

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Backholm, et al.
U.S. Patent No.: 10,027,619 Attorney Docket No.: 39521-0089IP1/IP2
Issue Date: July 17, 2018
Appl. Serial No.: 14/609,189
Filing Date: Jan. 29, 2015
Title: MESSAGING CENTRE FOR FORWARDING E-MAIL

Mail Stop Patent Board

Patent Trial and Appeal Board
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**PETITIONER'S NOTICE RANKING PETITIONS AND EXPLAINING
MATERIAL DIFFERENCES BETWEEN PETITIONS FOR U.S. PATENT
NO. 10,027,619**

Petitioner is filing two concurrent Petitions challenging the validity of claims of U.S. Patent No. 10,027,619 (“the ’619 patent”). Petitioner submits this paper pursuant to the Board’s July 2019 Trial Practice Guide Update.

I. Ordering of Petitions

Although Petitioner believes that both Petitions are meritorious and justified, Petitioner requests that the Board consider the Petitions in the following order:

Rank	Attny. Docket No.	Primary Reference
A	39521-0089IP1	Hind
B	39521-0089IP2	Brown

II. Material Differences that Compel Permitting Multiple Petitions

A. Difference in Focus of Primary References

While Hind and Brown are both generally directed toward e-mail redirection (by necessity, due to the subject matter of the ’619 patent), the specifications of Hind and Brown focus on different aspects of the redirection process. For example, Brown’s disclosure is largely dedicated to descriptions of authentication of a requesting device by an authenticating device through exchange of an authentication password (APPLE-1012, 1:60-4:26, 7:44-9:36; 14:15-16-67) with comparatively limited (yet still complete) disclosure of e-mail redirection (APPLE-1012, 5:37-7:43). By contrast, while Hind’s disclosure of the “PIN” used for service activation fully discloses the relevant portions of the challenged claims, such discussion of Hind’s PIN is limited to a few brief sections (APPLE-1004,

12:8-11, 17:18-31, 20:14-19, 28:25-29) while the bulk of Hind’s disclosure addresses message redirection. This difference in focus of the primary references leads to a difference in how the secondary references are applied by each Petition.

B. *Disclosure of the device that receives the “service activation code” in relation to receiving/sending the message*

Hind provides a clear and express disclosure that the device that receives the “PIN” and authenticates the requesting device (the mobile device) is the same device that redirects (receives, encrypts, and sends) the e-mail messages (the host system). APPLE-1004, 17:11-31, 28:27-29:1; Hind Petition, pp. 15-27. By contrast, the bulk of the relevant disclosure in Brown regarding device authentication refers generically to “requesting” and “authenticating” devices. APPLE-1012, 1:60-4:26, 7:64-8:15; 14:15-16-67. Due to this distinction, the Brown petition relies on obviousness arguments (based on Brown alone and an alternative argument based on the combination of Brown and Thompson) to demonstrate that it was obvious for the device that receives the authentication password to be the device that redirects messages. Brown Petition, pp. 20-42.

C. *Claims 32, 46 “...the encryption key is closely related to the service activation code.”*

The Brown reference discloses an example in which the password (which serves as Brown’s service activation code) is used as the encryption key to encrypt information (Brown Petition, pp. 48-59) while the Hind petition relies solely on a

secondary reference (Richardson) for such disclosures.

D. *Claim 33 “...store an association between at least two of...”*

The Hind reference discloses examples in which the PIN (which serves as Hind’s service activation code) is stored in association with an identifier of the remote device and where the PIN is stored in association with the messaging account. Hind Petition, pp. 32-33. By contrast, the Brown petition relies solely on a secondary reference (Eaton) for such disclosures.

E. *Claims 36, 50, 52 “...a control message is received from the remote device upon user interaction with the message”*

The Hind reference discloses an example in which a control message is sent from the mobile device to the host system to cause the host system to redirect an attachment to an e-mail to another device, in response to user interaction with the message. Hind Petition, pp. 33-34. By contrast, the Brown petition relies solely on a secondary reference (Friend) for these claims.

F. *Type of Prior Art*

Grounds 1 and 2 of the Hind petition rely on references (Hind, Nielsen, and Thompson) that qualify as prior art under §102(b) and therefore cannot be antedated. By contrast, Brown qualifies as prior art under §102(e) and furthermore relies on an earlier filed provisional patent application for this status, thus requiring a *Dynamic Drinkware* type analysis, which opens up opportunities for both antedating by the Patent Owner, and an attack of the *Dyanmic Drinkware* analysis.

In view of the material differences shown above, the Board should exercise its discretion to institute both Petitions. Both Petitions are necessary to show the breadth of prior art that reads on the overly broad claims. Instituting on only one Petition would give Patent Owner an unfair advantage, allowing Patent Owner to strategically attempt to distinguish its claims over the instituted prior art even if those same arguments would effectively show invalidity over the non-instituted prior art. This danger of Patent Owner gamesmanship is particularly relevant in this case, because the '619 patent has never before been challenged in IPR, and consequently, Patent Owner has yet to take an official position of what its claims do and do not cover (other than Patent Owner's litigation infringement contentions, which suggests that both sets of prior art are invalidating).

Moreover, this is not a situation where Petitioner has filed many IPR petitions against one patent or is asserting dozens of independent grounds. Rather, Petitioner has filed only two petitions, each based on a single primary reference. Given the number of claims asserted in litigation by Petitioner, (20 claims in the '619 patent, alone), instituting two petitions is reasonable. The differences between the petitions are due to Seven's uncertain positions and aggressive litigation strategy, which will continue until the Patent Owner Responses are filed.

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