein Kann

6   Murphy & Timbers representing Arendi. I'm here with Bruce

7   Sunstein and Dorothy Wu, as well as Atle Hedloy of Arendi.

8   And I will be presenting.

9   JUDGE MEDLEY: Thank you. Okay. Petitioner,

10 you may begin. And would you like to reserve rebuttal time?

11   MR. FEHRMAN: Yes. 20 minutes, please.

12   JUDGE MEDLEY: 20 minutes, okay. And just so

13 everyone knows, I go by this clock.

14   MR. FEHRMAN: Good afternoon. Our first slide

15 here is just the listing of the case which you have already

16 identified.

17   So the patent at issue is 7,496,854. We have the

18 cover sheet here on slide 2. The ground of institution for the

19 IPR2014-00206 is anticipation based on the Domini patent of

20 claims 19, 20, 22 to 26, 28 to 30, 57, 58, 60 to 74, 76 to 78,

21 85, and 96.

22   And the grounds of institution with respect to the

23 second petition 2014-0027 are 1 to 12, 36 to 38, 40 to 45 and

24 49, anticipation based upon Domini; 1 to 12, 36 to 49,

25 anticipation based upon Hachamovitch; and 3 to 5, 9 to 11, 38

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Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   to 41 and 45 to 48 based upon obviousness in view of

2   Hachamovitch.

3   I would like to start with a brief review of the

4   patent and the technology that is disclosed. It is basically

5   directed to kind of two types of operations: One is

6   completion or adding information into a document such as a

7   word processing document. Here it shows the name of a

8   person. This is figure 3, slide 5.

9   And the system can operate to insert a

10   corresponding address for that person that it obtains from a

11   database. And that is shown in figure 4, slide 6.

12   There are numerous types of operation disclosed in

13   the specification. I would like to briefly review those various

14   examples because they are relevant to recitations in the

15   claims.

16   So the first example that they provide corresponds

17   to the figures we just looked at, which is retrieving an address

18   from, for example, an address book to put into a document

19   based upon a name that has been typed in. This operation

20   works on the left side of figure 1 which I have illustrated in

21   slide 7.

22   And step 6 shows what data did we find. And if

23   you find a name, you look that name up in a database, shown

24   at step 12. And if you found just one match, then you insert

25   that corresponding address from the name into the document

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Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   and that ends that process. That's the straightforward entry of

2   an address into a document based upon looking it up in a

3   database. And that's illustrated in slide 8 that shows figures 3

4   and 4. The starting point is the name is entered, and then the

5   address is retrieved and put into the document.

6   The second example is where the name is entered

7   but it does not have a corresponding address. This is adding a

8   new contact to a database such as an address book. And this

9   works more on the right side.

10   Again, the information may be found, maybe it is

11   both name and address, and it is looked up in the database

12   here at step 14. But no match is found.

13   So in that case it goes to step 28, which is adding

14   that information into the address books. That's a new entry

15   into the address book because that did not previously exist.

16   And that example is illustrated in figures 5 and 6 of the

17   specification which we have shown at slide 10.

18   And the name and address are entered shown at

19   figure 5 and then the pop-up permits selection to add that

20   information into the database, as shown in figure 6.

21   Another example provided in the specification is

22   adding a new address for an existing contact. So it is not

23   something that didn't exist at all. But it has some different

24   information. So this moves over to further right. This is

25   slide 7. And, again, it is figure 1, where we have highlighted

6

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   a different path, which is again looking up the name in the

2   database, and it finds a name but not an address, and it

3   prompts the user at step 30 for a decision and/or review.

4   And the two possibilities are either changing the

5   address that's in there or adding it as an additional address,

6   for example, a work address when a home address was already

7   in there. So changing the address is shown with step 34 and

8   inserting the additional address is shown at step 36. And

9   that's illustrated in slide 12 at figures 4 and 9.

10   So figure 4 is again the name and address is

11   entered, and the options are given in figure 9 so you can

12   change the current address, as shown at 76. You can add a

13   new address. There are various options, but it is adding

14   information into the database that wasn't there, either adding

15   it on top or changing it.

16   Another is where there are several addresses

17   already in the database corresponding to a single person's

18   name. And that goes back to the left side. We show that on

19   slide 13.

20   And we go down through step 18 and we found

21   more than one possible address match, and then that provides

22   at step 20 the choices to the user of which address to select,

23   and the user selects which address to use for the document,

24   for example, and inserts that.

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   That's illustrated in slide 14. It shows figures 3

2   and 10, where in figure 10 two different addresses show up

3   corresponding to the name that was entered and the user

4   selects one of those addresses.

5   So the various examples of operations that are

6   performed can include displaying of information so you

7   display a located address, or name and address. You can

8   insert information from a database into a document. Those

9   are examples 1 and 5, the display is 4 and 5 that we just

10   reviewed, or you can insert information from what you've

11   typed into the document over into the database.

12   So it kind of has two different directions in terms

13   of operations performed with respect to information. And that

14   last one is examples 2 and 4. These are illustrated in slide 15.

15   So we have two primary areas of claim

16   construction: Application program, and then we've put

17   together "performing an operation related to second

18   information and second information associated with the first

19   information from a second application program." Those are

20   part of a larger recitation.

21   So slide 17, we just have repeated the institution

22   decision and the basic standard for claim construction in an

23   IPR proceeding. Claim terms are generally given their

24   ordinary and customary meaning as would be understood by

8

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   one of ordinary skill in the art in the context of the entire

2   disclosure.

3   And, in addition, if an inventor acts as his or her

4   own lexicographer, any special definition must be set forth in

5   the specification with reasonable clarity, deliberateness and

6   precision.

7   The first term we have is the term "application

8   program." It does not appear in the specification so certainly

9   there was no special definition given to that term by the

10   Patent Owner. It was only added in the claims and has no --

11   there is nothing in the specification that informs the meaning

12   of that term and, therefore, it goes to the ordinary and

13   customary meaning.

14   In the institution decision, as we show at slide 19,

15   the Board construed application program as an independent

16   executable program. And we have copied a bit of page 12

17   here from Paper 9, the institution decision, where the Board

18   first states that the term does not appear in the specification,

19   and the Patent Owner had argued for a narrow construction of

20   this term, that it is limited to programs designed to assist in

21   the performance of a specific task, such as word processing or

22   spreadsheet processing or contact management or e-mail or

23   calendaring.

24   JUDGE JEFFERSON: The party disputes that

25   independent should be independently?

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   MR. FEHRMAN: Yes.

2   JUDGE JEFFERSON: Do you think there is a

3   difference between the construction independently executable

4   program or independent executable program?

5   MR. FEHRMAN: I think there shouldn't be a

6   difference. My understanding as to the intent is that

7   independent may mean that a program is independent and can

8   work with, say, four or five other programs.

9   Independently means that a program can operate

10   solely by itself without reference to anything else. I'm not

11   sure if that's what it means or that's their intent, but certainly

12   the Patent Owner went to great lengths to attempt to point out

13   that the Board had a typographical error and meant

14   independently when it said independent.

15   So a very interesting and kind of unique situation

16   we have in this case, as far as I'm aware, is that the Patent

17   Owner is seeking a claim construction for application program

18   that excludes that very term that is used in one of the prior art

19   references, Domini.

20   The process or the exercise of claim construction

21   is a very interesting one. We start with words and then we go

22   pick some other words to replace those words with, and then

23   we use that to look at infringement or prior art. I have never

24   seen a situation where that exercise has been used to exclude

25   the words that are being construed.

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Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   And the purpose here is very clear. The reason is

2   that because the Domini reference has numerous references to

3   application program that the Patent Owner is seeking to

4   distinguish from the claims. So normally we wouldn't be

5   referring to a piece of prior art in the claim construction

6   process but it is so clear what's being done here that I think it

7   is appropriate to point that out.

8   And that is shown here in slide 21 as various

9   different application programs, word processing program 37A,

10 spell checker program 37B, grammar checker program 37C,

11 and it goes down to application program 37N. All of those

12 use the same number 37.

13   And in the specification they are all referred to as

14 application programs as we show at slide 22, and Domini at

15 7:41-50 refers to application programs 37, and then at the

16 bottom the application programs may include a number of

17 different programs, such as a word processor, spell checker

18 and grammar check program.

19   What the Patent Owner is attempting to do is parse

20 this out. So a word processing program, that meets their

21 definition of what an application program is, as we show in

22 slide 23, but a spell checker program and a grammar check

23 program don't. Those are somehow some different animals,

24 even though they are all referred to as application programs.

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Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   So, again, as we mentioned and shown at slide 25

2   here, it is quite a remarkable attempt to adopt a claim

3   construction based upon language that was not included in the

4   specification of the patent itself and, yet, adopt a claim

5   construction that excludes prior art that uses the exact

6   language used in the claims.

7   And we believe that's inappropriate, clearly

8   inappropriate and you cannot get a claim construction unless

9   there is clearly some special definition provided in the patent,

10   which is not done here, or clearly some out-of-ordinary use in

11   the prior art reference, which we also do not have here.

12   And on slide 26, then I go to the issue of

13   independent and independently. I believe that the prior art

14   would meet it under either construction because those prior

15   art references show applications that can be used with

16   numerous different applications, such as word processing, and

17   do not need to be part and parcel of the word processing

18   application.

19   So they are independently executable and they are

20   independent executable. But I do believe that the construction

21   provided by the Board is the more accurate one. There's

22   nothing to restrict these claims in any way from the

23   specification to some particular independence or something

24   else.

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Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   They are basically executable programs that

2   perform some function, they perform an application, whether

3   that's a narrow application or a bigger one. So I believe that

4   independent executable program is a correct broadest

5   reasonable construction.

6   JUDGE JEFFERSON: Is it your opinion that the

7   program can't be subsidiary to another program?

8   MR. FEHRMAN: Oh, certainly.

9   JUDGE JEFFERSON: It is not an application

10   program for your purposes in Domini?

11   MR. FEHRMAN: For our purposes, Your Honor?

12   JUDGE JEFFERSON: Would it not meet -- what it

13   would take for it to meet the application.

14   MR. FEHRMAN: I don't believe that subsidiary

15   changes it from meeting an application program or not. It is

16   still a program that performs particular functions, based upon,

17   you know, program steps. And those particular functions are

18   used to, for example, correct the spelling of a word.

19   So the second are a couple of interrelated phrases

20   in the claims. We have shown at slide 27, "performing an

21   operation related to second information." And here the Board

22   in the institution decision stated that: "Performing an

23   operation related to second information encompasses

24   operations on preexisting information or new information that

25   may be the second information itself or related to the second

13

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   information." And that's from page 9 of the institution

2   decision.

3   And that construction is not disputed by the Patent

4   Owner. And the reason that construction is appropriate is

5   there are a lot of different things that can be done, as

6   illustrated in figure 1, the various types of operations.

7   And, for example, here on slide 29 we show and

8   highlight three different operations where something can be

9   added to a database. And the left one, 28, box 28, that's a

10 situation where there was nothing in the database. They didn't

11 find anything. So the information gets added, the first and

12 second information.

13   The slides 34 and 36 already have some form of

14 second information but they may replace it with different

15 information or they may add on an additional address.

16   So there is quite a range of operations and that's

17 why the construction that was adopted by the Board is not

18 temporally restricted and require information to preexist and a

19 link to preexist because in the patent itself that second

20 application program, the information may be entered new

21 before it gets connected between first and second information

22 in that program, as shown at the box 28.

23   So that's, again, from figure 1, slide 29. And

24 figure 2 is essentially similar. It has a few differences but in

25 basic operation they are the same.

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Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   So on slide 30 we illustrate figure 6 and 9,

2   different operations, adding a new contact, brand new

3   information that's going into the database. And figure 9 is

4   modifying a contact address by replacing or adding an

5   additional address.

6   And so under the broadest reasonable construction

7   all of these various operations should be encompassed with

8   the performing an operation because those are various

9   operations that are being, potentially being performed, and

10   there is nothing to restrict it to one or more of those.

11   So related to that, which is part of the overall

12   recitation, we are now on slide 31 which is the construction of

13   the term "associated." And the Board in its institution

14   decision indicated that associated should not be narrowly

15   construed as requiring a preexisting connection or

16   relationship.

17   And it includes -- and the specification refers to

18   information that may match the search data or other data

19   corresponding to a typed name. So the Board construed the

20   term "associated" as connected or related.

21   And, again, on slide 32, page 11, the second

22   information associated with the longer recitation was

23   construed on as "encompasses second information that is

24   related to or connected with the first information from a

25   second application program."

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Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   And that's a correct construction. For example,

2   there is a dependent claim where the extra -- the operation

3   that is being performed is entering additional data into the

4   database. And that additional data may be the new

5   information where no name and address was found. It is

6   brand new information that's being entered into that database.

7   So, again, those various operations of entering

8   data into a database, those are illustrated in slide 34 with the

9   different steps, 28, 34 and 36. And under the broadest

10   reasonable construction those claims should encompass those

11   various operations.

12   So moving from the claim construction to the

13   application of Domini to the claims. Domini anticipates the

14   claims. The institution decisions we repeat here at slide 35

15   have anticipation based upon Domini of numerous claims of

16   the '854 patent.

17   And as we had seen before, Domini discloses

18   various application programs and specifically refers to those

19   as various application programs. And one of those is a spell

20   checker program that can operate in conjunction with a word

21   processing program, for example, to correct spelling of terms.

22   So as we show on slide 37, this is figure 3 from

23   Domini, and here a word was entered into a document, for

24   example, where the word is "engine" as shown at the bottom.

25   At 315 it is e-n-g-i-n. And the application program, the spell

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   checker operation, will perform an operation and search for

2   potential replacements and provide a list for the replacements.

3   It will first search to see if it finds the word

4   "engin," e-n-g-i-n, in its dictionary. If it is, that word is not

5   misspelled. But if it is not found it then searches further to

6   locate potential replacements and presents those to the user as

7   shown at 320 where there are two options of "engine" with an

8   "e" or "ensign," e-n-s-i-g-n.

9   And the operations that can be done include

10 change, where the user could select one of the suggestions and

11 change it as shown at the button 340 to replace the misspelled

12 word with the word that the search located or, if the word is

13 one that's used by the user and is, in fact, not a misspelling,

14 the user can add that word to the database. And 335 is that

15 indication. So these operations are shown in slide 37.

16   So there are many claims and we are not going to

17 go through each one of the claims but we have the chart here

18 for claim 19 on Domini and went through showing

19 element-by-element the presence of each element in Domini

20 and how Domini anticipates the claims. And based upon that

21 information, the Board instituted review. And we have broken

22 it out into the various steps.

23   Then we go to some dependent claims, and the step

24 as we have shown before here at slide 40 is claim 22, wherein

25 the operation is entering additional data into a database. So

17

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   that's the right side of figure 1, those various operations of

2   entering additional data as opposed to entering data into the

3   document, which is the left side of figure 1.

4   And, again, to repeat what the Board had

5   determined on claim construction -- we are at slide 41 -- in

6   the institution decision, "'performing an operation related to

7   second information,' encompasses operations on preexisting

8   information or new information that may be the second

9   information itself or related to the second information."

10   And that's a correct construction in view of all of

11   these different types of potential operations that are disclosed

12   to provide the broadest reasonable construction.

13   And we move where we have a separate argument

14   provided by the Patent Owner on claim 64, which has the

15   limitation regarding searching for second information,

16   "searching, using the second application program, for the

17   second information associated with the first information."

18   And the Patent Owner has argued that the only

19   thing that's searched for is the first information, that no

20   second information is searched for. But in order to get second

21   information, as we show at slide 43, the second information is

22   the "engine" or "ensign" potential replacements. Those had to

23   be searched for and obtained. And it searches for the first

24   word, the word that has been input. That's how all of these

25   work.

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   We move to slide 44 where the argument by the

2   Patent Owner is that it is searching for first information rather

3   than second information.

4   But as we see in slide 45, which is, again, figure

5   1, what is done in the patent itself is you look for the first

6   information, you look that up in the database at step 14. And

7   based upon that, you get either nothing if there is no

8   information, or you get a match which is second information.

9   In Domini, similarly, you look for first

10   information. If you get it, the word is spelled correctly. If

11   you don't, you continue to search to get a list of replacement

12   terms.

13   So then we also have the institution decisions

14   based upon Hachamovitch, and those are illustrated here in

15   slide 46 and it is claims 1 to 12, 36 to 49 of the '854 patent,

16   on anticipation, and then other claims 3 to 5, 9 to 11, 38 to

17   41, and 45 to 48 on obviousness.

18   So Hachamovitch -- this is slide 47 -- shows

19   figures 2 and 3. And figure 3 in particular shows a situation

20   where there is a name, Microsoft Corporation, and the

21   completion information for that name is the address for

22   Microsoft Corporation. That is the identical function to what

23   is described in the specification of the '854 patent. Not

24   similar, not just to claim anticipation, but it is the identical

25   function.

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Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   And we see figure 3 in slide 47, we go back to

2   slide 8 on retrieving an existing address, the name is entered,

3   shown in figure 3, and the completion information is the

4   address corresponding to that name.

5   We go back, slide 47, the name is entered and the

6   information that is used to complete it is the address. And the

7   only argument that the Patent Owner has here is, well, this is

8   a utility. This is not an application program.

9   Whatever application program means, it was not

10   defined in their specification, but the identical operation is

11   being distinguished based upon nothing more than the

12   assertion that this is something different, it is a utility and not

13   an application program, even though Hachamovitch clearly

14   states that it can be used independent of any particular

15   application and used across a number of different

16   applications.

17   And this identical function is just very telling in

18   terms of the weakness of the argument for unpatentability,

19   that the claims are not anticipated by or obvious in view of

20   Hachamovitch.

21   And that's all of my presentation. Thank you. Do

22   you have any questions?

23   JUDGE MEDLEY: Thank you.

24   MR. ASHER: May I hand up paper copies of the

25   exhibits?

20

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   JUDGE MEDLEY: That's fine. Thank you.

2   MR. ASHER: It appears that much of their

3   argument is being reserved for their rebuttal. Is it possible

4   for me to reserve five minutes to respond at the end?

5   JUDGE MEDLEY: No, because the burden of

6   proof rests with the Petitioner. Only Petitioner will have time

7   for rebuttal.

8   MR. ASHER: And are you using those lights?

9   JUDGE MEDLEY: No, I'm not. I'm looking at the

10 clock. So your time begins at 1:35. You get to 2:35.

11   MR. ASHER: Thank you, Your Honors. What I

12 will try to do now is briefly describe the invention, the claim

13 construction, the references that are cited and being addressed

14 in this proceeding and, if I have time, we will deal with some

15 of the other issues that have been raised in our Patent Owner

16 response.

17   Petitioner went through in great detail all of the

18 information handling processes that are performed in the word

19 processor of the invention in the '854 patent, but what he

20 misses is the actual unique aspect of the '854 patent, and that

21 was the abilities to obtain the information for working with

22 the word processor through another application program, the

23 database programs.

24   Beginning in the '854 patent, looking at the

25 background of the invention, the field of the invention, there

21

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   it describes how the invention relates to coupling a word

2   processor with an information management source.

3   Now, in the embodiment of the patent, it is the

4   OneButton that is provided in the word processor to initiate a

5   program that provides the coupling to an information

6   management source.

7   Information management sources are explicitly

8   identified, exemplified by Access, Outlook, Oracle, Dbase,

9   Rbase and Cardfile. And those were all well-known

10   application programs. The background described how those at

11   the time may have been faced with difficulties while working

12   on a word processor and needing to obtain information or

13   make use of a database.

14   They would have to have access to this other

15   program, the database program, and they would have to know

16   how to use this other database program. So the invention is

17   designed to solve those problems of the times.

18   Referring to slide 2, so all the patent claims in the

19   '854 patent in both of these IPR proceedings recite this

20   coupling of a first application program and a second

21   application program. It is the first application program in the

22   preamble that creates the document, and it is the second

23   application program that is the source of the second

24   information associated with the first information from the

25   document.

22

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   So there we have what's in the patent, and we will

2   continue looking at the patent, the intrinsic evidence for

3   determining what is meant by application programs in the '854

4   patent.

5   So referring to slide 3, we can see there a

6   recitation of exemplary first application programs. You have

7   there Microsoft Word, Microsoft Excel, a number of other

8   word processing type programs, and then it refers to the

9   information management source programs which I have

10   already spoke about.

11   Now, I should point out, now that we are doing

12   claim construction, this is the first time we will have the

13   opportunity to do claim construction with the benefit of

14   extrinsic evidence. Of course, our expert was not able to

15   testify at the time of the preliminary response. And so this

16   will be the first time we are actually able to look at claim

17   construction from the eyes of one of ordinary skill in the art.

18   Slide 4, please. So now we go through the

19   examples in the '854 patent. Example 1, you can see clearly

20   that the document, the program that creates the document is

21   Microsoft Word. That is the first application program. In

22   slide 4 -- sorry, slide 5, we just went through all of the

23   examples 2 through 6 and, similar to claim 1, the first

24   application program is Microsoft Word.

23

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   In slide 6, I'm sorry, yes, slide 6, here we get to

2 example 7. Example 7 points to spreadsheet application.

3 Everyone knows, it was clear that Excel is an application

4 program. And in this case the patent shows that there are

5 other programs that may be used to create the document. In

6 this case it was Microsoft Excel.

7   JUDGE JEFFERSON: Counsel.

8   MR. ASHER: Yes, sir.

9   JUDGE JEFFERSON: I'm taking from your slides

10 that Excel and Word are programs that are referred to in the

11 specification. The specification doesn't use the term

12 application program at all to describe any of those. The only

13 time application program appears is in the claims.

14   So are you suggesting or, let me be clear, are you

15 saying that application program means Excel and Word in

16 these specific examples given here? Is that how these should

17 be defined?

18   MR. ASHER: Those are examples of application

19 programs.

20   JUDGE JEFFERSON: Are they limited to those

21 types of programs, those specific programs?

22   MR. ASHER: Not to those specific programs, no.

23   JUDGE JEFFERSON: Okay. So application

24 program isn't limited to these. The broadest reasonable

25 interpretation of that term certainly should encompass

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   something that is not just Word or Excel or even things that

2   are defined specifically by those functions?

3   MR. ASHER: Defined by which functions?

4   JUDGE JEFFERSON: Defined by those particular

5   types of programs.

6   MR. ASHER: I mean, we are aware Excel is a

7   spreadsheet programming and does spread sheeting. Microsoft

8   Word does document word processing. No, it is not limited to

9   those functions.

10   JUDGE JEFFERSON: Microsoft Paint, would

11   Microsoft Paint be an application program?

12   MR. ASHER: Microsoft Paint, I don't know. I'm

13   not skilled with that and I'm not familiar with Microsoft

14   Paint.

15   If it is a program you can double-click on to open

16   on your windows I think it would be an application program.

17   Whether it would create a document that makes any sense for

18   this invention, I don't know. Certainly you can go beyond the

19   identified programs.

20   It is those programs that provided the support for

21   application program when it was used in the claims. It should

22   be quite clear from reading the patent and the claims that the

23   programs that have been coupled, the first application

24   program is clearly -- in the examples, Microsoft Word is an

25   example of the application program that is used.

25

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   When it refers to second application program,

2   that's one of those information source programs or another

3   similar type program. But it is always an application

4   program.

5   And in terms of the words application program,

6   there it is, spreadsheet application, example 7. Is it unclear

7   that that is a program? Again, we're looking at this from one

8   of ordinary skill in the art and I think -- and I agree with

9   counsel that the plain and ordinary meaning of application

10   program, as used by those of ordinary skill in the art, would

11   control.

12   So we see how the patent describes these

13   programs, these application programs. Now we have the

14   benefit of our expert witness. And certainly it should be

15   understood that in interpreting application program he looked

16   at it from those of ordinary skill in the art.

17   So in slide 7, Dr. Levy stated that: "Since the

18   computer programs described in the '854 specification include

19   word processors, spreadsheet programs, information

20   management programs and database programs as examples, a

21   person of ordinary skill in the art would understand that they

22   are application programs and that they, therefore, have

23   commonly-shared features."

24   So now in the claim construction process we're

25   trying to, you know, create words for what is an application

26

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   program. Those of ordinary skill in the art kind of know what

2   an application program is. And how would you describe it in

3   words? Well, let's look at the characteristics of an application

4   program that they share and that distinguish them from other

5   types of programs.

6   Dr. Levy goes on to state that: "In particular, each

7   of these programs can be executed independently" -- and that's

8   what we latched onto as a helpful word definition of what

9   constitutes an application program -- "and can be invoked, for

10   example, by double-clicking on an application program icon to

11   initiate its execution in a separate process. Each of these

12   example programs manages user interaction in a separate

13   window. All of these example programs run asynchronously

14   without being under the control of a separate application

15   program."

16   So one can operate Microsoft Excel. And you can

17   also open Microsoft Word on your program. And these two

18   can be running and doing the same things at the same time.

19   They don't need another program to call them. They don't

20   have to -- they are responsive to the user. They have their

21   own interface that one interacts with, the user interacts with.

22   They are separate application programs that have been made

23   available.

27

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   At slide 8, Dr. Levy helps us understand

2   application programs by contrasting them with programs that

3   operate in a subsidiary manner.

4   Here it says: "In contrast to these examples of

5   independently-executable programs, each subsidiary program

6   (or 'utility' or 'program module') described in Domini and

7   Hachamovitch for adding functions to an application program

8   requires that application program to activate it (by invoking it

9   with a call) and to communicate synchronously with it.

10   Consequently, these subsidiary programs are not

11   independently executable."

12   JUDGE BLANKENSHIP: I don't understand that.

13   Why is that not independently executable? You have a, for

14   example, a word processor program and you select to run a

15   spell checker, the spell checker doesn't run automatically

16   when the word processor is running, so why is that not

17   independently executable?

18   MR. ASHER: The spell checker is not

19   independently executable when the word -- because for it to

20   actually run or do anything the word program has to call it.

21   The user can't click on -- the user -- the spell checker program

22   doesn't have its own interface.

23   The user can't do a spell checker independently on

24   its own. Actually it wouldn't even make sense because you

25   need another program to provide text for the spell checker to

28

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   do its operations upon. So unless you were -- unless there

2   was like -- I suppose you could have a spell checker that was

3   an application program.

4   You click on it, it opens up, gives you an

5   interface, and you enter a word. Is the word correct? It tells

6   you if the word is correct or not. And all it does is spell

7   checking the words you put into it.

8   That's the spell check. But the spell checker

9   modules that are in Domini and the utilities of Hachamovitch,

10   they don't open in response to a user. They can't be

11   independently executed. They don't independently provide an

12   interface to interact with. They only come on when they are

13   called from the application program.

14   Is that clear?

15   JUDGE BLANKENSHIP: Proceed.

16   MR. ASHER: Okay. Thank you.

17   JUDGE JEFFERSON: Counsel, before you go on,

18   just so I understand, your presentation of Dr. Levy's testimony

19   is that one of ordinary skill in the art would define application

20   program by turning to the commonly-shared features of the

21   examples shown in the '854 spec and only those examples.

22   Did I hear that right?

23   MR. ASHER: Okay. So those are present in the

24   patent, and then one needs to know what is meant by

29

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   application program. People understood that those are

2   application programs.

3   JUDGE JEFFERSON: And so Dr. Levy is saying

4   that you would only look at the commonly-shared features of

5   those programs to determine what application program

6   encompasses. Is that correct?

7   MR. ASHER: No, it is what one of ordinary skill

8   in the art would understand an application program to be.

9   JUDGE JEFFERSON: So go back to slide 7. I

10   thought you said he divined those by looking at the

11   commonly-shared features of those programs and then goes on

12   to list them.

13   Are you saying that they weren't tied to those

14   programs, that he pulled those out just from his knowledge of

15   application programs?

16   MR. ASHER: They are shared by all application

17   programs. The ones they present are application programs.

18   And all application programs are independently executable.

19   That's his testimony as to how one of ordinary skill in the art

20   would understand the term.

21   JUDGE JEFFERSON: So he is looking at word

22   processors, spreadsheet programs, information management

23   programs and database programs. That's what he is looking at

24   to determine those.

30

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   Where is he getting the commonly-shared features

2   from?

3   MR. ASHER: His understanding of application --

4   yeah, his understanding of application programs.

5   JUDGE JEFFERSON: We're trying to define

6   application programs. So where is he getting the list of

7   commonly-shared features from to define that term?

8   MR. ASHER: From his knowledge of application

9   programs. They include all of the programs that have been

10   recited in the patent, Outlook and Excel and Microsoft Word

11   and Access. These all share these common characteristics,

12   and he focused on those characteristics which were shared

13   with any application program.

14   JUDGE JEFFERSON: And Domini uses the term

15   application program as well?

16   MR. ASHER: Yes.

17   JUDGE JEFFERSON: But he says that those are

18   application programs that have these commonly-shared

19   features. Is that correct?

20   MR. ASHER: I'm going to get to Domini and

21   explain exactly what Domini says. I think if you only look at

22   one sentence that the lawyers have identified for you, I think

23   you are subject to having a misimpression of what Domini

24   says. Domini never calls the spell checker an application

25   program.

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   JUDGE JEFFERSON: Thank you.

2   MR. ASHER: Okay. So after reviewing the

3   evidence, there is a discussion of what is in the patent, and

4   what Dr. Levy has to say with respect to one of ordinary skill

5   in the art, that evidence is consistent with the ordinary usage

6   of application program as an independently-executable

7   program, such as Microsoft Word and others recited in the

8   '854 patent.

9   That is the evidence we have for determining what

10   an application program is. So what evidence has the

11   Petitioner pointed to for any other definition? Let's look at

12   slide 9. There is nothing. There is no evidence at all.

13   There is no evidence in the record that one of

14   ordinary skill would have considered any other definition for

15   application program at the time of the application filing.

16   There is no evidence in the record that one of ordinary skill

17   would have considered a module or utility to be an application

18   program at the time of the application filing.

19   Even if the module or the utility stands alone and

20   serves a number of other application programs, it is still

21   functioning as a utility and it is not an application program

22   and there is no evidence that one of ordinary skill in the art

23   would consider it to be so.

24   At best, going through their record, we found from

25   Dr. Menasce at slide 10, paragraph 77, it kind of confirms our

32

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   approach that the second application program in the context of

2   the specification is a database program. So those database

3   programs that we have outlined are potential second

4   application programs.

5   The Petitioner seemed to rely upon the institution

6   decision for its claim construction. However, I'm pretty sure

7   that the institution decision is not evidence. And, indeed,

8   there was -- and it is rather unclear what interpretation -- I

9   really don't know what Petitioners are saying an application

10   program means.

11   What I heard today was that an application

12   program is a program with program steps that perform a

13   function. That's a program. All programs perform a function.

14   All programs have a series of steps.

15   I have not divined from the record or from

16   Petitioner's presentation how they are defining application

17   program. They seek to use the term independent and then

18   treat it as if it has no meaning. They deal with application

19   program as if the term application wasn't there.

20   You might as well just call it a program. And to

21   ignore the term application I think is clearly improper in

22   terms of claim construction.

23   What is an independent program? Is Microsoft

24   Word an independent program? Okay. Then what about the

25   spell checker that comes within Microsoft Word? In what way

33

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   is that independent? The argument is that that's an

2   independent program even though it's inside of Microsoft

3   Word? I'm not getting the connection there.

4   It actually appeared that they went further in their

5   claim construction and seek to rely on the extrinsic evidence.

6   They wanted to rely on Domini for claim construction.

7   Well, Domini is not a contemporary document with

8   the '854 patent. It was written two and a half years earlier

9   than the '854 patent. A better, more contemporary source

10   would be Hachamovitch which was written just a year earlier

11   than the '854 patent.

12   If one were to go to Domini, and Domini has -- if

13   one were construing Domini and said that its teachings were

14   inconsistent with the teachings of the '854 patent as far as

15   what an application program is, then it would be improper to

16   use such inconsistent extrinsic evidence in your claim

17   construction.

18   But, in fact, we believe Domini is entirely

19   consistent with our understanding of an application program.

20   And, again, I'm going to get there very shortly, but first take a

21   look at slide 11.

22   Here is Hachamovitch, which more clearly

23   explains how ones of ordinary skill in the art consider the

24   term application program. So you have -- and this is

25   Microsoft Word, the Microsoft Word environment. There are

34

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   application programs. 36 has its own block. And then there

2   is the program modules 37. Those are separate. Those are not

3   called application programs. And as far as Hachamovitch

4   there is the auto-complete utility -- that's separate from

5   application programs -- 100.

6   This is more in line with how those of ordinary

7   skill in the art viewed application program at the time of the

8   filing. And so to the extent that anyone is trying to use

9   Domini for claim construction, I think that's not helpful

10   unless it is actually consistent with the usage in the '854

11   patent and that understanding of those of ordinary skill in the

12   art.

13   JUDGE MEDLEY: Excuse me. Did your expert

14   clarify that point that you just made? Did they say that

15   Domini is not consistent with how one of ordinary skill in the

16   art at the time of the invention would have understood

17   application program, what that means?

18   MR. ASHER: No, I think the expert understood

19   what an application program is and found Domini consistent

20   in terms of what an application program is.

21   JUDGE MEDLEY: I thought earlier you said that

22   because Domini was two years prior --

23   MR. ASHER: If you look at it, if you were to look

24   at it and it were inconsistent, then it's extrinsic evidence that

25   should not be used in claim construction.

35

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   JUDGE MEDLEY: But that was not advanced in

2   your brief, that to the extent that they are inconsistent, here is

3   the reason why one of ordinary skill in the art would see --

4   would not understand two years prior to the claimed invention

5   that is before us that they used some application program in

6   Domini, was not how one of ordinary skill in the art would

7   have understood this?

8   MR. ASHER: Right, it is the Petitioner that

9   argues that it is inconsistent. So if you agree that it is

10 inconsistent, it is not proper extrinsic evidence for use in your

11 claim construction.

12   JUDGE MEDLEY: But you don't make that

13 argument?

14   MR. ASHER: No, I think Domini is perfectly

15 consistent with the '854 patent in terms of its usage of

16 application program.

17   JUDGE MEDLEY: Can you explain then how it is

18 consistent because I'm looking at the --

19   MR. ASHER: Yes, absolutely.

20   JUDGE MEDLEY: -- reference.

21   MR. ASHER: If you just jump right into that one

22 sentence you are going to be misled. Let me take you through

23 Domini and you will understand.

24   JUDGE MEDLEY: I'm looking at column 7,

25 beginning at line 40. If you could explain your point in light

36

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   of that paragraph, because it seems to suggest that the spell

2   checker is an application program.

3   MR. ASHER: Yes, if you look at that -- just

4   briefly I will address that sentence. It refers to application

5   programs include spell checker, grammar checker. It refers to

6   those as programs.

7   JUDGE MEDLEY: Well, it begins: Those skilled

8   in the art will understand that program modules such as an

9   operating system 36, application programs 37, referring to the

10   figure, it shows figure 1. It shows all of A, B, C, D and E of

11   37 as application programs.

12   And then it continues on, line 47 of column 7:

13   The application programs 37 may include a number of

14   different programs such as a word processing program 37A, a

15   spell checker program 37B, and a grammar checker program

16   37C. And it starts that's how one of ordinary skill in the art

17   would understand.

18   MR. ASHER: Yes, absolutely. Microsoft Word is

19   an application program and it includes a grammar checker

20   program, spell checker program, and a word processing

21   application program module. Absolutely. Microsoft Word is

22   an application program.

23   JUDGE MEDLEY: And it classifies them all as

24   application programs?

37

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   MR. ASHER: No, it calls them programs. It

2   doesn't call them application programs. It will become more

3   clear if I take you through Domini because, taken out of

4   context, we are subject to having a misimpression.

5   JUDGE MEDLEY: Okay. Well, explain then

6   where in Domini it says that, for example, the spell checker is

7   not an application program, or one of ordinary skill would

8   understand that it's not an application program.

9   MR. ASHER: Okay. What Domini -- let's turn to

10 slide 13. It never refers to the spell checker module or the

11 grammar checker module as an application program.

12   Domini, if you take a look at the figures, figure 7,

13 there is a block 720. It says: "Send spelling data to

14 application." The spell checker sends data to the application

15 program. It is not the application program.

16   What is the invention in Domini? "The present

17 invention satisfies the above-described needs by providing an

18 improved system and method for spell checking and grammar

19 checking an electronic document." So spell checking and

20 grammar checking is part of this invention.

21   The step of checking the spelling of the words in

22 the sentence also can include calling a spell checker program

23 module. It is not independently executable. It is a program

24 that is called by another program.

38

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   JUDGE BLANKENSHIP: If you look at column 10

2   of Domini, line 17, a while ago I understood you to tell us

3   that the user can't select that, but this seems to say that the

4   user can.

5   So how is that not independently executable,

6   because the user could choose to run it or not?

7   MR. ASHER: This is the user of Microsoft Word.

8   Word is already launched and running along with its utility

9   programs that are a part of Microsoft Word. So this is just

10   merely performing a function within Word.

11   JUDGE BLANKENSHIP: I'm sorry, I'm asking

12   about column 10.

13   MR. ASHER: Yes.

14   JUDGE BLANKENSHIP: Line 17. I don't see

15   Microsoft Word.

16   MR. ASHER: This whole document is about

17   Microsoft Word. Is that not clear? Domini is entirely about

18   Microsoft Word.

19   JUDGE JEFFERSON: In column 9, when it says

20   most word processor program modules, around column 9, line

21   29, only refers to Microsoft Word?

22   MR. ASHER: "Most word processor program

23   modules include spell checker modules and grammar checker

24   program modules." Okay. Other programs may be written to

25   include a spell checker and a grammar checker.

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   There are program modules that perform a function

2   within Microsoft Word, where it's the application program --

3   excuse me.

4   JUDGE JEFFERSON: I apologize for cutting you

5   off, but I want to be clear here.

6   You are saying that the entirety of Domini -- my

7   colleague was referring to column 10 and I'm referring to

8   column 9 -- is limited to Microsoft Word, period?

9   MR. ASHER: Microsoft Word is the preferred

10   embodiment. Other word processors may be included in the

11   invention.

12   JUDGE JEFFERSON: So it's the preferred

13   embodiment but it is not limited to it. Is that what you are

14   saying?

15   I'm trying to understand. You said it is limited to

16   Microsoft Word. I'm trying to understand what you mean by

17   that.

18   MR. ASHER: I don't know what sentence and line

19   you said. Certainly the claims of Domini aren't in question

20   here. It is not that it's -- Domini describes Microsoft Word.

21   JUDGE JEFFERSON: So when we were referring

22   to column 10, line 17, in the preferred program, the user

23   selects the command, column 10, lines 16 and 17, that's not

24   limited to Microsoft Word?

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Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   MR. ASHER: I don't know. It is talking about --

2   it is a little hard for me to get into this document right now,

3   but it is talking about a word processor program and how it

4   functions and that preferred embodiment is Microsoft Word.

5   Whether this happens in Word or it is certainly

6   applicable to another program that is doing the Domini

7   invention, it could be a different word processor that includes

8   a spell checker and a grammar checker. That's fine.

9   JUDGE JEFFERSON: If you don't mind me asking

10   another question. I don't want to lose too much focus.

11   The question is, so where in Domini does it say

12   that one of ordinary skill in the art would know that

13   application program that was referred to in column 7 does not

14   include grammar checker and spell checker?

15   MR. ASHER: Well, take a look at this document.

16   The next says that the CSAPI is designed to make it easy for

17   programmers to write applications that can utilize the spell

18   checking program module while being independent of the

19   underlying spell checker program module.

20   It is clearly distinguishing between applications

21   that programmers can write. And when trying to look at it

22   from the eyes of one of ordinary skill, it distinguishes

23   between those applications that programmers can write. They

24   can write word processors. It can be Microsoft Word. It can

41

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   be WordPerfect. It can be any new word processor that

2   someone chooses.

3   But those are applications and they can utilize the

4   spell checking program module. Okay? That's not referred to

5   as an application program.

6   If you look at the invention of Domini, claim 1, in

7   an electronic word processing system for creating and editing

8   a document, checking the spelling, checking the grammatical

9   composition, so spelling and grammar, grammar checkers, are

10   all part of the invention of Domini.

11   Do you see where that comes into play in the next

12   slide? "A computer-implemented process that is carried out

13   by the computer in response to input from the user and

14   instructions provided by the preferred application program

15   module," -- that's the word processor, right -- "the preferred

16   spell checker program module, and the preferred grammar

17   checker program module."

18   The word processor is the application, not the

19   spell checker and the grammar checker.

20   Then it goes on: "The preferred application

21   program module then sends a word of the sentence to the spell

22   checker program module." If the application program is the

23   word processor, as one of ordinary skill would understand,

24   and as Domini uses, and it is communicating with a spell

42

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   checker module, that's not an application. It is not referred to

2   as an application.

3   "Preferably, the spell checker program module

4   verifies the accuracy of the spelling of the word at step 715 in

5   response to a CSAPI function from the preferred application

6   program module."

7   It is always the application program module

8   communicating with this spell checker program module. And

9   for the spell checker program to actually do anything, it needs

10 to be called by an application program. It is not

11 independently executed by a user.

12   The next slide, 15, here we reference the

13 invention. I said the invention included grammar checking

14 and spell checking -- or Domini says this invention includes

15 grammar checking and spell checking. "The preferred

16 embodiment of the present invention is represented by Word,

17 version 8.0, which is a word processing application program."

18   And then it goes on to point out that "the preferred

19 program includes a spell checker program module and a

20 grammar checker program module." That's similar language

21 that we were talking about before in column 7.

22   The preferred program, Microsoft Word, which is

23 the program that includes spell checking and grammar

24 checking, that program includes a spell checker program

25 module and a grammar checker program module.

43

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   Let's look at how the petition treats this. At slide

2   16, the first application program in the claim corresponds, as

3   indicated in the petition, to "Microsoft Word, version 8.0,

4   which is a word processing application program."

5   They go on for a little bit, but they don't go too

6   far, do they? They stop the quote. They leave out a portion

7   in Domini, and so you haven't been looking at it and you

8   haven't been influenced by what is actually in Domini.

9   Take a look at 24 again. Go back to 24. The

10 preferred program includes a spell checker program module

11 and a grammar checker program module. They wouldn't want

12 you to know that because they are going to look to the spell

13 checker program again.

14   Slide 17. Here you look for a second application

15 program. And now the Petitioners refer to the second

16 application program as the spell checker program.

17   And they pull out that one sentence, that one

18 sentence from Domini, and take it out of context, which says:

19 "The application programs 37 may include a number of

20 different programs" -- and, indeed, Microsoft Word includes a

21 number of different programs -- "such as a word processing

22 program, a spell checker program, and a grammar checker

23 program."

24   Those are all programs and I understand that, but

25 they are not application programs and they don't call them

44

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   application programs. The application programs 37 include

2   those programs and certainly Domini says that. Microsoft

3   Word includes those programs. But they are not application

4   programs. One of ordinary skill in the art would understand

5   that.

6   If we look at slide 18, there is no 37. They just

7   have 37A, B, C, whatever, D, through N. Where do they put

8   -- this is the environment for Microsoft Word. He has a

9   section in a diagram where they put application programs.

10   Microsoft Word is an application program. And that's where

11   he put it.

12   They have the word processing program, the spell

13   checker program and the grammar checker program. They all

14   belong to Microsoft Word. In this document they put them all

15   in the space for application programs. Should they put them

16   somewhere else? They are all part of Microsoft Word and the

17   application programs are listed there.

18   Whether an application program includes a single

19   module or several modules, they are all contained under the

20   block application programs.

21   Nothing within Domini has transformed the spell

22   checker and the grammar checker from being a module that

23   serves an application program into an application program in

24   the eyes of those of ordinary skill in the art. Skip to slide 22,

25   please.

45

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   Now, whatever Domini calls the spell checker is

2   not really relevant. I think what the Board needs to do is this

3   claim construction, determine what a spell -- I'm sorry,

4   determine what an application program is, and determine

5   whether, on the evidence, Domini discloses a first application

6   program and a second application program.

7   So whatever one calls the spell checker program

8   module, it is not independently executable like an application

9   program. It is always responsive to a call from another

10   program. It does not run on its own independent from a

11   call-in program.

12   As confirmed by Dr. Levy and those of ordinary

13   skill in the art -- well, that's confirmed by Dr. Levy. Here is

14   his declaration: "A subsidiary module is not independently

15   executable. When an application program makes a call to a

16   subsidiary module, communication is also typically done

17   synchronously, because the call is made to obtain data or a

18   specific result from the subsidiary module."

19   Throughout Domini, you can go through it in

20   detail, the spell checker module is one that is called by an

21   application program. We went through numerous examples

22   where it is called by the application program and data is sent

23   from the spell checker back to the application program. The

24   spell checker, it is subsidiary to an application program.

46

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   JUDGE JEFFERSON: Counsel, in the '854 patent

2   itself, isn't the OneButton invoked to call the second

3   application --

4   MR. ASHER: Yes.

5   JUDGE JEFFERSON: -- to search the database?

6   Isn't that done through the same interface, at least in one

7   embodiment?

8   MR. ASHER: The OneButton would be a

9   subsidiary module and it is part of the interface of Word. So

10   it is similar to a spell checker. What we've added is, what the

11   inventor added is this additional module, the OneButton

12   program.

13   JUDGE JEFFERSON: So doesn't that do exactly

14   what you just described Domini is doing; it is just calling it

15   through the actual program?

16   MR. ASHER: Domini has a spell checker that has

17   a dictionary and does its functions and does the whole thing.

18   The OneButton is able to interact, call this second

19   application program, the Outlook -- such as Outlook or

20   another database management program.

21   JUDGE JEFFERSON: Before you move on, I want

22   to return to the same column 7 in Domini. But the first

23   sentence on line 41 says: "Those skilled in the art will

24   understand that program modules, such as an operating system

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   36, application program 37, and data are provided to personal

2   computer 10."

3   Isn't it referring to program modules there as

4   encompassing operating systems, application programs and

5   data?

6   MR. ASHER: I agree that the language is rather

7   ambiguously used and freely used in Domini.

8   JUDGE JEFFERSON: I'm trying to understand

9   what it would teach one of skill in the art. I mean, it seems to

10   say that a program module, contrary, if you will, to what you

11   are describing as being a subsidiary or narrower than an

12   application program, actually broadly describes computer

13   programs?

14   MR. ASHER: I think because of the sloppy way

15   that Domini uses module, maybe it wasn't the best term for us

16   to use, but it refers to a program or a program module.

17   What can be understood and what is consistently

18   used throughout Domini is the functions performed by the

19   spell checker module. The fact that the spell checker is

20   included within the Microsoft Word program, the fact that for

21   it to run it is called by an application program, that is

22   consistently used throughout.

23   It is referred to as -- so, okay, it is called program

24   module but it is never called an application program. It is

25   quite clear on that. And it only operates if it is called by an

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   application program. It is a function that is useful to an

2   application program.

3   Again, though, you are doing word processing, you

4   are entering text into a document, and that's where you need

5   the assistance of a helpful program like the spell checker.

6   What we invented, what -- I'm sorry, what the '854 invented

7   was a useful function like the OneButton.

8   So those are subsidiary to the program in which

9   they are contained. They make use of the interface of the

10   application program itself, the Microsoft Word.

11   If I wasn't clear about how the OneButton worked,

12   it calls the second application program, which is an

13   independently-executable program, such as Outlook. And it

14   does this without requiring the user to launch Outlook.

15   That's the whole benefit of the invention. You've

16   got this OneButton in Microsoft Word which allows you to get

17   information from another application program without needing

18   to know how to use it and have to have access to it.

19   JUDGE JEFFERSON: With respect to

20   Hachamovitch, column 7, line 65, I believe, they call their

21   utility stand-alone or application independent.

22   Wouldn't that be an application-independent

23   program?

24   MR. ASHER: An application-independent

25   program?

49

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   JUDGE JEFFERSON: The utility described in

2   Hachamovitch, they describe it can be deployed as stand-alone

3   or application independent.

4   Doesn't that indicate to one of skill in the art, you

5   said it was closer in time, I believe --

6   MR. ASHER: Yes, yes, yes.

7   JUDGE JEFFERSON: -- to the '854 specification.

8   Wouldn't that encompass an application program as described

9   in the '854?

10   MR. ASHER: What column are you at? In

11   Hachamovitch? Where did you point to?

12   JUDGE JEFFERSON: I'm sorry, column -- sorry, I

13   lost my reference here.

14   MR. ASHER: Okay. I think this is slide 43. No,

15   41.

16   JUDGE JEFFERSON: Column 7, lines 62 to 67.

17   MR. ASHER: 50, slide 50. All right. So you

18   were looking at column 7, line 62 to 67, "word completion

19   system may be deployed within an operating system or as a

20   stand-alone utility that may operate on an

21   application-independent basis." You want to know what that

22   means.

23   So Hachamovitch explains later on at column 8,

24   lines 6-14, that "to deploy the word completion system as an

25   application-independent utility, an interface is defined within

50

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   each application program." Okay? So each application

2   program can interact with the utility.

3   "An interface is defined within each application

4   program through which the word completion utility may

5   communicate with each application program." So we are

6   talking about a utility that interacts with application

7   programs. It is a useful program that an application program

8   can take advantage of.

9   Nowhere within Hachamovitch is the utility

10   referred to as an application program. So I think the word

11   independent is confusing you because that word has appeared

12   in other places in the claim construction.

13   But application-independent basis simply means

14   that the utility can be used with Microsoft Word, it can be

15   used with Excel, it can be used with other programs for which

16   they have an interface that allows them to talk to the utility.

17   But it is a utility. It is not an application program.

18   Does that answer your question?

19   JUDGE JEFFERSON: Thank you.

20   MR. ASHER: Thank you. So we went through

21   Domini, and for the bulk of Domini it is describing the spell

22   checker as a module, as ambiguous as that term might be, but

23   it is clearly, as one that is called by a word processing

24   program, an application program.

51

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   The evidence would support that those of ordinary

2   skill in the art would consider the spell checker of Word to be

3   a subsidiary of Word and not its own application program.

4   It is a little bizarre, don't you think, for the

5   petition to say that Microsoft Word is the first application

6   program and then to try to find a subsequent application

7   program, it goes inside the first application program, as if it

8   were separate. It is all one program.

9   So in that respect Domini does not support this

10   anticipation argument.

11   Now, I think there is other aspects of Domini that

12   have been referred to in this proceeding. It is referred to as

13   the stand-alone spell checker. In the prior art they talk about

14   stand-alone spell checker, but it doesn't go on to explain how

15   the stand-alone spell checker would interact with a word

16   processor.

17   Indeed, it is not integrated with the word

18   processor, which is the whole point of Domini, to integrate

19   them, and make the spell checker into a module subsidiary to

20   the word. If a spell checker is independent as a stand-alone

21   program as described in the background, then it doesn't have

22   access to the word processor.

23   So take a look at slide 24: "In other words, the

24   spell checker program modules" -- this is from Domini -- "and

25   grammar checker program modules were separate program

52

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   modules from each other and from the word processor program

2   module." And if it is separate from them, it wouldn't be able

3   to perform all of the other functions of the claim in the '854.

4   So referring to slide 26, paragraph 25 of Dr.

5   Levy's declaration: "A stand-alone spell checker program

6   module would not be capable of inserting a correctly spelled

7   word into a document concurrently being viewed and operated

8   on in a word processor application program" -- those are

9   separate programs now -- "because it would not have access to

10   the word processor application's document."

11   It is stand-alone. Indeed, if you have the

12   stand-alone spell checker program, you don't have a first

13   application program. You just have the spell checker

14   program. And someone might input a document into the spell

15   checker, into spell checker so it could operate on it, but there

16   is no -- it is separate from a word processor program. So

17   there is no first application program.

18   And the claim further requires marking without

19   user interaction, I believe, marking within the word

20   processing document would not be possible because all you

21   have is the spell checker standing independently and standing

22   alone. So that as a separate embodiment to be asserted

23   against the claims just doesn't work.

24   So there might be some confusion with regard to

25   stand-alone, because in Domini he talks about the stand-alone

53

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1 program which is independently executable. And he doesn't

2 really go into any detail, as I said, it doesn't have the

3 interaction with the word processor because that's separate.

4 　　　　　So there in Domini the spell checker might be

5 independently executable but it is not coupled with a first

6 application program. So that is just prior art, old prior art to

7 Domini, and it is a function that is not explained in any detail

8 and would not work to perform all of the steps of the '854

9 patent.

10 　　　　　Hachamovitch used the term stand-alone with

11 respect to a utility that was application-independent. So that

12 meant that -- there Hachamovitch is using it in the context of

13 you have this utility program that can be called by other

14 application programs. And that's not what Domini was

15 referring to when Domini mentioned the stand-alone.

16 　　　　　Clearly, looking at the background of Domini, the

17 next step in innovation was to integrate the spell checking

18 function into a word processor program.

19 　　　　　The Board addressed the spell checker in a

20 distributed environment but that's not asserted in the petition

21 or the reply or the Menasce declaration. So I'm going to rely

22 on Dr. Levy's declaration to address distributed environment,

23 just talking about where these programs are physically, and

24 having no impact on the fact that the spell checker is a

54

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   program that is subsidiary and is called by an application

2   program.

3   So going on to some other claims and other issues

4   that are in this case at slide 32. In Domini the spell checker

5   identifies correct words that might be inserted into a

6   document. If it does a search, the identification of these

7   corrected words comes after the search. And then the user

8   would select which corrected word it wants to insert.

9   So the insertion by the user takes place after the

10   search. That's precluded in claims 3-5, 9-11, 38-41, 45-48.

11   On its very face claim 1 talks about responding to a user

12   selection by inserting. So inserting is responsive to the user

13   selection.

14   And when you get to claim 3 it makes clear that

15   the step of inserting comprises initializing, searching and

16   retrieving. So searching here in claim 3 is a part of the

17   inserting function and, thus, by the plain language of the

18   claims 1 and 3, searching happens responsive to a user

19   selection. That does not happen in Domini.

20   Referring to slide 33, claims 22, 28, 60 and 76.

21   The operation here performed is entering additional data into

22   a database. Additional data, that's what it is talking about.

23   Referring to slide 35, claim 19 is the independent

24   claim. It talks about performing an operation related to a

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   second information. So the operation is related to a second

2   information.

3   Claim 22 is a dependent claim. The operation,

4   that operation that was related to a second information, that's

5   performed as entering additional data into a database.

6   The next slide, how it is applied in the petition.

7   Words are entered into a word processing program. That's the

8   first information. Slide 37. The second information, the

9   operation related -- second information is the list of suggested

10   corrections for a misspelled word. That's the second

11   information.

12   And slide 38, this is from the petition with regard

13   to claim 22. What do they consider to be this operation?

14   They call adding a misspelled word identified in the

15   document, so that misspelled word in the document, that was

16   the first information, and that is added into the database.

17   So here they are talking about adding the first

18   information into the database. But the claim calls for

19   additional data being entered into a database in an operation

20   that relates to the second information.

21   So the next slide, in the '854 patent one gets this

22   dialogue screen in figure 9. The additional data, if you were

23   going to enter a new address into the contacts, the address

24   from the document -- here you had a name and an address.

56

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   You went searching for the name and you got a different

2   address.

3   If you were going to take the name and address

4   from the document and add it to this contact, you would -- you

5   can add it with an indication like "business" or "home."

6   That's item 54. That's additional data that can be added to the

7   information that's being entered into the document.

8   We also have the option of button 58 for getting

9   and inputting additional data in the second, related to the

10 second information into the database.

11   Referring to slide 40 and slide 41, there is figure 1

12 of Hachamovitch again. There is application program and

13 there is utility program. You can look through the entirety of

14 Hachamovitch. The utility program is a subsidiary program

15 that gets called by an application program. It is not itself an

16 application program.

17   The petition fails to present any evidence to

18 suggest that one of ordinary skill would consider the

19 auto-complete utility to be an application program. They

20 merely list it as what they are calling an application program.

21   Slide 43 --

22   JUDGE MEDLEY: Please wrap up. You have a

23 few minutes. We asked a lot of questions so I will give you a

24 couple of extra minutes.

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   MR. ASHER: So there is mention of the

2   stand-alone utility that's mentioned in Hachamovitch. I think

3   we already dealt with that in answering your question earlier,

4   that in Hachamovitch, where it refers to a stand-alone utility,

5   that that is application independent. It is a program that may

6   be called by a number of different application programs.

7   So this is the first time you've been able to hear

8   from those of ordinary skill in the art and review how one

9   would view application program and understand it.

10   So I request that you now with all of the

11   information make an independent determination of the proper

12   meaning of claim construction as used in the '854 patent,

13   where application programs were exemplified by things like

14   Word, Excel, Outlook, programs that can be launched by a

15   user and provide their own interface and are not limited in

16   operation to being called by another program.

17   Thank you.

18   JUDGE MEDLEY: Thank you.

19   MR. FEHRMAN: I would like to start with just a

20   comment, that the Panel was asking about the reference to

21   application program in Domini.

22   And if I was counting correctly, counsel stated

23   five times that Domini never calls a spell checker an

24   application program. And yet when questioned about column

25   7, lines 41 to 50, and the specific statements of application

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   programs in the first sentence, 37, and then application

2   programs 37 include a number of different programs with

3   different small letter references, I'm not sure how to respond

4   to the assertion that Domini never calls a spell checker an

5   application program.

6   It is really kind of an unbelievable assertion. And

7   that's especially the case when we look at the corresponding

8   figure, at slide 21, figure 1 of Domini, that has all of these

9   different programs, all with the same main number and then

10   another letter to identify different application programs.

11   It is just an unequivocal disclosure in Domini of a

12   spell checker being referred to and called an application

13   program. They don't like that, but it says it.

14   Now, another comment that counsel is making was

15   the disclosure of various types of programs, database

16   programs or word processing programs. I believe that was

17   their slide 3. And that's referred to at column 9 from line 67,

18   or 65, into column 10 at line 10, with the listing of various

19   types of programs, and are word processing programs and then

20   database programs.

21   And each time it lists a number of different

22   trademark programs and concludes that with "et cetera." And

23   in the second case on the database it has "et cetera" and also

24   has a reference to flat files.

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   So it seems to be that what they are doing here is

2   inserting the term application program into the claims, and

3   then saying, well, we will let you know what that means later,

4   when we know where we need to draw the line between the

5   application program of the claims and the prior art.

6   And that doesn't seem to be the appropriate

7   approach for determining the broadest reasonable construction

8   in view of the specification, which does not use the term at

9   all.

10   What they really did, which is what the Panel

11   recognized, is picked characteristics as they chose in order to

12   have an argument to distinguish and define application

13   program based upon those selected characteristics, but there is

14   no discussion in the specification about such characteristics.

15   And just saying, well, these that we've disclosed

16   have these characteristics and we can use, that's where we

17   draw the line and then we can define or distinguish over the

18   prior art.

19   And one thing that was noticed and questioned by

20   Judge Medley is that they never had their expert say that

21   Domini is using the term application program in some way

22   that is not its ordinary and customary meaning. There is no

23   evidence in the record that Domini is some aberrant use of

24   application program.

60

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   And, interestingly, if you notice, Domini and

2   Hachamovitch have essentially the same figure 1. They use

3   some different terminology, which means there is no locked-in

4   meaning. And the broadest reasonable construction is very

5   broad if there is no customary and ordinary meaning that is

6   real clear cut here.

7   So to try to exclude something that explicitly

8   states in the specification and shows in the drawings it is an

9   application program, and then to say those are not application

10   programs based upon operational characteristics, I think is

11   not, certainly not an appropriate claim construction.

12   And another thing to keep in mind here is that both

13   Domini and Hachamovitch, those are databases. They have a

14   database of the words, the dictionary, that is used to look up

15   for potential corrections, spelling corrections, or look up an

16   address. That's a database.

17   So it is not enough to just say, well, it's a database

18   program and that distinguishes these references. They have

19   databases that are then used to put addresses in, letters or

20   spell, correct spelling words. So, again, that's not going to

21   provide any assistance to the Patent Owner in distinguishing

22   over these references.

23   Database itself is not clear as to where is the

24   database an application program versus not an application

25   program? And there is no evidence that it is appropriate to

61

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   draw the line at some stand-alone program that, I guess, has

2   the capability of working all by itself, and that's where the

3   line is drawn between an application program and another

4   program that may do, especially in the case of Hachamovitch,

5   the identical function.

6   But that's not an application program. And they

7   can do it with numerous different applications. Application

8   independence, as they call it.

9   They had another reference to Dr. Menasce, which

10   referred to database programs. Interestingly, that's in

11   paragraph 77 which relates to the means-plus-function

12   limitations and corresponding structure. So it is not a broad

13   definition of database program or providing any support for

14   the construction they are seeking.

15   And in terms of the assertions, the claim charts are

16   very clear that in Domini and Hachamovitch a word

17   processing program can be a first application program, and the

18   completion program or spell checking program can be the

19   second application program that interacts with that.

20   Just one other comment. There was a discussion, a

21   short discussion of claim 3. And as we set forth in our reply,

22   there is no limitation in order that the Patent Owner is reading

23   into that claim in order to make their arguments.

62

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   Those are the only points that I have. We have

2   one housekeeping function that Mr. Yap would like to address,

3   if he could.

4   JUDGE MEDLEY: Okay. Sure. Thank you.

5   MR. FEHRMAN: Thank you.

6   MR. YAP: Good afternoon, Your Honors.

7   Petitioner would like to request authorization to re-file the

8   Levy deposition transcript and the Menasce deposition

9   transcript in the 206 case, because they were inadvertently

10 labeled with duplicate exhibit numbers. Exhibit Number 1011

11 and Exhibit Number 1012, respectively.

12   JUDGE MEDLEY: That was part of their motion

13 to exclude, correct?

14   MR. YAP: That's correct.

15   JUDGE MEDLEY: Okay. It is noted. We are

16 going to -- can we go off the record?

17   (Whereupon, a recess was taken from 2:46 p.m. to

18 3:01 p.m.)

19   JUDGE MEDLEY: Please be seated. We are on

20 the record from the last transcript.

21   So when we ended, Petitioner requested

22 authorization to re-file two of their exhibits, 1011 and 1012,

23 and in just the 206 case?

24   MR. YAP: Yes, Your Honor.

63

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

1   JUDGE MEDLEY: Just in the 206 case. And we

2   understand the issue because those exhibit numbers were used

3   twice by the Petitioner.

4   And we have conferred and we are not going to

5   authorize the re-filing and re-labeling of those, mainly

6   because the briefing has already been submitted. We are at

7   the end of this proceeding.

8   And if we were to allow you to do that, you would

9   have to then re-file your reply brief, which refers to them, and

10   new exhibits, and it could just get messy. So we just want to

11   leave things the way that they are.

12   And now we will give you a few moments. Just let

13   me know, Court Reporter, to begin with the 208 transcript.

14   (Whereupon, at 3:02 p.m. the hearing was

15   adjourned.)

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20   //

21   //

22   //

23   //

24   //

25   //

Cases IPR2014-00206 and IPR2014-00207
Patent 7,496,854

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