

AGIS SOFTWARE DEVELOPMENT LLC
Patent Owner

IPR2018-01079

U.S. Patent No. 8,213,970

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Judges

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AGIS' EXPERT: Jaime G. Carbonell, Ph.D.

- ✓ University Professor, Allen Newell Professor, School of Computer Science, Carnegie Mellon University
- ✓ Director, Language Technologies Institute, Carnegie Mellon University
- ✓ B.S. Physics and Mathematics, Massachusetts Institute of Technology (1975)
- ✓ M.S., M.Phil., and Ph.D. degrees in Computer Science, Yale University (1976, 1977, and 1979, respectively)



See, e.g., Exhibits 2005, 2006

AGIS' EXPERT: Jaime G. Carbonell, Ph.D.

- ✓ Taught a wide variety of graduate and undergraduate courses at Carnegie Mellon falling within the general field of Computer Science (including courses in software engineering, data mining, natural language processing, electronic commerce, machine learning algorithms, system design, and AI) since 1979
- ✓ Involvement in a number of professional organizations and activities including the Association of Computing Machinery (ACM), Association for the Advancement of Artificial Intelligence (AAAI), and the Cognitive Science Society
- ✓ Leadership in professional organizations such as:
 - ✓ Chair of the ACM's Special Interest Group on Artificial Intelligence ("SIGART") (1983-1985)
 - ✓ Fellow of the AAAI (1988 to present)
 - ✓ Member of the AAAI Executive Committee (1990-1992)

See, e.g., Exhibits 2005, 2006

AGIS' EXPERT: Jaime G. Carbonell, Ph.D.

- ✓ Author or Co-Author on more than 390 technical papers directed towards computer-implemented algorithms and methods that related to machine learning (applications as mapping protein sequences to 3-D shapes, predicting protein folds, detecting financial fraud, natural language processing)
- ✓ Editor and peer-reviewer for a number of technical journals
- ✓ Recipient of:
 - ✓ The Recognition of Service Award for role as chair of SIGART
 - ✓ The Sperry Fellowship for excellence in artificial intelligence research
 - ✓ Carnegie Mellon University Computer Science Department's Teaching Award
- ✓ Technical Consultant on Computer Science Applications for variety of industrial clients including Industrial Scientific Corporation, Carnegie Group Inc., Citicorp, Dynamic Technologies, Meaningful Machines

See, e.g., Exhibits 2005, 2006

AGIS' EXPERT: Jaime G. Carbonell, Ph.D.

- ✓ **Named Inventor on a number of issued U.S. Patents:**
 - ✓ **U.S. Patent No. 5,677,835 (“Integrated Authoring and Translation System”)**
 - ✓ **U.S. Patent No. 5,995,920 (“Computer-based method and system for monolingual document development”)**
 - ✓ **U.S. Patent No. 6,139,201 (“Integrated authoring and translation system”)**
 - ✓ **U.S. Patent No. 6,163,785 (“Integrated authoring and translation system”)**
 - ✓ **U.S. Patent No. 7,406,443 (“Method and system for multi-dimensional trading”)**

See, e.g., Exhibits 2005, 2006

U.S. Patent No. 8,213,970



(12) **United States Patent**
Beyer

(10) **Patent No.:** US 8,213,970 B2
(45) **Date of Patent:** Jul. 3, 2012

(54) **METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS**

(75) **Inventor:** Malcolm K. Beyer, Jupiter Inlet Colony, FL (US)

(73) **Assignee:** Advanced Ground Information Systems, Inc., Jupiter, FL (US)

(*) **Notice:** Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 367 days.

(21) **Appl. No.:** 12/324,122

(22) **Filed:** Nov. 26, 2008

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Related U.S. Application Data

(65) Continuation-in-part of application No. 11/612,830, filed on Dec. 19, 2006, which is a continuation-in-part of application No. 11/308,648, filed on Apr. 17, 2006, now Pat. No. 7,630,724, which is a continuation-in-part of application No. 10/711,490, filed on Sep. 21, 2004, now Pat. No. 7,031,728.

(51) **Int. Cl.**
H04W 4/00 (2009.01)

(52) **U.S. Cl.** ... 455/466; 455/88; 455/404.2; 455/412.1; 455/412.2; 455/414.4; 455/415; 455/416; 455/418; 455/419; 455/420; 455/456.1; 455/456.3; 455/457; 455/458; 455/463; 455/500; 455/517; 455/518; 455/519; 455/556.2; 701/213; 701/482

(58) **Field of Classification Search** 455/41.1, 455/416, 518, 519, 41.3, 88, 404.2, 412.1, 455/414.4, 415, 418, 419, 420, 456.1, 456.3, 455/457, 458, 463; 701/213, 482

See application file for complete search history.

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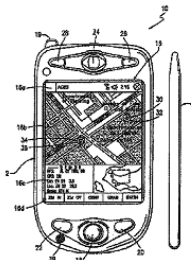
* cited by examiner

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Assistant Examiner — Ammanuel Lebassi
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(57) **ABSTRACT**

The system and method having a specialized software application on a personal computer or a PDA/cell phone that enables a participant to force an automatic acknowledgement and a manual response to a text or voice message from other participants within the same network. Each participant's PDA/cell phone includes a force message alert software application program for both creating and processing these forced message alerts. The system and method enabled by the force message alert software application program provides the ability to (a) allow an operator to create and transmit a forced message alert from a sender PDA/cell phone to one or more recipient PCs and PDA/cell phones within the communication network; (b) automatically transmit an acknowledgement of receipt to the sender PDA cell phone upon the receipt of the forced message alert; (c) periodically resend the message to the recipient PCs and PDA/cell phones that have not sent an acknowledgement; (d) provide an indication of which recipient PCs and PDA/cell phones have acknowledged the forced message alert; (e) provide a manual response list on the display of the recipient PC and PDA/cell phone's display that can only be cleared by manually transmitting a response; and (f) provide an indication on the sender PDA/cell phone of the status and content the manual responses.

13 Claims, 6 Drawing Sheets



U.S. Patent No. 8,213,970

US 8,213,970 B2

1 METHOD OF UTILIZING FORCED ALERTS FOR INTERACTIVE REMOTE COMMUNICATIONS

This application is a continuation-in-part of U.S. patent application Ser. No. 11/612,830 filed on Dec. 19, 2006 which is a continuation-in-part of U.S. patent application Ser. No. 11/308,648 filed Apr. 17, 2006 which is a continuation-in-part of U.S. patent application Ser. No. 10/711,490 now U.S. Pat. No. 7,031,728.

BACKGROUND OF THE INVENTION

1. Field of the Invention

A communications system and method that uses a plurality of PCs and PDA/cell phones for the coordination of two or more people through the use of a communications network.

The system and method provide a user with a PC or PDA/cell phone that has forced message alert software that enables a user to create and send a voice or text message alert that forces an automatic acknowledgement upon receipt and a manual response from the recipient.

2. Description of Related Art

The purpose of a communications system is to transmit information bearing digital messages from a source, located at one point, to a user destination, located at another point some distance away. A communications system is generally comprised of three basic elements: transmitter, information channel and receiver. One form of communication in recent years is cellular phone telephony. A network of cellular communication systems set up around an area such as the United States allows multiple users to talk to each other, either on individual calls or on group calls, with handheld devices. Some cellular phone services enable a cellular phone to engage in conference calls with a small number of users. Furthermore, cellular conference calls can be established through 800 number services. Cellular telephony also now includes the ability to access local WiFi connections, allowing the devices to utilize cellular phone data transmission technology as well as the data transmission ability of the Internet.

The method and operation of the integrated PDA/cell phones (cell phone/PDA/GPS with touch screen) used herein is described in U.S. Pat. No. 7,031,728, which is hereby incorporated by reference, pending U.S. patent application Ser. No. 11/308,648, and pending U.S. patent application Ser. No. 11/612,830, and are usually discussed herein as a cell phone.

In many situations it is desirable for a user to be able to simultaneously send a message to the cell phones or PCs of a large group of people. This can be typically accomplished using Digital SMS (Smart Message Service) and TCP/IP messages that are transmitted using cellular technology such as the various versions of GSM and CDMA or via a WiFi local area network. However, in some situations it is additionally desirable to know: (a) which people received the message on their cell phone or PC, (b) which people did not receive the message on their cell phone or PC, and (c) the response of each person receiving the message. Digital SMS and TCP/IP messages do not provide each of those functions. As a result, what is needed is a method in which a sender of a text or voice message can force an automatic acknowledgement upon receipt from a recipient's cell phone or PC and a manual response from the recipient via the recipient's cell phone or PC when sending the text or voice message.

2 SUMMARY OF THE INVENTION

Applicant's communication system and method described herein is embodied in the forced alert software developed by applicant and installed in the PCs and PDA/cell phones used herein.

A plurality of PCs and PDA/cell phones each having forced alert software installed providing a communication network of PCs and PDA/cell phones with the ability to: a) allow an operator to create and transmit (via TCP/IP or another digital transmission means) a forced voice alert, wherein said forced voice alert is comprised of a text or voice message file and a forced alert software packet, from a sender PC or PDA/cell phone to one or more recipient PCs and PDA/cell phones within said communication network.

Each recipient PC or PDA/cell phone is configured to: a) receive the recipient PC or PDA/cell phone; (b) provide an acknowledgement until an acknowledgement is received from every recipient PC and PDA/cell phone; (d) provide an indication on the display of the sender PC or PDA/cell phone of which recipient PCs and PDA/cell phones have acknowledged the forced message alert; (e) provide a manual response list on the display of the recipient PC and PDA/cell phone's display that can only be cleared by manually selecting and transmitting a response from the list or recording and transmitting a voice response after sending said automatic acknowledgement; and (f) provide an indication on the sender PC or PDA/cell phone of the status the manual response and the content of the manual response from each recipient PCs and PDA/cell phones.

A communication network server can act as a forwarder for TCP/IP communications between any combination of PC users or PDA/cell phone users. The server can also act as a forwarder of data addressed from one participant to one or more addressed participants, thus permitting the transmission of forced text or voice messages, other messages, photographs, video, E-mail and URL data from one network participant to other selected network participants.

The above functions can also be accomplished using WiFi, WiMax or other peer to peer communications. However, for use with cellular communications and to assure the level of security that cell phone companies require, a centralized static IP routable server is used.

It is the object of this invention provide to a method in which by sending a forced text or voice message to a recipient or a group of recipients, a sender can compel an automatic acknowledgement of receipt from each recipient's PC or PDA/cell phone and require a manual response from the recipient via the recipient's cell phone before the message can be cleared.

In accordance with these and other objects which will become apparent hereinafter, the instant invention will now be described with particular reference to the accompanying drawings.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1a shows a front elevational view of an integrated PDA/cell phone having a touch screen that includes forced message alert software described herein.

FIG. 1b shows a flow chart that explains the device shown in FIG. 1a.

1. Field of the Invention

A communications system and method that uses a plurality of PCs and PDA/cell phones for the coordination of two or more people through the use of a communications network. The system and method provide each user with a PC or PDA/cell phone that has forced message alert software that enables a user to create and send a voice or text message alert that forces an automatic acknowledgement upon receipt and a manual response from the recipient.

IPR2018-01079

- Petitioner filed 10 petitions for *inter partes* review directed the '970 Patent and related patents—IPR2018-01079 is one of two IPRs that were instituted.
- Petitioner petitions for *inter partes* review of claims 1 and 3-9 of the '970 Patent.
- Petitioner raises three grounds for *inter partes* review based on five references: Kubala, Hammond, Pepe, Johnson, and Banerjee.

The Instituted Claims

The Board granted institution on **claims 1 and 3-9** of the '970 Patent .

Ground 1: “[W]e find that Petitioner has made a sufficient showing for purposes of institution. We discuss limitations **1.2, 1.5, and 1.6** and **Petitioner’s rationale to combine** below.”

Grounds 2-3: “At this stage, we are not persuaded that this provides sufficient rationale to combine across all limitations of claim 1.”

Grounds 2-3: “Petitioner’s rationale is less than one page. Pet. 56–57 .”

Decision Granting Institution, Paper 9 at 23, 35.

The Instituted Claims

Ground 2-3: “Petitioner’s argument regarding rationale to combine Johnson with Pepe does not explain sufficiently why or how a skilled artisan would have modified the software in Pepe to include an algorithm that performs the steps of requiring a required manual response by the recipient in order to clear the recipient’s response list from the recipient’s cell phone display.”

Ground 2-3: “Petitioner does not identify any such algorithm in Pepe. This, combined with Petitioner’s reliance on Johnson for disclosure of the specified function, suggests Petitioner relies on Johnson for the corresponding algorithm.”

Decision Granting Institution, Paper 9 at 35-36.

The Instituted Claims

Ground 2-3: “We do not discern any identification in the Petition of where or how the asserted references disclose a “forced message alert software packet.”

Ground 2-3: “However, Petitioner does not explain how the messages transmitted in these references comprise a voice or text message and a forced message alert software packet attached thereto.”

Decision Granting Institution, Paper 9 at 36.

Claim 1

1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

- a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;
- a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;
- a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;
- a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;
- means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;
- means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;
- means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;
- means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and
- means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.

Exhibit 1001, claim 1

Claim 6

1. A method of sending a forced message alert to one or more recipient PDA/cell phones within a predetermined communication network, wherein the receipt and response to said forced message alert by each intended recipient PDA/cell phone is tracked, said method comprising the steps of:

- accessing a forced message alert software application program on a sender PDA/cell phone;
- creating the forced message alert on said sender PDA/cell phone by attaching a voice or text message to a forced message alert application software packet to said voice or text message;
- designating one or more recipient PDA/cell phones in the communication network;
- electronically transmitting the forced message alert to said recipient PDA/cell phones;
- receiving automatic acknowledgements from the recipient PDA/cell phones that received the message and displaying a listing of which recipient PDA/cell phones have acknowledged receipt of the forced message alert and which recipient PDA/cell phones have not acknowledged receipt of the forced message alert;
- periodically resending the forced message alert to the recipient PDA/cell phones that have not acknowledged receipt;
- receiving responses to the forced message alert from the recipient PDA/cell phones and displaying the response from each recipient PDA/cell phone; and
- providing a manual response list on the display of the recipient PDA/cell phone that can only be cleared by the recipient providing a required response from the list;
- clearing the recipient's display screen or causing the repeating voice alert to cease upon recipient selecting a response from the response list required that can only be cleared by manually selecting and transmitting a response to the manual response list.

Exhibit 1001, claim 6

Ground 1

Kubala does not disclose:

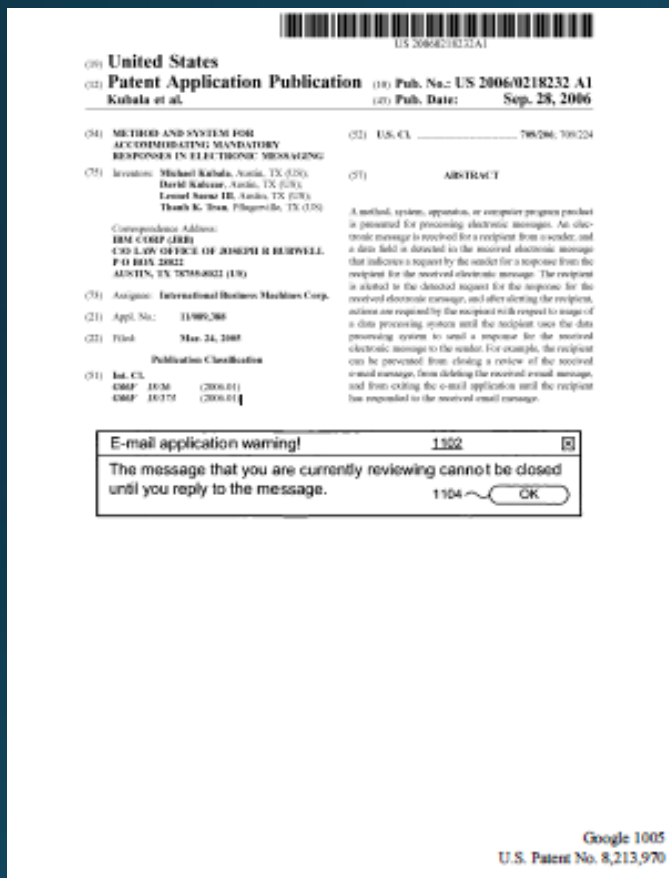
- *requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display*

Kubala and Hammond do not disclose:

- *forced message alert*
- *“displaying a listing” of which phones have automatically acknowledge and have not acknowledged the forced message alert*
- *displaying a listing which recipient PDA/cell phones have transmitted a manual response to said forced message alert*

Paper 17 at 14-28.

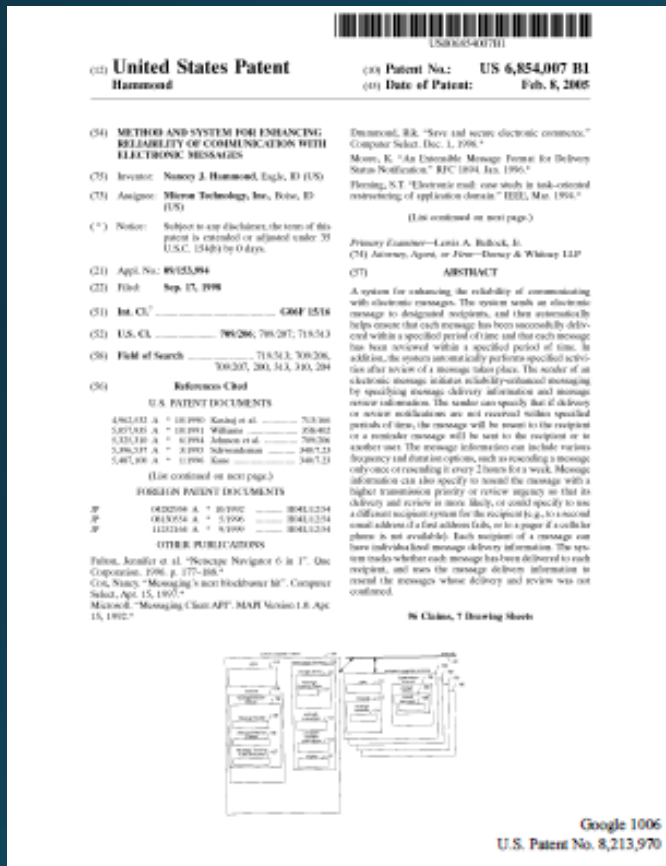
The Kubala Reference (Exhibit 1005)



- Kubala is directed to an e-mail application.
- Kubala's e-mail message is **voluntarily opened** by the recipient.
- Kubala provides warning windows, which are not e-mails.

Paper 17, at 3-4

The Hammond Reference (Exhibit 1006)



- Hammond discloses an e-mail application system utilizing data structures **stored** on a server to implement a **"Message Tracking Table,"** which is **not displayed."**
- Hammond's e-mails are **voluntarily opened** by the recipient.

Paper 17 at 4; Ex. 1006, 3:41-42; Ex. 2007, Williams Dep., 82:22-84:7.

Ground 1

Kubala does not disclose:

- *requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display*

Kubala and Hammond do not disclose:

- *forced message alert*
- *“displaying a listing” of which phones have automatically acknowledge and have not acknowledged the forced message alert*
- *displaying a listing which recipient PDA/cell phones have transmitted a manual response to said forced message alert*

Paper 17 at 14-28.

Claim 1

1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

- a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;
- a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;
- a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;
- a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;
- means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;**
- means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;
- means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;
- means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and
- means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.

Exhibit 1001, claim 1

Forced Message Alert

Kubala and Hammond fail to disclose: *forced message alert.*

“It is my opinion that neither Kubala nor Hammond nor their combination discloses the claimed ‘forced message alert.’”

Exhibit 2005, Carbonell Decl. ¶ 34.

Kubala

Kubala fails to disclose: *forced message alert*

Petitioner identifies Kubala's "e-mail message 214" that "may be a text message" without providing explanation regarding whether the **e-mail message corresponds to the claimed *forced message alert* or the claimed text message.**

Kubala does not disclose that its **conventional e-mail messages** are *forced* to the display without any action by the recipient.

- Kubala discloses that **a recipient manually selects and opens the e-mail message.**
- Kubala discloses that **the selection is the user's voluntary choice.**

Paper 17 at 15-16; Exhibit 1005, Fig. 7

Kubala

Kubala discloses that a recipient manually selects and opens the e-mail message.

[0047] With reference now to FIG. 7, a flowchart depicts a process in which a recipient opens an email message that contains a mandatory response flag. The process commences with the recipient, i.e. the receiving user, selecting a control within an e-mail application to open an e-mail message (step 702), and the e-mail application opens the selected e-mail message (step 704). The e-mail application may optionally show a special indication that the selected e-mail message requires a mandatory response (step 706), and the process of opening the message is concluded. The e-mail application may indicate the presence of a mandatory response flag: using a message within a pop-up window; other information within a status bar; through the use of colors on a display screen; or through some other means of alerting the user.

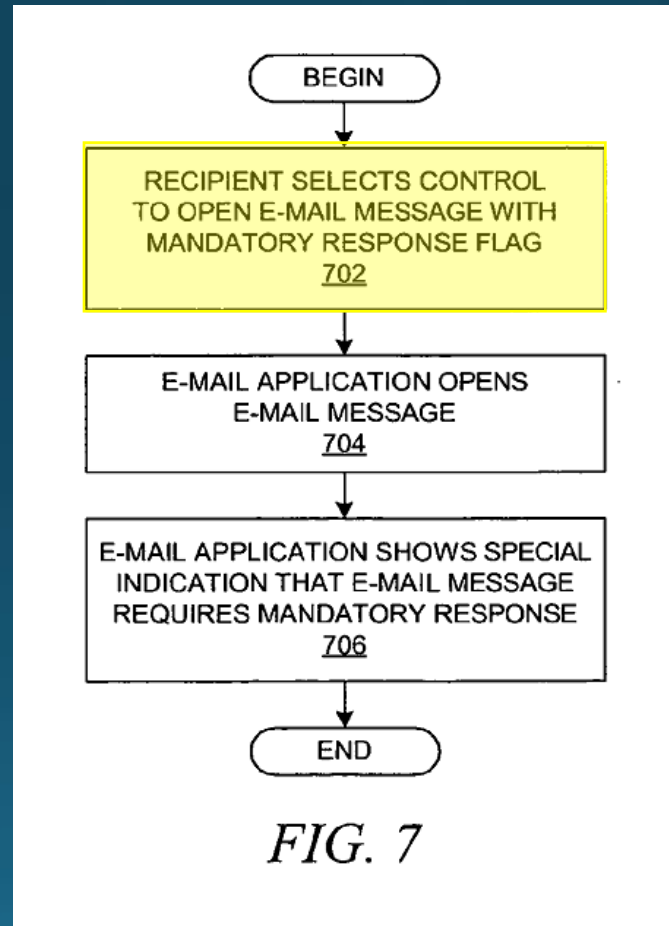
Exhibit 1005 ¶ 0047

16 A. There's three steps. The first is,
17 recipient selects control to open email message with
18 mandatory response flag. The second is, email

Exhibit 2007, Williams
Dep. at 60:16-21

Kubala

Kubala discloses that the selection is the user's voluntary choice, not a *forced message alert*.



Forced Message Alert

The '970 Patent expressly describes that the nature of the receipt and presentation of the text message within the *forced message alert* is automatic.

- “When the forced text or voice alert is received, the user operator is presented with the requested response list.” Exhibit 1001, 7:20-24.
- “Immediately following the detection of the forced message alert, the forced message alert software application program on the recipient PC or PDA/cell phones prepares and electronically transmits an automatic acknowledgement of receipt to the sender . . . [and] effectively takes control of the recipient PC or PDA/cell phone.” Exhibit 1001, 8:25-39.

Paper 17 at 16-17.

Forced Message Alert

The '970 Patent describes that upon receipt and automatic acknowledge of a forced message alert with a text message,

- “the *forced message alert software application program* causes the text message and the response list to be shown on the display of the recipient until selection of a manual response from the response list.” Exhibit 1001 at 8:37-44.
- A recipient is not permitted to ignore the *forced message alert*.
- Kubala’s e-mail message can be disregarded, and cannot satisfy the *forced* element of the claims.

Paper 17 at 17.

Forced Message Alert

Petitioner disregards the *forced* nature of the claims.

- Petitioner cannot point to the response list to meet the *forced* limitation.
- The *forced message* can contain the response list, but the response list does not necessarily include the forced message.

37. Clearly, Petitioner disregards the “forced” nature of the claims and merely presents evidence regarding the alleged “response list,” which is a separate claim limitation. While the forced message can contain the response list, a response list does not necessarily include the forced message. The specification of the '970 patent further teaches that it is clear the response list does not even need to be sent along with a forced message. Ex. 1001, 7:56-58 (“The response list from which the message receiver must select can either be included in the forced alert message or be preloaded in each phone.”) Thus because a response list alone

Forced Message Alert

- The response list does not have to be sent along with the *forced message*:

pants. The response list from which the message receiver must select can either be included in the forced alert message or be preloaded in each phone. The forced alert message is

Paper 17 at 17; Exhibit 1001 at 7:56-58.

Ground 1

Kubala and Hammond do not disclose or suggest the claimed *forced message alert*.

1. Petitioner inconsistently maps the term *forced message alert* to a single element of Kubala.
2. Petitioner does not identify or explain whether *forced message alert* corresponds to (1) Kubala's e-mail message 214 or the warning message 1112, or any other element in Kubala.
3. Petitioner does not explain how Kubala's e-mail message 214 is *forced*.

Paper 27 at 7-15.

Forced Message Alert

Petitioner inconsistently maps the term *forced message alert* to a single element of Kubala.

- Petitioner maps both Kubala's *email message 214* and *warning message 1112* shown in Figure 11C to *forced message alert*.
- Petitioner mapped:
 - Kubala's e-mail message 214 to the claimed voice or text message;
 - Kubala's flag 216 to the forced message alert software packet; and
 - Kubala's menu 1120 of Fig. 11C to the claimed list of possible required responses.

Forced Message Alert

Petitioner does not show or explain how Kubala's e-mail message 214 is forced.

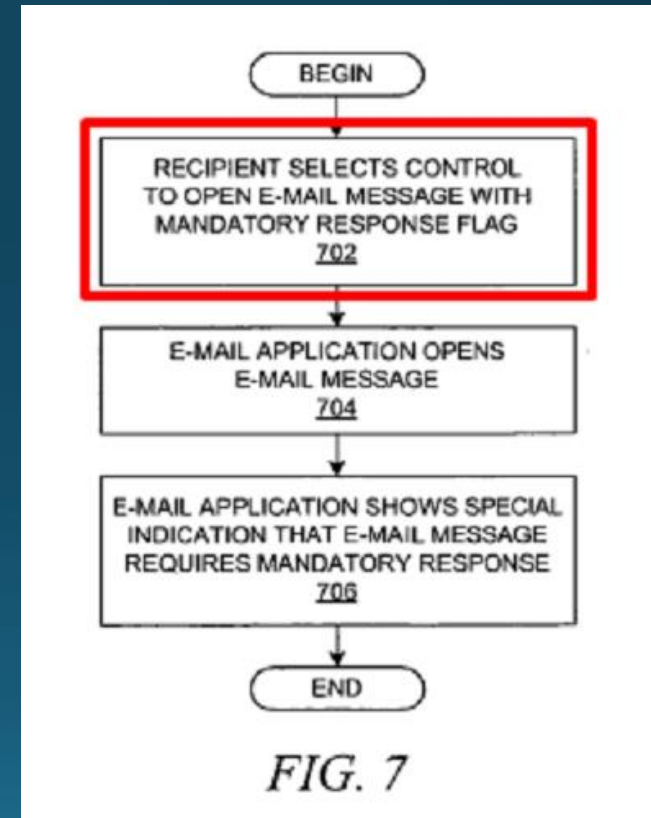
- The e-mail message is voluntary or optional—not forced.
- Petitioner attempts to *read out* the **forced** requirement to reduce the invention to a conventional e-mail message that can sit unopened and disregarded.
- Mr. Williams testified he did not conduct an analysis as to whether the forced message alert required display of the message and acknowledge of the alert to be forced by the software.

Paper 27 at 11-14.

Forced Message Alert

The e-mail message is voluntary or optional—not forced.

35. Petitioner submits that Kubala alone discloses these limitations despite failing to show how the conventional e-mail messages are forced. Kubala does not disclose that its conventional e-mail messages are forced to the display without any action on the part of the recipient. Petitioner identifies an “e-mail message 214” that “may be a text message,” but Petitioner does not explain whether the e-mail message corresponds to the claimed forced message alert or the claimed text message. Pet. at 28-29. In each embodiment of Kubala, as depicted below, a recipient manually selects and opens the e-mail message. Ex. 1005 at 0047; Ex. 2007, Williams Deposition at 60:16-21 (“There’s three steps. The first is, recipient selects control to open the email message...”). Since the selection is the user’s choice it cannot be a “forced message alert.”



Paper 27 at 11-12; Exhibit 2005, Carbonell Dec. ¶ 35.

Forced Message Alert

Petitioner attempts to *read out* the *forced* requirement to reduce the invention to a conventional e-mail message that can sit unopened and disregarded, despite its own Petition conceding the '970 Patent is directed to *forced message alerts*.

The application was filed on November 26, 2008. (Google 1002, '970 Pros. Hist., p. 44.) Unlike the previous applications in the priority chain, the application that led to the '970 patent was directed to “forced message alerts”—i.e., electronic messages that required the recipient to respond. The '970 patent explains that “[t]he heart of the invention lies in the forced message alert software application program provided in each PC or PDA/cell phone.” ('970 patent, 4:47-49.) These forced message alerts “allow[] a participant to send a text or voice message to a group of people and force an automatic acknowledgement of receipt and a manual response.” (*Id.*, 3:22-28.)

Paper 27 at 12; Pet. at 6.

Forced Message Alert

The '970 Patent makes clear the forced message alert software *forces the message and list of responses to the display*

Kubala and Hammond do not display a listing of which phones have auto-acknowledged or transmitted a manual response—only teach storage of data about read receipts in a table in memory.

Paper 27 at 14.

Forced Message Alert

Mr. Williams testified he did not conduct an analysis as to whether the forced message alert required display of the message and acknowledgement of the alert to be forced by the software.

5	Do you agree that the forced
6	message alert does not require display without
7	any action by the recipient user?
8	A. As far as I can recall, this is
9	the first time I've seen this sentence, so
10	I'd -- I'd have to read the broader
11	discussion, as well as go back to the patent.
12	I couldn't answer yes or no just based on
13	seeing this for the first time.

Paper 27 at 14; Exhibit 2008 at 32:5-13.

Claim 1

1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

- a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;
- a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;
- a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;
- a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;
- means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, **said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;**
- means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;
- means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;
- means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and
- means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.

Exhibit 1001, claim 1

said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient

- Kubala teaches a **flag 216**
- Kubala's background section teaches that "one prior art solution" is a **priority flag**
- Kubala's background section then contrasts the **priority flag** in one prior art solution with "other prior art solutions" such as **return receipts**.

[0006] Productivity-enhancing features have been added to e-mail applications to assist workers in handling the larger workload that is represented by the larger volume of e-mail. Prior art solutions have provided the ability to mark an e-mail message with a priority **flag that indicates** a normal priority, a high priority, or a highest priority, thereby allowing an employee to identify and respond to the most important e-mail messages from the sender's perspective. Other prior art solutions have provided the ability to generate return **receipts to the** sender when the sender's e-mail message is received at its intended destination or when the recipient opens the e-mail message, thereby providing an acknowledgment that a particular message has been received and/or opened.

Paper 17 at 18-22; Paper 12 at 2-3;
Exhibit 1005 at ¶ 0006.

said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgement to the sender PDA/cell phone as soon as said forced message alert is received by the recipient

- Petitioner did not argue obviousness between Kubala and the other prior art read-receipt solutions to disclose this limitation
- The Board *sua sponte* makes the obviousness argument for Petitioner, relying on the unrelated opinion from the Williams declaration
- The improper obviousness argument made by the Board, and not the Petitioner, should be disregarded

Claim 1

1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

- a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;
- a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;
- a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;
- a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;
- means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;
- means **for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;**
- means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;
- means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and
- means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.

Exhibit 1001, claim 1

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display

Kubala fails to disclose:

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display.

“It is my opinion that Kubala does not disclose a single embodiment in which selection of a response from the response list is required in order to clear the response list from recipient's cell phone display.”

Exhibit 2005, Carbonell Dec. ¶ 38.

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display

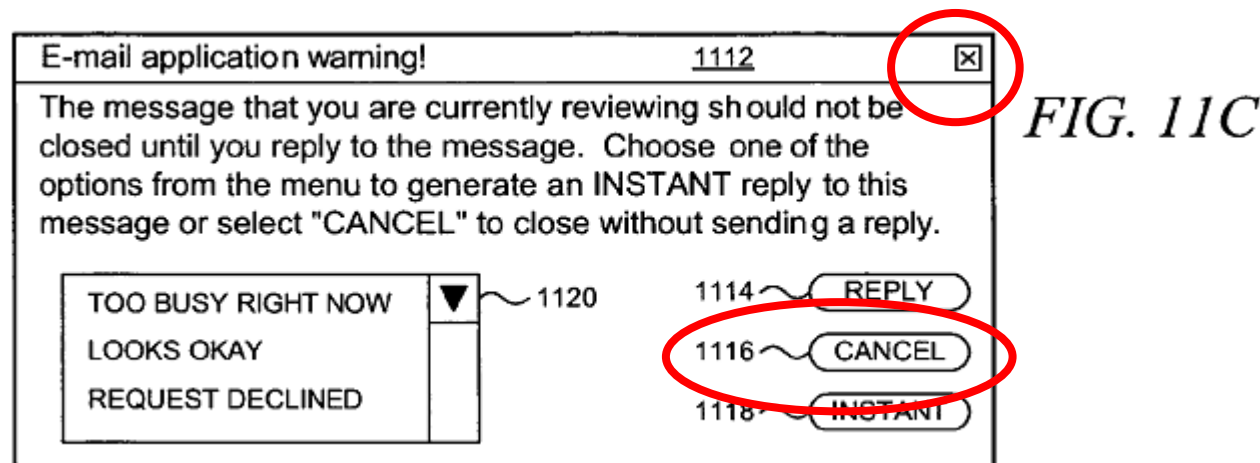
Kubala does not disclose a **single embodiment** in which selection of a response from a response list is required in order to clear the response list from the recipient's cell phone display.

38. It is my opinion that Kubala does not disclose a single embodiment in which selection of a response from the response list is required in order to clear the response list from recipient's cell phone display. Claim 1 expressly recites "requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display." Claim 6 similarly recites "providing a manual response list on the display of the recipient PDA/cell phone that can *only* be cleared by the recipient providing a required response from the list." (emphasis added)

Paper 17 at 18; Exhibit 2005, Carbonell Dec. ¶ 38.

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display

Petitioner submits that the **menu 1120** of **Figure 11C** contains the claimed response list, but later acknowledges that a response is not required in order to clear the response list:



Although the specific embodiment illustrated in Figure 11C shows that a user can “select ‘CANCEL’ to close without sending a reply,” Kubala also

Exhibit 1005 Fig. 11C; Pet. at 31.

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display

Petitioner alleges generally that other embodiments disclose:

- preventing the recipient from closing a review of the received e-mail message;
- deleting the e-mail message; and
- exiting the e-mail application until the recipient has responded to the e-mail message.

Pet. at 30-32.

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display

- However, Petitioner does not present an obviousness analysis or motivation to combine the distinct embodiments.
- Petitioner's general allegations points to different embodiments that lack menu 1120, the claimed *response list*.
- Petitioner's embodiments point to clearing the *received message* from the display, not the claimed response list from the display.

Paper 17 at 21-22.

Claim 1

1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

- a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;
- a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;
- a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;
- a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;
- means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;
- means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;
- means for receiving and **displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;**
- means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and
- means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.

Exhibit 1001, claim 1

displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert

Kubala and Hammond fail to disclose:

displaying a listing which recipient PDA/cell phones have transmitted a manual response to said forced message alert.

“It is my opinion that Kubala and Hammond do not disclose or suggest displaying a listing of which recipient phones have automatically acknowledged and have not acknowledged the forced message alert, as recited in claims 1 and 6.”

Exhibit 2005, Carbonell Decl. ¶ 42.

displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert

Petitioner concedes that the required function is to “*receive and display a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert.*”

Kubala’s collection and recording of information does not disclose or suggest a displaying a listing.

automatically acknowledge receipt of an electronic message, (*see id.*, ¶0006.) In addition, Kubala explicitly discloses that **the receiving e-mail application may collect and record information** about the manner in which the recipient responds to an e-mail message that has a mandatory-response flag. The information may

Pet. at 11, 32.

displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert

Petitioner relies on Hammond's Message Tracking Tables.

- Petitioner relies on the Williams Declaration, who merely parrots the conclusion regarding the accessibility of the message, not the required display.
- Mr. Williams conceded during his deposition that Hammond's Message Tracking Table is located and stored in the server's memory.

6	Q.	And this is the Message Tracking Table
7		that's in the storage device within the input device of
8		the server in Figure No. 1, correct?
9	A.	Correct.

displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert

Mr. Williams also testified that the existence of the Message Tracking Table itself is insufficient to show the table is displayed.

14 Q. But the table itself is the listing,
15 correct? I understand that the routines may be
16 implicated to disclose or allege disclosure of the
17 limitation, as a whole, but I'm just talking about one
18 discrete claim element, the listing. Is the listing
19 the table?

20 A. Well, a table in a database is storing the
21 element of the listing. How the data gets into and out
22 of and actually displays, is above and beyond, but
23 related to, obviously, the actual table structure. So
24 I just don't want to say the listing is the table,
25 because that doesn't tell the whole story.

Pet. at 11; Exhibit 2007 at 75:14-25

displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert

Mr. Williams conceded the table alone is a “data structure” that is not displayed, and it would be “nonsensical” to say the Message Tracking Table corresponded to the claimed listing.

```
2           Q.   So the table itself is not displayed,  
3 correct?  
4           A.   The table in Figure 2 is a data structure  
5 that would -- is very large, such that it is much more  
6 of an internal data structure than how any information  
7 would be displayed on a user screen.
```

Pet. at 11; Exhibit 2007 at 84:2-7.

displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert

- Petitioner must demonstrate that Hammond shows more than the Message Tracking Table to disclose this limitation.
- There is no disclosure or suggestion of the Message Receipt Tracker or Message Tracking Table Processor displaying anything, much less a list pertaining to automatic acknowledgements or mandatory forced message alerts.

Paper 17 at 25-26; Exhibit 2005, Carbonell Dec. ¶ 44.

Claim 1

1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

- a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;
- a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;
- a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;
- a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;
- means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;
- means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;
- means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;
- means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and
- means for receiving and **displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert** and details the response from each recipient PDA/cell phone that responded.

Exhibit 1001, claim 1

displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert

Kubala and Hammond fail to disclose:

displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert.

“It is my opinion that Kubala and Hammond do not disclose or suggest ‘displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert,’ as required in claim 1.”

Exhibit 2005, Carbonell Decl. ¶ 45.

displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert

Kubala's disclosure of *collecting and recording status codes* and Hammond's *Message Tracking Table* do not meet the claimed limitation.

- Hammond's Message Tracking Table is not displayed.
- Descriptions of the Message Receipt Tracker and Message Tracking Table Processors components do not disclose displaying a listing from the Message Tracking Table.

Paper 17 at 27.

displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert

Mr. Williams concedes the claimed **mandatory responses** differ from the claimed **automatic acknowledgements**.

```
19           Q.  Okay.  Mandatory responses are different
20  from automatic acknowledgments, correct?
21           A.  Correct.
```

Petitioner does not reconcile how the same table entries for **automatic acknowledgements** also qualify as **manual responses**, despite Mr. Williams testimony that the two must be different.

Exhibit 2007 at 59:19-21.

Grounds 2 and 3

Hammond, Johnson, Pepe and Banerjee do not disclose:

- *forced message alert*
- *requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display*
- *“displaying a listing” of which phones have automatically acknowledge and have not acknowledged the forced message alert*
- *displaying a listing which recipient PDA/cell phones have transmitted a manual response to said forced message alert*

Paper 17 at 28-39.

Grounds 2-3

The Board found Grounds 2-3 insufficient. Patent Owner agrees.

Grounds 2-3: “At this stage, we are not persuaded that this provides sufficient rationale to combine across all limitations of claim 1.”

Grounds 2-3: “Petitioner’s rationale is less than one page. Pet. 56–57 .”

Decision Granting Institution, Paper 9 at 23, 35.

Grounds 2-3

Ground 2-3: “Petitioner’s argument regarding rationale to combine Johnson with Pepe does not explain sufficiently why or how a skilled artisan would have modified the software in Pepe to include an algorithm that performs the steps of requiring a required manual response by the recipient in order to clear the recipient’s response list from the recipient’s cell phone display.”

Ground 2-3: “Petitioner does not identify any such algorithm in Pepe. This, combined with Petitioner’s reliance on Johnson for disclosure of the specified function, suggests Petitioner relies on Johnson for the corresponding algorithm. .”

Decision Granting Institution, Paper 9 at 35-36.

Grounds 2-3

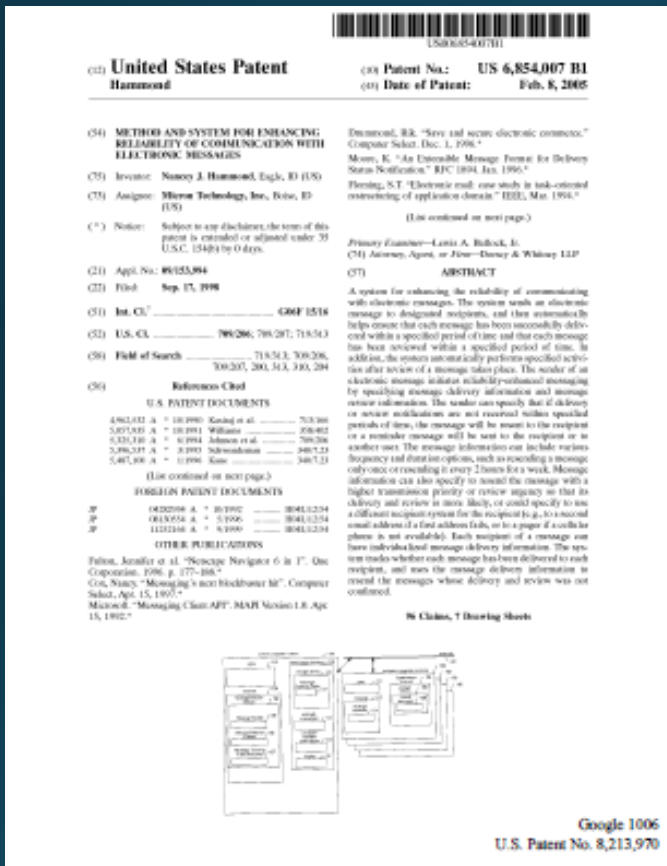
Ground 2-3: “We do not discern any identification in the Petition of where or how the asserted references disclose a “forced message alert software packet.”

Ground 2-3: “However, Petitioner does not explain how the messages transmitted in these references comprise a voice or text message and a forced message alert software packet attached thereto.”

Decision Granting Institution, Paper 9 at 36.

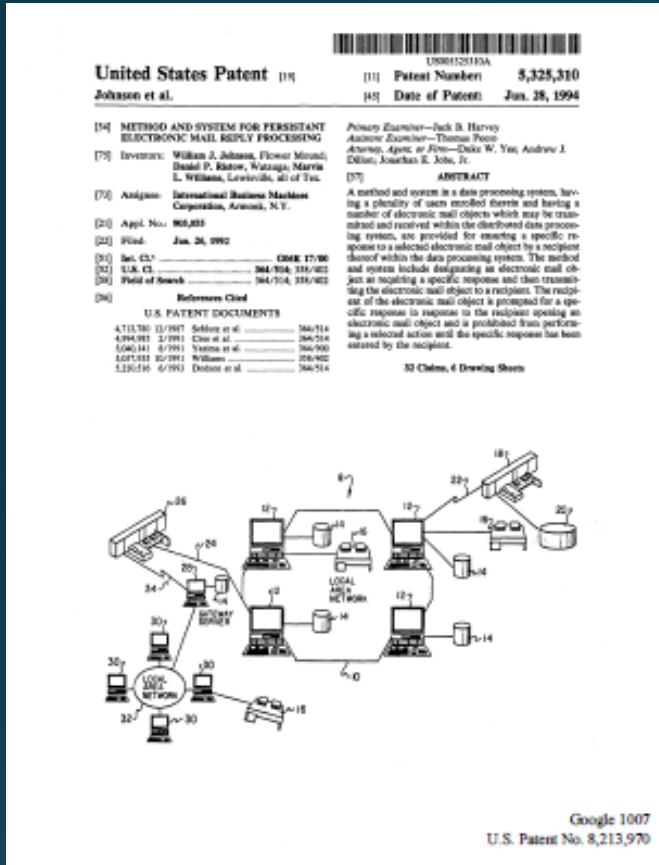
The Hammond Reference (Exhibit 1006)

- Hammond discloses an e-mail application system utilizing data structures stored on a server to implement a “Message Tracking Table.”



Paper 17 at 4; Ex. 1006, 3:41-42; Ex. 2007, Williams Dep., 82:22-84:7.

The Johnson Reference (Exhibit 1007)

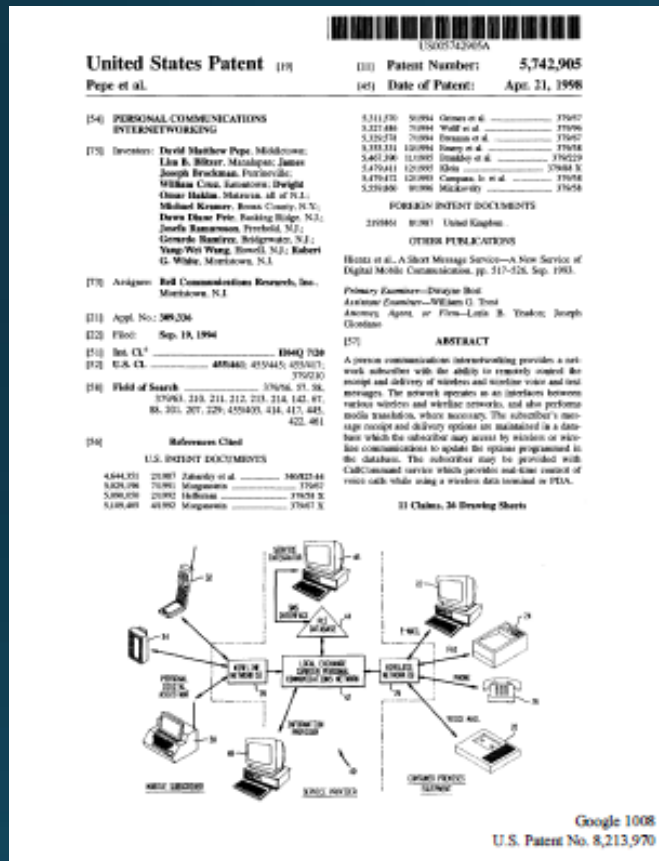


- Johnson is an electronic mail reply system. Ex. 1007 at 1:8-17.

Google 1007
 U.S. Patent No. 8,213,970

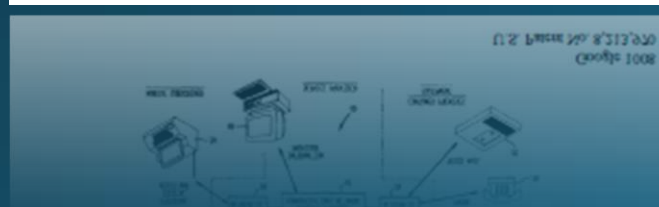
U.S. Patent No. 8,213,970
 Google 1007

The Pepe Reference (Exhibit 1008)

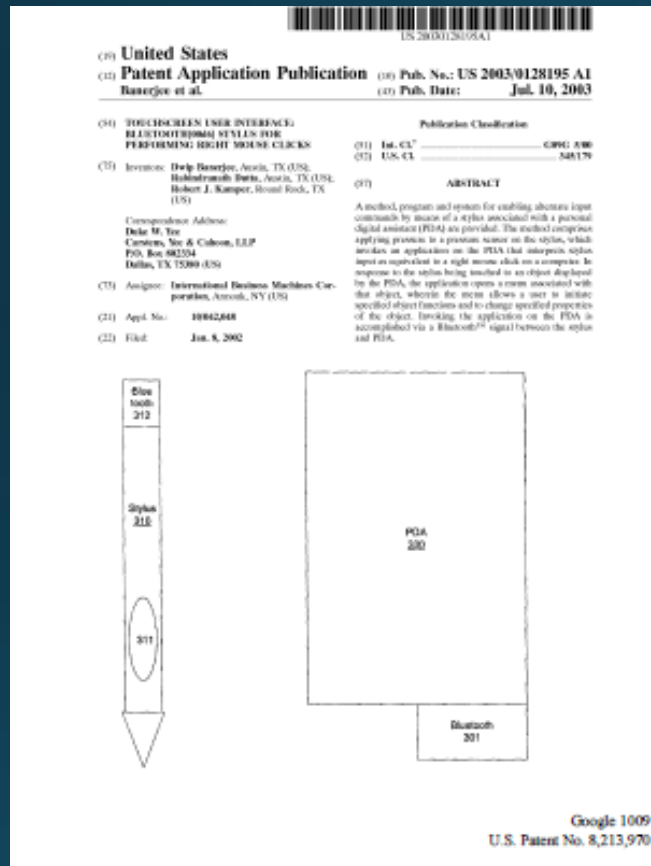


- Pepe is a personal communications internetworking network for sending voice and text. Ex. 1008 at 5:28-56.

- “Pepe does not describe forced responses.” Paper 17, Institution Dec., at 35.



The Banjeree Reference (Exhibit 1009)



- Banjeree is directed to inputting commands via a stylus. Ex. 1009 at [0007].



Claim 1

1. A communication system for transmitting, receiving, confirming receipt, and responding to an electronic message, comprising:

- a predetermined network of participants, wherein each participant has a similarly equipped PDA/cell phone that includes a CPU and a touch screen display a CPU and memory;
- a data transmission means that facilitates the transmission of electronic files between said PDA/cell phones in different locations;
- a sender PDA/cell phone and at least one recipient PDA/cell phone for each electronic message;
- a forced message alert software application program including a list of required possible responses to be selected by a participant recipient of a forced message response loaded on each participating PDA/cell phone;
- means for attaching a forced message alert software packet to a voice or text message creating a forced message alert that is transmitted by said sender PDA/cell phone to the recipient PDA/cell phone**, said forced message alert software packet containing a list of possible required responses and requiring the forced message alert software on said recipient PDA/cell phone to transmit an automatic acknowledgment to the sender PDA/cell phone as soon as said forced message alert is received by the recipient PDA/cell phone;
- means for requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display;
- means for receiving and displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert;
- means for periodically resending said forced message alert to said recipient PDA/cell phones that have not automatically acknowledged the forced message alert; and
- means for receiving and displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert and details the response from each recipient PDA/cell phone that responded.

Exhibit 1001, claim 1

Forced Message Alert

Hammond, Johnson, Pepe, and Banerjee fail to disclose:

forced message alert

“It is my opinion that Hammond and Johnson fail to disclose the claimed ‘forced message alert.’”

Exhibit 2005, Carbonell Dec. ¶ 47.

Forced Message Alert

The Board found that each and every element is not disclosed or suggested by the references in Grounds 2-3.

Patent Owner argues that Petitioner does not identify what element in the prior art discloses a “forced message alert software packet,” as recited in limitation 1.5. At this stage we agree with Patent Owner. We do not discern any identification in the Petition of where or how the asserted references disclose a “forced message alert software packet.” Petitioner asserts that Hammond, Johnson, and Pepe alone each disclose transmission of a forced message alert to a recipient computer. Pet. 60. Petitioner cites to various disclosure in each reference. *Id.* However, Petitioner does not explain how the messages transmitted in these references comprise a voice or text message and a forced message alert software packet attached thereto. *Id.*

Paper 9 at 36.

Forced Message Alert

Petitioner does not show how Hammond's *electronic messages* and Johnson's **electronic message objects** are *forced*.

messages.” However, Mr. Williams and Petitioner do not explain whether the electronic messages correspond to the claimed forced message alert or the claimed voice or text message. Pet. at 60-61. In each embodiment of Hammond, as

Exhibit 2005, Carbonell Dec. ¶ 48.

Forced Message Alert

Petitioner does not explain whether the electronic messages correspond to the claimed *forced message alert* or the claimed *voice or text message*.

- In Hammond, a recipient is provided the option of manually accessing and reviewing the message.

reviewed a successfully delivered message. A few transmission systems allow the sender to request notification when an electronic message is received by a recipient and when it is accessed (e.g., opened by an application program with which the recipient can review the message) by the recipient.

Exhibit 1006 at 1:47-51.

Forced Message Alert

- In Johnson, a user may be prompted for a response “in response to opening an electronic mail object.”

A method and system in a data processing system, having a plurality of users enrolled therein and having a number of electronic mail objects which may be transmitted and received within the distributed data processing system, are provided for ensuring a specific response to a selected electronic mail object by a recipient thereof within the data processing system. The method and system include designating an electronic mail object as requiring a specific response and then transmitting the electronic mail object to a recipient. The recipient of the electronic mail object is prompted for a specific response in response to the recipient opening an electronic mail object and is prohibited from performing a selected action until the specific response has been entered by the recipient.

Exhibit 1007, Abstract.

Forced Message Alert

- Review of the message is optional and dependent on user action to open the message, not *forced*.

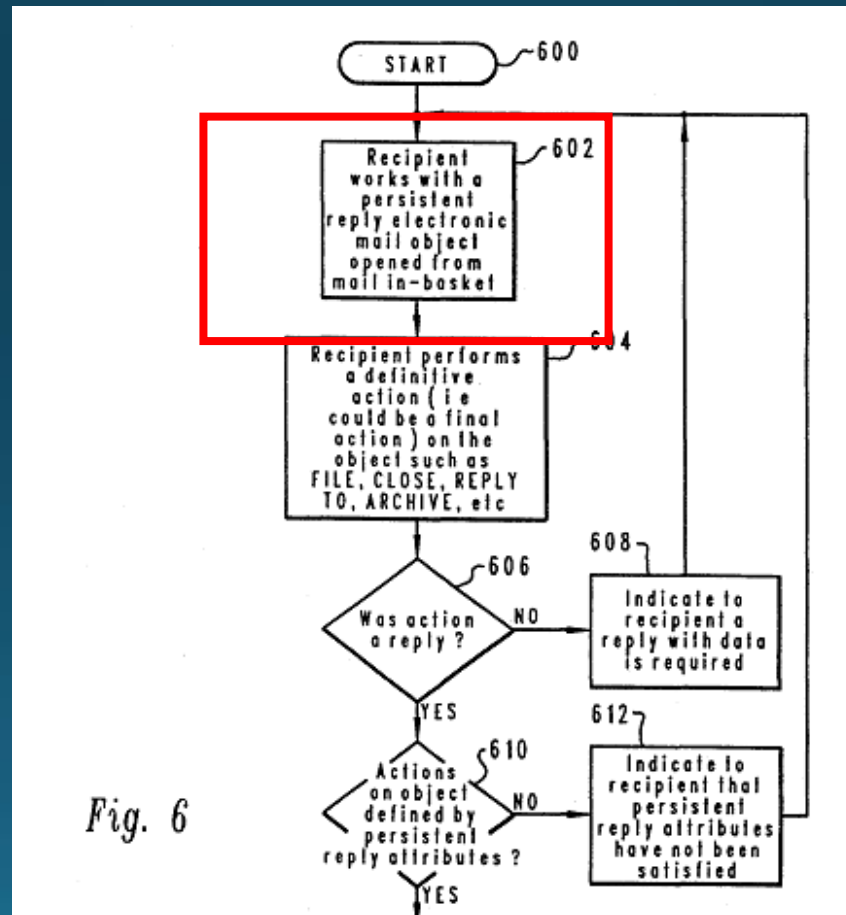


Fig. 6

Exhibit 1007, Fig. 6.

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display

Hammond, Johnson, Pepe, and Banerjee fail to disclose:

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display.

“It is my opinion that the combinations presented in Grounds 2-3 do not disclose a single embodiment in which selection of a response from the response list is required in order to clear the response list from recipient's cell phone display.”

Exhibit 2005, Carbonell Dec. ¶ 50.

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display

Petitioner submits that Pepe's **call command settings menu for configuring a forwarding message** and Johnson's **electronic mail object that "cannot be exited out of until the appropriate reply has been made"** disclose this limitation.

Petitioner fails to provide submit a motivation to combine an e-mail application with a call-forwarding settings menu.

Pet. at 74; Paper 17 at 32.

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display

Petitioner fails to show any selection of Pepe's response list is required in order to clear a display of the response list.

If the subscriber has connected the Call Command and an incoming call is received, a screen such as that illustrated in FIG. 43 is displayed. This screen displays in a box 712 the number from which the incoming call originates. **The user has the option of sending a message** and forwarding the call by clicking box 714, forwarding the call without a message by clicking box 716, sending a message and not forwarding the call by clicking box 718, or routing the call to voice mail by clicking box 720.

Exhibit 2005, Carbonell Dec. , ¶ 51; Exhibit 1008, 36:24-29.

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display

Pepe discloses that each of the options can be cancelled and selection is not required to clear the response list.

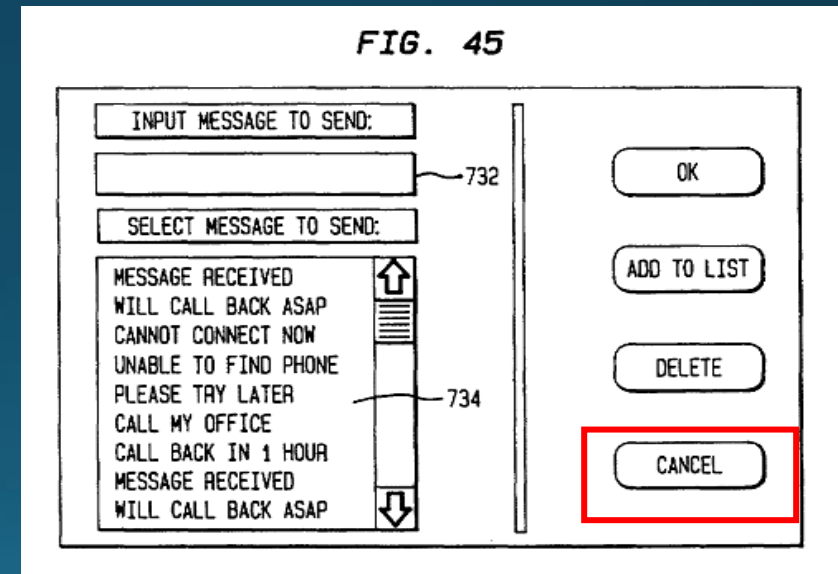
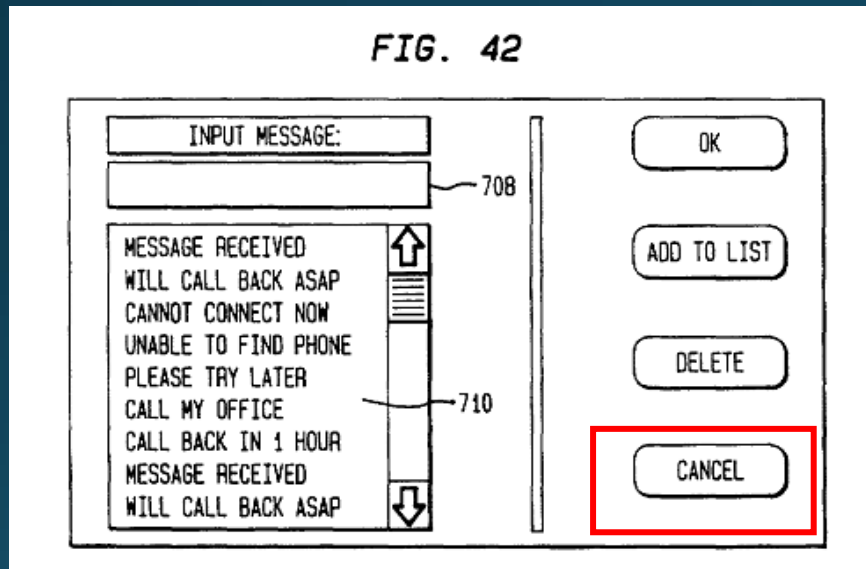


Exhibit 1008, Figure 42 and 45.

requiring a required manual response from the response list by the recipient in order to clear recipient's response list from recipient's cell phone display

Petitioner attempts to combine Pepe and Johnson to meet this limitation has several critical deficiencies:

1. Petitioner's conclusory statement does not indicate the message is *forced*;
2. Hammond's response can be a blank-email with no content;
3. Petitioner does not present an obviousness analysis or motivation to combine the distinct embodiments beyond conclusory allegations; and
4. Johnson's disclosure relates to clearing the *received electronic mail object*, not clearing the claimed response list from the display.

Exhibit 2005, Carbonell Dec. ¶ 53.

displaying a listing of which phones have automatically acknowledged and have not acknowledged the forced message alert

Hammond fails to disclose:

***“displaying a listing”* of which phones have automatically acknowledged and have not acknowledged the forced message alert.**

“It is my opinion that Hammond does not disclose or suggest displaying a listing of which recipient phones have automatically acknowledged and have not acknowledged the forced message alert, as recited in claims 1 and 6.”

Exhibit 2005, Carbonell Dec. ¶ 54.

displaying a listing of which phones have automatically acknowledged and have not acknowledged the forced message alert

Petitioner submits Hammond's collection and recordation of information meets the limitation of *displaying the required listing*.

- Mr. Williams parrots the bare conclusion limited to whether the listing is **accessible, not displayed**.
- Mr. Williams conceded during his deposition that Hammond's Message Tracking Table is located and stored in the server's memory.

6 Q. And this is the Message Tracking Table
7 that's in the storage device within the input device of
8 the server in Figure No. 1, correct?
9 A. Correct.

displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert

Mr. Williams also testified that the existence of the Message Tracking Table itself is insufficient to show the table is displayed.

14 Q. But the table itself is the listing,
15 correct? I understand that the routines may be
16 implicated to disclose or allege disclosure of the
17 limitation, as a whole, but I'm just talking about one
18 discrete claim element, the listing. Is the listing
19 the table?

20 A. Well, a table in a database is storing the
21 element of the listing. How the data gets into and out
22 of and actually displays, is above and beyond, but
23 related to, obviously, the actual table structure. So
24 I just don't want to say the listing is the table,
25 because that doesn't tell the whole story.

Exhibit 2007 at 75:14-25.

displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert

Mr. Williams conceded the table alone is a “data structure” that is not displayed, and it would be “nonsensical” to say the Message Tracking Table corresponded to the claimed listing.

2 Q. So the table itself is not displayed,
3 correct?
4 A. The table in Figure 2 is a data structure
5 that would -- is very large, such that it is much more
6 of an internal data structure than how any information
7 would be displayed on a user screen.

Exhibit 2007 at 84:2-7.

displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert

Hammond must show more to disclose this limitation:

56. Mr. Williams admits that the “Message Tracking Table” is not the displayed listing required by the claims and that much more would be required of a reference to disclose or suggest “displaying a listing of which recipient PDA/cell phones have automatically acknowledged [and] have not automatically acknowledged the forced message alert.” Mr. Williams and Petitioner essentially admit that it lacks factual support to disclose this limitation. Petitioner and Mr. Williams do not submit any knowledge or understanding of a person of ordinary skill in the art to disclose the function of displaying the required listing. The Petition itself does not describe any other listing or process related to a listing in the prior art references beyond Hammond’s “Message Tracking Table” of Figure 2. While Mr. Williams does not submit any specific teaching to disclose

displaying a listing of which recipient PDA/cell phones have automatically acknowledged the forced message alert and which recipient PDA/cell phones have not automatically acknowledged the forced message alert

There is no disclosure or suggestion of the **Message Receipt Tracker** or **Message Tracking Table Processor** displaying anything, much less a list pertaining to automatic acknowledgments or mandatory forced message alerts.

With respect to the Message Receipt Tracker, Hammond generally describes a server component that receives notifications about receipt, stores information about the notification in the Message Tracking Table, and resets timers. Ex. 1006, Figure 4 and 10:5-47. With respect to the Message Tracking Table Processor, Hammond generally describes a server component that tracks the expiration of timers and generates and sends follow-up reminders to message recipients according to pre-specified settings. Ex. 1006, Figures 5A-5B and 10:48-11:48. There is no disclosure or suggestion of the Message Receipt Tracker or Message Tracking Table Processor displaying anything, much less a list pertaining to automatic acknowledgements or mandatory forced message alerts. Mr. Williams does not

displaying a listing which recipient PDA/cell phones have transmitted a manual response to said forced message alert

Hammond fails to disclose:

displaying a listing which recipient PDA/cell phones have transmitted a manual response to said forced message alert.

“It is my opinion that Hammond does not disclose or suggest ‘displaying a listing of which recipient PDA/cell phones have transmitted a manual response to said forced message alert,’ as required in claim 1.”

Exhibit 2005, Carbonell Dec. ¶ 57.

displaying a listing which recipient PDA/cell phones have transmitted a manual response to said forced message alert

Like the previous limitation, the claimed **Message Tracking Table** is not displayed and the descriptions of the **Message Receipt Tracker and Message Tracking Table Processor components** are devoid of any disclosure regarding “displaying a listing from the ‘Message Tracking Table.’”

Mr. Williams concedes the claimed **mandatory responses** differ from the claimed **automatic acknowledgements**.

```
19           Q.   Okay.  Mandatory responses are different
20  from automatic acknowledgments, correct?
21           A.   Correct.
```

Exhibit 2007 at 59:19-21.

displaying a listing which recipient PDA/cell phones have transmitted a manual response to said forced message alert

Petitioner does not reconcile how the same table entries for **automatic acknowledgements** also qualify as **manual responses**, despite Mr. Williams testimony that the two must be different.

Grounds 2 and 3

Petitioner proposes new mappings in its Reply (Paper 21) not included in the Petition.

- Petitioner does not map the claimed *forced message alert software packet* to any element in **Hammond** or **Johnson** in the Petition.
- In its Reply, Petitioner introduces new theories that **Hammond**'s "message delivery information" and **Johnson**'s "persistent reply attribute" correspond to *forced message alert software packet*.
- Petitioner improperly presents new theories in its Reply.

Paper 27 at 15-17.

Forced Message Alert Software Packet

For the first time, Petitioner adopts new theories that Hammond’s “message delivery information” and Johnson’s “persistent reply attribute” correspond to the claimed *forced message alert software packet*. Paper 22 at 1-2.

“[A] reply may only respond to arguments raised in the corresponding opposition or patent owner response.” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016).

Forced Message Alert Software Packet

Petitioner cannot assert new theories raised for the first time in its Reply brief and Supplemental Williams Declaration.

Mr. Williams confirmed that he did not proffer any opinions with these new mappings in his declaration.

14	Q. And in the next paragraph, do
15	you see any recitation of message delivery
16	system -- I'm sorry -- message delivery
17	information?
18	A. No.
22	Q. Yes. In this same explanation
23	that you just reviewed on pages 60 to 61, do
24	you see any recitation of persistent reply
25	attribute?
3	A. Those words do not show up in
4	any of those three paragraphs.

Exhibit 2008 at 18:14-18, 22-25; 19:3-4.