

Patent Owner's Oral Hearing Demonstratives

Facebook, Inc., Instagram, LLC, and Whatsapp, Inc.
(Petitioners)
v.
BlackBerry Limited (Patent Owner)

Case Nos. IPR2019-00925
U.S. Patent Nos. 8,209,634

Before Hon. Miriam L. Quinn, Gregg I. Anderson, Robert L. Kinder

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Background

The '634 Patent

Prior Art Deficiencies

**Defects in Petitioner's Obviousness
Theory**

Petitioner’s obviousness theory involves multiple layers of modification

- 1) modifying Ordning’s computer to have “wireless communications capabilities of the mobile terminal in Abiko” (Pet., 31 (analysis of **preamble**));
- 2) further modifying Ordning’s computer to store “the e-mail program of Abiko” so that it is launched using an icon on Ordning’s userbar 600 (Pet., 33-34 (analysis of **claim element 1[a]**) (“software control program in Abiko,” and “e-mail program of Abiko in userbar 600 of Ordning”));
EX2017, 33:4-12; and

- 3) even further modifying Ordning’s icon to display a count of the number of distinct senders of new messages (Pet., 39-41 (analysis of **claim element 1[c]**).

Moreover, even after Petitioners assume these first three layers of modifications are implemented to alter Ordning’s original computer, the Petition then relies on at least two additional layers of proposed modifications to Abiko’s e-mail program that now supposedly resides on Ordning’s altered computer:

- 4) modifying Abiko’s e-mail program “to separately store new messages” by adding a “New mail folder” and a “Main mail folder” in “the same way” mentioned in Crumlish (Pet., 44); and
- 5) modifying Abiko’s e-mail program by creating a sender information menu—in addition to the newly added “New mail folder”—that is

Prior Art Deficiencies

Modification to Ording's computer to store "the e-mail program of Abiko" - Element 1[a]

Petitioner’s third layer of modification is deficient

Proposed modifications to Ording’s computer based on Abiko:

- 1) modifying Ording’s computer to have “wireless communications capabilities of the mobile terminal in Abiko” (Pet., 31 (preamble)).
- 2) modifying Ording’s computer to store “the e-mail program of Abiko” so that it is launched using an icon on Ording’s userbar 600 (Pet., 33-34 (element 1[a])).
- 3) modifying Ording’s icon to display a count of the number of distinct senders of new messages (Pet., 39-41 (element 1[c])).

Proposed additional modifications to resulting system:

- 4) modifying Abiko’s e-mail program “to separately store new messages” by adding a “New mail folder” and a “Main mail folder” in “the same way” mentioned in Crumlish (Pet., 44).
- 5) modifying Abiko’s e-mail program by creating a sender information menu—in addition to the newly added “New mail folder”—that is generated “by processing only the messages in the new message folder.” (Pet., 44).

No articulated motivation for modifying Ording’s computer hardware to store “the e-mail program of Abiko”

Petitioner’s case-in-chief:

(Ording, 7:47-52.) Ording specifically suggests permanently adding “e-mail applications” to the userbar 600. (Ording, 8:64-67 (“Candidate items for such permanent residency on the userbar 600 include, for example, application folders, favorites, address book, clock, web browser and e-mail applications.”)) It would thus have been obvious to render the application icon for the e-mail program of Abiko in userbar 600 of Ording. (Chatterjee, ¶80.)

Petition, 34

Patent Owner’s Response:

Instead, the Petition contends it is enough that Ording tersely mentions an entire genus of “e-mail applications,” without any explicit specific reasoning in the analysis of claim element 1[a] as to why a POSITA would have selected Abiko’s particular species of an e-mail application from the mere mention of a broad genus. Pet., 33-34. The law requires it; the Petition ignored it. *Knauf Insulation, Inc. v. Rockwool Int’l A/S*, 788 Fed. Appx. 728, 2019 U.S. App. LEXIS 30634, 2019 U.S.P.Q.2D (BNA) 392768, *10 (Fed. Cir. 2019). To be clear, even if Ording mentioned a genus (all possible “e-mail applications” to be launched) in which Abiko described one particular species (Abiko’s specific e-mail program), that assumed fact is not enough “to provide an ordinary artisan with a reason to cherry-pick components [] to lead to the claimed invention.” *Id.* Indeed, the Federal Circuit recently explained:

Response, 18; 2d Surati Dec., EX2013, ¶145

Knauf Insulation, Inc. v. Rockwool Int’l A/S, 788 Fed. Appx. 728, 733: “It is not enough, even after KSR, to support a determination of obviousness that a reference includes a broad generic disclosure and a common utility to that in the claims and other prior art references—there **must be some reason to select a species from the genus.**” (emphasis added)).

FISH Sur-Reply, 1

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No articulated motivation for modifying Ording's computer hardware to store "the e-mail program of Abiko"

Copied into
declaration

Petition:

As noted, Ording explains that a tile in the userbar 600 can contain an icon corresponding to an application frequently used by the user:

Applications can be presented on the userbar 600 by, for example, one of two methods. First, the application's icon can be added to the userbar 600 as a permanent fixture, e.g., for most frequently launched applications. Alternatively, the application may not be a permanent fixture of the userbar 600, but may be added thereto because it is currently running.

(Ording, 7:47-52.) Ording specifically suggests permanently adding "e-mail applications" to the userbar 600. (Ording, 8:64-67 ("Candidate items permanent residency on the userbar 600 include, for example, application folders, favorites, address book, clock, web browser and e-mail applications.")). It would thus have been obvious to render the application icon for the e-mail program of Abiko in userbar 600 of Ording. (Chatterjee, ¶80.)

Petition, 34

TQ Delta, LLC v. Cisco Sys., 942 F.3d 1352, 1362-63 (Fed. Cir. 2019): An "ipse dixit declaration" from a petitioner cannot provide substantial evidence support for an obviousness decision, and thus reversed the Board's finding of obviousness.

Response, 22; 2d Surati Dec., EX2013, ¶48; Sur-Reply, 12

Dr. Chatterjee:

80. As noted, Ording explains that a tile in the userbar 600 can contain an icon corresponding to an application frequently used by the user:

Applications can be presented on the userbar 600 by, for example, one of two methods. First, the application's icon can be added to the userbar 600 as a permanent fixture, e.g., for most frequently launched applications. Alternatively, the application may not be a permanent fixture of the userbar 600, but may be added thereto because it is currently running.

(Ording, 7:47-52 (underlining added).) Ording specifically suggests permanently adding "e-mail applications" to the userbar 600. (Ording, 8:64-67 ("Candidate items for such permanent residency on the userbar 600 include, for example, application folders, favorites, address book, clock, web browser and e-mail applications.")). It would have been obvious to render the application icon for the e-mail program of Abiko in userbar 600 of Ording.

Chatterjee Dec., EX1102, ¶180

No articulated motivation for modifying Ording's computer hardware to store "the e-mail program of Abiko"

Dr. Chatterjee was asked about element 1[a] during cross-examination.

Q. Turning now to Paragraphs 79 through 82.

These paragraphs are your analysis of Claim

Elements 1-A, the displaying step from Claim 1, correct?

A. They are. But as I explained earlier, this refers back a lot as well. And then if you read the first sentence in Paragraph 79, it states "This limitation adds little to what I described above."

So it is including what I've described in the previous section, the Paragraphs 67 -- or I'm sorry -- from 65 to 78 as well as the summaries that I provided earlier. So in general, yes. These are providing my analysis for Claim Element 1-A, but I just want to be clear that it's referencing back a lot.

Q. So you're saying when you refer to this limitation, this limitation being Claim 1-A, and it's addressed by what's in the preceding paragraphs in addition to what you see in these paragraphs here?

A. Yes. Specifically the analysis related to the preamble as well as the summary of the prior art.

Sur-Reply, 8; EX2017, 30:21-32:10

No articulated motivation for modifying Ording's computer hardware to store "the e-mail program of Abiko"

The Reply attempts to recast "other disclosures in the Petition" as providing motivation for the modification of Element 1[a]. Reply, 3.

Petition, p. 31 - Preamble

Rationale and Motivation to Combine: It would have been obvious to combine Ording with Abiko, predictably resulting in the user's computing device in Ording having the **wireless communications capabilities** of the mobile terminal in Abiko. (Chatterjee, ¶70.) A person of ordinary skill would have had many motivations to combine. (*Id.*, ¶¶70-75.)

Petition, p. 43 – Element 1[c]

Rationale and Motivation to Combine (With Crumlish): With respect to **this limitation**, the combination of Ording, Abiko, and Crumlish would have predictably resulted in the application icon shown in the userbar **600** of Ording being **visually modified**, in response to receiving at least one of the plurality of messages, **to display a numeric character showing the number of senders who have sent unread messages**, as disclosed in Abiko in view of Crumlish. (Chatterjee, ¶99.)

Petition, p. 45 – Element 1[c]

Rationale and Motivation to Combine (Ording, Abiko and Crumlish): Additional motivations to combine can be identified in connection with **this claim limitation** that further strengthen the combination. To begin with, a person of

Henny Penny (Fed. Cir. 2019): confirming it was proper for the Board to "hold[] [Petitioner] to the obviousness theory in its petition," and "an IPR petitioner may not raise in reply 'an entirely new rationale'" (emphasis added). Sur-Reply, 5

Reply Theory (p. 3, 8-9)

The Petition explained that a person of ordinary skill in the art would have been motivated to combine Ording with Abiko because Abiko provided wireless communications capabilities not disclosed in Ording. (Ex. 1102, ¶¶67, 71-73.) **This motivation is not only relevant to Patent Owner's first so-called modification (which Patent Owner does not dispute), but also the second.** The Petition explained that discouraged use of other email applications such as the one in Abiko. As explained above, Abiko provided specific advantages, including **wireless communication and the ability to automatically display messages by sender.** Patent Owner does not

No articulated motivation for modifying Ording’s computer hardware to store “the e-mail program of Abiko”

Petitioner’s legal error:
The law “does not” require motivations to combine on a feature-by-feature basis. Reply, 5.

And even if the law required motivations to combine on a feature-by-feature basis (which it does not), the Petition identified a specific benefit of Abiko’s email

1311 (Fed. Cir. 1992)) (underlining added). A motivation to combine the teachings of Ording and Abiko was provided by the benefit of adapting Abiko’s wireless capabilities, the sufficiency of which is not challenged by Patent Owner.

Authority:

- *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1069 (Fed. Cir. 2018)
- *Cutsforth v. Motivepower*, 636 Fed. Appx. 575, 577-79 (Fed. Cir. 2016)
- *In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002)
- *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000)
- *Stingray Digital Group Inc. v. Music Choice*, IPR2017-01191, Paper 38 (PTAB Oct. 11, 2018)

A mere showing of motivation to provide “wireless capabilities” does not unburden Petitioner from articulating motivation for distinct modifications of storing/executing Abiko’s particular species of “e-mail program.”

No articulated motivation for modifying Ording’s computer hardware to store “the e-mail program of Abiko”

Petitioner’s legal error:

Surati Depo., Ex. 1130, 90:24-91:10.) It would not have required any leap of logic or inventiveness for a skilled artisan, already armed with Ording and Abiko and the indisputably compelling justification to combine described above, to consult Abiko for a suitable email application for use with the userbar of Ording.

Reply, 5

Authority:

“But that reasoning seems to say no more than that a skilled artisan, **once presented with the two references**, would have understood that they could be combined. **And that is not enough.**”

PersonalWeb Techs., LLC v. Apple, Inc., 848 F.3d 987, 993-94 (*Fed. Cir.* 2017)
(*emphasis added*)

A mere showing of motivation to provide “wireless capabilities” does not unburden Petitioner from articulating motivation for distinct modifications of storing/executing Abiko’s particular species of “e-mail program.”

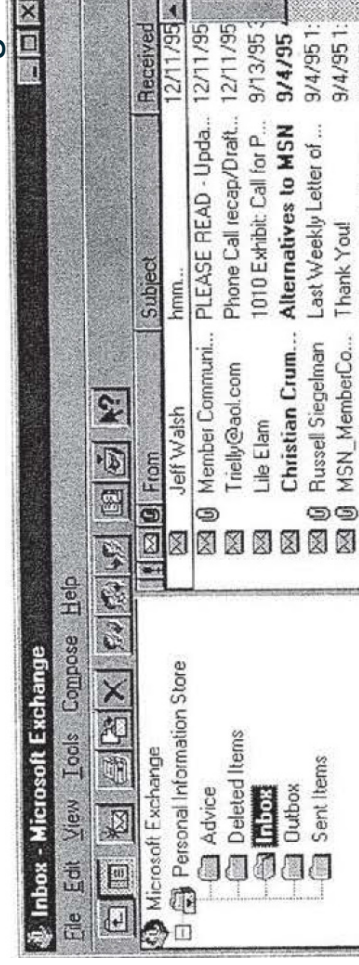
Petitioner’s belated theory still fails to articulate a motivation to modify Ording’s computer to store “the e-mail program of Abiko”

Reply Alleges: “*Abiko provided specific advantages, including . . . the ability to automatically display messages by sender.*” Reply, 8-9

Apple Mail



Microsoft Exchange



Knauf Insulation (Fed. Cir. 2019): “It is not enough, even after KSR, to support a determination of obviousness that a reference includes a broad generic disclosure and a common utility to that in the claims and other prior art references—there must be some reason to select a species from the genus.” Sur-Reply, 11

Prior Art Deficiencies

Modification of Ordning's icon to display a count of the number of distinct senders of new messages - Element 1[c]

Petitioner’s third layer of modification is deficient

Proposed modifications to Ording’s computer based on Abiko:

- 1) modifying Ording’s computer to have “wireless communications capabilities of the mobile terminal in Abiko” (Pet., 31 (preamble)).
- 2) modifying Ording’s computer to store “the e-mail program of Abiko” so that it is launched using an icon on Ording’s userbar 600 (Pet., 33-34 (element 1[a])).
- 3) modifying Ording’s icon to display a count of the number of distinct senders of new messages (Pet., 39-41 (element 1[c])).

Proposed additional modifications to resulting system:

- 4) modifying Abiko’s e-mail program “to separately store new messages” by adding a “New mail folder” and a “Main mail folder” in “the same way” mentioned in Crumlish (Pet., 44).
- 5) modifying Abiko’s e-mail program by creating a sender information menu—in addition to the newly added “New mail folder”—that is generated “by processing only the messages in the new message folder.” (Pet., 44).

Petitioner's third layer of modification is deficient

Dr. Surati:

screen or something like that.”). The fact that the final row of Abiko’s sender menu was buried at the end of the listing and not necessarily displayed onscreen would not have demonstrated a level of importance of the final row as compared to the preeminence of initial rows in the sender menu. Ultimately, the Petition did

NOT DISPUTED IN THE REPLY Sur-Reply, 12; 2d Surati Dec., EX2013, ¶55

Dr. Chatterjee:

Q. To clarify, I think you're saying that subsequent rows below what can fit on a screen would not be displayed on a screen?

A. Right. And there may be some mechanism to show those rows, for example a scrolling mechanism or another screen or something like that.

Sur-Reply, 12; EX2017, 76:18-78:4

No	Sender address	Sender name	Mail volume
1	09012345678	KAWADA, Hamako	13
2	sato@def.or.jp	sato@def.or.jp	10
3	taro@abc.or.jp	YAMADA, Taro	9
4	09012341234	09012341234	5
.	.	.	.
.	.	.	.

Sur-Reply, 12-14; 2d Surati Dec., EX2013, ¶55

Petitioner's third layer of modification is deficient

Petitioner's error:

simple count of new messages. (Chatterjee, ¶106.) And both Abiko and Crumlish recognized that users might be more interested in new messages than old ones. (*E.g.*, Abiko, ¶0099 (“[G]ives priority to the senders whose messages were most recently received....”); Crumlish, p.41.)

Petition, 47

Dr. Surati:

The Petition relies on this paragraph of Abiko to support Petitioners' assertion that a number of unread messages might be more valuable than a number of all messages. Based on my knowledge and experience in the field and my review of Abiko, Abiko describes prioritizing senders based on the date messages were received, irrespective of whether the messages are unread or read. For example, a message having a more recent “In Date” that has been read would be given priority over a message having a later “In Date” that is unread, which is a result that is the opposite to what is alleged at page 47 of the Petition.

Sur-Reply, 12; 2d Surati Dec., EX2013, ¶156

NOT DISPUTED IN THE REPLY

Abiko:

[0099] In the mobile telephone of this embodiment, since the information identifying the senders of received messages displayed on the sender selection by date menu screen gives priority to the senders whose messages were most recently received, the user can easily find desired sender identification information. The utility of the sender identification information is therefore enhanced.

Sur-Reply, 12; EX1109, [0099]

Petitioner’s third layer of modification is deficient

Petitioner’s analysis ignores “tradeoffs” without properly analyzing the prior art’s stated preferences, thus reducing to an assertion the proposed modifications were feasible—mere combinability.


Dvorak

• **Mail storms.** Often when a mail thread begins, people will feel the obligation to chime in for no good reason except to make their presence felt. Adding “Amen,” “I agree with this idea,” or other such blather and rebroadcasting the message does nobody any good. And getting into an e-mail argument that is

standard Internet mail. Combine these problems with the ubiquitous HTML “mailto:” command and the “reply to all” command and what we have is nothing less than a **monster no tool can easily fix.** Let’s examine just a few of the e-mail problems.

Needless to say, there are a lot of problems developing with e-mail, and they’re continuing to grow. I didn’t even have to mention spam mail to swamp you with problems. **And I see no easy cure for this situation except discipline.** It will sink us if we don’t try to do something. Starting with strict policies would help.

Sur-Reply, 14-15; EX1111, 18; Response, 33; 2d Surati Dec., EX2013, ¶157

Winner Int’l Royalty Corp. v. Wang, 202 F.3d 1340, 1349 (Fed. Cir. 2000): “Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter.”  **The Petition failed to meet its burden**

Petitioner's third layer of modification is deficient

Problem described by Abiko:

[0005] With the conventional mobile telephone, however, a user who wishes, for example, to create a list of all received mail messages from a particular sender must search through numerous messages one by one by means of a manual input operation. Some received messages required are therefore likely to be overlooked and many operations are needed to find the messages. Moreover, with the con-

Abiko's Solution:

(b)

Sender selection by mail volume menu	
1. KAWADA, Hanako	13
2. <u>satoh@def.or.jp</u>	10
3. YAMADA, Taro	9
4. 09012341234	5
.	.
.	.

No	Sender address	Sender name	Mail volume
1	09012345678	KAWADA, Hanako	13
2	<u>satoh@def.or.jp</u>	satoh@def.or.jp	10
3	<u>taro@abc.or.jp</u>	YAMADA, Taro	9
4	09012341234	09012341234	5
.	.	.	.
.	.	.	.

Response, 8-9, 45; 2d Surati Dec., EX2013, ¶35

Petitioner’s third layer of modification is deficient

Petition:

(Abiko, ¶¶0004-0005.) It therefore would have been obvious that the number of senders who sent unread messages **might be** more valuable to certain users than a simple count of new messages. (Chatterjee, ¶106.) And both Abiko and Crumlish recognized that users **might be** more interested in new messages than old ones. (*E.g.*,

For example, users who receive a large number of new e-mails **might** find a numeric character identifying the number of *senders* who have sent unread messages more useful and informative than simply a raw number of unread *messages*.

Petition, 46-47

In re Kotzab (Fed. Cir. 2000): “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, **would have selected** these components for combination in the manner claimed.”

Response, 25-27

Prior Art Deficiencies

**Further Modifications to Abiko's E-mail
program - Element 1[c]**

Petitioner’s fourth and fifth layers of modifications are deficient

Proposed modifications to Ording’s computer based on Abiko:

- 1)** modifying Ording’s computer to have “wireless communications capabilities of the mobile terminal in Abiko” (Pet., 31 (preamble)).
- 2)** modifying Ording’s computer to store “the e-mail program of Abiko” so that it is launched using an icon on Ording’s userbar 600 (Pet., 33-34 (element 1[a])).
- 3)** modifying Ording’s icon to display a count of the number of distinct senders of new messages (Pet., 39-41 (element 1[c])).

Proposed additional modifications to resulting system:

- 4)** modifying Abiko’s e-mail program “to separately store new messages” by adding a “New mail folder” and a “Main mail folder” in “the same way” mentioned in Crumlish (Pet., 44).
- 5)** modifying Abiko’s e-mail program by creating a sender information menu—in addition to the newly added “New mail folder”—that is generated “by processing only the messages in the new message folder.” (Pet., 44).

Petitioner’s further modifications to Abiko’s e-mail program suffer from multiple errors

Dr. Suratani:

In other words, the Petition provides no explanation as to how information related to read messages could be viewed, no explanation as to how all (read and unread) messages of a particular sender could be viewed, or even whether sender information for such messages could be viewed at all. A POSITA would have found these defects readily recognizable. For example, Fig. 8 of Abiko shows a

NOT DISPUTED IN THE REPLY

modified system might be configured, the Petition does not explain it. The proposed combination here again increases the risk that some received messages of a particular sender would be “overlooked” or would require “many operations” to locate, which Abiko set out to avoid. Petitioners assumed a POSITA could make

No	Sender address	Sender name	Mail volume
1	09012345678	KAWADA, Hamako	13
2	satoh@def.or.jp	satoh@def.or.jp	10
3	taro@abc.or.jp	YAMADA, Taro	9
4	09012341234	09012341234	5
.	.	.	.
.	.	.	.

Response, 49; Sur-Reply, 21;
2d Suratani Dec., EX2013, ¶73

At most, Petitioner requires the Board to speculate “how the combination[] was supposed to work” with respect to read/unread messages.
Personal/Web, 848 F.3d 987 at 994.

Petitioner’s further modifications to Abiko’s e-mail program suffer from multiple errors

Petitioner’s error:

Abiko explains that “[t]he received messages used to create the menu information including information identifying senders may include all received messages or only received messages that satisfy prescribed conditions.” (Abiko, ¶0011.) Abiko also explains that the menu information, which includes the number of distinct senders (e.g., Fig. 10(b)), could be created “when a new message is received.” (Abiko, ¶0015.) It therefore would have been obvious to implement Abiko to create the sender table and menu (e.g., Figs. 8, 10) – and thus count the number of distinct senders – only for new (unread) messages. (Chatterjee, ¶95.)

Petition, 42

Dr. Surati:

conditions” and “when a new message is received”). This passage of Abiko describes a **temporal trigger of when the menu information is populated**—“when a new message is received” —not a filter that limits which messages are included in the list. Based on my knowledge and experience in the field and my review of Abiko, a POSITA would have readily recognized this distinction. Critically, I see no explanation or evidence in the Petition why messages that are “not new” would be removed or otherwise excluded from Abiko’s sender information menu. Indeed,

NOT DISPUTED IN THE REPLY

Response, 47; EX2013, ¶171

Petitioner’s further modifications to Abiko’s e-mail program suffer from multiple errors

Moreover, Crumlish’s statements would have been regarded as mere subjective opinions, with which a skilled artisan would have felt free to agree or disagree. (*Id.*, ¶22.) Patent Owner’s expert acknowledged that he personally does

Reply, 15

Petitioner’s legal error:

TIP

I keep my mail around until I’ve replied to it. I could save it to a mailbox (as I’ll explain presently) but then I might forget about it. When my In box gets too cluttered, I bite the bullet and reply to mail I’ve been putting off, and then delete most of it.

Authority:

- “[S]tatements regarding preferences are relevant to a finding regarding whether a skilled artisan would be motivated to combine that reference with another reference.” *Polaris*, 882 F.3d at 1069 (Fed. Cir. 2018)
- “[S]tatements regarding users preferring other forms of switches are relevant.”

Apple, 839 F.3d 1034, 1051 n.15 (Fed. Cir. 2016)

Petitioner’s further modifications to Abiko’s e-mail program suffer from multiple errors

Dr. Surati:

references of Ground 1-4, a POSITA in 2003 would have understood that the Petition’s proposed modification would have hindered the performance and usability of Abiko’s e-mail program because e-mail messages that have not yet been replied to would have been automatically segregated in a different mailbox where—as explained by Crumlish—the user would be apt to “forget about” those messages and inadvertently fail to reply. EX1110, 49. In other words, **the Petition’s proposed modification introduced specific disadvantages that Crumlish expressly sought to avoid.**

Response, 38; 2d Surati Dec., EX2013, ¶162

Petitioner’s further modifications to Abiko’s e-mail program suffer from multiple errors

Crumlish:

Unread (usually new) mail typically appears with some indicator that it’s new, such as the Subject line appearing in bold, or a bullet or checkmark appearing next to new messages. This is supposed to help you avoid accidentally missing messages.

Dr. Surati:

checkmark appearing next to new messages.” EX1110, 48. Based on my knowledge and experience in the field and my review of Crumlish, these original solutions described by Crumlish achieved Petitioner’s sole purported motivation to “enable the user to focus on newly received messages.” Importantly, these solutions also avoided the risk that Crumlish explicitly warns against because they do not involve automatically moving mail to a different mailbox where the mail could be inadvertently forgotten. Petitioner’s reliance on Crumlish’s mention of

Response, 40;
EX2013, ¶63

Authority: “[E]ven if a reference is not found to teach away, its statements regarding preferences are relevant to a finding regarding whether a skilled artisan would be motivated to combine that reference with another reference.” *Polaris*, 882 F.3d at 1069 (Fed. Cir. 2018) (emphasis added)

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Sur-Reply, 18-19

Petitioner’s further modifications to Abiko’s e-mail program suffer from multiple errors

Notice of Allowance:

The prior art of record fails to disclose a numeric character that represents a count of the plurality of different messaging correspondents for which one or more of the electronic messages have been received and remain unread.

Response, 5; EX1113, 826

- 3) modify Ording’s icon to display a count of the number of distinct senders of new messages (Pet., 39-41 – element 1[c]).
- 4) modify Abiko’s e-mail program “to separately store new messages” by adding a “New mail folder” and a “Main mail folder” in “the same way” mentioned in Crumlish (Pet., 44 – element 1[c]).
- 5) modify Abiko’s e-mail program by creating a sender information menu—in addition to the newly added “New mail folder”—that is generated “by processing only the messages in the new message folder.” (Pet., 44 – element 1[c]).

W.L. Gore & Assocs. (Fed. Cir. 1983): reversing obviousness finding where “claims were used as a frame, and individual, and individual, naked parts of separate prior art references were employed as a mosaic to recreate a facsimile of the claimed invention.”

Sur-Reply, 23

Petitioner’s further modifications to Abiko’s e-mail program suffer from multiple errors

Dr. Surati:

(emphasis added); FIG. 10. In other words, Abiko itself demonstrates that the

significance of “numbers” in the sender table was in the context of the selecting a

row on the interface. Based on my knowledge and experience in the field and my

Response, 54-55; EX2013, ¶77

[0122] The sender selection by mail volume menu screen shown at FIG. 10(b) also displays a cursor C3 for selecting, for instance, a single item of “Sender name” information from among the multiple items of “Sender name” information the selected “Sender name” information. In the example shown at (b) in the drawing, “1. KAWADA, Hanako” is selected by the cursor C3.

Response, 55; EX1109, [0122]

Prior Art Deficiencies

**Ground 2 – Ording, Abiko, Crumlish,
Dvorak, and McPherson**

Petitioner's further modifications based on McPherson are deficient

McPherson:

Yahoo provides free e-mail and a calendar, and Yahoo Messenger can notify you when you receive e-mail or when an appointment is due. Yahoo Messenger provides a hyperlink to a text-only My Yahoo page with links to e-mail and calendar, which opens in Pocket Internet Explorer. To turn these alerts on or off, tap the Alerts tab on the Preferences screen and select or clear the check boxes.

Response, 61-62; EX2011, 174

Dr. Surati:

McPherson. McPherson already describes a solution for alerting a user of an incoming mail messaging in the context of instant messaging programs. For example, McPherson describes that “Yahoo messenger can notify you when you receive e-mail,” and “provides a hyperlink to a text-only My Yahoo page with links to e-mail and calendar, which opens in Pocket Internet Explorer.” EX1112, 419. The Petition does not address this solution described by McPherson, or any reason why it would have been disregarded by a POSITA.

Sur-Reply, 24; EX2013, ¶83.

NOT DISPUTED IN THE REPLY

Petitioner’s further modifications based on McPherson are deficient

McPherson:

Instant messaging is the CB radio of the Internet. If you are too young to remember, CB (citizens band) radios provide two-way voice communication, and they were very popular in the mid ‘70s.

You”. It was the first of what is now called *instant messaging software*. With an instant messaging program you can see whether your friends are connected to the Internet; and if so, you can send them text messages. Instant messaging is faster than e-mail, because you know the recipient is online to receive your message.

Response, 59; EX1112, 412

Dr. Surati:

81. Moreover, based on my knowledge and experience in the field and my review of McPherson, a POSITA would have recognized that McPherson’s “Notification bubble” was intended to facilitate a real-time, two-way conversation of the instant messaging, such as by displaying the received message and prompting a user with “Chat” and “Ignore” buttons that can be clicked to instantly engage in a conversation with the sender or to ignore the message. EX1112, 415

Response, 60; EX2013, ¶181.